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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re NER Data Products, Inc.

Serial No. 78791038
(filed January 13, 2006)

Patrick J. O'Shea of O'Shea, Getz & Kosakowski, P.C. for
NER Data Products, Inc.

Karen E. Bracey, Trademark Examining Attorney, Law Office
116 (Michael W. Baird, Managing Attorney).

Before Grendel, Kuhlke, and Wellington, Administrative
Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

NER Data Products, Inc., applicant, has applied to
register the mark NER (in standard character form) on the
Principal Register for goods ultimately identified as
"toner; toner cartridges; ink jet printer ink" in
International Class 2.¹

The examining attorney has refused to register the
mark under Section 2(d) of the Trademark Act because of a

¹ Application Serial Number 78791038 is based on applicant's
statement that it has a bona fide intent to use the mark in
commerce under Section 1(b).

prior registration for the mark NUR for the following goods:²

International Class 2

Printers ink for use in connection with the goods identified in the identification of goods of classes 7 and 9.

International Class 7

Digital ink jet printing machine systems for use in wide and super-wide format printing consisting of power-operated ink jet printers, structural parts and mechanical fittings thereof, digital ink jet printers and structural parts and mechanical fittings thereof; computer software for use in wide and super-wide format printing for the purpose of integrating printing machine operations, tracking problems, and generating production reports, printed publications, namely instructional manuals, user manuals, and product documentation, and metal substrates for use as printing plates, all sold as a unit.

International Class 9

Digital ink jet printers for use in wide and superwide production printing.

After the examining attorney made the refusal final, this appeal followed. As discussed further below, we affirm the refusal.

Evidentiary Objection and Applicant's Request to Remand

Before getting to the merits of this case, we address an evidentiary objection (brief, p. 2) raised by the examining attorney in her brief as to certain attachments filed with applicant's appeal brief. Applicant argues the

² Registration No. 2733636, issued July 8, 2003. The registration also covers goods in International Classes 16 and 24; however, the refusal does not involve these goods.

materials are properly of record, but also requests remand of the application to the examining attorney should the objection be sustained. Reply, p. 3.

The objected to materials consist of copies of two appeal briefs (with exhibits) filed in a 2002 *ex parte* appeal involving the cited registration. The briefs were filed by the owner of the cited registration (as applicant at the time) in an attempt to overcome a refusal based on a registration (since cancelled) that was owned by applicant.³

Applicant argues that the materials should be considered because they were referenced in its response to the first Office Action; that the examining attorney did not raise an objection at that time; and that "as official documents of the USPTO," the materials are "self-authenticating" and attaching the documents with its response to the Office Action would have been "duplicative and unnecessary." Reply Brief, p. 2.

Applicant's arguments are not well taken. The record must be complete prior to appeal, subject to certain exceptions not relevant here. 37 C.F.R. § 2.142(d); see also TBMP § 1207.01 (2d ed. rev. 2004). Applicant's

³ A decision was never reached by the Board in that proceeding. Instead, the application was remanded to the examining attorney who withdrew the refusal and the application matured into the registration cited in this proceeding.

submission of the appeal briefs (with exhibits) here is late. While applicant referenced and relied on the briefs filed by the cited registration owner, applicant did not attach copies thereof. Moreover, briefs filed in other proceedings before the Board are not materials which the Board may take judicial notice. See TBMP § 1208.04 (2d ed. rev. 2004) [taking judicial notice in ex parte proceeding]. Accordingly, we have not considered the additional materials filed with applicant's brief.

Applicant's request to remand the application is likewise denied inasmuch as it has not shown good cause. See authorities cited in TBMP § 1207.02 (2d ed. rev. 2004) (in particular, see discussion of circumstances where good cause has been found). Even if we were to find good cause and grant applicant's request to remand, it would be pointless to the extent that applicant seeks to rely on the materials to show a dissimilarity of the respective goods in actuality versus what the goods set forth in the identifications of goods (see discussion below regarding similarity of goods). And, should applicant be relying on these briefs as evidence that the Trademark Office previously accepted the arguments contained the briefs in registering the cited registration, we need only point out that the decisions of previous trademark examining attorneys are not binding on the Board. Rather, the

present application must be decided on its own merits. *In re Sunmarks Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994). See also *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). While uniform treatment under the Trademark Act is highly desirable, our task here is to determine, based upon the record before us, whether applicant's mark is registrable.

We now turn to the merits of the refusal.

Our determination of the examining attorney's refusal to register the mark under Section 2(d) of the Trademark Act is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Initially, we look to the level of similarity of the goods. The goods of applicant and the registrant need not

be identical to find a likelihood of confusion under Trademark Act Section 2(d). They need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods originate from or are associated with the same source. See *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

It is also well-established that the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods recited in applicant's application vis-à-vis the goods recited in the cited registration, rather than what the evidence shows the goods and/or services to be. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *In re William Hodges & Co., Inc.*, 190 USPQ 47 (TTAB 1976). This is because the presumptions afforded a registration under Section 7(b) of the Trademark Act extend to the goods or services as disclosed therein, and include a presumption of use on all goods or services encompassed by said description. See *Burger Chef Systems, Inc. v. Sandwich Chef, Inc.*, 201 USPQ 611 (TTAB 1978), aff'd 608 F.2d 895, 203 USPQ 733 (CCPA 1979).

Here, as the examining attorney has correctly pointed out, applicant's identification of goods includes "ink jet printer ink" and is without any restrictions or otherwise any language narrowing the scope of use of the ink jet printer ink. Applicant's use of "printer ink" in its identification is broad enough to encompass printer ink used in connection with production printing. As such, applicant's printer ink is highly related and potentially identical to registrant's goods, i.e., "printers ink for use in connection with...digital ink jet printers for use in wide and superwide production printing." Again, applicant's argument that the cited registrant's printer ink is, in actuality, different from applicant's printer ink is not persuasive because our determination of the issue of likelihood of confusion must be based on a comparison of the goods set forth in the cited registration's and subject application's identifications of goods.

Applicant's argument that that registrant's goods are marketed to different customers and move in different trade channels is also not well taken. Because the respective goods are legally identical and the identification of goods in the application contains no restrictions, we must presume that applicant's goods will be marketed and sold to

the same classes of consumers as registrant's and through the same channels of trade. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958).

Therefore, we find the goods, channels of trade, and classes of purchasers are all factors which strongly support the refusal to register.

We now focus our inquiry on the similarities and dissimilarities in the respective marks, when considered in their entireties. To determine whether the marks are similar for purposes of assessing the likelihood of confusion, we must consider the appearance, sound, connotation and commercial impression of each mark. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In some cases, one of these means of comparison may be critical in finding marks to be similar. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988); see also, *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). Also, in comparing the marks, we are mindful that where, as here, the goods are legally identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of*

America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enter. Corp.*, 212 USPQ 957, 959 (TTAB 1981).

Comparing the appearance of the marks, NER and NUR, the obvious similarity is that each begins with the letter "N", are followed by a vowel, and ends with the letter "R". Both marks are in standard character format and, thus, we must assume they may appear in the same font and/or stylized lettering.

As to the sounds of the marks, there is no correct pronunciation of a trademark, and it obviously is not possible for a trademark owner to control how purchasers will vocalize its mark. *Interlego AG v. Abrams/Gentile Entertainment Inc.*, 63 USPQ2d 1862 (TTAB 2002), citing *In re Belgrade Shoe*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969). With this in mind, we find it perfectly reasonable that applicant's mark could be pronounced in the same manner as registrant's mark. As the examining attorney illustrated in her brief (p. 6), applicant's mark will likely be pronounced the same as the word "per" and registrant's mark in the same manner as the word "fur"; in which case, the marks would be phonetically identical.

Applicant argues that because each mark comprises three letters, it is more likely that they be pronounced by

saying each letter individually, rather than being recited as a word. Brief, p. 3. Acknowledging that this is possible, we must also take into consideration, however, the cases that have stated that marks involving letter combinations are likely to be inherently difficult to remember and, therefore, consumers are more susceptible to confusion or mistake than with word marks. See *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 16 USPQ2d 1597 (TTAB 1990) and cases cited therein. Confusion of letter combinations is a concern even when the prospective purchasers of the goods are sophisticated purchasers. See *Weiss, supra*, and *Chemetron, supra*; *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers ... are not infallible."). Thus, even if consumers were to verbalize the marks by saying each letter, the only difference would be the second letter of the respective marks and this could still lead to confusion.

As to meaning of either term, applicant argued in its response to the first Office Action that each mark has a

different defined dictionary meaning.⁴ Yet, only the examining attorney provided evidence regarding possible meanings for the terms "ner" and "nur".⁵ The term "ner" has no defined contemporary meaning, but is an obsolete spelling for "nearer"⁶ or otherwise as a reference to the father of Abner in the Bible.⁷ The term "Nur" may be defined as "a hard knot in wood" but is more commonly found spelled as "knur".⁸ A review of *Merriam-Webster's Collegiate® Dictionary, Eleventh Edition* revealed no definition entry for either term.⁹

In addition to being very remote or obscure, we do not see any obvious connection between the above-defined meanings and the goods. Applicant has not argued how any of the defined meanings have relevance to either applicant's or registrant's goods. Accordingly, we find that consumers will not view either mark as taking on a connotation connected to any of the above-defined meanings. Rather, consumers will likely view the marks as short terms

⁴ This argument was not repeated in applicant's brief.

⁵ Attached to her final Office Action (dated January 5, 2007).

⁶ Webster's Revised Unabridged Dictionary, © 1996, 1998 MICRA, Inc.

⁷ Easton's 1897 Bible Dictionary.

⁸ Webster's Revised Unabridged Dictionary.

⁹ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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without any defined meaning or significance in relation to the goods.

In view of the above, we find that applicant's mark, NER, is substantially similar to that of the prior registrant, NUR, and this factor supports the examining attorney's refusal to register.

After considering the relevant du Pont factors, as discussed above, we find that applicant's mark is likely to cause confusion with the mark in Registration No. 2733636.

Decision: The refusal to register is affirmed.