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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Petrochem, Inc.

Serial No. 78813357

Michael Cerrati and John Alunit of Patel & Alunit, P.C. for
Petrochem, Inc.

Doritt Carroll, Trademark Examining Attorney, Law Office
116 (Michael W. Baird, Managing Attorney).

Before Grendel, Zervas and Walsh, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

On February 13, 2006, Petrochem, Inc. (applicant)
applied to register the mark HT-2000 in standard-character
form on the Principal Register for goods identified as "All
purpose lubricants; Industrial lubricants; Lubricants for
industrial machinery; Lubricating oils" in International
Class 4. Applicant claims both first use of the mark
anywhere and first use of the mark in commerce on April 30,
2000.

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The Examining Attorney has refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with prior Registration No. 2190519 for the mark shown below which is registered on the Principal Register for goods identified as "lubricating oils, greases, process oils, all derived from petroleum" in International Class 4.



The registration issued on September 22, 1998, and the registration is active and incontestable. When the Examining Attorney made the refusal final applicant appealed. Both applicant and the Examining Attorney have filed briefs. We affirm.

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion...." 15 U.S.C. § 1052(d). The opinion in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the

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factors to consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of the applicant and registrant. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

The goods of applicant and the registrant need not be identical to find likelihood of confusion under Section 2(d) of the Trademark Act. They need only be related in such a way that, because of the similarity of the marks, the circumstances surrounding their marketing could result in relevant consumers mistakenly believing that the goods originate from the same source. *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). See also *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

Furthermore, in comparing the goods we must consider the goods as identified in the application and registrations. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

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Applicant does not argue that there is any difference between the goods of applicant and the goods of registrant as identified in the application and the cited registration. The Examining Attorney points out that the goods of applicant and those identified in the cited registration are, at least in part, identical. Both the application and the cited registration include "lubricating oils." Although the registration specifies that the "lubricating oils," and the other identified goods, are derived from petroleum and the application does not, the "lubricating oils" identified in the application logically include those identified in the cited registration. Accordingly, the goods of applicant and registrant are, at least in part, legally identical. The remainder of the goods in the application and cited registration are closely related. Accordingly, we conclude that the goods are, at least in part, identical for purposes of our determination of likelihood of confusion here.

Furthermore, we note that, "the degree of similarity [between the marks] necessary to support the conclusion of likely confusion declines" when the goods or services are identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1992).

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). While we must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. As the Court of Appeals for the Federal Circuit observed, "...in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant argues that the marks differ significantly when viewed in their entireties. In fact, applicant rests its entire argument that there is no likelihood of confusion on the differences between the marks.

With respect to consideration of the marks applicant states, "In order to conduct a proper analysis, the Examining Attorney must consider: (a) the design in the

Registered Mark, (b) the word stylization and the lack of definiteness of the lettering in the Registered Mark, and (c) the addition of a distinguishing word in the Registered Mark." Applicant's Brief at 3. Applicant also states, "While it is often true that the word portion of a mark is more likely to be impressed upon a purchaser's memory, that is not the case in every situation, especially here, where the Registered Mark comprises a design feature where the words are not quite so apparent and the design contains unique features." *Id.* We have considered the marks in their entireties and find the marks similar.

First, we conclude that the design element is insufficient to distinguish applicant's mark from the mark in the cited registration. In *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987), the Board stated, "Thus, if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985)." However distinctive the design and the stylized presentation of the "HT" may be in the registered mark, the fact remains that HT is the only literal element in the registered mark which

a potential purchaser could use to identify the goods of registrant.

Furthermore, HT is the element which the marks share in common. HT is the first literal element in applicant's mark and the only literal element in the cited mark.

Presto Products, Inc. v. Nice-Pak Products Inc., 9 USPQ2d 1895, 1897 (TTAB 1988) ("... [it is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered."). See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692 ("The presence of this strong distinctive term as the first word in both parties' marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of ROYALE.").

Applicant also overstates the importance of "2000" in its own mark. Again, it follows HT. A potential purchaser familiar with registrant's mark who encounters applicant's mark on an identical or related product would likely perceive that "2000" merely identifies a related product from registrant. "2000" would simply be perceived as identifying a variation, such as a product somehow connected with the year 2000. We note that applicant claims that it began use of the HT-2000 mark in 2000,

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perhaps designating its own product as one connected with the year 2000. Accordingly, the addition of "2000" to applicant's mark is not sufficient to distinguishes applicant's mark from the registered mark. See *SBS Prods. Inc. v. Sterling Plastic & Rubber Prods. Inc.*, 8 USPQ2d 1147, 1149 (TTAB 1988).

Finally, applicant treats its own mark, which is in standard-character form, as if it were devoid of form and static. The Examining Attorney correctly points out that, by presenting its mark in standard-character form, applicant seeks a registration which would protect the mark in various manners of display within reason. See *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). Those variations could include one which resembles the display in the cited registration.

In conclusion, we have considered applicant's mark and the mark in the cited registration in their entireties in terms of appearance, sound, connotation and commercial impression, and we conclude that the marks are similar. While there are specific differences between the marks, we conclude that those differences are not sufficient to distinguish the marks which have the same dominant literal element, HT.

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Finally, we have considered all arguments and evidence bearing on the *du Pont* factors in this case and conclude that there is a likelihood of confusion between applicant's mark and the cited mark principally because the marks are similar and the goods are legally identical and otherwise closely related.

Decision: We affirm the refusal to register applicant's mark under Trademark Act Section 2(d).