

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Mailed: October 1, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Wheel Technology Ltd.

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Serial No. 78884488

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Jonathan Moskin of White & Case LLP for Wheel Technology Ltd.

Brian Pino, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

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Before Drost, Cataldo and Wellington,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Wheel Technology Ltd. has filed an application on the Principal Register for the mark ROTO SHAVE (in standard characters with SHAVE disclaimed) for "electric razors, non-electric razors, razor blades and razor cases" in International Class 8.<sup>1</sup>

Registration has been finally refused pursuant to

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<sup>1</sup> Application Serial No. 78884488 was filed on May 16, 2006, based upon applicant's assertion of its bona fide intent to use the mark in commerce.

Trademark Act §2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark ROTORAZOR (in standard characters) in Registration No. 2987507<sup>2</sup> for "razors for cutting hair" in International Class 8, as to be likely, if used on or in connection with the identified goods, to cause confusion, to cause mistake, or to deceive. Applicant and the examining attorney have filed main briefs on the issue under appeal. In addition, applicant filed a reply brief.

#### **Evidentiary Matters**

Before turning to the substantive ground for refusal, we note that applicant has submitted five exhibits (Exhibits A through E) with its main brief. These exhibits consist of materials that previously were made of record by applicant during prosecution of the involved application. As such, the materials comprising Exhibits A through E are at best duplicative and cumulative of evidence timely made of record, and thus need not and should not be resubmitted. *See Life Zone, Inc. v. Middleman Group, Inc.*, \_\_\_USPQ2d\_\_\_, (TTAB July 15, 2008).

Further, we note that both applicant and the examining attorney have submitted definitions of "roto" with their briefs. Both definitions agree that "roto" is an

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<sup>2</sup> Issued on August 23, 2005.

abbreviation for various terms, most notably "rotogravure."<sup>3</sup> In addition, the examining attorney submitted a definition of "rotogravure" with his brief. However, none of these dictionary definitions apply to the goods recited in the involved application or cited registration. As a result, none is helpful in coming to our determination on the issue under appeal. Accordingly, while we will exercise our discretion to take judicial notice of these definitions, we have not relied upon them in our determination herein.<sup>4</sup>

#### **Likelihood of Confusion**

Our determination under Trademark Act §2(d) is based upon an analysis of all of the probative 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 and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311,

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<sup>3</sup> The examining attorney relies upon *Random House Unabridged Dictionary* (2006) and *The American Heritage Abbreviations Dictionary* (3<sup>rd</sup> Ed. 2005), and applicant relies upon *The Oxford English Dictionary* (2<sup>nd</sup> Ed. 1989) for these definitions.

<sup>4</sup> The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). See also *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999), and cases cited therein.

We review the relevant *du Pont* factors as they apply to this case.

The Goods

We begin by comparing applicant’s goods with those of registrant. In making our determination under the second *du Pont* factor, we look to the goods as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the

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identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.")

In this case, applicant's goods are identified as "electric razors, non-electric razors, razor blades and razor cases" and registrant's goods are identified as "razors for cutting hair." Thus, on the face of the goods as recited in the application at issue and the cited registration, "electric razors" and "non-electric razors" encompass registrant's "razors for cutting hair," which are more narrowly identified inasmuch as they recite a particular function, namely, cutting hair. Put another way, registrant's "razors for cutting hair" are a subset of applicant's more generally identified electric and non-electric razors. We are not persuaded by applicant's arguments and evidence that registrant's goods are actually narrower in nature and scope than indicated in its identification of goods. See *Octocom Systems, Inc. v.*

*Houston Computers Services Inc., supra.* Nor do we find that registrant's goods, as identified, are so ambiguous as to require reliance upon extrinsic evidence in order to come to a determination with regard to their similarity to those of applicant. Cf. *In re Trackmobile, Inc.*, 15 USPQ2d 1152 (TTAB 1990); and *Acomb v. Polywood Plastics Corp.*, 187 USPQ 188 (TTAB 1975).

In addition, it is commonly understood that razor blades are the cutting portion of razors, and that they become dull and must be replaced with sharp blades in order for razors to function. It is further understood that "razor cases" may be used to hold or store razors. Inasmuch as applicant's identification of goods does not specify the types of razors with which its blades and cases may be used, it must be presumed that such may be used with "razors for cutting hair." See *Paula Payne Products v. Johnson Publishing Co., supra.* Thus, applicant's "razor blades" are related to registrant's "razors for cutting hair" inasmuch as the former are a necessary and integral part of the latter. Further, applicant's "razor cases" are related to registrant's "razors for cutting hair" inasmuch as the former may be used to hold or store the latter.

As such, based upon the goods recited in the involved application and the cited registration, we find that

applicant's goods encompass in part or otherwise are related to those provided by registrant.<sup>5</sup> The legal identity in part of the goods is a factor that weighs heavily against applicant.

Channels of Trade

Neither applicant's goods nor those of registrant contain any restrictions as to the channels of trade in which they are distributed or the class of purchasers to whom they are marketed. It is settled that in making our determination regarding the channels of trade, we must look to the goods as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, *supra*; and *Paula Payne Products v. Johnson Publishing Co.*, *supra*. Because as noted above the

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<sup>5</sup> Applicant, in its briefs, requests remand of the involved application to submit an unspecified amendment to limit its identification of goods, and argues that it was prevented from doing so during examination of its application due to the examining attorney's failure to articulate the basis for his contention that applicant's goods are related to those of registrant. We note, however, that the examining attorney stated his position that applicant's goods encompass those of registrant in both his first and final Office actions as well as his denial of applicant's request for reconsideration. Applicant thus was afforded two opportunities to submit an amendment to its identification of goods during examination of its application, and a further opportunity to submit such an amendment with a request for remand or as part of its main brief. See TBMP §1205.01 However, applicant never filed a proposed amendment to its identification of goods, and will not now be heard to argue for the first time in its brief that it seeks an additional opportunity to do so. See Trademark Rule 2.142(g). See also TBMP §1218. Accordingly, applicant's request for remand is denied.

goods are legally identical in part and otherwise related, and there are no restrictions in the application or registration, registrant's goods are presumed to move in the same channels of trade as those of applicant and be available to the same classes of potential consumers. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Accordingly, this *du Pont* factor further favors a finding of likelihood of confusion.

The Marks

We turn then to the first *du Pont* factor, i.e., whether applicant's ROTO SHAVE mark and registrant's ROTORAZOR mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We note initially that the test under the first *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather

than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

In this case, the marks ROTO SHAVE and ROTORAZOR are similar in appearance and sound. Both marks share the identical first term ROTO, followed by the disclaimed, descriptive term SHAVE in applicant's mark and the highly descriptive term RAZOR in that of registrant. Furthermore, we note that ROTO, the word which the marks share in common, is also the first word in the marks. *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*, *supra*.

In addition, the marks as a whole are substantially similar in connotation and commercial impression. The examining attorney submitted during examination of the involved application definitions of RAZOR and SHAVE.

According to these definitions, RAZOR is defined as

a sharp-edged cutting instrument used especially for shaving the face or other body parts; a device for holding a razorblade, with guards to prevent cutting of the skin; an electric instrument with vibrating or rotating blades used

for shaving; and to shave cut, or remove with or as with a razor.<sup>6</sup>

SHAVE is defined as "to remove the beard or other body hair from, with a razor or shaver; to cut (the beard, for example) at the surface of the skin with a razor or shaver."<sup>7</sup> By definition, when used as a verb, RAZOR is essentially identical in meaning to SHAVE. When used as a noun, RAZOR is highly similar in meaning to SHAVE in that the former is defined as the device used to perform the latter. As such, ROTO SHAVE and ROTORAZOR both connote a rotating device used to cut facial, head or body hair. ROTO SHAVE and ROTORAZOR thus have the same connotation as applied to the goods both of applicant and registrant, and convey highly similar commercial impressions.

Thus, based upon the foregoing analysis, we find that applicant's mark is highly similar to that of registrant in appearance, sound, connotation and overall commercial impression. As such, this *du Pont* factor also weighs heavily against applicant.

Strength of Registrant's Mark

Applicant argues that registrant's ROTORAZOR mark is "best categorized as descriptive (as previously argued) -

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<sup>6</sup> *The American Heritage Dictionary of the English Language*, (4<sup>th</sup> Ed., 2000), retrieved from Bartleby.com.

<sup>7</sup> Id.

or at most weakly suggestive" (brief, p. 13) and that there is no "evidence of secondary meaning that the term has acquired broader significance" (brief, p. 12).

We point out, however, this is an ex parte proceeding, and applicant is not permitted to overcome a refusal by arguing that a cited registration is merely descriptive. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997). See also *Hecon Corporation v. Magnetic Video Corporation*, 199 USPQ 502, 507 (TTAB 1978) ("Applicant has also contended that the term 'COPYCORDER' is 'particularly descriptive' of opposer's goods and thus is entitled to but a limited scope of protection. Aside from the fact that the term 'COPYCORDER' is, in our opinion, only suggestive as applied to either opposer's or applicant's goods, the assertion of descriptiveness constitutes a collateral attack upon the validity of opposer's pleaded registration and as such cannot be entertained herein in the absence of a counterclaim to cancel the same"). Therefore, inasmuch as the cited mark is registered on the Principal Register, we must assume that it is at least suggestive and we cannot entertain applicant's argument that the registered mark is descriptive of registrant's goods or otherwise lacking in secondary meaning.

Applicant further argues that "the USPTO registry lists 262 applications or issued registrations incorporating the primary element 'ROTO'" (brief, p. 14), and that, as a result, registrant's ROTORAZOR mark is weak and entitled to a narrow scope of protection. However, applicant has not submitted copies of any of the asserted third-party registrations or applications. To make third-party applications or registrations of record, applicant must submit a copy thereof or a printout from the USPTO's electronic database prior to the briefing stage of the case. *See In re Duofold, Inc.*, 184 USPQ 638, 640 (TTAB 1974). Moreover, in his final Office action the examining attorney advised applicant that its mere assertion of the existence of these registrations and applications is insufficient to make them of record at a point when applicant could have corrected the error. *See* TBMP §1208.02. We therefore have given no consideration to applicant's unsupported assertions regarding the putative weakness of registrant's mark due to third-party registrations of similar marks.

We accordingly find that, on the record in this case, the mark in the cited registration is entitled at least to a sufficient scope of protection to prevent registration of a confusingly similar mark for goods that are legally

identical in part. See *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1740 (TTAB 1991), *aff'd unpub.*, (Appeal No. 92-1086, Federal Circuit, June 5, 1992). Cf. *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559 (TTAB 1996).

Summary

Neither applicant nor the examining attorney has discussed any of the remaining *du Pont* factors. We note, nonetheless, that none seems to be applicable, inasmuch as we have no evidence with respect to them.

In light of the foregoing, we conclude that consumers familiar with registrant's goods sold under its above-referenced mark would be likely to believe, upon encountering applicant's goods rendered under its mark that the goods originated with or are associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

**Decision:** The refusal to register is affirmed.