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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Trumpf GmbH + Co. KG

Serial No. 79015005

Peter L. Costas of Pepe & Hazard LLP for Trumpf GmbH + Co. KG.

Colleen Kearney, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Seeherman, Holtzman, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 25, 2005, Trumpf GmbH + Co. KG (applicant)

applied to register the mark **Merkur** (stylized) on the

Principal Register for goods ultimately identified as:

Operating tables and parts thereof, namely operating table pedestals and table tops supported thereon; operating table accessories, namely pelvis supports, buttock supports, arm supports, leg supports, knee supports, foot supports, lateral supports, head supports, shoulder supports and rectal positioning devices for medical use; transporters and lifts for transporting patients and table tops to, and from, operating table columns and for lifting patients onto

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and from, operating tables, and for lifting table tops onto and from columns in Class 10.

The application (extension of protection) was filed under the provision of 15 U.S.C. § 1141f(a), Section 66(a) of the Trademark Act. Serial No. 79015005.

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act because of a registration of the mark MERCURY (in typed or standard character form) for a "full line of medical equipment and supplies identified by a housemark" in Class 10.¹ 15 U.S.C. § 1052(d).

After the examining attorney made the refusal final, this appeal followed.

We affirm.²

The examining attorney argues that applicant's "mark MERKUR is the foreign equivalent of the registered mark

¹ Registration No. 1557794 issued on September 26, 1989. Affidavits under Sections 8 and 15 have been accepted or acknowledged.

² The examining attorney also relied on a second registration, owned by the same entity, for the mark MERCURY MEDICAL in typed form for "medical and surgical equipment and supplies; namely, anesthesia and respiratory apparatus, suction devices, needles, stethoscopes, sphygmomanometers, laryngoscopes, medical hose assemblies and adjustable medical chairs" in Class 10. Registration No. 1694194, renewed. The registration contains a disclaimer of the term "Medical." In view of our conclusion that there is a likelihood of confusion with the '794 registration, we do not reach the confusion issue for the '194 registration. If it were subsequently concluded that there was no likelihood of confusion with the '794 registration, there would similarly not be a likelihood of confusion with the '194 registration.

MERCURY... Specifically the German word MERKUR translates to MERCURY in English." Brief at unnumbered p. 5. Regarding the goods, the examining attorney maintains that applicant's "goods, namely operating tables, parts thereof, and lifts for transporting patients to and from operating tables, are undoubtedly within the scope of a full line of medical equipment and supplies. A full line is just that. All conceivable medical equipment and supplies are covered under registrant's identification." Brief at unnumbered p. 7.

Applicant argues that the "marks are different visually and phonetically." Reply Brief at unnumbered p. 1. Regarding the foreign translation, applicant maintains that "there is no English meaning for the German word "MERKUR" which is applied for registration. The German word is not commonly known in the United States." *Id.* It "is the special nature of the goods concerned (goods for reestablishing and/or preserving human health) which urges the consumer to take marks which are used for marking those goods as they are." Reply Brief at unnumbered pp. 1-2. Finally, "purchasers of the goods of the prior registrant and those of Applicant are discerning and discriminating buyers who recognize that the respective goods come from different sources." Brief at 9.

Determining whether there is a likelihood of confusion requires application of the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that “[t]he fundamental inquiry mandated by § 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).

We begin by discussing whether the involved goods are related. We must consider the goods as they are identified in the application and registration. *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 re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (punctuation in original) (quoting *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987)) (“Likelihood of confusion must be determined based on an analysis of the mark applied to the ... services [or goods] recited in applicant’s application vis-à-vis the ... services

[or goods] recited in [a] ... registration, rather than what the evidence shows the ... services [or goods] to be'").

In this case, applicant's goods include medical supplies and equipment such as operating tables and accessories and transporters and lifts for transporting patients and for lifting patients onto and from, operating tables. Registrant's goods are identified as a full line of medical equipment and supplies. We agree with the examining attorney that applicant's goods would be included within registrant's full line of medical supplies and equipment.³ See, e.g., *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999) ("[A]pplicant's figurines must be considered to be encompassed by registrant's broadly described 'full line of toys,' notwithstanding applicant's restriction of its own goods to wooden figurines and its claim that the figurines are 'collectibles rather than toys'").

Inasmuch as the goods of applicant and registrant are overlapping, when "marks would appear on virtually identical goods or services, the degree of similarity

³ We add that even if the goods were not at least legally identical in part, the examining attorney has submitted evidence in the nature of third-party registrations, see, e.g., Nos. 0404862, 1400234, 1456370, and 1889205, to suggest that operating tables and other medical equipment are related because various entities have registered these goods under a common mark. See *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). Furthermore, in cases where the goods are overlapping, we must assume that the purchasers and channels of trade are the same. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"). Therefore, the factors concerning the relatedness of the goods and the overlap in the channels of trade and potential purchasers all favor a conclusion that confusion is likely.

The next factor we address requires an examination of the marks' similarity or dissimilarity in their entireties as to appearance, sound, connotation, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d

1689, 1691 (Fed. Cir. 2005). In this case, the comparison of the marks is relatively straightforward. Registrant's mark consists in its entirety of the word MERCURY.

Applicant's mark consists of the word MERKUR with a slight stylization. This stylization is not significant in our likelihood of confusion analysis inasmuch as the cited mark is depicted in typed form and we must consider that it can be displayed in any style including applicant's stylization. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) ("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce"); *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 1378, 170 USPQ 35, 36 (CCPA 1971) ("The drawing in the [opposed] application shows the mark typed in capital letters, and ... this means that [the] application is not limited to the mark depicted in any special form").

The words themselves are somewhat similar in sound and appearance inasmuch as the words MERCURY and MERKUR begin with the same letters "Mer" and are followed by what can be a phonetically similar "Kur" or "Cur" sound. Obviously, there are also some differences because registrant adds a

"Y" to its mark, which changes both the pronunciation and appearance somewhat.

Regarding the meaning of the marks, applicant and the examining attorney agree that the term MERKUR is translated as "Mercury." Response dated August 21, 2006 at 2; Examining Attorney's Brief at unnumbered p. 5. As such, the marks have identical meanings, albeit in different languages. The Federal Circuit has explained that: "Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks." *Palm Bay*, 73 USPQ2d at 1696. See also *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) ("The test to be applied to a foreign word vis-a-vis an English word with respect to equivalency is not less stringent than that applicable to two English words"). Furthermore, the Federal Circuit has explained that the doctrine of foreign equivalents "should be applied only when it is likely that the ordinary American purchaser would 'stop and translate [the word] into its English equivalent.'" *Palm Bay*, 73 USPQ2d at 1696, citing *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)

(Purchasers unlikely to stop and translate LA POSADA into its English equivalent, "the inn").

In this case, "Merkur" would be a term that potential customers would stop and translate. It is similar to the English word Mercury, and potential purchasers familiar with German would have no reason not to recognize the term as the equivalent of the English term. Moreover, we cannot agree with applicant that the "special nature" of applicant's and registrant's goods "urges the consumer to take the marks ... as they are." Reply Brief at unnumbered p. 2. In certain situations, the board has held that customers would not translate a mark into its English equivalent. For example, the board stated:

[I]t is unlikely to expect that a person encountering "AUNT MARY'S" canned fruits and vegetables in a supermarket or other establishment where goods of this type are customarily sold would translate "AUNT MARY'S" into "TIA MARIA," and then go one step further and associate these food products with applicant's restaurant.

In re Tia Maria, Inc., 188 USPQ 524, 526 (TTAB 1975).

However, there is no similar reason in this case why purchasers would not translate MERKUR as MERCURY. When potential purchasers encounter the marks MERCURY and MERKUR for the same goods, purchasers familiar with the German language would simply recognize that the terms are foreign equivalents. Unlike the terms TIA MARIA and AUNT MARY,

which have different connotations in English especially in light of the fact that first names are often not translated, persons familiar with both the English and German languages are likely to translate the terms MERCURY and MERKUR. Thus, the present case presents us with a situation that is more akin to *In re Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006) ("MARCHE NOIR and BLACK MARKET MINERALS not only have the same literal meaning, but they create the same overall commercial impression in relation to the respective goods and services"). See also *In re Accumulatorenfabrik Sonnenschein GMBH*, 160 USPQ 341, 342 (TTAB 1968) ("The prime and distinguishing element of the registered mark is the term 'SUNSHINE.' The German word 'sonnenschein' not only sounds like the word 'sunshine' but is the equivalent thereof").

Applicant also argues that "[p]urchasing agents in hospitals exercise great care in purchasing and the expense there militates against the likelihood of an assumption that the goods are related." Brief at 9. However, we are not dealing with goods that are merely related; we must assume that the goods are overlapping. Furthermore, while these medical supplies and equipment would likely be purchased by medical professionals, that fact does not mean that these purchasers would not be confused when it would

come to distinguishing trademarks that involve similar marks with identical meanings in German and English for the same goods. *In re Hester Industries, Inc.*, 231 USPQ 881, 883 (TTAB 1986) ("While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products"). We also note that this case is unlike *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 USPQ 786 (1st Cir. 1983) and *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992). In those cases, as applicant's own brief (pp. 10-11) points out, the goods were not the same. Indeed, in *Electronic Design*, 21 USPQ2d at 1391, the Federal Circuit noted that the board found that "applicant's goods are specifically different and noncompetitive." Here, the goods are at least in part the same and the channels of trade and purchasers are also assumed to be the same. Therefore, the *Astra* and *Electronic Design* cases are not on point.

In this case, we take into consideration the fact that the purchasers of applicant's and registrant's goods are likely to be sophisticated purchasers, but, when we balance

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that factor with the overlapping nature of the goods and the fact that the purchasers and channels of trade are the same, we conclude that there would be a likelihood of confusion if the marks MERCURY and its German translation, MERKUR, were used on the identified goods.

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.