

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

Mailed: July 21, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Invatec S.R.L.

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Serial No. 79024620

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of Rothwell, Figg, Ernst & Manbeck, P.C. for Invatec S.R.L.

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Before Holtzman, Zervas and Cataldo,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Invatec S.R.L. to register  
on the Principal Register the mark ADMIRAL XTREME in  
standard character form for "catheters," in International  
Class 10.<sup>1</sup>

The trademark examining attorney refused registration  
under Section 2(d) of the Trademark Act on the ground that

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<sup>1</sup> Application Serial No. 79024620 was filed on April 6, 2006,  
seeking an extension of protection under Section 66(a) of the  
Trademark Act, as amended, based upon International Registration  
No. 0886910.

applicant's mark, as used in connection with applicant's goods, so resembles the mark EXTREME, previously registered on the Principal Register for "disposable laser angioplasty catheters," in International Class 10<sup>2</sup> as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed main briefs on the matter under appeal, and applicant filed a reply brief.<sup>3</sup>

#### **Likelihood of Confusion**

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key, though not exclusive, considerations are the similarities between the marks and the similarities between

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<sup>2</sup> Registration No. 1741114 issued on December 22, 1992. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

<sup>3</sup> We note that applicant enclosed as exhibits to its brief copies of evidence previously submitted with its March 20, 2007 response to the examining attorney's September 20, 2006 Office action. Inasmuch as these filings were already of record in this proceedings, applicant's submission of copies thereof with its brief is unnecessary and duplicative.

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).

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 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 "catheters" without limitation and registrant's goods are

identified as "disposable laser angioplasty catheters." Thus, on the face of the goods as recited in the application at issue, "catheters" encompasses registrant's more narrowly identified "disposable laser angioplasty catheters." Put another way, registrant's "disposable laser angioplasty catheters" are a subset of applicant's more generally identified "catheters."

Thus, based upon the goods recited in the challenged application and the cited registration, we find that applicant's goods encompass those provided by registrant. We note in addition that applicant does not argue that its goods are dissimilar to those of registrant. The legal identity 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.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA

1973). Because the goods are legally identical and there are no restrictions in the application or registration, registrant's goods are presumed to move in the same channels of trade 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.

Strength of Registrant's Mark

Prior to our consideration the involved marks, we will consider applicant's arguments that registrant's EXTREME mark is weak as a result of third-party registration of similar marks for related goods. In support of its argument, applicant has made of record copies of third-party registrations from the United States Patent and Trademark Office's (USPTO) Trademark Electronic Search System (TESS) database. These marks include Registration No. 2472359 for the mark XTREME PLEASURE for condoms; Registration No. 2564195 for the mark XTREME for prosthetic limb components; Registration No. 2809777 for the mark EXTREME for custom knee braces for medical use; Registration No. 2986890 for the mark EXTREME RESPONSE for medical and emergency rescue equipment; and Registration No. 2967408 for the mark XTREME ZONE for heart-rate monitors, blood pressure monitors and body fat monitoring apparatus.

With regard to these third-party registrations, we first note that such registrations are not evidence of use of the marks shown therein and, therefore, are not proof that consumers are familiar with said marks so as to be accustomed to the existence of similar marks in the marketplace. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). Second, these registrations identify goods which are not as closely related to those in the cited registration as applicant's recited goods. As such, they have very limited probative value for purposes of demonstrating the asserted weakness of registrant's EXTREME mark for "disposable laser angioplasty catheters."

In addition, applicant submitted from the Office's TESS database a summary page indicating a total of 1,400 live registrations and applications for EXTREME-formative third-party marks. For the following reasons, we find this submission to be unpersuasive. First, a mere summary indicating a number of third-party applications and registrations is insufficient to make them of record. See *In re Duofold, Inc.*, 184 USPQ 638, 640 (TTAB 1974) ("[T]he submission of a list of registrations is insufficient to make them of record.") See also TBMP §1208.02 (2d ed. rev.

2004) and the authorities cited therein. Second, there is no indication of the marks that are the subject of such applications and registrations, or the goods or services recited therein. It is further settled that an application made of record in a Board ex parte proceeding is of very limited probative value, and is evidence only of its filing. See *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

We accordingly find that, on the record in this case, the mark in the cited registration is entitled to more than a narrow scope of protection, particularly in the field of catheters. 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).

The Marks

We turn then to the first *du Pont* factor, i.e., whether applicant's ADMIRAL XTREME mark and registrant's EXTREME 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).

The marks ADMIRAL XTREME and EXTREME are similar in appearance and sound. The word EXTREME is registrant's entire mark, and the nearly identical word XTREME is a major component of applicant's mark. XTREME is also a visually significant component of applicant's mark. The words ADMIRAL and XTREME do not blend together in applicant's mark as a single term, but rather are separate, giving the word XTREME separate visual prominence in the mark.

In addition, the marks as a whole are substantially similar in meaning and commercial impression. While we agree with applicant that, based upon the dictionary definitions made of record, the word ADMIRAL appears to be arbitrary as applied to its goods, we do not agree that the word EXTREME, defined as "existing in the highest or

greatest possible degree; very great; very intense"<sup>4</sup> is highly suggestive or laudatory as applied either to its goods or those of registrant. In other words, while the term EXTREME or XTREME may connote a very high level of utility or quality, there is no evidence of record that the word has any particular significance in relation to catheters. Further, to the extent EXTREME or XTREME may be found to have a particular meaning with regard to such goods, it would have the same connotation as applied to the goods both of applicant and registrant. In that case, the addition of ADMIRAL to applicant's mark would simply suggest a subset of EXTREME or XTREME catheters.

In making our determination that the marks as a whole are similar, we note the line of cases holding that the addition of other matter, such as a house mark, primary mark or other material, to one of two otherwise similar marks, will not necessarily be sufficient to distinguish the marks as a whole. *See, generally, First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988); *In re Champion Oil Company*, 1 USPQ2d 1920 (TTAB 1986); *In re Christian Dior, S.A.*, 225 USPQ 533 (TTAB 1985); and *In re C. F. Hathaway Company*, 190 USPQ 343 (TTAB 1976). The

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<sup>4</sup> *Webster's Third New International Dictionary*, (1993), submitted with applicant's June 20, 2007 request for reconsideration.

additional matter has been found sufficient to distinguish the marks under circumstances where:

(i) there are recognizable differences in the common term. *See, for example, Rockwood Chocolate Co., Inc. v. Hoffman Candy Co.*, 372 F.2d 552, 152 USPQ 599 (CCPA, 1967) (ROCKWOOD BAG-O-GOLD for candy not confusingly similar to CUP-O-GOLD for candy); or

(ii) the appropriated matter is highly suggestive or merely descriptive or has been frequently used or registered by others in the field for the same or related goods or services. *See, for example, Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005); and *In re Merchandising Motivation, Inc.*, 184 USPQ 364 (TTAB 1974) (MEN'S WEAR for a semi-monthly magazine not confusingly similar to MMI MENSWEAR for fashion consulting for men because "MENSWEAR" is merely descriptive of such services); or

(iii) the marks in their entirety convey significantly different meanings or commercial impressions. *See, for example, Lever Brothers Company v. The Barcolene Company*, 463 F.2d 1107, 174 USPQ 392 (CCPA 1972) ("ALL CLEAR!" a play on an expression popularized in connection with air raid drills, not confusingly similar to ALL, both for household cleaning products); or

(iv) the incorporated matter has been so merged with the other matter that it "loses its separate identity." See *In re Champion International Corporation*, 196 USPQ 48, 49 (TTAB 1977). See also, for example, *Castle & Cooke, Inc. v. Oulevay, S. A.*, 370 F.2d 359, 152 USPQ 115, 115 (CCPA 1967) (FARENDOLE not confusingly similar to DOLE for related food products; DOLE "is so merged into" FARANDOLE "that it loses its individual identity therein"); and *B. Kuppenheimer & Co., Inc. v. Kayser-Roth Corporation*, 326 F.2d 820, 140 USPQ 262, 263 (CCPA 1964) (the mark KUPPENHEIMER SUPPANTS and design for pants is not confusingly similar to SUPP-HOSE for hosiery; stating that the house mark "is completely integrated with the other portion of the mark" and noting that the result might be different where the house mark word is "divisible from the other word or words in the mark.")

None of these circumstances exists here. In this case, the common portions of the marks, i.e., EXTREME and XTREME differ by a single letter. They are nearly identical. Even assuming that EXTREME or XTREME is laudatory or suggestive of the parties' goods, there is no evidence that the term is highly suggestive of the identified goods or, as discussed above, that it has been commonly used or registered by others for such goods. The

commercial impressions created by the two marks are not distinctly different, as we noted above. Nor is XTREME indivisible from ADMIRAL or so merged therewith that it loses its identity. To the contrary, XTREME still remains a conspicuous and separately recognizable portion of applicant's mark.

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.

Conditions of Sale

The next *du Pont* factor discussed by applicant is that of the conditions of sale. Applicant asserts that purchasers of its goods as well as those of registrant are sophisticated medical personnel and will exercise care in selecting catheters. However, given that applicant's goods encompass those of registrant, i.e., both provide catheters of a general and more specific sort, even sophisticated consumers may not realize that applicant's recited goods do not emanate from the same source as those of registrant. Furthermore, even if some degree of care were exhibited in making the purchasing decision, because of the similarities between the marks, even careful purchasers are not likely

to distinguish between them. As a result, we also find this *du Pont* factor to weigh against applicant.

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.