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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Akzo Nobel Coatings International B.V.

Serial No. 79031781

Louis A. Morris, Esq. for Akzo Nobel Coatings International
B.V.

Katherine Connolly, Trademark Examining Attorney, Law
Office 101 (Ronald R. Sussman, Managing Attorney).

Before Drost, Taylor, and Ritchie de Larena, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On October 19, 2006, applicant, Akzo Nobel Coatings
International B.V., filed an application to register the
mark FLEXXPRESS in standard character form on the Principal
Register for goods ultimately identified as:

Industrial coatings, paints, primers and inks to be
used on plastic substrates in Class 2.

Industrial machines for transfer printing; membranes, in the nature of silicones, for industrial machines for transfer printing in Class 7.¹

The examining attorney refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a registration for the mark FLEXPRESS (standard character drawing) for high speed flexographic printing machines with variable repeat lengths for printing photographic quality images on continuous webs used for packaging of consumer goods in Class 7.²

When the refusal was made final, applicant filed a request for reconsideration and this appeal.

In cases involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). 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

¹ Serial No. 79031781. The application is an extension of protection filed under the provision of Section 66(a) of the Trademark Act. 15 U.S.C. § 1141f(a).

² Registration No. 2893640 issued October 12, 2004.

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 looking at the "first *DuPont* factor [which] requires examination of 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). In this case, the marks are FLEXXPRESS and FLEXPRESS. They are both displayed in standard character form so the only difference in the marks is the extra "X" in applicant's mark. It is difficult to discern any difference in pronunciation of the marks as a result of this difference. Also, their meanings would likely be the same because the marks would be viewed as the same combination of the terms FLEX(X) and PRESS. In addition, the extra "X" in applicant's mark would create only a minor difference in appearance and commercial impression. *See, e.g., In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985) ("Moreover, although there are certain differences between the [marks' CAYNA and CANA] appearance, namely, the

inclusion of the letter 'Y' and the design feature in applicant's mark, there are also obvious similarities between them. Considering the similarities between the marks in sound and appearance, and taking into account the normal fallibility of human memory over a period of time (a factor that becomes important if a purchaser encounters one of these products and some weeks, months, or even years later comes across the other), we believe that the marks create substantially similar commercial impressions").

Next, we will consider the relationship between the goods. In this case, registrant's goods are high speed flexographic printing machines with variable repeat lengths for printing photographic quality images on continuous webs used for packaging of consumer goods. Applicant's goods are industrial coatings, paints, primers and inks to be used on plastic substrates in Class 2 and industrial machines for transfer printing; membranes, in the nature of silicones, for industrial machines for transfer printing in Class 7. The examining attorney argues that: "Both applicant and registrant have identified printing machines." Brief at 5. The examining attorney points to numerous Internet printouts that "show that different types of printing machines are offered for sale through the same channels of trade and are produced and sold under the same

mark." Brief at 6. Some of these printouts show that there is a relationship between various types of printing machines such as thermal transfer printing and flexographic printing machines (emphasis added).

Rather than force **flexographic** systems out of the market thermal-**transfer printers** may just end up partnering with them. Use of the two systems may allow companies to get the best of both worlds a low-cost, easy-to-operate flexographic system for producing high-quality standard information.
<http://desktoppubabout.com>

UniTherm is designed for pressure-sensitive thermal **transfer** applications that require fast **flexographic** pre-printing and matrix stripping. UniTherm Basic is designed for pressure sensitive thermal transfer applications that require no conventional pre-printing and is a good choice for high-fidelity bar code printing on blank labels.
PackagePrinting, April 2006

Brady operates state-of-the-art **flexographic** printing equipment for projects requiring four color process or up to six colors. We print on a variety of materials including woven and non-woven backing, Tyvek, films, foams and label stock. In addition, we offer inkjet and thermal **transfer printing** for barcode and variable information.
www.bradydiecut.com

VisionMark uses a wide variety of thermal **transfer printers** with different capacities and functions. In addition, VisionMark is able to [use] thermal **transfer printing** ... in conjunction with hot stamp printing and **flexographic printing** for unique designs and constructions.
www.visionmark.com

"We were focused on labor reduction and adding capacity," says Thoman, "so we started taking a serious look at thermal-**transfer printing**." There was one negative aspect of thermal-transfer printing, says Thoman. The cost of the thermal-transfer ribbon.

However, the benefits of this printing method outweighed the ribbon costs. After weighing **the pros and cons of flexographic and thermal-transfer printing methods**, Thoman chose Greydon's S 107 thermal-transfer printer.
www.healthcare-packaging.com

The evidence also shows that inks are used for transfer and flexographic printing from the same source or sold in the same channels of trade with various printing machines. www.dfm.com ("INTRATHERM® disperse dyes are recommended for inks used in heat transfer printing of polyester and other synthetic fibers and selected nonwoven materials. Gravure, Lithographic and Flexographic Printing: INTRATHERM® disperse dyes are noted for their brightness, fastness properties and compatibility as shading components and are also recommended for inks used in gravure, lithographic and flexographic printing"); www.decortechgroup.com (Screen printing & pad printing inks and various printers); www.inkcups.com (Pad printing ink, screen printing ink, pad printing machines, screen printing supplies and equipment); and www.lawsonsp.com (screen printing equipment and plastisol ink).

More generally, the examining attorney has submitted evidence that shows printing machines of various types originating from the same source or being sold in the same channels of trade. See www.decortechgroup.com (pad

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printing equipment, screen printing solutions, direct to garment digital press, heat transfer presses); www. pannier.com (code printers, dot & stripe printers, flexographic printers, ink jet printers, printers for pipe & extruded products, differential tinplate printers); www. packaging-technology.com ("Our product range includes rotogravure and flexographic printing presses"); www. allproducts.com/machine/gruger ("We also provide relevant technical support to our customers, and solve problems, for instance Pad Printing, Screen Printing, Heat Transfer Printing, Aerial Dye Transfer Printing, Water Covering Transfer Printing..."); www. atlascreensupply.com (cap printers, transfer presses, manual presses, automatic presses, cylinder printers); and www. mascoprint.co.uk ("Manufacturers of screen print presses and ancillary equipment, and suppliers of pad printing machines, inks, consumables... silk screen manufacture and stenciling services").

Applicant argues that there "is no reason to believe that paints, primers and inks with which the instant mark is used, could even be employed for use with the machines with which FLEXPRESS is used." However, the evidence convinces us that prospective customers of applicant's and registrant's printing machines and applicant's inks are

likely to assume that there is some relationship between the goods in this case. We point out that:

In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources.

McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also *In re Opus One Inc.*, 60 USPQ2d 1812, 1814-15 (TTAB 2001).

Here, the evidence shows that flexographic printing machines and transfer printing machines are used together or as substitutes. Various sources sell different printing machines and inks and the same customers could encounter applicant's and registrant's goods identified by the marks at issue here. Therefore, we conclude that these goods are related.

However, applicant has one additional argument that needs to be addressed:

To eliminate cause for doubt, with regard to likelihood of confusion, applicant has suggested to the examiner that the goods['] descriptions in classes 002 and 007 be limited by adding the expression "not for uses related to packaging of consumer goods." Since the goods['] description for FLEXPRESS is specifically limited to packaging of consumer goods, the respective goods would clearly travel in different channels of trade and be seen by different classes of

customers. The same consumers would not encounter the two marks and there could be no mistaken belief that the goods originate from the same source.

Brief at 5. See also Request for Reconsideration at 3-4.

The examining attorney rejected the proposed amendment and argues that:

The limitation of a particular application of the goods will not eliminate the confusion as to whether the goods originate from a common source because, as indicated above and demonstrated in the previously attached evidence, different types of printing machines and printing coatings, paints, primers and inks are sold under the same mark as well as through the same channels of trade.

Furthermore, the evidence of record illustrates that plastic substrates, such as those with which applicant's coatings, paints, primers and inks are used, may, in fact, be used in flexographic printing. Thus, applicant's coatings, paints, primers and inks necessarily include those that are used with flexographic printing machines such as registrant's.

Brief at 6-7.

We agree with the examining attorney that the addition of this limitation would not result in the goods being unrelated. The evidence shows that these goods, even with applicant's proposed limitation, are sold in broad channels of trade where the goods of applicant and registrant would be sold together. Furthermore, prospective purchasers would include printing operations that would offer multiple printing services. These purchasers would need a variety of printing machines to offer services that would include

printing of packaging for consumer goods as well as other types of printing for packaging.

We note that these goods may be expensive and that the purchasers may be professionals. However, even professionals are likely to be confused when they encounter the marks FLEXXPRESS and FLEXPRESS on printing machines and inks. *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999) ("We recognize applicant's attorney's point that its software is expensive and that purchasers of it are likely to be sophisticated. Suffice it to say that no evidence in support of these assertions was submitted. In any event, even careful purchasers are not immune from source confusion"). *See also 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").

When we balance the *du Pont* factors in this case, we conclude that confusion is likely. The marks are virtually identical except for applicant's additional "X," which does not significantly change the appearance, pronunciation, meaning, or commercial impression of the marks.

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Furthermore, the goods, even if we consider the proposed amendment, are related to the extent that purchasers overlap and they are likely to assume that the sources of the goods are related. We add that to the extent that we have any doubt about the likelihood of confusion, we must resolve it in favor of registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Decision: The examining attorney's refusal under Section 2(d) of the Trademark Act to register applicant's mark FLEXXPRESS for the identified goods on the ground that it is likely to cause confusion with the mark FLEXPRESS for the goods indicated in the cited registration is affirmed.