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Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Louis E. Bondurant Revocable Trust
v.
Varn International, Inc.

Opposition No. 91118737
to application Serial No. 75537739
filed on August 17, 1998

Theodore A. Breiner of Breiner & Breiner, L.L.C. for The
Louis E. Bondurant Revocable Trust.

Kimberly Gambrel of Killworth, Gottman, Hagar & Schaeff,
L.L.P. for Varn International, Inc.

Before Hohein, Bottorff and Rogers, Administrative Trademark
Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark WEB-PRO (in typed form) for "lithographic
printing chemical solutions" in Class 1.¹

¹ Serial No. 75537739, filed August 17, 1998. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), and June 1997 is alleged in the application as the date of first use of the mark anywhere and the date of first use of the mark in commerce.

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Opposer filed a timely notice of opposition to registration of applicant's mark, alleging as its ground for opposition that opposer is the owner of various registered marks which incorporate the word PRO for goods and services similar and related to those of applicant's, and that applicant's mark, as applied to applicant's goods, so resembles opposer's marks as to be likely to cause confusion. See Trademark Act Section 2(d), 15 U.S.C. §1052(d).² Applicant filed an answer by which it denied the salient allegations of the notice of opposition which remain pertinent in this case,³ except that, as discussed *infra*, applicant admitted that "Applicant has used 'web' as part of the phrase 'web offset' to describe a type of lithographic printing." (Answer, ¶ 21.)

The evidence of record consists of the pleadings, the file of the opposed application, and status and title copies of opposer's twelve pleaded registrations, submitted by

² In the notice of opposition, opposer also alleged as grounds for opposition, in addition to the Section 2(d) ground, that applicant committed fraud during the examination process, that applicant's mark is merely descriptive, and that applicant committed fraud in executing its application declaration. By order dated March 31, 2001, the Board granted summary judgment to applicant dismissing the examination fraud and mere descriptiveness claims. Opposer has failed to present any evidence or argument with respect to the declaration fraud claim, and we therefore dismiss that claim as well. Thus, the only ground of opposition remaining for consideration is the Section 2(d) ground.

³ See *supra* at footnote 2.

opposer via notice of reliance.⁴ We also take judicial notice of the dictionary definitions of the words "lithography" and "planography" submitted by opposer with its brief.⁵ However, we have given no consideration to the items of correspondence and other documentary materials attached as Appendices 16 and 17 to opposer's brief, nor have we considered any of opposer's arguments which are based on those materials (including opposer's contentions regarding the purported "admissions" made by applicant in this correspondence). Those documents were not made of

⁴ Review of the Office's automated database reveals that, subsequent to opposer's submission of status and title copies of its twelve pleaded registrations, two of those registrations were cancelled. (The Board will take judicial notice of, and rely on, the current status of a registration owned and made of record by a party to an inter partes proceeding, if the status of the registration has changed between the time it was made of record and the time the case is decided. See TBMP §704.03(b)(1)(A) (2d ed. 1st rev. March 2004).) Specifically, Registration No. 1770943, of the mark PRO 3, was cancelled under Section 8 (10 yr.) and held expired under Section 9 on February 21, 2004. Registration No. 2030433, of the mark PRO CHEM, was cancelled under Section 8 (6 yr.) on October 18, 2003. In view thereof, opposer's status and title copies of these registrations are evidence only that the registrations issued; they are not evidence of any presently existing rights in the marks shown in the registrations. See *Time Warner Entertainment Company v. Jones*, 65 USPQ2d 1650, 1653 n.6 (TTAB 2002); see generally TBMP §704.03(b)(1)(A) (2d ed. 1st rev. March 2004). We therefore will give such registrations no further consideration.

⁵ The Board may take judicial notice of dictionary definitions. See, e.g., *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); see also TBMP §704.12(a) (2d ed. 1st rev. March 2004).

record during trial and they therefore are not evidence in this case.⁶

Opposer filed a brief on the case, but applicant did not. No oral hearing was requested. We sustain the opposition.

To the extent that opposer has proven that it is the owner of its pleaded registrations and that such registrations are subsisting, and because opposer's likelihood of confusion claim is not wholly without merit, we find that opposer has established its standing to oppose registration of applicant's mark. See *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Moreover, as to those of its pleaded registrations which the record shows are subsisting and owned by opposer, Section 2(d) priority is not at issue with respect to the goods and services identified in those registrations. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

For the reasons discussed below, we find that a likelihood of confusion exists between applicant's mark, as

⁶ Those documents, among others, were attached as exhibits to opposer's notice of opposition, but they were not made of record at trial and they therefore are not evidence in this case. See Trademark Rule 2.122(c), 37 C.F.R. §2.122(c); TBMP §704.05(a). Likewise, they are not of record by virtue of their attachment as exhibits to opposer's brief. See TBMP §704.05(b).

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applied to applicant's goods, and two of opposer's previously-registered marks, i.e., Registration No. 1657921,⁷ which is of the mark PRO (in typed form) for "planographic printing solutions," and Registration No. 1943816,⁸ which is of the PRO PRODUCTS design mark depicted below



(PRODUCTS disclaimed), for "chemical solutions used in the printing industry" in Class 1.⁹

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion

⁷ Issued September 24, 1991; affidavits under Sections 8 and 15 accepted and acknowledged; renewed for a term of ten years from September 24, 2001.

⁸ Issued December 26, 1995; affidavits under Sections 8 and 15 accepted and acknowledged. The Office's assignment records show an assignment of this registration to opposer, recorded on May 27, 1997 at Reel 1591, Frame 0568.

⁹ Because we find that these two registrations suffice to bar registration of applicant's mark under Section 2(d), we need not and do not decide whether a likelihood of confusion exists with respect to opposer's other eight subsisting registrations of record.

factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we 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 and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

First, we find that applicant's "lithographic printing chemical solutions" are encompassed by and are legally identical to the "planographic printing solutions"¹⁰ and the "chemical solutions used in the printing industry" identified in opposer's respective registrations. Given the legal identity of the parties' goods, we also find that the goods would be marketed in the same trade channels and to the same classes of purchasers. Thus, the second and third *du Pont* factors weigh in favor of a finding of likelihood of confusion.

We also find that applicant's mark WEB-PRO is similar to opposer's registered mark PRO. Indeed, in terms of appearance, sound, connotation and overall commercial

¹⁰ The dictionary evidence submitted by opposer, of which we have taken judicial notice, shows that "planographic" is the adjectival form of "planography," which is defined as "a process (as lithography) for printing from a plane surface." Merriam-Webster's Collegiate Dictionary (10th ed. 1993).

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impression, WEB-PRO and PRO are identical but for applicant's addition of the word WEB and a hyphen. Applicant has admitted that "web offset" is a type of lithographic printing. (Answer, ¶ 21.) In view thereof, we find that the term WEB has very little source-indicating significance as applied to applicant's goods, which must be presumed to be used in connection with web offset lithographic printing. Although we do not ignore this component of applicant's mark, we find that it contributes relatively less to the mark's overall commercial impression than does the PRO component of the mark, and that its presence in the mark does not suffice to distinguish applicant's mark from opposer's mark, for purposes of the first *du Pont* factor. When these marks are used on the identical goods involved herein, purchasers are likely to mistakenly assume that a source connection exists, i.e., that the source of PRO planographic printing solutions also is the source or sponsor of WEB-PRO lithographic printing chemical solutions for use in web offset printing.

We likewise find that applicant's mark WEB-PRO is similar to opposer's registered PRO PRODUCTS design mark. Although opposer's mark has a design element which cannot be ignored, we find that the design element is more likely to be viewed by purchasers as mere background ornamentation for the wording in the mark, PRO PRODUCTS. It is that wording

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which has the greater source-indicating significance in the mark, and which will be used by purchasers in calling for the goods. See *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553 (TTAB 1987). Moreover, it is the word PRO in opposer's mark, depicted as it is in bold, stylized lettering, that dominates the commercial impression of opposer's mark. The generic and disclaimed word PRODUCTS contributes relatively little to the mark's commercial impression.

Thus, the dominant feature in both applicant's mark (see discussion *supra*) and opposer's mark is the word PRO. Although we do not disregard the other elements of the respective marks which render the marks non-identical, we find that they do not suffice to distinguish the marks in terms of overall commercial impression. The respective marks are sufficiently similar that confusion is likely to result from use of the marks on the identical goods involved herein. Purchasers are likely to assume that WEB-PRO chemical solutions are part of the PRO PRODUCTS line of chemical solutions.

Thus, we find that applicant's mark is similar to each of opposer's registered marks, and that the first *du Pont* factor accordingly weighs in opposer's favor.

There is no evidence of any third-party use of trademarks incorporating the word PRO in connection with the

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types of goods at issue here. The absence of any such evidence of third-party use of similar marks on similar goods weighs in favor of a finding of likelihood of confusion, under the sixth *du Pont* factor.

Having considered all of the evidence of record as it pertains to the *du Pont* likelihood of confusion evidentiary factors,¹¹ and for the reasons discussed above, we find that a likelihood of confusion exists between applicant's mark, as applied to applicant's identified goods, and opposer's previously-registered marks PRO (Registration No. 1657921) and PRO PRODUCTS and design (Registration No. 1943816) as applied to the goods identified in the respective registrations.

In summary, we find that opposer has established both its standing to oppose and its Section 2(d) ground of opposition.

¹¹ Opposer argues, under the fifth *du Pont* factor, that its marks are famous. It also argues, under the ninth *du Pont* factor, that it has a "family" of marks. Neither of these contentions is supported by the evidence of record, which consists solely of the status and title copies of opposer's registrations. First, the allegations in these registrations of dates of first use are not evidence on opposer's behalf. See Trademark Rule 2.122(b)(2), 37 C.F.R. §2.122(b)(2); TBMP §704.04(2d ed. 1st rev. March 2004). Thus, and contrary to opposer's contention, those allegations do not establish long-time use of the marks, which opposer asserts as a basis of its claim of fame. Second, mere ownership of multiple registrations with a common word does not create a family of marks. See, e.g., *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Consolidated Foods Corporation v. Sherwood Medical Industries Inc.*, 177 USPQ 279 (TTAB 1973). In short, these *du Pont* factors play no role in our decision in this case, due to absence of evidence.

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Decision: The opposition is sustained.