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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Cognis Corporation
v.
HANA Company Limited

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Opposition No. 91163340
to application Serial No. 76558733
filed on November 13, 2003

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Jordan LaVine of Flaster/Greenberg, P.C. for Cognis Corporation.

Andrew D. Price of Venable, LLP for HANA Company Limited.

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Before Bucher, Grendel and Holtzman, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

HANA Company Limited (applicant herein) seeks registration on the Principal Register of the mark depicted below

PRO-ECO

for goods identified in the application as follows:

Photocopier toner contained in bottles and cartridges, photocopying toner in cartridges for printers, computer printers, photocopying apparatus and facsimile machines; toner for offset printing; toner ink for copying apparatus and machines; cartridges filled with toner and ink; cartridges filled with toner and ink for computer printers, dot matrix printers, laser printers, photocopying machines, electrostatic photocopiers, photographic photocopiers, thermal photocopiers, electronically operated printing apparatus and facsimile machines; toner and ink for photocopiers, printers, off-set printing machines and facsimile machines; laser toner cartridges filled with toner for computer printers; filled laser toner cartridges; printing ink; printers' ink; engraving ink; printer's ink and toner for printing on paper, transparencies and textiles; filled ink cartridges; ink jet refills; pigments; color pigments; carbon black pigments; titanium dioxide used as a color pigment; colorants for use in the manufacture of printing ink; dyes for use in the manufacture of engraving ink; and fixatives for water colors,

in International Class 2; and

computer peripherals; printers for use with computers and data processing apparatus; computer printers; ink jet printers for use with computers; ink jet printers for use with data processing apparatus; printers incorporating lasers; computer mice; computer mouse pads; computer keyboards; computer monitors; computer screen filters for monitors; printed circuits; integrated circuits; computer storage media, namely, computer hard discs, CD-ROM's, DVD-Rs and floppy discs; blank data storage discs; magnetic data carriers; blank magnetic discs and tapes; blank recording discs; blank floppy discs; blank disc files; blank disc memories; blank discs for recording and storing data; blank computer discs; read only memory compact discs; recordable blank compact discs; writable blank compact discs; blank optical discs; blank digital video discs; recordable blank digital video discs; writable blank digital video discs; blank video compact discs; computer cartridges adapted for use with data carriers;

> integrated circuit chips used in computer printers, toner cartridges and ink jet cartridges; computer cartridge holders; computer cleaning tissues; computer cleaners; empty toner cartridges; empty toner cartridges for use with computers, computer printers, photocopiers, electrostatic photocopiers, photographic photocopiers, thermic photocopiers, printers, electronically operated printing machines, dot matrix printers and laser printers; empty toner cartridges for use with office machines and printing machines,

in International Class 9.[1]

Cognis Corporation (opposer herein) has opposed registration of applicant's mark as to both classes of goods. Opposer has asserted a Section 2(d) ground of opposition, alleging in its notice of opposition that applicant's use of its mark is likely to cause confusion vis-à-vis opposer's previously-used and registered mark PROECO for various synthetic lubricants in Class 4. See *infra*.

Applicant answered the notice of opposition by denying the salient allegations thereof.

Opposer presented evidence at trial; applicant did not. Opposer filed a brief on the case;[2] applicant did not.

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[1] Serial No. 76558733, filed November 13, 2003. The application is based on applicant's allegation of a bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

[2] Opposer's March 6, 2006 motion to extend time to file its brief is granted as uncontested. *See* Trademark Rule 2.127(a).

The evidence of record consists of: the file of the opposed application; the pleadings herein; the testimony deposition of opposer's witness Chris Toomey (and exhibits thereto); opposer's notice of reliance on printouts of seven third-party registrations; and opposer's notice of reliance on status and title copies of four registrations it owns.[3] These four registrations of opposer's are summarized as follows:

Registration No. 2082237, of the mark PROECO (in standard character form), for "all purpose synthetic lubricants, namely, lubricants for use in industry, manufacturing, construction, mining, forestry and marine applications; synthetic lubricants for vehicles, engines, transmissions, power tools and industrial machinery; and synthetic lubricants for use in refrigeration and air conditioning compressors," in Class 4;[4]

Registration No. 2265245, of the mark depicted below

[3] Of these four registrations, only the first (Reg. No. 2082237) was pleaded by opposer in the notice of opposition. However, the other three were made of record by opposer via notice of reliance without objection from applicant. In view of applicant's lack of objection, we deem the pleadings to be amended to include opposer's allegations of ownership of these other three registrations. *See* Fed. R. Civ. P. 15(b).

[4] Issued July 22, 1997; affidavits under Sections 8 and 15 accepted and acknowledged.

(SYNTHETIC LUBRICANTS disclaimed), for "all purpose synthetic lubricants, namely, lubricants for use in industry, manufacturing, construction, mining, forestry and marine applications; synthetic engine lubricants for use in industry, synthetic lubricants for power tools and industrial machinery; and synthetic lubricants for use in refrigeration and air conditioning compressors," in Class 4;[5]

Registration No. 642185, of the mark VERSAMID (in standard character form), for "polyamide resins" in Class 6;[6] and

Registration No. 1175663, of the mark PHOTOMER (in standard character form), for "radiation curable chemicals," in Class 1.[7]

The evidence of record, particularly the testimony deposition of Mr. Toomey (opposer's "Vice President, Regional Business Director, NAFTA, Synlubes Technology,

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[5] Issued July 27, 1999; affidavits under Sections 8 and 15 accepted and acknowledged.

[6] Issued March 5, 1957; affidavits under Sections 8 and 15 accepted and acknowledged; renewed.

[7] Issued November 3, 1981; affidavits under Sections 8 and 15 accepted and acknowledged; renewed.

Cognis Corporation"; Toomey Depo. at 4) reveals the following relevant information about opposer, its marks, and its goods.

Opposer is a "specialty chemical company" which bases its technology and commercial activities on a core of two basic "megatrends," i.e., "wellness" and "sustainability." (Toomey Depo. at 5-6.) The "sustainability" concept "mean[s] that the products and markets that we serve, we serve both with an eye towards using renewable raw materials, enhancing the life of processes or applications for our chemicals, decreasing the amount of waste." (Id. at 10-11.)

Opposer's company is organized into five strategic business units, i.e., aleochemicals, nutrition and health, care chemicals, functional products, and process chemicals. (Id. at 6.) The "functional products" business unit itself is composed of four subsidiary business units, i.e., mining chemicals; polymers, coatings, and inks (also referred to as PCI); agro solutions; and synthetic lubricants (also referred to as "Synlubes"). (Id. at 11.) The functional products business unit "is defined around the concept of sustainability." (Id. at 10.) Of particular relevance in the present case are two of these subsidiary business units or divisions within opposer's functional products business unit, i.e., the Synlubes division, and the polymers,

coatings and inks (PCI) division. We shall discuss each of these divisions in turn.

As is reflected in the identifications of goods in opposer's PROECO and ProEco registrations (see *supra*), the Synlubes division "is focused on the development of synthetic lubricants used in transportation, industrial, refrigeration applications predominantly, as well as the use of some base component chemicals that ... are sold to other companies for their use in lubricant applications." (Id. at 12.)

> [T]he core nature of the business that we're in, is to take synthetic lubricant products or technologies for which we are basic in both technology and in raw material, and extend those into different applications in the lubricant marketplace. If you look at the segmentation of those marketplaces, there are really four key segment areas that we focus on. One is transportation lubricants, predominantly we focus on things like axle and transmission lubricants for heavy duty trucks, where the performance of a synthetic lubricant is required because of the extreme nature of the operating conditions, whether it's high heat, low temperature, or long haul, or really carrying heavy loads. Synthetic lubricants have been proven to perform better. That kind of performance extends itself also to industrial application. Things like compressors, hydraulics, high temperature chains that are used for food manufacturing or in forestry. Offshore applications where, you know, service is very difficult and costly. They're looking for a product that will extend the life and performance of the gears and the hydraulics and things like that that are driving their systems. Refrigeration really falls within that industrial segment, but we treat it as a separate one because it is a very, very unique set of requirements that the refrigeration compressor and makers have. ...

> And then finally we're in additives, which are primarily used as lubricity agents for diesel fuel.

(Id. at 18-19.)

Opposer markets its Synlubes products through three main trade channels, i.e., direct sales, as the synthetic lubricant arms of many major oil companies (such that, for example, Shell's synthetic lubricant product may be manufactured by opposer), and through a national distributor. (Id. at 28.)

> Typically what we'll do is work with a component, a machine component manufacturer, someone who's making compressors, making hydraulics, to prove that – to prove our fluid in their components. Then we use those approvals to drive the fluids through either direct sales at the component manufacturer's so when they make their components they're putting our fluids in, through major oil markets like, you know, Shells and Chevrons and Conocos and Castrols, or through our distributor into the after market or the service market where there are more local entities who are providing essentially oil change services.

(Id. at 40-41.) Opposer participates in industry trade shows, including "segment-specific" conferences such as forestry, mining, heavy duty trucks and off-road vehicles, and at broader industry shows for broader categories of applications, like the National Fluid Power Association, or the National Lubes and Greases Institute. (Id. at 36-37.)

Opposer's Synlubes products are marketed under four trademarks or brand names, i.e., PROECO,[8] EMGARD, BREOX, and SYNATIVE, as well as under the house mark COGNIS. (Id. at 22-23.) Mr. Toomey estimated that in 2004 opposer spent $100,000 in advertising and promoting its ProEco products "in North America" (id. at 29), and that opposer's 2004 sales of ProEco products "in North America" were between $10 million and $15 million (id. at 31).

Opposer's ProEco mark was first used commercially in 1996. (Id. at 29.) It initially was used on refrigeration lubricants, and those lubricants continue to be the primary products upon which the mark is used. (Id. at 25-26.) Use of the mark has since expanded into lubricants used in connection with offshore hydraulics, industrial compressor applications, and forestry applications, and conceivably could expand into further types of lubricant applications. "It's really been something where the applications have grown and extended over time, but always focusing on the concept of being ecologically compatible, biodegradable, you know, environmentally friendly type fluids." (Id. at 21-22). Opposer does not currently market any of its Synlubes

[8] As noted above, opposer owns registrations of the marks PROECO (in standard character form) and ProEco Synthetic Lubricants (and design; "Synthetic Lubricants" disclaimed). The record shows that in opposer's literature, it consistently refers to its mark as ProEco. See, e.g., Toomey Depo. Exhibits 2, 6, 10 and 11. Likewise, throughout the testimony deposition of Mr. Toomey, the

products at the retail level, although it is "looking at" expansion of its ProEco brand into the retailing of "environmentally acceptable applications in the drive line transportation area." (Id. at 41.)

The ProEco mark was adopted to reflect opposer's "environmentally friendly" focus: "The ProEco brand of products – first of all, the ProEco name itself is, was defined as nothing more than being for ecologic, you know, for the ecology. You know, or for the environment. That's really what that name means. So it's nice and simple and very effective in relating what it does." (Id. at 24.) Further with respect to the intended meaning and significance of the ProEco mark, we note that opposer's 2004 Annual Report (Exh. 2 to Toomey Depo., at COG 00064) includes the following text: "Cognis has developed particularly high-performance polyolester and polyalkylene glycol lubricants for compressors used in refrigerators and all types of air conditioning units. This product range, marketed under the self-explanatory label 'ProEco™', also offers additional benefits including longer equipment lifetimes and reduced energy consumption."

Opposer regards its ProEco mark as a mark which suggests and embodies its company-wide focus on "sustainability." Those of opposer's products which are not

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mark is referred to as ProEco. Accordingly, in this decision we

deemed by opposer to fall within the "environmentally friendly" category are not marketed under the ProEco mark. (Id. at 24-25.) The mark has never been used on any products outside opposer's Synlubes division, but Mr. Toomey testified that it was "possible" that the mark's use could be expanded in the future to products in opposer's other "functional products" divisions, including products in the polymer, coatings and inks (PCI) division. (Id. at 33-34, 49.)

We turn now to opposer's PCI division. Of particular relevance herein is the PCI division's "inks" subsegment, which opposer identifies as its "graphic arts solutions" business. (Id. at 45.) Opposer markets its "graphic arts solutions" products under the registered marks VERSAMID and PHOTOMER. (Id. at 45-49; Exhibit Nos. 12-14.) These "inks" products include

> ... laminates and resins that are used to cover magazines, for example. So if you get a glossy cover on a magazine, depending on which magazine you bought, that would be our product there that's used to prevent the inks, which are relatively inexpensive, cheap sort of inks, from fading too quickly if they're out on the newsstand. They enhance the actual inks themselves, to keep them from smearing or to keep them from having some sort of negative reaction with the type of paper that it's on, or to make the ink more – the color stand out better, or resist the sunlight better. ... And [opposer's products are used] very much as component chemicals to enhance the capabilities of final inks. Printed inks, especially.

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will refer to opposer's mark primarily as ProEco.

(Toomey Depo. at 44-45.) In "layman's terms," the goods identified in opposer's PHOTOMER and VERSAMID registrations (see *supra*) are described by Mr. Toomey as follows. The "polyamide resins" identified in the VERSAMID registration "are used, in my understanding, predominantly as coatings for things like gloss on magazine covers." The "radiation curable chemicals" identified in the PHOTOMER registration "are component chemicals that are added into inks, and to a certain amount of resins as well, that are used as glossy covers, to protect the ink in the print from fade or any kind of other breakdown as a result of ultraviolet light or other types of light applications." (Id. at 56.)

Opposer's "graphic arts solutions" products are

> typically going to be sold to companies involved in the packaging and/or printing industry, so those companies would - they'll either be suppliers to that industry. Meaning that they'll take our components, mix them with their chemicals to make a finished product that they can sell for use, for example, in printing for newspapers or, you know, magazines or that kind of thing. ... But specific to inks, we either sell to companies who then further develop the final ink, or we sell directly to printers.

(Id. at 48-49.)

Opposer has "maintained a presence at trade shows relevant to the inks industry." (Id. at 54.) Exhibit 16 to the Toomey deposition is what appears to be the conference

brochure or program from the "Information Management Institute Ink Jet Printing Conference" of 2003. Mr. Toomey testified that opposer was both a sponsor and an exhibitor at this conference, and was listed in the program as a "featured supplier," as were companies like Hewlett-Packard and Philips. (Toomey Depo. at 54-55.) Mr. Toomey testified that "I think the key point there is that we position ourselves in with those type of companies. I mean, that's the kind of presence that we want to maintain in this industry. So it's a fairly high profile presence." (Id. at 55.) It is not apparent from Exhibit 16 or elsewhere in the record whether or how opposer used or displayed its various marks at this conference; we will assume that opposer used and displayed its inks products marks VERSAMID and PHOTOMER, if any. We note that the listing for opposer (under the name COGNIS) in the program's descriptions of featured suppliers reads as follows: "Cognis is a worldwide leader in specialty chemicals serving numerous major industries. Cognis develops and manufactures raw materials for printing inks and coatings – all backed up by comprehensive processing know-how. Across the entire product portfolio, we draw on decades of experience in developing solutions for surfaces and interfaces."

As noted above, opposer markets its "graphic arts solutions" products under the marks PHOTOMER and VERSAMID.

Opposer does not use its ProEco mark on these products. Mr. Toomey testified, however, that

> I think could see it [the ProEco mark] extending potentially into the inks business. Our business in – now this, we're talking about a different business segment here. That's the polymer, coatings, and inks business segment. The portion of that business where there are certainly going to be some potential applications for these products would be in – we make a number of component chemicals that serve to enhance the capabilities of different types of inks that are used for, say, magazine print, newspaper print, things like that. And to the extent that the ProEco name or an environmentally sensitive name may have some marketing application, yes, it's quite possible that it could. Or it's quite possible we would want to do that.

(Id. at 33.) Later on, when he was asked, "And Mr. Toomey, because both the coatings and inks products, as well as the Synlubes, are all at least in part directed towards this general company goal of sustainability, is it foreseeable that the products in this coatings and inks category could be branded at some point under the ProEco mark, given the meaning and significance of that mark?", Mr. Toomey answered, "It's possible." (Id. at 49.)

When he was asked how the various products in opposer's "functional products" business unit are related, Mr. Toomey testified as follows:

> Okay. Well again, it all sort of stems, comes back to the way that we've organized the company around these two megatrends of wellness and sustainability. The functional products markets,

> or the markets that are served by functional products applications, are markets where typically our products are being used to enhance the performance of some other application. ... That kind of philosophy is true throughout all of the functional products segments where we're looking at reducing waste, reducing environmental impact, using renewable raw materials wherever possible, and extending the life, the service life, of the products that our chemicals support. So if you look, for example, at the polymers, coatings, and inks business, and the Synlubes business and say where is the overlap between them, it is in the use of common base chemicals that come out of our oleochemicals divisions. There's common – in some cases common manufacturing processes that we use internally. And then there's the common theme – and in some case there's some overlap in technology, although that tends to be less so in those two particular divisions – in how the products themselves are derived.

(Id. at 12-14.) When he was asked in particular about the relationship between opposer's Synlube products and its graphic arts solutions products, Mr. Toomey testified as follows:

> Well, it's on a couple of different levels. First, we draw on the same core of materials, so they're different applications but the core materials that are used for both of these segments are fairly common. Second, the products that are used in the polymers, coatings, and inks, if you were to take away all of the technical names and just talk about what these products do, if you were to take away the technical names and you were to take away any reference to a specific market segment, you would find that the performance-enhancing characteristics associated with these, if you just have sort of a generic, layman's description of what those products serve, how they serve, to interact as components, it is boy, nigh on similar to what the synthetic lubricant products do. Talk about enhancing life, enhancing product capability, environmental sensitivity, you

> know, reduction of waste, efficiency. I mean, these are all things that are common across these products. And that's what wraps them and makes them all part of this functional products business unit to start with.

(Id. at 47-48.)

Keeping this evidence in mind, we turn now to the substantive issues in this case, i.e., to the issues of opposer's standing, opposer's Section 2(d) priority, and likelihood of confusion.

Because opposer has properly made its pleaded registrations of record, and because opposer has established that its 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 Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *see also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000);

Moreover, because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and goods covered by said registrations. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In any event, opposer has proven use of its ProEco mark on synthetic lubricants since prior to applicant's November 13, 2003 application filing date, which is the earliest date

upon which applicant may rely for priority purposes in this case.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). *See In re E. I. du Pont de Nemours & 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.,* 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Under the first *du Pont* factor (similarity or dissimilarity of the marks), we find that applicant's mark is similar to opposer's registered PROECO and ProEco and design marks in terms of appearance, sound, connotation and overall commercial impression.[9] The differences between the parties' marks are outweighed by the basic similarity

[9] We also find that applicant's mark is completely dissimilar, in terms of appearance, sound, connotation and overall commercial impression, to opposer's registered and pleaded VERSAMID and PHOTOMER marks. To the extent (if any) that opposer is basing its Section 2(d) claim on its ownership of these marks, we find that the dissimilarity between these marks and applicant's mark is so pronounced that the first *du Pont* factor outweighs all of the other factors and precludes any finding of likelihood of confusion with respect thereto. *See Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

arising from the presence in each of the marks of the designation PRO-ECO or a variation thereof.

However, we also find that opposer's ProEco mark is not a particularly strong mark as applied to opposer's goods, but rather that it is at best suggestive of the avowedly "environmentally friendly" nature of the goods. As noted above, Mr. Toomey testified that the mark "... is, was defined as nothing more than being for ecologic, you know, for the ecology. You know, or for the environment. That's really what that name means. So it's nice and simple and very effective in relating what it does." (Toomey Depo. at 24.) Likewise, in its 2004 Annual Report (Exh. 2 to Toomey Depo., at COG 00064), opposer refers to its ProEco mark as being "self-explanatory." We further note that at page 5 of its brief, opposer states that "Opposer's 'PROECO' mark was selected to suggest the environmentally positive nature of Opposer's products offered under the 'PROECO' mark." Thus, while we deem applicant's mark to have the same connotation as opposer's mark, and we find that the marks are similar in that respect, we find that the mark itself is not a particularly strong mark which would be entitled to the same scope of protection that a more arbitrary and less suggestive mark would receive.

On balance, we find that the first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

We turn next to a determination, under the second *du Pont* factor, of the similarity or dissimilarity of the parties' goods. It is settled that it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. It is sufficient that the goods be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

We find, first, that the synthetic lubricant products identified in opposer's pleaded PROECO and ProEco registrations, and as to which opposer has proven prior use of its ProEco mark, are completely dissimilar and unrelated to the Class 9 computer-related goods identified in

applicant's application. There is no basis in the record for finding otherwise, and we note that opposer in its brief does not contend otherwise. Moreover, we find that this fundamental dissimilarity between these goods (as well as the obvious dissimilarity in the respective trade channels and customers for such goods) outweighs the evidence pertaining to all of the other *du Pont* factors (including the similarity of the marks), and that it precludes any overall finding of likelihood of confusion with respect to these goods. *See, e.g., Pure Gold, Inc. v. Syntex (U.S.A.) Inc.,* 221 USPQ 151 (TTAB 1983), *aff'd* 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). This is especially so given the suggestive nature of the ProEco mark. The opposition therefore must be dismissed as to applicant's Class 9 goods.

We consider next the similarity or dissimilarity between opposer's ProEco synthetic lubricant products and applicant's Class 2 toners and inks products. We note, initially, that throughout its brief opposer specifically mentions and presents argument with respect to only those of applicant's Class 2 goods identified as: printing ink; printers' ink; pigments; color pigments; carbon black pigments; titanium dioxide used as a color pigment; colorants for use in the manufacture of printing ink; dyes for use in the manufacture of engraving ink; and fixatives for water colors. Opposer does not present any evidence or

argument in support of a claim that the remainder of the Class 2 goods identified in the application are similar or related to opposer's goods. We find that these other Class 2 goods identified in the application, which comprise finished toner and ink products obviously intended for home and office use by businesses and general consumers, are not similar or related to opposer's synthetic lubricant products. Again, this fundamental dissimilarity of the parties' respective goods (and the trade channels and customers therefor) outweighs the other *du Pont* factors (including the similarity of the marks), and precludes a finding of likelihood of confusion as to such goods. *Pure Gold, supra.*

We turn now to what appears to be the essence of opposer's argument with respect to the issue of the similarity or dissimilarity of the parties' goods, i.e., that opposer's synthetic lubricant products marketed under opposer's ProEco mark are similar and related to applicant's Class 2 goods identified as printing ink; printers' ink; pigments; color pigments; carbon black pigments; titanium dioxide used as a color pigment; colorants for use in the manufacture of printing ink; dyes for use in the manufacture of engraving ink; and fixatives for water colors. We shall refer to these products as applicant's inks products.

We find, first, that opposer's synthetic lubricant products and applicant's inks products, per se, are dissimilar and unrelated in terms of their nature, function, purpose, and application. As discussed *infra*, they are used in different industries, by different customers, for different applications. To the extent that opposer is arguing to the contrary, such arguments are unpersuasive.[10]

However, opposer argues that its synthetic lubricant products and applicant's inks products, even if not similar on their face, are nonetheless sufficiently related that the parties' use of their respective marks thereon is likely to cause confusion as to the source of the respective products.

In support of this argument, opposer relies, first, on its evidence of seven third-party registrations which assertedly include in their respective identifications of goods both opposer's type of products and applicant's type of products. It is settled that although such third-party registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the goods listed therein are of a kind

[10] See, e.g., opposer's argument at page 13 of its brief: "While the synthetic lubricants offered under Opposer's 'PROECO' mark are not identical to the products identified in Applicant's application, it is clear from the Opposer's testimony submitted herein that there is very little distinction between Opposer's synthetic lubricants and Applicant's products..."

which may emanate from a single source under a single mark. *See In re Albert Trostel & Sons Co.,* 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

However, upon review of these third-party registrations, we find that they provide meager support for opposer's position. Two of the registrations (Reg. Nos. 2909455 and 2939027) are not based on use but rather are Section 44(e) registrations which have no probative value under *Trostel and Mucky Duck. See Trostel, supra*, 29 USPQ2d at 1786. Another of the registrations (Reg. No. 2835042) has an identification of goods which lists a very large number and variety of goods in five International Classes. The very breadth of this identification of goods substantially reduces or negates the registration's probative value under *Trostel* and *Mucky Duck*. *See Mucky Duck, supra*, 6 USPQ2d at 1470 n.6; *In re Wilson,* 57 USPQ2d 1863, 1867 n.7 (TTAB 2001); and *In re Donnay International S.A.,* 31 USPQ2d 1953, 1954 n.3 (TTAB 1994). A fourth registration (Reg. No. 2518946) again lists goods in five International Classes, including Class 2 "ink auxilaries in the nature of binders for use with colorants in the manufacture of printed inks," which may or may not be related to applicant's inks products (the record is unclear), as well as Class 4 "textile lubricants," which may

or may not be related to opposer's industrial synthetic lubricants. The record's lack of clarity as to the nature of these goods limits the probative value of this registration. A fifth registration (Reg. No. 2723090) lists Class 2 "coatings, namely, lacquers, printed ink, topcoats and slip coats," along with Class 4 "lubricants, namely cutting fluids for industrial metal working." The sixth and seventh registrations (Reg. Nos. 1141941 and 1071218), which are owned by the same entity, list both Class 2 "layout ink" and Class 4 "penetrating oil and lubricants for machinery and other non-machinery applications." We will assume that these last three registrations have some probative value in this case.

Thus, we find that several of opposer's third-party registrations are of little or no probative value, and that the remaining registrations amount to merely de minimis evidence that applicant's and opposer's goods (which do not appear to be necessarily the same as the goods identified in the third-party registrations) are related.

Opposer's primary argument in support of its contention that applicant's inks products and opposer's synthetic lubricant products are related, for purposes of the second *du Pont* factor, is as follows. In essence, opposer contends that opposer itself manufactures and markets inks products (under its VERSAMID and PHOTOMER marks) which are similar to

applicant's inks products; that opposer's inks products business is related to opposer's synthetic lubricant products business in several respects; and that because opposer's inks products are related to opposer's synthetic lubricant products, and because opposer's inks products are similar to or the same as applicant's inks products, it follows that applicant's inks products, like opposer's inks products, are related to opposer's synthetic lubricant products. We shall address each prong of this argument in turn.

First, opposer argues that its VERSAMID and PHOTOMER inks products, which are marketed as part of opposer's "graphic arts solutions" segment of its "polymers, coatings and inks" (PCI) division of its "functional products" business unit, are similar to applicant's inks products. As noted above, the identification of goods in opposer's VERSAMID registration is "polyamide resins," and the identification of goods in opposer's PHOTOMER registration is "radiation curable chemicals." Also as noted above, opposer's witness Mr. Toomey testified that these products are used "very much as component chemicals to enhance the capabilities of final inks. Printed inks, especially." (Toomey Depo. at 45.) We will assume (although the evidence of record does not directly establish) that at least some of

applicant's inks products likewise would be used as components in the manufacture of final inks.

The next prong of opposer's argument is that opposer's VERSAMID and PHOTOMER inks products are related, both in opposer's business model and in the marketplace, to opposer's synthetic lubricant products, including those sold under the ProEco mark. Opposer contends that these disparate goods are related because (a) they both are marketed under opposer's "functional products" business unit, albeit in different divisions of that business unit; (b) as products in opposer's "functional products" business unit, they share the same "sustainability" focus which opposer tries to apply to all goods in that business unit (and indeed to all products that it sells); (c) they are derived from the same core chemicals; and (d) they have the same basic purpose, i.e., to enhance the performance of the products of which they are components.[11] We cannot conclude that these facts, even if established, would support a conclusion that the relevant purchasing public is likely to assume that synthetic lubricant products and inks products are related as to source.

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[11] Opposer also argues that its synthetic lubricants and its inks products are related because they are marketed together, to overlapping customers and in overlapping trade channels. We shall address this argument *infra*, in connection with the third *du Pont* factor (similarity or dissimilarity of trade channels).

First, the fact that opposer has structured its business such that its synthetic lubricant products and its inks products are found in the same general "business unit" (and assuming that such fact is even known by purchasers) does not establish that purchasers would deem these products to be related for purposes of the second *du Pont* factor. Opposer's "functional products" business unit also includes mining chemicals and agricultural chemicals, goods which are no more related to opposer's synthetic lubricant products than are opposer's inks products, notwithstanding their inclusion in the same "business unit."

Second, even assuming that purchasers are aware of the fact that opposer tries to develop all of the products in its "functional products" business unit with a view toward its general focus of "sustainability," that fact does not suffice to establish the relatedness of these disparate goods. We note in this regard that it is not at all clear from the record that opposer's "sustainability" focus applies, or would be known by purchasers to apply, to opposer's inks products. The evidence in the record which pertains to opposer's inks products does not establish, specifically, that opposer's inks products are environmentally sensitive. Opposer's generalized contention that opposer tries to have all of the products in its "functional products" business unit be environmentally

sensitive does not establish specifically that the inks products in fact are environmentally sensitive. Not all of opposer's "functional products" goods are environmentally sensitive, as is evidenced by the fact that even some of opposer's synthetic lubricant products are not marketed under the ProEco mark because they are not environmentally sensitive. (Toomey Depo. at 24-25.) Moreover, Mr. Toomey testified that applicant's goods are not the type of goods which are likely to be, or to be viewed as being, environmentally sensitive. (Id. at 51-52.) That fact or perception would appear to apply likewise to opposer's inks products, which opposer contends are similar if not identical to applicant's.

Third, the purported relatedness of opposer's synthetic lubricant products and its inks products is not established by the fact that they might be derived from the same core chemicals, even if that fact were known to purchasers. Likewise, the fact that both of these types of products share the same basic purpose of enhancing the performance of the products of which they are components is not sufficient to prove product relatedness under the second *du Pont* factor. The same could be said of any and all materials which are designed and intended to be components of other products.

Mr. Toomey testified that it is "possible" that opposer might expand use of its ProEco mark into the inks products field. (Toomey Depo. at 33, 49.) We find this testimony to be far too speculative and tenuous to serve as a basis for finding that such expansion of use of the mark is likely, or that purchasers are likely to assume that such expansion has taken place. Even if we assume that opposer's inks products are or could be made to be "environmentally sensitive" and thus potentially eligible to be marketed under opposer's ProEco mark (which opposer only uses on environmentally friendly products),[12] we find it telling that opposer has used the ProEco mark for at least ten years with no such expansion of use into its inks products line in that time. *See M2 Software Inc. v. Madacy Entertainment*, 421 F.3d 1073, 76 USPQ2d 1161 (9th Cir. 2005)(prior user's de minimis efforts in past ten years to expand use of its mark into junior user's product market belies claim that such expansion is likely); *The Procter & Gamble Company v. A.E. Staley Manufacturing Company*, 138 USPQ 534 (TTAB 1963), *aff'd*, 342 F.2d 476, 144 USPQ 759 (CCPA 1965)(given plaintiff's thirty-year failure to expand use of its mark into defendant's product market, likelihood of such expansion is remote). *See also Sal Ianelli, Incorporated v.*

[12] As discussed *supra*, there is no evidence that opposer's inks products in fact are or could be environmentally friendly.

Wasser, 151 USPQ 653, 654 (TTAB 1966), *aff'd*, 411 F.2d 1350, 162 USPQ 260 (CCPA 1969)("Moreover, the mere fact that one of opposer's competitors markets both a color comparator and an overhead light for use in the photographic field, together with the fact that opposer is experimenting with an overhead light, is felt insufficient to establish that opposer has any real business in the above-mentioned field under the mark 'ANALYTE'").

In short, we are not persuaded by opposer's contention that its synthetic lubricant products and its inks products are related in the marketplace. These products obviously are quite different, with completely different applications in completely different industries. The fact that opposer happens to manufacture both types of products (along with many other products in its five general business units) is not sufficient to prove the relatedness of the goods for purposes of the second *du Pont* factor, especially in view of the fact that opposer markets these disparate products under different trademarks.

Having found that opposer has failed even to prove that its own inks products are related to its synthetic lubricants products for purposes of the second *du Pont* factor, we likewise find that the evidence of record does not support a finding that opposer's synthetic lubricant products are similar or related to applicant's inks

products. We simply cannot conclude that the scope of protection to be afforded opposer's ProEco mark, which has only been used on opposer's synthetic lubricant products, should be extended so far as to encompass applicant's completely different and unrelated inks products. The second *du Pont* factor thus weighs against a finding of likelihood of confusion.

The third *du Pont* factor requires us to determine the similarity or dissimilarity of the trade channels for opposer's and applicant's goods. As it did in connection with the similarity or dissimilarity of the goods under the second *du Pont* factor, opposer argues that its own synthetic lubricant products and its own inks products are marketed in the same trade channels and to the same classes of purchasers, and that we therefore should find that applicant's inks products likewise are or would be marketed in the same trade channels and to the same classes of purchasers as opposer's synthetic lubricant products. We are not persuaded.

Contrary to opposer's assertion, the evidence simply fails to establish that opposer's synthetic lubricant products and its inks products are marketed in the same trade channels to the same classes of purchasers. These goods obviously have very different purposes and applications. The record fails to show that, for example,

the mining, forestry, transportation and refrigeration industries which purchase applicant's synthetic lubricants would be the same as the ink manufacturers and printers who purchase opposer's (or applicant's) component chemicals for inks. Further, there is nothing in the record to support a finding that these disparate products would be marketed in the same trade channels (e.g., at the same trade shows or in the same trade publications).

The closest that opposer's evidence comes to addressing this issue is the following testimony from Mr. Toomey (at pp. 59-60 of his deposition):

> Q. And it's therefore foreseeable and it would be your expectation that the customer base for products within the coatings and inks category, and for the synthetic lubricants category, in many ways could overlap or be related.
>
> A. Yes. Absolutely. Yeah. In fact, we have a, both at the global level and at the regional level, what we term a key account structure which is in place specifically for customers who use multiple - or use products, or have a demand for products, across multiple business units. So yeah. You know, to them we're Cognis. And we don't have a Synlubes sales rep and a PCI sales rep and an oleochemical sales rep calling on them. We have one Cognis sales rep who calls on them and represents our entire product line.

We find that this testimony fails to establish that opposer in fact has specific customers who would purchase both opposer's synthetic lubricant products and its inks products. The fact that opposer has a "key account

structure" under which a single sales representative services customers who purchase products from multiple product lines does not, in itself, establish that such customers exist with respect to the synthetic lubricant products and the inks products, specifically. No such customers are identified by Mr. Toomey, nor is their existence revealed elsewhere in the record.

Mr. Toomey's testimony that opposer is "looking at" potentially using its ProEco mark on "drive line transportation" products at the retail level (Toomey Depo. at 41) fails to establish that the normal trade channels for opposer's synthetic lubricant products include retail trade channels. In any event, the fact that applicant's Class 9 goods and its Class 2 finished toners and inks products might be marketed in retail trade channels does not aid opposer's argument in this regard, because those goods are so dissimilar to opposer's synthetic lubricants that no source confusion is likely, as discussed above. As for those of applicant's inks products, which, like opposer's inks products, would appear to be marketed solely as component chemicals for use in the manufacturing of inks, such component products are unlikely to be sold at retail to general consumers.

Having found that opposer has failed to show that its own synthetic lubricant products and its own inks products

are marketed in the same trade channels to the same classes of purchasers, we likewise find that opposer has failed to establish that its synthetic lubricant products and applicant's inks products (or any other of applicant's products) are or would be marketed in the same trade channels and to the same classes of purchasers. The third *du Pont* factor therefore weighs against a finding of likelihood of confusion.

Under the fourth *du Pont* factor (conditions of purchase), we find that the evidence of record, and the identifications of goods in opposer's registrations, establish that the purchasers of opposer's synthetic lubricant products, who are in the fields of industry, manufacturing, construction, mining, forestry, refrigeration equipment and transportation, are sophisticated, knowledgable and careful purchasers who are not likely to be confused as to the source of the synthetic lubricants they purchase. We likewise find that the ink manufacturers who are the purchasers of opposer's VERSAMID "polyamide resins" and its PHOTOMER "radiation curable chemicals" are knowledgable and sophisticated, as are the purchasers of applicant's inks products which are or would be used as components in the manufacture of inks.

Opposer argues, however, that the purchasers of applicant's Class 9 computer goods and its Class 2 finished

toners and inks are likely to be ordinary consumers, and that we must base our findings under the fourth *du Pont* factor on those purchasers, rather than the knowledgable and sophisticated purchasers of opposer's products and applicant's inks products. We disagree. The members of the general public who might be retail purchasers of applicant's computer products and its finished toners and inks products would not be the purchasers of opposer's specialty chemicals and industrial synthetic lubricant products, or applicant's inks products. Their sophistication, or lack thereof, is immaterial under these circumstances. Moreover, even if we were to deem the relevant purchasers in this case to be unsophisticated general consumers, we would find that such lack of sophistication is greatly outweighed by the fundamental dissimilarity between opposer's goods and applicant's goods.

For these reasons, we find that the fourth *du Pont* factor weighs against a finding of likelihood of confusion.

We find that the fifth *du Pont* factor (fame of opposer's mark) is neutral in this case. Opposer's sales and advertising expenditures in relation to its goods sold under the ProEco mark, i.e., 2004 sales "in North America" of $10 million to $15 million, and 2004 advertising expenditures "in North America" of $100,000, are not a sufficient basis for finding that opposer's mark is famous

for purposes of the fifth *du Pont* factor. Opposer does not contend otherwise.

There is no evidence pertaining to the sixth *du Pont* factor (number and nature of similar marks in use on similar goods), and we therefore deem that factor to be neutral in this case. Likewise, there is no evidence of record pertaining to the rest of the *du Pont* factors.

Balancing all of the evidence of record as it pertains to the *du Pont* factors, we conclude that there is no likelihood of confusion as between applicant's PRO-ECO mark as used on applicant's goods and opposer's ProEco mark as used on opposer's goods. The marks are similar, but opposer's mark is quite suggestive and thus is deserving of a more limited scope of protection than if it were a stronger mark. Even if it were a stronger mark, the scope of protection to which it would be entitled simply does not extend so far as to preclude applicant's registration of its mark for fundamentally dissimilar goods, which are marketed in fundamentally different trade channels to fundamentally different (and sophisticated) classes of purchasers for use in fundamentally different applications. We have considered all of opposer's arguments to the contrary, but are not persuaded that the evidence of record supports a finding of

likelihood of confusion. Opposer's Section 2(d) ground of opposition therefore must fail.

Decision: The opposition is dismissed.