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05 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

R. E. Whittaker Company, Inc.

v.

Crystal Magic, Inc.

Consolidated Cancellation Nos. 30,339; 30,519; and 30,370

Thomas C. Wettach of Cohen & Grigsby for R. E. Whittaker Company, Inc.

Daniel R. Johnson of Ryan, Kromholz & Manion for Crystal Magic, Inc.

Before Hanak, Quinn and Holtzman, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

In May 2000 R. E. Whittaker Company, Inc. (petitioner) filed three separate petitions seeking to cancel three registrations owned by Crystal Magic, Inc. (respondent). On August 16, 2001 this Board issued an order consolidating the three cancellation proceedings stating that "the cases involve the same parties and common issues of law and fact."

Cancellation No. 30,339 involves respondent's mark CRYSTAL MAGIC depicted in typed drawing form and registered

for "carpet cleaning preparations, namely, cleaners for removing spots on carpets and carpet extraction cleaners." This Registration No. 2,247,086 issued on May 25, 1999. Cancellation No. 30,370 involves respondent's mark CRYSTALLINE registered in typed drawing form for "dry cleaning fluids for cleaning of carpets." This Registration No. 2,127,697 issued on January 6, 1998. Finally, Cancellation No. 30,519 involves respondent's mark CRYSTAL-EX registered in typed drawing form for "chemical preparations for extracting moisture from carpets." This Registration No. 2,109,776 issued on October 28, 1997.

The three cancellation petitions are essentially identical. They allege that commencing on February 14, 1992 petitioner has used throughout the United States the mark CRYSTAL DRY in connection with a carpet cleaning product. Continuing, the petitions allege that each of registrant's marks (CRYSTAL MAGIC, CRYSTALLINE and CRYSTAL-EX) so resemble "petitioner's mark, as to be likely, when used in connection with the products of registrant, to cause confusion, or cause mistake or to deceive because the public is likely to believe that registrant's products have their origin with petitioner or that such products are approved, endorsed or sponsored by petitioner or associated in some way with petitioner." (Petitions paragraphs 6).

While petitioner has not made specific reference to Section 2(d) of the Trademark Act, it is clear that this is the basis for each of the petitions.

Respondent filed answers which denied the pertinent allegations of the petitions. Both parties filed briefs. Neither party requested an oral hearing.

The record in this case is summarized at pages 4 to 6 of petitioner's brief. At page 1 of its brief, respondent states that it "hereby incorporates [petitioner's] description of the record." This record includes the depositions (with exhibits) of Richard E. Whittaker (petitioner's vice-president) and Gregory DeWerff (the owner of respondent). In addition, the record includes a copy of petitioner's Registration No. 1,770,989 for the mark CRYSTAL DRY for "carpet cleaning compound for commercial and/or industrial carpet cleaning." This registration issued on May 18, 1993 with a claimed first use date of February 14, 1992.

The record demonstrates that petitioner has continuously used its mark CRYSTAL DRY since February 1992. This is over two years prior to respondent's first use of CRYSTALLINE, and it is over three years prior to respondent's first use of CRYSTAL MAGIC and CRYSTAL-EX. Thus, priority of use rests with petitioner.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the goods and the similarities of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Considering first the goods, there is no dispute that as described in petitioner's registration and as described in respondent's three registrations, all of the goods are carpet cleaning compounds or preparations. Unlike petitioner's CRYSTAL DRY registration which contains the limiting words "for commercial and/or industrial cleaning," respondent's registrations do not contain such limiting words. However, this means that respondent's carpet cleaning preparations as described in its three registrations are broad enough to include carpet cleaning preparations for commercial and/or industrial carpet cleaning. Indeed, respondent's carpet cleaning preparations are specifically designed for commercial and industrial uses. (DeWerff deposition page 12). Thus, while petitioner's carpet cleaning compound and registrant's carpet cleaning compounds are not identical in the sense

that they contain the exact chemical formulation, they are legally identical in the sense that they are all carpet cleaning preparations or compounds for commercial and industrial use.

Considering next the marks, we note at the outset that when the goods are legally identical, as is the case here, "the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Obviously, petitioner's mark and respondent's three marks all begin with the identical word CRYSTAL. This is "a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." Presto Products v. Nice-Pak Products, 9 USPQ2d 1895, 1897 (TTAB 1988). Moreover, the record reflects that as applied to carpet cleaning compounds and preparations, there are no other trademarks or trade names that contain the word CRYSTAL.

To be perfectly clear, Mr. DeWerff did testify about two or three other companies which used the word "crystal" or a variation thereof in the text of their carpet cleaning compound labels. (DeWerff deposition pages 22-23). However, Mr. DeWerff did not testify that any other

companies used the word CRYSTAL as part of a trademark or trade name for carpet cleaning compounds.

In addition, respondent attached to its motions for summary judgment a list of third-party registrations which contained the word CRYSTAL as part of the mark. Three comments are in order. First, respondent has not properly made of record copies of these third-party registrations. Material attached to a motion for summary judgment does not form a part of the record at final hearing. Second, even if we were to consider these third-party registrations, we note that not one of these third-party registrations is for carpet cleaning compounds or preparations. Thus, even if the third-party registrations had properly been made of record, their evidentiary value would be minimal. Finally, even assuming that the third-party registrations had been properly made of record and even further assuming that some of the third-party registrations were for carpet cleaning compounds, the third-party registrations by themselves would "in the absence of any evidence showing the extent of use of any of such marks or whether any of them are not in use, they [the third-party registrations] provide no basis for saying that the marks so registered have had, or may have, any effect at all on the public mind so as to have a bearing on likelihood of confusion." Smith Bros. Mfg. Co.

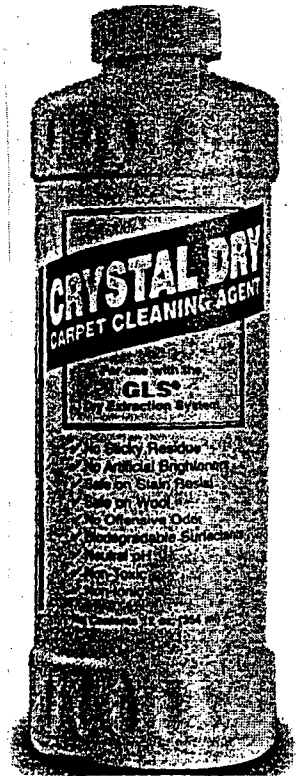
v. Stone Mfg. Co., 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973)(original emphasis).

As noted earlier in this opinion, the similarities of the marks and the similarities of the goods, while the most important factors in deciding the issue of likelihood of confusion, are not the only factors. In this case, there is another important factor bearing on the issue of likelihood of confusion, namely, respondent's intent in adopting its marks CRYSTAL-EX, CRYSTALLINE and CRYSTAL MAGIC. Petitioner and respondent are by no means strangers. Respondent entered the carpet cleaning business in 1983 under the name Dryit Carpet Dry Cleaning. It began manufacturing carpet cleaning preparations in 1991 under the name Sun Distributing. (DeWerff deposition pages 47-48). Respondent changed its corporate name from Sun Distributing to Crystal Magic, Inc. "when we saw what was happening in the industry with crystallization and with what Mr. Whittaker [petitioner] had done with the crystallization of his chemical." (DeWerff deposition page 48). Indeed, Mr. DeWerff had purchased petitioner's CRYSTAL MAGIC carpet cleaning preparation for testing purposes, and in addition, Mr. DeWerff traveled from Wisconsin to petitioner's headquarters in Massachusetts to

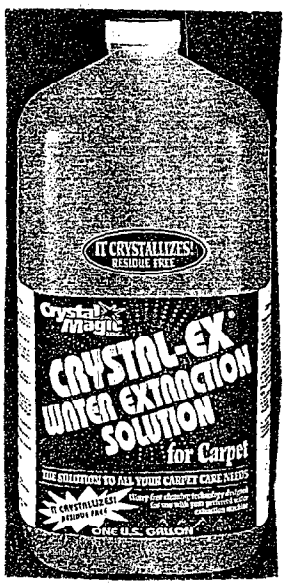
visit petitioner's facilities for manufacturing its CRYSTAL MAGIC carpet cleaning preparation.

Thereafter, respondent came out with its CRYSTAL-EX and CRYSTALLINE carpet cleaning preparations. On both of these carpet cleaning preparations, the mark CRYSTAL MAGIC appears in subordinate fashion as a housemark.

Reproduced below is a container for petitioner's CRYSTAL DRY carpet cleaning preparation.



Reproduced below are the containers for respondent's CRYSTALLINE and CRYSTAL-EX carpet cleaning preparations with the CRYSTAL MAGIC housemark.



As is readily apparent, the packagings for respondent's products bear a striking resemblance to the packaging for petitioner's product. In each case, respondent's marks (CRYSTALLINE and CRYSTAL-EX) are positioned on the products exactly as is petitioner's mark CRYSTAL DRY. That is to say, all three marks are positioned in a sloping fashion with the first portion of the marks lower than the latter portion of the marks. Mr. DeWerff has testified that "we steered clear when we designed, when we put together our labels, we specifically

steered clear of anything that the Whittaker Company, and actually a number of other companies, were using." (DeWerff deposition page 45). We find that respondent simply did not steer clear. Of all of the possible ways to place its trademarks on its packaging, there was absolutely no need for respondent to slope its marks in the same manner as petitioner had long since sloped its CRYSTAL DRY mark.

Over seventy years ago, a predecessor court to our primary reviewing Court stated that "one entering a field of endeavor already occupied by another should, in the selection of a trade name or trade mark, keep far enough away to avoid all possible confusion," and that a court has "a right, in determining the question of likelihood of confusion or mistake, to consider the motive in adopting a mark as indicating an opinion, upon the part of one vitally interested, that confusion or mistake would likely result from the use of the mark." Lever Brothers Company v. Riodela Chemical Co., 41 F.2d 408, 5 USPQ 152, 154-55 (CCPA 1930).

The teachings of Lever Brothers are as true today as they were over seventy years ago. Our primary reviewing Court has stated that "proof of intent to trade on another's goodwill, while persuasive evidence of likelihood of confusion, is not, in any event, a requirement under

Section 2(d)." Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 853 F.2d 888, 7 USPQ2d 1628, 1630 (Fed. Cir. 1988). Other Courts of Appeal have adopted the same reasoning of Lever Brothers. See Beer Nuts, Inc. v. Clover Club Foods Co., 711 F.2d 934, 221 USPQ 209, 216 (10th Cir. 1987)("One who adopts a mark similar to one already established in the marketplace does so at his peril … because the court presumes that he can accomplish his purpose: that is that the public will be deceived."); Official Airline Guides Inc. v. Goss, 6 F.3d 1394, 28 USPQ2d 1641, 1647 (9th Cir. 1993) ("When an alleged infringer knowingly adopts a mark similar to another's, courts will presume intent to deceive the public.").

In short, given the fact that petitioner's and respondent's goods are legally identical; the fact that all of the involved marks begin with the word CRYSTAL; the fact that on this record there is no evidence that others are using the word CRYSTAL as part of a trademark or trade name for carpet cleaning preparations or compounds; and the fact that respondent knowingly adopted its three marks with full knowledge of petitioner's CRYSTAL DRY mark and then respondent presented its marks in a similar fashion, we find that there exists a likelihood of confusion. Of course, it need hardly be said that to the extent that

there are doubts on the issue of likelihood of confusion, we are obligated to resolve those doubts in favor of petitioner as the prior user. Century 21 Real Estate, 23 USPQ2d at 1707; In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1691 (Fed. Cir. 1993).

Two final comments are in order. We have accorded no weight to Mr. Whittaker's testimony about possible instances of actual confusion as it is too vague. (Whittaker deposition pages 17-18). Second, at pages 27 to 30 of its brief, petitioner argues that its CRYSTAL DRY mark is famous. In finding that there exists a likelihood of confusion, we have done so under the premise that petitioner has not shown its mark to be famous.

Decision: The petitions for cancellation are granted.