Paper No. 16
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sakurai Graphic Systems Corporation

Serial No. 74/421,806

Kit M. Stetina of Stetina Brunda & Buyan for applicant.

Andrew P. Baxley, Trademark Examining Attorney, Law Office 104 (Sidney I. Moskowitz, Managing Attorney).

Before Simms, Quinn and Hairston, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Sakurai Graphic Systems Corporation to register the mark OLIVER for "sheet-fed offset printing presses."[1]

The Trademark Examining Attorney has refused registration under Section 2(d) of the Act on the ground that applicant's mark, when applied to applicant's goods, so

[1]Application Serial No. 74/421,806, filed August 9, 1993, alleging first use anywhere in September 1975 and first use in commerce between Japan and the United States on July 13, 1981.

resembles the previously registered mark OLIVER in typed form[2] and the previously registered mark shown below[3]

both for "automatic wrapping machines for packaging goods in film materials; bread and baked goods slicing machines; combination bread slicing machines and wrapping machines (combination bread slicing and wrapping machines in Reg. No. 1,239,195); meat slicing machines; label applicating machines; combination label applicating machines and printing machines (combination label printing and applicating machines in Reg. No. 1,239,195), and combination wrapping, label applying and printing machines (combination wrapping, label printing and applicating machines in Reg. No. 1,239,195) as to be likely to cause confusion. The cited registrations are owned by the same entity.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs.[4]

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[2]Registration No. 1,207,893, issued September 14, 1982; combined Sections 8 and 15 affidavit filed.

[3]Registration No. 1,239,195, issued May 24, 1983; combined Sections 8 and 15 affidavit filed.

[4]Applicant's appeal brief is accompanied by new evidence, namely Exhibit C which is an excerpt from a printed publication. Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the appeal and that the

Applicant, in urging that the refusal to register be reversed, argues the following four points: the goods are different; the trade channels for the goods are different (more specifically, that registrant's goods are sold to the food industry whereas applicant's goods are sold to the printing, publishing and graphic arts industries); the goods are expensive machines sold only to sophisticated commercial purchasers; and there have been no instances of actual confusion during several years of contemporaneous use. In support of its position, applicant submitted the affidavits of Yoshikuni Sakurai, applicant's president, and Larry Fuller, applicant's vice president and general manager. Mr. Fuller's affidavit is accompanied by three related exhibits, namely, a customer list, a price list and product brochures.

The Examining Attorney maintains that the goods are sufficiently similar that, when sold under identical or substantially identical marks, purchasers are likely to be

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Board will ordinarily not consider additional evidence after the appeal is filed. The rule further provides that if additional evidence is sought to be introduced, the offering party may request the Board to suspend the appeal and to remand the application. Evidence submitted by an applicant after appeal, without a granted request to suspend and remand for additional evidence, may be considered by the Board, despite its untimeliness, if the Examining Attorney does not object to the new evidence and discusses the new evidence or otherwise affirmatively treats it as being of record. See, e.g., In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991). See also: Trademark Trial and Appeal Board Manual of Procedure § 1207.03. Although in this case the Examining Attorney did not object to Exhibit C, neither did he discuss this evidence or otherwise treat it of record. Accordingly, Exhibit C does not form part of the record in this appeal, and we have not considered it. We hasten to add, however, that even if this evidence were considered, it would not change the result.

confused. The Examining Attorney contends that registrant's combination label applicating and printing machines are not limited to the food packaging industry and that, therefore, it must be presumed that the machines can be used in any type of packaging industry. As for applicant's goods, he argues that applicant's goods, in the absence of any limitations, must be presumed to encompass all kinds of sheet-fed offset printing presses, including those used to print labels in the packaging industry. Thus, when the goods as set forth in the cited registration are compared to the goods as set forth in the involved application, a relationship between them is evident. In this connection, the Examining Attorney submitted excerpts (third-party patents and articles from printed trade publications) retrieved from the NEXIS data base which show, according to the Examining Attorney, that sheet-fed offset printing presses are commonly used to print labels in the packaging industry.

A determination of likelihood of confusion requires an analysis of the relevant factors listed in In re E.I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis under Section 2(d) of the Act, two key considerations are the similarities between the marks and the similarities between the goods. In the present case, applicant has not disputed the

similarity between its mark and registrant's marks.[5] Indeed, applicant's mark OLIVER in typed form is identical to registrant's mark OLIVER in typed form as shown in Registration No. 1,207,893. Further, applicant's mark is substantially identical to registrant's mark OLIVER in stylized form as shown in Registration No. 1,239,195. The insignificant stylized features of this cited mark hardly detract from the literal identity between it and applicant's mark.

Given the similarities between the marks, applicant and the Examining Attorney have concentrated their arguments on the similarities and dissimilarities between registrant's combination label printing and applicating machines and applicant's sheet-fed offset printing presses.

With respect to the goods, it is clear that the Board must compare applicant's goods as set forth in its application with the goods as set forth in the cited registration. In re Trackmobile Inc., 15 USPQ2d 1152 (TTAB 1990). It is not necessary that the goods be similar or competitive or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same person under

[5]In this connection, applicant's brief is entirely silent on the point.

circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In the present case, we find that applicant's sheet-fed offset printing presses and registrant's combination label printing and applicating machines are sufficiently similar that, when sold under identical or virtually identical marks, purchasers are likely to be confused. Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981) [relationship between the goods need not be as close where the marks are identical or strikingly similar]. In reaching this conclusion, we are mindful that registrant's goods would appear to be directed to the food industry whereas, according to applicant's evidence, applicant's printing presses are sold to those in the printing, graphic arts and publishing industries.[6] However, applicant's identification of goods is not so restricted, and we must therefore assume that the printing presses encompass all types, including those that are used to print labels in the food industry. In this connection, the Examining Attorney has submitted

[6]We note the Examining Attorney's assertion that "[a]lthough many of the items listed in the registrant's identifications of goods are clearly limited to the food packaging industry, there is no such limitation placed on goods identified as combination label and applicating and printing machines and combination wrapping, label applying/applicating and printing machines." (brief, p. 5) The Examining Attorney technically is correct. Even assuming that all of registrant's goods travel in only limited trade channels, however, applicant's goods are not limited in any fashion. Thus, the result in this case would not change.

excerpts retrieved from the NEXIS database which establish that sheet-fed offset printing presses are used to print labels for packaging, with some applications in the food industry. By way of example, we highlight the following excerpts:

> ...the bulk of label volume [for food cans] is done on sheetfed offset presses...
> *Graphic Arts Monthly*, September 1995
>
> For commercial printers, perhaps the easiest point of market entry is in packaging labels, i.e., producing paper labels--typically for canned goods--on conventional printing presses.
> *Graphic Arts Monthly*, October 1995

Inasmuch as the record establishes that offset printing presses are used to print labels for packaging, including labels in the food industry, we conclude that applicant's goods are related to registrant's combination label printing and applicating machines.

The record shows that some of applicant's printing presses are quite expensive. Even conceding that registrant's and applicant's customers are sophisticated, we would point out that even sophisticated purchasers would not be immune from source confusion. In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983). We find this to be especially the case here where identical and/or substantially identical marks are involved, and there is no evidence showing any third-party uses of the same and/or similar marks in the printing field.

The evidence bearing on the absence of actual confusion between the marks does not compel a different result in this case. Although applicant has supplied a list of customers for its goods, no evidence has been provided as to the level of sales of its goods. Thus, there is no meaningful way to evaluate the opportunity for actual confusion to occur among purchasers. Further, this factor is of limited probative value in the context of an ex parte proceeding wherein there is no way to assess what the experience of the registrant has been. In re Cruising World, Inc., 219 USPQ 757, 758 (TTAB 1983). Moreover, the issue before us in not one of actual confusion, but only the likelihood of confusion.

Finally, to the extent that any of the points raised by applicant casts doubt on our decision, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

We conclude that consumers familiar with registrant's combination label printing and applicating machines sold under the mark OLIVER would be likely to believe, upon encountering applicant's mark OLIVER for sheet-fed offset printing presses, that the goods originated with or were somehow associated with or sponsored by the same entity.

Decision: The refusal to register is affirmed.

R. L. Simms

T. J. Quinn

P. T. Hairston
Administrative Trademark Judges
Trademark Trial and Appeal Board