

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
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Hearing:
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EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

UNOVA, Inc. v. Z-Flex (U.S.), Inc.

Opposition No. 115,544 to Application
Serial No. 75/338,630 filed August 11, 1997

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Inc.

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Before Seeherman, Hanak and Chapman, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Z-Flex (U.S.), Inc. (applicant) seeks to register U-
NOVA in typed drawing form for "metal industrial duct and
hose products, namely hoses, ducts, pipes, joints and
connectors" (Class 6) and "non-metallic industrial duct and
hose products, namely hoses, ducts, pipes, joints and
connectors manufactured from plastic, rubber and fabric"

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(Class 17). The intent-to-use application was filed on August 11, 1997.

On September 2, 1999 UNOVA, Inc. (opposer) filed a Notice of Opposition alleging that it had prior rights in the mark UNOVA for a wide array of industrial machines, and further alleging that the contemporaneous use of UNOVA by opposer for its goods and U-NOVA by applicant for its goods is likely to cause confusion. Subsequently, opposer obtained a registration of UNOVA in typed drawing form covering, among other goods, "automated manufacturing, machining and assembly lines for the automotive and other high volume manufacturing industries." Opposer has properly made of record a certified status and titled copy of this Registration No. 2,406,597 which issued on November 21, 2000.

Applicant filed an answer which denied the pertinent allegations of the Notice of Opposition. Opposer and applicant filed briefs, and were present at a hearing held on February 26, 2002.

The record in this case is summarized at page 2 of opposer's brief and page 1 of applicant's brief. It

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consists of, in part, the deposition testimony (with exhibits) of the following three individuals: M. Michael Carpenter (opposer's Staff Vice-President of Intellectual Property); Douglas Bidy (Vice-President of Sales for a wholly owned subsidiary of applicant); and Ian Donnelly (President of applicant).

Because opposer has properly made of record a certified status and titled copy of its aforementioned registration of UNOVA for, among other goods, "automated manufacturing, machining and assembly lines for the automotive and other high volume manufacturing industries," priority rests with opposer. King Candy Co. v. Eunice King's Kitchen Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Hence, as applicant agrees, the only issue in this proceeding is one of likelihood of confusion. (Applicant's brief page 2).

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192

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USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of the differences in the essential characteristics of the goods and differences in the marks.").

Considering first the marks, they are virtually identical. Obviously, in terms of pronunciation, the marks are absolutely identical. In terms of visual appearance, they are nearly identical. Finally, as will be discussed at greater length in a moment, the marks are totally arbitrary. In considering the marks, we take note of the following statement made by applicant at page 22 of its brief: "The parties' marks -- UNOVA and U-NOVA -- are pronounced identically and differ in written form only by the fact that [applicant's] mark has a hyphen while opposer's mark does not."

In sum, the first Dupont "factor weighs heavily against applicant" because opposer's mark and applicant's mark are virtually identical. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Turning to a consideration of opposer's goods and

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applicant's goods, we note that because the marks are virtually identical, their contemporaneous use can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). This is particularly true when the virtually identical marks are also (1) arbitrary in that they lack any meaning, and (2) unique in the sense that no third parties are using the marks for any type of goods or services. Philip Morris, Inc. v. K2 Corp., 555 F.2d 815, 194 USPQ 81, 82 (CCPA 1977) (Confusion was found when the mark K2 was used on very different goods, namely, skis and cigarettes). See also National Motor Bearing Co. v. James-Pond-Clark, 266 F.2d 799, 121 USPQ 515, 518 (CCPA 1959). In this regard, we note that applicant's president testified that U-NOVA has absolutely no meaning in English, and is "purely fanciful." (Donnelly deposition pages 13-14). Moreover, before adopting their marks, both opposer and applicant had conducted extensive trademark searches to ascertain whether any third parties were using UNOVA or U-NOVA for any goods

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or services. These extensive trademark services revealed that no third parties were using either UNOVA or U-NOVA for any type of goods or services. (Donnelly deposition pages 18 and 56; Carpenter deposition page 27).

As just noted, because the marks are virtually identical, their contemporaneous use can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 26 USPQ2d at 1689. However, in this case we find that certain of opposer's goods and at least certain of applicant's goods are clearly related in that applicant's hoses, ducts and connectors could be used as replacement parts for opposer's automated manufacturing and assembly line equipment. Before discussing the specifics of our finding, one legal principle should be articulated. In Board proceedings "the question of likelihood of confusion must be determined based on a analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in opposer's registration, rather than what the evidence shows the goods and/or

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services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Applicant has acknowledged this legal principle when it makes the following statement at page 23 of its brief: "In making this inquiry [into likelihood of confusion], the Board must compare the parties' products, as described in [applicant's] trademark application and opposer's registration, and must assume that the products move through all the normal channels of trade."

As previously noted, applicant seeks to register U-NOVA for metal and non-metallic (plastic, rubber and fabric) industrial duct and hose products, namely hoses, ducts, pipes, joints and connectors. As Mr. Bidy testified, applicant's identification of goods is "pretty broad." (Bidy deposition page 93).

With the foregoing in mind, we turn now to a consideration of opposer's goods as described in its registration and applicant's goods as described in its application. As applicant has conceded, "both parties manufacture industrial products which may be found on a

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factory floor." (Applicant's brief page 28). With regard to opposer's automated manufacturing, machining and assembly lines for the automotive and other high volume manufacturing industries, there is no dispute that opposer's machines are expensive and are purchased with great care. Opposer's large automated manufacturing machines sell from \$50,000 to "several hundreds of thousands of dollars." (Carpenter deposition pages 107 and 149) Moreover, opposer has conceded that when the middle managers of its customers initially purchase opposer's large automated manufacturing machines, they "exercise extreme care." (Carpenter deposition pages 157 to 158, and page 121).

As might be expected, opposer's large automated manufacturing machines have "hundreds of component parts." (Carter deposition page 155, and page 146). Among these component parts are hoses, ducts, joints and connectors. (Carter deposition pages 62, 76, 86, 91 and 162). With time, the hoses, ducts, joints and connectors on opposer's large automated manufacturing machines must be replaced.

Applicant has conceded that its U-NOVA hoses and the

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like could be used as replacement parts on opposer's UNOVA automated manufacturing machines. (Bidly deposition page 86). While Mr. Bidly testified that many of applicant's actual hoses, ducts, joints and connectors would not be suitable for opposer's large automated manufacturing machines, this is irrelevant because, as Mr. Bidly conceded, the identification of goods in applicant's application is quite broad in that it encompasses all types of metal and non-metallic (plastic, rubber and fabric) industrial duct and hose products, namely hoses, ducts, pipes, joints and connectors. Whether many of applicant's actual current line of hoses and the like are suitable for opposer's machines is not the issue. As previously noted, applicant has conceded that its products are found on factory floors, the precise location where one would find opposer's automated manufacturing machines (Applicant's brief page 28). When it came time to replace a hose, duct, joint or connector on one of opposer's machines, an ordinary factory worker, seeing opposer's UNOVA mark displayed on the machine, could easily turn to one of applicant's U-NOVA catalogues listing various hoses, ducts,

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pipes and connectors, and make the erroneous assumption that these U-NOVA hoses and the like were specifically designed as replacement parts for opposer's UNOVA machinery. In other words, an ordinary factory foreman or worker could easily assume that the manufacturer of the large UNOVA automated manufacturing machine was also the manufacturer of, or at least the endorser of, the U-NOVA hoses and the like. In short, we find that there exists a likelihood of confusion not when opposer's large, expensive automated manufacturing machines are initially purchased with care by middle management, but rather there exists a likelihood of confusion when it comes time to replace hoses and the like on opposer's machines. At this point, the replacement of such mundane items as hoses and the like would not be done by middle management with great care, but rather would be done by factory foremen and factory workers who could easily assume that applicant's U-NOVA hoses and the like are made by or at least endorsed by the manufacturer of the large UNOVA automated manufacturing machines. Accordingly, we find that there exists a

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likelihood of confusion and sustain the opposition.

Of course, to the extent that there are any doubts on the issue of likelihood of confusion, we are obligated to resolve said doubts in favor of opposer who has prior rights. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir 1984).

Two final comments are in order. First, at page 13 of its brief, opposer argues that actual confusion has occurred involving its mark UNOVA and applicant's mark U-NOVA. While opposer has established that a minor amount of confusion occurred in the form of misdirected e-mails and reader response cards from a publication entitled Industrial Equipment News, this confusion did not involve actual or potential customers of opposer, as Mr. Carpenter acknowledges at page 124 of his deposition. Accordingly, in reaching our conclusion that there exists a likelihood of confusion, we have accorded no weight to opposer's proof that there existed a minor amount of actual confusion among individuals who were not proven to be actual or potential customers of opposer or applicant. Of course, it need hardly be said that proof of actual confusion is not a

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prerequisite for a finding of likelihood of confusion. Accordingly, we have treated the Dupont factor of actual confusion as being neutral in this case.

Second, we wish to distinguish two cases cited by applicant. The first is Toro Manufacturing v. Gleason Works, 474 F.2d 1401, 177 USPQ 330 (CCPA 1973) cited by applicant at page 24 of its brief. In Toro, the Court found no likelihood of confusion between opposer's TORO mark for lawnmowers, tractors and golf carts and applicant's TOROID mark for gears, gear cutters and blades. However, in Toro the Court quoted with approval the following language from the TTAB: "TORO and TOROID ... do not look or sound very much alike, and the several meanings thereof are not the same." 177 USPQ at 331. In stark contrast to the marks in the Toro case, the marks here are virtually identical (UNOVA and U-NOVA).

The second case relied upon by applicant at page 21 of its brief is Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992). In Electronic Design & Sales the Court found no likelihood of confusion despite the fact that "the two

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parties conduct business not only in the same fields but also with some of the same companies." 21 USPQ2d at 1391. The Court made it clear that the mere sale by opposer and applicant of their respective goods to the same institutions was not sufficient to prove that there existed a likelihood of confusion. Rather, the Court stated that opposer must establish that actual "users [individuals] who might influence future purchasers" had to be exposed to both opposer's goods and applicant's goods in a manner such that a likelihood of confusion would exist. Electronic Design & Sales, 21 USPQ2d at 1392. Here there is no dispute that actual individuals (factory foremen and workers) are exposed to both opposer's UNOVA automated manufacturing machines and applicant's hoses, joints, pipes and connectors. Indeed, at page 86 of his deposition Mr. Bidy testified that if someone on a factory floor was operating large manufacturing equipment and had a problem with the hoses on the equipment, they could call applicant to seek a replacement hose. In short, unlike the situation in Electronic Design & Sales where the goods of opposer and applicant were sold to entirely different sections of a

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particular company (institution), here opposer has established that factory foremen and workers operating opposer's large UNOVA automated manufacturing machines could have access to one of applicant's U-NOVA catalogues and could call applicant to order a U-NOVA hose or the like as a replacement part for opposer's UNOVA machine.

Decision: The opposition is sustained, and registration to applicant is refused.

