

Oral Hearing:
June 10, 1997

Paper No. 26
CEW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

JULY 8, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Otis Elevator Company
v.
Schindler Aufzuge AG

Consolidated
Opposition Nos. 93,526 and 95,936;
Cancellation No. 22,550

Albert Robin and Howard B. Barnaby of Robin, Blecker, Daley
& Driscoll for opposer

Neil F. Greenblum of Greenblum & Bernstein for applicant

Before Cissel, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Otis Elevator Company (Otis) filed its opposition to
two applications of Schindler Aufzuge AG (Schindler) to
register, respectively, the mark ESCALANT for "escalators;
moving pavements and walkways; continuous passenger
conveyors"¹; and the mark SCHINDLER ESCALINE for

¹ Opposition No. 93,526 to application Serial No. 74/298,696, filed in
International Class 7 on July 28, 1992, based both upon an alleged bona
fide intention to use the mark in commerce in connection with the
identified goods, under Section 1(b) of the Trademark Act, and upon

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"escalators; moving pavements and walkways and other belt conveying apparatus for persons; continuous passenger conveyors."² Additionally, Otis has petitioned to cancel a registration owned by Schindler for the mark SCHINDLER ESCALANT for "escalators, passenger walkways, continuous passenger conveyors."³ These three proceedings were consolidated by the Board, upon the motion of Otis with the consent of Schindler, in its order of May 2, 1996.

Cancellation No. 22,550

In view of the cancellation under Section 8 of the Trademark Act of Registration No. 1,613,545, the registration which is the subject of Cancellation No. 22,550, the Board issued, on March 13, 1998, an order allowing respondent time to show cause why judgment should

ownership of Swiss Registration No. 372,328, under Section 44(e) of the Trademark Act. The record includes a claim of ownership of U.S. Registration No. 1,613,545. We note that several papers are missing from this application file, including page 1 of applicant's response to the Examining Attorney's office action and the certified copy and translation of the Swiss registration forming one basis for the application. Should applicant ultimately succeed in defending against this opposition, the application file should be reconstructed in its entirety.

² Opposition No. 95,936 to application Serial No. 74/301,117, filed in International Class 7 on August 4, 1992, with a claim of priority, under Section 44(d) of the Trademark Act, based on the filing on June 15, 1992, of an application in Switzerland. The Swiss application matured into Registration No. 403,757, a certified copy of which has been filed in this application. Thus, this application is based both upon an alleged bona fide intention to use the mark in commerce in connection with the identified goods, under Section 1(b) of the Trademark Act, and upon ownership of the aforementioned Swiss registration, under Section 44(e) of the Trademark Act. The record includes a claim of ownership of Registration Nos. 1,019,036; 1,428,097; 1,613,545; and 1,722,463.

³ Cancellation No. 22,550 regarding Registration No. 1,613,545, issued in International Class 7 on September 18, 1990. The records of the

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not be entered against respondent. As respondent did not respond to this order, judgment is hereby entered against respondent in Cancellation No. 22,550.

Opposition Nos. 93,526 and 95,936

As grounds for opposition, opposer asserts that applicant's marks, ESCALANT and SCHINDLER ESCALINE, when applied to applicant's goods, so resemble opposer's previously used and registered mark ESCAL-AIRE for "moving stairways and parts therefor"⁴ as to be likely to cause confusion under Section 2(d) of the Trademark Act. Also as a ground of opposition, opposer asserts that applicant has never used ESCALANT alone but only as part of the composite mark SCHINDLER ESCALANT. Opposer alleges, further, that since prior to July 28, 1992, opposer has been in the business of designing, developing, manufacturing, advertising, offering for sale, selling and maintaining a variety of elevator, escalator and related products.

Applicant, in its answer, denies the salient allegations of the likelihood of confusion claim. With respect to opposer's second ground of opposition, namely, that applicant has never used ESCALANT alone but only as part of the composite mark SCHINDLER ESCALANT, applicant

Patent and Trademark Office (PTO) indicate that this registration was canceled, under Section 8 of the Trademark Act, as of March 24, 1997.
⁴ Registration No. 754,578, issued August 13, 1963, and renewed for a period of twenty years from August 13, 1983. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

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admits this fact, but requests, affirmatively, that this ground be dismissed for failure to state a claim upon which relief can be granted.

The Record

The record consists of the pleadings; the files of the involved applications; a title and status copy of opposer's pleaded Registration No. 754,578; and the testimony depositions taken by opposer of Richard K. Pulling, Jr., applicant's product manager for traction elevators, and Dennis Barrow, the consulting archivist at Otis, both with accompanying exhibits.⁵ Applicant did not submit testimony or evidence in this case. Only opposer filed a brief and, at the oral hearing on this case, only opposer was represented.

The Parties

Opposer manufactures, installs and maintains "vertical and horizontal transportation equipment," including elevators and escalators. According to the testimony of Richard K. Pullings, Jr., opposer's production manager for traction elevators, opposer sells several types of

⁵ Two of the exhibits submitted by opposer in connection with the testimony of Richard K. Pulling, Jr., No. 31 [title and status copy of opposer's pleaded registration] and No. 32 [a Thomson & Thomson search report pertaining to ESCAL], were not identified or otherwise discussed by the witness. However, we have considered these exhibits as applicant has not objected to them. In fact, with respect to Exhibit No. 31, a certified title and status copy of opposer's registration, applicant admits, in its answer, that opposer "appears" to own this valid and subsisting registration. Although considered of record, the third-party search report comprising Exhibit No. 32 is of little persuasive value as it is not evidence of use of the marks therein.

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escalators with varying characteristics, such as, the length of the spanned rise. All of its units are custom manufactured to the specifications of the purchaser. The period from purchase to installation is approximately 14 to 18 weeks. Opposer markets its products to those persons involved in specifying, purchasing, installing and/or designing elevators and escalators for a building, in particular, architects, building owners, developers and general contractors. From 1987 to the date of trial, opposer sold approximately 1500 ESCAL-AIRE escalators in the United States, for a total dollar value of approximately \$110 million.

According to Mr. Pulling, while it has been the practice of the industry to place the trademark for an escalator on the escalator's riser or landing plate, customers now often specify that no trademark should appear on the product. Where no specification is made in this regard, opposer places its mark on the landing platform. Opposer's trademark does, in any case, appear on shipping boxes for its products and on advertising brochures.

Mr. Pulling testified that opposer's primary competitors for the escalator business in the United States are Montgomery-Kone, Fujitec, Ornstien and Kopple, and Schindler, the applicant herein (which, according to

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opposer, purchased Westinghouse and now provides escalators
in the United States for Westinghouse).

Analysis

Inasmuch as a certified copy of opposer's registration
is of record, there is no issue with respect to opposer's
priority. *King Candy Co., Inc. v. Eunice King's Kitchen,
Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Furthermore,
opposer has submitted substantial evidence of its use of the
mark ESCAL-AIRE in connection with escalators since long
prior to the filing dates of the applications herein.

Our determination of likelihood of confusion under
Section 2(d) must be based on an analysis of all of the
probative facts in evidence that are relevant to the factors
bearing on the likelihood of confusion issue. *In re E.I.
duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA
1973). Two key considerations in this case are the
similarities between the goods and the similarities between
the marks. *Federated Foods, Inc. v. Fort Howard Paper Co.*,
544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). This is
especially true in cases where, as here, there is little
evidence bearing on the other factors enumerated in the
duPont case.

With respect to the goods of the parties, we observe
that there is a substantial overlap in the goods identified
in the application and in the pleaded registration. Both

identifications of goods are broadly worded. Therefore, we must presume that the goods of the applicant and registrant are sold in all of the normal channels of trade to all of the normal purchasers for goods of the type identified. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). That is, we must presume that the goods of applicant and registrant are sold through the same channels of trade to the same classes of purchasers. Opposer's testimony that the parties are direct competitors in the escalator field indicates that the parties sell at least some of the same kinds of goods to the same purchasers.

The evidence indicates, further, that the goods involved in this case are very expensive and are purchased after careful consideration by knowledgeable purchasers. The fact that the goods are manufactured to the specification of the purchaser for installation in a particular building indicates that purchasers are likely to discuss their specifications with the seller on at least one, and probably numerous, occasions.

Turning to the marks, we note that we must base our determination on a comparison of the marks in their entireties. However, we are guided, equally, by the well-established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "there is

nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Considering, first, applicant's mark ESCALANT, we find that opposer's mark, ESCAL-AIRE and applicant's mark, ESCALANT, are substantially similar in sound, appearance, connotation and overall commercial impression. Both marks consist of the root ESCAL followed by a single syllable beginning with "A." We find the visual impression created by the hyphen in opposer's mark is minor and does not affect the pronunciation, connotation or overall commercial impression of opposer's mark. While ESCAL would appear to be derived from the word "escalator" there is no evidence that it is more than suggestive in connection with the parties' goods or that it comprises part of any third-party marks.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of opposer's mark, ESCAL-AIRE, and applicant's mark, ESCALANT, their contemporaneous use on the same or closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Similarly, considering opposer's mark, ESCAL-AIRE, and applicant's mark, SCHINDLER ESCALINE, we find the ESCALINE portion of applicant's mark to be substantially similar in sound, appearance and connotation to the ESCAL-AIRE portion of opposer's mark. We find that ESCALINE is the dominant portion of applicant's mark. We do not find that the addition of SCHINDLER to ESCALINE significantly changes the overall commercial impression of the mark. As such, we find that the overall commercial impressions of opposer's mark, ESCAL-AIRE, and applicant's mark, SCHINDLER ESCALINE, are substantially similar. In view thereof, we find that the contemporaneous use of the parties' mark on the same or closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods. We note that applicant, by failing to take testimony or file a brief herein, has made no argument that confusion is not likely.

While the goods are expensive goods purchased by knowledgeable consumers after careful consideration, we do not find such factors to obviate the likelihood of confusion found herein.

Finally, we consider opposer's allegation that applicant has never used ESCALANT alone but only as part of the composite mark SCHINDLER ESCALANT. We find that this claim does not state a separate ground of opposition as the

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application to register the mark ESCALANT herein is not based on use of the mark in commerce and, therefore, such a fact, as admitted by applicant, is not a basis for granting the opposition against that application.

Decision: Judgment is entered against respondent in Cancellation No. 22,550. Regarding Opposition Nos. 93,526 and 95,936, the opposition in each case is sustained as to the Section 2(d) ground and judgment is entered against respondent. The opposition is dismissed in Opposition No. 93,526 as to the ground of non-use of the applied-for mark.

R. F. Cissel

P. T. Hairston

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board