

This Opinion is not a
Precedent of the TTAB

Oral Hearing: August 28, 2019

Mailed: September 11, 2019

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board**

In re Kitz Corporation

Serial No. 79221711

Rebecca Gan, Wenderoth LLP for Kitz Corporation.

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Managing Attorney.

**Before Mermelstein, Wolfson, and Coggins, Administrative Trademark
Judges.**

Opinion by Mermelstein, Administrative Trademark Judge:

Kitz Corporation applied to register the mark



on the Principal Register for a variety of goods in International Classes 6 and 7, including “iron and steel” in Class 6.¹

¹ Filed August 4, 2017, pursuant to Trademark Act § 66, 15 U.S.C. § 1141f, requesting extension of protection of International Registration No. 1377039. The application contains a statement that “[t]he English translation of TOYO in the mark is East or Orient.” Applicant claims ownership of Registration Nos. 0857355, 1197701, and 4374195.

Applicant appeals from the Examining Attorney's final partial refusal (limited to "iron and steel") pursuant to Trademark Act § 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant's mark is likely to cause confusion with the registered mark **TOYO KOHAN**² (in standard characters) for:

Iron and steel; non-ferrous metals and alloys thereof; metal ingredients made especially for architecture and construction for further manufacture; assembly sets for metal buildings comprising roof, wall, ceiling, duct, door, and pre-fabricated bath; metal joinery fittings for use in doors, windows, stationery supplies, home electronic appliances, audio-visual appliances, personal computers, office automation devices, bolts and pipes; packaging containers made of metal; joinery fittings made of metal;

in International Class 6.

We affirm the refusal to register.

I. Applicable Law

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see In*

² Registration No. 4777629, issued July 21, 2015. The registration includes a statement that "[t]he English translation of 'TOYO' in the mark is 'east,' 'orient.'"

re Azteca Rest. Enters., Inc., 50 USPQ2d 1209 (TTAB 1999).

II. Analysis

A. Similarity or dissimilarity and nature of the goods.

In comparing the goods, “[t]he issue to be determined . . . is not whether the goods . . . are likely to be confused but rather whether there is a likelihood that purchasers will be misled into the belief that they emanate from a common source.” *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989).

The Examining Attorney partially refused registration with respect to “iron and steel” identified in the subject application. The goods in the cited registration include “iron and steel.” With his first Office Action, the Examining Attorney submitted third party registration evidence to show the relationship of Applicant’s goods to those of the cited registrant. However, the refusal to register has been limited to “iron and steel” in the subject application, which is identical to the “iron and steel” in the cited registration. We need no evidence to determine that “iron and steel” is identical to “iron and steel,” making the relationship of the other goods of little importance. *See Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (refusal to register must be affirmed if confusion is likely with respect to any item in the application).

Because the goods subject to the refusal are identical to goods in the cited registration, this factor weighs heavily in favor of a finding of likely confusion.

B. The similarity or dissimilarity of established, likely-to-continue trade channels.

Because we have found Applicant’s goods to be identical to some of the goods in

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the cited registration, we find that to the same extent, they move in the same channels of trade and to the same purchasers. *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (“we have legally identical goods, hence the same class of purchasers”); see *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this presumption in determining likelihood of confusion).

This factor supports a finding that confusion is likely.

C. Similarity or dissimilarity of the marks.

In a likelihood of confusion analysis, we compare the marks in their entireties for similarities and dissimilarities in appearance, sound, connotation, and commercial impression. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1377, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation and internal quotation marks omitted).

Applicant’s mark is



and the cited registrant’s mark is **TOYO KOHAN**.

Obviously, the marks look and sound alike and have a similar meaning to the extent they both include the term **TOYO** as the first or only word. And they differ to the extent Applicant's mark includes a diamond-shaped carrier and the cited registration includes the final word **KOHAN**. Because the cited mark is registered in standard characters, the words **TOYO KOHAN** could be displayed in any font style, size, or color, including that used by Applicant. *See Viterra*, 101 USPQ2d at 1909; *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). We accordingly consider the stylized wording in Applicant's mark to be legally identical in stylization to that in the cited registration. *Viterra*, 101 USPQ2d at 1910; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (“[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display.”).

While we recognize that Applicant's mark features a design element — a diamond-shaped carrier — we accord it relatively little weight in distinguishing the marks. It is “an ordinary geometric shape that serves as a background for the word mark,” and thus does not “offer[] sufficient distinctiveness to create a different commercial impression.” *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (considering a diamond-shaped carrier); *see also B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1508 n.23 (TTAB 2007) (“Plain geometric designs, such as the oval carrier or frame for the design of a man wearing a sombrero would not be seen by consumers as a particularly distinctive element of applicant's mark.”). In any event, when a mark consists of a literal element and a design, “the word is normally

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accorded greater weight because it would be used by purchasers to request the goods or services.” *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987). We find that to be the case here. Thus, although we do not ignore the design element in Applicant’s mark, we find that the impression of the mark is primarily that of the word **TOYO**.

We also recognize the apparent meaning of the common word **TOYO** in the marks at issue: Applicant and the registrant have inserted translation statements in the application and registration indicating that **TOYO** means “East” or “Orient.” The marks are thus similar in meaning to the extent that they both refer to East or Orient.

Finally, we consider the term **KOHAN** in the cited registration. The term is the second word in the cited mark, and is dissimilar in appearance and pronunciation to the word **TOYO** in the subject application. There is no evidence that **KOHAN** has a meaning in any language, so we assume it to be fanciful. On the other hand, it must be noted that **KOHAN** is the second word in the cited mark, while the first word in each mark is the identical term **TOYO**. The appearance of an identical term as the initial word in both marks is significant. First words are entitled to greater emphasis in comparing marks “because consumers typically notice those words first.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (citing *Palm Bay*, 73 USPQ2d at 1692). Further, although the cited registration includes the additional word **KOHAN**, given the identity of the goods at issue, purchasers are likely to believe that the registrant’s **TOYO KOHAN** mark is an extension of Applicant’s **TOYO** brand.

Applicant complains that the Examining Attorney “improperly dissected” the cited mark, *App. Br.*, 4 TTABVUE 10, and erred in not considering the geographic significance of **TOYO**. *Reply Br.*, 8 TTABVUE 7. “[I]n 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 Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). We have done just that in this case. Such analysis is not “dissection”; it is “unavoidable.” *Id.*

As noted above, **TOYO** presumably translates to East or Orient. As such, the term is vaguely suggestive of the geographic origin of Applicant’s and registrant’s goods. (The application and cited registration indicate that both Applicant and the cited registrant are Japanese corporations.) Nonetheless, there is no indication that **TOYO** is primarily geographically descriptive or deceptively misdescriptive, *see* Trademark Act Section 2(e)(2)–(3), 15 U.S.C. § 1052(e)(2)–(3), of “iron and steel.” Applicant was not required to disclaim it and the cited registration does not include a disclaimer. Moreover, there is no indication in this record that the term **TOYO** is widely used in connection with the same or similar goods. *See du Pont*, 177 USPQ at 567 (factor six: “The number and nature of similar marks in use on similar goods.”). So despite possessing some geographically suggestive meaning, we consider the common term **TOYO** to be distinctive with respect to the goods at issue. In the context of the marks as a whole, we consider it a significant, source-indicating element. It is the only literal

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element in Applicant’s mark (the design element being a common-shaped carrier), and the first element in the cited registration.

Although we recognize that the marks at issue are not identical, “where . . . the goods at issue are identical, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Viterra*, 101 USPQ2d at 1908), *cert. denied*, 139 S. Ct. 1550 (2019). When considered in their entireties, the mark **TOYO** and design is substantially similar to **TOYO KOHAN**. This factor supports a finding of likely confusion.

D. Applicant’s Prior Registrations

Applicant argues that the Examining Attorney failed to give appropriate consideration to three of Applicant’s prior registrations:

Mark	Goods	Reg. No.	Issued
	Valves and cocks. IC 06	0857355	Sept. 24, 1968
	Valves and cocks. IC 06	1197701	June 15, 1982
	Iron and steel; metal materials for building or construction, namely, soffits, fascia and metal piles; valves of metal, not being parts of machines; metal hardware, namely, pulleys, springs, nuts and washers; metal stoppers for industrial packaging containers; metal lids and caps for industrial packaging containers. IC 06 Valves or machine parts in the nature of joints for gasoline pumps for service stations; dish washing machines for industrial purposes; valves being parts of machines, not for land vehicles. IC 07 Fire alarms; gas leak alarms; anti-theft warning apparatus, namely, theft alarms, excluding anti-theft	4374195	July 30, 2013

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Mark	Goods	Reg. No.	Issued
	<p>alarms for vehicles; electric or magnetic meters and circuit testers. IC 09</p> <p>Freezing machines and apparatus, namely, freezers, commercial freezers and parts and fittings therefor; tap water faucets; level controlling valves for tanks; pipe line cocks; waste water treatment tanks for industrial purposes; septic tanks for industrial purposes; solar water heaters; water purifying apparatus; washers for water taps; household tap-water filters. IC 11.</p> <p>Non-metal and non-plastic water pipe valves; non-metal transportable greenhouses for household use. IC 19.</p> <p>Valves of plastic being other than machine parts; containers for transport, not of metal. IC 20</p> <p>Repair or maintenance of water purifying apparatus; plumbing; machinery installation; renovation, repair and maintenance of electrical wiring; installation of thermal insulating materials for buildings; repair or maintenance of air-conditioning apparatus for industrial purposes; repair or maintenance of boilers; repair or maintenance of pumps; diagnosis, repair or maintenance of valves or plumbing instruments; conversion, installation or check of valves or plumbing instruments; technical guidance or consultancy on maintenance of valves or plumbing instruments. IC 37.</p>		

As can be seen, all of Applicant’s registrations³ issued prior to the July 21, 2015, issuance of the cited intervening **TOYO KOHAN** registration, and are now more than

³ During examination, Applicant submitted a fourth registration not mentioned in its brief, Reg. No. 3302239, for **RED-WHITE TOYO** and design for “manually operated metal valves,” issued Oct. 2, 2007. Consideration of the ’239 Registration would add nothing to our decision.

five years old. Most relevant to our consideration is Applicant's '195 Registration, for essentially the same mark as in the subject application, and also identifying "iron and steel" in International Class 6.⁴ Citing the need for "[]consistent examination," *App. Br.*, 4 TTABVUE 10, Applicant argues that the subject application should be registered notwithstanding the intervening cited registration.

The Board has addressed similar arguments on several occasions. In *In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012), the Board was confronted with an "unusual situation." *Id.* at 1399. At issue was the examining attorney's refusal to register **ANYWHERE** (stylized) for "footwear" in view of a registration for **ANYWHERE BY JOSIE NATORI** and design for "jackets, shirts, pants, stretch T-tops and stoles." What made the situation unusual was that the applicant owned a registration for the virtually identical mark **ANYWHERE** (in standard characters) for, among other items, "footwear." Although the applicant's prior registration issued after the cited registration, both had been registered for more than five years. If, as the examining attorney asserted in that case, the applicant's new application for a stylized mark raised a likelihood of confusion with the cited mark and goods, it logically followed that the applicant's previous registration should not have issued, considering that the applicant's previous registration was for a nearly identical mark and identical goods. Nonetheless, the applicant's prior registration was more than five years old, and therefore could not have been challenged by the cited registrant

⁴ While the '195 Registration and Applicant's other registrations contain other goods and services, some of them possibly related to "iron and steel," consideration of them would not change our analysis.

on the ground of likelihood of confusion. In other words, refusal of the applicant's new registration would be inconsistent with issuance of its prior registration.

It is important to note that in *Strategic Partners*, the “applicant’s registration and the cited registration ha[d]” been registered for over five years. *Id.* Therefore, regardless of which party was the first to use its mark, neither could seek to cancel the other’s registration on the ground of likelihood of confusion. *See* Trademark Act Section 14(3); 15 U.S.C. § 1064(3) (permitting cancellation after five years only on enumerated grounds not including likelihood of confusion). In *Strategic Partners*, the applicant owned the intervening registration. But because that registration was over five years old, the cited registrant—the party arguably aggrieved by the applicant’s intervening registration—could not challenge the applicant’s registration, so an additional registration for essentially the same mark and goods would cause no additional harm.⁵

Likewise, in *In re Allegiance Staffing*, 115 USPQ2d 1319 (TTAB 2015), the applicant previously owned a registration for **ALLEGIANCE STAFFING**, which was inadvertently allowed to expire, and was seeking a new registration for the same mark and services. But over a number of years, six registrations for **ALLEGIS GROUP** (and variations) for similar services issued and another two were approved for publi-

⁵ But for the relief provided under the thirteenth *du Pont* factor, it is likely that the problem faced by the applicant in *Strategic Partners* would have equally vexed the cited registrant: regardless of priority, neither would have been able to register any new mark that would have been likely to cause confusion with the other’s prior registration, although neither could break the stalemate by cancelling the other’s registration based on a likelihood of confusion.

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cation all while applicant's prior registration remained valid. These intervening registrations were cited against the applicant's new application. Six of the intervening registrations were over five years old, and thus immune from cancellation on the ground of likelihood of confusion. *Id.* at 1322–23. Although the applicant's prior registration had inadvertently expired, the Board took the seemingly inconsistent intervening registrations into account as one factor⁶ in reversing the refusal to register. *Id.* at 1323–24.

A somewhat different fact pattern was presented in *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790 (TTAB 2017). In that case the first registration was issued to the cited registrant for the mark **USA HOCKEY** and design. A registration then issued to the applicant for **USA WARRIORS ICE HOCKEY NONE TOUGHER** and design. Applicant then sought another registration for a mark with the same wording and a similar design. This time, the **USA HOCKEY** registration was cited as a bar to registration of the applicant's second mark. As in *Strategic Partners*, the applicant argued that the issuance of its own intervening registration supported its right to a second similar registration. But unlike the case in *Strategic Partners*, the applicant's intervening registration in *USA Warriors* was less than five years old:

This is significant not only because it is less time, but because the five-year milestone carries added weight because of its legal significance under the Lanham Act: it means

⁶ The Board also cited “the differences in the meaning and commercial impression of the marks [and] the degree of care exercised by consumers” as grounds for reversal. *Allegiance Staffing*, 115 USPQ2d at 1323. The Board did not discuss the weight it assigned to the relevant *du Pont* factors.

that Applicant's registration, issued May 7, 2013, is still subject to a cancellation action by Registrant based on likelihood of confusion. This represents a key factual distinction from *Strategic Partners*. See Section 14 of the Trademark Act, 15 U.S.C. 1064.

USA Warriors, 122 USPQ2d at 1793. While the Board found that the applicant's prior intervening registration was "a relevant consideration, it [did] not outweigh the other *du Pont* factors." *Id.*

In the case at bar, the facts are more similar to those in *USA Warriors* than they are to *Strategic Partners* or *Allegiance Staffing* in that the cited intervening registration is less than five years old. Applicant thus has a remedy available: if it wishes, it can seek to cancel the cited intervening registration in whole or in part,⁷ thus removing it as a bar to registration.

While we realize that a cancellation proceeding would impose a burden on Applicant, it would be preferable to registering marks when confusion would otherwise be likely. *In re Thomas*, 79 USPQ2d 1021 (TTAB 2006) ("we will not compound the problem of the registration of a confusingly similar mark by permitting such a mark to register again"). The Trademark Act provides *ex parte* examination as the primary means of determining registrability, but also provides for oppositions and cancellations as "a backstop for the examination process," "to remedy oversight or error," *Viterra*, 101 USPQ2d at 1910 (quoting *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d

⁷ As indicated, the Examining Attorney has asserted the cited registration as a bar to Applicant's registration only to the extent it includes the goods "iron and steel." We express no opinion as to the appropriate scope of any cancellation proceeding that might be brought. Moreover, any finding of fact or conclusion of law in this opinion is not binding on the Board in any such proceeding, which must be based on evidence and argument submitted pursuant to the rules governing *inter partes* proceedings.

1687, 1691 (Fed. Cir. 1993)); *see also* J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 20:2, 20:40 (5th ed. Sept. 2019 update), arguably the very situation in the case before us. The statutory scheme thus recognizes that examination may not be perfect, and provides remedies for those who may be damaged by the registration of a mark, *see* Trademark Act §§ 13–14, to oppose or petition to cancel as appropriate. It is true that the statute does not **require** any party to oppose or petition to cancel the registration of a potentially conflicting mark, although consequences may flow from the failure to do so. Whatever may be said about the intervening registration, it is presumptively valid, *see* Trademark Act § 7(b) (registration as prima facie evidence of validity). Although “a prima facie presumption of validity may be rebutted . . . , the present *ex parte* proceeding is not the proper forum for such a challenge.” *Dixie Rests.*, 41 USPQ2d at 1534.

Here, Applicant essentially asks us to ignore a presumptively valid registration that would otherwise give rise to a finding of likely confusion. The cited registrant is not a party to this proceeding nor is the validity of its registration before us. Nonetheless, and unlike the case in *Strategic Partners*, Applicant possesses the means to challenge the propriety of the cited registration. If successful, Applicant would eliminate a barrier to registration of its applied-for mark on “iron and steel.”

While we have considered Applicant’s prior registration and the intervening cited registration, we do not find this situation as compelling as that in *Strategic Partners* or *Allegiance Staffing*. As we found in *USA Warriors*, while the “co-existence of Applicant’s prior registration and the cited registration is a relevant consideration, it

does not outweigh the other *du Pont* factors in this case.” *USA Warriors*, 122 USPQ2d at 1793. “[T]o hold otherwise would essentially give binding effect to the decision of a Trademark Examining Attorney in granting Applicant’s prior registration. Neither the Board nor any Trademark Examining Attorney is bound by decisions of Examining Attorneys to register prior marks.” *Id.* at 1793 n.10; *cf. In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to Nett Designs’ application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”).

III. Conclusion

Having considered all of the evidence and argument of record, we find that Applicant’s goods at issue — “iron and steel” are identical to goods in the cited registration. We further find that those goods move in the same channels of trade and to the same purchasers. Although the marks at issue are not identical, they are substantially similar. These factors all support a finding that confusion is likely. Finally, while we have taken Applicant’s prior registrations into consideration, we do not find them to merit a different result.

Decision: The refusal to register under Trademark Act § 2(d) is **affirmed** as to “iron and steel” in International Class 6. The Application will proceed to registration amended as follows:

- International Class 6 should be amended by deleting “Iron and steel;” and capitalizing “Metal”:

~~Iron and steel; m~~ Metal valves with actuators, not including machine elements; valves of metal, not including machine elements; metal strainers for filtering liquid in pipes,

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namely, cast iron strainers, bronze strainers, ductile strainers and stainless steel strainers used in the commercial preparation of industrial water, air-conditioning equipment, foods, beverages, dairy products, pharmaceuticals and drugs.

- International Class 7 remains unchanged.