

This Opinion is not a
Precedent of the TTAB

Mailed: February 23, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Tenax S.p.A.

v.

Wuhan Keda Marble Protective Materials Co., Ltd.

—
Opposition No. 91213895
Opposition No. 91224663
—

Michele S. Katz of Advitam IP LLC for Tenax S.p.A

P. Jay Hines of Muncy Geissler Olds and Lowe PC for Wuhan Keda Marble
Protective Materials Co., Ltd.

—
Before Cataldo, Shaw and Goodman,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Wuhan Keda Marble Protective Materials Co., Ltd. (“Applicant”) filed applications to register the marks TEENIAX (in standard characters) for the following International Class 1 goods:

Application Serial No. 86266726:

Adhesives and glues for industrial and commercial use;
Adhesives for industrial purposes; Adhesives for wall tiles;

Agglutinants for concrete; Chemical products for preventing scale; Industrial gluing agents; Preparations for fortifying plants; Unprocessed epoxy resin; Waterproofing chemical compositions¹;

Application Serial No. 85887343:²

This application covers the same goods listed above as well as the following:

Waterproofing chemical compositions for articles of leather.

Application Serial No. 86626147:³

This application covers the same goods listed in the two applications above as well as the following:

Adhesives for floor, ceiling and wall tiles; Chemical additives for use as binding agents in concrete, feed pellets; Chemical compounds for curing concrete; Concrete additives; Concrete admixtures; Epoxy glue for general bonding and repair purposes; Industrial gluing agents; Scale removing preparations, other than for household purposes; Waterproofing chemical compositions for articles of fabric; Waterproofing chemical compositions for articles of masonry, wood and other building and/or construction surfaces; Waterproofing membranes in liquid chemical form for use in construction.

¹ Application Serial No. 86266726 was filed on April 30, 2014, based upon Applicant's allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act. The wording "TEENIAX" has no meaning in a foreign language. This application is the subject of Opposition No. 91224663.

² Application Serial No. 85887343 was filed on March 27, 2013, under Section 1(a) alleging a date of first use of June 1, 2004, and a date of first use in commerce of June 5, 2005. The wording "TEENIAX" has no meaning in a foreign language. This application is the subject of Opposition No. 91213895.

³ Application Serial No. 86626147 was filed on May 12, 2015, based upon Applicant's allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act. The wording "TEENIAX" has no meaning in a foreign language. This application is the subject of Opposition No. 91224663.

Tenax S.p.A (“Opposer”) opposes registration of Applicant’s TEENIAX marks on the ground of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).⁴ Opposer has pleaded ownership of the previously used and registered mark TENAX (typed drawing)⁵ in Opposition Nos. 91213895 (‘895) and 91224663 (‘663) for the following goods:

Adhesives for use in the gravestone sector, namely for marble, granite, natural stones, marble and granite powder agglomerates, porcelain stoneware; unprocessed synthetic and artificial epoxy resins for use in the gravestone sector, namely for marble, granite, natural stones, marble and granite powder agglomerates, porcelain stoneware in International Class 1;

Waxes for polishing stones, ceramics and the like in International Class 3;

Machine parts, namely blades, blades for power saws, blades with diamond coated segments, grindstones; power-operated segments and discs with diamond coated segments for planning, polishing and cutting stones, ceramics and the like in International Class 7.⁶

Opposer has also pleaded the registration TENAX (typed drawing) in Opposition No. 91213895 for the following goods:

⁴ In Opposition No. 91213895, the notice of opposition also references a possible claim of dilution under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). However, this claim was not sufficiently pleaded. Opposer did not plead that its mark was famous before the first use of Applicant’s mark. Moreover, Opposer did not pursue this claim in its brief. In view thereof, we consider any possible dilution claim to have been waived.

⁵ Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. § 2.52, was amended to replace the term “typed” drawing with “standard character” drawing. A mark depicted as a typed drawing is the legal equivalent of a standard character mark. *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1236 n.5 (TTAB 2015) (citing Trademark Manual of Examining Procedure § 807.03(i)).

⁶ Registration No. 2591547, issued July 9, 2002; renewed.

Machine parts, namely, abrasive blocks for polishing machines of lapidary materials in International Class 7.⁷

Applicant filed answers denying the salient allegations in the notices of opposition.

In each opposition, each party filed a trial brief and Opposer filed a reply brief.

Because the oppositions involve the same issues and nearly identical records, we hereby consolidate them and issue a single opinion for both oppositions. Citations to the record are to Opposition No. 91213895, unless otherwise noted.⁸

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of the involved applications. In addition, Opposer introduced a notice of reliance upon Applicant's interrogatory and document responses in Opposition No. 91213895, a notice of reliance upon Applicant's responses to interrogatory requests, document requests, and requests for admissions in Opposition No. 91224663, notices of reliance upon Internet documents in Opposition Nos. 91213895 and 91224663⁹, and in both oppositions, the declaration testimony of Andrea Barbieri, Operative Coordinator of Tenax Group, Stefano Fioratti, General

⁷ Registration No. 2290107 issued November 2, 1999; renewed.

⁸ References to the briefs and the record refer to the Board's TTABVUE docket system.

⁹ The product catalogs that are duplicative of exhibits to Opposer's declaration testimony are superfluous. *Entex Indus., Inc. v. Milton Bradley Co.* 213 USPQ 1116, 1117 n.1 (TTAB 1982). The Internet web page evidence lacking a URL and product catalogs (or pages) that lack a date of publication have not been considered. Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2); *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). With its notice of reliance, it appears Applicant provided some of these same webpages, translated, and properly authenticated by containing a URL and date.

Manager of Tenax Group and General Manager of Tenax S.p.A., Tatiana Savoia, Marketing Coordinator of Tenax Group, and Filippo Emanuel, General Manager of Tenax U.S.A.¹⁰ Applicant, in both oppositions, introduced a notice of reliance upon Internet documents and the affidavit testimony of Du Kunwu, General Manager of Applicant.

II. Standing

Opposer has properly made its pleaded registrations of record by submitting certified copies by way of notice of reliance.¹¹ Trademark Rule 2.122(d)(1)-(2), 37 C.F.R. §§ 2.122(d)(1)-(2). In view thereof, we find Opposer has established its personal interest in this proceeding and proven its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lincoln Nat'l Corp. v. Anderson*, 110 USPQ2d 1271, 1274 (TTAB 2014). *See also Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

III. Priority

Because Opposer has made its pleaded registrations of record and shown they are valid and subsisting, priority is not an issue in this case as to the TENAX marks for the goods recited in those registrations.¹² *King Candy, Inc. v. Eunice King's Kitchen*,

¹⁰ Tenax U.S.A. is a partially-owned subsidiary to Tenax Group. The exact relationship between Tenax S.p.A. and Tenax Group has not been explained by any of Opposer's declarants.

¹¹ '895 Opposition, 45 TTABVUE 6-11; '663 Opposition. 17 TTABVUE 6-11.

¹² '895 Opposition, 45 TTABVUE 6-11; '663 Opposition. 17 TTABVUE 6-11.

Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Applicant states in its briefs that it does not contest priority.¹³

IV. Likelihood of Confusion

We now turn our attention to the likelihood of confusion analysis. We consider Opposer's pleaded registered marks vis-à-vis the marks in the involved applications. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014). In our analysis we will focus on Opposer's registered mark and the class of goods which can be considered closest to the goods in the subject applications, namely Registration No. 2591547 and its International Class 1 goods. *Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 USPQ2d 1913, 1917 (TTAB 2015).

Our determination under Trademark Act Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence.

A. Similarity of the Marks

As to the first *du Pont* factor, "similarity or dissimilarity of the marks," we analyze "the marks in their entirety as to appearance, sound, connotation and commercial impression." *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) quoting *In re E.I. du Pont*, 177 USPQ at 567. See also *Palm Bay Imports Inc. v.*

¹³ '895 Opposition, 55 TTABVUE 7; '663 Opposition, 23 TTABVUE 7.

Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *In re E.I. du Pont*, 177 USPQ at 567). “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, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Applicant’s mark is TEENIAX and Opposer’s mark is TENAX. While acknowledging the differences in the marks *i.e.*, the additional vowels “E” and “I” in Applicant’s mark, we find that the visual similarities outweigh these differences. Both marks are similarly constructed, having “TE” as the first two letters, “AX” as the last two letters, and the letter “N” in the middle. Consumers viewing the marks could easily overlook the additional “E” and the “I” in Applicant’s marks.

As to sound, there is no correct pronunciation of a trademark. *See In re Belgrade Shoe*, 411 F.2d 1352, 162 USPQ 227, 227 (CCPA 1969). The marks are capable of being pronounced so as to sound similar, with consumers pronouncing the letters “TE” in Opposer’s mark and the letters “TEE” in applicant’s mark with a long “E”

sound.¹⁴ Although Applicant argues that the marks differ in pronunciation because Applicant's mark is three syllables,¹⁵ while Opposer's mark is two syllables, consumers could easily overlook the letter "T" which precedes "AX" in Applicant's mark by not articulating that vowel as a long "E" sound when pronouncing the mark.

As to meaning, Opposer has stated in its briefs that its TENAX mark is an "arbitrary construction in the English language with no inherent meaning,"¹⁶ while according to Applicant's testimony,¹⁷ TEENIAX is coined word.¹⁸ We would have to assume that most consumers would view both of these marks as being coined and would not be able to create a distinction based upon any clear difference in meanings. Given the similarities in sound and appearance, the marks engender similar overall commercial impressions.

We find the marks as a whole are more similar than dissimilar, and this *du Pont* factor weighs in favor of a finding of a likelihood of confusion. *See, e.g. Hercules Inc. v. Nat'l Patent Dev. Corp.*, 524 F.2d 1227, 187 USPQ 668 (CCPA 1975) (HYDROLYN and HYDRON similar); *Russell Chem. Co. v. Wyandotte Chem. Corp.*, 337 F.2d 660, 143 USPQ 252 (CCPA 1964) (SENTOL and SENTROL similar); *Blansett Pharmacal*

¹⁴ Applicant acknowledges that Opposer's mark could be pronounced "te-nax" or as "ten-ax" 55 TTABVUE 8 ('895 Opposition); 23 TTABVUE 9 ('663 Opposition).

¹⁵ Applicant submits that its mark could be pronounced either "tee-ni-ax" or "tee-ni-ax". *Id.*

¹⁶ 54 TTABVUE 21.

¹⁷ 49 TTABVUE 39, Declaration of Du Kunwu.

¹⁸ According to Applicant's testimony, Applicant's mark is derived from TENICE, itself a coined term. TENICE is a combination of the English transliteration "TE" and the English word "Nice" and means "specially good" or "very good." 42 TTABVUE 39, Declaration of Du Kunwu.

Co. v. Carmrick Labs., Inc., 25 USPQ2d 1473 (TTAB 1992) (NALEX and NOLEX similar); *Haveg Indus., Inc. v. Shell Oil Co.*, 199 USPQ 618 (TTAB 1978) (ELEXAR and EXAR similar).

B. Scope of Protection

Applicant argues without evidentiary support that Opposer's mark should be afforded a narrow scope of protection because it is conceptually weak and commercially weak.¹⁹ Opposer, on the other hand, argues that its mark is entitled to broad protection because TENAX is "arbitrary and inherently distinctive."²⁰ We find Opposer's TENAX mark is a coined term, and as Opposer has not argued that its TENAX mark is well-known or famous, it is entitled to the normal scope of protection we accord an inherently distinctive mark. We find the sixth *du Pont* factor to be neutral.

C. Similarity of the Goods

We next consider the *du Pont* factors regarding the similarity or dissimilarity of the parties' respective goods. In comparing the goods, the issue is not whether purchasers would confuse Applicant's and Opposer's goods, but rather whether there is a likelihood of confusion as to the source of those goods. *In re Cook Medical Tech. LLC*, 105 USPQ2d 1377, 1380 (TTAB 2012); *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989); *In re Rexel Inc.*, 223 USPQ 830, 831

¹⁹ Applicant has not provided any evidence of TENAX third-party registrations or use of TENAX in the marketplace.

²⁰ '895 Opposition, 54 TTABVUE 21; '663 Opposition, 22 TTABVUE 22.

(TTAB 1984). It is not necessary that the goods be identical or even competitive in nature in order to support a finding of likelihood of confusion. The goods need only be “related in some manner or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

On the face of the respective identifications of goods themselves, some of the goods clearly are related or encompassing of one another. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (Board must compare the goods as described in the application and registration). Specifically, Opposer’s “adhesives” are for use in the “gravestone sector” field of use and Applicant’s are for “commercial use,” which could include the gravestone sector. Moreover, Applicant’s “unprocessed epoxy resin” in the involved applications encompasses Opposer’s more narrowly identified “unprocessed synthetic and artificial epoxy resins ...for use in the gravestone sector, namely for marble, granite, natural stones, marble and granite powder agglomerates, porcelain[ed] stoneware.” Thus, we find that Applicant’s goods are, at least in part, overlapping with Opposer’s goods. The fact that Applicant’s identification includes other goods does not obviate the relatedness of the legally identical goods. *See, e.g., Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981). This *du Pont* factor weighs in favor of Opposer.

D. Channels of Trade

As to trade channels, there are no restrictions with regard to the goods in pleaded Registration No. 2591547 and the involved applications, and we must presume that they move in all normal and usual channels of trade and methods of distribution for those goods and that they are available for purchase by all the usual purchasers. *See Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). With regard to the partially overlapping goods of Applicant and Opposer, *i.e.*, adhesives and unprocessed epoxy resin, we may presume that the channels of trade and classes of purchasers are at least in part the same. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) (“Given the in-part identical and in-part related nature of the parties’ goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade”).²¹ We find this *du Pont* factor weighs in favor of finding a likelihood of confusion.

E. Extent of Concurrent Use and Actual Confusion

In its brief and through its testimony,²² Applicant has asserted that it is not aware of any instances of actual confusion. However, uncorroborated statements of no known instances of actual confusion are of little evidentiary value. *In re Majestic*

²¹ While this restriction is not reflected in the identification of goods, in Serial No. 85887343, Applicant indicates its end users are construction companies and individuals. 45 TTABVUE 19, 26, 27.

²² 49 TTABVUE 40, Declaration of Du Kunwu.

Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). Further, we note that for Serial Nos. 86626147 and 86266726, there has presumably been no opportunity for confusion to occur, if it was likely to occur, as Applicant filed these applications under intent to use the mark in commerce, rather than actual use. Applicant also has stated in its discovery responses that there have been no sales, distribution or promotion in the United States with regard to the TEENIAX mark and the identified goods in the intent-to-use applications.²³ As to Serial No. 85887343, Applicant has stated that the TEENIAX mark has been in use in the United States since 2005 with direct sales to construction material suppliers and trading companies.²⁴ We find on this record, there is no meaningful way to gauge the absence of actual confusion given the fact that we do not know the extent of Applicant's use with regard to Serial No. 85887343. In any event, the applicable test here is likelihood of confusion, not actual confusion, and, as often stated, it is unnecessary to show actual confusion in establishing likelihood of confusion. *Herbko Int'l, Inc. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002). We find these *du Pont* factors neutral.

F. Market Interface

Applicant asserts that the *du Pont* factor regarding market interface is in its favor, as it has registered its mark in Singapore, Phillipines, Mongolia, Argentina, Cambodia, Laos, and Russia and prevailed in oppositions involving Opposer in China,

²³ '663 Opposition, 17 TTABVUE 16, 17.

²⁴ '895 Opposition, 45 TTABVUE 16, 19, 26.

Vietnam, Thailand, Indonesia, Brazil, Malaysia, India and Hong Kong. However, registration of Applicant's mark outside the United States is not relevant for purposes of our determination as registration in a foreign country does not ensure eligibility for registration in the United States. *In re Rath*, 402 F.3d 1207, 74 USPQ2d 1174, 1179 (Fed. Cir. 2005); *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612 (TTAB 1991). We find this *du Pont* factor to be neutral.

G. Good Faith Adoption

Applicant argues that it adopted its mark in good faith. However, it is settled that while evidence of bad faith adoption typically will weigh against an applicant, good faith adoption typically does not aid an applicant attempting to establish no likelihood of confusion. *See J & J Snack Foods Corp. v. McDonald's Corp.*, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). Thus, this *du Pont* factor also is neutral.

VII. Conclusion

We have considered all of the evidence pertaining to the relevant *du Pont* factors, as well as the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion). In balancing the relevant *du Pont* factors, we conclude that the similarity of the marks, the similarity of the goods, and the overlapping trade channels and classes of purchasers favor a likelihood of confusion with the goods identified in Registration No. 2591547.²⁵

²⁵ To the extent that any other *du Pont* factors for which no evidence or argument was presented may be applicable, we treat them as neutral. With regard to Opposition No. 91213895, we need not consider the issue of likelihood of confusion with respect to Opposer's pleaded Registration No. 2290107 in view of our finding of likelihood of confusion with respect

Decision: Opposition Nos. 91213895 and 91224663 are sustained on the basis of likelihood of confusion with the mark in Registration No. 2591547, and registration to Applicant's application Serial Nos. 85887343, 86266726 and 86626147 is refused.

to Registration No. 2591547. *See, e.g., See Multisorb Techs., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1243 (TTAB 2010).