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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Weatherford Technology Holdings, LLC

Serial No. 88371629

David W. Carstens of Carstens & Cahoon, LLP,
for Weatherford Technology Holdings, LLC.

Lyal L. Fox III, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

Before Wellington, Lynch, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Weatherford Technology Holdings, LLC (“Applicant”) seeks registration on the Principal Register of the standard character mark VICTUS for goods that it proposes to identify as

Oilfield system for managing annulus pressure during land based and sea based drilling operations, namely, managed pressure drilling manifolds designed to manage bottom hole pressure; Coriolis flow meters; manifolds; chokes; electric and hydraulic valves; fluid extraction systems designed to continuously extract mud samples for gas composition analysis; junk catchers; control systems designed to manage wellbore pressure changes and provide early kick and loss detection; automated managed drilling

pressure riser system designed for floating drilling vessels; below tension-ring rotating control devices; valves; reeler; hydraulic sheave; volume trap system; robotic arm; connection hub designed for integration of subsea control umbilical and flow lines for easy connect; follow-spool sensors; annular isolation devices; subsea surveillance system; and integrated rig equipment designed to detect, control, and circulate out influxes, in International Class 7;

and services that it proposes to identify as

Oilfield drilling services for managing annulus pressure during land based and sea based drilling operations, namely, developing managed drilling pressure plans and drilling strategies; optimizing drilling performance by providing early detection and precision control of unexpected influxes, maintaining constant bottomhole pressure, minimize formation damage and maintain wellbore integrity, and minimizing nonproductive time; liner running; cementing operations; assisting with contingency plans and procedures; supervising rigsite; training third parties; integrating rig equipment for machine-to-machine communications, real-time analysis of downhole conditions, and facilitate rapid automated responses to annulus pressure changes during drilling operations; managing riser gases, in International Class 37.¹

The Trademark Examining Attorney has refused registration of Applicant's mark for two different reasons. First, the Examining Attorney argues under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), that Applicant's mark so resembles the registered standard character mark VECTUS for goods identified as

Machinery used for recovering and obtaining oil and gas; hydraulic motors, pumps and valve actuators; pressure controls and regulators being parts of machines; subsea control systems, namely power and communication

¹ Application Serial No. 88371629 was filed on April 4, 2019 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's allegation of a bona fide intention to use the mark in commerce.

systems which provide hydraulic, electrical or electrohydraulic control and monitoring for production equipment comprised primarily of hydraulic controls for machines, valves for pumps, valves being parts of machines and also comprised of subsea control modules comprised of remote controls for subsea production equipment, apparatus for recording transmission, processing and production of data in the nature of subsea control module communication distribution units and automatic control valves, in International Class 7; and

Communication and control systems comprised of computer hardware and software for machines; communication systems for transferring data for subsea oil and gas networks comprised of computer hardware, software, modems and communication cables; monitoring and control systems comprised of computer hardware and software for offshore and subsea operations including hydrocarbon extraction; subsea control systems comprised of electrical power units, electric control panels; electronic control systems for underwater machines; computer software systems and software for offshore and subsea operations, in International Class 9;

and services identified as

Monitoring of performance and condition of offshore and subsea installations, components and environment for quality control purposes and to ensure proper functioning, in International Class 42;²

as to be likely, when used in connection with the goods and services identified in Applicant's application, to cause confusion, to cause mistake, or to deceive.

Second, the Examining Attorney argues that there are several deficiencies in Applicant's identification of goods and services, in its current proposed form and in previous iterations. He argues that it is indefinite and overly broad, in violation of Trademark Rule 2.32(a)(6), 37 C.F.R. § 2.32(a)(6), that Applicant's amendments to its

² The cited Registration No. 5024428 issued on August 23, 2016.

original identification exceeded its scope, in violation of Trademark Rule 2.71(a), 37 C.F.R. § 2.71(a), and that Applicant has failed to clarify the number of classes in which it sought registration and failed to satisfy the requirements for a multi-class application.

When the Examining Attorney made the refusals final, Applicant appealed and requested reconsideration, which was denied. Applicant and the Examining Attorney have filed briefs.³ We affirm both refusals to register.

I. Record on Appeal⁴

The record on appeal includes the following:

- USPTO electronic records regarding the cited registration, made of record by the Examining Attorney,⁵ and Applicant;⁶
- Pages from the MERRIAM-WEBSTER DICTIONARY showing no entries for the words “victus” and “vectus,” made of record by the Examining Attorney,⁷ definitions of “victus” and “vectus” from LATDICT, made of record by Applicant,⁸ a page from ACRONYM FINDER regarding the meanings of “vic,”

³ Citations in this opinion to the briefs refer to TTABVUE, the Board’s online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear.

⁴ Citations in this opinion to the application record, including the request for reconsideration and its denial, are to pages in the Trademark Status & Document Retrieval (“TSDR”) database of the United States Patent and Trademark Office (“USPTO”).

⁵ June 17, 2019 Office Action at TSDR 2-4.

⁶ December 17, 2019 Response to Office Action at TSDR 24-25.

⁷ June 17, 2019 Office Action at TSDR 5-6.

⁸ December 17, 2019 Response to Office Action at TSDR 26-27.

made of record by Applicant,⁹ and definitions of the word “victor,” “vector,” and “monitor” from dictionary.com, and the word “manage” from the MERRIAM-WEBSTER DICTIONARY, made of record by Applicant;¹⁰

- Pages from ALL ABOUT LEARNING PRESS and pronuncian.com discussing the pronunciation of the short “i” and the short “e” in American English, made of record by the Examining Attorney,¹¹ and Applicant;¹²
- Internet webpages regarding the goods and services identified in the application and cited registration, made of record by the Examining Attorney;¹³
- The declaration of James Kurka (“Kurka Decl.”), Applicant’s Senior Counsel, Intellectual Property, regarding Applicant’s goods and services, customers, and purchase process, made of record by Applicant;¹⁴ and
- Pages from Applicant’s website and the cited registrant’s website, and a press release issued by Applicant, made of record by Applicant.¹⁵

⁹ July 2, 2020 Request for Reconsideration at TSDR 15.

¹⁰ *Id.* at TSDR 16, 18, 20, 21.

¹¹ January 6, 2020 Final Office Action at TSDR 2.

¹² July 2, 2020 Request for Reconsideration at TSDR 17, 19.

¹³ June 17, 2019 Office Action at TSDR 7-15; January 6, 2020 Final Office Action at TSDR 3-48.

¹⁴ December 17, 2019 Response to Office Action at TSDR 10-11; July 2, 2020 Request for Reconsideration at TSDR 13-14. It was unnecessary for Applicant to submit the Kurka Declaration twice. We will cite the Kurka Declaration by paragraph number (i.e., “Kurka Decl. ¶ 6”).

¹⁵ December 17, 2019 Response to Office Action at TSDR 12-23; July 2, 2020 Request for Reconsideration at TSDR 22-53.

II. Prosecution History

We summarize the application's prosecution history because it provides necessary background to our analysis of the issues on appeal.

When Applicant filed its application, it identified its Class 7 goods as an "Oilfield system for managing annulus pressure during drilling operations" and its Class 37 services as "Oilfield drilling services, namely managing annulus pressure during drilling operations" (the "Original Identification").¹⁶ In the First Office Action, the Examining Attorney (1) cited the registration of VECTUS as a bar to registration under Section 2(d), (2) found the Class 7 Original Identification to be indefinite and overly broad, and required Applicant to clarify its goods by describing the nature, purpose, or use of the "system" and listing its primary parts or components,¹⁷ and (3) found the Class 37 Original Identification of services to be indefinite and overly broad, and required Applicant to clarify its services,¹⁸ and to clarify the classes in which it sought registration.¹⁹ The Examining Attorney noted that in amending Applicant's identification, Applicant could not broaden the identification of its goods or services beyond those in the Original Identification.²⁰

Applicant responded by arguing against the Section 2(d) refusal and proposing to amend the Original Identification of goods to "Oilfield system for managing annulus

¹⁶ April 4, 2019 Application at TSDR 1.

¹⁷ June 17, 2019 Office Action at TSDR 1.

¹⁸ *Id.*

¹⁹ *Id.*

²⁰ *Id.*

pressure during drilling operations comprised of integrated rig equipment designed to detect, control, and circulate out influxes” and the Original Identification of services to “Oilfield drilling services, namely, rig equipment integration, real-time analysis, and facilitate [sic] rapid automated responses to manage annulus pressure during drilling operations” (the “First Proposed Amended Identification”).²¹ Applicant argued that the proposed amendments obviated the identification issues and the need to specify the classes in which Applicant sought registration.²²

The Examining Attorney was not persuaded and issued a Final Office Action on the Section 2(d) refusal and the identification issues. He maintained that the First Proposed Amended Identification was unacceptable because it too was overly broad and indefinite, and identified goods and services that were potentially in additional classes.²³ He suggested several possible amendments to the First Proposed Amended Identification, including possible reclassification of the goods and services, and again reminded Applicant that it could not broaden the identification of its goods or services beyond that in the Original Identification.²⁴

Applicant requested reconsideration, and proposed to amend its identification as set forth at the outset of this opinion (the “Second Proposed Amended Identification”).²⁵ The Examining Attorney denied the request, finding that the

²¹ December 17, 2019 Response to Office Action at TSDR 1.

²² *Id.* at TSDR 8.

²³ January 6, 2020 Final Office Action at TSDR 1.

²⁴ *Id.*

²⁵ July 2, 2020 Request for Reconsideration at TSDR 1.

Second Proposed Amended Identification also exceeded the scope of the Original Identification, and remained indefinite and overly broad.²⁶ The Examining Attorney also maintained the Section 2(d) refusal.²⁷

III. Analysis of Refusals

A. Acceptability of Identifications of Goods and Services²⁸

“Every applicant must provide ‘[a] list of the particular goods or services on or in connection with which the applicant uses or intends to use the mark.’” *In re tapio GmbH*, 2020 USPQ2d11387, *6 (TTAB 2020) (quoting Trademark Rule 2.32(a)(6), 37 C.F.R. § 2.32(a)(6)). As the Board recently explained in *tapio*,

An identification that fails to enumerate the goods and services with specificity is indefinite, either because the nature of the goods or services is not clear, or because the wording is so broad that it may include goods or services in more than one class. Clarity in the identification of goods and services is crucial to the USPTO's public notice function, so it “has discretion to determine whether and how a trademark registration should include a more particularized statement of the goods for which the mark is [to] be used” *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541, 1544 (Fed. Cir. 2007). For goods or services that do not have common names, the applicant should use clear and succinct language that is understandable to the average person, and such language must specifically

²⁶ July 14, 2020 Denial of Request for Reconsideration at TSDR 1.

²⁷ *Id.*

²⁸ It is regrettable that the record does not reflect any attempt at verbal communication between Applicant and the Examining Attorney to discuss the identification issues in an effort to negotiate an acceptable identification. The examination of the application afforded ample opportunity for dialog between Applicant and the Examination Attorney, including regarding the technical terms used in Applicant's business, which might have resulted in compromise language to obviate these issues and better informed the likelihood of confusion analysis.

identify the goods and services in order to provide notice to the public of the scope of rights claimed by an applicant.

Id.

When an applicant amends an identification that does not meet these standards, “[u]nder Trademark Rule 2.71(a), 37 C.F.R. § 2.71(a), ‘[t]he applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services’” *Id.* at *7 (quoting *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1770 (TTAB 2016) (internal quotation omitted)).

Applicant focuses its entire argument on the identification issues pertaining to the Second Proposed Amended Identification, which it characterizes as the “present identification of Applicant’s goods and services,” 6 TTABVUE 5,²⁹ and which we set forth again below for ease of reference in following our analysis:

Oilfield system for managing annulus pressure during land based and sea based drilling operations, namely, managed pressure drilling manifolds designed to manage bottom hole pressure; Coriolis flow meters; manifolds; chokes; electric and hydraulic valves; fluid extraction systems designed to continuously extract mud samples for gas composition analysis; junk catchers; control systems designed to manage wellbore pressure changes and provide early kick and loss detection; automated managed drilling pressure riser system designed for floating drilling vessels; below tension-ring rotating control devices; valves; reeler; hydraulic sheave; volume trap system; robotic arm; connection hub designed for integration of subsea control umbilical and flow lines for easy connect; follow-spool sensors; annular isolation devices; subsea surveillance

²⁹ The Examining Attorney similarly focuses on the Second Proposed Amended Identification, 8 TTABVUE 5-15, although in the course of his argument, he explains why he rejected the Original Identification and First Proposed Amended Identification as well. *Id.* at 8-10. We may consider the acceptability of those identifications, *tapio*, 2020 USPQ2d 11387 at *6-8, and we agree with the Examining Attorney that they too are unacceptable as overbroad and indefinite for the reasons set forth by the Examining Attorney in his brief. 8 TTABVUE 8-10.

system; and integrated rig equipment designed to detect, control, and circulate out influxes,

and

Oilfield drilling services for managing annulus pressure during land based and sea based drilling operations, namely, developing managed drilling pressure plans and drilling strategies; optimizing drilling performance by providing early detection and precision control of unexpected influxes, maintaining constant bottomhole pressure, minimize formation damage and maintain wellbore integrity, and minimizing nonproductive time; liner running; cementing operations; assisting with contingency plans and procedures; supervising rigsite; training third parties; integrating rig equipment for machine-to-machine communications, real-time analysis of downhole conditions, and facilitate rapid automated responses to annulus pressure changes during drilling operations; managing riser gases.

Id. at 5-10.

The Second Proposed Amended Identification clearly exceeds the scope of the Original Identification. We agree with the Examining Attorney that the Second Proposed Amended Identification “contain[s] numerous new goods and services not include[d] in the original identification.” 8 TTABVUE 10. In the Second Proposed Amended Identification, the additional goods, such as “Coriolis flow meters; manifolds; chokes; electric and hydraulic valves,” and the additional services, such as “assisting with contingency plans and procedures; supervising rigsite; training third parties,” are separated from the rest of the identification by semicolons, and “[u]nder standard examination practice, a semicolon is used to separate distinct categories of goods or services.” *In re Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1166 (TTAB 2013). *See also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”)

Section 1402.01(a) (Oct. 2018) (“Semicolons should generally be used to separate distinct categories of goods or services within a single class.”).

Applicant originally sought registration of its mark for Class 7 goods identified as an “oilfield system for managing annulus pressure during drilling operations,” an identification which under standard examining practice requires a listing of the “primary parts or components of the system” to be sufficiently specific. TMEP Section 1401.05(d). But in the Second Proposed Amended Identification of goods, the multiple additional goods are not listed as “primary parts or components of the system,” but rather are separated by semicolons from the goods identified as an “Oilfield system for managing annulus pressure during land based and sea based drilling operations, namely, managed pressure drilling manifolds designed to manage bottom hole pressure.” The Second Proposed Amended Identification of goods thus exceeds the scope of both of its predecessors, in violation of Trademark Rule 2.71(a).³⁰

With respect to the Class 37 services in the Second Proposed Amended Identification, numerous discrete services similarly have been separated by semicolons from the language “Oilfield drilling services for managing annulus pressure during land based and sea based drilling operations, namely, developing managed drilling pressure plans and drilling strategies.” These discrete services exceed the scope of the Original Identification of services, “Oilfield drilling services, namely managing annulus pressure during drilling operations,” and the Second

³⁰ Applicant is, of course, free to seek registration of its mark for any discrete goods that it sells, or for a system in which the “primary parts or components of the system” are properly identified, but it cannot do both in the same application.

Proposed Amended Identification of services thus also exceeds the scope of both of its predecessors, in violation of Trademark Rule 2.71(a).³¹

Because in both classes, the Second Proposed Amended Identification exceeds the scope of the goods and services identified in Applicant's Original Identification, we affirm the refusal to register on that ground.

B. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of the likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Two key *DuPont* factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because the "fundamental inquiry mandated by § 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

³¹ As with its goods, Applicant is free to seek registration of its mark for any discrete services that it renders.

24, 29 (CCPA 1976). Applicant addresses these key factors, 6 TTABVUE 13-19, as well as the sophistication of the purchasers of the involved goods and services, *id.* at 10-13, which implicates the fourth *DuPont* factor, the “conditions under which and buyers to whom sales are made, i.e. ‘impulse vs. careful, sophisticated purchasing,’” *DuPont*, 177 USPQ at 567, and the third *DuPont* factor, the “similarity or dissimilarity of established, likely-to-continue trade channels.” *Id.* 6 TTABVUE 20.

1. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we consider “the similarity or dissimilarity of the [VICTUS and VECTUS] marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. v. Veuve Cliquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019).

The proper test regarding similarity “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.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks and citation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a

general rather than specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted). As discussed below, the average customer here is not an ordinary consumer, but rather a professional buyer.

Applicant’s core argument is that its “VICTUS mark has a unique commercial impression that is sufficiently different from the Cited Mark’s commercial impression so that the factor of the dissimilarity between the two marks . . . weighs against a finding of a likelihood of confusion between the marks.” 6 TTABVUE 16-17. Applicant argues that VICTUS and VECTUS have different meanings in Latin,³² and that

Latin and words derived from Latin are prevalent to such a degree in the English language that even though a professional purchaser may not be able to speak Latin, a professional purchaser is going to recognize that both marks are connected to the Latin language and presume that each has a distinct meaning. As a result, each mark is going to convey a unique commercial impression.

Id. at 14.

Applicant’s fallback argument is that even if the marks would not be translated from Latin, “Applicant’s mark is a fanciful word, implying that Applicant’s mark serves as a strong source indicator of distinctive source indication.” *Id.* Applicant argues that “[a]s a result of the different spelling in Applicant’s [VICTUS] mark, the first syllable in the mark begins with the unique ‘vic’ term which is an acronym for ‘victory,’” *id.*, which “imbues Applicant’s Mark with a commercial impression generally related to triumphing over adversity,” *id.*, while the cited VECTUS mark

³² Applicant argues that “victus” “is Latin for ‘nourishment’, ‘provisions’, or ‘that which sustains life,’” while “vectus” “is Latin for ‘bear, carry, convey’ or pass, ride, sail.” 6 TTABVUE 14.

“has a first syllable that begins with the ‘*vec*’ term which does not conjure anything related to triumphing or victory.” *Id.* at 14-15.

With respect to the sound of the respective marks, Applicant argues that VICTUS “is extremely similar to the English word, *victor*, which has the *vic* portion of the word pronounced with a *short I* that is distinct,” *id.* at 15, while VECTUS “is extremely similar to the English word, *vector*, and the *vec* portion of the Cited Mark would be pronounced with a *short E* that is different from a *short I* sound.” *Id.* Applicant argues that it is unlikely that purchasers would mispronounce the first vowels in the involved marks in a manner that would make them sound similar or identical, *id.* at 15-16, and rejects the Examining Attorney’s evidence regarding mispronunciation. *Id.* at 16.

The Examining Attorney responds that “the marks consist of exactly six letters, with five of the letters being identical” and that the “only difference in appearance and sound is that the second letter in the applicant’s mark is the letter ‘I’ whereas the second letter in the registrant’s mark is the letter ‘E.’” 8 TTABVue 17. He notes that neither mark appears in an English language dictionary, and that the marks “give the same commercial impression of arbitrary wording when used in relation to the goods and services provided.” *Id.* He argues that the marks could be pronounced the same based on evidence of the pronunciation of the short “i” and short “e” sounds, *id.*, but that even “slight differences in the sound of similar marks will not avoid a likelihood of confusion.” *Id.* at 23.

The “marks ‘must be considered . . . in light of the fallibility of memory’ and ‘not on the basis of side-by-side comparison.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2 (CCPA 1977)). When the VICTUS and VECTUS marks are considered in this manner, we agree with the Examining Attorney that they are similar. Each mark consists of two syllables and six letters, five of which are identical and appear in the same order. Each mark begins with the V_C- prefix and ends with the -TUS suffix. The marks differ only to the extent of having different vowels in their respective first syllables, and taking into account “the general rather than specific impression of marks,” *i.am.symbolic*, 127 USPQ2d at 1630, retained by all consumers, including professional buyers, the marks are quite similar in appearance.

With respect to sound, we need not resolve the dispute between Applicant and the Examining Attorney regarding possible mispronunciation of the vowels “i” and “e” because even if the marks are pronounced in the manner argued by Applicant, they sound quite similar because of their similar V_C- prefixes and identical -TUS suffixes.

Finally, with respect to meaning, the means of comparison on which Applicant relies most heavily, we find Applicant’s arguments unpersuasive. Applicant’s argument regarding the different meanings of “victus” and “vectus” in Latin invokes the doctrine of foreign equivalents, pursuant to which the Board assumes that consumers would translate marks consisting of words from foreign languages into English in considering their meaning. *See generally Ricardo Media Inc. v. Inventive*

Software, LLC, 2019 USPQ2d 311355, *6-7 (TTAB 2019). “Under the doctrine of foreign equivalents, foreign words from common, modern languages are translated into English to determine similarity of connotation with English words in a likelihood of confusion analysis.” *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008) (citing *Palm Bay Imps.*, 73 USPQ2d at 1696), but, as Applicant tacitly acknowledges, 6 TTABVUE 14, “Latin is generally considered a dead language.” TMEP Section 1207.01(b)(vi)(B). The TMEP notes that “if evidence shows that a Latin term is still in use by the relevant purchasing public (i.e., if the term appears in current dictionaries or news articles), then this Latin term would not be considered dead,” *id.*, but there is no evidence of any such current use of either mark. The record is insufficient to show that the professional buyers of Applicant’s goods and services would recognize either mark as a Latin word, translate either mark into English, and distinguish them on the basis of their different meanings in English.³³

Applicant’s argument that the marks differ in meaning because the “VIC-” prefix in its mark connotes or abbreviates “victory,” while the “VEC-” prefix in the cited mark has no such connotation, is similarly unpersuasive. The VICTUS and VECTUS marks have no known meanings in English,³⁴ and Applicant’s own evidence shows that “victory” is only one of more than 50 possible meanings of the “VIC-” prefix in

³³ There is similarly no support in the record for Applicant’s argument that “even though a professional purchaser may not be able to speak Latin, a professional purchaser is going to recognize that both marks are connected to the Latin language and presume that each has a distinct meaning.” 6 TTABVUE 14.

³⁴ June 17, 2019 Office Action at TSDR 5-6 (MERRIAM-WEBSTER DICTIONARY).

Applicant's mark.³⁵ But even if the "VIC-" prefix may evoke "victory" for some consumers, while the "VEC-" prefix does not, "[e]ach syllable of each mark generates an 'impact,' but the only impact to be considered is that of the whole." *San Fernando Elec.*, 196 USPQ at 3 (MONOCERAM and MICRO CERAM found to be "not sufficiently different in their total impacts to eliminate likelihood of confusion as to source" even though their prefixes had different meanings) (citing *Massey Junior Coll. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 181 USPQ 272 (CCPA 1974)). To the extent that VICTUS and VECTUS in their entirety would be perceived as having any particular meanings, any vague differences in those meanings are not sufficient to make confusion unlikely given the close similarity of the marks in appearance and sound.

The VICTUS and VECTUS marks are quite similar in appearance and sound, and those similarities outweigh any dissimilarities in connotation and commercial impression. The first *DuPont* factor supports a finding of a likelihood of confusion.

2. Similarity or Dissimilarity of the Goods and Services, and Channels of Trade

The second *DuPont* factor "considers '[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration," *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir 2018) (quoting *DuPont*,

³⁵ Applicant made of record a single page from acronymfinder.com setting forth the results of a search entitled "What does VIC stand for?" July 2, 2020 Request for Reconsideration at TSDR 15. The search "returned 57 meanings," *id.*, but Applicant included only three, "Victoria (State of Australia)," "Victor," and "Victory." On the face of the results of Applicant's search, there are 54 other meanings that could give the "VIC-" prefix in Applicant's mark a different connotation from the one argued by Applicant.

177 USPQ at 567), while the third *DuPont* factor considers “the similarity or dissimilarity of established, likely-to-continue trade channels.” *Id.* at 1052 (quoting *DuPont*, 177 USPQ at 567). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014).

The goods and services need not be identical, but “need only be related in some manner and/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)).

“Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods and services are used together or used by the same purchasers; advertisements showing that the relevant goods and services are advertised together or sold by the same manufacturer or dealer; or copies of use-based registrations of the same mark for both the applicant’s [goods and] services and the goods [and services] listed in the cited registration.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, *4-5 (TTAB 2019).

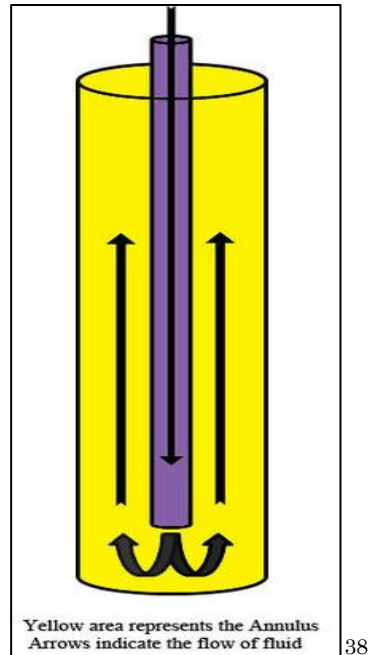
Applicant correctly acknowledges that “the nature and scope of a party’s goods or services should be analyzed in view of the goods or services recited in the application or registration.” 6 TTABVUE 17. Applicant and the Examining Attorney disagree, however, as to which identification of Applicant’s goods and services should be analyzed under the second and third *Du Pont* factors. Applicant discusses the Second Proposed Amended Identification, *id.* at 17-20, while the Examining Attorney argues

that because the Second Proposed Amended Identification was unacceptable, “the original identification of goods and services in the application remains active for purposes of determining likelihood of confusion.” 8 TTABVUE 18 (citing Trademark Rule 2.71(a) and TMEP Section 1402.07(d)). We agree with the Examining Attorney.

Applicant’s Original Identification described its Class 7 goods as an “Oilfield system for managing annulus pressure during drilling operations” and its Class 37 services as “Oilfield drilling services, namely managing annulus pressure during drilling operations.” The Board “may take judicial notice of information from dictionaries, encyclopedias, and other standard referenced works,” *In re Information Builders Inc.*, 2020 USPQ2d 10444, *3 n.6 (TTAB 2020), and we take judicial notice that in the context of “extractive engineering, field development, and drilling,” an “annulus” is “the space between two concentric objects (=objects of the same shape in which a larger one surrounds a smaller one), for example, between the wellbore and casing,”³⁶ and that in the context of drilling, a “wellbore” is “a hole drilled in the ground in order to look for or extract natural resources such as oil and gas” and a “casing” is a “steel pipe or tubing, esp. as used in oil and gas wells.”³⁷ We depict below an illustration of a drilling annulus:

³⁶ COLLINS ENGLISH DICTIONARY (collinsdictionary.com, last accessed on February 24, 2021).

³⁷ COLLINS ENGLISH DICTIONARY (collinsdictionary.com, last accessed on February 24, 2021).



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Applicant's Original Identification describes a system and services that manage the pressure that builds up in the annulus during drilling operations.

The goods identified in the cited registration are:

Machinery used for recovering and obtaining oil and gas; hydraulic motors, pumps and valve actuators; pressure controls and regulators being parts of machines; subsea control systems, namely power and communication systems which provide hydraulic, electrical or electrohydraulic control and monitoring for production equipment comprised primarily of hydraulic controls for machines, valves for pumps, valves being parts of machines and also comprised of subsea control modules comprised of remote controls for subsea production equipment, apparatus for recording transmission, processing and production of data in the nature of subsea control module communication distribution units and automatic control valves, in International Class 7; and

Communication and control systems comprised of computer hardware and software for machines; communication systems for transferring data for subsea oil

³⁸ [wikipedia.org/wiki/Annulus \(well\)](https://wikipedia.org/wiki/Annulus_(well)) (last accessed on February 24, 2021).

and gas networks comprised of computer hardware, software, modems and communication cables; monitoring and control systems comprised of computer hardware and software for offshore and subsea operations including hydrocarbon extraction; subsea control systems comprised of electrical power units, electric control panels; electronic control systems for underwater machines; computer software systems and software for offshore and subsea operations, in International Class 9;

and the services identified in the cited registration are:

Monitoring of performance and condition of offshore and subsea installations, components and environment for quality control purposes and to ensure proper functioning, in International Class 42.

The Examining Attorney claims that the goods identified in the Original Identification are related to the goods identified in the cited registration for two reasons.³⁹ First, he argues that Applicant “has failed to provide a definite identification properly listing the primary components of their [sic] ‘oilfield system’ and therefore the applicant’s ‘oilfield system’ could contain the same primary components as the numerous systems identified by the registrant.” 8 TTABVUE 19. Second, he argues that the Internet evidence in the record shows that “applicant’s goods and the registrant’s goods are machinery and systems for use in oil field drilling.” *Id.* at 19-21.

With respect to the services described in the Original Identification, the Examining Attorney argues that “the application uses broad wording to describe ‘oilfield drilling services, namely managing annulus pressure during drilling

³⁹ As noted above, Applicant addresses the similarity of the goods and services in the Second Proposed Amended Identification to those in the cited registration, and does not address the Examining Attorney’s arguments regarding the Original Identification.

operations,’ which presumably encompasses all services of the type described, including registrant’s more narrow ‘monitoring of performance and condition of offshore and subsea installations, components and environments for quality control purposes and to ensure proper functioning.’” *Id.* at 21. He points to Internet evidence showing “that one way of managing annulus pressure is by monitoring (and/or analyzing) the pressure on a recurring basis,” *id.*, which he claims shows that “applicant’s managing annulus pressure wording could encompass the registrant’s monitoring services,” such that those services legally identical. *Id.* at 21-22.⁴⁰

The “Oilfield system for managing annulus pressure during drilling operations” identified in Applicant’s Class 7 Original Identification is broad enough to encompass some of the Class 7 goods identified in the cited registration, such as “subsea control systems, namely power and communication systems which provide hydraulic, electrical or electrohydraulic control and monitoring for production equipment comprised primarily of hydraulic controls for machines, valves for pumps, valves being parts of machines and also comprised of subsea control modules comprised of remote controls for subsea production equipment, apparatus for recording transmission, processing and production of data in the nature of subsea control module communication distribution units and automatic control valves.” In that regard, we note that portions of Applicant’s Second Proposed Amended Identification,

⁴⁰ Registration may be refused as to each class in Applicant’s application if we find that the goods and services in the Original Identification are related to any of the goods and services identified in the cited registration. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

which attempted unsuccessfully to identify the primary goods in Applicant’s “Oilfield system for managing annulus pressure during drilling operations,” reflected Applicant’s belief that its system encompassed “sea based drilling operations” and “control systems designed to manage wellbore pressure changes and provide early kick and loss detection,” a “subsea surveillance system,” “electric and hydraulic valves,” and “valves.” Such a system reasonably encompasses the registrant’s “subsea control systems, namely power and communication systems which provide hydraulic, electrical or electrohydraulic control and monitoring for production equipment comprised primarily of hydraulic controls for machines, valves for pumps, valves being parts of machines” These Class 7 goods are thus legally identical. *See, e.g., Information Builders*, 2020 USPQ2d 10444 at *3; *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, *13 (TTAB 2020).

The Examining Attorney also provided evidence that Applicant’s Class 7 goods are related to the registrant’s Class 7 goods. A company called TCO offers both an annulus pressure relief management system that manages annulus pressure by “bleed[ing] off the pressure that is necessary to hold and maintain a safe, pre-determined B-annulus pressure,”⁴¹ and a disappearing tubing hanger plug that falls within the registrant’s goods broadly identified as “Machinery used for recovering and obtaining oil and gas” and “pressure controls and regulators being parts of machines.”⁴² Halliburton offers a “B/Annulus Pressure/Temperature Monitoring

⁴¹ June 17, 2019 Office Action at TSDR 9.

⁴² *Id.* at TSDR 10-11.

System” that helps “manag[e] the pressure integrity of the wellhead” by “pick[ing] up any pressure/temperature fluctuations, enabling the operator to detect pressure buildup while producing,”⁴³ as well as an electro hydraulic system for large bore subsea well intervention applications that also falls within the registrant’s goods broadly identified as “Machinery used for recovering and obtaining oil and gas.”⁴⁴

Techni offers a “B-Annulus Monitoring System,”⁴⁵ as well as a subsea high pressure pump that falls within the goods identified as “pumps” in the cited registration.⁴⁶ Petroleum Technology Company offers an “A-Pro Annulus Pressure Management System,”⁴⁷ as well as valves,⁴⁸ annulus pressure monitoring and management technologies,⁴⁹ and software,⁵⁰ which is encompassed within the registrant’s Class 9 goods. Emerson offers a wireless system for monitoring annulus pressure,⁵¹ as well as other equipment and systems, including a valve actuator,⁵² and valves.⁵³

⁴³ *Id.* at TSDR 12.

⁴⁴ *Id.* at TSDR 13.

⁴⁵ *Id.* at TSDR 14.

⁴⁶ *Id.* at TSDR 15.

⁴⁷ January 6, 2020 Final Office Action at TSDR 3.

⁴⁸ *Id.* at TSDR 4-5.

⁴⁹ *Id.* at TSDR 7.

⁵⁰ *Id.* at TSDR 8.

⁵¹ *Id.* at TSDR 9.

⁵² *Id.* at TSDR 12.

⁵³ *Id.* at TSDR 15.

This evidence of the sale of goods similar in nature to Applicant's and registrant's under the same mark supports a finding that the goods are related. *Detroit Athletic Co.*, 128 USPQ2d at 1050 (crediting relatedness evidence that third parties use the same mark for the goods and services at issue because "[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both"); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (stating that evidence that "a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis"); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009) (two websites showing that water pumps and electric motors, and compressors "can be manufactured and sold by a single source" supported a finding of relatedness). Because certain of the involved goods are legally identical or are otherwise related, we find that the second *DuPont* factor supports a finding of a likelihood of confusion as to Applicant's Original Identification of its Class 7 goods.

Because certain of the Class 7 goods are legally identical, and neither Applicant's Class 7 Original Identification nor the Class 7 identification in the cited registration contains any pertinent limitations, "we must presume that the channels of trade and classes of purchasers are the same." *In re Am. Cruise Lines, Inc.*, 128 USPQ2d 1157, 1158 (TTAB 2018) (citing *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)). The third *DuPont* factor also supports a finding of a likelihood of confusion as to Applicant's Original Identification of its Class 7 goods.

We also agree with the Examining Attorney that the Class 37 services identified in the Original Identification are legally identical to the Class 42 services identified in the cited registration. For the reasons discussed below, the services identified in the application as “Oilfield drilling services, namely managing annulus pressure during drilling operations” encompass the services identified in the cited registration as “Monitoring of performance and condition of offshore and subsea installations, components and environment for quality control purposes and to ensure proper functioning.”

The record contains a webpage entitled “Well Integrity: A Holistic Approach to Annulus Pressure Management for Subsea Wells” on the website of gateinc.com, which addresses the question “What is Annulus Pressure Management and Why is it Important?”⁵⁴ The webpage uses the wellbore schematic drawing displayed below:

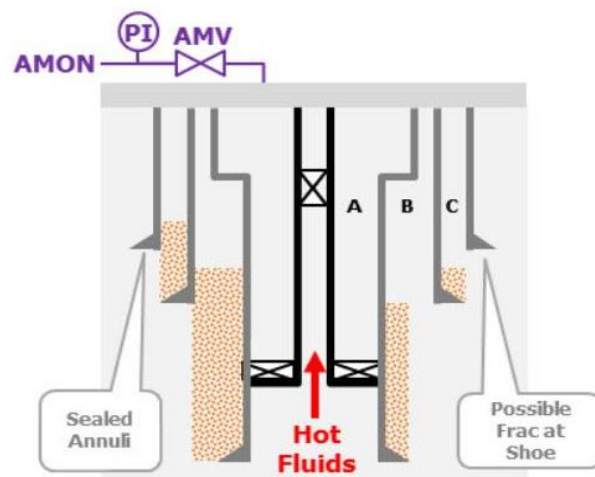


Figure 1: Wellbore Schematic

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⁵⁴ June 17, 2019 Office Action at TSDR 7. The text of the webpage appears to continue on one or more subsequent pages, but the Examining Attorney only made the first page of record. The better practice is to include the entire text.

⁵⁵ *Id.*

The webpage explains that “Annulus Pressure Management refers to an engineered approach ensuring that casing annulus pressures do not challenge the well’s integrity during the life of the well” and that the “aim is to maintain the casing pressure within the well’s mechanical design limits at all times by controlling the ‘A’ annulus pressure.”⁵⁶ The webpage notes that “[i]n subsea wells, the ‘A’ annulus is the only annulus that can be monitored and controlled,” that it “is monitored via a pressure transducer located on the subsea tree which is linked to the control system,” and that “subsea wells are typically designed with an Annulus Monitoring Line via a subsea distribution systems and an umbilical system that are tied back to the host facility (typically referred to as an Annulus Monitoring, AMON, or Auxiliary System.”⁵⁷

The registrant’s Class 42 identification of services, “Monitoring of performance and condition of offshore and subsea installations, components and environment for quality control purposes and to ensure proper functioning,” is itself broad enough to include monitoring annulus pressure in subsea wells, which helps “ensure proper functioning” of these “subsea installations.” We find that monitoring annulus pressure is part and parcel of, and thus encompassed by, Applicant’s Original

⁵⁶ *Id.* The “A” annulus is shown by the letter “A” in the schematic drawing shown above.

⁵⁷ *Id.* The Halliburton and Emerson systems discussed above similarly describe themselves as monitoring annulus pressure in the course of helping to manage it during drilling operations. The Halliburton system “picks up any pressure/temperature fluctuations, enabling the operator to detect pressure buildup while producing,” June 17, 2019 Office Action at TSDR 42, while the Emerson systems “continuously monitor annulus B temperature and pressure for the subsea well’s lifetime” and improve “production and offshore safety [by] providing early high-pressure warnings, protecting casing integrity and preventing pressure build-up.” January 6, 2020 Final Office Action at TSDR 9.

Identification of its services as “managing annulus pressure during drilling operations.” Applicant’s original Class 37 services are thus legally identical to the registrant’s Class 42 services, and the second *DuPont* factor supports a finding of a likelihood of confusion as to Applicant’s Original Identification of its Class 37 services.

As discussed above, because Applicant’s Original Identification of its Class 37 services is legally identical to the registrant’s Class 42 services, and neither identification contains any pertinent limitations, we must presume that the channels of trade and classes of purchasers are the same, and the third *DuPont* factor also supports a finding of a likelihood of confusion as to Applicant’s Original Identification of its Class 37 services.

3. Purchase Conditions and Degree of Consumer Sophistication

The fourth *DuPont* factor involves “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse vs. careful, sophisticated purchasing.’” *DuPont*, 177 USPQ at 567. Applicant argues that

[p]roducts identified by Applicant’s Mark and the Cited Mark are going to be exclusively sold to ‘professional’ consumers because of the extraordinary cost associated with oil production and the extremely high degree of technical knowledge and effort required to complete a transaction for a system offered under Applicant’s Mark and the Cited Mark.

6 TTABVue 10-11. Applicant relies on the Kurka Declaration, which discusses the elaborate process of negotiating, customizing, and deploying Applicant’s systems, and their high prices. *Id.* at 11-12 (citing Kurka Decl. ¶¶ 3-6). Applicant concludes that

because the good [sic] and services for Applicant's mark can cost upward of \$20 million, can require, on average, fifty (50) weeks of lead time, and require extensive customization and highly technical decision making by the consumer, the offered goods and services are of the nature that a purchaser would exercise extreme care when making a purchase and would be able to distinguish even highly similar goods/services offered by [sic] similar marks.

Id. at 13.

The Examining Attorney responds that "the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion." 8 TTABVue 22.

Mr. Kurka testified that "[p]otential consumers for Applicant's system (goods/services) offered under the applied for mark are going to be a sophisticated buyer" because negotiations to complete a transaction can take a year or more to complete, Kurka Decl. ¶ 3; that "the system offered under the applied-for mark has to be specifically customized for each drilling rig and conform with purchaser preferences," Kurka Decl. ¶ 4, which may take between one and six months, Kurka Decl. ¶ 4; that the total cost for Applicant's system is "around \$15 Million" and "can range from \$10 Million to \$20 Million" depending on various factors, Kurka Decl. ¶ 5; and that if a customer wishes Applicant to operate the system following installation, the daily operating costs are around \$35,000. Kurka Decl. ¶ 6. His testimony focuses, however, specifically on the purchasers, purchasing process, and cost of the goods and services actually offered by Applicant, rather than on the purchasers, purchasing process, and cost of "Oilfield system[s] for managing annulus pressure during drilling operations"

and “Oilfield drilling services, namely managing annulus pressure during drilling operations” generally. Our analysis under the fourth *DuPont* factor “must be based on the identification of goods [and services] in the [cited] Registration and subject [a]pplication, as that determines the scope of the benefit of registration.” *Sock It to Me, Inc. v. Fan*, 2020 USPQ2d 10611, *7 (TTAB 2020). Accordingly, because Mr. Kurka’s testimony focuses solely on Applicant’s actual goods and services instead of the general goods and services described in the Original Identification in the application, we cannot find that his testimony regarding purchase conditions and purchaser sophistication establishes the degree of purchaser care for all of the goods and services encompassed within the Original Identification.

At the same time, however, we find that by their nature, the goods and services identified in Applicant’s Original Identifications and in the cited registration would involve some elevated degree of purchaser care on the part of professional buyers. *See Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992) (“Just from the record description of goods and services here one would expect that nearly all of opposer’s and applicant’s purchasers would be highly sophisticated.”). Accordingly, we find that the fourth *DuPont* factors weighs against a finding of a likelihood of confusion.

4. Balancing the *DuPont* Factors

The involved identified goods and services and channels of trade are legally identical in part, which “reduces the degree of similarity between the marks necessary to find a likelihood of confusion,” *New Era*, 2020 USPQ2d 10596 at *14 (citations omitted), and the VICTUS and VECTUS marks are sufficiently similar

under that standard for confusion to be likely. The professional purchasers of the identified goods and services will exercise a heightened degree of care, but “purchaser sophistication does not always result in a finding that confusion is unlikely, especially where legally identical in part goods and services are involved and . . . the marks are similar.” *Information Builders*, 2020 USPQ2d at *4 (citing *Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1841-42 (Fed. Cir. 1990) (similarities of goods and marks outweighed sophisticated purchasers, careful purchasing decisions, and expensive goods); *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962)). On balance, we find that the Examining Attorney carried his burden of showing that Applicant’s VICTUS mark is likely to cause confusion, mistake, or deception when used in connection with the goods and services in the Original Identification in the application.

Decision: The refusals to register are affirmed on both grounds.