


The Examining Attorney has refused registration of Applicant's mark under Ser. No. 86113752 on a basis of likely confusion under Section 2(d) of the Lanham Act due Reg. Nos. 2289538 and 4082341. Applicant notes that it owns Reg. No. 2289538, as evidenced by the updated assignment information for that mark, such that that mark should not bar registration of Applicant's mark.

In addition, Applicant submits that Reg. No. 4082341 should not bar registration of Applicant's marks for the reasons set out below. A side by side review of the marks at issue is set out below for easy reference:

- Reg. No. 4082341 for the mark PROPAK, covering various goods, including "plastic garbage bags, trash can liners, plastic general purpose storage bags" in Class 16, as well as goods in Classes 5, 8, 20, 21, and 25 (the "Cited Mark")

PROPAK

- App. No. 86113752 for the mark , covering "Insulated shipping containers for transporting frozen materials made of paper or cardboard; padded paper envelopes for packing or shipping in Class 16

In *In re E.I. du Pont de Nemours & Co.*, the Court of Customs and Patent Appeals discussed the factors relevant to a determination of likelihood of confusion.¹ 476 F.2d 1357 (CCPA 1973). Each of the relevant factors must be considered independently. The facts in each case vary and the weight to be given each factor may be different in light of the varying circumstances. TMEP 1207.01(a)(iv). In the case at hand, when all of the relevant factors are considered, it is clear that Applicant's mark and the Cited Marks are not confusingly similar.

As an initial matter, Applicant's prior registration for PROPAK and Design under Reg. No. 2289583, covering non-metal containers, already coexists on the Register with the Cited Mark. Moreover, Applicant's Reg. No. 2289583 has been registered since 1999, and Applicant or its predecessor has used the mark since at least as early as 1998. The owner of the Cited Mark has claimed use of its mark with bags since 2007. Therefore, the Cited Mark should not bar registration of Applicant's mark. See *In re Strategic Partners Inc.*, 102 USPQ2d 1397 (TTAB 2012) (reversing Examiner's refusal to register where the parties already owned coexisting registrations for their marks).

¹ (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) The similarity or dissimilarity of established, likely-to-continue trade channels; (4) The conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing; (5) The fame of the prior mark; (6) The number and nature of similar marks in use on similar goods; (7) The nature and extent of any actual confusion; (8) The length of time during and the conditions under which there as been concurrent use without evidence of actual confusion; (9) The variety of goods on which a mark is or is not used; (10) The market interface between application and the owner of a prior mark; (11) The extent to which applicant has a right to exclude others from use of its mark on its goods; (12) The extent of potential confusion, i.e., whether *de minimis* or substantial.; (13) Any other established fact probative of the effect of use.

When determining likely confusion, the analysis of the nature of the goods and the respective channels of trade is a significant factor. For example, in *Phoenix Closures Inc. v. Yen Shaing Corp. Ltd.*, the TTAB reversed the Examiner's refusal to register the mark PHOENIX and Design for vacuum bottles in light of existing registrations for PHOENIX FOIL and PHOENIX PHOIL for metal foil liners for bottle closures, where the applicant's marks were sold to consumers and the registrant's marks were sold to professionals in the packaging industry who would exercise a "high degree of care" in making purchases. See *Phoenix*, 9 USPQ2d 1891 (TTAB 1988) ("We doubt that these professionals would assume that vacuum bottles bearing applicant's mark PHOENIX and bird design originated with or were associated with the same company that manufactures and sells bulk quantities of closures as component parts for finished containers.") See Also *Golden Gate Salami Co. v. Gulf States Paper Corp.*, 141 USPQ 661 (C.C.P.A. 1964) (no confusion between marks E-Z OPEN on containers for lunch meat sold to consumers, and E-Z OPENER and E-Z PAK, both used for paper bags sold to grocery stores, where there was no evidence of overlapping customers for the goods under the respective marks). *CLEVELAND-DETROIT CORPORATION v. CAMCO (MACHINERY) LIMITED*, 119 USPQ 331 (TTAB 1958) (no confusion likely between marks CLAMCO and CAMCO for paper wrapping machines and packaging equipment, where there was no evidence of any common trade channels or common purchasers, and where goods under the respective marks were used in specialized fields).

In this case, the goods under the Cited Mark are trash or storage bags, and Applicant's goods are insulated shipping containers for transporting frozen materials, and padded paper envelopes for packing or shipping. Moreover, Applicant sells its goods to businesses in the frozen goods packing industry. As such, not only are the goods themselves different, but Applicant's customers are discriminating, and will take time to closely examine the goods at issue to confirm they will be appropriate for the job at hand, will further minimize any possibility of confusion. See also *Savin Corp. v. Savin Group*, 73 USPQ2d 1273 (2d Cir. 2004) (no confusion between identical marks for different types of consulting services, because companies' decisions to purchase respective services would be "the result of careful deliberation by more than one person in the purchasing organization."); see also *In re Com-Pac International, Inc.*, Ser. No. 76/181,701 (TTAB 2003) (no confusion between INTEGRA for packaging machinery and INTEGRA TEAR for plastic packaging used in food industry, due to differences in marks overall, different channels of trade, and sophistication of purchasers).

In addition, a review of the Register indicates several third marks relating to the terms PRO and PAK, for various goods, including "bags" or "packing" goods. Notably, the Cited Mark PROPAK already coexists with the following registered marks:

- PROPAK for waste collection bags under Reg. No. 2285959
- PRO-PAK for packing for use in gas-liquid container apparatus under Reg. No. 927780.

The above referenced marks (full details regarding all are below) and the other marks shown below indicate that the terms "PRO" and "PAK" are widely used by third parties in connection with general packaging related goods and services, such as Applicant's marks and the Cited Mark:

TM/SN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner
PRO PAK SN:74-419184 RN:1,858,670	Renewed October 18, 2004 Int'l Class: 25 First Use: February 14, 1990 Filed: August 2, 1993 Published: February 22, 1994 Registered: October 18, 1994	(Int'l Class: 25) Athletic uniforms	Speedline Athletic Wear, Inc. (Florida Corp.) 1804 N. Habana Avenue, P. O. Box 2498 Tampa, Florida 33601
PRO/PAK SN:75-177654 RN:2,126,922	Renewed January 6, 2008 Int'l Class: 9 First Use: August 24, 1996 Filed: October 7, 1996 Published: October 14, 1997 Registered: January 6, 1998	(Int'l Class: 9) Fire fighting apparatus, namely, fire extinguishers	Task Force Tips, Inc. (Indiana Corp.) 2800 East Evans Ave. Valparaiso, Indiana 46383
PRODUCE-PAK SN:72-285910 RN:861,217	Renewed December 3, 2008 Int'l Class: 16 First Use: January 1, 1965 Filed: November 30, 1967 Published: June 11, 1968 Registered: December 3, 1968	(Int'l Class: 16) Paperboard box	Rock-Tenn Shared Services, LLC (Georgia Limited Liability Company) 504 Thrasher Street Norcross, Georgia 30071
PROPAC SN:78-476452 RN:3,053,774	Registered 8 & 15 February 27, 2012 Int'l Class: 9 First Use: June 28, 1982 Filed: August 31, 2004 Published:	(Int'l Class: 9) Batteries	Anton/Bauer, Inc. (Delaware Corp.) 14 Progress Drive Shelton, Connecticut 06484

TM/SN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner
	November 8, 2005 Registered: January 31, 2006		
PROPAC PROPAC SN:77-157242 RN:3,429,698	Registered May 20, 2008 Int'l Class: 35 First Use: January 1, 1989 Filed: April 16, 2007 Published: March 4, 2008	(Int'l Class: 35) Wholesale distributorship services and online wholesale distributorship services featuring emergency kits, first aid kits, evacuation kits, preparedness kits, community emergency response team products, tents, and shelters, cots, self protection products, and emergency trailers	Propac, Inc. (South Carolina Corp.) 2390 Air Park Road N. Charleston, South Carolina 29406
PROPACK DATA SN:76-395122 RN:3,233,789 Disclaimer: "DATA"	Registered 8 & 15 May 14, 2013 Int'l Class: 9 First Use: 2001 In Commerce: September 29, 2002 Filed: April 12, 2002 Published: March 8, 2005 Allowed: September 20, 2005 Registered: April 24, 2007	(Int'l Class: 9) Computer software, namely computer software for collecting, storing, tracking, analyzing, integrating, transmitting, reporting, and managing data for use in the chemical, biological, pharmaceutical and food industries; computer software to manage the data and information used in the development, approval process, and production of products subject to regulatory approval; not including software for the operation of chromatography columns	Rockwell Automation Solutions GmbH (Federal Republic of Germany Corp.) Zur Giesserei 19-21 Karlsruhe 76227 Federal Republic of Germany
PROPAK PROPAK SN:77-590360 RN:4,080,394	Registered January 3, 2012 Int'l Class: 10 First Use: March 1, 2011 In Commerce: April 29, 2011 Filed: October 10, 2008 Published: August 25, 2009 Allowed: November 17, 2009	(Int'l Class: 10) Acupuncture needles packaged and sold in blister cards that allow the user to open one or up to five blister packs simultaneously	Seirin-America, Inc. (Massachusetts Corp.) 230 Libbey Parkway Weymouth, Massachusetts 02189

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<p>PROPAK</p> <p>PROPAK</p> <p>SN:85-192653 RN:4,082,341</p>	<p>Registered January 10, 2012</p> <p>Int'l Class: 8, 20 First Use: September 30, 2003 Int'l Class: 21 First Use: February 28, 2007 Int'l Class: 5 First Use: July 31, 2007 Int'l Class: 25 First Use: September 30, 2007 Int'l Class: 16 First Use: September 30, 2010 Filed: December 7, 2010 Published: October 25, 2011</p>	<p>(Int'l Class: 5) Sanitary towels, namely, towels impregnated with antimicrobial treatment (Int'l Class: 8) Plastic utensils for use in the consumption of food, namely, knives, forks and spoons (Int'l Class: 16) Goods of paper, namely, paper take-out cartons for food, napkins, towels, table cloths, place mats, and food wraps; plastic garbage bags, trash can liners, plastic general purpose storage bags; cash register paper rolls; paper restaurant guest checks (Int'l Class: 20) Plastic drinking straws, plastic lids (Int'l Class: 21) Plastic accessories for use in the consumption of food, namely, plastic cups, bowls; foam cups, plates, bowls; paper cups; plastic beverage stirrers; disposable gloves for general use, namely, latex gloves, poly gloves and vinyl gloves; cleaning pads (Int'l Class: 25) Chef hats</p>	<p>Distribution Marketing Services, L.P., Distribution Marketing Services GP, L.L.C. (Delaware LTD. Partnership) 16000 Memorial Drive, Suite 200 Houston, Texas 77079</p>
<p>PROPAK (Stylized)</p> <p>ProPak</p> <p>SN:75-244414 RN:2,285,959</p>	<p>Renewed October 12, 2009</p> <p>Int'l Class: 9 First Use: June 30, 1997 Filed: February 21, 1997 Published: December 9, 1997 Registered: October 12, 1999</p>	<p>(Int'l Class: 9) Disposable sample collection bags for water and wastewater analysis</p>	<p>Teledyne Instruments, Inc., Db a Teledyne Isco (Delaware Corp.) C/O 1049 Camino Dos Rios Thousand Oaks, California 91360</p>
<p>PRO-PAK</p> <p>PRO-PAK</p>	<p>Registered 8 & 15 June 3, 2011</p>	<p>(Int'l Class: 29) Freeze-dried foods, namely, apples, plums, pears, peaches, sliced</p>	<p>Oregon Freeze Dry, Inc. (Oregon Corp.) 525 Sw 25th Avenue</p>


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SN:78-365805 RN:3,069,159	Int'l Class: 29 First Use: July 19, 2004 In Commerce: October 28, 2004 Filed: February 10, 2004 Published: March 8, 2005 Allowed: May 31, 2005 Registered: March 14, 2006	strawberries, raspberries, peas, corn, cut green beans, diced carrots, sliced mushrooms, scrambled egg mix, creamed cottage cheese, cheese omelet, mexican omelet, chicken chop suey, beef chop suey, chicken stew, cooked diced chicken, chili with beans, cooked diced beef, beef with rice and onions, beef patties, sausage patties, pork chops, beef steak, beef stew, potatoes and pork, fish squares, and shrimp	Albany, Oregon 97322
PRO-PAK SN:72-350307 RN:927,780	Renewed January 25, 2012 Int'l Class: 17 First Use: December 5, 1963 Filed: February 2, 1970 Published: November 9, 1971 Registered: January 25, 1972	(Int'l Class: 17) Packing for use in gas-liquid contact apparatus to provide contact surfaces for vapors and liquids	Cannon Instrument Company (Pennsylvania Corp.) 2139 High Tech Road State College, Pennsylvania 16803
PROPAQ SN:73-737444 RN:1,523,389	Renewed February 7, 2009 Int'l Class: 10 First Use: February 28, 1988 Filed: June 30, 1988 Published: November 15, 1988 Registered: February 7, 1989	(Int'l Class: 10) Blood pressure monitoring apparatus	Welch Allyn, Inc. (New York Corp.) 4341 State Street Road Skaneateles Falls, New York 13153
PROPAX PROPAX SN:85-874562 RN:4,441,503	Registered November 26, 2013 Int'l Class: 3 First Use: May 2, 2013 Filed:	(Int'l Class: 3) Laundry detergent	Phoenix Brands LLC (Delaware Limited Liability Company) One Landmark Square, Suite 1810 Stamford, Connecticut 06901


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	March 13, 2013 Published: June 25, 2013 Allowed: August 20, 2013		
PROTECTPAK PROTECTPAK SN:77-656548 RN:3,756,722	Registered March 9, 2010 Filed: January 26, 2009 Published: December 22, 2009	(Int'l Class: 3) Cleaning preparations and disinfectant soaps (Int'l Class: 5) Disinfectants, antiseptics and disposable wipes impregnated with disinfecting chemicals or compounds for medical use, for use in personal hygiene and for use in sanitizing surfaces	Sanitas Healthcare Plc (United Kingdom Company) 18 Hanover Square London W1s 1Hx United Kingdom
PROTEKTIVE PAK SN:76-463403 RN:2,766,616 Disclaimer: "PACK"	Renewed September 23, 2013 Int'l Class: 16 First Use: August 5, 1989 Filed: October 31, 2002 Published: July 1, 2003 Registered: September 23, 2003	(Int'l Class: 16) Specially formulated cardboard boxes and containers for use by the electronics industry	Desco Industries, Inc. (California Corp.) 3651 Walnut Avenue Chino, California 91710

Given that the Office and the respective owners of the marks shown above have apparently felt that all such marks could peacefully coexist on the Register for the referenced goods, and given the nature of Applicant's goods as compared to the goods under the Cited Mark, Applicant submits that confusion between its mark and the Cited Mark is not likely, and Applicant requests that the refusal to register be withdrawn.

Finally, Applicant notes that the Cited Mark already coexists with several other marks that appear to be more closely related to the general goods under the Cited Mark than do Applicant's goods. For example, Applicant notes in particular the following third party marks that coexist with the Cited Mark in overlapping Classes or goods or services that can be described in the same general way:

TM/SN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner

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PROPAK SN:75-399114 RN:2,242,130	Renewed April 27, 2009 Int'l Class: 5 First Use: January 2, 1998 Filed: December 3, 1997 Published: September 22, 1998 Registered: April 27, 1999	(Int'l Class: 5) Pharmaceutical preparations for the prevention and treatment of hair loss and for the promotion of hair growth	Merck Sharp & Dohme Corp. (New Jersey Corp.) One Merck Drive Whitehouse Station, New Jersey 08889- 0100
ASPREGA PROPAC ASPREGA PROPAC SN:85-787141 RN:4,416,036	Registered October 8, 2013 Int'l Class: 5 First Use: January, 2013 Filed: November 26, 2012 Published: April 30, 2013 Allowed: June 25, 2013	(Int'l Class: 5) Nutraceuticals for the treatment of gastro- intestinal conditions	Scimera Bioscience (Florida Limited Liability Company) 4967 Sw 75th Ave. Miami, Florida 33115
PRO PAK ULTRA and Design  SN:77-662049 RN:3,682,575 Disclaimer: "PAK"	Registered Principal Register - Sec. 2(F) September 15, 2009 Int'l Class: 5 First Use: January 1, 2007 Filed: February 3, 2009 Published: June 30, 2009	(Int'l Class: 5) Animal feed supplements	H.J. Baker & Bro., Inc. (Delaware Corp.) 228 Saugatuck Avenue Westport, Connecticut 06880-6425

TM/SN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner
<p>PROFESSIONAL PACK and Design</p>  <p>SN:75-850972 RN:2,431,211 Disclaimer: "PROFESSIONAL PACK"</p>	<p>Renewed February 27, 2011</p> <p>Int'l Class: 5 First Use: August 1, 1995 Filed: November 17, 1999 Published: December 5, 2000 Registered: February 27, 2001</p>	<p>(Int'l Class: 5) Antiseptics</p>	<p>Humco Holding Group, Inc. (Texas Corp.) 7400 Alumax Road Texarkana, Texas 75501</p>
<p>PRO PAK</p> <p>SN:74-419184 RN:1,858,670</p>	<p>Renewed October 18, 2004</p> <p>Int'l Class: 25 First Use: February 14, 1990 Filed: August 2, 1993 Published: February 22, 1994 Registered: October 18, 1994</p>	<p>(Int'l Class: 25) Athletic uniforms</p>	<p>Speedline Athletic Wear, Inc. (Florida Corp.) 1804 N. Habana Avenue, P. O. Box 2498 Tampa, Florida 33601</p>

Clearly, the Office and the owners of the above marks took the position that such marks were different from one another due to differences in goods and channels of trade. Similarly, Applicant submits that its mark is different from the Cited Mark due to differences in goods and channels of trade.