

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/469860

APPLICANT: Williams Products, Inc

CORRESPONDENT ADDRESS:
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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: WILLIAMS PRODUCTS, INC.

CORRESPONDENT'S REFERENCE/DOCKET NO: WPI-106-TM

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

FACTS

Applicant filed the instant application Serial No. 76/469860 on November 25, 2002 to register the mark W WILLIAMS PRODUCTS, INC. and design for "construction materials, including water stops, bearing pads, joint fillers, panel seals, joint seals, masonry accessories sales." In an Office Action dated June 19, 2003, the examining attorney refused registration under Trademark Act Section 2(d) on the grounds that the applied-for mark so resembles the marks in Registration Nos. 1,090,001; 381,837; 517,355; and 1,415,609 as to result in a likelihood of confusion among consumers as to the source of the identified goods and services. The examining attorney also required applicant to amend the recitation of goods and services and to provide a disclaimer of PRODUCTS, INC., inter alia. Applicant's response of December 19, 2003 provided the disclaimer, failed to amend the recitation of goods and services and set forth arguments in favor of registration, inter alia. In an Office Action dated January 21, 2004, the

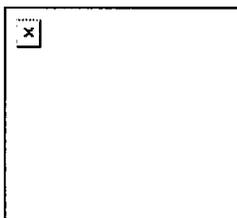
examining attorney made final both the requirement to amend the recitation of services and the refusal to register under Section 2(d) as to all of the referenced registrations. On July 22, 2004, applicant filed a Notice of Appeal. On September 20, 2004, applicant filed an appeal brief and a separate paper containing an amendment to the recitation of services. The examining attorney found the amended recitation of services acceptable. However, in an Office Action dated December 2, 2004, the examining attorney continued the final refusal under Section 2(d). The application was then returned to the Trademark Trial and Appeal Board for resumption of the appeal. On March 24, 2005, the Office reassigned the application file to the undersigned examining attorney. The only remaining issue in this case is the Section 2(d) refusal.

ARGUMENT

Registration of the mark W WILLIAMS PRODUCTS, INC. and design for a distributorship in the field of construction materials will result in a likelihood of confusion with the prior registered marks, all WILLIAMS, in typed form or with design, for various construction materials.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

Applicant's mark is:



for "distributorship services in the field of construction materials, including water stops, bearing pads,

joint fillers, panel seals, joint seals and masonry accessories,” in class 35.

The cited registered marks are:



[Reg. No. 1,415,609] for “hand tools, namely, adapters, ratcheting adapters, adjustable wrenches, carbide bits, cobalt bits, boring bars, boring tools, box wrenches, wheel sockets, chisels, c-clamps, strap clamps, toolmakers clamps, combination wrenches, crank handles, crowfoot wrenches, drills, extensions, screw extractors, flange jacks, flare nut wrenches, flaring tools, flex head rachets, flex/open end wrenches, gear pullers, ball pein hammers, sledge hammers, soft face hammers, hammer wrenches, hex key wrenches, impact sockets, lathe dogs, lock ring pliers, nut drivers, open end wrenches, pinch bars, roll bars, pipe tongs, pliers, pullers, ratchets, ratcheting box wrenches, rod ends, roll pouches, slotted screwdrivers, screwdrivers, torque screwdrivers, screw extractors, wedges, slip joint pliers, snap ring pliers, aviation snips, sockets, soft face hammer tips, spark plug sockets, striking face wrenches, tappet wrenches, torque tools, tube cutters, adjustable wrenches, chain wrenches, combination wrenches, box end wrenches, check nut wrenches, construction wrenches, metric wrenches, open end wrenches, spanners, special purpose wrenches, structural wrenches, bolt cutters, pipe wrenches, cable cutters, vises and cone pullers,” in Class 8.



[Reg. No. 517,355] for “c clamps, strap clamps, [lathe dogs, crank handles, balance handles, machine handles, tool posts, tool-post rings, tool post wedges,] lathe tools, planer tools, boring tools, lathe-tool holders, [grinding tools, pipe-cutting tools, grinding-tool holders, pipe-cutting-tool holders,] threading tools, pipe tools, chain pipe wrenches, [pipe wrenches,] wrenches, [chain pipe vises, pipe vises, vises,] machinists' clamps [, clamp lathe dogs],” listed both as Class 7 and Class 8.

WILLIAMS in typed form

[reg. no. 381,837] for “c-clamps, [strap clamps, lathe dogs, crank handles, balance handles, machine handles, tool posts, tool post rings, tool post wedges, lathe tools, planer tools, boring tools, lathe tool holders, planer tool holders, boring tool holders,] [knurling tool holders, grinding tools, pipe cutting tools, grinding tool holders, pipe cutting tool holders,] [threading tools, pipe tools,] [detachable sockets, detachable socket devices, screwdrivers, chisels, pliers, ratchet wrenches, adjustable wrenches,] chain pipe wrenches [, pipe wrenches,] and wrenches [,] [wheel pullers,] [chain pipe vises, pipe vises, vises, machinists' clamps, and clamp lathe dogs],” listed both as class 7 and class 8.

WILLIAMS in typed form

[Reg. No. 1,090,001] for “concrete form hardware used in pouring and laying concrete; rock bolts,” in Class 6.

With respect to a comparison of the marks, the applicant is correct that the marks are compared in their entireties under a Section 2(d) analysis. Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); TMEP §1207.01(b)(viii). The dominant feature of applicant's mark is WILLIAMS. The addition of the stylized W and the disclaimed descriptive matter PRODUCTS, INC. is insufficient to obviate the likelihood of confusion. Applicant's focus on the W in the mark is misplaced. The W merely stands for the word WILLIAMS in the mark, and does not significantly alter the commercial impression of the mark. Moreover, the only literal portion of the cited marks is WILLIAMS. The mere addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) ("BENGAL" and "BENGAL LANCER"); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) ("THE LILLY" and "LILLI ANN"); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) ("MACHO" and "MACHO COMBOS"); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" and "CREST CAREER IMAGES"); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) ("CONFIRM" and "CONFIRMCELLS"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE"); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) ("HEAD START" and "HEAD START COSVETIC"). Therefore, the addition of a W and descriptive wording to the cited marks is insufficient to obviate the likelihood of confusion.

Similarly, the addition of a design in applicant's mark and in one of the cited marks is not a persuasive factor. When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3

USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii). The stylization of WILLIAMS in applicant's mark and in two of the cited registered marks is also not significant. These are minor differences in the marks. Further, the two registered marks where WILLIAMS is in typed form encompass all stylizations of WILLIAMS.

Applicant's final argument regarding a comparison of the marks is its allegation that WILLIAMS is a weak mark, entitled to limited protection. Applicant argues that WILLIAMS is weak on the federal register. However, applicant has only submitted a mark and serial number printout, and not copies of the actual registrations. There is no showing that these marks are used in connection with goods or services in the construction materials industry. Applicant is correct that WILLIAMS is used in this field in the cited registrations. However, three of these registrations are owned by the same registrant and the fourth is for very different construction materials. Applicant's recitation of services encompasses the distribution of all of these goods. Applicant's argument that the mark WILLIAMS is a surname is not relevant to the issue of whether a likelihood of confusion exists between these marks. The fact that a name may be a common surname does not mean that a trademark is a common trademark when used in relation to particular goods or services. The applicant's argument and "evidence" do not establish that WILLIAMS is a weak mark in the construction field.

Turning to a comparison of the goods and services, applicant's services are "distributorship services in the field of construction materials, including water stops, bearing pads, joint fillers, panel seals, joint seals and masonry accessories" in Class 35. The term "including" does not limit the recitation in any meaningful way. Therefore, the recitation must be construed broadly to encompass distributorship services in the field of all "construction materials". "Materials"^[1] is defined as:

3. materials. Tools or apparatus for the performance of a given task: *writing materials*.^[2]

Therefore, "construction materials" are tools or apparatus for the performance of a given construction task. The hardware and tools listed in the cited registrations would be used in construction. Therefore, they are "construction materials" and applicant's services encompass the distribution of registrants' goods. Applicant's conclusory statement that the goods and services are distinct is not convincing.

Applicant also argues that the purchasers of the goods in the cited registrations “appear to be craftsmen who would certainly discern the difference...”. Applicant’s Brief at 4. Applicant’s speculations as to the users and channels of trade are not evidence, and are pure conclusory statements. Further, a determination of whether there is a likelihood of confusion is made solely on the basis of the goods and services identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin’s Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999). If the cited registration describes the goods broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639 (TTAB 1981); TMEP §1207.01(a)(iii). In the instant case, registrants’ goods and applicant’s services are not limited to particular consumers, and both encompass construction workers and craftspeople as intended users. If applicant is suggesting that craftspeople are sophisticated purchasers, even if there was evidence to support this assertion, it is neither persuasive nor dispositive. 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. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii). In the instant case, the marks and goods and services are so similar that consumers are likely to be confused as to the source of the goods and services.

CONCLUSION

The examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). Due to the highly similar nature of the marks and the goods and services, confusion is likely among consumers as to the source of those services. Accordingly, the refusal to register under Trademark Act Section 2(d) should be affirmed.

Respectfully submitted,

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[1]The definition of “materials” is not of record. The Board is asked to take judicial notice of this definition. *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 862 n. (TTAB 1981).

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