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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Builder's Best, Inc.

Serial No. 76642671

Eugene J. Rath III of Price, Heneveld, Cooper, DeWitt & Litton, LLP for Builder's Best, Inc.

Brian Pino, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Seeherman, Mermelstein and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Builder's Best, Inc. filed an intent-to-use application for the mark LOWES, in standard character format, for goods ultimately identified as "ventilation duct components, namely metallic dryer vent ducts," in Class 6 (Serial No. 76642671).

The Trademark Examining Attorney finally refused registration under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark LOWES, for metallic dryer vent ducts, is likely to

cause confusion with the following marks owned by LF Corporation:

1. LOWE'S, in typed drawing format, for the following services:

Retail outlet services specializing in a variety of building materials, plumbing supplies, roofing materials, home furnishings and items used in home improvement, in Class 42;¹

2. LOWE'S, in typed drawing format, for the following services:

Providing extended warranties on appliances and home improvement products; credit card services; and charitable fundraising, in Class 36;

Installation, repair and renovation services for appliances, home furnishings and home improvement items; rental of construction equipment and tools; paint mixing; and computer paint mixing services, in Class 37;

Installation, repair and remodeling services specializing in appliances, home furnishings and home improvement items; rental of construction equipment and tools; paint mixing; and computer paint matching services, in Class 38;

Providing cutting and pipe threading services, in Class 40;

Educational services, namely conducting clinics and workshops and providing written materials to promote home safety and regarding home protection procedures and products, in Class 41; and,

¹ Registration No. 1168799, issued September 8, 1981; Sections 8 and 15 affidavits accepted and acknowledged; renewed. The registration issued under Section 2(f) of the Trademark Act of 1946.

Retail outlet store services featuring a variety of appliances, building materials, plumbing supplies, roofing materials, home furnishings and items used in home improvement; consultation and design services for building materials, plumbing supplies, roofing materials, home furnishings and landscaping; retail floral services; landscape gardening design for others; and bridal registry services, in Class 42;²

2. LOWE'S, in standard character format, for the following goods and services:

Books and magazines featuring ideas, methods and instructions relating to home improvement, construction, decorating, gardening, landscaping and related activities, in Class 16;

Retail outlet store services featuring a variety of appliances, building materials, lighting and electrical supplies, plumbing supplies, roofing materials, home furnishings, home improvement items, tools, outdoor power equipment, home safety and security items, and landscaping materials; business consultation services for building materials, lighting and electrical supplies, plumbing supplies, roofing materials, home furnishings, home improvement, home safety and security; bridal registry services; retail floral store services; Promoting public awareness of home safety and home protection procedures and products and distributing written materials in connection therewith, in Class 35;

Providing extended warranties on appliances and home improvement products; credit card services; charitable fundraising, in Class 36;

Installation, repair and remodeling services specializing in appliances, building materials, lighting and electrical supplies, plumbing supplies, roofing materials, home furnishings, home improvement items, home safety and security items, landscaping materials; rental of

² Registration No. 1922425, issued September 26, 1995; Sections 8 and 15 affidavits accepted and acknowledged; renewed.

construction equipment and tools; paint mixing services; computer paint matching services, in Class 37;

Providing custom cutting of lumber, rope, chain, mini blinds and rope; custom pipe threading services, in Class 40;

Educational services, namely, conducting clinics and workshops relating to the installation and repair of appliances, building materials, lighting and electrical supplies, plumbing supplies, roofing materials, home furnishings, home improvement items, home safety and security items, and landscaping, in Class 41; and,

Design and/or design consultation services for building materials, lighting and electrical supplies, plumbing supplies, roofing materials, home furnishings, home improvement, home safety and security, in Class 42; and,

Consultation and design services for landscaping and landscape gardening, in Class 44.³

The Examining Attorney also refused registration under Section 2(e)(4) for of the Trademark Act of 1946, 15 U.S.C. §1052(e)(4), on the ground that LOWES is primarily merely a surname.

³ Registration No. 3097334, issued May 30, 2006. The registration issued under Section 2(f) of the Trademark Act of 1946.

The Examining Attorney also cited the following registrations, also owned by LF Corporation: Registration No. 1537782 for the mark LOWE'S DELIVERS, Registration No. 1965131 for the mark LOWE'S KNOWS, Registration No. 1931270 for the mark LOWE'S HOME IMPROVEMENT WAREHOUSE, and Registration No. 2646400 for the mark LOWE'S HOME IMPROVEMENT. Because the LOWE'S marks identified in the body of this decision are closer to applicant's mark than the compound LOWE'S marks identified in this footnote, we have focused our analysis on the LOWE'S marks identified in the body of this decision.

Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the probative 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). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("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").

- A. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, *supra*. In a particular case, any one of

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these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

The marks at issue, LOWES and LOWE'S, are essentially identical; the fact that one mark is shown as a possessive does not distinguish them. See *In Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (TTAB 1988) ("bigg's" for general merchandise is likely to cause confusion with

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"Biggs" for furniture); *In re Curtice-Burns, Inc.*, 231 USPQ 990 (TTAB 1986) (MCKENZIE'S for processed frozen fruits and vegetables is likely to cause confusion with MCKENZIE for canned fruits and vegetables); *Robert A. Johnston Co. v. Ward Foods, Inc.*, 157 USPQ 204 (TTAB 1968) (JOHNSTON'S for frozen pies and cakes is likely to cause confusion with JOHNSTON for cookies and crackers); *In re Suzanne's Frozen Foods*, 125 USPQ 307, 307 (TTAB 1960) ("SUZZANE'S' is the French equivalent of the possessive form of the name 'SUSAN', and these names are susceptible of being pronounced in much the same manner. In view thereof, it is concluded that resemblances between 'SUZZANE'S' and 'SUSANS' are such as to be likely, when applied to the goods, to cause confusion in trade"). See also *Wilson v. Delaunay*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) ("there is no material difference, in a trademark sense, between the singular and plural forms of the word 'Zombie' and they will therefore be regarded here as the same mark"); *In re Home Federal Savings and Loan Association*, 213 USPQ 68, 69 (TTAB 1982) ("That applicant's mark 'TRAN\$FUND' has a dollar sign where registrant's mark has a letter 'S' is inconsequential in a comparison of the sound, appearance, and meaning of the two marks"); *Goodyear Tire & Rubber Company v. Dayco Corporation*, 201 USPQ 485, 488 n.1

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(TTAB 1978) ("Fast-Finder" with a hyphen is substantially identical to FASTFINDER without a hyphen). In view thereof, this likelihood of confusion factor heavily favors finding that there is a likelihood of confusion.

B. The similarity or dissimilarity and nature of the goods and services.

It is well settled that the goods of the applicant and the services of the registrant do not have to be identical or directly competitive to support a finding that there is a likelihood of confusion. It is sufficient if the respective goods and services are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the mistaken belief that they emanate from or are associated with a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Moreover, the greater degree of similarity between applicant's mark and the cited registration, the lesser degree of similarity between the applicant's goods and the registrant's services that is required to support a finding of likelihood of confusion. Where, as here, the

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applicant's mark is virtually identical to the registrant's mark, there need only be a viable relationship between the respective goods and services in order to find a likelihood of confusion. See *In re Shell Oil, Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

Applicant's products are metallic dryer vent ducts. The registrant offers retail store services "specializing in a variety of building materials, plumbing supplies, roofing materials, home furnishings and items used in home improvement." These products would include dryer vents, vent kits and duct work.⁴ Accordingly, we find that applicant's metallic dryer vent ducts and the registrant's retail store services are sufficiently related such that when used in connection with a highly similar mark would be likely to cause confusion.

C. The similarity or dissimilarity of established, likely-to-continue channels of trade and classes of consumers.

Because there are no restrictions as to trade channels and classes of consumers in either the application or the

⁴ www.lowes.com attached to the April 30, 2007 Office Action.

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cited registrations, we presume that the goods and services move in all normal trade channels for such goods and services and to all normal classes of purchasers for such goods and services. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Accordingly, we cannot consider applicant's extrinsic evidence or arguments that applicant's products are sold at wholesale, not retail, to restrict the channels of trade and classes of consumers. See *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). We must presume that applicant's metallic dryer vent ducts may be sold in retail stores. In this regard, the registrant's website noted above, indicates that registrant sells dryer vents and ducts. Moreover, the excerpt from the website of *CornerHardware.com* shows that this online retailer in the field of home improvement products such as building materials, hardware, tools, etc., also sells dryer vents and ducts.⁵ Accordingly, we find that the channels of trade and classes of consumers are the same.

⁵ September 20, 2006 Office Action.

E. Balancing the factors.

We have carefully considered all of the evidence of record pertaining to the *du Pont* likelihood of confusion factors, as well as applicant's arguments with respect thereto. For the reasons discussed above, we conclude that applicant's use of the mark LOWES for "ventilation duct components, namely metallic dryer vent ducts" is likely to cause confusion with the registrant's LOWE'S marks and the services described in the registrations.

Surname Refusal

Section 2(e)(4) of the Trademark Act of 1946 provides that registration should be refused if the proposed mark is "primarily merely a surname." "Merely" is synonymous with "only," and "primarily" refers to "first in order" or "fundamentally." Thus, we must determine whether LOWES is fundamentally only a surname. *In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265, 267 (CCPA 1953).

The determination of whether the primary significance of the designation at issue is that of a surname is based on the facts made of record. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). The Examining Attorney has the initial burden to make a *prima facie* showing of surname significance. *Id.* If the Examining Attorney makes that showing, then we must weigh

all of the evidence from the examining attorney and the applicant to determine ultimately whether the mark is primarily merely a surname. *In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994). If there is any doubt, we must resolve the doubt in favor of applicant. *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

In *Benthin*, the Board identified five factors, four of which are relevant here, to consider in determining whether a mark is primarily merely a surname:

1. The degree of the surname's "rareness";
2. Whether anyone connected with the applicant has the involved term as a surname;
3. Whether the mark has any recognized meaning other than as a surname; and,
4. Whether the mark has the "look and sound" of a surname.

Id at 1333. Because LOWES is in standard character form, we need not consider the fifth *Benthin* factor here, that is, whether the manner in which the mark is displayed might negate any surname significance.

The Examining Attorney submitted the following evidence:⁶

⁶ We do not consider the Wikipedia evidence submitted with the April 30, 2007 Office Action (response to a request for reconsideration) because applicant did not have an opportunity to verify and rebut the evidence. *In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1032 (TTAB 2007).

1. The results from a nationwide LexisNexis database search with 440 listings for LOWES;⁷
2. A dictionary definition for LOWES identifying John Livingston Lowes, a "U.S. scholar, critic, and teacher";⁸
3. An excerpt from the *House of Names* website (www.houseofnames.com) describing the Lowes surname. The website identifies "Lowes" as "one of the many names that came to England following the Norman Conquest of 1066. . . . Other instances of this surname are derived from the Anglo-Norman French word 'lou' or 'leu,' meaning a wolf, and in this case, the name was most likely a nickname for a crafty or dangerous person. Spelling variations of this family name include: Lowe, Lowes, Lowis, Lowse, Low, McLoy and others";⁹
4. An excerpt from the Topeka Genealogical Society's 2004 Publication with two listings for LOWES, one for LOW, and two for LOWE;¹⁰ and,

⁷ February 8, 2006 Office Action.

⁸ *Dictionary.com* based on the Random House Unabridged Dictionary (2006) attached to the September 20, 2006 Office Action.

⁹ April 30, 2007 Office Action.

¹⁰ April 30, 2007 Office Action.

5. An advertisement for an abstract of North Carolina wills, including a surname index that includes Lowes, Lowe, and Low.¹¹

1. Rareness

Applicant argued that the 440 listings for LOWES from the LexisNexis database is only 0.000147% of the population of the United States, and therefore LOWES is a rare surname.¹² We agree with applicant that based on the record, LOWES is a rare surname. However, the fact that a surname is rare is not determinative. Even a rare surname may be primarily merely a surname if its primary significance is that of a surname. See *In re Etablissements Darty et Fils*, 225 USPQ 652 (even though DARTY is an unusual name, the Court held that it would be perceived as a surname); *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314, 1315 (TTAB 1990) ("even if REBO is a rare surname, this does not mean that its surname significance would not be recognized by a substantial number of persons); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986) (even a rare surname may not be registered if there is no evidence of that the name has any meaning other than a surname).

¹¹ April 30, 2007 Office Action.

¹² Applicant's Brief, p. 6.

2. Connection with applicant

Applicant stated that no one connected with applicant has the surname LOWES.¹³ While we have considered this fact, it is not determinative of whether LOWES is primarily merely a surname.

3. Recognized meaning other than a surname

This factor inquires as to whether the name has any significance other than as a surname. Applicant stated that it is unaware of any meaning for LOWES other than as a surname,¹⁴ and there is nothing in the record that evidences any other meaning for the name. Accordingly, we find that LOWES has no meaning other than as a surname.

4. Structure and pronunciation

Insofar as this factor is concerned, we consider whether LOWES has the structure and pronunciation of a surname, or the "look and sound" of a surname. *In re Benthin Management GmbH*, 37 USPQ2d at 1333; *In re Industrie Pirelli*, 9 USPQ2d 1564, 1566 (TTAB 1988). This fourth factor is highly subjective and takes into account the likely perception of consumers. As stated in *Pirelli*, "certain rare surnames look like surnames, and certain rare surnames do not and that 'Pirelli' falls into the former

¹³ Applicant's Brief, p. 6.

¹⁴ Applicant's Brief, p. 6.

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category, while 'Kodak' falls into the latter." *In re Industrie Pirelli*, 9 USPQ2d at 1566. We find that LOWES has the clear look and sound of a surname.

We have considered all of the evidence and all of applicant's arguments against this refusal, including those not specifically mentioned in the opinion. Notwithstanding applicant's arguments, we conclude, based on the evidence of record, that LOWES is primarily merely a surname within the meaning of Section 2(e)(4).

Decision: Refusal is affirmed and registration to applicant is refused.

Seeherman, Administrative Trademark Judge, concurring in part and dissenting in part:

I concur with that portion of the majority opinion affirming the refusal of registration on the basis of likelihood of confusion. However, I respectfully dissent from the majority's decision to affirm the refusal on the basis that LOWES is primarily merely a surname. The dispositive factor for me is that LOWES is an extremely rare surname. The Examining Attorney submitted evidence that a search of the LexisNexis database retrieved 440 listings for LOWES. From this, the Examining Attorney made of record "screen shots" showing the first 18. The first

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two listings are for LOWES per se (without a first name or initial) and therefore may represent a business rather than an individual; moreover, as applicant has pointed out, one cannot tell from what was submitted whether there are any duplications of names in the 440 total. However, even if we assume that there are 440 listings of different individuals, there is no question that LOWES is a rare surname. See *In re Joint-Stock Co. "Baik"*, 84 USPQ2d 1921, 1923 (TTAB 2007), in which BAIK was found to be "an extremely rare surname," based on the fact that "only 456 examples of the Baik surname were located from a comprehensive directory of the entire United States."

As I pointed out in my concurring opinion in *Baik*, *id.* at 1924, "the purpose behind Section 2(e)(4) is to keep surnames available for people who wish to use their own surnames in their businesses, in the same manner that merely descriptive terms are prohibited from registration because competitors should be able to use a descriptive term to describe their own goods or services." See *Kimberly-Clark Corp. v. Marball, Comr. Pats.*, 94 F.Supp.254, 88 USPQ 277, 279 (D.D.C. 1950) ("The spirit and the intent of the entire Act indicate that Congress intended to codify the law of unfair competition in regard to the use of personal names as it has been developed by

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the courts. ... At common law it was held that every man had an absolute right to use his own name"). During the hearings on the bills that eventually became the Lanham Act, the testimony shows that Congress was not trying to prevent the registration of surnames per se; one witness pointed out that "almost every word you can think of is somebody's surname, somewhere" and to refuse the registration of a term because "it falls into the general category that there might be a surname somewhere of that kind, that somebody somewhere may bear that name, it merely limits the field of choice." See *Hearings on H.R. 4744 Before the Subcomm. Trade-Marks of the House Comm. On Patents, 76th Cong., 1st Sess. (1939) at 40.*

If a surname is extremely rare, there are very few, if any, people who can be affected by the registration of that surname. This is because not only must there be a person with that surname, but that person must want to use his or her surname for the same or related goods or services as those of the trademark applicant. Accordingly, if the Examining Attorney cannot show that a reasonable number of people have a particular surname, in my view the Office cannot meet its burden of prima facie showing that a mark is primarily merely a surname.

I recognize, as the majority has pointed out, that in some precedential decisions the fact that a surname was rare did not prevent it from being found primarily merely a surname. In those cases, the Board and the Courts looked to other factors, such as whether the term would be perceived as a surname because, for example, it was the name of someone associated with the applicant, or because it was the surname of someone who had public recognition. *See In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1990). However, many of these surname cases were decided prior to the availability of computer databases showing surname listings for everyone in the United States, and therefore there was some uncertainty, based on evidence from a limited number of print telephone directories, about how rare a surname might be. As a result, the Board and the Courts were concerned that the listings in the print directories were just the "tip of the iceberg." I suggest that, with the availability of computer databases from which we can determine whether a term is truly a rare surname, if the name is sufficiently rare we should find it registrable regardless of the evidence on the other factors.