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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 77983232

MARK: C.H. HANSON



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: C. H. Hanson Company

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the Trademark Examining Attorney's final refusal to register the mark "C.H. HANSON" for the following goods:

"Hand tools, namely, chalk line reels; Hand tools, namely, squares; Hand-operated sharpening tools and instruments; Hand-operated tin snips; Pliers; Snips;" in Class 8.

on the grounds of likelihood of confusion, mistake or deception under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), with the mark in Registration No. 3593636 (HANSON) for the following goods:

"Die taps and die sets, taps and tap sets, all the foregoing for use with machine tools" in Class 7; and

"Hand tools, namely, wrenches, and accessories for wrenches, namely, die taps and die sets, taps and tap sets;" in Class 8.

FACTS

Applicant filed this application on June 8, 2009, seeking registration of the wording "C.H. HANSON" in standard characters for the Class 8 goods listed above in addition to goods in Classes 6, 9, 16 and 17.

On September 13, 2009, the examining attorney issued an Office Action in which registration of applicant's mark was refused based on a likelihood of confusion with (1) Registration No. 2304636, which applied to applicant's Class 6 goods, (2) Registration No. 3593636, which applied to applicant's Class 8 goods, and (3) Registration No. 2364950, which applied to applicant's Class 16 goods, which were all for the mark "HANSON" in typed/standard characters. In addition, a potential likelihood of confusion refusal as to applicant's Class 9 goods for Application Serial No. 77407453, for the wording "HANSON" with a design element, was issued as was a requirement for applicant to claim ownership of its prior Registration No. 1433865.

On March 13, 2010, applicant submitted a response to the September 13, 2009, office action. In that response, applicant (1) presented arguments with respect to the Section 2(d) refusals, (2) amended its Class 16 identification of goods, (3) and claimed ownership of Registration No. 1433865. The examining attorney subsequently suspended action on the application pending the disposition of Application Serial No. 77407453, and, after consideration of applicant's arguments with respect to the Section 2(d) refusals, continued and maintained those refusals as to all of the previously cited registrations.

On June 15, 2011, applicant submitted a Response to Letter of Suspension indicating that Application Serial No. 77407453 had registered and requesting removal of the application from suspension for consideration by the examining attorney of a likelihood of confusion refusal relating to that registration. Consequently, on July 7, 2011, the examining attorney issued a non-final Office Action in which a new Section 2(d) refusal was issued for Registration No. 3966633, which is the registration

that matured from Application Serial No. 77407453, while also continuing and maintaining the previous Section 2(d) cites.

On January 12, 2012, after the applicant failed to respond to the July 7, 2011, Office Action within the required six-month time period, applicant filed a Petition to Revive the application (granted the same day) along with a Response to the July 7, 2011, Office Action; in addition, on that date, applicant submitted a second, supplemental Response to Office Action. In those responses, applicant submitted arguments with respect to all cites in the Section 2(d) refusal.

On February 1, 2012, a Priority Action was issued that continued the Section 2(d) refusal with respect to all four cited mark, and also issued a new requirement for applicant to provide additional information relating to its goods. Applicant responded on August 1, 2012, with (1) arguments relating to the Section 2(d) refusals for Registration Nos. 2304636, 3593636, 3966633 and 2364950, (2) amendments to its Class 6 and 16 identifications of goods and (3) additional information relating to its goods.

On August 24, 2012, an Examiner's Amendment was issued in which applicant's Class 16 identification of goods was amended and the Section 2(d) refusals for Registration Nos. 2304636, 3966633 and 2364950 were withdrawn. The Examiner's Amendment stated that further action would be taken, after the issuance of the Examiner's Amendment, with respect to the Section 2(d) refusal for Registration No. 3593636.

On September 14, 2012, applicant filed a Request to Divide the application and, in particular requested that all of Class 8 be divided from the remaining classes in the parent/original application. The Request was granted/processed and applicant's Class 6, 9, 16 and 17 goods remained in parent Application Serial No. 77754790 while applicant's Class 8 goods were assigned to child Application Serial No. 77983232, which is the application at issue in the present appeal.

On October 10, 2012, a final Office Action was issued relating to the Section 2(d) refusal for Registration No. 3593636; however, on October 22, 2012, a non-final Office Action was issued to address the new issue of whether the name "C.H. HANSON" identified a particular living individual and to also advise applicant that its Section 2(f) Claim of Acquired Distinctiveness, which was asserted in the original application, was unnecessary. The Section 2(d) refusal for Registration No. 3593636 was continued and maintained in that Office Action. Applicant responded on April 23, 2013, indicating that "C.H. HANSON" did not identify a particular living individual and again presenting arguments relating to the Section 2(d) refusal for Registration No. 3593636.

On May 20, 2013, a subsequent final Office Action was issued as to the Section 2(d) refusal for Registration No. 3593636 and an advisory was, once again, issued relating to the Section 2(f) claim of acquired distinctiveness as applicant did not address that issue in its April 23, 2013, response.

On November 19, 2013, applicant filed its *ex parte* appeal with the Trademark Trial and Appeal Board and, on that same date, the Trademark Trial and Appeal Board acknowledged applicant's appeal.

Applicant filed its Appeal Brief and Exhibits on January 17, 2014, and, on January 27, 2014, applicant submitted its request for an Oral Hearing.

The file was forwarded to the examining attorney on February 10, 2014, for preparation of this Reply Brief.

ISSUE

The sole issue on appeal is whether the applied-for mark (“C.H. HANSON”), when used in connection with the identified goods, so resembles the mark in Registration No. 3593636 (“HANSON”) as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d).

ARGUMENT

THE PROPOSED MARK CREATES A HIGHLY SIMILAR COMMERCIAL IMPRESSION TO THE MARK IN THE CITED REGISTRATION AND THE GOODS ARE HIGHLY RELATED. THEREFORE, REGISTRATION IS LIKELY TO CREATE CONSUMER CONFUSION AS TO SOURCE.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In*

re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the goods. *Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1938 (TTAB 2013) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see TMEP §1207.01. That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the goods are compared to determine whether they are similar or commercially related or

travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

A. SIMILARITY OF THE MARKS: THE PROPOSED MARK CREATES A HIGHLY SIMILAR COMMERCIAL IMPRESSION TO THE CITED REGISTRATION BECAUSE THEY BOTH CONTAIN OR ARE ENTIRELY COMPRISED OF THE TERM "HANSON".

In a likelihood of confusion analysis, marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534,

1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under applicant's and registrant's marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

In this case, applicant's mark is the wording "C.H. HANSON" in standard characters. Registrant's mark is the wording "HANSON" in standard characters. The marks are similar because they both contain or are entirely comprised of the word "HANSON". The only other matter in either mark is the wording/letters "C.H." in applicant's mark, and, as discussed below, that element of applicant's mark is less significant in forming the mark's overall commercial impressions.

The mere addition of wording/letters, such as "C.H.", to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d

556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE); TMEP §1207.01(b)(iii). There is no other matter in registrant's mark to distinguish the marks; therefore, the existence of the lettering "C.H." in applicant's mark is not likely to resolve any confusion that consumer might have when attempting to determine source.

In particular, the lettering "C.H." indicates a first and middle initial of someone who has the surname "HANSON". The mark "HANSON" merely indicates the surname "HANSON". Therefore, the commercial impression is highly similar in that the surname "HANSON" still appears in the marks and consumers will be under the impression that someone with the surname "HANSON" was involved with the making of the goods. Because registrant's mark does not have any other wording to distinguish it from applicant's marks, consumers will be confused as to source because they will not know whether "C.H. HANSON" is the "HANSON", or one of the "HANSON" family members, referred to in registrant's mark.

Applicant argues that the "HANSON" is a common last name, is "inherently weak for the purposes of applying less significance to [that] term" and, as a result, "the public will look to the other elements to distinguish the source of the goods", namely, the "C.H." element in applicant's mark. See

Applicant's Brief at p. 11 and Applicant's Exhibit submitted to the Trademark Trial and Appeal Board on January 17, 2014.

In support of this proposition/argument, applicant points to the case of Brennan's Inc. v. Brennan's Rest. L.L.C., 360 F.3d 125, 132-133 (2d Cir. 2004) where a denial of a preliminary injunction was upheld when the owners of a registration for the mark "BRENNAN'S" for restaurant services sought an injunction against the users of the mark "TERRANCE BRENNAN'S SEAFOOD & CHOP HOUSE" for restaurant services. The court, in that case, was reviewing a lower court's decision to see if the denial of the injunction constituted an abuse of discretion. The standard of review and the parties involved in the case, namely, the parties who were using the marks, are different from the analysis that must be undertaken in this case, where the issue is whether the denial of registration of federal trademark was proper and where one of the two parties using the marks at issue in the case is not a party to the case. Furthermore, while the court in Brennan's did find the last name Brennan to be a common one, that finding appeared to be based on evidence in the record regarding the number of persons in a telephone directory who use that surname; no such evidence is of record in the present case. In addition, the Brennan's court indicated that its analysis as to why the denial of the injunction was not an abuse of discretion rested on factors that are unrelated to the facts of the present case, namely, that (1) in the restaurant industry, it is common for particular chefs to become known and followed such that consumers associate particular chefs and their names with particular restaurants and (2) the parties provided their restaurant services in geographically distinct areas. The court also discussed the importance of allowing persons to use their surnames in connection with the goods/services that they are providing; however, in the present case, applicant has stated that there is no living individual associated with its mark. Therefore, this factor is not an issue in the present case.

In further support of its argument, applicant points to third party registrations containing the term “HANSON” that have been allowed to coexist for clothing goods. However, the third party registrations submitted by applicant in support of its argument that the term “HANSON” are not relevant and/or persuasive in that they do not show use of the term “HANSON” in Class 8 and/or in use in connection with goods/services that are the same/similar to those of applicant and registrant in this case.

The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar goods*. See *Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). Furthermore, as indicated above and as conceded by applicant, the goods listed in the third-party registrations submitted by

applicant are different from those at issue and thus do not show that the relevant wording is commonly used in connection with the goods at issue. See Applicant's Brief at p. 11-12.

Applicant states that the third party registrations it submitted are for the purpose of (1) "illustrat[ing] that, "for marks all having a common class of goods and utilizing the term 'hanson', numerous USPTO examining attorneys presumably concluded that 'HANSON' was not the dominant term of the composite marks, thus allowing each registration to issue despite the other's existence within the same class" and that (2) "[i]n view of the conclusions of numerous other trademark examining attorneys, such a conclusion should be drawn in this case as well, utilizing Applicant's 'C.H.' as the dominant term to distinguish its composite mark from that of the cited reference". See Applicant' Brief at p. 12.

However, prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); see *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

Furthermore, please note that, of the seven third party registrations cited by applicant, (1) all of them are owned by a total of three different registrants, not seven, and (2) two of the seven third party

registrations do not even contain the term “HANSON”, as indicated by applicant, but rather contain the highly stylized lettering “HAN” or “HAON” and the wording “HANSONI”. See Registration Nos. 3701881, 2906514, 2828600, 2341732, 2341727, 1192177 and 1140858, which are attached to applicant’s August 1, 2012, Response to Office Action.¹ Therefore, the number of examining attorneys who allowed different registrants to have HANSON or HANSON formative marks in the same industry/field is not so numerous that, for consistency purposes, it necessitates allowing the registration of a HANSON formative mark in a different industry/field.

Even assuming arguendo that the term “HANSON” is weak, or is a common last name that is treated as a weak term, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); see, e.g., *In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975).

Finally, where the goods of an applicant and registrant are “similar in kind and/or closely related,” the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); see *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir.

¹ Please note that applicant indicated the mark for Registration No. 1192177 was “TOM HANSON”; however, that registration is for the mark “HANSONI”.

2004); TMEP §1207.01(b). Please see the Similarity of Goods section below discussing the highly related nature of applicant's and registrant's goods in this case.

Accordingly, the relevant marks are sufficiently similar to support and require a finding of likelihood of confusion

B. SIMILARITY OF THE GOODS: THE GOODS ARE HIGHLY RELATED AND ARE LIKELY TO TRAVEL THROUGH THE SAME CHANNELS OF TRADE, BE ENCOUNTERED BY THE SAME CONSUMERS AND/OR EMANATE FROM THE SAME SOURCE.

The goods of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

Consumers are likely to be confused by the use of similar marks on or in connection with goods/services featuring or related to those goods. TMEP §1207.01(a)(ii); see *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (holding 21 CLUB for various items of men's, boys', girls' and women's clothing likely to be confused with THE "21" CLUB (stylized) for restaurant services and towels); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (holding STEELCARE INC. for refinishing of furniture, office furniture, and machinery likely to be confused with STEELCASE for office furniture and accessories).

In this case, applicant's goods are as follows:

"Hand tools, namely, chalk line reels; Hand tools, namely, squares; Hand-operated sharpening tools and instruments; Hand-operated tin snips; Pliers; Snips;" in Class 8.

Registrant's goods are as follows:

"Die taps and die sets, taps and tap sets, all the foregoing for use with machine tools;" in Class 7.

"Hand tools, namely, wrenches, and accessories for wrenches, namely, die taps and die sets, taps and tap sets;" in Class 8.

The most relevant goods for purposes of this analysis are registrant's wrenches. However, both registrant's (1) wrenches and (2) die taps and die/tap sets are related to applicant's wrenches because they are likely to emanate from the same source and/or be provided/marketed in connection with one another. See, e.g., the following webpages that were attached to the July 11, 2011, Office Action (TICRS p. 54-106):

- (1) The webpages from www.craftsman.com evidence that pliers, squares, wrench sets and tap and die sets all emanate from the same source;
- (2) The webpages from www.dewalt.com evidence that snips, pliers, squares and wrenches all emanate from the same source;
- (3) The webpages from www.homedepot.com evidence that pliers and wrenches both emanate from "HUSKY" and that wrenches and snips both emanate from "KLEIN";
- (4) The webpages from www.lowes.com evidence that pliers, wrenches and tap and die sets all emanate from "KOBALT";
- (5) The webpages from www.menards.com evidence that chalk line reels, pliers, squares, tap and die sets, tin snips and wrenches all emanate from "TOOL SHOP";
- (6) The webpages from www.stanley.com evidence that chalk line reels, pliers, squares and wrenches all emanate from the same source; and
- (7) The webpages from www.truevalue.com evidence that wrenches, pliers, snips and tap and dies sets all emanate from "MASTER MECHANIC".

Material obtained from the Internet is generally accepted as competent evidence. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (accepting Internet evidence to show relatedness of goods in a likelihood of confusion determination).

Applicant questions the probative value of various retailer webpages, such as Ace Hardware, True-Value, Home Depot, Lowes, Menards, Sears and Grainger, that were attached to the Office Actions in this application because "these printouts are not probative that the products at issue move in the same channels of trade because it is common knowledge that virtually all products are sold through these outlets". See Applicant's Brief at p. 9. However, most of those webpages, as indicated above, demonstrate not only that applicant's and registrant's goods are sold/marketed in connection with one another but also show that the same brands/manufacturers make the relevant goods.

Applicant then indicated that the Stanley and DeWalt retail websites would be a better indicator of whether applicant's and registrant's goods were related because those retailers only sell tools and

that, while those websites sold tools such as applicant's, they did not sell tap and die sets. However, those websites do indicate that Stanley and DeWalt sell/make wrenches, such as registrant's, even if they do not sell/make tap and dies sets.

Evidence from the USPTO's X-Search database, which consists of a number of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case, also shows that the goods listed therein, namely (1) wrenches and (2) chalk line reels, squares, hand-operated sharpening tools and instruments, tin snips, pliers and/or snips, are of a kind that may emanate from a single source under a single mark. See *In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). See, e.g. the following third party registrations which were attached to the September 13, 2009, Office Action, the July 11, 2011, Office Action and the October 8, 2012 Office Action: Registration Nos. 3593636, 3659669, 3659670, 3492385, 357921, 3394132, 3625318, 3951895, 4126830 and 4199865.

Applicant does not appear to dispute that "common" (i.e. not specialized) wrenches are related to applicant's applied-for goods. Rather, applicant argues that "registrant's 'wrench' is a specialized tool used solely to rotate taps and dies to create internal or external threads on a piece of metal." See Applicant's Brief at p. 6. In support of this argument, applicant submitted evidence from registrant's brochures/website, which includes evidence that registrant not only makes these specialized "drives"/"stocks" but also makes common wrenches. See March 10, 2010, January 12, 2012, and April 23, 2013, Responses to Office Action and attachments thereto. However, because the evidence submitted by applicant indicates that the common wrenches made by registrant are not marketed

under the “HANSON” trademark, applicant argues that its mark should be allowed to proceed to registration. See Applicant’s Brief at p.8.

The question of likelihood of confusion is determined based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Absent restrictions in an application and/or registration, the identified goods are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identifications set forth in the application and registration have no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers.

Applicant argues that the wrenches in registrant's identification of goods are limited to "a specific type of wrench used in relation to taps and dies" and that the punctuation in registrant's identification of goods necessitates this limitation. See Applicant's Brief at p. 6-7. As a result of this interpretation/construction of the identification of registrant's goods, applicant also questions the probative value of some of the third party registrations and webpages submitted by the examining attorney that show relatedness of the goods to the extent that those webpages/third party registrations demonstrate relatedness of applicant's goods and common wrenches rather than relatedness of applicant's goods and specialized wrenches.

However, the limitation suggested by applicant is not a limitation that should or must be imposed on registrant's identification of goods. In fact, the comma after the word "wrenches" in registrant's Class 8 identification of goods actually precludes the limitation that applicant suggests. That comma indicates a break between two separate sets of goods with the first being "wrenches" and the second being "accessories for wrenches, namely, die taps and dies sets, taps and tap sets". The word "and" that follows the comma after "wrenches" further supports the examining attorney's interpretation/construction of the registrant's Class 8 identification of goods. The fact that accessories for a specialized type of wrench are in the Class 8 identification of goods does not mean that all of registrant's Class 8 wrenches are or must be so specialized.

Applicant points to TMEP §1402.01(a) as mandating (1) that the wording "wrenches, and accessories for wrenches, namely, die taps and die sets, taps and tap sets" be read as indicating that all the terms therein "fall within a common particular category of goods", (2) that the terms 'die taps and die sets, taps and tap sets' modify the term "wrenches" because "wrenches" is not separated from the

remaining wording by a semi-colon and, (3) that “the term [wrenches] does not fall into a distinct category separate from that of the taps and dies of class 8”.

However, TMEP §1402.01(a) does not mandate the use of semi-colons in order for goods to be considered as separate and apart from one another. Rather that TMEP section states that “[s]emi-colons *should generally* be used to separate distinct categories of goods or services within a single class” and that “commas *should* be used in the identification to separate items within a particular category of goods or services”. Emphasis added. TMEP 1402.01(a) also states that “[d]eference should be given to the language set forth by the applicant in the original application.” Therefore, nothing in the TMEP required registrant to use a semi-colon in order for it to cover all types of wrenches. As such, registrant should be given the broadest permissible construction of its goods, which includes a construction that does not place a limitation on the type of wrenches that are covered by its registration.

In further support of its argument, applicant pointed to a prior registration owned by registrant as demonstrating that registrant has previously submitted an identification of goods wherein “wrenches” was separated from other goods by semi-colons and that, therefore, the lack of semi-colons separating “wrenches” from the “accessories for wrenches” goods in the cited registration leads to the conclusion that registrant did not intend for its wrenches to be separate goods in the cited registration. See Applicant’s Brief at p. 7-8; see also Registration No. 2978383, which is attached to the October 8, 2012 Office Action and the April 23, 2013, Response to Office Action. The identification in the prior registration contained many more goods than the cited registration and, therefore, the use of and/or need for separation of the goods may have been more apparent in that registration. Furthermore, the use of semi-colons in the prior registration has no bearing on the construction of the identification of

goods in the present registration. Of note, however, is the fact that registrant's prior registration does, clearly and unequivocally, indicate that registrant makes wrenches that are not limited in any way, i.e. that encompass common and specialized wrenches, and that they also make tap and die goods.

Applicant also argues that its purchasers are discerning/sophisticated ones. This argument is premised on a finding that the wrenches in registrant's identification of goods are not common ones, which, as discussed above, is not the case. However, even assuming arguendo that the wrenches were specialized tap and die wrenches and assuming arguendo that the purchasers were discerning/sophisticated ones, this argument is not persuasive because 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. TMEP §1207.01(d)(vii); *see, e.g., Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, [34 USPQ2d 1526, 1530](#) (Fed. Cir. 1995); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

Accordingly, the goods, while not identical, are highly related; as such, there is a likelihood as to confusion as to source of these goods.

CONCLUSION

Applicant's mark, "C.H. HANSON", is likely to be confused with the cited registered mark, "HANSON" (Registration No. 3593636). Applicant's mark creates a similar commercial impression to

that of the cited mark and is used on very closely related goods that travel through the same channels of trade and will be encountered by the same consumers. For the foregoing reasons, it is respectfully requested that the refusal of registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), be affirmed.

Respectfully submitted,

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