

THIS DECISION IS NOT
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OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re G. Loomis, Inc.

Serial No. 78279545

Jerald E. Nagae of Christensen O'Connor Johnson Kindness
PLLC for G. Loomis, Inc.

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(J. Leslie Bishop, Managing Attorney).

Before Rogers, Zervas and Walsh, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

On July 28, 2006, G. Loomis, Inc. ("applicant") filed
an intent-to-use application to register the mark METOLIUS
in standard-character form on the Principal Register for
goods identified as "artificial fishing bait, fishing
hooks, fishing lure boxes, fishing lures, fishing poles,
fishing reels, fishing rod blanks, fishing rods, fishing
tackle boxes and fishing tackle and weights for fishing
lines" in International Class 28.

The Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of Reg. No. 1913483, which issued on August 22, 1995, for the mark METOLIUS in standard-character form for a "house mark for a full line of mountain climbing equipment" in International Class 28.¹ The registration claims both first use and first use of the mark in commerce in September 1983. The registration has been renewed and is active.

Applicant responded to the refusal; the Examining Attorney issued a final refusal; and applicant appealed. Both applicant and the Examining Attorney have filed briefs. We affirm.

PROCEDURAL ISSUES

Applicant submitted evidence with both its main brief and its reply brief which applicant had not filed prior to the filing of the appeal. The new evidence applicant submitted with its reply brief is manifestly untimely. Trademark Rule 2.142(d) requires that the record be complete prior to the filing of an appeal, subject to certain exceptions not relevant here. It is apparent that this evidence was available prior to the filing of

¹ A different Examining Attorney took the first action on this application.

applicant's appeal. Accordingly, we have not considered the evidence applicant submitted with its reply brief.

With its main brief applicant also submitted, for the first time, certain items from the Internet and certain third-party registrations for marks which include "METOLIUS." The evidence applicant provided with its main brief was also untimely. However, the Examining Attorney had the opportunity to object to that evidence in her brief, and she did not do so. Furthermore, the Examining Attorney discussed the Internet evidence submitted with applicant's main brief. Because the Examining Attorney did not object to the Internet evidence and discussed it, we will consider it of record. See In re Gibson Guitar, Corp., 61 USPQ2d 1948, 1952 n.5 (TTAB 2001). We will not consider the registration records because the Examining Attorney did not discuss them, or otherwise treat them as being of record.² Id.

For completeness we also note here that, although we will consider the Internet evidence of record, we will not consider it for any impermissible purpose. Applicant alleges that certain Internet evidence is connected with the owner of the cited registration and that it allegedly

² If we had considered this evidence, we would not reach different conclusions in this case.

shows the manner in which the registrant uses its mark and the goods with which the registrant uses the mark. Applicant also submitted similar evidence with regard to its own mark and goods. In determining likelihood of confusion, we must consider the goods as identified in a cited registration and cannot consider extrinsic evidence regarding a registrant's actual use of its mark. In re Bercut-Vandervoort & Co., 229 USPQ 763, 764 (TTAB 1986) (extrinsic evidence and argument suggesting trade-channel restrictions not specified in application rejected). Likewise, we cannot consider any extrinsic evidence which indicates that either applicant or registrant use the respective marks in a particular manner, as we explain further below. Vornado, Inc. v. Breuer Electric Mfg. Co., 390 F.2d 724, 156 USPQ 340, 342 (CCPA 1968) (" . . . the display of a mark in a particular style is of no material significance since the display may be changed at any time as may be dictated by the fancy of the applicant or the owner of the mark.").

LIKELIHOOD OF CONFUSION

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the

goods of the applicant, to cause confusion . . .” Id. The opinion in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors we may consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of the applicant and registrant. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). Below we will discuss all factors as to which applicant or the Examining Attorney argued or presented evidence.

Comparing the Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of both marks. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Although applicant’s mark and the mark in the cited registration are both METOLIUS in standard-character form, applicant still claims that the marks differ. Applicant argues, as follows:

In context, as an Oregon company, the Registrant is no doubt aware that the Metolius River is only a few miles from its Bend, Oregon headquarters, and the irony is rich that a mountain climbing source would be named after a river. In this context, the imagery of good things flowing from a common source was perhaps appealing to Registrant or the name was simply catchy. In any event the connotation of Registrant's METOLIUS mark is different from that of Appellant's use of the METOLIUS mark as one of several specialized, technical pieces of fishing equipment... As a business specializing in fishing gear Appellant is of course also aware of the Metolius river area-and many other such less-well-known rivers, streams and lakes-and this location's reputation among fishermen and others as "an open meadow and riparian forest harbor(ing) a diversity of plant life alongside the cold waters of the spring-fed Metolius River." (Citation omitted.) In context then, coming from a mountain climbing gear store, the mark Metolius as a house mark on a wide variety of mountain climbing equipment, has a distinct and different connotation and commercial impression than Appellant's METOLIUS mark for specialty fishing gear.

We are not persuaded by applicant's argument. While we concede that a term may take on variations in connotation or commercial impression as a result of its use in relation to different types of goods or services, none of applicant's evidence convinces us that such is the case here. The simple fact is that the marks are identical in appearance and sound and that, to the extent purchasers may recognize the reference to the Metolius River, the connotation and commercial impression would not vary significantly when used with fishing equipment as opposed to mountain climbing equipment. In either instance the

natural beauty of the location and its general suitability for outdoor recreation would most likely dominate the connotation and commercial impression whether it is used in connection with either fishing or mountain climbing equipment.

There is no evidence indicating how widely known the Metolius River is. Potential purchasers who would not recognize METOLIUS as the name of a river would most likely perceive it as an arbitrary designation without any particular meaning. As such, the connotation and commercial impression of the mark would not differ based on its use with the goods of applicant versus those of registrant.

Accordingly, we conclude that the connotation and commercial impression of both applicant's mark and registrant's mark are identical. Finally, we conclude that the marks of applicant and registrant are identical in all respects.

Comparison of the Goods and Channels of Trade

First, we acknowledge, as the examining attorney notes, the importance of the fact that the marks are identical in comparing the goods of applicant and registrant. When the marks are identical, the goods of applicant and registrant need not be as closely related to

find a likelihood of confusion in comparison to cases where the marks differ. Amcor, Inc. v. Amcor Indus., Inc., 210 USPQ 70, 78 (TTAB 1981).

Also, the goods need not be identical to find that the goods are related under Section 2(d) of the Trademark Act. The goods need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods originate from the same source. On-Line Careline Inc. v. America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

Furthermore, in comparing the goods and the channels of trade for the goods, we must consider the goods as identified in the application and registration. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

Applicant first argues that the goods of applicant and registrant "are decidedly different: mountain climbing gear and fishing equipment." This characterization misses the point. The proper inquiry is not whether the goods could be confused, but rather whether the source of the goods could be confused. Safety-Kleen Corp. v. Dresser

Indus., Inc., 518 F.2d 1399, 186 USPQ 476, 480 (CCPA 1975);
In re Rexel, Inc., 223 USPQ 830, 831 (TTAB 1984).

Applicant, in fact, argues most strenuously that the channels of trade for the goods of applicant and registrant differ. In presenting this argument applicant relies on Internet web pages which are allegedly associated with registrant and attempts to show that in the Seattle area the dealers carrying registrant's products are limited to a number of specific retailers. Applicant also presents similar evidence regarding its own goods to show that its goods are sold through different outlets in Seattle than registrant's goods.

As we noted above, we must consider both applicant's and registrant's goods, as identified in the application and registration, and we cannot consider extrinsic evidence purporting to show that the goods or channels of trade are somehow limited. In re Bercut-Vandervoort & Co., 229 USPQ at 764. Neither the application nor the cited registration specify any limits as to trade channels, on the Internet or otherwise. Accordingly, applicant's evidence and arguments which focus on the results of an Internet search for a particular geographic location are of limited probative value. Needless to say, a search outside Seattle or one using different media might yield very different results.

The Examining Attorney has offered evidence to show that both types of goods, fishing equipment and mountain climbing equipment, travel in the same trade channels. Specifically, the Examining Attorney has submitted copies of pages from two Internet web sites, that is, www.eshopjacksonhole.com and www.gorp.away.com. We find this evidence both probative and sufficient to show that the two types of goods could be sold through the same trade channels.³

Applicant's own evidence lends some further support to the position that both types of goods could be sold through the same trade channels. Specifically, applicant provided copies of web pages from www.landbigfish.com where its own fishing equipment is available. The site also includes a link to camping and outdoor gear, including, tents, hand-held GPS devices and back packs - equipment which might be used by mountain climbers.

The Examining Attorney also correctly points out that the Board has previously found different types of sporting goods related. See, e.g., In re New Archery Prods. Corp.,

³ The Examining Attorney also submitted copies of two pending applications covering both types of goods. This evidence is not probative of the issues in this appeal, and we have not considered it. Third-party applications have no probative value other than as evidence that the applications were filed. In re Phillips-Van Heusen Corp., 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

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218 USPQ 670, 671-672 (TTAB 1983) (“... it seems to us that fishing lures and arrowheads are closely related.”); Trak Inc. v. Traq Inc., 212 USPQ 846, 851 (TTAB 1981) (holding trade channels for racquetball racquets and skis and ski boots overlapping stating, “Moreover, absent any restriction in Traq's application for registration, the channels of trade must be presumed to be the same.”); A. G. Spalding & Bros. Inc. v. Bancroft Racket Co., 149 USPQ 391, 393-394 (TTAB 1966) (tennis and squash racquets held related to golf clubs).

We also reject applicant's comparison of the examining attorney's evidence to the use of evidence from outlets, such as Costco, where goods of all types are offered. The evidence here is clearly directed to equipment for use in outdoor sports and similar or related activities.

Applicant also argues that the purchasers for the two different types of goods are distinct. Applicant has not offered any evidence to support this contention. In the absence of evidence to the contrary, we assume that there are individuals who engage in both fishing and mountain climbing and would be potential purchasers for both types of goods.

Accordingly, we conclude that the goods of applicant and registrant are related and that the channels of trade

for the goods of applicant and registrant could be the same or overlapping.

Purchaser Sophistication

Applicant also argues that the purchasers for the goods are sophisticated and that therefore confusion is less likely. Applicant asserts that its products are technologically advanced and relatively expensive, noting that one of its products ranges in price from \$345 to \$445. Applicant states, "Additionally, 'Where the goods involve significant cost, the relevant buyers are virtually certain to be informed, deliberate buyers . . . This is not the sort of purchasing environment in which confusion flourishes.' *Oreck Corp. v. U.S. Floor Systems, Inc.*, 231 USPQ 634, 640 (5th Cir. 1986), *reh'g denied en banc*, 808 F.2d 56 (5th Cir. 1986), *cert. denied*, 481 U.S. 1069 (1987)." The Examining Attorney disagrees and states that such purchasers are not immune from trademark confusion.

We agree with the Examining Attorney. First, based on the identification of goods in both the application and registration we assume that the goods of both applicant and registrant could vary in price from relatively inexpensive items to more expensive items, including those in the price range applicant suggests for one of its items. Even if we did assume that the goods of both applicant and registrant

are relatively expensive, and that the goods consequently would be purchased with a significant degree of care, we would not also assume that all purchasers are sophisticated. That is, in the absence of evidence to the contrary, we assume that the goods of both applicant and registrant may be purchased by members of the general public with an interest in either fishing or mountain climbing who possess varying degrees of sophistication. Furthermore, as the Examining Attorney noted, even sophisticated purchasers are not immune from trademark confusion. In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983). Accordingly, we conclude that the evidence in this application bearing on the sophistication of the potential purchasers fails to indicate a diminished likelihood of confusion.

Conditions of Sale

Applicant also argues that the conditions of sale for both its products and those of registrant will preclude confusion. Specifically, applicant states:

... advertisements for Appellant's products market and sell goods using the METOLIUS mark as a third-tier trademark. Consumers first encounter the G. LOOMIS house mark and company name. Second, the line of fishing products is seen labeled with a second-tier mark: STREAMDANCE. In the StreamDance line of products there are several quality levels, and products with the G. LOOMIS STREAM DANCE METOLIUS marks are mid-grade and mid-priced in that line. The

term METOLIUS is not prominently displayed alone on the products, but is always displayed as connected to the G. Loomis and StreamDance marks and in a lesser manner than the other, more significant marks.

As to the registrant, applicant correctly argues that the cited registration specifies that the registered mark is a house mark. Applicant argues further that, "The mark is not used directly on the mountain climbing products themselves, and none of the Registrant's products are marked with the term METOLIUS." Applicant appears to base the representations about registrant's use of its mark on materials it submitted from the web pages applicant alleges to be associated with registrant.

We do not find these arguments persuasive. First, as we noted above, we will not consider evidence or argument regarding the registrant offered for the purpose of showing that registrant's use of the registered mark is limited in a manner not specified in the registration itself. In re Bercut-Vandervoort & Co., 229 USPQ at 764. Accordingly, we reject applicant's argument that the registrant does not place its mark on any of its goods and its other arguments suggesting limits on registrant's use of its mark. Registrant may, in fact, use its house mark alone or with other marks, and it may or may not be recognized as a house mark by potential purchasers.

Likewise, we reject applicant's allegations regarding the manner of its use of its own mark. Applicant has applied to register METOLIUS in standard-character form by itself. If applicant secured a registration for METOLIUS on that basis, the registration would afford applicant a presumption of its exclusive right to use that mark without regard to the use of any first-tier or second-tier marks in conjunction with METOLIUS. Vornado, Inc. v. Breuer Electric Mfg. Co., 156 USPQ at 342. In fact, applicant could use the mark as a house mark.

In sum, on this record we reject applicant's arguments which attempt to draw distinctions between applicant and registrant based on the allegations that conditions regarding the use of the respective marks differ.⁴

CONCLUSION

After considering all of applicant's arguments and evidence bearing on the du Pont factors, we conclude that there is a likelihood of confusion between applicant's mark and the cited registered mark principally because the marks are identical, because the goods of applicant and

⁴ In its briefs applicant has cited a number of cases which originated in the district courts. These cases involve infringement and similar claims where the focus is on the actual use of marks. These cases are of limited relevance here due to our focus in this proceeding on the particulars of the application and registration, not actual use. In re Bercut-Vandervoort & Co., 229 USPQ at 765 (TTAB 1986).

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registrant are related, and because the channels of trade for the goods are the same or overlapping.

Furthermore, if we had any doubt in this case, we would resolve it in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register applicant's mark under Section 2(d) of the Act is affirmed.