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Mailed:  
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tomberlin Product Group, LLC.

Serial No. 78734308

Timothy E. Moses of Hull, Towill, Norman, Barrett & Salley  
for Tomberlin Product Group, LLC.

A.D. Saunders, Trademark Examining Attorney, Law Office 109  
(Dan Vavonese, Managing Attorney).

Before Zervas, Mermelstein and Wellington, Administrative  
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On October 17, 2005, Tomberlin Product Group, LLC  
("applicant") filed an application (Serial No. 78734308)  
for registration on the Principal Register of the mark  
ANVIL (in standard character form) for "land vehicles,  
namely, electric utility cars" in International Class 12.  
Applicant has claimed an intention to use the mark in  
commerce under Section 1(b) of the Trademark Act, 15 U.S.C.  
§ 1051(b).

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The examining attorney has finally refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), in view of Registration No. 2680860 for the mark



for "tires" in International Class 12. The registration record states that the mark contains a stylized depiction of an anvil.

Applicant has appealed the final refusal of its application. Both applicant and the examining attorney have filed briefs. The refusal to register is affirmed.

Before turning to the merits of this case, we address one evidentiary issue. Applicant, with its brief, submitted several third party registrations and several web pages. The examining attorney's objection to this evidence is well taken because the record in the application should be complete prior to the filing of an appeal. See Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d) ("The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed.") We therefore have not considered this evidence

in arriving at our decision. However, even if we had considered this evidence, our disposition of this case would not be any different.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first consider the similarity or dissimilarity of the marks in their entirety. Specifically, we consider whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

Applicant's mark consists only of the word ANVIL, and registrant's mark consists of the word ANVIL and a stylized

depiction of an anvil. The wording in the marks is identical; therefore the marks are identical in sound and meaning. Further, we agree with the examining attorney that the word portion of registrant's mark dominates over the design portion of its mark; the word portion of the mark would be used in referring to the goods. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) (although the marks must be considered in their entirety, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark.) Additionally, the anvil design merely reinforces the word component of the mark. Thus, the commercial impression of the marks is the same. We conclude too that the marks are highly similar in appearance inasmuch as both marks contain the term ANVIL and no other wording, and applicant, who has applied for registration of its mark in typed form, is not restricted to any particular style of lettering and may adopt registrant's style of lettering. Thus, when we consider the marks as a whole, we find the marks to be similar and resolve the *du Pont* factor regarding the similarity of the marks against applicant.

We next consider the *du Pont* factor regarding the similarity or dissimilarity and nature of the goods. The

goods need not be identical or even competitive in order to find that the goods are related for purposes of our likelihood of confusion analysis. It is sufficient that the goods be related in some manner, or that the circumstances surrounding their use be such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

In support of her contention that the goods are related, the examining attorney has submitted various use-based third-party registrations with her final Office action which show that various trademark owners have adopted a single mark for goods of the kind that are identified in both applicant's application and the cited registration. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d

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1783 (TTAB 1993). The following five registrations are relevant:<sup>1</sup>

Registration No. 1220779 for VOLVO for, inter alia, cars and tires;

Registration No. 2464267 for AUTOBACS for, inter alia, electric vehicles, namely, cars, and land vehicle parts, namely, tires;

Registration No. 3091881 for STATUS QUO for, inter alia, electric vehicles and tires for vehicle wheels;

Registration No. 2599645 for RESTOMOD for, inter alia, tires and cars; and

Registration No. 3166894 for SURF CITY USA for, inter alia, cars, motorized golf carts and tires.

We find that the examining attorney has established prima facie at least a viable relationship between the goods at issue through her evidence of third-party registrations. Additionally, as pointed out by the examining attorney, the Board in the past has found a likelihood of confusion in cases involving the use by different parties of the same or similar marks for vehicles, on the one hand, and for

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<sup>1</sup> Several of the third-party registrations submitted by the examining attorney do not show any of the goods identified in both applicant's and registrant's identifications of goods. We do not give these registrations any further consideration.

Additionally, we do not give further consideration to those registrations submitted by the examining attorney that are not use-based, that include a "laundry list" of goods and services, and that do not recite goods of the kind identified in applicant's and registrant's identifications of goods, including those registrations that specifically exclude tires from the claimed goods.

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various vehicle parts or accessories, including tires, on the other. See *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984) (LAREDO for land vehicles and structural parts therefor confusingly similar to LAREDO for pneumatic tires); *Ford Motor Company v. Hi-Performance Motors, Inc.*, 186 USPQ 64 (TTAB 1975) (representation of a coiled snake for automobile tires likely to cause confusion with COBRA for automobiles and automobile components).

Applicant has argued that registrant's goods are "indoor, industrial, non-marking, white tires specifically for forklifts," relying on the contents of registrant's webpage which applicant submitted after filing the notice of appeal. Brief at p. 2. Because registrant's identified goods are not limited to tires for forklifts but are broad enough to include tires for electric utility cars, and because we must consider the goods as described in registrant's identification of goods rather than the goods on which registrant actually uses its mark, see *Dixie Restaurants*, 41 USPQ2d at 1534, quoting *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987), we reject those of applicant's arguments which are premised on applicant using its mark only on forklift tires.

In view of the foregoing, we resolve the *du Pont* factor regarding the similarity of the goods against applicant.

We now consider the *du Pont* factor regarding the similarity of established, likely-to-continue trade channels. Applicant maintains that the trade channels are not related because registrant "is a renowned, straight-independent, tire dealer in [eight states in] the Pacific Northwestern United States" with tire service centers, while applicant sells its goods in recreational vehicle stores, "the type that sell motorcycles, ATVs and go-carts," in Georgia and South Carolina. Brief at unnumbered pp. 5 - 6. The problem with applicant's argument is that there are no trade channel or geographic restrictions in the identifications of goods of the registration and the application. Because there are no such restrictions, registrant's and applicant's goods must be presumed to travel in all trade channels normal for such goods throughout the United States. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). We therefore must presume that both applicant's and registrant's goods as described will both be sold through, e.g., Internet retailers and electric utility car dealerships which sell both electric utility

cars and parts for electric utility cars. Thus, we resolve the third *du Pont* factor against applicant.

As to the *du Pont* factor focusing on the conditions under which and buyers to whom sales are made, we note that goods such as golf carts would be included within applicant's identification of goods and that purchasers of both applicant's and registrant's goods would include members of the general public who buy such goods. Of course, applicant's goods are likely to be expensive and purchases of its goods would be undertaken with some care. As for registrant's goods, we acknowledge that the tires for electric utility cars included with the scope of registrant's goods would be costly enough that they could not be considered to be impulse purchases. Additionally, because the tires must be compatible with the tire specifications set by the electric utility car manufacturer, replacement tires will be bought with greater care than would be the case with more inexpensive, routine purchases. However, this does not mean that applicant's and registrant's purchasers are immune from source confusion; even sophisticated purchasers and purchasers who carefully make their purchasing decisions are not necessarily immune from source confusion. See, e.g., *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132

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USPQ 289 (CCPA 1962); *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). In this case, because of the identical wording in the marks and the relatedness of the goods, we find that even sophisticated purchasers and those who take care in their purchasing decisions regarding purchases of applicant's and registrant's goods are likely to believe that applicant's and registrant's goods emanate from a single source. The *du Pont* factor regarding the conditions under which and buyers to whom sales are made therefore only slightly favors applicant.

Additionally, applicant states that there have been no instances of actual confusion between the marks. Brief at p. 7. It is not necessary to show actual confusion in order to establish likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). On the record before us there is no evidence as to whether there has been any opportunity for confusion to occur - we have no information as to the extent of applicant's use, or that of registrant.

Additionally, applicant has argued that applicant and registrant have been selling in distant geographic areas that do not overlap, which suggests that applicant's consumers have not had a chance to encounter registrant's goods and vice versa. Applicant's argument regarding

actual confusion therefore is unpersuasive, and the *du Pont* factor regarding actual confusion is neutral.

When we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, we conclude that, when potential purchasers of applicant's and registrant's goods encounter the applied-for and registered marks for their respective goods, they are likely to believe that the sources of these goods are in some way related or associated with one another. As a result, there is a likelihood of confusion. Although we have stated that the *du Pont* factor regarding the conditions under which and buyers to whom sales are made weighs slightly in applicant's favor, it is not sufficient to outweigh our findings on the other *du Pont* factors, all of which are neutral or favor registrant.

**DECISION:** The refusal to register under Section 2(d) of the Trademark Act is affirmed.