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*Decision Mailed:
May 19 2008
GDH/gdh*

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Banom, Inc.

Serial No. 78869262

Stanley H. Cohen of Caesar, Revise, Bernstein, Cohen & Plotilow,
Ltd. for Banom, Inc.

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Before Quinn, Hohein and Walters, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Banom, Inc. has filed an application to register the
mark "GRIP-RITE" on the Principal Register in standard character
form for "protective gloves for industrial use" in International
Class 3.¹

Registration has been finally refused under Section
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that
applicant's mark, when applied to its goods, so resembles the
mark "GRIPRITE," which is registered on the Principal Register in

¹ Ser. No. 78869262, filed on April 25, 2006, which is based on an
allegation of a bona fide intention to use such mark in commerce.

standard character form for "footwear, namely, shoes and boots" in International Class 25,² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed and briefs have been filed. We reverse the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.³ See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Here, because applicant's mark and registrant's mark are essentially identical in all respects as to sound, appearance, connotation and commercial impression,⁴ the primary focus of our inquiry is

² Reg. No. 2,942,964, issued on April 19, 2005, which sets forth a date of first use anywhere and in commerce of April 15, 2003.

³ The court, in particular, pointed out that: "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." 192 USPQ at 29.

⁴ Applicant, we note, states in its initial brief that "[i]t is admitted that the marks in issue are nearly identical."

accordingly on the similarity or dissimilarity of the respective goods and their established, likely to continue channels of trade, although the strength or weakness of the marks at issue, including the number and nature of any similar marks in use on similar goods, is also a factor to be considered in assessing whether there is a likelihood of confusion.

Turning to the latter factor first, applicant argues in its initial brief that "the mark GRIPRITE is a highly diluted mark, having been registered by numerous others" as shown by a list made of record by applicant from its search of "prior registrations for the mark GRIPRITE ... [or GRIP-RITE as] determined from the TESS database." Applicant maintains that such evidence shows "numerous different companies owning registrations for the mark GRIPRITE [or GRIP-RITE}." While acknowledging that the mere existence of the third-party registrations "does not prove that the marks covered by the registrations are in use," applicant contends that such registrations do serve to prove that "the mark is highly diluted and has been adopted because of its suggestive connotation." In view thereof, applicant insists that "the mark GRIPRITE is not a distinctive mark, which might entitle it to a broad range of protection." Instead, while conceding that "the marks in issue are nearly identical," applicant urges that "in view of the dilute nature of the registered mark, it is entitled to only a minimal scope of protection" and that, given "the wide differences in the goods at issue, no likelihood of confusion will result."

The Examining Attorney, while acknowledging in his brief that "the term, 'GRIPRITE,' suggests the [respective] goods have some appropriate level of grasping ability," argues that even if applicant has shown that the cited mark is weak, such mark is "still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods," citing *Hollister Inc. v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976). In addition, the Examining Attorney points out that (*italics in original*):

[A] review of the third-party registrations supplied by the applicant in support of its argument that the term, GRIPRITE, is diluted, yields evidence that the mark is, in fact, not diluted. Of the twenty-five (25) active registrations referenced by the applicant, twenty-one (21) of those registrations are owned by a single registrant for, primarily, metal fasteners and construction tools. The remaining four (4) registrations are [also] for goods completely unrelated to the goods at issue in the instant case. Third-party registrations may be of value to the extent that they indicate that a particular word, feature or design has been adopted and registered by others *in a particular field* ... and, thus, that registration of a mark consisting of that word or design or containing that feature, for goods ... *in the same or related field*[,] should be given more restricted scope of protection. *Pizza Inn, Inc. v. Russo*, 221 USPQ 281 (TTAB 1983). However, such is not the case here and, based on the foregoing, applicant's argument that the mark is weak and/or diluted is without merit.

Suffice it to say that a mark may be shown to be weak extrinsically, such as by its widespread adoption and/or use by others as a mark for similar goods and/or as a part of marks for the same goods, or intrinsically in view of its highly suggestive connotation in relation to its associated goods. Here, even

though, as contended by the Examining Attorney, it appears that applicant has failed to establish the extrinsic weakness of the mark "GRIPRITE" with respect to the cited mark, it is still the case, as acknowledged by the Examining Attorney, that such mark is intrinsically weak in that, like applicant's mark, it is highly suggestive of the ability of the respective goods to provide a good or "right" grip on either a surface, as in the case of footwear such as shoes and boots, or an object, as in the case of protective gloves for industrial use. Consequently, while both applicant's and the cited registrant's marks share the same highly suggestive connotation, such identity is likely to cause confusion only if the respective goods are considered to be related in a commercial sense, which is the primary focus of our inquiry herein.

Turning, therefore to the issue of the similarity or dissimilarity of the respective goods, it is well established that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the application and the cited registration. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Moreover, as the Examining Attorney correctly observes in

his brief, it is well established that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is instead sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same entity or provider. See, e.g., *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). Furthermore, as the Examining Attorney also correctly notes, where--as here--the marks at issue are essentially identical, the relationship between the respective goods "need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks." See, e.g., *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992),⁵ cert. denied, 506 U.S. 1034 (1994); and *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001).

In light of such principles, the Examining Attorney contends that "the goods of the applicant and registrant are sufficiently related that there is a likelihood of confusion as to source," arguing in particular that:

⁵ As stated by the court: "When marks would appear on virtually identical goods ..., the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines."

The applicant's "protective gloves for industrial use" and the registrant's "footwear, namely, shoes and boots," are all items that are worn by the users. As items that are worn by the users, the goods of both the applicant and registrant would be present or marketed in the same channels of trade.

As to applicant's assertion that its goods are "protective gear used in industry" and thus, unlike items of clothing or articles of apparel, including footwear, which "would normally be purchased wherever consumer goods are available," would instead be purchased by "the specific industries that use Applicant's gloves," including "paper manufacturing, automobile interior manufacturing and industrial woodwork," the Examining Attorney maintains that:

Since the identification of the registrant's goods is very broad, it is presumed that the registration encompasses all goods of the type described, including those in the [same field as] applicant's more specific identification, that they move in all normal channels of trade and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)

Applying the above to the facts in the instant case, registrant's "footwear, namely, shoes and boots," is sufficiently broad an identification as to encompass such goods for industrial use including use by customers in the industries referenced by the applicant. Therefore, the goods ... [at issue] are of a type that would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods ... come from a common source.

As support for his position, the Examining Attorney has made of record copies of several use-based third-party registrations (of which we find only the following five--rather than ten as asserted by the Examining Attorney--to be the most

pertinent)⁶ for marks which are variously registered for both "protective clothing, ... gloves for industrial use, [and] protective footwear" in International Class 9 and "clothing, namely, gloves, shoes, ... [and] boots" in International Class 25; "protective industrial boots; ... [and] protective gloves for industrial use" in International Class 9 and "boots" in International Class 25; "protective gloves for industrial use" in International Class 9 and "general work gloves ... [and] rainwear, namely[,] ... boots" in International Class 25; "protective work gloves" in International Class 9 and "apparel, namely, ... shoes, boots, [and] gloves" in International Class 25; and "protective gloves, namely, welder's gloves, heat and fire resistant gloves and cult, abrasion resistant gloves; protective industrial shoes and boots" in International Class 9 and "work clothing, namely, ... rain boots" in International Class 25. Although it is the case that such registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, the Examining Attorney is nonetheless correct that the registrations have some probative value to the extent that they serve to suggest that the goods

⁶ While the Examining Attorney appears to rely on a number of registrations for goods which are broadly identified as "protective clothing" or "protective gloves" as necessarily encompassing "protective gloves for industrial use," we elect not to do so inasmuch as the registrations variously set forth such specifically different items as "protective clothing for indoor and outdoor use, namely, ... gloves"; "protective gloves and gas detectors"; and "protective clothing, namely, crash helmets, helmet visors, chin guards, gloves, reinforced boots, shoulder pads, mouth guards, protective nylon and leather pants, and shoulder protectors." Likewise, we do not consider registrations for "gloves and mittens, ski gloves and driving gloves" as including "protective gloves for industrial use."

listed therein, including in particular protective gloves for industrial use and footwear, namely, shoes and/or boots, are of the kinds which may emanate from a single source. See, e.g., In re Infinity Broadcasting Corp. of Dallas, 60 USPQ2d 1214, 1217-18 (TTAB 2001); In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd as not citable precedent*, No. 88-1444 (Fed. Cir. Nov. 14, 1988). In view thereof, the Examining Attorney maintains that "the specific third-party registrations referenced above do, in fact, evidence the relatedness of the goods" at issue in that they show that "entities that provide industrial or protective wearing apparel also provide non-industrial or protective wearing apparel as well."

In addition, the Examining Attorney relies in support of his position upon "Internet evidence of three (3) entities that provide both goods in the nature of the goods of the applicant and registrant in the instant case."⁷ Consisting of excerpts from websites for northernsafety.com, shoesforcrews.com and unitedglove.com, the evidence shows various brands of protective gloves and other kinds of work gloves being offered by each on-line retailer of such products along with different brands of street shoes and/or work boots. While the Examining

⁷ Contrary to the suggestion in applicant's initial brief that such evidence is untimely under Trademark Rule 2.142(d), the Examining Attorney is correct in his brief that he "is entitled to introduce additional evidence in an Office action denying an applicant's request for reconsideration." See TBMP §1207.04 (2d ed. rev. 2004) and TMEP §715.03 (5th ed. 2007). The evidence therefore is properly of record and may be considered for whatever probative value it may have.

Attorney acknowledges that applicant "argues, in effect, that the evidence fails to support that the goods are related because the evidence fails to show goods identical to that of the applicant and registrant in the instant case," the Examining Attorney nonetheless urges that such evidence is an indication that applicant's and registrant's goods are related in a commercial sense and thus that a likelihood of confusion would exist if sold under the marks at issue herein.

Although admittedly somewhat of a close question, we are constrained, however, to agree with applicant that, on this record, confusion as to origin or affiliation of the respective goods has not been demonstrated to be likely. In particular, we concur with applicant that the respective goods are specifically different and are likely to be sold through different channels of trade. Moreover, as previously discussed, the marks at issue are highly suggestive and, thus, the scope of protection to which such are entitled is much less than would be the case for more distinctive or arbitrary marks. As applicant persuasively argues, its goods simply have not been shown to be "closely related to the registrant's goods." Specifically, as applicant points out in its initial brief:

The registrant's goods are footwear, namely, shoes and boots. These goods are wearing apparel, commonly bought in a consumer shoe store.

Applicant's goods are not items of clothing. They are protective gear used in industry. They are not apparel.

Whereas footwear would normally be purchased wherever consumer goods are available, protective gloves for industrial use are purchased by the industries that use such gloves.

Accordingly, applying the criteria set forth ... [above], the goods in issue would not normally be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods come from a common source.

Clearly, on this record, while ordinary consumers would be purchasers of registrant's footwear, namely, shoes and boots as items of wearing apparel, nothing demonstrates that they would also be purchasers of applicant's protective gloves for industrial use, which are safety equipment bought by the industries in which such goods are used as protection for their employees who need such equipment. Furthermore, while registrant's footwear, namely, shoes and boots in International Class 25 arguably includes work shoes and work boots, which concededly have use beyond that of just wearing apparel, it is still the case that such goods are not the kinds of protective or safety apparel which, like applicant's protective gloves for industrial use, the record shows are generally classified in International Class 9 and, thus, registrant's goods do not include the types of protective or safety gear which would, like applicant's goods, be purchased by the industries in which those goods are used. As applicant repeatedly emphasizes, "the goods in issue are not encountered by the same consumers under the same purchasing circumstances," at least as evidenced by the limited record herein.

Moreover, neither the third-party registrations nor the Internet or website excerpts demonstrate that applicant's goods and registrant's goods share a common channel of trade. In particular, the website excerpts are at best analogous to a mass merchandiser, in which different products are sold at retail in different sections of the store. As applicant accurately observes in its initial brief with respect to such evidence:

The first Web site is for a company identified as NORTHERN SAFETY. Based on the Web pages, the company sells a wide variety of safety equipment, including safety gloves and safety boots.

The shoes and boots of the [cited] registration are for wearing apparel. As pointed out above, these are consumer products, whereas Applicant's protective gloves are specialty products, sold through industrial channels of trade.

The Web pages for a company identified as SHOES FOR CREWS appears to sell a wide variety of products, including footwear The trademark used on the gloves, which do not appear to be industrial gloves, is different from the trademark used on all of the footwear products.

The third Web site is for a company identified as UNITED GLOVE. This company appears to sell a wide variety of gloves. Although there are rubber boot shown on the Web site, these appear to be snow boots or wader boots. No trademark is associated with the boots. Nothing on this Web site shows that a single trademark is used for both the boots and the gloves.

In summary, none of the Web sites shows that the use of a trademark on protective gloves for industrial use would be likely to cause confusion with a trademark used on shoes and boots.

Given, therefore, the absence of any significant evidence demonstrating that protective gloves for industrial use and

footwear, namely, shoes and boots, are typically sold in the same channels of trade under the same or substantially similar marks, there simply has been no showing that circumstances are conducive to a likelihood of confusions.

We accordingly conclude on this record that contemporaneous use by applicant of its highly suggestive "GRIP-RITE-" mark in connection with its "protective gloves for industrial use," would not be likely to cause confusion with registrant's use of the essentially identical, highly suggestive "GRIPRITE" mark in connection with its "footwear, namely, shoes and boots."

Decision: The refusal under Section 2(d) is reversed.