

This Opinion is Not a  
Precedent of the TTAB

Oral Hearing: July 10, 2019

Mailed: September 4, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Smith & Wesson Corp.*

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Serial No. 87390227

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Hara K. Jacobs and Jenna M. Loadman of Ballard Spahr LLP,  
for Smith & Wesson Corp.

Megan K. Harnett, Trademark Examining Attorney, Law Office 123,  
Susan Hayash, Managing Attorney.<sup>1</sup>

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Before Zervas, Kuczma and Dunn,  
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Smith & Wesson Corp. (“Applicant”) filed an application for registration on the Principal Register of the standard character mark M&P SHIELD for the following goods:

Knives; hunting knives; fishing knives; knives for hobby use; leather sheaths for knives; tactical knives; pocket knives; cutlery; sport knives; utility knives; pen knives; folding knives; fixed blade knives; multi-purpose tools, namely, multi-function hand tools comprised of knives

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<sup>1</sup> Examining Attorney Kathleen Schwarz argued for the Office at the oral hearing.

and hand-operated can openers; hatchets; machetes in International Class 8.<sup>2</sup>

The Examining Attorney refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark is likely to cause confusion with the standard character mark SHIELD registered on the Principal Register for "knives" in International Class 8.<sup>3</sup>

After the refusal was made final, Applicant appealed to this Board and filed a request for reconsideration. The Examining Attorney denied the request for reconsideration and maintained the refusal. Applicant then filed a request for remand to the Examining Attorney to consider additional evidence, which the Board granted. The Examining Attorney was not persuaded by the additional evidence and maintained the refusal to register. The Board resumed the appeal, and Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

#### I. Evidentiary Issue

The Examining Attorney objects to Applicant's inclusion of photos and screenshots at pp. 17-18 of its appeal brief because the photos and screenshots had not been submitted into the record. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), provides that the "record in the application should be complete prior to the filing of an appeal," and that "[e]vidence should not be filed with the Board after the filing of a notice of

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<sup>2</sup> Application Serial No. 87390227, filed on March 29, 2017 pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), asserting a bona fide intent to use the mark in commerce. Applicant claims ownership of Registration No. 4997903 for the standard character mark M&P SHIELD for "firearms" in International Class 13.

<sup>3</sup> Registration No. 4952359, registered May 3, 2016.

appeal.” “If the appellant . . . desires to introduce additional evidence after an appeal is filed, the appellant . . . should submit a request to the Board to suspend the appeal and to remand the application for further examination.” *Id.* Applicant did not do so, and there are differences between what was submitted into the record and what is depicted on these pages of Applicant’s brief. We sustain the Examining Attorney’s objection to Applicant’s untimely evidence and have given it no consideration in our decision. *See, e.g., In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018). We have considered all of the evidence that was properly submitted into the record.

## II. Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) (“*DuPont*”); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that “[t]he 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.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortgage Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

a. The Similarity of Goods, Trade Channels and Classes of Purchasers

Both Applicant's and Registrant's identifications of goods identify "knives"; the goods therefore are identical. The Trademark Examining Attorney need not prove, and we need not find, similarity as to each and every product listed in Applicant's identification of goods. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods in a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017).

Turning to the channels of trade and classes of purchasers, because the goods are identical and there are no limitations as to channels of trade or classes of purchasers in either the application or cited registration, we must presume that Applicant's and Registrant's goods will be sold in the same channels of trade and will be bought by the same classes of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003). The *DuPont* factors regarding the similarity of the goods, trade channels and classes of purchasers weigh in favor of finding a likelihood of confusion.

b. The Similarity of the Marks

We compare Applicant's M&P SHIELD mark and Registrant's SHIELD mark "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imps.*, 73 USPQ2d at 1691 (quoting *DuPont*, 177 USPQ at 567). 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 terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)). Further, marks "must be considered ... in light of the fallibility of memory ...." *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

We may not dissect the involved marks when comparing the marks but must consider them in their entireties. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 750-51 (Fed. Cir. 1985). Nonetheless, there is nothing improper in stating that,

for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 76 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). Additionally, because the goods are identical, the marks need not be as close as would be necessary if there were a disparity between the goods. *See, e.g., Bridgestone Ams. Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (“When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.”).

Applicant’s and Registrant’s marks are in standard characters. The rights associated with a mark in standard characters reside in the wording and not in any particular display. *In re RSI Sys., LLC*, 88 USPQ2d 1445 (TTAB 2008); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). Because standard character marks may be depicted “regardless of font style, size, or color,” *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011), we consider iterations that emphasize the common element SHIELD and deemphasize M&P.

Applicant’s mark incorporates the entirety of Registrant’s mark; likelihood of confusion is often found where, as here, the entirety of one mark is incorporated within the other. *In re Denisi*, 225 USPQ 624, 626 (TTAB 1985) (PERRY’S PIZZA for restaurant services specializing in pizza and PERRY’S for restaurant and bar

services); *Johnson Publ'g Co. v. Int'l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); *In re South Bend Toy Mfg. Co.*, 218 USPQ 479, 480 (TTAB 1983) (LIL' LADY BUGGY for toy doll carriages and LITTLE LADY for doll clothing).

Of course, the marks are similar in sound and appearance because they both include the term SHIELD. With regard to meaning and commercial impression, we agree with the Examining Attorney that the marks do not convey a different commercial impression through the inclusion of "M&P" in Applicant's mark because "M&P" does not modify the meaning of the word SHIELD. Both Applicant and the Examining Attorney agree that "this portion of the mark could be understood as a house mark and thus separate from the word 'SHIELD'."<sup>4</sup>

Applicant argues "the second portion of Applicant's Mark – SHIELD – [is] a component that is weak because it is highly suggestive when applied to defensive products whose primary purpose is to 'shield' or protect consumers from danger [and] the term SHIELD is diluted when used in connection with knives and other products meant to provide some type of protection for consumers."<sup>5</sup> Applicant concludes that "the use of Applicant's well-known house mark [M&P] is sufficient to distinguish Applicant's Mark from the cited mark."<sup>6</sup>

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<sup>4</sup> 14 TTABVUE 8.

<sup>5</sup> 12 TTABVUE 16.

<sup>6</sup> *Id.*

The addition of a house mark or other matter has been found sufficient to distinguish marks under circumstances where the appropriated matter is highly suggestive or merely descriptive or has been frequently used or registered by others in the field for the same or related goods or services. *See, e.g., Knight Textile Corp. v. Jones Inv. Co.*, 75 USPQ2d 1313 (TTAB 2005) (NORTON MCNAUGHTON ESSENTIALS for ladies' sportswear not confusingly similar to ESSENTIALS for women's clothing because ESSENTIALS is a highly suggestive term for articles of clothing); *In re Merchandising Motivation, Inc.*, 184 USPQ 364 (TTAB 1974) (MEN'S WEAR for a semi-monthly magazine not confusingly similar to MMI MENSWEAR for fashion consulting for men because "MENSWEAR" is merely descriptive of such services). We therefore determine whether the term SHIELD is highly suggestive or has been frequently used or registered by others in the field for the same or related goods.

The record does not reflect that the common matter, SHIELD, is highly suggestive or diluted. The definition of the term "shield" in the record is "one that protects or defends : DEFENSE."<sup>7</sup> Only in its broadest interpretation can the term "shield" be understood to cover a function for knives; the term thus is only slightly suggestive. In addition, there is at best only one relevant third-party registration for related goods in the record including the term SHIELD, i.e., STERISHIELD for "cutlery."<sup>8</sup>

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<sup>7</sup> Registration No. 3616687, Req. for Recon., Exh. C, 5 TTABVUE 23.

<sup>8</sup> The third-party registrations reciting razors and razor blades are not relevant to our analysis because they are for unrelated goods. See Dec. 28, 2017 Resp. to Office Action, Exh. D, TSDR 78-96.

This evidence does not demonstrate that SHIELD is so highly suggestive or diluted that the addition of the Applicant's M&P mark would obviate confusion. *Cf. Knight Textiles, supra* (no likelihood of confusion between NORTON MCNAUGHTON ESSENTIALS and ESSENTIALS where evidence of record included 23 third-party registrations owned by 21 different owners of marks with ESSENTIALS and dictionary definition of "essentials"). Therefore, we find that the record does not establish that SHIELD is so highly suggestive or diluted, and the M&P portion of Applicant's mark does not distinguish the marks.<sup>9</sup>

Further, even assuming Applicant's M&P house mark is well-known, this does not help to distinguish the marks because purchasers familiar with Registrant's SHIELD knives upon encountering Applicant's M&P SHIELD mark are likely to believe that Applicant is the source of Registrant's M&P knives. *See In re Christian Dior, S.A.*, 225 USPQ 533, 535 (TTAB 1985) (addition of house mark DIOR to applicant's LE CACHET DE DIOR for shirts does not obviate likely confusion with CACHET for dresses and toiletries).

Applicant also argues that its M&P mark "serves as the housemark for a product family of firearms."<sup>10</sup> The family of marks doctrine is not available to an applicant

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<sup>9</sup> Applicant has cited two non-precedential Board cases in support of its argument. While applicants may cite to non-precedential decisions, such decisions are not binding on the Board and the Board does not encourage this practice. *In re Fiat Grp. Mktg. & Corporate Commc'ns S.p.A.*, 109 USPQ2d 1593, 1596 n.6 (TTAB 2014); *In re Procter & Gamble Co.*, 105 USPQ2d 1119, 1121 (TTAB 2012). In any event, unlike in the case here, the common elements discussed therein were inherently weak source indicators. Applicant agrees, stating "the second portions of the applied-for marks and the cited marks were weak because they were highly suggestive of a characteristic or feature of the product ...." 12 TTABVUE 17.

<sup>10</sup> 12 TTABVUE 12.

seeking to overcome a likelihood of confusion refusal in an ex parte proceeding. The focus must be on the applied-for mark Applicant, not other marks Applicant may have used or registered. *In re Cynosure Inc.*, 90 USPQ2d 1644, 1645 (TTAB 2009).<sup>11</sup>

Applicant further argues that trade use indicates that house marks function as the primary source indicator. Applicant relies on evidence submitted by the Examining Attorney with the denial of the Request for Reconsideration to demonstrate that “consumers are accustomed to entities using their house marks and trademarks both together and separately.”<sup>12</sup> According to Applicant, this evidence shows that knife manufacturers ordinarily affix their house mark directly to the product or product packaging and use the product mark or the combination house mark and product mark in product descriptions.”<sup>13</sup> This evidence does not establish that all manufacturers affix their house mark directly to the product or product packaging; it only consists of that evidence selected by the Examining Attorney. Of course, as the Board recognized in *In re Crompton Co.*, 221 USPQ 471, 472 (TTAB 1983), trade practices can be changed at any time.

We find that, viewed as a whole, the similarities between the marks in appearance, sound, connotation and commercial impression, due to the identical word SHIELD, outweigh the dissimilarities. *Stone Lion Capital Partners*, 110 USPQ2d at

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<sup>11</sup> Even if the family of marks doctrine was available to Applicant in this case, Applicant’s ownership of similar registrations does not per se establish a family. Rather there must be recognition by the public that the shared characteristic (or “family surname”) is indicative of a common origin. See *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991).

<sup>12</sup> 6 TTABVUE 2.

<sup>13</sup> 12 TTABVUE 18.

1161. The *DuPont* factor of the similarity of the marks therefore favors a finding of likelihood of confusion.

c. Any Other Established Fact Probative of the Effect of Use

Pursuant to the 13<sup>th</sup> *DuPont* factor, the Board may consider any other established fact probative of the effect of use. Applicant points out that the Examining Attorney advised Applicant of a prior pending mark and potential Section 2(d) refusal based on an application for the mark RED SHIELD for a variety of knives. The Examining Attorney did not refuse registration of Applicant's mark in view of the RED SHIELD registration. Applicant maintains – without proof – that the owner of the SHIELD registration did not oppose the RED SHIELD application and the mark registered. Applicant argues, “[i]t cannot reasonably be suggested that the mark RED SHIELD can co-exist with Registrant's Mark SHIELD but that Applicant's Mark M&P SHIELD is unable to coexist with Registrant's Mark SHIELD simply because the additional component of Applicant's Mark is a house mark as opposed to marginally suggestive, or even [a] descriptive word”;<sup>14</sup> and “[i]f the word “RED,” a descriptive color modifier, is distinctive enough to create sufficient differences between the marks RED SHIELD and SHIELD for nearly identical knives, then Applicant's inherently distinctive and well-known M&P Mark should certainly be enough to avoid confusion with the mark SHIELD.”<sup>15</sup>

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<sup>14</sup> 12 TTABVUE 23-24.

<sup>15</sup> 12 TTABVUE 24.

We do not have before us sufficient information from the RED SHIELD registration file to determine the facts surrounding the registration of this mark. Further, while the USPTO strives for consistency, each case must be decided on its own facts and record. *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017) (quoting *In re Boulevard Entm't*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003)). 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 Board. *Id.*

In addition, Applicant maintains that Registrant will not be damaged by the registration of Applicant's mark and references Applicant's prior registration for M&P SHIELD. It argues,

Applicant ... has used the same mark for related defensive products for more than five years. Applicant has thus established goodwill in its mark that extends to its use of that mark for related defensive products. Denying registration of Applicant's Mark would inhibit an established company from reasonably expanding its product line, and permit potential infringers to adopt an applicant's product mark for closely related products to prevent an applicant from registering it for a broad scope of goods.<sup>16</sup>

The problem with Applicant's argument is that its prior registration is for firearms, which are not the goods identified in its pending application, and the goods are not necessarily related just because they both may have a "defensive" function. Applicant's expansion beyond firearms interferes with the rights encompassed by

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<sup>16</sup> 12 TTABVUE 17.

Registrant's registration. Section 2(d) of the Trademark Act specifically provides that registration of a mark may be refused if it "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, or to cause mistake, or to deceive."

d. Conclusion

We have considered all of the evidence properly in the record and the arguments of the Examining Attorney and Applicant. In view of the similar marks, the identical or presumed identical goods, trade channels and classes of purchasers, we conclude that confusion is likely between Applicant's mark for "Knives; hunting knives; fishing knives; knives for hobby use; leather sheaths for knives; tactical knives; pocket knives; cutlery; sport knives; utility knives; pen knives; folding knives; fixed blade knives; multi-purpose tools, namely, multi-function hand tools comprised of knives and hand-operated can openers; hatchets; machetes" and Registrant's mark for "knives."

**Decision:** The refusal to register is affirmed.