

This Opinion is not a
Precedent of the TTAB

Mailed: December 16, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Craft Bearing Company, Inc.

v.

UAB “Craft Bearings”

Opposition No. 91225061

Matthew P. Hintz of Lowenstein Sandler LLP
for Craft Bearing Company, Inc.

Heidi Howard Tandy of Salazar Law Firm
for UAB “Craft Bearings”.

Before Zervas, Wolfson, and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

UAB “Craft Bearings,” a Lithuanian joint stock company (Applicant), seeks registration on the Principal Register of the word and design mark



(with “BEARINGS” and “QUALITY” disclaimed) for:

“Bearings, as parts of machines; bearings for transmission shafts, being

parts of machines; journal boxes, as parts of machines” in International Class 7, and

“Structural parts for airplanes; structural parts for ambulances; structural parts for automobiles; structural parts for boats; structural parts for buses; structural parts for motorcycles; structural parts for trucks; structural parts for vans; structural parts of bicycles; vehicle parts, namely, rearview mirrors; vehicle parts, namely, shock absorbers; vehicle parts, namely, steering wheels; windshield wipers, ball joints, axle bearings for land vehicles, and wheel bearings for land vehicles; apparatus for locomotion by land, air or water, namely, land vehicles, boats, airplanes, and automobiles” in International Class 12.¹

Craft Bearing Company, Inc. (Opposer), a corporation based in Newport News, Virginia, has opposed registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with its claimed common law marks CRAFT and CRAFT BEARING COMPANY for bearings and related components for machinery.² Applicant denies the salient allegations.³

After Opposer’s motion for summary judgment was denied,⁴ the parties filed a stipulation, approved by the Board, providing inter alia that at trial, each party could rely upon materials submitted with its briefing on the motion, as well as testimony

¹ Application Serial No. 79166521 was filed on March 26, 2015, seeking an extension of protection of International Registration No. 1239438 under Section 66A of the Trademark Act, the Madrid Protocol. According to Applicant’s description of the mark, “The mark consists of the following: two linked black and white circles, the orange wording ‘CRAFT BEARINGS’ in stylized font, and the black wording ‘QUALITY MINDED’ in stylized font.” The color(s) orange, black and white are claimed as a feature of the mark.

² Notice of Opposition ¶¶ 4-5, 1 TTABVUE 4. References to filings and orders in this proceeding are to the Board’s TTABVUE docket system. A request for extension of protection under the Madrid Protocol is subject to opposition under 15 U.S.C. § 1063. See 15 U.S.C. § 1141h(a)(2).

³ Answer, 7 TTABVUE.

⁴ 31 TTABVUE.

of up to three witnesses.⁵ The matter is now fully briefed.

I. Standing

Standing is a threshold issue that must be proven by the plaintiff in every inter partes case. To establish standing in an opposition proceeding, an opposer must show a ‘real interest’ in the proceedings and a ‘reasonable basis’ for its belief of damage. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014).

Opposer introduced evidence that it has used its marks CRAFT and CRAFT BEARING COMPANY on bearings and related components for machinery since 1994, which establishes its standing. A claim of likelihood of confusion that “is not wholly without merit,” including prior use of a confusingly similar mark, may be sufficient “to establish a reasonable basis for a belief that one is damaged.” *Executive Coach Builders, Inc. v. SPV Coach Co., Inc.*, 123 USPQ2d 1175, 1179 (TTAB 2017) (citing *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982)); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (“Petitioner has established his common-law rights in the mark ..., and has thereby established his standing to bring this proceeding.”).

Further, Opposer has submitted evidence that it has two pending applications, one for CRAFT⁶ and the other for CRAFT BEARING COMPANY;⁷ both applications

⁵ Stipulation, 34 TTABVUE; Order approving stipulation, 35 TTABVUE.

⁶ Application Serial No. 86804906, filed on Oct. 30, 2015, claiming first use and first use in commerce as of 1994. 15 U.S.C. § 1051(a).

⁷ Application Serial No. 86804924, filed on Oct. 30, 2015, claiming first use and first use in commerce as of 1994. 15 U.S.C. § 1051(a).

are for “machine parts, namely, bearings, split bearings, bearing inserts, bearing housings, bearing cartridges, bearing inner races, bearing outer races, bearing seals, rolling element cages, clamp collars” in International Class 7, claiming use in commerce since 1994; and both applications have been suspended pending resolution of Applicant’s opposed application. *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1807 (TTAB 2018) (suspension of application due to claimed likelihood of confusion demonstrates reasonable belief of damage).

The parties have stipulated that Opposer has standing in this proceeding.⁸ *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1604 (TTAB 2018) (stipulation establishes standing).

II. The Record

The record consists of the pleadings and the file of opposed Application Serial No. 79166521, *see* 37 C.F.R. § 2.122(b), as well as the following:

A. Opposer’s Evidence

1. Declarations of Donald L. Moore, Chief Executive Officer and Secretary of Opposer Craft Bearing Company, with exhibits, attached to Opposer’s motion for summary judgment and reply in support thereof, and in rebuttal to Applicant’s trial evidence.⁹
2. Declarations of Matthew P. Hintz, Opposer’s counsel, with exhibits, attached to Opposer’s motion for summary judgment and reply in support thereof.¹⁰

⁸ Stipulation ¶1, 34 TTABVUE.

⁹ 24 TTABVUE, 30 TTABVUE, 53 TTABVUE.

¹⁰ 24 TTABVUE, 30 TTABVUE.

3. Testimony declarations of Ian G. Hadden, President of Opposer, with exhibits.¹¹
4. Opposer's First Notice of Reliance, with circulation and subscriber numbers for industry magazines in which Opposer has advertised its products under its marks, and webpages discussing Opposer and its products under its marks.¹²
5. Testimony declaration of Craig Gipson, president and owner of Gipson Bearing and Supply Company, which distributes Opposer's branded products.¹³
6. Testimony declarations of Jim McLain, president and owner of Allied Bearings & Supply, Inc., which sells and distributes Opposer's branded products.¹⁴
7. Testimony declarations of John Slawinski, president and owner of J.S. Inc., a sales representative of bearing companies, including Opposer.¹⁵

B. Applicant's Evidence

1. Exhibits attached to Applicant's response in opposition to Opposer's motion for summary judgment.¹⁶
2. Applicant's First Notice of Reliance with Internet materials advertising and promoting Applicant's branded products, Applicant's catalogs from 2013 to 2018, and a catalog of exhibitors at the Frankfurt automotive trade fair.¹⁷
3. Testimony declaration of Cesar Niada, General Manager at Prime Industrial Solutions, a product distributor for Applicant.¹⁸

¹¹ 36 TTABVUE, 54 TTABVUE.

¹² 37 TTABVUE.

¹³ 38 TTABVUE.

¹⁴ 39 TTABVUE, 55 TTABVUE.

¹⁵ 40 TTABVUE, 56 TTABVUE.

¹⁶ 29 TTABVUE.

¹⁷ 46 TTABVUE.

¹⁸ 47 TTABVUE. Opposer objects to Applicant's reference in its brief to "the 2006 date on which Cesar Niada and his US employer became aware of Applicant" (64 TTABVUE 33), as no reference to a US employer appears in Mr. Niada's underlying declaration at 47 TTABVUE 4. Opposer's brief, 65 TTABVUE 6. In view of our analysis of Applicant's analogous use argument, this reference is immaterial, and the objection is overruled.

4. Testimony declaration of Nicola Beer, Commercial Director for BearingNet Limited, an online inquiry and information service helping distributors locate sources of bearings.¹⁹
5. Testimony declaration of Martynas Martikonis, Marketing Manager of Applicant, with exhibits.²⁰

III. Priority

A. Applicable Law

To prevail on the ground of likelihood of confusion under Section 2(d) of the Lanham Act, based on a previously used mark, it is the Opposer's burden to prove both priority of use and likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000). A party opposing an application for registration under Section 2(d) must prove that it has proprietary rights in the term it relies upon to demonstrate likelihood of confusion as to source. *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). A party may establish its own prior proprietary rights in a trademark through ownership of a registration, through actual use, or through use analogous to trademark use. *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), *vacating Pactel Teletrac v. T.A.B. Sys.*, 32 USPQ2d 1668 (TTAB

¹⁹ 48 TTABVUE.

²⁰ 49 TTABVUE. Opposer has interposed five objections to evidence to which Applicant refers in its brief. See Opposer's reply brief, 65 TTABVUE 5-6. We address these objections as they arise in the course of this decision. For example, attached to Applicant's brief were exhibits A-D, to which Opposer objects on the ground that the exhibits are either untimely evidence or unnecessary duplicates of timely evidence. Opposer's brief, 65 TTABVUE 6. The objection is sustained on both grounds, and the exhibits have been given no consideration. See *Life Zone Inc. v. Middleman Grp., Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008).

1994). Here, because Opposer has not pleaded or submitted any registrations, it must rely on its asserted common law rights, which must precede Applicant's actual or constructive use of its mark. *WeaponXPerformance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040-41 (TTAB 2018).

Opposer contends that it has used its CRAFT and CRAFT BEARING COMPANY marks since 1994, long before any date on which Applicant can rely.²¹ Opposer contends that the earliest date on which Applicant may rely is its constructive use date of March 26, 2015, when it filed its request for extension of protection.²² 15 U.S.C. § 1141f(b)(2); *see* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPE) § 1904.01(b) (Oct. 2018).

B. Use Analogous

Although Applicant could rely on this March 26, 2015 constructive use date,²³ it contends that it commenced use analogous to trademark use years earlier. *See Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1635 (TTAB 2007) (use analogous may be tacked onto constructive use date for purposes of determining priority). Even though it has not offered its products for sale in the United States, Applicant states that it has promoted its products via its website, catalogs, participation in trade shows, and social media accessible to potential purchasers in the U.S., beginning in December 2004:

²¹ Opposer's brief, 61 TTABVUE 24-25; Moore Decl. ¶ 2, 24 TTABVUE 2; Hadden Decl. ¶ 3, 24 TTABVUE 4-5.

²² Opposer's brief, 61 TTABVUE 25.

²³ Applicant's brief, 64 TTABVUE 33.

Applicant commenced use analogous to trademark use within the United States in December, 2004, when it first launched its English-language website; the website has been active and accessible since then throughout the United States and around the world. Since then, Applicant has provided web pages and catalogs in English, German, Russian and Polish languages and hosted booths featuring its bearings at conventions around the world where attendees are from US-based companies, as well as sponsored race and sports teams around the world where attendees and viewers are US residents. ... Companies with significant US presences like Ingersoll-Rand have discussed with Applicant the purchase of bearings. ... The English-language craft-bearings.com website was aimed to target English speaking countries globally as well as the US market, as there is a common practice for European countries to use English for their websites to accommodate countries who speak their own language. ... The website and its English-language promotional material were accessible to businesses in the United States, as well as US companies overseas, although Applicant was not specifically directing its sales staff to focus on marketing to US businesses. ... Since 2012, Applicant has spent approximately a million dollars across the globe on advertising, promotion



and marketing of its goods under its mark, excluding sums spent by Applicant in sponsorship of race vehicles and travel to, from and at distributor meetings and conventions. ...

Applicant's website ... as well as its convention booths ..., promotional sponsorships ..., globally distributed catalogs ..., media coverage ..., and Facebook and Twitter presence ... among other marketing materials, engendered use analogous to US trademark usage such that it created a public awareness in the United States of the designation as a trademark identifying Applicant as a source.²⁴

Applicant cites the testimonial declaration of its marketing manager, Martynas Martikonis, who testified in pertinent part about Applicant's website, its promotional activities, and the geographic reach of its sales:

²⁴ Applicant's brief, 64 TTABVUE 13-14, 33. (Citations to record omitted.) *See also* Applicant's Response to Motion for Summary Judgment, 29 TTABVUE 27-42 (website and exhibitions at international conventions; Applicant's first notice of reliance, 46 TTABVUE, exs. A-I (Applicant's Internet materials, catalogs from 2013 to 2018, promotional materials, and catalog of exhibitors at Frankfurt automotive trade fair).

6. Applicant obtained its first domain name in early December of 2004, and set up a website at craft-bearings.com later that month to market and promote its bearings under the mark CRAFT bearings and later CRAFT bearings QUALITY MINDED. Since then, Applicant has provided web pages and catalogs in English, German, Russian, Spanish and Polish languages and hosted booths featuring its bearings at conventions around the world where attendees are from US-based companies, as well as sponsored race and sports teams around the world where attendees and viewers are US residents.
7. The English-language craft-bearings.com website was aimed to target English speaking countries globally, and catch the attention of the US market, as there is a common practice for European countries to use English for their websites to accommodate countries who speak their own languages. The website and its English-language promotional material were accessible to businesses in the United States, as well as US companies overseas, **although Applicant was not specifically directing it sales staff to focus on marketing to US businesses**, whether operating in the US or in other countries.
8. CRAFT bearings has an extensive presence in Latin America.
9. Since 2012, Applicant has spent approximately a million dollars across the globe on advertising, promotion and marketing of its goods under the CRAFT bearings QUALITY MINDED & Design mark. Applicant's website, as well as its convention appearances..., industry organizations like BearingNet ... , promotional and sales interactions with global companies that have a US presence... and globally distributed marketing materials..., engendered use analogous to US trademark usage such that it created a public awareness of the designation as a trademark identifying Applicant as a source. ...
14. Applicant has attended industry association meetings and conventions to promote our products under the CRAFT bearings QUALITY MINDED & Design marks; I have managed booths, advertising and promotional activity at such events. We have attended dozens of meetings since 2005, and a few since that date as well. ...
15. Craft Bearings has promoted and sold its goods under our CRAFT bearings QUALITY MINDED & Design mark on our website, through catalogs, and through a global network of distributors. ...
17. **While we have not focused on the sale of goods in the United States**, we have marketed and promoted our goods in a manner accessible to US companies operating in South America, Central America, Europe, Africa and Asia, through our presence at conventions and conferences..., our website and Facebook pages as well as our social media content... and via

our catalogs. ...²⁵

We agree with Opposer, however, that Applicant's efforts do not amount to use analogous to trademark use for purposes of establishing priority. Applicant had no products for sale in the U.S. and no immediate plans to sell products in the U.S. Its marketing measures did not inform prospective purchasers in the U.S. of the present or future availability of its goods. In its answers to Opposer's interrogatories, Applicant averred:

"[N]o such goods have been offered for sale or sold under or in connection with the CRAFT BEARINGS QUALITY MINDED & Design Mark in the United States by Applicant."²⁶

"Applicant states that no printed advertisements, promotional materials or marketing materials including the CRAFT BEARINGS QUALITY MINDED & Design Mark have been distributed in the United States by Applicant."²⁷

"Applicant states that to date, no goods have been offered for sale or sold under or in connection with the CRAFT BEARINGS QUALITY MINDED & Design Mark in the United States by Applicant."²⁸

"Applicant states that it has not displayed, promoted, or sold any of its CRAFT bearings production in the US market and has no knowledge as to

²⁵ Martikonis decl., 49 TTABVUE 2-6 (emphasis added).

²⁶ Answer (in pertinent part) to Interrogatory nos. 7, 8, 9, 24 TTABVUE 64.

²⁷ Answer to Interrogatory no. 10, 24 TTABVUE 65.

²⁸ Answer to Interrogatory no. 11, 24 TTABVUE 66.

any grey market sales or third party re-sales of goods under the CRAFT BEARINGS QUALITY MINDED & Design Mark.”²⁹

Beyond that, Applicant’s marketing manager avers repeatedly that “Applicant was not specifically directing its sales staff to focus on marketing to US businesses” and “we have not focused on the sale of goods in the United States.”³⁰

Applicant’s extraterritorial use fails to establish prior rights in the United States:

[P]rior use and advertising of a mark in connection with goods or services marketed in a foreign country (whether said advertising occurs inside or outside the United States) creates no priority rights in said mark in the United States as against one who, in good faith, has adopted the same or similar mark for the same or similar goods or services in the United States prior to the foreigner’s first use of the mark on goods or services sold and/or offered in the United States....

Mothers Restaurants, Inc. v. Mother’s Other Kitchen, Inc., 218 USPQ 1046, 1048 (TTAB 1983).

The reasoning enunciated in *Mother’s Restaurants* applies to claims of analogous use based on extraterritorial sales: “Here respondent had no products for sale in the U.S. and no immediate plans to sell products in the U.S. ... so its promotional activities **cannot be considered use analogous to trademark use for purposes of establishing priority.**” *Adolphe Lafont, S.A. v. Ellera, S.P.A.*, 228 USPQ 589, 595 (TTAB 1985) (emphasis added). Activities conducted solely outside the U.S. are excluded from consideration for purposes of establishing priority. *See Dyneer Corp. v. Auto. Prod. plc*, 37 USPQ2d 1251, 1256 (TTAB 1995). To hold otherwise would permit

²⁹ Answer to Interrogatory no. 14, 24 TTABVUE 66.

³⁰ Martikonis decl. ¶¶ 7, 17.

Applicant to circumvent the longstanding principle that “Prior use of a trademark in a foreign country does not entitle its owner to claim exclusive trademark rights in the United States as against one who used a similar trademark in the U.S. prior to entry of the foreigner into the domestic American market.” 5 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 29:3 (5th ed. Nov. 2019 update) (citing *Person’s Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990)). Consequently, Applicant has not shown use analogous to technical trademark use, and must rely on its constructive use date of March 26, 2015.

C. Opposer’s Priority

The issue becomes whether Opposer has established common law rights in its CRAFT and/or CRAFT BEARING COMPANY marks prior to that constructive use date. For purposes of determining priority and likelihood of confusion, we focus our analysis on Opposer’s mark CRAFT BEARING COMPANY, as it is most similar to Applicant’s mark. See *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010); *North Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1225 (TTAB 2015). “Under the rule of *Otto Roth* [209 USPQ at 43], a party opposing registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning or through ‘whatever other type of use may have developed a trade identity.’” *RxD Media v. IP Application Development LLC*, 125 USPQ2d 1801, 1808 (TTAB 2018) (quoting *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990)).

Applicant argues that Opposer’s claimed common law marks are either generic or

so highly descriptive that they have not acquired distinctiveness as of the earliest date on which Applicant may rely.³¹ Applicant argues that generic terms “are by definition incapable of indicating a particular source of the services, and cannot be registered as service marks; doing so ‘would grant the owner of the mark a monopoly, since a competitor could not describe his goods [or services] as what they are.’”³² With respect to mere descriptiveness, it argues that Opposer “may not claim exclusive rights to terms that others may need to use to describe their goods and/or services in the marketplace.”³³

But as Opposer correctly points out, Applicant’s argument is inconsistent.³⁴ Applicant’s argument, and the case law on which it relies, refers to competitors’ rights to **use** generic or merely descriptive terms, not to **register** them. Applicant has applied to register a mark with the wording “CRAFT BEARINGS QUALITY MINDED,” but only disclaims the words “BEARINGS” and “QUALITY.” It does not disclaim CRAFT, nor does it claim acquired distinctiveness under Section 2(f). 15 U.S.C. § 1052(f). All of this suggests that the term is suggestive—a finding that should apply with equal force to Opposer’s CRAFT BEARING COMPANY mark, which uses the same key term.

³¹ Applicant’s brief, 64 TTABVUE 15-31.

³² Applicant’s brief, 64 TTABVUE 30, *citing In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987).

³³ Applicant’s brief, 64 TTABVUE 17, *citing Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991).

³⁴ Opposer’s reply brief, 65 TTABVUE 9.

1. Inherent Distinctiveness

a. Genericness

We find the Applicant's genericness argument unavailing as to Opposer's CRAFT BEARING COMPANY mark, taken as a whole. A genericness inquiry asks (1) what is the genus of goods at issue, and (2) is the term understood by the relevant public primarily to refer to that genus of goods? *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). In this case, the genus is not, as Applicant argues, "crafted bearings."³⁵ It is bearings and related parts, a category or subcategory of goods Opposer manufactures. *Royal Crown Co., Inc. v. The Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1045 (Fed. Cir. 2018) (quoting *Marvin Ginn*, 228 USPQ at 530: "A generic term 'is the common descriptive name of a class of goods or services.>"). A mechanical "bearing" is "a component used between two parts that allows rotational or linear movement, reducing friction and enhancing performance to save energy."³⁶ As with Applicant's mark, the term "BEARING" would have to be disclaimed, as it names Opposer's class of goods. Moreover, the term "COMPANY" has no source-indicating significance, as it merely indicates the formation of a business entity to deal in the goods. *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1792-93 (TTAB 2002) (quoting *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 US 598, 602 (1888) ("[t]he addition of the word 'Company' only indicates that parties have formed an association or partnership to

³⁵ Applicant's brief, 64 TTABVUE 31.

³⁶ *CraftechInd.com* 10/31/2017, Ex. O, Applicant's response to motion for summary judgment, 29 TTABVUE 320-321.

deal in such goods....”). Nonetheless, there is no evidence that the relevant public— industrial bearing users—would understand the entire term CRAFT BEARING COMPANY to refer to the genus of bearings.³⁷ To the contrary, as discussed below, the evidence shows that they understand the phrase to indicate Opposer as a particular source of bearings. Opposer’s CRAFT BEARING COMPANY is no more generic than Applicant’s applied-for mark.

b. Suggestive versus Descriptive

With respect to whether Opposer’s CRAFT BEARING COMPANY mark is merely descriptive, Applicant adduces dictionary definitions showing that “craft” means “skill in planning, making, or executing” or “to make or produce with care, skill, on ingenuity.”³⁸ Those definitions, Applicant argues, literally describe a characteristic of Opposer’s goods: that they are manufactured with skill and careful attention to detail.³⁹ As such, it argues, the term “CRAFT” is laudatory and descriptive of the character and quality of Opposer’s goods.⁴⁰ In support, Applicant cites a nonprecedential Board decision, *In re IM Brands*, Serial No. 86441404, 2017 WL 3102587 (TTAB 2017) holding that an applicant for the mark ISAAC MIZRAHI CRAFT (in standard characters) for “yarn” was required to disclaim “CRAFT” as

³⁷ See Moore rebuttal decl. ¶ 8, 53 TTABVUE 8-9.

³⁸ See Merriam-Webster.com/dictionary/craft, 29 TTABVUE 60-63. We take judicial notice of this definition, and overrule Opposer’s objection to this evidence. See *M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd. and Global Technology & Trade Marks Limited*, 2019 USPQ2d 14909, *1 n. 2 (TTAB 2019).

³⁹ Applicant’s brief, 64 TTABVUE 19.

⁴⁰ Applicant’s brief, 64 TTABVUE 19-20. See *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 1373, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (“Marks that are merely laudatory and descriptive of the alleged merit of a product are also regarded as being descriptive.”).

descriptive. And it quotes from Opposer’s promotional material, which states that “Craft Bearing exemplifies all that is fine in American craft....”⁴¹ Applicant concludes that “Opposer has used the term ‘craft’ descriptively in connection with marketing its goods.”⁴²



We agree with Opposer, though, that its CRAFT BEARING COMPANY mark is suggestive with respect to its goods, and thus inherently distinctive. *See In re N. Carolina Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017); *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1684 (Fed. Cir. 2010). There is but a thin line of distinction between suggestive and merely descriptive terms, and distinguishing between the two is often difficult. *See, e.g., Nautilus Grp., Inc. v. ICON Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1181 (Fed. Cir. 2004); *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992). A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). On the other hand, a mark is suggestive if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1252 (Fed. Cir. 2012). Opposer’s mark must be considered in relation to the particular goods involved, in the context in which it is being used, and in the perception of the average purchaser of the goods. *See Bayer Aktiengesellschaft*, 488

⁴¹ 24 TTABVUE 238. *See In re Hikari Sales Usa, Inc.*, 2019 USPQ2d 111514, *9 (TTAB 2019) (marketing materials indicate how the public perceives a term).

⁴² Applicant’s brief, 64 TTABVUE 19.

F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978)); *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, *5 (TTAB 2019). In *In re IM Brands*, where the applicant sought to register ISAAC MIZRAHI CRAFT for “yarn,” the Board found that “Applicant’s identified goods encompass all types of yarn including ‘craft yarn’ or yarn that may be used in making yarn crafts.” (Op. at 6.) As Opposer correctly notes, “this does not mean that ‘craft’ is forever deemed as such across all goods, services, and industries.”⁴³

In fact, the record in the present case contains evidence of numerous third-party registrations on the Principal Register in which the word “craft” is not disclaimed as descriptive, and no claim is made to acquired distinctiveness under Section 2(f), even though the identified goods are mechanical parts that could be made with care and skill. For example:

MARK	REG. NO.	PERTINENT GOODS
	1071286	valves-namely, gate valves, globe valves, check valves, twin-pack valves, jacket valves, and bellow valves
CYCLE CRAFT (“CYCLE” disclaimed)	4930129	Motorcycle parts
ROUGH CRAFTS	4959728	Motorcycles and structural parts thereof
 (“3 in 1” disclaimed)	4504140	Bicycle parts
ALUMI CRAFT	5155652	Structural parts for automobiles Custom manufacture of cars, automotive chassis, and structural parts of automobiles

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⁴³ Opposer’s reply brief, 65 TTABVUE 11-12.

⁴⁴ 29 TTABVUE 90-304.

As with these third-party registrations, examination of Opposer's and Applicant's applied-for marks did not question the inherent distinctiveness of "CRAFT." Opposer points out:

Examination of Opposer's Application Ser. Nos. 86/804,906 and 86/804,924 did not question the inherent distinctiveness of "craft" in Opposer's Marks. The only issues raised during examination were Applicant's prior-filed application. Hintz Decl. ¶¶ 2-3 and Ex. A-B; 24 TTABVUE 7-8, 9-58. Examination of Applicant's application also did not question that "craft" is inherently distinctive in the context of bearings and related goods. The examining attorney only rejected "BEARINGS" and "QUALITY" as merely descriptive of a characteristic and feature of applicant's goods, not the word "craft."⁴⁵

Taken as a whole, Opposer's CRAFT BEARING COMPANY mark is a suggestive mark. It suggests indirectly, by terms requiring thought and perception, Opposer's care and skill in the manufacture of its goods. We conclude that Opposer's mark is suggestive and therefore inherently distinctive.

2. Acquired Distinctiveness

For the sake of completeness, assuming arguendo that Opposer's mark was merely descriptive when it was adopted, we find that it acquired distinctiveness prior to Applicant's constructive use date of March 26, 2015. Acquired distinctiveness, or "secondary meaning," is a term of art denoting the "association formed in the minds of the consumers between the mark and the source or origin of the product." *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1377 (Fed. Cir. 2018) (quoting *Tone Bros., Inc. v. Sysco Corp.*, 28 F.3d 1192, 31

⁴⁵ Opposer's brief, 61 TTABVUE 21. See file histories for Opposer's Application Serial Nos. 86804906 for CRAFT and 86804924 for CRAFT BEARING COMPANY, exs. A and B, 24 TTABVUE 10-58.

USPQ2d 1321, 1327 (Fed. Cir. 1994)). Protection of that association, otherwise known as goodwill, is consistent with both the language and purpose of the Trademark Act. *See Matal v. Tam*, 582 U.S. ___, 137 S. Ct. 1744, 122 USPQ2d 1757, 1762 (2017) (quoting *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U. S. 189, 224 USPQ 327, 331 (1985) (“The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers”))).

The burden of proving secondary meaning is on the party asserting it. *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). Opposer’s burden of proving acquired distinctiveness is commensurate with its mark’s degree of descriptiveness. *Real Foods v. Frito-Lay*, 128 USPQ2d at 1378. For the reasons stated above, we find that the mark was at worst only slightly descriptive of the quality of its goods. Acquired distinctiveness may be proven through “both direct and circumstantial evidence.” *Schlafly v. Saint Louis Brewery, LLC*, 909 F.3d 420, 128 USPQ2d 1739, 1743 (Fed. Cir. 2018). “Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence is evidence from which consumer association may be inferred, such as years of use, extensive amounts of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers.” *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1506 (TTAB 2017). The evidence may show (1) association of the mark with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers;

(5) intentional copying; and/or (6) unsolicited media coverage of the product embodying the mark. *Converse, Inc. v. ITC*, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018); *In re SnowWizard, Inc.*, 129 USPQ2d 1001, 1005 & n.8 (TTAB 2018) (holding *Converse* applicable to Board proceedings). On this list, no single factor is determinative. *Performance Open Wheel Racing, Inc. v. U. S. Auto Club Inc.*, 2019 USPQ2d 208901, *7 (TTAB 2019). We limit our consideration of these factors to the time preceding Applicant's constructive use date of March 26, 2015, as the issue is whether Opposer's marks acquired distinctiveness prior to that date.

Opposer's president and chief executive officer aver that since at least as early as 1994, it has manufactured and "sold bearings and related components for machinery in various industries (including, but not limited to, mining, marine, lumber, waste and waste water treatment, sugar, flour mills, automotive, fiberglass, and other manufacturing), under the CRAFT and CRAFT BEARING COMPANY marks (the 'CRAFT Marks')."46

After its sales began in 1994, Opposer's sales of bearings and related components under its marks grew to over \$300,000 per year, totaling in excess of \$53 million from the inception of the business.⁴⁷ Applicant argues that (1) success in sales does not necessarily evidence consumers' recognition of the mark, (2) Opposer has not shown its market share, and (3) sales outside the United States do not show secondary meaning in the United States.⁴⁸ However, the evidence shows, first, that the marks

⁴⁶ Moore decl. ¶2, 24 TTABVUE 2; Hadden decl. ¶3, 36 TTABVUE 4-5.

⁴⁷ Hadden decl. ¶¶ 9-11, 36 TTABVUE 7; Moore decl. ¶ 5, 24 TTABVUE 3.

⁴⁸ Applicant's brief, 64 TTABVUE 25-26.

appear on the packaging and imprinted on the goods:⁴⁹



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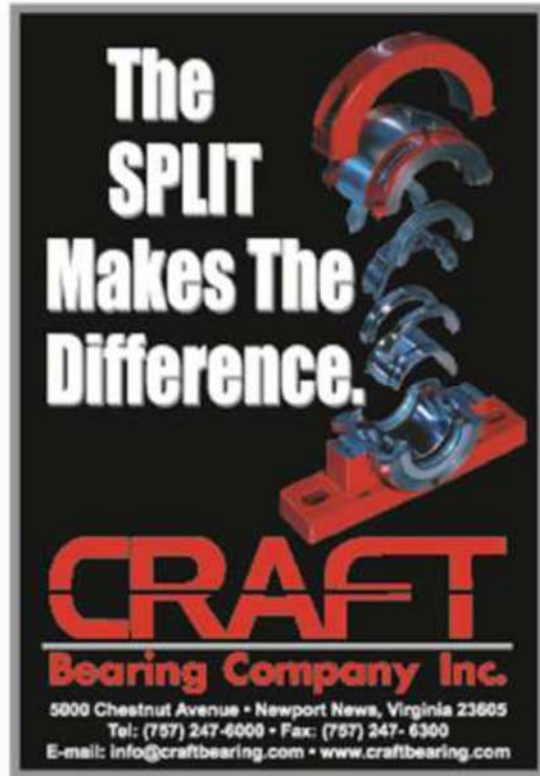
Second, Opposer establishes that it is the only concern that manufactures split bearings in the United States.⁵² A “split bearing” is split in half, facilitating installation and repair around cylindrical shafts, as its catalog cover shows:

⁴⁹ Moore decl. ¶7, 24 TTABVUE 4.

⁵⁰ 24 TTABVUE 57.

⁵¹ 24 TTABVUE 58.

⁵² Opposer’s reply brief, 65 TTABVUE 10; Hadden Decl. ¶ 12, 36 TTABVUE 8.



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Third, Opposer’s CEO avers that “we have marketed, advertised, and sold our bearings in every state in the United States,”⁵⁴ and that Opposer has established its reputation for manufacturing its products entirely in the United States, using only U.S. raw materials.⁵⁵ Hence, Opposer’s length of use, market share, and extent of sales weigh in favor of creating customer association between its goods and its marks.

Opposer avers that: it has spent approximately \$1,900,000 in direct advertising costs to promote its bearings under the CRAFT Marks over the past two decades;⁵⁶ it has printed and distributed approximately 150,000 catalogs since 1994;⁵⁷ it has run

⁵³ Ex. N., 24 TTABVUE 285.

⁵⁴ Moore rebuttal decl. ¶3, 53 TTABVUE 5.

⁵⁵ Moore rebuttal decl. ¶5, 53 TTABVUE 6.

⁵⁶ Moore decl. ¶ 8, 24 TTABVUE 4.

⁵⁷ Moore decl. ¶¶ 6, 8, 24 TTABVUE 4, 146; Hadden Decl. ¶ 7, 36 TTABVUE 6-7

advertisements promoting its bearings under the CRAFT marks in trade publications such as Marine News (circulation approximately 30,000), Maritime Reporter, Boats & Harbour Magazine (front page for over 12 years) (circulation 60,000), Pit & Quarry Magazine (circulation approximately 25,000);⁵⁸ its representatives have met with its distributors over the past two decades;⁵⁹ and its representatives have attended at least 150 industry association meetings and conventions, such as the Bearings Specialists Association Convention (attended by bearing manufacturers and distributors), and the Work Boat Show, since 1998 to promote its goods under its CRAFT marks.⁶⁰

Applicant responds in pertinent part that:

these efforts to advertise and promote Opposer's products are extremely modest over the given time frames. Even if Opposer meets with 20 or even 50 people per day at trade shows and conventions, ... that is not evidence of secondary meaning manifesting in the term CRAFT as used in connection with split roller bearings. While Opposer has presented evidence of paid advertising and promotional materials, including catalogs, it has presented no direct consumer testimony, no consumer surveys, and no evidence of unsolicited media coverage.⁶¹

Opposer counters with direct testimony from three witnesses in the bearings business—two distributors and one sales representative—all of whom are familiar with Opposer Craft Bearing Company's status in the marketplace.

Craig Gipson is president of Gipson Bearing and Supply Company, which “sells

⁵⁸ Moore decl. ¶¶ 9, 11 and Ex. N, 24 TTABVUE 5, 284-297; Hadden decl. ¶8, 36 TTABVUE 7; First Notice of Reliance Ex. A, D, and F, 37 TTABVUE.

⁵⁹ Moore decl. ¶ 8, 24 TTABVUE 4.

⁶⁰ Moore decl. ¶ 8, 24 TTABVUE 4; Hadden Decl. ¶¶ 2, 5, 36 TTABVUE 4-5.

⁶¹ Applicant's brief, 64 TTABVUE 26.

and distributes bearing and power transmission products to heavy industries such as steel and others that need quality bearings.”⁶² Mr. Gipson testifies that “I have worked in the bearing business all of my adult life.”⁶³ He testifies that his company:

began distributing Opposer’s bearings with the CRAFT marks since at least as early as 1994, and we consider them a valuable supplier because of the established reputation for the quality of their products. Because of their time in business, the name “CRAFT” and “CRAFT BEARING COMPANY” is well-known to us and our customers. Gipson bearing is proud to offer Craft bearing Company’s products and many of our customers, when selecting bearings, rely on the names “CRAFT” and ‘CRAFT BEARING COMPANY’ due to the established name, quality, reputation of these made in U.S.A. products.⁶⁴

Jim McLain, president of Allied Bearings & Supply, Inc. co-founded that company over 30 years ago, and is responsible for its sales and operations.⁶⁵ He testified that “I have worked with Craft Bearing Company since 1995, and Allied Bearings has consistently sold Craft bearing Company’s products since that time.”⁶⁶ Further:

Craft Bearing company is ... important to us as a known manufacturer of quality roller bearings that are well suited to the industrial market. The bearings manufactured by Craft bearing Company are known for their quality, load carrying capacity, ease of installation, and for being made in the United States.

Because of its established reputation for quality, many of our customers, when selecting bearings, specifically request and rely on the names “CRAFT” and CRAFT BEARING COMPANY.”⁶⁷

John Slawinski of J. S. Inc. testified that his company has acted as Opposer’s sales

⁶² Gipson decl. ¶¶ 2-3, 38 TTABVUE 4.

⁶³ *Id.*

⁶⁴ Gipson decl. ¶ 5, 38 TTABVUE 5.

⁶⁵ McLain decl. ¶ 2, 39 TTABVUE 4.

⁶⁶ McLain decl. ¶ 5, 39 TTABVUE 5.

⁶⁷ McLain rebuttal decl. ¶¶ 5, 6, 55 TTABVUE 6.

representative for over 15 years.⁶⁸ He testified that “J.S. Inc. only represents quality manufacturers such as Craft Bearing Company.” “I consider Craft Bearing Company a valuable supplier because of their established reputation for quality.”⁶⁹ “Many of our customers, when selecting bearings, rely on the names ‘CRAFT’ and ‘CRAFT BEARING COMPANY’ due to the established name, quality and reputation of these made in U.S.A. products.”⁷⁰

Applicant professes confusion with one of the declarations:

In the Gipson declaration at Paragraph Seven, Mr. Gipson attested that Applicant “is advertising bearings in sizes and load ranges that we sell to Craft’s customer and which could be used in the same applications as the CRAFT bearings of which we are familiar.” but there is much that is confusing about this sentence. Is Mr. Gipson trying to imply that Opposer has only one customer?⁷¹

Applicant’s argument is not well taken. To begin with, Mr. Gipson’s declaration has only six paragraphs.⁷² Mr. **McLain’s** rebuttal declaration had a seventh paragraph with the quoted language, but his declarations, taken as a whole, repeatedly refer to Opposer’s customers in the plural.⁷³ If Applicant found the direct testimony of this witness or any other witnesses confusing, it could have deposed them, but it did not do so. In any event, the quoted section of the McLain rebuttal declaration concerns the relatedness of the parties’ goods, not the acquired

⁶⁸ Slawinski decl. ¶ 3, 40 TTABVUE 4.

⁶⁹ Slawinski decl. ¶¶ 5, 6, 40 TTABVUE 5.

⁷⁰ Slawinski rebuttal decl. ¶5, 56 TTABVUE 6.

⁷¹ Applicant’s brief, 64 TTABVUE 27.

⁷² Gipson decl., 38 TTABVUE.

⁷³ McLain decl. ¶ 5, 6, 7, and rebuttal decl. ¶ 6, 7, 8, 39 TTABVUE 5-6, 55 TTABVUE 6-7.

distinctiveness of Opposer's marks.

Applicant also objects to the three witnesses' statements regarding whether Applicant's use of its mark for bearings would cause customer confusion:

Further, the claims made in Paragraph 8 of the Gipson declaration, Paragraph 5 of the Slawinski declaration and Paragraphs 5 and 8 of the McLain declaration are inadmissible hearsay, insofar as the declarants attribute beliefs and statements to unnamed and unidentified "customers", such as the McLain statement hypothesizing a what-if by saying, "If our customers acquired..." McLain Decl. ¶8). Without direct testimony from these unidentified customers, there is insufficient information to ascertain what they were thinking, or what caused the purported confusion.⁷⁴

Again, Applicant's argument pertains more to likelihood of confusion under the *DuPont* factors than to the acquired distinctiveness of Opposer's marks. We agree that the witnesses' testimony cannot supplant the Board's determination of the ultimate question of whether there is a likelihood of confusion. *See Pierce-Arrow Soc'y v. Spintek Filtration, Inc.*, 2019 WL 3834985, *3, 2019 USPQ2d 471774, *2 (TTAB 2019) ("the Board disregards opinion testimony regarding the ultimate disposition of the claims asserted") (citing *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1755 (TTAB 2013), *aff'd mem.*, 565 F. App'x 900 (Fed. Cir. 2014)). Their testimony has not been considered for that purpose.

With respect to acquired distinctiveness, these three witnesses attest not only to their own familiarity with Opposer's marks, but to their direct transactions with industrial users, who use the CRAFT marks to request and purchase Opposer's

⁷⁴ Applicant's brief, 64 TTABVUE 27-28.

products.⁷⁵ The statements are direct testimony regarding distributors' and customers' use of the marks, calling for the goods by their brand name. As Mr. McLain testified, "In ordering Craft Bearing Company's products, some of our customers have referenced the advertisements and marketing materials they have seen."⁷⁶ And as Mr. Slawinski testified, "many of our customers, when selecting bearings, specifically request and rely on the names 'CRAFT' and 'CRAFT BEARING COMPANY'."⁷⁷ This is not hearsay; it is offered not for the truth of what the customers stated, but for the fact that the statements were made; the witnesses, as parties to the transactions, may testify to customers' use of the brand names based on personal observation. Fed. R. Evid. 801(c). Since the customers in this case are industrial concerns using the brand names in the course of negotiating contracts to purchase the CRAFT BEARING COMPANY bearings, the distributors and reseller with whom they transact business over the years can testify regarding their use and recognition of the marks. As such, we accord this testimony appropriate probative value in determining the acquired distinctiveness of Opposer's marks.⁷⁸

Finally, Applicant, referring once again to its chart of approximately forty third-

⁷⁵ Gipson decl. ¶ 5, 38 TTABVUE 5; McLain decl. ¶ 5, 39 TTABVUE 5, Slawinski decl. ¶ 6, 40 TTABVUE 5.

⁷⁶ McLain decl. ¶ 7, 39 TTABVUE 6.

⁷⁷ Slawinski rebuttal decl. ¶5, 56 TTABVUE 5-6.

⁷⁸ This is not a case involving consumer goods, where the customers are members of the general public, and distributors' views of brand recognition would carry less probative value. See e.g., *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 296 (CCPA 1954) (affidavits of secondary meaning from those in the trade probative of recognition of "BUTTER-NUT" mark for candy, although not representative of purchasing public); *In re Edward Ski Products Inc.*, 49 USPQ2d 2001, 2005 (TTAB 1999) (affidavits of dealers as to secondary meaning does not prove consumer recognition of ski masks as source-indicating).

party registrations, all of which have been submitted into the record, argues that Opposer cannot show substantially exclusive use of its CRAFT marks, as required for a showing of acquired distinctiveness:

Opposer here has not provided -- and cannot provide -- proof of substantially exclusive use of “CRAFT” in commerce for the five years before it had to show priority because of the various third party registrations that then existed for marks containing the term “craft” or phonetic equivalents in connection with related if not identical goods that moved in the same channels of trade as do Opposer’s goods bearing its “CRAFT” mark.⁷⁹

To these third-party registrations, Applicant adds one more reference: to Craft Machine Works, Inc., a Norfolk, Virginia metal products firm at which the CEO and secretary of Opposer and another individual had been shareholders and officers before forming Opposer.⁸⁰

The issue is whether these third-party marks impaired purchasers’ formation of an association between Opposer’s CRAFT BEARING COMPANY mark and Opposer as the source of bearings and related components bearing that mark. *See Real Foods. v. Frito-Lay*, 128 USPQ2d at 1377. We find that they did not. To prevent the marks from acquiring distinctiveness, such third-party evidence should show, for instance, common use of the same terminology by different entities in the industry to describe their same or similar goods. *See Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1854 (TTAB 2017) (“Given the number of third-party uses, consumers are likely to perceive the word ‘medical extrusion technologies’ when

⁷⁹ Applicant’s brief, 64 TTABVUE 28; Applicant’s response to motion for summary judgment ex. J, 29 TTABVUE 103-106.

⁸⁰ Moore decl. ¶ 4, 24 TTABVUE 3; Applicant’s brief, 64 TTABVUE 29.

used for medical extrusion goods, not as a trademark for one company, but rather as common terminology used by different entities in the industry to describe those goods.”); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1480 n. 21 (TTAB 2016) (“The evidence of third-party usage of Mini Melts marks for food products does not negate Applicant’s claim that its use has been ‘substantially exclusive.’ To this point, the record is devoid of any third-party uses of the same or a similar mark in the pharmaceutical industry.”). A party’s own entry into a market for the same or similar goods may help show that its adversary’s use was not substantially exclusive. *E.g., Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) (“This evidence of a significant and continuous concurrent use of the term [SUPER BLEND motor oil] by appellee rebuts appellant’s contention that it has exclusively and continuously used the mark with the result that it has become distinctive of its goods.”); *Performance Open Wheel Racing v. United States Auto Club*, 2019 USPQ2d 208901, * 9 (TTAB 2019) (evidence that opposer “has used the phrase NATIONAL MIDGET SERIES for its arranging and conducting of automobile racing events and sanctioning, supervising, and officiating of automobile races across the country since as early as 2004’ is probative that Applicant’s use of NATIONAL MIDGET SERIES has not been substantially exclusive.”).

Yet here, Applicant has not entered the U.S. market, so its mark has not impaired Opposer’s acquisition of distinctiveness in this country. None of the third-party marks it cites contains the phrase “CRAFT BEARING,” as does Opposer’s CRAFT BEARING COMPANY mark. Only two of the cited third-party marks identify

bearings as goods: CAFT (Reg. No. 4979483 for bearings as parts of machines) and CRAFTFSA (Reg. no. 4097082 for bicycle bearings), and the latter registration for CRAFTFSA was cancelled for failure to file a Section 8 statement of continued use. Applicant's evidence of use by others has more bearing on the sixth *DuPont* likelihood-of-confusion factor, "the number and nature of similar marks in use on similar goods," than on acquired distinctiveness. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"). That is, it has more bearing on the strength of Opposer's CRAFT BEARING COMPANY mark than on whether it would be recognized as a mark or as a merely descriptive phrase.

Substantial exclusivity does not mean absolute exclusivity; it makes allowance for use by others that may be inconsequential, and that therefore does not necessarily invalidate the claim of acquired distinctiveness. *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 52 USPQ2d 1307, 1309 (Fed. Cir. 1999). "Thus, in order to determine what constitutes substantial exclusivity in a particular case, we consider all relevant market evidence, including evidence of [a mark owner's] efforts to promote public perception of its mark as a source-indicator and evidence indicating whether such efforts have succeeded." *In re General Mills*, 124 USPQ2d at 1021. The true test of a mark's acquired distinctiveness is the mark owner's success in educating the relevant purchasers to identify the mark with the source of the product. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 422 (Fed. Cir. 1985). In this case, as noted, the evidence indicates that Opposer has marketed and sold its goods under the CRAFT BEARING COMPANY mark over the course of two decades since 1994, and

over that time has succeeded in educating relevant industrial users that it is the source of bearings and related components bearing that mark.

In sum, even if the CRAFT BEARING COMPANY mark were not deemed inherently distinctive, the totality of the evidence shows that it acquired distinctiveness among the relevant purchasing public in the two decades preceding Applicant's constructive use date. We find accordingly that Opposer has established priority in the mark CRAFT BEARING COMPANY for bearings and related components.

IV. Likelihood of Confusion

We base our determination of likelihood of confusion under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *DuPont*, 177 USPQ at 567, cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); see also *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019). When analyzing these factors, the overriding concern is not only to prevent buyer confusion as to the source of the goods, but also to protect the senior mark owner from adverse commercial impact due to use of a similar mark by a newcomer on similar goods. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *In re Country Oven, Inc.*, 2019 USPQ2d 443903, * 2-3 (TTAB 2019).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil*, 26 USPQ2d at 1688 ("the various evidentiary factors may play more or less weighty roles in any particular

determination”). Two key considerations are the similarities between the marks and the similarities between the goods. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”)).

A. Similarity of the Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s and Opposer’s marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “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).

Again, we compare Opposer’s **CRAFT BEARING COMPANY** mark with



Applicant’s mark

Quality Minded

. Applicant argues that the marks are “not

identical”; “Applicant’s mark also includes the phrase ‘QUALITY MINDED’ and a logo that is unique and specific to Applicant”; moreover, its wording is colored and

stylized; so if the marks are taken in their entireties, and not dissected, they are dissimilar.⁸¹

We agree with Opposer, though, that the marks are more similar than dissimilar. While we must consider the marks in their entireties, as purchasers or prospective purchasers would see them, *Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018), one feature of a mark may make a greater impression on these purchasers than another part, and it is appropriate to give more weight to the dominant feature in determining the commercial impression made by the mark. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“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 consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.”) *quoted in TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1116 (TTAB 2019). In this case, the first two words of each mark—CRAFT BEARING and CRAFT BEARINGS—are virtually identical. *See Swiss Grill Ltd., v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2011 n.17 (TTAB 2015) (holding “it is obvious that the virtually identical marks [the singular and plural of SWISS GRILL] are confusingly similar”). The virtual “identity of the marks’ initial two words is particularly significant because consumers typically notice those words first.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018). Even though “BEARING(S)” is generic or at best descriptive, it contributes to the overall

⁸¹ Applicant’s brief, 64 TTABVUE 36-38.

similarity in commercial impression made by the marks. *See In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1748 (TTAB 2018) *aff'd* 777 Fed. Appx. 516 (Fed. Cir. 2019).

The virtually identical wording at the beginning of both marks outweighs the differing wording at the end. *In re Detroit Athletic Co.*, 128 USPQ2d at 1049 n. 3. As noted, the addition of the word 'COMPANY' only indicates that parties have formed an association to deal in such goods, *Goodyear's Rubber Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. at 602, *cited in In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004). And the words "Quality Minded" in Applicant's mark (with "Quality" disclaimed) are not only smaller in size, but less distinctive in meaning, as they would appear to be a laudatory slogan accompanying Opposer's mark.

The design and stylization elements do not distinguish Applicant's mark, either.

As the Board has observed:

In the case of marks, such as Applicant's, consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods. *See In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). The verbal portion of a word and design mark "likely will appear alone when used in text and will be spoken when requested by consumers." *Id.* at 1911; *see also In re Solid State Design Inc.*, 125 USPQ2d 1409, 1411 (TTAB 2018) (citing *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883, 1887 (TTAB 2007) ("[I]t is well settled that if a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods.")).

In re Aquitaine Wine USA, LLC, 126 USPQ2d 1181, 1184 (TTAB 2018).

If anything, Applicant's linked circles design merely reinforces the reference to circular bearings, thus emphasizing the similarity between the marks. *Id.* at 1185

(design reinforces connotation of word mark). And because Opposer's CRAFT BEARING COMPANY mark is not limited to any particular font style, size, or color, it can present its mark in font styles, sizes or colors similar to Applicant's. *Id.* at 1186.

“Considering the substantial similarities between the marks in this case, it seems to us that a purchaser who sees one mark and later encounters the other is likely to think, if the two marks are applied to the same or related goods and/or services, that the second mark is the same mark he had seen earlier, or, if he realizes that there are some differences in the marks, that the second is simply a slightly varied version of the first, with both serving to indicate origin in the same source.” *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1468 (TTAB 1988).

In sum, the marks are extremely similar given that the most important, source-identifying literal portions of the marks are virtually identical. Although the additional wording and design elements present some dissimilarities, they are not sufficient to overcome the identity of the dominant elements, and, as such, the overall commercial impression of the marks is similar. For these reasons, the first *DuPont* factor weighs in favor of finding a likelihood of confusion.

B. Relatedness of the Goods

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration....” *DuPont*, 177 USPQ at 567. Applicant's goods, once again, are:

“Bearings, as parts of machines; bearings for transmission shafts, being parts of machines; journal boxes, as parts of machines” in International Class 7, and

“Structural parts for airplanes; structural parts for ambulances; structural parts for automobiles; structural parts for boats; structural parts for buses; structural parts for motorcycles; structural parts for trucks; structural parts for vans; structural parts of bicycles; vehicle parts, namely, rearview mirrors; vehicle parts, namely, shock absorbers; vehicle parts, namely, steering wheels; windshield wipers, ball joints, axle bearings for land vehicles, and wheel bearings for land vehicles; apparatus for locomotion by land, air or water, namely, land vehicles, boats, airplanes, and automobiles” in International Class 12.

The goods identified in both of Opposer’s applications are “machine parts, namely, bearings, split bearings,” and their components: “bearing inserts, bearing housings, bearing cartridges, bearing inner races, bearing outer races, bearing seal, rolling element cages, clamp collars.” Applicant states that it would be “reasonable for the Board to use only Opposer’s Applied-for Goods in its analysis,”⁸² but then argues that Opposer should be limited to a narrower identification of goods that it has actually manufactured: split ring bearings for industrial uses.⁸³ “If Opposer has established common law trademark rights in or to the mark CRAFT in connection with Opposer’s Stated Goods, they are limited to split roller bearings used in specified industries...” Applicant contends.⁸⁴ Applicant argues that its Class 7 goods are not legally identical to Opposer’s goods, as there is a broad range of bearings:

It is understandable that one may assume that bearings are a single type of goods, and that all bearings are as similar as all t-shirts. However, this is incorrect; bearings are a broad field....

A mechanical bearing is any type of “component used between two parts that allows rotational or linear movement, reducing friction and enhancing performance to save energy.” ... Some types are plain bearings, rolling element bearings, jewel bearings, fluid bearings, magnetic bearings, and flexure bearings; they are not all the same thing as each bearing does not

⁸² Applicant’s brief, 64 TTABVUE 39.

⁸³ *Id.*

⁸⁴ *Id.*

do the work or fit the purpose that a different type of bearing would do. Opposer only has produced and sold split-housing bearings, which are also known as split roller bearings, and the components thereof ...; they have produced no evidence that they produce, distribute, sell or market the standard bearing groups that are produced, sold and/or distributed by Applicant.⁸⁵

Applicant's marketing manager contends, moreover, that the parties' product ranges differ:

Craft Bearing co. vs. CRAFT bearings product ranges

Craft Bearing Company manufactures premium quality level (i) Split Roller Bearings which consist of Split Cylindrical Roller Bearings and Split Cartridge Assembly with either a Float or Held Bearings. Their product group is used for nonstandard (ii) and high-tech application with difficult replacement requirements (iii). Whereas CRAFT bearings manufactures economy quality level (i) standard bearing groups (ii) for low-tech applications (iii). All CRAFT bearings groups consist of complete and solid bearings and don't offer split type modification (iv). Therefore, Craft Bearing Co. and CRAFT bearings product ranges cannot be compared as they are fundamentally different by designed and overall different bearing groups.

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We find, though, that Applicant's Class 7 bearing goods are legally identical to Opposer's bearing goods. Applicant's general identification of goods, "Bearings, as parts of machines" must be deemed to include all goods of the type identified. *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013); *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413 (TTAB 2018) (citing *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006)). We may not read limitations into Applicant's identification based on its actual goods in commerce. *In re i.am.symbolic, LLC*, 123 USPQ2d at 1748; *In re Country Oven, Inc.*, 2019 USPQ2d 443903, * 5 (TTAB 2019). Applicant's broadly worded "bearings, as

⁸⁵ Applicant's brief, 64 TTABVUE 39-40.

⁸⁶ Martikonis decl. ex. E, 49 TTABVUE 235-236.

parts of machines” completely encompasses Opposer’s goods, even if they are limited to split roller bearings in industrial uses. *See, e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”). Applicant’s Class 7 goods are thus legally identical to Opposer’s goods.

Applicant contends that its Class 12 goods are not even related to Opposer’s goods: “Applicant notes that not one piece of evidence ... states that Opposer’s Goods are used in land or air vehicles...”;⁸⁷ “Opposer has no claim to common law rights that intersect at all with Applicant’s Class 12 Goods such as windshield wipers, steering wheels or bicycle parts...”;⁸⁸ Opposer’s goods “are limited to split roller bearings used in specified industries”;⁸⁹ “The parties’ respective goods’ nature, purpose and function, are inherently non-competitive. Opposer’s Goods are bearings for manufacturing, not for vehicles; Opposer’s Stated Goods certainly do not overlap with Applicant’s Class 12 Goods.”⁹⁰

Applicant’s arguments miss the point. “[T]he test is not whether consumers would be likely to confuse these goods, but rather whether they would be likely to be confused as to their source.” *In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1737 (TTAB 2018). “When analyzing the similarity of the goods, ‘it is not necessary that the

⁸⁷ Applicant’s brief, 64 TTABVUE 38.

⁸⁸ Applicant’s brief, 64 TTABVUE 39.

⁸⁹ *Id.*

⁹⁰ Applicant’s brief, 64 TTABVUE 42.

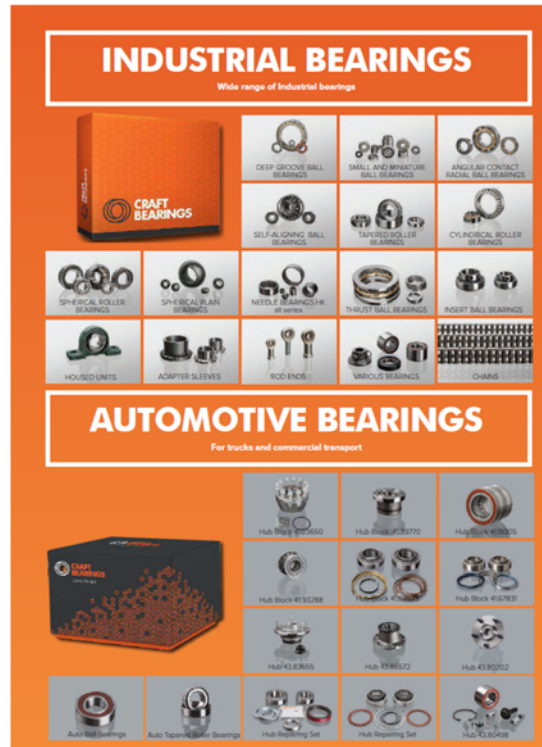
products of the parties be similar or even competitive to support a finding of likelihood of confusion.’ *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007). Instead, likelihood of confusion can be found ‘if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’ *Id.*” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012). This mistaken belief can take different forms:

The PTO and this court apply the related goods test to refuse registration when a mark so resembles a previously registered mark or one used in commerce that consumers are likely to believe that the applicant’s related goods or services come from the **same source, are affiliated with, connected with, or sponsored** by the owner of the previous mark or name. 15 U.S.C. §1052(d) (1994 & Supp.V 1999); *Nina Ricci, S.A.R.L. v. E.T.F. Enters.*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989); *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §24:63 (4th ed. 1997).

In re Save Venice New York, Inc., 259 F.3d 1346, 59 USPQ2d 1778, 1784 (Fed. Cir. 2001) (emphasis added).

Applicant’s Class 12 goods are sufficiently related to Opposer’s goods to engender a mistaken belief among purchasers that they come from the same source, or are affiliated with, connected with, or sponsored by Opposer. Although Applicant’s Class 12 goods consist largely of structural parts of vehicles, they include “axle bearings for land vehicles, and wheel bearings for land vehicles...” Vehicular bearings and industrial bearings can emanate from the same source, as evidenced by Applicant’s

marketing materials, which state that “CRAFT Bearings develops and produces a comprehensive range of high-quality industrial and automotive bearings,”⁹¹ e.g.:



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Opposer is at present the only entity in the United States manufacturing bearings under a CRAFT BEARING mark. (The closest third party, according to the record evidence, offers bearings as parts of machines under the registered mark CAFT.)⁹³ If Applicant were to enter the U.S. market offering axle bearings and wheel bearings



under its mark **Quality Minded**, that would suggest an affiliation or connection with

Opposer, or sponsorship by Opposer, *see In re Save Venice New York*, 59 USPQ2d at 1784. It could also suggest a line expansion by Opposer, who testifies that its split

⁹¹ Martikonis decl. ex. D, 49 TTABVUE 193.

⁹² Martikonis decl. ex. D, 49 TTABVUE 198.

⁹³ Reg. No. 4979483.

roller bearings can substitute for conventional solid roller bearings in many applications.⁹⁴ See *Tuxedo Monopoly, Inc. v. General Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (“likelihood of confusion must be found if the public, being familiar with [plaintiff’s] use of MONOPOLY for board games and seeing the mark on any item that comes within the description of goods set forth by [applicant] in its application, is likely to believe that [plaintiff] has expanded its use of the mark, directly or under license.”). In fact, Applicant, which mainly produced industrial bearings, created a subsidiary to produce automobile bearings.⁹⁵ Its entry into the U.S. market under its proposed mark would suggest that Opposer expanded its line of bearings in much the same way: through an affiliation with Applicant.

For these reasons, we find that the parties’ goods are related under the second *DuPont* factor.

C. Channels of Trade and Classes of Customers

The third *DuPont* factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1161.

Applicant states “It is reasonably presumed that Applicant’s Goods and Opposer’s Goods move in all normal channels of trade for such goods, and are available to all classes of purchasers of such goods.”⁹⁶ It argues, however, that those channels

⁹⁴ Opposer’s brief, 61 TTABVUE 31; Opposer’s reply brief, 65 TTABVUE 13; Hadden decl. ¶¶ 6-7, 53 TTABVUE 6; Hintz decl. ¶¶ 2-8, exs. A-F, 30 TTABVUE 16-53.

⁹⁵ Applicant’s first notice of reliance, ex. G, Applicant’s 2013 catalog, 46 TTABVUE 74.

⁹⁶ Applicant’s brief, 64 TTABVUE 43, citing *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 1373 (Fed. Cir. 2013).

diverge, that the record does not admit of a reasonable probability of the same customers encountering both parties' marks, and that there is no "evidence that Applicant's Class 12 Goods would be sold alongside Opposer's Goods."⁹⁷ (Citing *In re Fesco Inc.*, 219 USPQ 437, 438-39 (TTAB 1983) (finding no relatedness between processing equipment and machinery and "distributorship services in the field of farm equipment and machinery" and their channels of trade). In this regard, Cesar Niada, general manager at Prime Industrial Solutions, a product distributor for Applicant, testifies that because Opposer produces split bearings and Applicant does not, their bearing numbers would differ, and distributors and end users, who order bearings by number, not brand, would not encounter the parties' products together.⁹⁸ Another witness, Nicola Beer, commercial director of BearingNet Limited, based in the United Kingdom, testifies that BearingNet gives businesses online access to the inventories of the largest bearing and power transmission distributors; and while Applicant has been a member of BearingNet since 2006, Opposer has never been a member.⁹⁹

Unlike *In re Fesco*, however, we find in this case that the parties' goods, which are related, have related channels of trade and classes of customers. Since Applicant's Class 7 bearing goods are legally identical to Opposer's, they are presumed to travel in the same channels of trade to same classes of customers. *In re Viterra Inc.*, 101

⁹⁷ Applicant's brief, 64 TTABVUE 43.

⁹⁸ Niada decl. ¶¶ 4-5, 47 TTABVUE 4.

⁹⁹ Beer decl. ¶¶ 1-2, 6-7, 48 TTABVUE 4.

USPQ2d at 1908; *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

As Applicant states, its Class 12 bearings are presumed to travel through all usual channels of trade and be offered to all normal potential purchasers. *In re i.am.symbolic*, 123 USPQ at 1750. And as its own advertising demonstrates, its Class 12 automotive bearings are offered alongside its industrial bearings.¹⁰⁰ Opposer corroborates this convergence of trade channels with evidence that five bearing distributors sell split bearings with other types of bearings.¹⁰¹ In the United States, the primary source for bearings is through such authorized distributors, according to Opposer's witnesses.¹⁰² Customers ordering bearings from these distributors ask for them by brand name first and bearing size second, they attest.¹⁰³ This is contrary to the testimony of Applicant's witness, Mr. Niada, whose business operates in Latin America and the Caribbean, and who has provided no evidence of familiarity with marketing practices in the United States.¹⁰⁴ Similarly, BearingNet, based in the United Kingdom, is used primarily in Europe, and is not a primary source for locating bearings in the United States.¹⁰⁵

Consequently, Applicant's evidence does not contravene Opposer's evidence that

¹⁰⁰ Martikonis decl. ex. D, 49 TTABVUE 198.

¹⁰¹ Hintz reply decl. exs. A-F, 30 TTABVUE 15-53.

¹⁰² Hadden rebuttal Dec. ¶ 5, 54 TTABVUE 5; McLain Rebuttal Dec. ¶ 4, 55 TTABVUE 5.

¹⁰³ Moore rebuttal decl. ¶ 7, 53 TTABVUE 7; McLain Rebuttal Dec. ¶ 3, 55 TTABVUE 5.

¹⁰⁴ Moore decl. ¶ 7, 53 TTABVUE 7-8.

¹⁰⁵ Moore rebuttal Decl. ¶ 7, 53 TTABVUE 5; Hadden Rebuttal Dec. ¶ 5, 54 TTABVUE 5.

the parties' channels of trade and classes of customers are identical in part and overlapping in part.

For these reasons, we find that the third *DuPont* factor favors Opposer.

D. Care and Sophistication of Purchasers

Under the fourth *DuPont* factor, we consider “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.”

DuPont, 177 USPQ at 567.

Applicant argues that:

Where purchasing decisions for goods like Opposer's and Applicants are made, they are done by highly sophisticated and knowledgeable buyers under conditions of sale which would further minimize any likelihood of confusion as to source or affiliation. No customer would purchase a bearing without knowing their needs in terms of its rating, the temperature it will be operating at, and information regarding the axial, radial and shock loads; no reasonable consumer would seek out or purchase a bearing for a bicycle or a car when they were seeking a split cylindrical roller bearing for use in a water treatment plant - or even an automotive manufacturing facility.¹⁰⁶

It is true that the nature of the goods and the process of contracting for their purchase will necessarily entail some measure of care and sophistication. But “being knowledgeable and/or sophisticated in a particular field does not necessarily endow one with knowledge and sophistication in connection with the use of trademarks.” *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988).

In this case, the legal identity or similarity of the [goods] and similarity of the marks outweigh any sophisticated purchasing decision. *See HRL Assocs., Inc. v. Weiss Assocs., Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods.). *See also In re Research & Trading Corp.*, 793 F.2d

¹⁰⁶ Applicant's brief, 64 TTABVUE 44.

1276, 230 USPQ 49, 50 (Fed. Cir. 1986), (citing *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) (“Human memories even of discriminating purchasers ... are not infallible.”)).

In re Integrated Embedded, 120 USPQ2d 1504, 1516 (TTAB 2016).

Even if prospective bearing purchasers are sophisticated, they could still infer from the parties’ highly similar CRAFT BEARING-formative marks that their legally identical or related goods emanate from the same source, or from affiliated sources, such as a licensor and licensee. See *Tuxedo Monopoly v. General Mills Fun Grp.*, 209 USPQ at 988. The advertising and goodwill of one entity could inure unfairly to the other; and any lapses in quality by one could reflect unfairly on the other, damaging its goodwill. *In re Shell Oil*, 26 USPQ2d at 1690 (“The registrant/senior user is safeguarded by the trademark law, as is the consuming public, from likelihood of confusion caused by the entry of a junior user of a confusingly similar mark. ...The trademark law not only protects the consumer from likelihood of confusion as to commercial sources and relationships, but also protects the registrant and senior user from adverse commercial impact due to use of a similar mark by a newcomer.”).

Thus, the care and sophistication of prospective purchasers does not suffice to avert a likelihood of confusion. This *DuPont* factor is neutral.

E. Strength of Opposer’s Mark

The fifth *DuPont* factor is “[t]he fame of the prior mark (sales, advertising, length of use).” *DuPont*, 177 USPQ at 567.

Applicant argues that Opposer “has made no showing that its mark was famous before Applicant’s application date, much less Applicant’s first use analogous to

trademark usage.”¹⁰⁷ Likelihood of confusion fame varies along a spectrum from very strong to very weak. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017). We consider its inherent strength, based on the nature of the mark itself, and its commercial strength, based on its marketplace recognition. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010).

In this case, we have found that Opposer’s CRAFT BEARING COMPANY mark is either suggestive, and therefore inherently distinctive, or has acquired distinctiveness. In the course of assessing its acquired distinctiveness, we considered the evidence of its marketplace exposure to relevant purchasers, including its sales, advertising, length of use since 1994, and general reputation. *See Coach Servs. v. Triumph Learning*, 101 USPQ2d at 1720. Based on all of the evidence, we have found that if Opposer’s mark were merely descriptive when adopted, it acquired distinctiveness before Applicant’s constructive use date. To determine likelihood of confusion, we generally consider evidence relating to the fame of a mark up to the time of trial. *TiVo v. Tivoli*, 129 USPQ2d at 1113 n. 69. And we find that Opposer has steadily continued to build purchaser recognition over the past 25 years.

Considering the record in its entirety as to strength, we accord Opposer’s mark a normal degree of strength as to its goods in the likelihood of confusion analysis. This *DuPont* factor is also neutral.

F. Third Party Use of “CRAFT”

¹⁰⁷ Applicant’s brief, 64 TTABVUE 44-45.

Under the sixth *DuPont* factor, we consider “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 177 USPQ at 567. This *DuPont* factor is the inverse of the fifth, as evidence of third parties’ registration and use of similar marks on the same or similar goods may show that an opposer’s mark, or an element of that mark, is conceptually or commercially weak. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). Applicant cites its list of approximately forty third-party registrations for this purpose, arguing that this evidence “can show that customers have been educated to distinguish between different marks on the basis of minute distinctions,”¹⁰⁸ (quoting *Jack Wolfskin*, 116 USPQ2d at 1136 (quoting *Juice Generation*, 115 USPQ2d at 1674)).

However, Applicant’s list fails to demonstrate that Opposer’s CRAFT BEARING COMPANY mark is so weak, as used on bearings, that Applicant may register a CRAFT BEARINGS-formative mark for use on bearings and related goods without engendering source confusion. As noted, only two of the third-party registrations were for bearings; one of those was cancelled, and the other was for CAFT. Unlike *Juice Generation* and *Jack Wolfskin*, where the third-party evidence involved the same restaurant services and clothing at issue, Applicant’s third-party evidence relates to a broader range of goods. “[T]he controlling inquiry is the extent of third-party marks in use on ‘similar’ goods or services. . . . ‘It is less relevant that [the mark] is used on

¹⁰⁸ Applicant’s brief, 64 TTABVUE 45.

unrelated goods or services....’” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694 (Fed. Cir. 2018) (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)). Applicant submitted no evidence of the third-party marks’ use in commerce. *Cf. Jack Wolfskin*, 116 USPQ2d at 1136 (noting that third-party registrations were accompanied by evidence of the marks in use in Internet commerce); *Juice Generation*, 115 USPQ2d at 1674 (acknowledging testimony of applicant’s founder concerning third-party use of similar marks). “Third-party registrations are not evidence that the marks shown therein are in use, or that the public is familiar with them.” *TiVo v. Tivoli*, 129 USPQ2d at 1117. Moreover, none of the third-party marks contained “CRAFT BEARING(S),” the main point of similarity between the parties’ marks. Thus Applicant’s evidence does not demonstrate that customers have been educated to distinguish between the parties’ marks on the basis of minute distinctions.

The sixth *DuPont* factor is therefore neutral.

G. Actual Confusion

Under the seventh and eighth *DuPont* factors, we consider the nature and extent of any actual confusion in light of the length of time and conditions under which there has been contemporaneous use of the parties’ subject marks. *DuPont*, 177 USPQ at 567.

Opposer, whose website is at www.craftbearing.com, adduces seven emails, most addressed to Opposer at info@craftbearing.com, requesting price quotations for bearings displayed on **Applicant’s** website, at www.craft-bearings.com. The emails

date from August 2017 through November 2018, and come from prospective customers in East Hanover, New Jersey, Duluth, Minnesota, and Chicago, Illinois, as well as foreign countries: Denmark, Mexico, Sri Lanka, and England.¹⁰⁹ We infer that these are prospective rather than existing customers, as none of the correspondence evinces prior familiarity with Opposer. For instance, one begins “Hi Craft I’m looking in your catalog called, Quality Minded, and I have found some automotive bearing....”¹¹⁰ Opposer contends that these emails demonstrate actual confusion, and notes that “[t]his has occurred even without Applicant conducting sales in the United States.”¹¹¹

Applicant contends that this is not legitimate evidence of actual confusion, as four of the emails originate from outside the United States, where Applicant markets its goods, and “While Applicant has only used the CRAFT BEARINGS QUALITY MINDED & Design mark for a few years, it has used the CRAFT BEARINGS portion since 2004, during which time it has co-existed in the global marketplace alongside Opposer’s use of the term “CRAFT” in connection with Opposer’s Goods, and as explained elsewhere herein, no instances of actual confusion have been shown by Opposer, or by Applicant.”¹¹² Opposer counters that “As Applicant has not sold goods in the United States yet, there have been limited opportunities for confusion to have

¹⁰⁹ Hadden decl. ex. J, 36 TTABVUE 134-138; Hadden rebuttal decl. ex. A, 54 TTABVUE 9-12.

¹¹⁰ 36 TTABVUE 136.

¹¹¹ Opposer’s brief, 61 TTABVUE 35-36.

¹¹² Applicant’s brief, 64 TTABVUE 47-48.

occurred so far.”¹¹³

We find that this evidence falls short of proving actual confusion. After all, the misdirected email correspondence could be attributable to the parties’ similar domain names, www.craftbearing.com and www.craft-bearings.com. “Without direct testimony from these individuals, there is insufficient information to ascertain what they were thinking, or what caused the purported confusion.” *Mini Melts v. Reckitt Benckiser*, 118 USPQ2d at 1475. On the other hand, the misdirected emails are at least “illustrative of a situation showing how and why confusion is likely.” *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975) (quoting *Libbey-Owens-Ford Glass Co. v. Thermoproof Glass Co.*, 390 F.2d 770, 156 USPQ 510, 511 (CCPA 1968)). They illustrate how the singular “craftbearing” could be confused with the plural “craft-bearings,” and how a prospective customer could take “Quality Minded” as a laudatory phrase referring to Opposer’s catalog of goods, not as a distinguishing element of Applicant’s mark.

The seventh and eighth *DuPont* factors are thus neutral.

H. Variety of Goods on Which a Mark is or is Not Used

The ninth *DuPont* factor is “the variety of goods on which a mark is or is not used...” *DuPont*, 177 USPQ at 567. If a party in the position of plaintiff uses its mark on a wide variety of goods, then purchasers are more likely to view a defendant’s related goods under a similar mark as one of the plaintiff’s large number of diverse products. *See, e.g., Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1663

¹¹³ Opposer’s reply brief, 65 TTABVUE 15.

(TTAB 2002) (“We find that the ninth *du Pont* factor (the variety of goods on which a mark is used) weighs in opposer’s favor. The evidence establishes that opposer has licensed its Road Runner marks for use on a large number of diverse products.”).

Applicant states that “Opposer appears to only use its mark in connection with split bearings and replacement component parts for its own split bearings....”¹¹⁴ Opposer responds that it promotes its split bearings as an improvement over standard bearings, and endeavors to persuade users of standard bearings, such as those sold by Applicant, to switch to Opposer’s bearings.¹¹⁵

We find that this is essentially a reiteration of the arguments under the second *DuPont* factor, and find the ninth *DuPont* factor neutral.

I. Right to Exclude Others

The eleventh *DuPont* factor is “[t]he extent to which applicant has a right to exclude other from use of its mark on its goods.” *DuPont*, 177 USPQ at 567.

Applicant asserts that “Opposer has no federal registration, and no registration in any country outside the United States; Applicant, of course, has the right to exclude others, including Opposer, from use of ‘CRAFT BEARINGS’ in other countries.”¹¹⁶ Opposer notes that “trademark rights are still territorial,”¹¹⁷ and we agree.

This *DuPont* factor concerns the extent to which Applicant has a right to exclude others from use of its mark on its goods in the United States. *See Am. Stock Exch.*,

¹¹⁴ Applicant’s brief, 64 TTABVUE 48.

¹¹⁵ Opposer’s reply brief, 65 TTABVUE 13; Hadden rebuttal decl. ¶¶ 6-7, 54 TTABVUE 6.

¹¹⁶ Applicant’s brief, 64 TTABVUE 49.

¹¹⁷ Opposer’s reply brief, 65 TTABVUE 16.

Inc. v. Am. Express Co., 207 USPQ 356, 364 (TTAB 1980). As noted above, Applicant's extraterritorial use of its mark has created no rights in this country. There is, in consequence, no evidence that Applicant has asserted its rights so as to exclude anyone else from using its mark or any similar mark in this country. See *McDonald's Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1284-85 (TTAB 2014).

This factor is also neutral.

J. Extent of Potential Confusion and Any other Probative Fact


Under the twelfth *DuPont* factor, the extent of potential confusion, Applicant argues that since both parties have used their marks in the "global marketplace" since 2004, without evidence of actual confusion, the absence of confusion should weigh in Applicant's favor. And under the thirteenth factor, it argues that the parties' goods are so unrelated that confusion is unlikely, even if their marks were similar.¹¹⁸ This is essentially a reargument of the second, seventh and eighth *DuPont* factors. We agree with Opposer that since Applicant has not yet entered the U.S. marketplace, there has been no reasonable opportunity for confusion to occur. See *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039-40 (TTAB 2016). And if it did enter the marketplace in this country, its legally equivalent and related goods, offered under a mark very similar to Opposer's, would be likely to cause confusion.


Thus, these factors are neutral.

V. Conclusion

¹¹⁸ Applicant's brief, 64 TTABVUE 49-50.

We have considered of all of the evidence of record and all of the arguments presented, including evidence and arguments not specifically discussed in this opinion, as they pertain to the relevant *DuPont* likelihood of confusion factors. For the above reasons, we find by a preponderance of the evidence that Opposer has established prior trademark rights in its CRAFT BEARING COMPANY mark in the

United States, and that Applicant's subject  mark, as used in connection with the goods identified in the Application, so resembles Opposer's mark as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

Decision: The opposition to registration of Applicant's mark  is sustained.