

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
April 24, 2013

Mailed:
July 12, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Edgecraft Corporation
v.
*Smith's Consumer Products, Inc.*¹

Cancellation No. 92052940
Cancellation No. 92054092
Cancellation No. 92054104

Jennifer Fraser of Connolly Bove Lodge & Hutz LLP for Edgecraft Corporation.

Kathryn Bennett Perkins of Rose Law Firm for Smith's Consumer Products, Inc.

Before Bucher, Bergsman and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Edgecraft Corporation ("petitioner") filed three petitions, each seeking to cancel a registration of the trademark EDGEWARE, in standard character form, belonging to Smith's Consumer Products, Inc. ("respondent"). Upon the parties' joint motion, the three cancellation proceedings were consolidated by an order of the

¹ Respondent, formerly named Smith Abrasives, Inc., changed its name as of May 23, 2012. The change of name has been recorded in the Assignments Branch of the Patent and Trademark Office at Reel 4808, Frame 0704.

Board dated August 25, 2011. The three registrations at issue relate to the following goods:

- | | |
|--------------------------------|--|
| Reg. No. 3617203: ² | Electric knife sharpeners; Electric scissor sharpeners; Power operated sharpeners; Hand tools, namely, knife sharpeners; hand-operated sharpening tools and instruments; knife sharpeners; manually operated sharpeners; sharpening rods; sharpening stones; whetstones; |
| Reg. No. 3881712: ³ | Hand operated kitchen tools, namely, slicers, choppers and mandolins for cutting food; and |
| Reg. No. 3951563: ⁴ | Hand operated kitchen tools, namely, graters. |

As grounds for cancellation, petitioner has alleged priority of use and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Petitioner has alleged that it is the owner of the trademark EDGECRAFT, which it uses and has used in the manufacture and sale of knife sharpeners and other household tools and appliances; that it is the owner of several U.S. registrations of the mark EDGECRAFT and of other marks that include the designation EDGECRAFT combined with additional matter; that petitioner has priority of use over respondent and its mark; and that respondent's registered mark EDGEWARE, as applied to respondent's goods, so resembles the mark EDGECRAFT as to be likely to cause confusion, or to cause mistake, or to deceive as to the source of respondent's goods. Respondent has denied the salient allegations of the petitions for cancellation.

² Issued May 5, 2009, based on an application filed March 12, 2008.

³ Issued November 23, 2010, based on an application filed July 28, 2009.

⁴ Issued April 26, 2011, based on an application filed July 28, 2009.

In connection with the petition to cancel Reg. No. 3617203, petitioner has pleaded ownership of the following U.S. registrations:

Reg. No. 1678267 for the mark **EDGECRAFT** for “electric knife sharpener”;⁵

Reg. No. 1870338 for the mark **EDGECRAFTER** for “hand operated sharpeners for knives and other cutting tools; and hand-held tools, namely, files”;⁶

Reg. No. 2810653 for the mark **EDGECRAFT WORLD LEADER IN CUTTING EDGE TECHNOLOGY** for “electric sharpeners for cutting instruments, namely, knives and scissors” and “manually operated knives, namely, kitchen knives and hand operated sharpeners for knives and other cutting tools”;⁷

Reg. No. 2625106 for the mark **EDGESELECT** for “electric knife sharpener”;⁸

Reg. No. 1831107 for the mark **EDGECRAFTER DIAMOND HONE SET** for “manual files and sharpeners.”⁹

In connection with the petitions to cancel Reg. Nos. 3881712 and 3951563, petitioner has pleaded ownership of the above registrations and, in addition, has pleaded ownership of the following registrations:

Reg. No. 1832619 for the mark **EDGECRAFTER** for “manual files and sharpeners”;¹⁰

Reg. No. 1868018 for the mark **EDGECRAFT DIAMOND FILE SET** for “hand tools; namely, files”;¹¹

⁵ Registered March 10, 1992, based on an application filed November 19, 1990; renewed.

⁶ Registered December 27, 1994, based on an application filed December 21, 1992; renewed.

⁷ Registered February 3, 2004, based on an application filed February 24, 2003. Section 15 affidavit acknowledged.

⁸ Registered September 24, 2002, based on an application filed May 17, 2001; renewed.

⁹ Registered April 19, 1994, based on an application filed July 20, 1993; renewed.

¹⁰ Registered April 26, 1994, based on an application filed July 19, 1993; renewed.

¹¹ Registered December 20, 1994, based on an application filed July 19, 1993; renewed.

Reg. No. 2135689 for the mark EDGECRAFT for “manual sharpeners for knives and other cutting tools.”¹²

I. The record

The record includes the pleadings and, by operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the registration files for respondent’s marks. The record also includes the testimony and evidence set forth below:¹³

A. Petitioner’s Evidence.

1. Testimony deposition of Samuel Weiner, petitioner’s President, with attached exhibits.
2. Testimony deposition of Valerie Jean Gleason, petitioner’s public relations, marketing, communications manager, with attached exhibits.
3. Testimony deposition of Margaret Lynn Liddle, petitioner’s sales manager.
4. Testimony deposition of Michael M. Kilyk, petitioner’s sales manager, with attached exhibits.
5. Testimony deposition of Tracy L. Bray, former acting assistant manager at GHR¹⁴, Lancaster, PA, with attached exhibits.
6. Testimony deposition of John Rae, Buying Director, UKDA,¹⁵ with attached exhibits.

Petitioner also relies upon portions of the discovery depositions (and related exhibits), submitted by stipulation of the parties, of the following persons:

¹² Registered February 10, 1998, based on an application filed January 31, 1997; renewed.

¹³ A note on confidentiality: The parties have designated most information relating to their customers and prospective customers as highly confidential. Accordingly, instead of naming the parties’ customers, we will identify them by defined terms relating to their general type of entity.

¹⁴ GHR is a gourmet housewares retailer that has offered goods of both parties.

¹⁵ UKDA is a distributor of petitioner’s goods in the United Kingdom.

7. Daniel Lee Glidden, respondent's Chairman and CEO.
8. Samuel Weiner, petitioner's President.
9. Michael M. Kilyk, petitioner's sales manager.
10. The late Daniel D. Friel, Sr., petitioner's former Chief Executive Officer.
11. Daniel D. Friel, Jr., petitioner's Vice President of Operations.
12. Mark Shannon Adkison, respondent's Vice President of Global Sales.
13. Mary Katherine DaRin, petitioner's manager of trade shows and special events.
14. Jon A. Holmquist, owner of Edgemaster Mobile Sharpening.
15. Geoffrey D. Rapp, Vice President of Engineering and Quality, Bettcher Industries.

Petitioner also submitted, with its notice of reliance and rebuttal notice of reliance, its pleaded registrations, various printed publications, selected responses of respondent to interrogatories, requests for admission, and requests for production, web page printouts, discovery documents produced by the parties (by stipulation), and prosecution histories of U.S. trademark applications of third parties.

B. Respondent's Evidence.

1. Testimony deposition of Daniel Lee Glidden, petitioner's President and CEO, with attached exhibits.
2. Testimony deposition of Mark Shannon Adkison, petitioner's Vice President of Global Sales, with attached exhibits.

Respondent also relies upon portions of the discovery depositions (and related exhibits), submitted by stipulation of the parties, of the following persons:

3. Daniel Lee Glidden, respondent's Chairman and CEO.
4. Samuel Weiner, petitioner's President.
5. Michael M. Kilyk, petitioner's sales manager,.
6. The late Daniel D. Friel, Sr., petitioner's former Chief Executive Officer.
7. Daniel D. Friel, Jr., petitioner's Vice President of Operations.
8. Mark Shannon Adkison, respondent's Vice President of Global Sales.
9. Mary Katherine DaRin, petitioner's manager of trade shows and special events.
10. Jon A. Holmquist, owner of Edgemaster Mobile Sharpening.
11. Geoffrey D. Rapp, Vice President of Engineering and Quality, Bettcher Industries.
12. Janet Shen, owner of YE and YK Enterprise.
13. Richard Wayne Axelrod, President of The Ultimate Edge, Incorporated.
14. Henry F. O'Dougherty, President and CEO of Darex, LLC.

Respondent also relies upon affidavits, submitted by stipulation of the parties, of the following persons:

15. Benton Dale, President of EdgePro, Inc.
16. John R. Anton, President of Great American Tool Company, Inc.
17. Chris Jurey, Treasurer of Klawhorn Industries, Inc.
18. Morgan A. Taylor, President of Taylor Brands, LLC.
19. Daniel Sander, President of United Security Seals, Inc.
20. Clay Allison, President of Wicked Edge Precision Sharpeners.

Respondent also submitted, with its notice of reliance, copies of U.S. registrations owned by itself and by third parties, printed publications, selected responses of petitioner to interrogatories, web page printouts, and discovery documents produced by the parties (by stipulation).

Testimony depositions are cited herein as “[witness] Dep.” Discovery depositions are cited as “[witness] DD.” Petitioner’s notice of reliance is cited as “PNOR”; respondent’s as “RNOR.”

II. Petitioner’s motion to strike respondent’s brief.

Petitioner, in its reply brief, noted that respondent’s main brief was filed late and requested that the Board strike it.¹⁶ Petitioner contends that its own main brief was due on August 4, 2012 (a Saturday) and that respondent’s brief was accordingly due 30 days later on September 3, 2012 (a federal holiday), in accordance with 37 C.F.R. § 2.128(a)(1); that, because of the holiday, respondent’s brief should have been filed on the next business day, September 4; but that respondent actually filed its brief on September 5, 2012.

Respondent argues that its brief was, in fact, timely filed because Trademark Rule 2.196, 37 C.F.R. § 2.196, which allows a party whose deadline falls on a Saturday, Sunday or holiday to act on the next non-holiday weekday, shifted the “due date” of petitioner’s brief to August 6, thereby shifting the date from which respondent’s due date should be calculated. Alternatively, respondent urges that its

¹⁶ Petitioner’s reply brief at 1.

failure to file its brief in a timely manner was the result of an error made in good faith, without prejudice to petitioner.¹⁷

Trademark Rule 2.196 “is not applicable when the opening of an assigned period ... falls on a Saturday, Sunday or Federal holiday.” TBMP § 112. Accordingly, it did not shift the date from which respondent’s due date should have been calculated. Nonetheless, it is clear that respondent’s tardiness, by one day, was the result of a miscalculation made without bad faith, and there is no indication of prejudice to petitioner. Moreover, it serves the Board’s policy of deciding cases on their merits and it benefits the Board in its ability to make a just determination of the case to have the briefs of both parties before it. Accordingly, petitioner’s motion to strike respondent’s brief on the case is denied.

III. The parties

Petitioner is a manufacturer of housewares with manufacturing facilities in Pennsylvania. Petitioner was formed in 1984, but had its first full year of operations in 1996. Weiner Dep. at 9. Petitioner produces and markets “electric sharpeners, manual sharpeners, hybrid-type sharpeners ... electric food slicers, electric kettles, electric waffle makers, electric egg cookers, ... meat grinders, and other miscellaneous products, including knives and some hardware tools, such as files.” Weiner Dep. 10:5-11. Petitioner’s sharpeners are primarily for sharpening knives, but it also produces sharpeners for scissors and sharpeners that can be used to sharpen “hatchets, arrows, fishhooks. Just about anything that has an edge or a

¹⁷ Respondent’s surreply brief at 1-3.

point on it.” Weiner Dep. 10:16-21. Petitioner sells virtually all of its products through retailers in the United States, and directs its goods to the “gourmet,” “sports,” and “hardware” market segments. Petitioner sells to commercial customers, such as restaurants, hotels, and caterers, through dealers and distributors. Weiner Dep 18:5-12. Petitioner also sells through internet retailers and exports its goods to 70 foreign countries. Weiner Dep. 11:8-23. While petitioner maintains that it sells all of its goods under the EDGECRAFT brand (Weiner Dep. 9:23-10:1), it is also clear from the record that the CHEF’S CHOICE brand is an extremely important one for petitioner. According to respondent, the CHEF’S CHOICE brand accounts for the largest market share of the knife sharpener industry. Glidden DD 58:7-10.

Respondent is a company with a long history in the field of sharpeners for knives and other tools. As early as 1886, respondent mined and distributed novaculite (also known as “Arkansas stone”), an abrasive stone used to make traditional flat knife-sharpening stones. Glidden Dep. 8:13-21. Today, under a number of trademarks including SMITH’S and a variety of marks that include the designation EDGE, respondent produces and markets electric and manual sharpeners for knives and other tools. Glidden DD at 11. Respondent has described its consumer retail market as divided into the following segments: housewares, sporting goods, hardware, clubs, grocery, and internet. Glidden DD 164, Exhibit 43. Respondent adopted the mark EDGEWARE particularly for use in the housewares segment. Respondent’s customers are primarily retailers, distributors, and

consumers. Glidden DD 31. Respondent apparently does not target the commercial segment of the market, such as the hospitality industry or industrial customers. Glidden Dep. 13:13-14:1. Among relevant competitors in the sharpener industry, respondent considers itself to be “one of the larger ones.” Glidden DD 59:9. Beginning at least as early as 2006, respondent has used various marks that incorporate the designation EDGE, including THE EDGE EXPERTS, EDGESPORT, EDGEWORK, DIAMOND EDGE GOURMET, CERAMIC EDGE GOURMET, EDGE GRIP, and KNOWLEDGE; and respondent owns U.S. registrations of many of such trademarks. Glidden Dep. at 9-10, 24-25; RNOR Exhibit A-1.

The parties have stipulated that “they are competitors in the marketplace.”¹⁸ Indeed, the evidence shows that they are in a posture of intense direct competition. Respondent has described petitioner as “Smith’s biggest competitor in knife sharpeners,” (Glidden DD at 118) and described petitioner’s CHEF’S CHOICE brand as “who we viewed as our primary competitor.” Glidden DD at 76. Petitioner said of respondent, “out of all the competitors that we have in the marketplace, Smith Abrasives has made the greatest effort to replicate the breadth of our sharpeners across those three major categories [electric, manual, and hybrid sharpeners].” Weiner Dep. at 90. Respondent has acknowledged that “In order to grow our business in the housewares’ channel, we would either have to grow the

¹⁸ PNOR, Ex. 9 (stipulations of the parties).

market or take share from Chef's Choice and any other competitors." Glidden DD 154:3-6 and 12-14; see also Glidden DD Exhibit 41 at SMITHS1621.

The parties have kept an eye on each other in recent years. After respondent's adoption of the EDGEWARE mark, petitioner's President encouraged employees to be alert to instances of confusion between the two companies' brands. Weiner Dep. at 66 and Exhibit 213. In 2008, respondent commissioned a formal competitive analysis of petitioner. Glidden DD 80:20-21 and Exhibits 28 and 32. In 2010, respondent prepared an in-house competitive evaluation of petitioner. Glidden DD 161:22-25 and Exhibit 43. Retailers were aware of the competitive posture of the two parties. When respondent vied for the opportunity to sell through an important mass market retailer (hereinafter, "MMR"), the retailer's buyer requested empirical evidence of the performance of respondent's products as against Chef's Choice products. Glidden DD 168:8-11 and Exhibit 44. To be clear, the record indicates that the competitive stance of the parties related to all segments of the market and all marks of the parties. Unless it is specified in the evidence, we do not assume that a competitive position between the parties involved the EDGEWARE mark in competition with the EDGE CRAFT mark, as both parties were making vigorous use of a number of other trademarks.

The competitive environment between the parties is illustrated by several salient incidents. In 2010, respondent persuaded GHR to carry some of respondent's products. In order to obtain this arrangement, respondent agreed to reduce GHR's inventory by "buying back" from GHR approximately 1200 Chef's

Cancellation Nos. 92052940; 92054092; 92054104

Choice Model CC120 electric sharpeners, thereby creating the retail space that respondent's goods would occupy. Adkison Dep. 13:10-14:11 and Exhibit 321. Respondent intended to resell the sharpeners of petitioner on a clearance basis and, after offering them to several retailers, did resell them to two online retailers. Adkison Dep. 15:15-16; Glidden DD 183-184. Petitioner appears to have viewed such competitive gains of respondent as detrimental to itself to some extent. Weiner Dep. 65:11-14. Moreover, as will be discussed later, certain instances of alleged actual confusion regarding the parties' marks involved GHR.

There is also evidence indicating that the parties competed directly for the opportunity to market their goods with the mass market retailer MMR, and that while one party held the account, the other was excluded from that retailer. Friel, Sr. DD 33:22-33:11 and Exhibit 107.

Finally, we note also that respondent's goods have been offered on the website (but not in the stores) of a certain middle-range housewares retailer (hereinafter "MRHR") that petitioner describes as one of its most important customers; and that respondent would like to make its goods available in that retailer's stores. Glidden DD 159:13-20; Weiner Dep. 11:11; 12:2-3; 13:17.

IV. Standing

Petitioner has made of record its pleaded U.S. registrations by filing copies of the registrations from the online database records of the Patent and Trademark Office. Petitioner has also presented evidence of its use of the trademark EDGECRAFT in connection with knife sharpeners and other household goods.

Petitioner has thereby shown that it is not a mere intermeddler and has established its standing to bring these proceedings. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

V. Priority

Because this is a cancellation proceeding, priority is in issue despite the fact that petitioner has made of record its pleaded registrations. *See Brewski Beer Co. v. Brewski Brothers, Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998). For purposes of establishing a date of first use of its trademark EDGEWARE, respondent may, under Section 7 of the Trademark Act, rely upon the filing dates of the applications underlying its involved registrations. 15 U.S.C. § 1057(c). The earliest such date, relating to Reg. No. 3617203, is March 12, 2008. Moreover, respondent has admitted that it had no rights in the mark EDGEWARE prior to that date.¹⁹

Petitioner, similarly, is entitled to rely upon the filing dates of the applications underlying its pleaded registrations, all of which predate March 12, 2008. *See* fn. 5 through 12, above. In particular, we note that petitioner's earliest registration of EDGE-CRAFT, relating to electric knife sharpeners, has an underlying application filing date of November 19, 1990; and petitioner's registration of EDGE-CRAFT relating to manual sharpeners has an underlying application date of January 31, 1997. Inasmuch as the filing dates underlying all of

¹⁹ Response to Petitioner's First Set of Requests for Admission, No. 26 (PNOR Exhibit 4.)

petitioner's pleaded registrations predate March 12, 2008, petitioner has established its priority.

VI. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion as set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In this case, the parties have presented evidence and arguments relevant to nearly all of the established *du Pont* factors.

A. Actual Confusion.

The centerpiece of petitioner's case is petitioner's contention that in the relatively brief time between the 2008 adoption of the EDGEWARE mark and the time of trial, a substantial amount of actual confusion occurred in the market. Respondent criticizes at length each alleged incident of confusion and argues that petitioner's evidence of alleged confusion consists largely of inadmissible hearsay.²⁰ We have reviewed petitioner's accounts of confusion with a critical eye, not only with respect to the problem of hearsay but also as to the witnesses' competence to testify regarding the incidents and as to the degree of detail with which the

²⁰ Respondent's brief at 39-52.

incidents are described; and we have carefully considered respondent's criticisms of the accounts.²¹

We find the evidence of the following incidents to be lacking in sufficient detail to be probative of actual confusion:

- (i) The inquiry by a website editor as to whether petitioner was now owned by respondent. Gleason Dep. at 12 and Exhibit 216.
- (ii) Telephone inquiry by a producer/coordinator of a television show, based upon written contact instructions that referred to both petitioner and respondent. Weiner DD at 187.
- (iii) Account of woman who entered petitioner's booth at trade show, "asked to look at some Edge...", stopping in mid-sentence. Kilyk Dep. at 18.
- (iv) Statement made at a trade show by Canadian customers that they had purchased from petitioner a product that petitioner does not make. Liddle Dep. at 11; *see also* DaRin DD 99-104.
- (v) Inquiry on respondent's blog <edgeexpert.com> regarding the "smith electric 120." PNOR, Exhibit 4 (Respondent's response to second set of requests for admission, Exhibit H).
- (vi) Inquiry to respondent from online retailer regarding "new opportunity for... Chef's Choice." PNOR, Exhibit 7G at SMITHS3209-3210.

We also find that the following incidents do not demonstrate actual confusion, but rather perspicacious awareness that respondent and petitioner's brands are different:

- (vii) Reported comments from third parties that new EDGEWARE packaging was similar to packaging of petitioner. Liddle Dep. at 17-18.
- (viii) Comments of a buyer and a sales representative of petitioner to the effect that it was not appropriate of respondent to use the

²¹ Although we have found many of the incidents adduced by petitioner not to be probative of actual confusion, in some instances we have deemed the incidents relevant to the *du Pont* factors of trade channels and renown of the senior mark, as discussed later in this decision.

EDGEWARE name because of its similarity to EDGE CRAFT. Kilyk Dep. at 11, 29, 35 and Exhibit 218.

The following incidents do not demonstrate actual confusion; rather, they appear to be mere slips of the tongue by persons who were fully aware of the distinction between the parties' brands:

- (ix) E-mail message from potential distributor of petitioner indicating that he was "looking forward to getting started selling the Edgeware products." PNOR Exhibit 6E at EDGE2372.
- (x) E-mail to respondent from marketing consultant eager to "secure the business under Edgecraft." PNOR Exhibit 7C at SMITHS1538.
- (xi) Purchase order sent to respondent, with address of petitioner and other inconsistent entries. Glidden Dep. at 51-52, Exhibit 317.
- (xii) E-mail from Russian distributor of respondent erroneously referring to Edgecraft. *Id.* at Exhibit 318.
- (xiii) E-mail from military customer of respondent referring to listing of vendor code under Edgecraft. Adkison Dep. at 12 and Exhibit 320.
- (xiv) Communications mistakenly sent to petitioner from GHR relating to return to petitioner of CHEF'S CHOICE model 120 sharpeners that should instead be returned to respondent, which had agreed to accept such goods as a "return to vendor." Weiner Dep. at 71, 85-89 and Exhibit 214.

There are, however, several incidents recounted in the record that we find to be probative, to varying degrees, of actual confusion in the marketplace. They are discussed below.

1. Acting Assistant Manager for GHR.

Testimony was given by a former Acting Assistant Manager GHR, a gourmet retailer that is a customer of both petitioner and respondent, and which petitioner refers to as one of its most important accounts and as a store that lends prestige to

the goods offered in it. The witness was stationed in a store in Pennsylvania. She had previously held the post of Coordinator, in which her duties were “inventory, primarily.” Bray Dep. 11:8-9. She described her role in arranging product demonstration events referred to as “marketplace” events:

Marketplace was to allow the vendors to come into the store and demonstrate their products and talk about their products, not just to associates, but then it was also open to the public when the store was open.

Bray Dep. 12:12-16.

My role was contacting all of the vendors to have them come in, to see who could make it, setting up the stations once we knew who was coming in, asking, what did they need from us, and then basically making sure that everybody had what they needed once they were there.

Bray Dep. 13:3-9.

She described an incident in which petitioner participated in the marketplace demonstration:

I remember setting up the station, and then the EdgeCraft representative approached me saying, this is not EdgeCraft. She could not demonstrate it. And it was taken away.

Q. When you say “it,” what do you mean?

A. The other brand of knife sharpener, Edgeware specifically.

Q. Why did you set up the demonstration with Edgeware for the EdgeCraft representative?

A. I was not aware that Edgeware was not Edgecraft. I saw “Edge” and pulled all of the various knife sharpeners that had that name, thinking that it was part of it.

Q. When you say “thinking it was part of it,” what do you mean?

A. I assumed Edgeware was part of EdgeCraft. It was the same type of knife, the same company made it.

Q. Why did you assume it was the same company?

A. The name “Edge.”

...

EdgeCraft – there aren’t that many knife sharpeners out there, and EdgeCraft is what we had carried. And when I saw Edgeware, I assumed Edgeware was part of EdgeCraft.

...

EdgeCraft had been in the store first, and then Edgeware came out, and lack of knowledge, if you will, just thought it was part of the same company.

Bray Dep. 14:21-16:12

The representative of petitioner at the marketplace demonstration was Mary Katherine DaRin. In testimony, she identified an e-mail that she addressed to Sam Weiner regarding the incident, which stated:

Sunday, November 7, 2010 I participated in a vendor day at the Lancaster, Pennsylvania [GHR]. ... Chef’sChoice was the only knife sharpener represented at this vendor event. ...

When I arrived at my station the Store Manager had my area set up with our 1520 and the Edgeware Ceramic Edge Gourmet Sharpener. I questioned her and asked if Smith was going to be participating in this event. She had a puzzled look. The Store Manager believed that Edgeware was an EdgeCraft product and thought it was a new sharpener in our line. As the associates circled through they asked questions about the new Edgeware sharpener thinking that it was an addition to our line. ...

... Once the difference in manufactures was pointed out to the Store Manager she was apologetic and removed the

Edgeware model from my demo area. Smith did not send a representative to this event.

DaRin DD, Ex. 116.²²

Respondent argues that Ms. Bray “was fairly new to the job and was not knowledgeable about the products at issue,” and points to Ms. Bray’s excuse that her error was due to “lack of knowledge.”²³ Even assuming that Ms. Bray had insufficient information about the products at issue, her account would nonetheless be probative, because typical consumers have even less knowledge about specific products. In any event, the evidence suggests that Ms. Bray had substantially more familiarity with the field of goods at issue than most people in the marketplace. That she was actually confused suggests strongly that consumers, who have less information than she, are likely be confused. *Morningside Group Ltd. V. Morningside Capital Group, L.L.C.*, 182 F.3d 133, 51 USPQ2d 1183 (2d Cir. 1999).

2. The United Kingdom distributors.

The Buying Director of petitioner’s exclusive United Kingdom distributor (“UKDA”) testified that in March, 2010 he attended the International Home and Housewares Show in Chicago, a trade show of prime importance at which both petitioner and respondent had booths in different halls of the convention area. He arranged to have coffee with a buyer for a competing United Kingdom distributor that operates in the field of kitchen and home products. He testified as follows:

²² We consider Ms. DaRin’s account for the objective information it contains. We give no weight to her perceptions of the Store Manager’s state of mind or what the Store Manager “believed” about the products.

²³ Respondent’s brief at 41.

[W]hen I met her,... she actually asked me why [UDKA] were distributing this brand in the U.K. and also a U.K. company called [UKDB]²⁴ were distributing the same brand.

Rae Dep. 12:12-17.

And she also questioned why they had two different stands in two different halls because they looked very similar.

Rae Dep. 14:3-5

She actually said to me when I met her for a coffee that she couldn't understand why the two companies in the U.K., that being [UKDA] and [UKDB], were distributing the same brand, that being Edgecraft. But then I explained to her that it wasn't the same brand, there was actually another company called Edgeware who did similar products, that being knife sharpeners, as those to Edgecraft.

Q. Do both [UKDA] and [UKDB] distribute Edgecraft products in the U.K.?

A. No.

Q. Who does distribute Edgecraft products in the U.K.?

A. Edgecraft is from [UKDA]. Edgeware is from [UKDB].

Rae Dep. 14:19-15:8. *See also* Exhibit 223 (an e-mail account of the same incident, directed to Sam Weiner: "The buyer asked me why both [UKDA] and [UKDB], were distributing Chefs Choice/Edgecraft products in the UK.").

Mr. Rae was competent to testify as to what happened to him and the questions that were asked of him by the second buyer ("declarant"). The declarant's

²⁴ "UKDB" is, according to this account, a United Kingdom distributor that distributes EDGEWARE products. Rae Dep. 15:7-8.

questions are not in evidence for the purpose of proving the truth of any matter asserted, but merely to demonstrate that they were asked. *See Programmed Tax Systems, Inc. v. Raytheon Co.*, 439 F. Supp. 1128, 197 USPQ 509 (S.D.N.Y. 1997); *Fun-Damental Too, Ltd. V. Gemmy Industries Corp.*, 111 F.3d 993, 42 USPQ2d 1348 (2d Cir. 1997). It is clear, from the nature of the declarant's questions that she perceived, mistakenly, that there were two distributors handling petitioner's goods in the United Kingdom.

The fact that Mr. Rae and the declarant distribute goods in a foreign country does not reduce the probative value of this account, as respondent contends.²⁵ Mr. Rae was a customer of petitioner and his traffic in goods of petitioner was in international commerce involving the United States, a form of commerce that is regulable under the Trademark Act. Similarly, the declarant was a businessperson who was engaged in commerce between the United States and the United Kingdom. Moreover, she was engaged in a field of business in which she may have had an interest in becoming a customer of petitioner.

3. Resale of Chef's Choice goods to online retailer.

As explained above in Part III, in 2010 respondent "bought back" from GHR approximately 1200 Chef's Choice Model CC120 electric sharpeners in order to persuade GHR to carry some of respondent's goods. Adkison Dep. 13:10-14:11 and Exhibit 321. In the process of finding a buyer for the Chef's Choice sharpeners bought back from GHR, respondent prepared a quotation document on which the

²⁵ Respondent's brief at 41-42.

Chef's Choice model CC120 was pictured and described along with six other sharpening products of respondent. Glidden DD 125:4-5; 127:6-9 and Exhibit 36. The EDGEWARE trademark appears prominently twice in logo form at the top of the page. The quotation document was apparently used in offering the bought-back merchandise to various retailers. Glidden DD 128:10-21. Ultimately, one of the companies to whom the goods were sold displayed the product on its website in a surprising format. On a web page dedicated to products of "Smith's" with an 8-line description of the Smith's company, five products are presented in thumbnail presentation. The Model CC120 is the first item, and it is identified as "Smith's Chef's Choice 120 Professional Knife Sharpener." PNOR Exhibit 6A at EDGE0011-0013. An associated web page dedicated to this single product depicts the product in larger format, again identifying it as "Smith's Chef's Choice 120 Professional Knife Sharpener." *Id.* The name "Smith's" appears above the photograph of the product. The product description text begins, "From your pocket knives and hunting blades to gourmet chef's knives and even serrated kitchen knives, Smith's Chef's Choice 120 three-stage professional sharpener renews any blade's razor-sharp edge without destroying the temper." *Id.*

Respondent argues that the online retailer's mistaken description of the petitioner's product "is not an example of confusion between Edgeware and Edgecraft"; that petitioner's product was branded CHEF'S CHOICE and that "Edgecraft Corporation' is only referred to on the bottom of the packaging"; and that "Smith's has never sold any EDGEWARE products to [the online retailer], so

there is no reason to think that anyone confused Edgeware with Edgecraft.” (Respondent’s brief at 46; *see* Glidden Dep. at 50.) The evidence indicates that the Model CC120 package bears only an inconspicuous reference to EdgeCraft Corp. on the back of the box. RNOR Exhibit E-09 at EDGE0001071. However, the instruction manual for the Model CC120 bears prominent trademark presentation of EDGE-CRAFT as a trademark. RNOR Exhibit E-07 at EDGE0001070.

Also relevant to this incident is an exchange of e-mails between petitioner’s employee Michael Cunningham and Customer Service of the online retailer. Mr. Cunningham’s message states, in part:

I noticed that on your website, that you are selling a product with a description that includes two different brand names into one. Both Chef’sChoice and Smith’s. I called your customer service department to determine what the product actually was and they confirmed that it was from Smith’s Abrasives, not Chef’sChoice, which is made by the EdgeCraft Corporation. Your offering also show’s an image of the Chef’sChoice product.

[URL omitted.]

In the interest of your customers receiving what they actually think they are getting, could I ask you to correct the copy and image to reflect a Smith’s electric knife sharpener....?

RNOR Exhibit E-06 at EDGE0001716.

The response from the online retailer’s Customer Service states, in part:

The vendor who we received the Chef’s Choice 120 Diamond Hone 3 state professional knife sharpener, Item 3587R, may be manufactured by Smith’s Abrasives.

We have entered an inquiry to the product specialist to see who the manufacturer is....

Id. at EDGE0001715.²⁶

The pieces of this puzzle fit together only imperfectly. As a result, as respondent notes, the evidence does not clearly demonstrate that a mistake was caused by the similarity of the mark EDGEWARE to the mark EDGECRAFT. Nonetheless, this incident shows a series of very troubling mistakes. Respondent's inclusion of the CHEF'S CHOICE model 120 on the quotation sheet, under the bold trademark EDGEWARE and commingled with products of respondent, results in the uncomfortable blending of the good will of respondent with the good will of petitioner. Similarly, the online retailer's advertisement of a "Smith's Chef's Choice 120 Professional Knife Sharpener" blends the good will of respondent with the good will of petitioner. The product in question, a model 120, bears the mark EDGECRAFT at least as a sub-brand, even though that mark is not apparent in the photographs on the quotation sheet and the online advertisement. In the case of the quotation sheet, that marked product was clearly associated with – and one could say, marketed under – the trademark EDGEWARE. The message of the online retailer to Mr. Cunningham clearly demonstrates that, as of that time, the problem at issue had not yet been resolved, as the online retailer wrongly suggests that the item "may be manufactured by Smith's Abrasives." If this incident does not undeniably illustrate confusion as between the EDGECRAFT and EDGEWARE

²⁶ We consider this exchange of emails without regard to the truth or falsity of any matter asserted in them. In particular, we give no credence to Mr. Cunningham's statement that "I called your customer service department to determine what the product actually was and they confirmed that it was from Smith's Abrasives, not Chef'sChoice"; or to any suggestion in the responsive message that the vendor may have stated that the product "may be manufactured by Smith's Abrasives." Rather, we consider the fact that the exchange took place and the fact that error as to source is apparent on the face of the communications.

marks, the collection of circumstances underlying it are a near-perfect recipe for likely confusion.

Considering all of the evidence of record on this point, we find the factor of actual confusion in the marketplace weighs in favor of a finding of likelihood of confusion.

B. The parties' goods.

We next consider the similarity or dissimilarity of the goods at issue. The three involved registrations cover different sets of goods. Each registration must be considered separately because, even though the three cancellation proceedings have been consolidated, each proceeding maintains its own character and we decide each one on its own merits. TBMP § 511.

1. Respondent's Reg. No. 3617203.

The goods identified in respondent's Reg. No. 3617203 are essentially identical to the goods collectively identified in petitioner's Reg. Nos. 1678267 (for the mark EDGE CRAFT) and 2810653 (for the mark EDGE CRAFT WORLD LEADER IN CUTTING EDGE TECHNOLOGY). The registrations of both parties cover electric knife sharpeners, hand-operated knife sharpeners, and electric sharpeners for scissors. A number of respondent's goods are identified broadly, such that they include within their scope petitioner's electric and hand-operated knife sharpeners, to wit: "power operated sharpeners; ... hand-operated sharpening tools and instruments; ... manually operated sharpeners." Respondent's "sharpening rods; sharpening stones; whetstones" are types of "hand operated sharpeners for

knives and other cutting tools,” as identified among petitioner’s goods. We note that in the petition against respondent’s Reg. No. 3617203, petitioner did not plead ownership of any registration for the mark **EDGECRAFT** alone (without accompanying slogan) that covers manual sharpeners or electric scissors sharpeners. However, there is testimony that petitioner produces such goods and there is evidence of the use of the **EDGECRAFT** mark on such goods. Weiner Dep. 10:16-21 and Exhibit 202 at EDGE0001072 and EDGE0001074. In light of all of these facts, the *du Pont* factor relating to the similarity of the goods favors a finding of likelihood of confusion with respect to respondent’s Reg. No. 3617203.

2. Respondent’s Reg. No. 3951563.

The goods identified in Reg. No. 3951563 are “hand operated kitchen tools, namely, graters.” None of petitioner’s pleaded registrations includes graters within its scope, and the evidence indicates that graters are not among the goods offered by petitioner. Petitioner’s President described petitioner’s range of products under the **EDGECRAFT** mark as follows:

We sell electric sharpeners, manual sharpeners, hybrid-type sharpeners. We sell slicers, electric food slicers, electric kettles, electric waffle makers, electric egg cookers, grinders, meat grinders, and other miscellaneous products, including knives and some hardware tools, such as files.

Weiner Dep. 10:5-11.

The question before us is therefore whether the goods of petitioner with respect to which it has priority of use of its **EDGECRAFT** mark are related in some manner or are marketed in such a way that they would or could be encountered by

the same relevant customers under circumstances that could, because of similarities of the marks used on them, give rise to the mistaken belief that they originate from or are in some way associated with the same producer. *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010); *Schering Corporation v. Alza Corporation*, 207 USPQ 504, 507 (TTAB 1980); *Oxford Pendaflex Corporation v. Anixter Bros. Inc.*, 201 USPQ 851, 854 (TTAB 1978).

Petitioner argues that its products are closely related to graters; that “as a manufacturer of household appliances, Edgecraft is constantly considering broadening its offerings into other products”; that graters “are clearly within Edgecraft’s zone of natural expansion”; and that “small household appliances such as sharpeners, graters, ... travel through, at least, overlapping trade channels and to, at least, overlapping consumers”²⁷ Petitioner’s President testified that graters are sold:

... in the same type of market segments that we operate in, in gourmet stores, department stores, Internet accounts, mail order catalogs that cater to people that are interested in cooking.

Weiner Dep. 16:10-14.

Again, it’s considered a food preparation item, and its generally used to reduce a big piece of food into small pieces. And that can be done many different ways. It could be done by chopping either with a chopper or with a knife. It could be done with a grater, as Smith Abrasives and other companies sell, or it could be done by means of diamond files, for example, or a meat grinder.

Id., pp. 17-18.

²⁷ Petitioner’s brief at 17.

Petitioner also points to Glidden DD Exhibit 316, which shows a 2011 catalog of respondent on the cover of which a grater is depicted alongside a manual knife sharpener and an electric knife sharpener and within which graters are characterized as “kitchen tools,” together with text that states, “Edgeware’s strategic expansion into food preparation kitchen tools is *a natural progression* offering next-generation solutions to professional chefs and home cooks alike.” Glidden DD, Exhibit 316 at SMITHS 91-92 (emphasis supplied). Finally, petitioner notes that the parties have stipulated, “The parties agree they have at least some of the same classes of consumers in common,” and “The parties agree they have at least some of the same trade channels in common.”²⁸

Respondent argues, “That both companies sell knife sharpeners is of little import where, as here, the products are not marketed in a way that suggests they come from the same source.”²⁹ Respondent points out that petitioner does not sell graters “and has no plans to do so,” which is confirmed by petitioner’s President:

Q. You also mentioned graters earlier. Has EdgeCraft Corporation ever done any research on offering a grater?

A. We have done research on graters. Have been approached by companies that were in the grater business that talked to us about the possibility of introducing graters on – under the EdgeCraft umbrella.

Again, based on the priorities that we had in our business, we chose at that point not to pursue the grater

²⁸ PNOR, Ex. 9 (stipulations of the parties). Despite petitioner’s urging, we do not read these stipulations as an outright admission that graters travel through the same channels of trade as petitioner’s goods, or are purchased by the same classes of consumers.

²⁹ Respondent’s brief at 22.

business. But it is one that is open for later consideration.

Q. Do you have any definite plans right now to offer graters in the future?

...
[objection to form omitted]

A. We do not have any specific plans right now to introduce graters into the market.

Weiner Dep. 93:21-94:19. See also Weiner DD 29:13.

Graters may fairly be characterized as “kitchen tools”; as such they are similar, in a general way, to the kitchen knives identified in petitioner’s Reg. No. 2810653 as well the electric food slicers, electric kettles, electric waffle makers, electric egg cookers, and meat grinders identified by Mr. Weiner as products offered by petitioner under the EDGECRAFT mark. Even though petitioner may have decided not to expand its line of goods to include graters, customers for petitioner’s goods would likely believe that a grater offered under an identical or highly similar mark emanates from petitioner. Accordingly, with respect to respondent’s Reg. No. 3951563, the *du Pont* factor relating to the similarity of the goods favors a finding of likelihood of confusion.

3. Respondent’s Reg. No. 3881712.

The goods identified in Reg. No. 3881712 are “hand operated kitchen tools, namely, slicers, choppers and mandolins for cutting food.”³⁰ None of petitioner’s pleaded registrations includes slicers, choppers or mandolines within its scope. However, petitioner’s Reg. No. 2810653 for the mark EDGECRAFT WORLD

³⁰ The words “mandolin” and “mandoline” appear to be used interchangeably. We will use “mandoline.”

LEADER IN CUTTING EDGE TECHNOLOGY covers “manually operated knives, namely, kitchen ... knives.” The evidence also indicates that petitioner sells “electric food slicers” under the EDGECRAFT mark. Weiner Dep. 10:7. A depiction of packaging in which petitioner offered a food slicer under the EDGECRAFT mark as of the time of trial is of record. Weiner Dep. 38:8-10 and Ex. 202, EDGE1090.

Petitioner contends that choppers and mandolines are closely related to petitioner’s range of goods. Petitioner’s president testified as follows:

We’re constantly looking at ways of broadening our business. We’ve looked at many products, including some that Smith Abrasives is currently selling. For example, a mandoline, since we were in the, in the electric slicer business, the function of an electric food slicer is very similar to a mandoline. So we had researched that market. We had developed some prototypes internally. But, up until this point, we have not pursued that business.

Q. Based on your experience, where are mandolines typically sold?

A. Mandolines are typically sold in the same market segment that our other products are sold. They’re primarily in the housewares and gourmet market segment, on the Internet and any type of store that caters to people interested in cooking.

Q. Where are choppers typically sold?

A. Similar market segments that I previously described. Also in cook stores, gourmet stores, department stores, the Internet, generally retailers that cater to cooking enthusiasts.

Weiner Dep. 15:6-16:7.

The fact that goods such as choppers and mandolines are sold through channels of the types described by Mr. Weiner is confirmed by respondent's President. *See* Glidden Dep. 12:3-7.

Respondent points out that petitioner does not sell mandolines or choppers and has no plans to do so. *See* Weiner Dep. 92:5-93:20. In particular, petitioner's President testified under cross-examination as follows:

Through the process of research and development and evaluating products, there's always competition amongst those products, in our opinion, which one is most compelling for us to tackle, because we don't have unlimited resources. So the choices did not necessarily preclude mandolines, but we felt there were better opportunities for us to redirect our attention to other products.

...

We have not established specific plans for introducing a mandoline in the future, but it's always been on our radar screen that it's a very compatible product with our electric slicer business.

...

We have looked at that product line [choppers] and, again, we chose to pursue products that accomplished the same food prep type of work in different ways. Grinders, for example, in many ways accomplish the same thing that a chopper would. Knives will also accomplish the same thing in a different format.

Weiner Dep. 92:12-93:15.

Respondent's slicers, choppers and mandolines are identified as "kitchen tools" in respondent's registration and in this regard they are similar, in a general way, to petitioner's core products (knife sharpeners) as well as petitioner's other goods. The kitchen knives identified in petitioner's pleaded Reg. No. 2810653 are similar in purpose to respondent's slicers, choppers and mandolines. Both parties

appear to focus on marketing such goods through housewares and gourmet channels. The fact that petitioner has produced and marketed an electric food slicer and has considered expanding its line of goods to include choppers and mandolines suggests that consumers would readily believe that choppers and mandolines might emanate from petitioner. We find that, with respect to respondent's Reg. No. 3881712, the *du Pont* factor relating to the similarity of the goods favors a finding of likelihood of confusion.

C. The parties' trade channels.

We turn next to consider the parties' established and likely-to-continue trade channels. By stipulation, the parties have agreed that "they have at least some of the same channels of trade in common" and that "they advertise through at least some of the same media." (Stipulation of September 30, 2011, RNOR Ex. G-02.) Moreover, to the extent that the parties' goods are identical (*i.e.*, electric knife sharpeners and hand-operated knife sharpeners), we must presume that the parties' goods move through the same channels of trade. *See American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994); *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

Respondent testified that it sells its EDGEWARE branded products in "what we call the Gourmet Housewares Channel, that would include retailers from [MRHR], [three other retailers omitted],³¹ and then up to [GHR]."³² Respondent sells

³¹ The record does not contain sufficient information about the three omitted retailers to allow us to characterize them.

directly to retailers; through independent sales representatives; and to distributors in the United States and abroad.³³ There is also evidence that respondent sells its goods to Amazon.com for marketing on the internet. Glidden Dep. 29:14 and Exhibit 307.

Petitioner, similarly, states that it sells its product to retailers in the “gourmet market” segment, and describes GHR as one of its most important accounts and MRHR as its biggest customer. Weiner Dep. 11:11; 12:2-3; 13:17. Petitioner also sells to internet retailers, including Amazon, and exports its products to approximately 70 countries. *Id.* 11:18-23. Unlike respondent, petitioner also markets its goods to “sports market” retailers and to “hardware market” retailers. *Id.* 11:13-17.³⁴ (Respondent sells to the sports and hardware markets, but under marks other than EDGEWARE.)

The parties also market their respective goods at some of the same trade shows. Respondent displays EDGEWARE products at the International Home and Housewares Show (Chicago); Atlanta International Gift and Home Furnishings Market, Ace Hardware Show, TruServ Hardware Show, and the Gourmet Housewares Show (San Francisco). Glidden Dep. 22:24-23:2 and Exhibit 303. The record indicates that petitioner’s personnel attend the same shows. Kilyk Dep. 15:16-23; Gleason Dep. 9:2-8; Liddle Dep. 7:25-8:2. We note that the mistake

³² Glidden Dep. 12:3-7.

³³ *Id.*, 11:11-14.

³⁴ While respondent contends that its EDGEWARE branded goods are not sold into the sports and hardware markets, the record is clear that respondent sells similar goods under different brands into those markets.

recounted in the Rae Deposition related, in part, to the fact that both petitioner and respondent had booths at the same trade show.

The record also indicates that both parties have advertised their products in the publications *Kitchenware News*, *HomeWorld*, *Fine Cooking*, and *Housewares Executive*. Glidden Dep. 20:3-10 and Exhibit 302; Glidden DD at 67; Weiner Dep. at 19; PNOR Ex. 2F at EDGE326-8.

Respondent argues that, in an important respect, the trade channels of the parties are not the same. Respondent maintains that its EDGEWARE products are offered exclusively in the gourmet housewares trade channel, while petitioner's EDGECRAFT line of goods is "generally found in sporting goods stores."³⁵ Respondent argues that the products offered by petitioner in the housewares channel are actually branded CHEF'S CHOICE and are not branded EDGECRAFT; that only 10% of petitioner's products have the mark EDGECRAFT prominently displayed on the packaging (citing Weiner Dep. at 236);³⁶ and that respondent's personnel had no knowledge of the existence of EDGECRAFT branded goods in the housewares channel (citing Glidden Dep. at 35 and Adkison DD at 85-86).

The record is replete with evidence showing the importance of the CHEF'S CHOICE mark to petitioner. Respondent implies that the CHEF'S CHOICE brand is, in the housewares market, greatly more important to petitioner than the EDGECRAFT brand. We need not make a finding as to that point because, even if CHEF'S CHOICE were the primary brand on all of petitioner's products in the

³⁵ Respondent's brief at 52.

³⁶ *Id.* at 13.

housewares market, the evidence indicates that the trademark EDGECRAFT usually appears on the CHEF'S CHOICE package, albeit in a subsidiary role. Respondent's suggestion that EDGECRAFT is relegated to use as a trade name, not a trademark, in the housewares channel is not supported by the record, although there are examples of packages and promotional materials on which EDGECRAFT does appear to be merely a trade name. Nonetheless, petitioner has submitted numerous samples of packaging artwork for CHEF'S CHOICE products which were in use on packages at the time of trial, showing the designation EDGECRAFT displayed in the manner of a trademark, rather than a trade name. Weiner Dep. 38:6-19 and Exhibit 202. These examples include packaging for the CHEF'S CHOICE Diamond Hone Sharpener, which displays, on the panel opposite the front face of the box, the designation EDGECRAFT in distinctive lettering that is larger than all other lettering on the panel (EDGE1073); similar displays on the CHEF'S CHOICE manual knife sharpener, models 450, 440 and 430 (EDGE1074-1076); and the CHEF'S CHOICE EdgeCrafter diamond sharpening steel, sharpening stone, and diamond rod sharpener, on the backs of which EDGECRAFT is presented in distinctive lettering larger than all text other than the primary trademarks (EDGE1079-1084). Accordingly, the EDGECRAFT mark is found in the housewares market by virtue of its display on the packaging of goods that are marketed under the primary trademark CHEF'S CHOICE.

Going beyond this, petitioner has submitted evidence that it has marketed some of its products in housewares channels in a manner such that it is clear that

EDGECRAFT is the primary trademark. Weiner Dep. 39:5-40:16 and Exhibit 203. Exhibit 203 includes depictions of the EDGECRAFT Hybrid 21 knife sharpener, EDGECRAFT models 10, 30, 35 and 42 knife sharpeners, and EDGECRAFT model 609E food slicer. Petitioner's president testified that the Model 35 has been marketed in the housewares section of a certain mass market retailer; the model 30 and model 10 in a certain club store; and the model 10 in the housewares section of another club store. Weiner Dep. 39-12-40:16.

On the present record, there is no doubt that the CHEF'S CHOICE brand was present in the housewares channels of interest to respondent. Respondent's President referred to CHEF'S CHOICE as the "primary brand" of knife sharpeners in the housewares channel (Glidden Dep. 34:11-12), and made of record photographs showing displays of CHEF'S CHOICE products in stores including GHR and another gourmet housewares retailer, MRHR, MMR and two other kitchen goods retailers. Glidden Dep. 36-41 and Exhibits 309 and 310. In several of these photographs, the CHEF'S CHOICE product is displayed in close proximity to an EDGEWARE product. Glidden Dep. Exhibit 309 at SMITHS982-983 and Exhibit 310 at SMITHS5208, 5214 and 5216 (GHR displays).

Since petitioner regularly displayed the EDGECRAFT mark, as a trademark, on its CHEF'S CHOICE products, the EDGECRAFT mark was present in the housewares market. Accordingly, even if respondent's EDGEWARE products were present in the housewares channel and nowhere else, it would be sharing that channel with the EDGECRAFT mark.

We note, as relevant to the factor of trade channels, evidence of incidents demonstrating that certain persons in the trade were familiar with both petitioner and respondent, and with their respective EDGECRAFT and EDGEWARE marks. We note in particular an inquiry from a website editor as to whether petitioner was owned by respondent (Gleason Dep. at 12 and Exhibit 216); an inquiry by a producer/coordinator of a television show (Weiner DD at 187); reported comments from third parties that new EDGEWARE packaging was similar to packaging of petitioner (Liddle Dep. at 17-18); comments of a customer of petitioner to the effect that it was not appropriate of respondent to use the EDGEWARE name because of its similarity to EDGECRAFT. Kilyk Dep. at 11, 29, 35 and Exhibit 218. Such evidence gives deeper significance to the similarity between the trade channels of the parties, as it shows that the marks of both parties were, in many cases, successfully reaching the same people and making an impression on them.

Considering all of the foregoing, the *du Pont* factor relating to established trade channels weighs in favor of a finding of likelihood of confusion.

D. Customers and Conditions of Sale.

Both parties clearly intend that their marked products will ultimately reach the types of consumers that shop in housewares stores, the housewares departments of stores, and stores that offer gourmet kitchen goods.³⁷ Such consumers would encounter the parties' goods not only in the retail store environment, but also in the context of online retailers. There is no substantial

³⁷ Respondent's brief at 38; petitioner's brief at 11-12.

evidence to indicate that such consumers have an elevated degree of sophistication. However, respondent argues that consumers for the parties' goods exercise extra care because the goods are expensive.³⁸ This contention is not borne out by the evidence because some of the parties' goods are relatively simple in nature and inexpensive (*e.g.*, a rod sharpener). Some of petitioner's goods are priced under \$20. Weiner DD at 52. Some of respondent's goods are priced under \$10. Glidden DD at 49. While some of the parties' other goods are quite expensive (*e.g.*, higher-end electric sharpeners), there is the potential for impulse purchasing of the goods of either party.

Both parties also consider their customers to include professional distributors and buyers for retail establishments. Respondent correctly points out that such buyers are sophisticated by virtue of their understanding of the marketplace and their professional interest in the specific field of housewares. While we do not assume that any type of customer is immune to trademark confusion, such professional customers would ordinarily be more resistant to confusion than typical consumers. *See Morningside Group Ltd. V. Morningside Capital Group, L.L.C.*, 182 F.3d 133, 51 USPQ2d 1183 (2d Cir. 1999).

Petitioner also markets its goods to dealers who in turn sell to commercial customers, such as restaurants, hotels, and caterers. Weiner Dep. 18:5-12. Respondent apparently does not intentionally target commercial customers for its

³⁸ Respondent's brief at 37.

EDGEWARE products. Accordingly, for purposes of our analysis this customer base is not significant.

Because of the wide range of customer types and marketing environments, we consider this *du Pont* factor to be neutral.

E. Renown of the senior mark.

Petitioner contends that it is “the leading branded company in the knife sharpener marketplace,” and the record shows that its sales and advertising expenditures are very substantial.³⁹ Although petitioner has submitted voluminous evidence relating to recognition of its mark in the marketplace, such evidence is not of a type or quality as to allow us to find that the strength of the reputation of the mark would have a perceptible impact on the likelihood of confusion.

We do, however, note evidence of several specific incidents in which individuals doing business with respondent (business which apparently had nothing to do with petitioner) accidentally interjected references to the designation EDGECRAFT into their communications. This type of slip of the tongue at least illustrates an awareness of petitioner among persons in the relevant trade. (As we discuss later, we do *not* consider such slips of the tongue to be evidence of trademark confusion.) In particular, we note such communications involving a marketing consultant to respondent (PNOR Exhibit 7C at SMITHS1538); a customer issuing a purchase order to respondent (Glidden Dep. at 51-52, Exhibit 317); a Russian distributor of respondent (*Id.* at Exhibit 318); and a military

³⁹ Petitioner’s brief at 8.

customer of respondent (Adkison Dep. at 12 and Exhibit 320). Such evidence suggests that among the most relevant segment of the market (*i.e.*, customers of respondent and those doing business with respondent), petitioner's mark is known and readily comes to mind. For this reason, we find that the *du Pont* factor relating to the marketplace strength of the senior mark weighs in favor of a finding of likelihood of confusion.

F. Similar marks in the marketplace.

Respondent argues that there is a multitude of third-party marks that include the designation EDGE in use in the sharpener/kitchen tools industry; and that accordingly the designation EDGE "should not be accorded significant weight in the likelihood of confusion analysis."⁴⁰ Respondent has shown that trademarks incorporating the following designations have been registered and are in actual use in the United States in connection with sharpening devices:⁴¹

EDGEMAKER
EDGEMASTER
EDGE WORLD
EDGE PRO
EDGE MATE
EDGE KING
EDGE-VISION
THE ULTIMATE EDGE
ADVANT-EDGE
DURA-EDGE
REDI-EDGE
WICKED EDGE

⁴⁰ Respondent's brief at 17.

⁴¹ RNOR Exhibit A-2; Depositions of Rapp, Shen, Axelrod, Holmquist, and O'Dougherty; Affidavits of Dale, Anthon, Jurey, Taylor, Sander and Allison.

Among these third-party marks, we give reduced weight to the marks EDGE KING, which is used on a sharpener marketed to the meat processing industry (Rapp Dep. at 11); and EDGE-VISION, which is used on a component of a sharpener for use on woodworking tools (O'Dougherty Dep. at 16). Neither of these marks is likely to have an impact on the housewares market, which is, according to respondent, the only segment of the market to which it directs its EDGEWARE mark. The remaining marks illustrate, to varying degrees, that there is a weakness of source-indicating power inherent in the designation EDGE in the field of sharpening devices. A proliferation in the relevant market of trademarks that include the designation EDGE may have the effect of conditioning customers to distinguish between such trademarks on the basis of other distinguishing elements. We do bear in mind, however, that marks such as THE ULTIMATE EDGE, ADVANT-EDGE, DURA EDGE, REDI-EDGE, AND WICKED EDGE, in which the component EDGE is not positioned as the initial element of the mark, are substantially different from the marks EDGECRAFT and EDGEWARE. We also bear in mind that revenues attributed to several of the third-party marks (notably, EDGE KING, EDGE WORLD and EDGEMASTER) are extremely small;⁴² such low volume of use in the marketplace would, of course, reduce the diluting impact of such marks on the source-indicating strength of petitioner's mark. We also give due consideration to the diluting effect of respondent's use, beginning in 2006, of EDGE marks including THE EDGE EXPERTS, EDGESPORT, EDGEWORK, DIAMOND

⁴² See Rapp Dep. at 11; Shen Dep. at 31-32; Holmquist Dep. at 36-37.

EDGE GOURMET, CERAMIC EDGE GOURMET, EDGE GRIP, and KNOWLEDGE. Glidden Dep. at 9-10, 24-25; RNOR Ex. A-1.

Finally, we note that the term EDGE is highly suggestive in the context of sharpening implements, inasmuch as it describes an ultimate purpose of the goods, *i.e.*, to improve the cutting edge of a knife or other cutting tool. This suggestiveness is the likely cause of the proliferation of EDGE- formative marks in the marketplace.

Overall, the number of similar marks in the marketplace weighs against a finding of likelihood of confusion.

G. The Similarity or Dissimilarity of the Marks.

We next consider whether the marks at issue are sufficiently similar in terms of appearance, sound, meaning, and overall commercial impression to result in confusion, mistake or deception among likely customers. The marks at issue, EDGECRAFT and EDGEWARE, are manifestly not identical. It is equally obvious that each of the marks has, as its initial element, the designation EDGE, which in the contexts of the two marks has the identical appearance, pronunciation, and suggestive meaning. It has been observed that the initial element of a mark may be more strongly impressed upon the minds of relevant customers, giving it some dominance as to the overall commercial impression created by the mark. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). We note that the mistake recounted in the Bray Deposition and

the slips of the tongue discussed above in Part VI(E) were likely precipitated by the common initial element EDGE- in the two marks at issue. Marks that have an initial element in common are also more likely to appear in close proximity in alphabetical listings. *See*, for example, Weiner Dep. Exhibit 200: in the alphabetical index of the 2011 Show Directory of the International Home and Housewares Show, EDGEWARE is listed directly below the entry for EDGECRAFT CORP.

As petitioner notes, both marks consist of two syllables rendered as a single word. In form, each mark is a coinage formed from the combination of two actual words, making them more similar than would be the case if one of the marks consisted of an actual word combined with a coined designation.

Clearly, the syllables -CRAFT and -WARE are largely different, although they share the single vowel A, which lends some similarity in appearance and possibly some phonetic similarity. We do not agree with petitioner's argument that "craft" and "ware" are essentially synonyms, as it is based upon a very strained interpretation of dictionary evidence suggesting that "A 'ware' is... a 'product[] of... *craft*..."⁴³ However, both "craft" and "ware" are words of relatively low distinctiveness in the context of commercial goods; certainly neither word carries a meaning that is arbitrary in the context of the parties' goods. Accordingly, in each case the second syllable brings relatively little distinctiveness to the mark as a whole. Even though the term "craft" is different in meaning from "ware," neither

⁴³ Petitioner's brief at 15 and fn13.

word substantially alters the suggestive meaning of the term EDGE, so that the two marks are somewhat similar in overall commercial impression.

We find that when the parties' marks are compared in their entirety, they are more similar than dissimilar in appearance, sound, meaning and commercial impression.

H. Balancing the factors.

The evidence shows petitioner and respondent to be in direct competition under circumstances in which their goods and their marks are almost constantly in close proximity to one another, and travel through the same trade channels to be offered, as alternatives to one another, to the same customers at numerous tiers of the market. The evidence suggests a readiness among members of the trade to mistakenly perceive a connection between petitioner and respondent, and there have been some reported incidents of actual confusion or mistake relating to the EDGECRAFT and EDGEWARE marks. Where confusion has occurred among members of the trade, it is likely that consumers, too, will be susceptible to mistake and confusion relating to the marks. Although not all of the specific goods on which petitioner and respondent have used or registered their marks are identical, all of them are sufficiently similar in nature, in the trade channels through which they move, and in the customers to whom they are directed, that customers would readily believe that they could emanate from a single source if marketed under similar marks. Our analysis of the *du Pont* factors indicates that, with respect to all of the goods at issue, respondent's mark, as used in connection with the

identified goods, so closely resembles petitioner's earlier used and registered marks as to be likely to cause confusion, mistake or deception as to the source of respondent's goods.

VII. Respondent's defense of laches.

Respondent argues that, even if petitioner were able to demonstrate that there is a likelihood of confusion between the parties' marks, respondent has a complete defense of laches based on the prejudice it suffered from petitioner's unjustified delay in bringing the present cancellation proceedings.⁴⁴ Laches is available as a defense in cancellation proceedings. 15 U.S.C. §1069. In order to prevail on a defense of laches, respondent is required "to establish that there was undue or unreasonable delay [by petitioner] in asserting its rights, and prejudice to [respondent] resulting from the delay." *Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460, 1462-63 (Fed. Cir. 2001). *See Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes Inc.*, 971 F.2d 732, 23 USPQ2d 1701 (Fed. Cir. 1992).

For purposes of establishing a date of notice from which petitioner's delay can be measured, a petitioner must be shown to have had actual knowledge or constructive notice of a registrant's trademark use. In the absence of actual notice, the date of registration is the date from which laches runs in the context of a cancellation proceeding, because registration of a mark provides *constructive* notice of use of the mark. *Teledyne Technologies, Inc. v. Western Skyways, Inc.*, 78

⁴⁴ Respondent's brief at 52-54.

Cancellation Nos. 92052940; 92054092; 92054104

USPQ2d 1203, 1210 (TTAB 2006), *aff'd unpublished op.*, Appeal Nos. 2006-1366, - 1367 (Fed. Cir. Dec. 6, 2006). The relevant dates of registration and of the filing of each of the three consolidated proceedings are set forth below:

<u>PROCEEDING</u>	<u>REG. NO.</u>	<u>REGISTRATION DATE</u>	<u>PROCEEDING FILING DATE</u>
92052940	3617203	May 5, 2009	August 2, 2010
92054092	3951563	April 26, 2011	June 10, 2011
92054104	3881712	November 23, 2010	June 10, 2011

For purposes of demonstrating that petitioner had actual notice earlier than the constructive notice dates, respondent states that “Petitioner’s president picked up a brochure promoting EDGEWARE in March of 2008 along with business cards from two of Smith’s employees,” citing Weiner DD at 265-266 and Exhibit 100.

Respondent argues:

As a result of Petitioner’s undue and unexcused delay, Smith’s suffered both economic and evidentiary prejudice. Smith’s has invested valuable and extensive time in registering and developing its trademark and has spent hundreds of thousands of dollars in promoting the EDGEWARE brand. (*See, e.g.*, Glidden Ex. 304 (showing EDGEWARE marketing and promotion expenses).) Petitioner set idly by for two years while it was on notice that Smith’s was developing and promoting products under its trademark.⁴⁵

Petitioner, for its part, characterizes respondent’s adoption of the EDGEWARE mark as a “slow, but purposeful encroachment upon the EDGE CRAFT Mark”; and argues that petitioner acted promptly as soon as it realized that

⁴⁵ Respondent’s brief at 54.

respondent was “migrating” to use of EDGEWARE as a “stand-alone brand,” a realization that occurred in November 2009.⁴⁶

As evidence that petitioner had notice of respondent’s use of the mark EDGEWARE as early as March, 2008, respondent points to testimony of petitioner’s president, stating that he was in possession, as of that date, of a product catalogue of 2008 that bore on its cover in large lettering the designation “EDGEWARE™” and the wording “INNOVATIVE KNIFE & SCISSORS SHARPENERS FOR HOME & KITCHEN.” Weiner DD Exhibit 100. Only the cover of the catalogue is included in Exhibit 100. In the upper left corner, the cover bears a SMITH’S logo; a large photograph of an appliance with the mark SMITH’S on it occupies the center of the cover. (Exhibit 100 also includes an image of a CD marked “2009 MEDIA KIT”; the CD is not marked EDGEWARE, and the content of the CD was not made of record with the deposition.) With respect to this catalogue, another similar catalogue of 2009, and the CD, Mr. Weiner testified as follows:

Q. Would you agree with me that as of March 2009, you were aware that Smith had started using this Edgeware brand?

[Objection]

A. We had some inkling, but we were very confused about the direction in which Smith was going, because in the instance of this [2009] catalog, although it said Edgeware on the catalog, the product said Smith’s. And the heading on the catalog said Smith’s.

So it wasn’t clear to us where the company was going with that mark.

...

⁴⁶ Petitioner’s reply brief at 12-13.

I don't recall what it [the CD] contained. But I recall my reaction to it, it was a very confusing picture to us. We didn't know what this Edgeware thing name was, what its goal was, the product was marked as Smith's. The catalog was marked as Smith's. And this name Edgeware appeared on it and it wasn't clear to us what the meaning of it was.

Weiner DD 262:12-263:5; 267:7-17.

With respect to the catalogues, petitioner argues:

This claimed "use" of the EDGEWARE Mark would not be sufficient to support a registration for knife sharpeners because the mark is not being used on the goods or its packaging, ... and was not sufficient to give Edgecraft notice that its competitor was using the EDGEWARE Mark in an infringing manner on its goods.

Edgecraft's first realization that Smith was migrating to the EDGEWARE stand-alone brand on its knife sharpeners is shown in a November 2009 e-mail reporting that "[a]pparently beginning in January [Smith] will have new packaging under the EdgeWare brand instead of Smith – this will be in answer to gourmet accounts that were resistant to putting in the Smith brand in the gourmet accounts." [Citing PNOR Exhibit 6D at EDGE0001494; footnote omitted.] Shortly after Edgecraft learned of this intent by Smith to use the EDGEWARE Mark alone, it acted promptly to address the issue and sent a letter in January 2010 demanding Smith cease use of the EDGEWARE Mark. [Citing PNOR Exhibit 6E at EDGE0001988-1992.]

Petitioner's reply brief at 12-13. Petitioner also states that "instances of confusion began with the standalone brand." *Id.* at 11.

The evidence adduced by respondent cannot effectively demonstrate an early awareness of petitioner with respect to graters, slicers, choppers, or mandolines, because there is no reference to such goods in the evidence. Accordingly, with

respect to Reg. Nos. 3881712 and 3951563, the evidence cannot alter the date from which laches runs from the respective issue dates of those registrations (April 26, 2011 and November 23, 2010). The cancellation proceedings against those registrations were filed less than 2 months and less than 7 months after registration, respectively. We find no unreasonable delay with respect to those two proceedings.

Regarding Reg. No. 3617203, which relates to various sharpeners, the evidence adduced by respondent is germane. However, considering that respondent's mark is not identical to petitioner's mark, and considering the gradual shift from using EDGEWARE as a cobrand with SMITH'S to using EDGEWARE on a standalone basis, it was not unreasonable for petitioner to take a "wait and see" approach for the relatively short period of time between March of 2008 and its cease-and-desist letter of January 2010 and subsequent filing of the cancellation proceeding in August of 2010. There having been no unreasonable delay on petitioner's part, we find that respondent has failed to prove its asserted defense of laches.

VIII. Conclusion.

We have considered all of the evidence of record and all arguments of the parties relevant to the issues before us, including those not specifically discussed herein. Our analysis of the *du Pont* factors leads us to find, with respect to each of respondent's three registrations at issue, that respondent's mark, as used in connection with the identified goods, so closely resembles petitioner's earlier used

Cancellation Nos. 92052940; 92054092; 92054104

and registered marks as to be likely to cause confusion, mistake or deception as to the source of respondent's goods.

Decision: The consolidated petitions for cancellation are granted.

Concurrence By:

Bergsman, Administrative Trademark Judge, concurring:

I agree with the majority that there is a likelihood of confusion.

However, with respect to the laches affirmative defense, the instances of actual confusion indicate that confusion is inevitable. When confusion is inevitable, the defendant cannot prevail on its affirmative defense of laches. The laches defense, if successful, will serve as a bar against a petition for cancellation grounded on likelihood of confusion unless confusion is inevitable. *See Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Christian Broadcasting Network, Inc. v. ABS-CBN-International*, 84 USPQ2d 1560, 1572 (TTAB 2007); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1131 (TTAB 1990) (equitable defenses such as laches and acquiescence would not preclude a judgment for plaintiff if it is determined that confusion is inevitable); *Feed Flavors Inc. v. Kemin Industries, Inc.*, 214 USPQ 360, 364 (TTAB 1982).