

This Opinion is Not a
Precedent of the TTAB

Mailed: February 22, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Hammers USA, Inc.*¹

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Serial No. 85611025

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Victoria Newland of Law Offices of Victoria Newland
for House of Hammers, Inc.

Andrew C. Leaser, Trademark Examining Attorney, Law Office 117,
Hellen Bryan-Johnson, Managing Attorney.

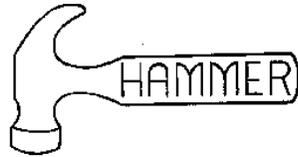
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Before Kuczma, Goodman and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

¹ Jim Greco originally filed the application, and then assigned it to House of Hammers, Inc. (assignment recorded with the USPTO at Reel/Frame Numbers 5282/0826). House of Hammers, Inc. subsequently assigned it to Hammers USA, Inc. (assignment recorded with the USPTO at Reel/Frame Numbers 5692/0280).

I. Background

A predecessor in interest to Hammers USA, Inc. (“Applicant”) applied for registration on the Principal Register of the mark HAMMER in standard characters for “Skateboarding clothing, headwear and footwear, namely, beanies; belts; footwear; hats; jackets and socks; pants; shirts; sweatshirts; t-shirts” in International Class 25 (“the Application”).² The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), as likely to cause confusion with the registered mark shown below for “Jackets and Hats” in International Class 25 and “Bowling Balls” in International Class 28 (the “Registration”).³



After the Examining Attorney made the refusal final, Applicant appealed to this Board and filed a request for reconsideration which argued against the refusal and also amended the identification as reflected above to specify that Applicant’s clothing is skateboarding clothing. The Examining Attorney accepted the amendment but denied the request for reconsideration. We affirm the refusal to register.

² Application Serial Number was filed on April 27, 2012 based on intent to use under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

³ Registration Number 1331008 issued April 16, 1985; renewed.

II. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods. *See In re Chatam Int'l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

With respect to the marks, we must compare them “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). The test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

Similarity of the Marks

Applicant's proposed mark consists only of the word HAMMER. The cited mark consists of the identical word, HAMMER, in block letters that appear inside the outline of a hammer. Clearly, the two marks sound identical. Visually, they share a key similarity because the applied-for mark is a standard character mark and could be presented in any font style, size, or color, including in the same block lettering and size as the word HAMMER in the Registration. *See* 37 C.F.R. § 2.52(a). Given this, the design element in the mark in the Registration constitutes the only real difference between the marks. However, as a pictorial representation of a hammer, the design merely reinforces the literal element shared by both marks. The word HAMMER and design in the registered mark and the word HAMMER in the applied-for mark have the same meaning, and the overall commercial impressions therefore also remain similar. We also note that while the mark in the Registration comprises both words and a design, "the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed." *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015), *citing* *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983). If a mark comprises both wording and a design, greater weight is often given to the wording, because it is the wording that purchasers would use to refer to or request the goods or services. *See, e.g., In re Viterra, Inc.*, 671 F.3d 1358, 1366, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012); *see also In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010) (holding

applicant's mark, MAX with pillar design, and registrant's mark, MAX, likely to cause confusion, noting that the "addition of a column design to the cited mark ... is not sufficient to convey that [the] marks ... identify different sources for legally identical insurance services").

Thus, considering the marks in their entirety, they are quite similar visually, share a comparable commercial impression, and are phonetically identical. This *du Pont* factor weighs in favor of likely confusion.

Relatedness of the Goods and Trade Channels

Turning next to the goods, we must determine whether their degree of relatedness rises to such a level that consumers would mistakenly believe the goods and services emanate from the same source. The comparison must be based on the identifications in the Application and Registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). If likelihood of confusion exists with respect to any of Applicant's identified goods or services in a particular class, the refusal of registration must be affirmed as to all goods in that class. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

On their face, the identifications show that the goods overlap in part. Applicant seeks registration for various items of skateboarding clothing, including "hats" and "jackets." The Registration's identified goods in International Class 25 consist of "Jackets and Hats." Even considering Applicant's narrower identification of

skateboarding jackets and hats, they fall within the Registration's unrestricted identification of the broader categories of jackets and hats. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (broad wording in an identification is presumed to encompass all goods of the type described, including those in more narrow identification).

Applicant argues that “the distinctiveness of the image, marketing, and trade channels renders confusion as to origin highly unlikely.” 25 TTABVUE at 4. Applicant contends that the image of its now-predecessor-in-interest, the original applicant Jim Greco, as “a famous skateboarder,” along with its exclusive sales through “skateboarding and Action Sports-oriented shops,” differentiates its goods from those in the Registration. Applicant then attempts to limit the unrestricted identification of goods in the Registration to “a bowling-specific brand purposefully aimed at professional bowlers” “sold exclusively in bowling specific retailers and professional bowling shops.” *Id.* at 5.

However, this line of argument to restrict the Registration must be rejected. While Applicant amended its identification to narrow the scope of clothing to “skateboarding” clothing, as noted above, the identification in the Registration remains unrestricted and lacks any limitation as to trade channels or classes of purchasers. We therefore must presume that Registrant's goods are marketed in all normal trade channels for “Jackets and Hats” and to all normal classes of purchasers for such goods. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (affirming Board finding that where the

identification is unrestricted, “we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods”); *In re Wilson*, 57 USPQ2d 1863, 1865 (TTAB 2001). Even, assuming *arguendo*, we accepted Applicant’s assertion that the Registrant’s jackets and hats actually travel only in trade channels associated with bowling, this fact must be deemed irrelevant in this *ex parte* proceeding. The identification of goods in the Registration, “Jackets and Hats” without limitation, controls, not the goods as sold in the marketplace. See *Cunningham*, 55 USPQ2d at 1848. Attempts in an *ex parte* proceeding to argue limitations outside the identified goods in the cited registration effectively constitute improper collateral attacks on the validity of the registration. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 105 F.3d 1405, 1408 (Fed. Cir. 1997). Accordingly, given the overlapping goods and trade channels, we find that these *du Pont* factors also heavily favor likely confusion.⁴

Number and Nature of Similar Marks in Use on Similar Goods

Applicant’s remaining argument against likely confusion rests on the premise that a “crowded field” of marks containing the word HAMMER exists for clothing or footwear, and that it should be permitted to join the field. In its January 22, 2013

⁴ In addition to the overlapping goods, the Application identifies other clothing items for which the Examining Attorney provided substantial evidence to show the relatedness of these goods to the “Jackets and Hats” identified in the Registration. See January 29, 2013 Office Action at 2-98; August 17, 2013 Denial of Request for Reconsideration at 2-107.

Response to Office Action, Applicant submitted the following registrations for consideration:⁵

<u>MARK</u>	<u>REGISTRATION NUMBER</u>	<u>GOODS</u>	<u>OWNER</u>
	3178548	footwear	Under Armour, Inc.
HAMMER JEANS (“JEANS” disclaimed)	3472321	Clothing, namely, pants, shirts, sweaters, tops, namely blouses, tank tops, tee-shirts, pullovers, vest and jackets	R.O.N.X. Fashion Group Limited
 (“MAN” disclaimed)	3704037	boots, hats, jackets, pants, shirts	Matt Becker, Harold Grafton, Greg Becker

⁵ Applicant’s July 29, 2013 Request for Reconsideration referred to “25” third-party registrations containing the word HAMMER, but only introduced evidence of five into the record. The Examining attorney has objected to the consideration of any third-party registrations other than the five properly made of record. We sustain the Examining Attorney’s objection and therefore we decline to consider any third-party registrations other than the five Applicant submitted in its Request for Reconsideration. *See In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (mere listing of third-party registrations insufficient).

<p>HAMMER MADE</p>	<p>3955509</p>	<p>Men's clothing, namely shirts, suits, vests, sport coats, neck ties, pocket squares, socks, pants, and knitwear in the nature of shirts</p>	<p>Humble Fashion LLC</p>
 <p>(translation of MARTELO is hammer)</p>	<p>3983050</p>	<p>Leather clothing namely, shoes, jackets, belts and ties.</p>	<p>Brand Q, Inc.</p>

The Examining Attorney contends that this evidence should be accorded little weight because the registrations do not establish actual use in the marketplace. The Examining Attorney further points out that each registration is distinguishable from the mark in the cited Registration for various reasons. We agree with the Examining Attorney that all five registered marks contain other matter in addition to HAMMER (or its foreign translation), either wording, designs, or both, that help distinguish them from



whereas Applicant's mark includes no additional distinguishing matter. The HAMMER MAN and design registration includes a design of a figure using a jackhammer, creating a distinct commercial impression from the mark in the Registration with the word HAMMER and the outline of the hand tool. Although the HAMMER MADE and design mark includes a design of the hand tool, the use of

“hammer-made” in connection with clothing creates a distinct and somewhat incongruous commercial impression that differs from the mark in the Registration. The UA HAMMER registration for “footwear” includes a highly stylized UA in addition to the word HAMMER. The MARTELLO and design registration includes numerous design elements such as a hat and olive branches, consists of the Italian word MARTELLO rather than its English translation, HAMMER, and while the record lacks additional evidence necessary for consideration of the doctrine of foreign equivalents, this “is not an absolute rule and should be viewed merely as a guideline.” *See Palm Bay Imps., Inc.*, 73 USPQ2d at 1696. The closest third party registration seems to be that for the mark HAMMER JEANS, with “JEANS” disclaimed, but even the disclaimed matter must receive some significance in comparing marks. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1676 (Fed. Cir. 2015) (Must “avoid[] the error of giving no significance to the term, which is impermissible notwithstanding that the term is generic and disclaimed.”).

Thus, we find that the registered marks submitted by Applicant are not comparable to Applicant’s mark, consisting only of the single word HAMMER. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (Each case must be assessed “on the record of public perception submitted with the application”). We find that the record of third party registrations does not establish that consumers could rely on any difference in Applicant’s mark to distinguish it from that in the Registration. We consider this *du Pont* factor neutral.

Based on the similarity of the marks, as well as the overlap and relatedness of the goods, and the overlapping trade channels, we find confusion likely.

Decision: The refusal to register Applicant's mark under Section 2(d) is affirmed.