

This Opinion is not a
Precedent of the TTAB

Mailed: October 25, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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*In re Stanley Black & Decker, Inc.*¹

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Serial No. 86954703
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Joshua A. Aldort of McAndrews, Held & Malloy, Ltd.,
for Stanley Black & Decker, Inc.

Edward Fennessy,² Trademark Examining Attorney, Law Office 114,
K. Margaret Le, Managing Attorney.

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Before Zervas, Ritchie and Greenbaum,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Stanley Black & Decker, Inc. (“Applicant”) seeks registration on the Principal Register of the standard character mark WHEN IT MATTERS for “retail department store services and online retail department store services” in International Class 35.³

¹ On May 25, 2017, the USPTO recorded an assignment from the original applicant, Sears Holdings Corporation, to Stanley Black & Decker, Inc.

² Another Examining Attorney issued the Office Actions in this application.

³ Application Serial No. 86954703, filed on March 28, 2016 pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), asserting a *bona fide* intent to use the mark in commerce.

The Examining Attorney refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), in view of Registration No. 4276311 for the standard character mark WHEN IT MATTERS for "retail store services featuring computer hardware, software, network and networking components, telecommunications products and services, cabling and wiring" in International Class 35.

After the Examining Attorney issued a final Office Action, Applicant appealed the refusal to register. Both Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

Evidentiary Issue

The Examining Attorney objects to a list of third-party references Applicant submitted with its brief.⁴ The list is very similar to the list submitted by Applicant with its October 4, 2016 response consisting of U.S. trademark registrations, a U.S. trademark application, a state trademark registration, a "WIPO Reference," and "Common Law References."⁵ The response includes a copy of several, but not all, of the registrations certificates for the listed registrations.

In the subsequently-issued Office Action dated October 31, 2016, the Examining Attorney did not object to the list Applicant submitted in its October 4, 2016 response.

Section 710.03 of the TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") (October 2017) states:

⁴ 6 TTABVUE 12.

⁵ October 4, 2016 Resp., TSDR 1.

If the applicant's response includes improper evidence of third-party registrations, the examining attorney must object to the evidence in the first Office action following the response. Otherwise the Board may consider the objection to be waived. *See In re Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012) (finding that the examining attorney's failure to advise applicant of the insufficiency of the list of registrations when it was proffered during examination constituted a waiver of any objection to consideration of that list); *In re 1st USA Realty Prof'ls*, 84 USPQ2d at 1583 (allowing evidence of a list of third-party registrations because the examining attorney did not advise applicant of the insufficiency of the list while there was still time to correct the mistake); *In re Broyhill Furniture Indus., Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001) (finding examining attorney's objection to a listing of third-party registrations waived because it was not raised in the Office action immediately following applicant's response in which applicant's reliance on the listing as evidence was indicated).

See also TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 1208.02 (June 2017).

The Examining Attorney's objection is granted in-part and denied in-part. We will consider the list submitted with the October 4, 2016 response because of the Examining Attorney's failure to object to the list. We will also consider the list submitted with Applicant's brief, but only to the extent that it repeats the information submitted with the October 4, 2016 response. The record on appeal closed with the filing of the Notice of Appeal. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d).

We will not, however, consider more than the information provided by Applicant in its list submitted on October 4, 2016. *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1264 n.6 (TTAB 2011) (Board considered TESS listings for whatever probative value they had); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1583 (TTAB

2007) (Board treated listing of particulars of third-party applications/registrations submitted by applicant as stipulated into record only to the extent that the specific data provided by applicant was considered); *In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001) (listing of registration information considered for whatever probative value it might have, with Board noting that the listing did not indicate whether registrations issued on the Principal or the Supplemental Register).

Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see also In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014).

Similarity of the Marks

Marks are compared for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay Imports*, 73 USPQ2d at 1692.

Similarity in any one of these elements is sufficient to support a determination of likelihood of confusion. *See Krim-Ko Corp. v. The Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion”); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988) (“In appropriate cases, a finding of similarity as to any one factor (sight, sound or meaning) alone ‘may be sufficient to support a holding that the marks are confusingly similar.’”) (citations omitted)).

The marks are identical in sound and appearance. Applicant has acknowledged that the marks are “similar” in sound and appearance.⁶

Applicant argues that the marks differ in both connotation and commercial impression because “IT” in registrant’s mark refers to “Information Technology,” giving “the connotation that their mark involves software, computers, electronics or a number of other things related to Information Technology (IT)”; and “IT” in Applicant’s mark refers to a pronoun.⁷ Even if registrant’s mark has the connotation and commercial impression ascribed by Applicant to some consumers, other consumers will understand registrant’s mark to have the same connotation and commercial impression as Applicant’s mark because the phrase “when it matters” can be applied to both technology and non-technology goods and services. Additionally, as the Examining Attorney points out, the registered mark is in standard character form

⁶ Applicant’s brief at 5 (“The marks here are similar in sound and appearance”), 4 TTABVUE 6.

⁷ Applicant’s brief at 5, 4 TTABVUE at 6.

and may be displayed with “it” in lower case letters, thus removing “it” from the “information technology” meaning offered by Applicant.⁸

In view of the forgoing, we find that the *du Pont* factor regarding the similarity of the marks weighs heavily in favor of a finding of likelihood of confusion.

Similarity of services

Applicant identifies its services as “retail department store services and online retail department store services” and registrant identifies its services as “retail store services featuring computer hardware, software, network and networking components, telecommunications products and services, cabling and wiring.” *The Merriam-Webster Dictionary* definition of “department store” in the record is “a store having separate sections for a wide variety of goods.”⁹ The webpages in the record from department stores such as Walmart, Sears, Target, Frys, Overstock and Kohls depict a wide variety of goods offered for retail sale, including clothing, jewelry, electronic goods, toys, food and video games.¹⁰ In view of the definition and the webpages, we find that retail and online department stores services include the sale of computer hardware (desktops, tablets, printers, mouse, keyboard, flash drive, fax board)¹¹, software,¹² network and networking components (network card),¹³

⁸ 6 TTABVUE 15.

⁹ June 2, 2016 Office Action, TSDR 5.

¹⁰ June 2, 2016 Office Action, TSDR 7-75.

¹¹ June 2, 2016 Office Action, TSDR 10-20, 38, 39, 40, 52, 55, 60-64, 72.

¹² June 2, 2016 Office Action, TSDR 21-27, 46-48, 57-59.

¹³ June 2, 2016 Office Action, TSDR 28.

telecommunications products and services (routers, extenders, fax board,¹⁴ cabling¹⁵ and wiring).¹⁶ We therefore find that Applicant's and the cited registrant's services overlap.

Applicant's argument that Applicant's services will focus on the general promotion of tools, lawn and garden equipment is unavailing because we must compare the services as they are identified in the application and cited registration; we may not consider Applicant's services to be limited to tools, lawn and garden equipment, as advocated by Applicant. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (goods as identified in involved application and cited registration compared); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also, Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). We may not read limitations into the recitations of services. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration").

The *du Pont* factor regarding the similarity of the services therefore favors a finding of likelihood of confusion.

¹⁴ June 2, 2016 Office Action, TSDR 30-31, 38.

¹⁵ June 2, 2016 Office Action, TSDR 54, 65-69, 72.

¹⁶ June 2, 2016 Office Action, TSDR 55, 65-69, 72.

Similarity of Trade Channels

Because the two recitations of services overlap and are without trade channel restrictions which distinguish one from the other, the trade channels also overlap. See *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) (“Given the in-part identical and in-part related nature of the parties’ goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade”). The *du Pont* factor regarding the similarity of trade channels therefore favors a finding of likelihood of confusion.

Third-Party Marks

In *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015), the Federal Circuit recently stated:

[S]ufficient evidence of third-party use of similar marks can “show that customers ... ‘have been educated to distinguish between different ... marks on the basis of minute distinctions.’” 2 *McCarthy on Trademarks and Unfair Competition* § 11:88 (4th ed. 2015) (quoting *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 USPQ 383 (TTAB 1976)). More broadly, evidence of third-party use bears on the strength or weakness of an opposer’s mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373 [73 USPQ2d 1689] (Fed. Cir. 2005). The weaker an opposer’s mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection. *Id.* (“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”); *In re Coors Brewing Co.*, 343 F.3d 1340, 1345 [68 USPQ2d 1059] (Fed. Cir. 2003) (third-party use can establish that mark is not strong); *Fleetwood Co. v. Mende*, 298 F.2d 797, 799 [132

USPQ 458] (CCPA 1962) (“Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.”).

Id. at 1674.

The five registration certificates submitted with Applicant’s October 4, 2016 response do not assist Applicant because they concern dissimilar marks (*e.g.*, MADE TO MATTER and YOUR EARTH MATTERS) or dissimilar goods/services (*e.g.*, “vehicular after market parts and accessories, namely, brake light assemblies, towing hitch assemblies, and air spoiler repair kits” and “insurance; financial affairs; monetary affairs; real estate affairs[;] insurance; financial affairs; monetary affairs; real estate affairs”), and some are not based on use in commerce. Further, Applicant has not demonstrated that certain older registrations still are valid; no indication was provided that the necessary Trademark Act Section 8, 15 U.S.C. § 1058, affidavit has been filed or that the registration has been renewed. The trademark applications included in the list are of no help to Applicant because the mark is not identified in one instance, and because trademark applications evidence only that applications were filed on a certain date; an application is not evidence of use or that the mark, in fact, co-existed in the marketplace with registrant’s mark. *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007); *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1468 n.6 (TTAB 2003); *In re Juleigh Jeans Sportswear, Inc.*, 24 USPQ2d 1694, 1699 (TTAB 1992).

As for the state registration and the WIPO Reference submitted by Applicant, they do not demonstrate actual use of the identified marks in the United States. The

Internet references in the chart submitted with the October 4, 2016 Office Action do not show how the listed designation is used or on what goods or services.¹⁷ Some identify foreign Internet addresses (URLs)¹⁸ and hence are of no assistance in demonstrating use in the United States. In at least one instance, the designation does not appear at all on the list.¹⁹

Thus, Applicant has not demonstrated the existence of similar third party marks, and the *du Pont* factor regarding the number and nature of third-party marks is neutral in our analysis.

Conditions of Purchase/Purchaser Sophistication

Applicant argues:

customers that are interested in purchasing tools, lawn and garden equipment ... [are] aware that tools, lawn and garden equipment are often expensive purchases and are important household products that likely impact the lives of the customer and his/her loved ones. Thus, the customer will seek out a reputable sales provider for their respective needs. While doing so, the consumer will carefully and thoroughly evaluate the costs and benefits of potential purchases, rather than buying something on impulse. The ultimate selection of a certain good will be based on evaluation and steady thought by the consumer and will leave no doubt in the consumer's mind as to the source of the goods that it will be obtaining.²⁰

¹⁷ FOR WHEN IT MATTERS (<http://www.stephenb-photography.co.uk/>), October 10, 2016 Resp., TSDR 1.

¹⁸ *Id.*; and “Web and Internet Services, For When It Matters” (<http://new.fastbits.ca/>), October 5, 2016 Resp., TSDR 1.

¹⁹ *See, e.g.*, “FOR WHEN FASTENING MATTERS.” October 4, 2016 Resp., TSDR 1.

²⁰ Applicant's brief at 9, 4 TTABVUE 10.

We see two problems with Applicant's argument. First, the operative identifications in this case do not concern goods, but rather retail store services. Applicant's argument concerns the selection and purchase of the goods, rather than the store that sells the goods. Second, as noted earlier in this opinion, Applicant's recitation of services is not limited to the retail sale of tools, lawn and garden equipment. Applicant's recitation includes retail department store services featuring low-cost items such as mittens and socks. (Even a garden tool can be a low cost item.) Registrant's identification includes the retail sale of low-cost computer hardware items such as computer cable plugs, which can retail as little as \$3.48, as indicated on the webpage from walmart.com submitted by the Examining Attorney with the June 2, 2016 Office Action.²¹

Thus, in light of the broad recitations of services, we are not persuaded by Applicant's arguments about purchasing conditions or consumer sophistication and find this *du Pont* factor to be neutral in our analysis.

Balancing the factors

Applicant's mark and the cited mark are identical, and the services and trade channels overlap in part. Applicant has not demonstrated any weakness in the mark or that purchasers of the services are sophisticated and apply any heightened level of care. Thus, upon consideration of all of the arguments offered by the Examining Attorney and Applicant, and all the evidence in the record, including evidence and arguments not specifically mentioned in this decision, we find that there is a

²¹ June 2, 2016 Office Action, TSDR 54.

likelihood of confusion between Applicant's mark and the cited registrant's mark for their respective services.

Decision: The refusal to register is *affirmed*.