

This Opinion is Not a
Precedent of the TTAB

Mailed: January 7, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Hard Rok Equipment, Inc.
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Serial No. 87581245
—

Steven A. Caloiaro of Dickinson Wright PLLC,
for Hard Rok Equipment, Inc.

Jonathon Schlegelmilch, Trademark Examining Attorney, Law Office 108,
Kathryn E. Coward, Managing Attorney.

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Before Greenbaum, Goodman, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Hard Rok Equipment, Inc. (“Applicant”) seeks registration on the Principal Register of the mark HARDROK EQUIPMENT INC. in standard characters (EQUIPMENT INC. disclaimed) for “distributorship services in the field of industrial machinery and parts therefor in the mineral and aggregate industries” in International Class 35.¹

¹ Application Serial No. 87581245 was filed on August 23, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use of the mark and first use of the mark in commerce at least as early as November 1, 2003.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the registered mark HARDROCK in standard characters, and the registered mark HARDROCK DIRECTIONAL DRILLING HDDP and design (DIRECTIONAL DRILLING disclaimed) shown below



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both for “rock drills for directional drilling; drill bits for directional rock drilling; systems for converting rock drills into directional drills, consisting of complete power hammer with choke, rings and chuck, complete hammer housing, sonde carriage assembly, support station with remote electric valve, hammer oiler, and water injection device; steerable downhole directional rock drills” in International Class 7, as to be likely, when used in connection with the services identified in the application, to cause confusion, to cause mistake, or to deceive.

Applicant appealed when the Examining Attorney made the refusal final. The appeal is fully briefed.³ We affirm the refusal to register.

² Registration No. 4141194 for the standard character mark and Registration No. 4141196 for the composite word-and-design mark both issued on May 15, 2012 to Hard Rock Horizontal Drilling Products, Inc. (“Registrant”), and have been maintained. The composite mark “consists of [t]he word ‘HARDROCK’ above the words ‘DIRECTIONAL DRILLING HDDP’, all on a white and light grey marble background with the word ‘HARDROCK’ in teal letters outlined in white with the letter ‘O’ being formed in the design of a drill bit, and the words ‘DIRECTIONAL DRILLING HDDP’ in white with a black rectangular border.” The colors teal, white, light grey and black are claimed as a feature of the mark.

³ Citations in this opinion to the briefs refer to TTABVUE, the Board's online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the

I. Record on Appeal⁴

The record on appeal includes Applicant's specimen of use,⁵ and the following materials:

- Copies of the cited registrations from TSDR;⁶
- Third-party webpages that the Examining Attorney claims show that the services identified in the application and the goods identified in the cited registrations are commonly offered by the same entities under the same mark;⁷
- Dictionary definitions of the words "equipment" and "inc.,"⁸ Wikipedia entries entitled "Aggregate Industries,"⁹ "Mining,"¹⁰ and "Drilling and blasting,"¹¹ and a "Glossary of Mining Terminology" from rocksandminerals.com,¹² made of record by the Examining Attorney; and

number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear.

⁴ Citations in this opinion to the application record are to pages in the Trademark Status & Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO").

⁵ August 23, 2017 Application at TSDR 3.

⁶ December 1, 2017 Office Action at TSDR 2-6.

⁷ *Id.* at TSDR 9-18; May 30, 2018 Final Office Action at TSDR 40-52.

⁸ December 1, 2017 Office Action at TSDR 19-43.

⁹ *Id.* at TSDR 44-47.

¹⁰ May 30, 2018 Final Office Action at TSDR 2-15.

¹¹ *Id.* at TSDR 16-19.

¹² *Id.* at TSDR 20-39. In the Final Office Action, the Examining Attorney referred to a definition of the word "distributor" from THE AMERICAN HERITAGE DICTIONARY, *id.* at TSDR 1, but no definition was attached.

- A declaration of Applicant’s President Theodore Zebroski, and exhibits thereto, regarding various aspects of Applicant’s business and the business of Registrant, and third-party uses of “Hard Rock” or a similar mark in connection with such businesses.¹³

II. Analysis of Likelihood of Confusion Refusal

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under § 2(d) is based on an analysis of all probative facts established by the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Two key factors in every § 2(d) case are the similarity or dissimilarity of the marks, and the goods or services, because 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.” *Federated Foods, Inc. v. Fort Howard Paper*

¹³ May 9, 2018 Response to Office Action at TSDR 13-31. Applicant attached copies of the declaration and exhibits to its main brief, 6 TTABVUE 19-37, and repeatedly cited to it as a self-styled appendix to the brief. This was unnecessary and distracting. “Parties to Board cases occasionally seem to be under the impression that attaching previously-filed evidence to a brief and citing to the attachments, rather than to the original submission is a courtesy or a convenience to the Board. It is neither.” *In re Michalko*, 110 USPQ2d 1949, 1950 (TTAB 2014). Citation to the record is sufficient. *Id.*

Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). Applicant argues that the pertinent *DuPont* factors are these two key factors, the fourth *DuPont* factor regarding the conditions under which and buyers to whom sales are made, the sixth *DuPont* factor regarding the nature and number of similar marks in use on similar goods,¹⁴ and the eighth *DuPont* factor, the length of time during and conditions under which there has been concurrent use without evidence of actual confusion. 6 TTABVUE 9.

We will confine our analysis to the cited standard character mark HARDROCK, which we find to be the more pertinent of the two cited marks. If we find a likelihood of confusion as to that mark, we need not consider the composite word-and-design mark; conversely, if we do not find a likelihood of confusion as to the standard character mark, we would not find it as to the composite mark. *See In re Max Capital Grp.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we consider “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps., Inc. v. Veuve Cliquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the

¹⁴ Applicant incorporates its arguments regarding the third-party uses of HARD ROCK formative marks into its argument under the first *DuPont* factor rather than presenting them in a separate argument regarding the sixth *DuPont* factor. Accordingly, we will address the third-party uses in our analysis of the first *DuPont* factor.

marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)).

The proper test regarding similarity “is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks and citation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted).¹⁵

1. Applicant’s Arguments

Applicant concedes that its mark HARDROK EQUIPMENT INC. in standard characters “shares the phonetic equivalent of the word HARDROCK in the Cited Marks,” 6 TTABVUE 10-11, but makes a variety of arguments that the marks nevertheless are not confusingly similar.

Applicant argues that “the Examining Attorney has dissected Applicant’s Mark into component parts to compare Applicant’s HARDROK with the Cited Marks’ HARDROCK” and “has entirely neglected the role of the additional terms

¹⁵ The average customer of the identified distributorship services are purchasers of “industrial machinery and parts therefor in the mineral and aggregate industries.” The only record evidence specifically identifying these customers is Mr. Zebroski’s testimony that they are “large scale commercial and industrial operators” in those industries. Zebroski Decl. ¶ 15.

‘EQUIPMENT INC.’ in Applicant’s Mark . . . in evaluating the marks for purposes of likelihood of confusion.” *Id.* at 10. In Applicant’s view, the Examining Attorney’s dissection of the mark is a fatal error because “[t]he inclusion of the additional words ‘EQUIPMENT INC.’ creates a completely different impression on the consumer even though Applicant’s Mark incorporates the phonetic equivalent of the term HARDROCK” *Id.* at 11. Applicant claims that its mark “is distinguishable from the Cited Marks because of the inclusion of the additional terms” because “the consumers in this industry are sophisticated and the additional terms . . . provide additional details that would be understood by the sophisticated purchasers to identify that the Marks cover dissimilar goods, and thus create a different commercial impression.” *Id.* at 10.

Applicant also argues that “the shared word ‘HARDROCK’ is weak in the mining industry and, thus, less likely to generate confusion over source identification.” *Id.* at 11. Applicant claims that “HARDROCK is inherently descriptive, or at most, highly suggestive of a characteristic or feature of Registrants’ Goods,” *id.* at 12, and that “the public is already accustomed to distinguishing between various HARDROCK marks used in connection with mining and drilling and will easily differentiate between the Applicant’s Mark and the Cited Marks.” *Id.* Applicant argues that where the common portions of marks are weak, “small differences between marks under review will be sufficient to preclude a likelihood of confusion.” *Id.* Applicant concludes that “the term HARDROCK is often used in unregistered marks in connection with mining and drilling that [sic] it carries a descriptive connotation in the industry, and

is weak for this reason,” *id.* at 13, such that the “Cited Marks are entitled to only a narrow scope of protection.” *Id.*

2. The Examining Attorney’s Arguments

The Examining Attorney responds that “although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression,” 8 TTABVUE 3, and the more significant or dominant portion of Applicant’s mark is the term HARDROK, the first word in the mark. *Id.* The Examining Attorney argues that “[w]hile not exactly identical, the marks here feature a dominant term, which is identical in sound and nearly identical in appearance,” and “[t]his causes the marks to convey highly similar commercial impressions” *Id.* at 4. Finally, the Examining Attorney argues that even if HARDROCK is weak within the mining industry, “the term is strong enough to carry both the applied-for mark and the first cited mark,” and that weak marks also “are entitled to protection under Section 2(d) against the registration by a subsequent user of a similar mark for closely related goods and/or services.” *Id.*

3. Analysis of Similarity

Applicant’s mark HARDROK EQUIPMENT INC. and Registrant’s mark HARDROCK must be considered in their entireties, but “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751

(Fed. Cir. 1985)). We begin with a determination of the dominant portion of Applicant's mark because, as discussed above, Applicant accuses the Examining Attorney of dissecting its mark and giving undue weight to the word HARDROK.

The word HARDROK is the first part of Applicant's mark, and that "is particularly significant because consumers typically notice those words first." *Id.* at 1049 (citing *Palm Bay Imps.*, 73 USPQ2d at 1692). *See also Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (marks CENTURY 21 and CENTURY LIFE OF AMERICA found to be confusingly similar in part because "upon encountering each mark, consumers must first notice [the] identical lead word" CENTURY). The words EQUIPMENT INC. that follow HARDROK in Applicant's mark have been disclaimed and have virtually no source-identifying capacity because "EQUIPMENT" is another term for the "industrial machinery and parts therefor" that are the subject of Applicant's distribution services,¹⁶ and "INC." "merely describe[s] the business form of the entity that owns the mark[]." *Detroit Athletic*, 128 USPQ2d at 1049. Accordingly, we find that HARDROK is the dominant portion of Applicant's mark, and we turn now to the required comparison of the marks in their entireties, giving greater weight in that comparison to the word HARDROK in Applicant's mark than to the words EQUIPMENT INC.

¹⁶ The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *See, e.g., Ricardo Media, Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, *6 n.8 (TTAB 2019). We take judicial notice that the word "equipment" in Applicant's mark is a synonym for the word "machinery" that appears in Applicant's identification of services. THESAURUS.COM (last accessed on January 6, 2020).

Structurally, Applicant's mark adds the words EQUIPMENT INC. to the word HARDROK, which Applicant acknowledges to be the phonetic equivalent of the cited mark HARDROCK. 6 TTABVUE 11. Applicant invokes the principle that "[a]dditions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted." TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") Section 1207.01(b)(iii) (Oct. 2018). Applicant argues that "[t]he term HARDROCK is inherently descriptive, or at most, highly suggestive of a characteristic or feature of Registrants' Goods," 6 TTABVUE 12, and that the third-party uses discussed below "demonstrate that the Cited Marks are weak and entitled to only a narrow scope of protection." *Id.*¹⁷

The cited HARDROCK mark "is registered on the Principal Register [and] is entitled to all Section 7(b) presumptions, including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods." *Tea Bd. of India v. The Republic*

¹⁷ Applicant does not appear to dispute that the marks are similar in appearance and sound. Applicant acknowledges several times that its mark "incorporates the phonetic equivalent of the term HARDROCK" that comprises the cited mark, 6 TTABVUE 11, and Applicant does not specifically address the similarity of the marks in appearance. The differences between the marks in appearance and sound arising from the presence of the words EQUIPMENT INC. in Applicant's mark are outweighed by the similarities arising from the presence in the marks of the virtually identical words HARDROCK and HARDROK, particularly taking into account that the "marks 'must be considered . . . in light of the fallibility of human memory' and 'not on the basis of side-by-side comparison.'" *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977)).

of Tea, Inc., 80 USPQ2d 1881, 1899 (TTAB 2006). The registration did not issue on the basis of a showing of acquired distinctiveness under § 2(f), and the HARDROCK mark is thus presumed to be inherently distinctive. *Id.* Applicant's claim that the mark is "inherently descriptive" is an impermissible collateral attack on the validity of the registration, which we cannot entertain in the absence of a petition to cancel it. *See, e.g., In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) and cases cited therein. The HARDROCK mark "cannot be treated as merely descriptive; at worst [it] must be viewed as highly suggestive," *Am. Lebanese Syrian Associated Charities, Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1029 (TTAB 2011), and viewing the mark "at worst" as highly suggestive, *id.*, it is well settled that "even weak marks are entitled to protection against confusion." *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974).

With respect to the asserted dilution of the HARDROCK mark, Applicant argues that third-party uses of similar marks make consumers "accustomed to distinguishing between similar marks [that] contain the terms 'HARDROCK' (and the phonetic equivalents) for similar goods and services and will look to additional distinguishing terms including Applicant's additional words 'EQUIPMENT INC.' to distinguish among other HARDROCK marks." 6 TTABVUE 9. Applicant made of record webpages from two United States companies that use "Hard Rock" or "Hardrock" as part of their trade names and as marks.¹⁸ We reproduce below portions of the two pages:

¹⁸ May 9, 2018 Response to Office Action at TSDR 20-27. Another page in the record is from the website of a company that uses the .ca country code top-level domain for Canada

Our Mission



Hard Rock is a leading provider of horizontal directional drilling (HDD) services. We provide a comprehensive range of services – including pre-bore profiling, bore design and utility infrastructure installation.

With over 100 years of combined experience, Hard Rock's administrative and management teams have successfully completed hundreds of HDD projects for national, state and local firms.

Horizontal Directional Drilling is a complex and costly process that requires expertise and experience. Hard Rock's drilling professionals are fully trained in the HDD process and are capable of drilling through all types of materials and in all type of conditions.

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2 (/iProView/761270/hardrock-drilling-excavation/subcontractors/construction-projects/)

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- Underground Utilities - Trenchless Technology
- Gas
- Water

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(hardrockdrilling.ca) and that lists a telephone number in the (250) area code, which we judicially notice is an area code in the Canadian province of British Columbia. *Id.* at TSDR 30. This webpage does not show use of the Hardrock Diamond Distilling mark in the United States in the absence of evidence that it has been exposed to United States consumers. Another page in the record is from the website of a trade association called the Indiana Mineral Aggregates Association (“IMAA”) that lists a “new company” named Hardrock Drilling LLC that is described as a member of the IMAA since 2017. *Id.* at TSDR 28-29. No link to any website of the “new company” is provided in the company’s contact information. *Id.* Applicant also cites two other uses that it claims involve use of “the term HARDROCK or variations thereto for similar goods and services,” 6 TTABVUE 13, but they do not support Applicant’s argument. One is a page from the Komatsu website that makes non-trademark use of the phrase “hard rock equipment.” May 9, 2018 Response to Office Action at TSDR 19. The other is a page from the website of a company called SSAB. *Id.* at TSDR 31. Applicant claims that this page refers to a “Hardrox Wear Plate,” 6 TTABVUE 13, but it actually refers to a Hardox wear plate. May 9, 2018 Response to Office Action at TSDR 31.

¹⁹ *Id.* at TSDR 20.

²⁰ *Id.* at TSDR 26.

“Internet printouts, such as those offered by Applicant, ‘on their face, show that the public may have been exposed to those internet websites and therefore may be aware of the advertisements contained therein.” *In re FabFitFin, Inc.*, 127 USPQ2d 1670, 1674 (TTAB 2018) (quoting *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011)).

“The purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694 (internal quotation and quotation marks omitted)). The record is devoid of evidence of the number of United States sellers of tools for directional rock drilling, but by any measure two (or even three or four) third-party uses do not establish the existence of a “plethora” of similar marks. *Id.* The Federal Circuit has held that “extensive evidence of third-party registration and use is ‘powerful’ on its face,’ even when the specific extent and impact of the usage has not been established.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millenium Sports, S.L.U.*, 797 F.2d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015)). The number of third-party uses here, however, is significantly fewer than the 14 third-party uses and registrations in *Jack Wolfskin*, 116 USPQ2d at 1136 n.2, the 26 third-party uses and registrations in *Juice Generation*, 115 USPQ2d at 1673 n.1,

and even the 10 third-party uses in *FabFitFun*, 127 USPQ2d at 1674, which the Board held “reflect[ed] a more modest amount of evidence than that found convincing in *Jack Wolfskin* and *Juice Generation*,” but when coupled with dictionary definitions of the phrase “smoking hot,” supported a conclusion that the SMOKIN HOT’ component of the cited mark SMOKIN’ HOT SHOW TIME for cosmetics was “somewhat weak.”²¹

The third-party uses here are far too few in number to be “extensive” evidence of weakness that is “powerful on its face,” *Jack Wolfskin*, 116 USPQ2d at 1136, and there is no accompanying showing of any long duration or widespread exposure of the referenced uses that might enhance their probative value. We find that Applicant’s third-party use evidence is insufficient to show that the HARDROCK mark has been weakened to such a degree that consumers of Applicant’s services will differentiate HARDROK EQUIPMENT INC. from HARDROCK on the basis of the addition of the disclaimed, non-source identifying words EQUIPMENT INC.

²¹ Applicant also cites *Sun Banks of Florida, Inc. v. Sun Fed. Sav. & Loan Ass’n*, 651 F.2d 311, 211 USPQ 844 (5th Cir. 1981), *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559 (TTAB 1996), and *Gen. Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992) as examples of cases where third-party uses established that “small differences between marks under review will be sufficient to preclude a likelihood of confusion.” 6 TTABVUE 12. These cases do not aid Applicant because the third-party uses here pale in comparison to the number of third-party uses and registrations in the cited cases. In *Sun Banks of Florida*, there were “25 active financial businesses employing the word ‘Sun’ and 50 active financial businesses employing a compound of the word ‘Sun’” in the state of Florida alone. 211 USPQ at 848 n.8. In *Broadway Chicken*, a “search of company names in the Dun & Bradstreet database found more than 500 entities providing restaurant, bar, or related services under a trade name containing the term BROADWAY.” 38 USPQ2d at 1560-61. Finally, in *Health Valley Foods*, there were 171 third-party registrations of, and applications to register, FIBER-formative marks for food products and dietary supplements and “numerous third-party uses of ‘fiber’ in connection with food products” that left no doubt that “the field of ‘fiber’ marks for foods (including cereals) is a crowded field.” 24 USPQ2d at 1227.

We turn now to Applicant's argument under the principle that "[a]dditions . . . to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions." TMEP § 1207.01(b)(iii). Applicant argues that "[t]he inclusion of the additional words 'EQUIPMENT INC.' creates a completely different impression on the consumer even though Applicant's Mark incorporates the phonetic equivalent of the term HARDROCK." 6 TTABVUE 11. According to Applicant, its mark "is distinguishable from the Cited Marks because . . . the consumers in this industry are sophisticated and the additional terms . . . provide additional details that would be understood by the sophisticated purchasers to identify that the Marks cover dissimilar goods, and thus create a different commercial impression." *Id.*

The added words EQUIPMENT INC. do not provide meaningful "additional details" that would enable consumers to distinguish the source of the goods and services sold under the HARDROCK and HARDROK EQUIPMENT INC. marks. The Federal Circuit has recently reiterated that words of this sort are relatively insignificant to the overall commercial impression of marks that contain them. *Detroit Athletic Co.*, 128 USPQ2d at 1049 (citing, inter alia, 4 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:49, at 23-279 (5th ed. 2018) ("Tacking on a generic business entity name such as 'company' or 'Inc.' or 'Partners' will not usually avoid a likelihood of confusion to an otherwise confusingly similar mark") and *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("The disclaimed word 'Technologies' is highly

suggestive or descriptive of the data processing and data transmission services in Packard Press's application [to register PACKARD TECHNOLOGIES]" and "[g]iven the highly descriptive nature of the disclaimed word 'Technologies,' the Board correctly found that the word 'Packard' is the dominant and distinguishing element of PACKARD TECHNOLOGIES"). The words EQUIPMENT and INC. do not identify the source of Applicant's distributorship services, but simply describe their subject matter and the business form of the HARDROK entity that provides them. "Those words are therefore unlikely to change the overall commercial impression engendered by the marks." *Detroit Athletic Co.*, 128 USPQ2d at 1049.²²

Applicant relies heavily on *In re Box Solutions*, 79 USPQ2d 1953 (TTAB 2006), in support of its claim that the words EQUIPMENT INC. sufficiently differentiate the HARDROK EQUIPMENT INC. mark from the HARDROCK mark. 6 TTABVUE 11. It is axiomatic that each likelihood of confusion case must be decided on its own facts, but *Box Solutions* is readily distinguishable in any event.

In *Box Solutions*, the Board found that the marks shown below

²² As noted above, we must focus "on the recollection of the average customer, who retains a general rather than specific impression of marks." *i.am.symbolic*, 127 USPQ2d at 1630. Applicant claims that "it is the mark as a whole" that is "likely to be impressed upon a purchaser's memory," 6 TTABVUE 11, but it is unlikely that even the most sophisticated purchaser of Applicant's services would retain a general impression of the mark as HARDROK EQUIPMENT INC. given the "penchant of consumers to shorten marks." *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1961 (TTAB 2016). See also *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) ("[T]he users of language have a universal habit of shortening full names—from haste or laziness or just economy of words") (Rich, J., concurring). It is far more likely that a consumer would recall the mark and its owner simply as HARDROK, which Applicant acknowledges is the phonetic equivalent of the cited HARDROCK mark.



(The applicant's mark)



(The cited mark)

were not confusingly similar when applied to closely related computer hardware where dictionary definitions and at least seven third-party registrations showed that “BOX is a weak term in the computer industry in that it signifies a computer or computer related device.” *Box Solutions*, 79 USPQ2d at 1957. In view of the weakness of the term BOX, the Board could not say “that BOX dominates over the prominent design in registrant’s mark,” and held that the registrant’s “stylistic design of what appears to be a monitor with an antenna-like check mark, stands in stark contrast to applicant’s highly stylized mark which consists of the phrase BOX SOLUTIONS with the word BOX with white slash marks cutting through it,” which caused the marks to “have substantially different appearances and commercial impressions.” *Id.* at 1958. Here, both marks are standard character marks and, as discussed above, the record does not show that the registered HARDROCK mark has been weakened to any significant extent, much less to such an extent that we “must accord this term a very narrow scope of protection.” *Id.*

We find that the HARDROCK and HARDROK EQUIPMENT INC. marks are quite similar in appearance, sound, and connotation and commercial impression when considered in their entireties. The first *DuPont* factor strongly supports a finding of a likelihood of confusion.

B. Similarity or Dissimilarity of the Goods and Services and Channels of Trade

The second *DuPont* factor “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,’” *Detroit Athletic Co.*, 128 USPQ2d at 1051 (quoting *DuPont*, 177 USPQ at 567), while the third *DuPont* factor considers “the similarity or dissimilarity of established, likely-to-continue trade channels.” *Id.* (quoting *DuPont*, 177 USPQ at 567). Our analysis under these factors is based on the identifications of services in the application and the identification of goods in the cited registration. *Id.*; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014). The identification of services in the application is “distributorship services in the field of industrial machinery and parts therefor in the mineral and aggregate industries,” while the identification of goods in the cited registration is “rock drills for directional drilling; drill bits for directional rock drilling; systems for converting rock drills into directional drills, consisting of complete power hammer with choke, rings and chuck, complete hammer housing, sonde carriage assembly, support station with remote electric valve, hammer oiler, and water injection device; steerable downhole directional rock drills.”

It is “not necessary that the products [or services] be identical or even competitive to support a finding of a likelihood of confusion.” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). “[L]ikelihood of confusion can be found ‘if the respective products [or services] are related in some manner and/or if the circumstances surrounding their marketing are

such that they could give rise to the mistaken belief that they emanate from the same source.” *Id.* (quoting *7-Eleven*, 83 USPQ2d at 1724). Goods may be related to services, *see, e.g., Detroit Athletic Co.*, 128 USPQ2d at 1051; *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988), and the Federal Circuit has “held that confusion is likely where one party engages in retail services that sells the goods of the type produced by the other party” *Detroit Athletic Co.*, 128 USPQ2d at 1051.

1. Applicant’s Arguments

Applicant argues that the goods in the cited registration are “‘rock drills for directional drilling’ and associated support goods,” 6 TTABVUE 14, which “are used to drill a hole,” *id.* at 15, while “Applicant’s Services relate to providing goods for crushing, conveying, or screening material in the limited aggregate and mineral field.” *Id.* Applicant claims that the goods identified in the cited registration “would not be used in the aggregate or mineral industry.” *Id.* Applicant acknowledges that the record shows that “mining is a large and expansive process that covers many different goods and services,” and that “both marks [pertain to] *generally related* industrial equipment,” but argues that “they are not, in fact, in the same industry, and are only tangentially related under a broad definition of the mining industry.” *Id.*

In its reply brief, Applicant argues that “the degree of relatedness must be viewed in the context of the *reasonable consumer* of such goods,” 9 TTABVUE 6, and that “the Examining Attorney improperly views the goods at issue from the uneducated untrained laymen’s perspective as opposed to actual reasonable consumers of the

goods in question,” *id.* at 6-7, by relying on sources such as Wikipedia to define the relevant industries. *Id.* at 7.

2. The Examining Attorney’s Arguments

The Examining Attorney argues that “the mineral and aggregate industries include drilling,” and that “the goods identified by registrant commonly emanate from the services identified by applicant, under the same mark” 8 TTABVUE 5. He claims that the record, including the Wikipedia entry regarding mining, the *Rocks and Minerals* GLOSSARY OF MINING TERMINOLOGY, and pages from five third-party websites, shows “that mineral and aggregate industry equipment includes rock drills, that drills are commonly used in the mineral industry, that it is common for manufacturers of rock drills to provide related distribution services, and that the applicant’s identified services and the registrant’s identified goods travel in the same channels of trade.” *Id.*

3. Analysis of Similarity or Dissimilarity

Mr. Zebroski states in his declaration that “Applicant distributes crushing, conveying, and screening aggregate wear parts and machines to the aggregate and mineral industries,” Zebroski Decl. ¶ 2, and that Applicant “does not manufacture or sell” the drilling equipment identified in the cited registration. *Id.* ¶ 3. He further states that Applicant “provides services related to crushing, conveying, or screening for the aggregate or mineral fields only,” and that drills “are never used to complete this type of work.” *Id.* at ¶ 14. His declaration does not establish, however, that the goods identified in the cited registration and the services identified in the application

are unrelated, or that “Registrants’ Goods would not be used in the aggregate or mineral industry.” 6 TTABVUE 15.

As discussed above, and as Applicant acknowledges, *id.* at 13, in considering the second *DuPont* factor, we must look to the identification of services in the application and the identification of goods in the registration, not to extrinsic evidence of the actual current uses of the respective marks. “The relevant inquiry in an *ex parte* proceeding focuses on the goods and services described *in the application and registration*, and *not* on real-world conditions.” *Detroit Athletic Co.*, 128 USPQ2d at 1052 (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)). Because the application covers “distributorship services in the field of industrial machinery and parts therefor in the mineral and aggregate industries,” we must define the “mineral and aggregate industries” and determine what “industrial machinery and parts therefor” are distributed for use in those industries.

a. Defining the “Mineral and Aggregate Industries”

Mr. Zebroski’s declaration does not define the “mineral and aggregate industries,” and there is no definition in the record of these terms *per se*,²³ but the record establishes that the mineral and aggregate industries fall under the rubric of “mining.” As noted above, Applicant made of record pages from the website of the IMAA trade association.²⁴ One page cited by Applicant lists a new member company

²³ A Wikipedia entry entitled “Aggregate Industries” discusses a United Kingdom company with that name that supplies heavy building materials, not the “aggregate industry[y]” referenced in Applicant’s identification of services. December 1, 2017 Office Action at TSDR 44-47.

²⁴ May 9, 2018 Response to Office Action at TSDR 28-29.

that falls under the website's "Drilling" category of members whose founders are described as having "36 years of combined drilling experience in the construction and mining field."²⁵ The other page states that IMAA "members produce crushed stone, sand, gravel or slag, sell mining equipment, haul material, and much, much more."²⁶ The website suggests that companies that distribute mining equipment, including drilling equipment, consider themselves to be part of the "mineral and aggregate industries" referenced in Applicant's identification of services.

The Wikipedia "Mining" entry in the record defines "mining" as "the extraction of valuable minerals or other geological materials from the earth, usually from an orebody, lode, vein, seam, reef, or placer deposit,"²⁷ and states that "[o]nce the mineral is extracted, it is often then processed,"²⁸ and that such processing involves "the mechanical means of crushing, grinding, and washing that enable the separation (extractive metallurgy) of valuable metals or minerals from their gangue (waste materials)."²⁹ The entry also states that "[l]arge drills are used to sink shafts, excavate stopes, and obtain samples for analysis," and that "[p]rocessing plants

²⁵ *Id.* at TSDR 28.

²⁶ *Id.* at TSDR 29.

²⁷ May 30, 2018 Final Office Action at TSDR 2. The GLOSSARY OF MINING TERMINOLOGY defines "mineral" as "[a]n inorganic compound occurring naturally in the earth's crust, with a distinctive set of physical properties, and a definite chemical composition." *Id.* at TSDR 31. We take judicial notice that "aggregate" in its adjective form means "composed of mineral crystals of one or more kinds or of mineral rock fragments" and in its noun form means "a rock composed of mineral crystals of one or more kinds or of mineral rock fragments: an aggregate rock." MERRIAM-WEBSTER DICTIONARY (merriam-webster.com), last accessed on January 7, 2020.

²⁸ May 30, 2018 Final Office Action at TSDR 8.

²⁹ *Id.*

utilize large crushers, mills, reactors, roasters and other equipment to consolidate the mineral-rich material and extract the desired compounds and metals from the ore.”³⁰

Applicant agrees in its appeal brief that the Wikipedia entry shows that “mining is a large and expansive process that covers many different goods and services,” 6 TTABVUE 15,³¹ and in its reply brief, Applicant describes the goods that it currently distributes to companies in the mineral and aggregate industries as “specialized aggregate **mining equipment.**” 9 TTABVUE 7 (emphasis added).³² The record as a whole establishes that the mining industry is effectively synonymous with, or at a

³⁰ *Id.*

³¹ Applicant criticizes the Examining Attorney’s use of the Wikipedia entry because “purchasers in the mining industry and the mineral industry are not going to be viewing Wikipedia or a glossary to determine the source of the specialized equipment that is needed,” 9 TTABVUE 7, and because Wikipedia is inherently unreliable. *Id.* at 7 n.1. Applicant’s first critique misses the point. We certainly agree that purchasers would not use Wikipedia as a catalog, but the entry is not offered for that purpose. It discusses the nature of mining, and is useful in understanding the scope of the phrase “mineral and aggregate industries” in Applicant’s identification of services. Applicant notably does not challenge the “accuracy of the particular Wikipedia information” per se. *In re IP Carrier Consulting Grp.*, 84 USPQ2d 1028, 1032 (TTAB 2007). As to Applicant’s second critique, we recognize the limitations inherent in Wikipedia evidence, but have long held that we will consider it for whatever probative value it has if the non-offering party “has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information.” *Id.* The Examining Attorney submitted the Wikipedia entry in the May 30, 2018 Final Office Action, and Applicant could have responded to it by filing a request for reconsideration. *Cf. i.am.symbolic*, 127 USPQ2d at 1633 n.6 (Board considered Wikipedia evidence submitted with a denial of a request for reconsideration because Applicant had the opportunity to rebut it by requesting remand to submit rebutting evidence).

³² Applicant argues that drills “would not be used in the aggregate or mineral industry,” 6 TTABVUE 15, citing Mr. Zebroski’s statement that a “customer looking to do directional drilling would not be confused by crushing, conveying, or screening aggregate or mineral products and believe them to be one and the same thing.” Zebroski Decl. ¶¶ 15-16. The cited testimony does not speak to the meaning of “the aggregate or mineral industry,” and, in any event, the relevant test for relatedness “is not whether consumers would be likely to confuse [the] goods, but rather whether they would be likely to be confused as to their source.” *In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018).

minimum subsumes, the mineral and aggregate industries. There is no contrary evidence in Mr. Zebroski's declaration or elsewhere in the record that the mineral and aggregate industries and mining are distinct, mutually-exclusive industries.

b. The "Industrial Machinery and Parts Therefor" Used in the Mineral and Aggregate Industries

Applicant acknowledges that the drilling equipment identified in the cited registration and the "crushing, conveying, and screening aggregate wear parts and machines" that it distributes, Zebroski Decl. ¶ 2, "are *generally related* industrial equipment," 6 TTABVUE 15 (emphasis in original), and that they are "tangentially related under a broad definition of the mining industry." *Id.* Applicant thus concedes some degree of relatedness between the goods identified in the cited registration and the "specialized aggregate mining equipment" that Applicant actually distributes.

As discussed above, however, Applicant cannot limit the scope of its distributorship services to "specialized aggregate mining equipment" where its application broadly identifies its services as the distribution of "industrial machinery and parts therefor." *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). In the absence of a limitation of the "industrial machinery and parts therefor" to "specialized aggregate mining equipment" or "crushing, conveying, and screening aggregate wear parts and machines," we must presume that the identified "industrial machinery and parts therefor" include not just the goods that Applicant actually distributes, but all "industrial machinery" and parts used by companies in the mineral and aggregate industries. *Cf. Detroit Athletic Co.*, 128 USPQ2d at 1051 (holding that the clothing

sold through applicant's retail stores featuring sports team related clothing involved a subset of the clothing identified in the cited registration); *Hewlett-Packard*, 62 USPQ2d at 1004-05 (applicant's service of "electronic transmission of data and documents via computer terminals" found to be closely related to registrant's "facsimile machines, computers, and computer software" on the basis of the breadth and nature of the pertinent identifications alone).

The record shows that a broad range of "industrial machinery," including drills, is used in the "mineral and aggregate industries." The IMAA website, which contains a link to members in the "Drilling" category and lists one such company, indicates that drilling equipment is sold to companies in those industries. The Wikipedia entry regarding mining, and the GLOSSARY OF MINING TERMINOLOGY, each discusses both drills and various forms of processing equipment,³³ and we reproduce below one of the third-party webpages in the record, which lists a variety of types of "mining equipment" and includes links to both "Drills" and "Processing" products:

³³ Consistent with Applicant's characterization of the "crushing, conveying, and screening aggregate wear parts and machines" that it distributes as "specialized aggregate mining equipment," the GLOSSARY OF MINING TERMINOLOGY defines a "conveyor" as "[a]n apparatus for moving material from one point to another in a continuous fashion," May 30, 2018 Final Office Action at TSDR 24, and a "crusher" as a "machine for crushing rock or other materials." *Id.* at TSDR 25.

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We find, on the basis of the record as a whole, including the respective identifications of goods and services, that the “industrial machinery and parts therefor” in Applicant’s identification of distributorship services encompass the drilling equipment identified in the cited registration. Accordingly, “while the goods and services are not identical, they substantially overlap, which weighs in favor of finding a likelihood of confusion.” *Detroit Athletic Co.*, 128 USPQ2d at 1051.³⁵ The second *DuPont* factor thus supports a finding of a likelihood of confusion.

³⁴ December 1, 2017 Office Action at TSDR 9.

³⁵ Applicant cites a number of cases involving identical or very similar marks in which courts or the Board found no likelihood of confusion even though the subject goods were used “in a common industry.” 6 TTABVUE 14 (quoting *In re Fesco, Inc.*, 219 USPQ 437 (TTAB 1983)). Applicant relies most heavily on *Fesco*, in which the Board found no likelihood of confusion between the applied-for mark FESCO and design for distributorship services in the field of farm equipment and machinery and the registered mark FESCO for various forms of fertilizer processing equipment and machinery. *Fesco* is readily distinguishable because the Board found in that case that it was “not dealing with goods or services which overlap or

With respect to the third *DuPont* factor, the Examining Attorney argues “that the applicant’s identified services and the registrant’s identified goods travel in the same channels of trade.” 8 TTABVUE 5. Applicant does not address channels of trade beyond a reference to “overlapping distribution channels.” 9 TTABVUE 7. We have found above that the goods identified in the cited registration may be offered in the course of rendering the distributorship services identified in the application, and to that extent the trade channels overlap and the goods and services reach the same consumers. *See Detroit Athletic Co.*, 128 USPQ2d at 1052-53. The third *DuPont* factor also supports a finding of a likelihood of confusion. *Id.* at 1053.

C. Purchaser Sophistication and Purchase Conditions

“The fourth *DuPont* factor considers ‘[t]he conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.’” *Stone Lion*, 110 USPQ2d at 1162 (quoting *DuPont*, 177 USPQ at 567). Applicant argues that “[b]oth Applicant’s Services and Registrants’ Goods are purchased by highly sophisticated, professional purchasers who exercise a great deal of care in their

move in common trade channels,” *id.*, because “Applicant’s distributorship services are clearly limited to ‘farm equipment and machinery’ and the cited registrant’s [goods] encompass only ‘machinery for ‘processing’ goods, i.e., production machinery.” *Fesco*, 219 USPQ at 438. The Board found that the registrant’s goods “would not likely be purchased or used by or otherwise come to the attention of those who sell or those who purchase or use farm equipment,” *id.*, because purchasers and users of farm equipment would purchase fertilizer, the goods produced by the registrant’s machinery, not the machinery itself. The Board concluded that the goods that were the subject of the distributorship services identified in the application and the goods that were identified in the registration were mutually exclusive. *Id.* The record here shows that the drilling equipment identified in the cited registration and the “industrial machinery and parts therefor” that are the subject of Applicant’s distributorship services are not mutually exclusive, but instead are both used by companies in the mineral and aggregate industries to which Applicant provides its services.

purchases and are thus unlikely to be confused as to the source of their purchases.” 6 TTABVUE 15. Applicant cites portions of Mr. Zebroski’s declaration that state as follows:

[T]he buyers of our products are large scale commercial and industrial operations who are extremely sophisticated. Many of our jobs are ‘bid out’ and the purchasers will review several offers or bids before making the informed decision to purchase our products. The products sold are extremely expensive and it is highly unlikely a customer would be confused because of their sophistication and the costs of the products.

Zebroski Decl. ¶ 15.

Additionally, the sophisticated drilling kits of [Registrant] are also incredibly expensive and costs [sic] tens of thousands of dollars to rent and millions to buy. The buyers of these products do not make their purchases hastily. The buyers exercise diligent thought and conduct research prior to purchasing the products. Based upon the information I have reviewed, [Registrant] also offers quotes for its products and goes through the bidding process before a customer makes a purchase.

Zebroski Decl. ¶ 17.

The Examining Attorney’s primary response is that “the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion.” 8 TTABVUE 5. He does not dispute the substance of Mr. Zebroski’s testimony.³⁶

³⁶ The Examining Attorney also argues that Applicant’s “only evidence that its customers are sophisticated comes in the form of the [Zebroski] declaration” and that “[s]uch limited evidence fails to adequately demonstrate consumer sophistication.” 8 TTABVUE 6. We disagree. The nature of “the information I have reviewed” that forms the basis for Mr. Zebroski’s testimony in paragraph 17 regarding Registrant’s alleged bidding and quotation

As discussed above in connection with the second *DuPont* factor, neither Registrant's identification of goods nor Applicant's identification of services contains any restrictions to "large scale commercial and industrial operation" purchasers or goods purchased through a quotation or bidding process, but that does not significantly affect our analysis of the fourth *DuPont* factor. While Mr. Zebroski's testimony regarding the cost of the directional drills and the other "industrial machinery and parts therefor" distributed to the mineral and aggregate industries is not corroborated by evidence in the record, the cost of those goods is obviously considerable, *see In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985), and that fact, coupled with the need to use particular machinery for particular functions in the mineral and aggregate industries, makes it very likely that all purchasers would exercise considerable care in the purchase decision under all circumstances of purchase.³⁷ The fourth *DuPont* factor supports a finding that confusion is not likely.

practices] is unclear, and we accord that testimony little weight, but he clearly has sufficient personal knowledge about Applicant's business to testify competently about its customers.

³⁷ The Examining Attorney cites *Stone Lion*, 8 TTABVUE 5-6, which held that "Board precedent requires the decision to be based 'on the least sophisticated potential purchasers.'" 110 USPQ2d at 1163 (quoting *Gen. Mills, Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 USPQ2d 1584, 1600 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB Jan. 22, 2014)). Applicant argues in its reply brief that the "least sophisticated potential purchaser" standard discussed in *Stone Lion* does not apply here because in that case, the applicant's identification of investment services "were not restricted to only high-dollar investments or sophisticated customers," 9 TTABVUE 8-9, while here "Applicant's services, by their very nature, do not include unsophisticated purchasers." *Id.* at 9. We need not decide whether "the least sophisticated purchaser" standard applies where, as here, all purchase decisions would be made with significant care because in that scenario, even the "least sophisticated" such purchaser would exercise more than average care. *Cf. Primrose Retirement Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) (even though purchasers of senior living services include "families and people in all

D. Concurrent Use Without Evidence of Actual Confusion

The eighth *DuPont* factor “examines the ‘length of time during and conditions under which there has been concurrent use without evidence of actual confusion.’” *Guild Mortg.*, 129 USPQ2d at 1162 (quoting *DuPont*, 177 USPQ at 567). In *Guild Mortg.*, the Federal Circuit reversed the Board’s finding of no likelihood of confusion because the Board “fail[ed] to address Guild’s argument and evidence related to *DuPont* factor 8,” which involved a declaration of Guild’s President and CEO that over a 40 year period of use of Guild’s mark and the cited mark, Guild was aware of no actual confusion and had received no correspondence asserting rights in the cited mark or inquiring about an affiliation between Guild and the owner of the cited mark. *Id.* at 1163. The court held that Guild “presented evidence of concurrent use of the two marks for a particularly long period of time—over 40 years—in which the two businesses operated in the same geographic market—southern California—without any evidence of actual confusion, *id.* at 1163-64, and that because this evidence “weighs in favor of no likelihood of confusion, we do not deem the Board’s error harmless.” *Id.* at 1164.

Mr. Zebroski’s declaration bears some similarities to the declaration in *Guild Mortg.* On the basis of statements made on the Registrant’s website, Mr. Zebroski claims that the Registrant “has been in business since 2002,”³⁸ and he states that

walks of life, at all levels of education and income,” a “decision as important as choosing a senior living community will be made with some thought and research, even when made hastily,” such that the fourth *DuPont* factor supported a finding of no likelihood of confusion).

³⁸ His statement is consistent with the 2002 dates of use claimed in the cited registrations. December 1, 2017 Office Action at TSDR 2-6.

“Applicant has been in business since 1999, and has been using the name [HARDROK] since 2003.” Zebroski Decl. ¶ 9. He further states that “[f]or over 15 years, the marks and companies have co-existed, and I am not aware of a single instance of confusion between the two companies or their respective marks,” Zebroski Decl. ¶ 9, and that to the best of his knowledge, “no one has contacted the Applicant believing Applicant was in fact Hard Rock Horizontal, or affiliated or connection with Hard Rock Horizontal,” and “Applicant has never received any correspondence from Hard Rock Horizontal or been provided with any other indication that Applicant’s mark was unavailable for use.” Zebroski Decl. ¶ 10.

Applicant argues that Mr. Zebroski’s declaration, “although not dispositive, is highly probative” of no likelihood of confusion, 9 TTABVUE 10, but we find that three features of his declaration significantly reduce its probative value.³⁹

First and foremost, the “absence of any reported instances of actual confusion would be meaningful only if the record indicated appreciable and continuous use by [Applicant] of its mark for a significant period of time in the same markets as those

³⁹ Mr. Zebroski’s declaration “is one-sided inasmuch as it provides only [A]pplicant’s experience in the marketplace and not that of [R]egistrant.” *In re Gen. Motors Corp.*, 23 USPQ2d 1465, 1470 (TTAB 1992). The Federal Circuit has held that such “uncorroborated statements of no known instances of actual confusion are of little evidentiary value” with regard to the seventh *DuPont* factor regarding the nature and extent of any actual confusion. *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) (citing *In re Bissett-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973)). In *Guild Mortg.*, however, the Federal Circuit noted that the “*Majestic Distilling* court did not extend this holding to the eighth factor, which it termed one of Majestic’s ‘principal challenges.’” *Guild Mortg.*, 129 USPQ2d at 1163 (quoting *Majestic Distilling*, 65 USPQ2d at 1205). The *Guild Mortg.* court acknowledged the absence of testimony “from the owner of the registered mark or other parties testifying as to the absence of actual confusion,” *id.* at 1164, but found nevertheless that the applicant’s declaration had to be considered in balancing the *DuPont* factors. *Id.*

served by [Registrant] under its marks.” *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Mr. Zebroski states that “[a]s Hard Rock Horizontal’s website indicates, its market is limited to the Southeast United States.” Zebroski Decl. ¶ 6. The website also indicates that Registrant’s main office is located in Winder, Georgia,⁴⁰ which we judicially notice is more than 2,000 miles from Applicant’s address of record in Winnemucca, Nevada.⁴¹ *In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1744 n.4 (TTAB 2016) (taking judicial notice of the locations of the city of Puyallup, Washington and Mount Rainier in the state of Washington). Mr. Zebroski does not establish the geographic scope of Applicant’s business, or show that Applicant has provided its distributorship services to customers in the “Southeast United States” or that its mark has been exposed there through advertising or otherwise. On this record, we cannot find that Applicant and Registrant have ever operated in the same area, which limits, if not eliminates entirely, the opportunity for confusion to occur. *See, e.g., Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) (finding that the absence of evidence of actual confusion was of very little, if any, probative value because, among other reasons, “no evidence was presented as to the extent of [applicant’s] use of [its] mark on the merchandise in question during prior years”); *Gillette Can.*, 23 USPQ2d at 1774 (finding that there was “simply no evidence that the parties’ goods have been sold together in the same locality for a significant period of time so that, if confusion

⁴⁰ May 10, 2018 Response to Office Action at TSDR 16.

⁴¹ August 23, 2017 Application at TSDR 1.

were likely to occur, circumstances have been such that it could be expected to have happened.”); *cf. Guild Mortg.*, 129 USPQ2d at 1164 (noting that the applicant and registrant “operated in the same geographic market—southern California—without any evidence of actual confusion.”). Mr. Zebroski also does not establish that Applicant has rendered its distributorship services on such a large scale that the geographic separateness of the businesses would not be relevant to the exposure of the marks to the same customers. *See Gen. Motors Corp.*, 23 USPQ2d at 1470-71.

Second, Mr. Zebroski states that he has “no knowledge of any facts that indicate there has been, or that there is likely to be, market interface between Applicant and Registrants due to the distinct nature of the respective goods and services.” Zebroski Decl. ¶ 13. As with the geographic separateness of the businesses, the alleged lack of “market interface” causes the absence of any evidence of actual confusion to have little, if any, probative value.

Finally, the 15-year claimed period of simultaneous use of the marks, Zebroski Decl. ¶ 9, is less than half as long as the claimed period of peaceful coexistence in *Guild Mortg.* Given the other issues with Mr. Zebroski’s declaration discussed above, 15 years of simultaneous use of the mark without actual confusion is not probative of no likelihood of confusion. *See In re Azteca Rest. Enters. Inc.*, 50 USPQ2d 1209, 1212 (TTAB 1999) (20 years of simultaneous use of the marks not probative of no likelihood of confusion where parties’ respective restaurants were located in the Pacific Northwest and Chicago); *cf. Gen. Motors Corp.*, 23 USPQ2d at 1470-71 (holding that evidence of the absence of actual confusion for nearly 30 years was probative of no

likelihood of confusion in view of a “confluence of facts,” including large sales of both sets of goods and expansion of the applicant’s use of its mark into the goods identified in the cited registration, which “persuasively point[ed] to confusion as being unlikely.”) On this record, we find that the eighth *DuPont* factor is neutral.

E. Balancing the *DuPont* Factors

The first, second, and third *DuPont* factors support a finding of a likelihood of confusion, as the HARDROCK and HARDROK EQUIPMENT INC. marks are quite similar, Registrant’s HARDROCK mark has not been diluted by third-party uses, and the goods and services, channels of trade, and classes of purchasers at least overlap. The fourth *DuPont* factor cuts the other way because purchasers of the goods and services are sophisticated and would exercise a significant degree of care in purchasing, but the fact “[t]hat the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar [goods and services]. ‘Human memories even of discriminating purchasers . . . are not infallible.’” *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (affirming refusal to register ROPELOK for safety fall protection equipment on basis of registration of ROPELOCK for releasable locking buckles for ropes particularly for industrial purposes) (quoting *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970)). We find on the basis of the evidence on the pertinent *DuPont* factors that the “[s]ophistication of buyers and purchaser care are relevant considerations but are not controlling on this factual record.” *Id.* Consumers

who are familiar with drilling equipment sold under the HARDROCK mark who encounter “industrial machinery and parts therefor” distributed to the mineral and aggregate industries under the HARDROK EQUIPMENT INC. mark are likely to believe that the goods and the distributorship services originate from a single source.

Decision: The refusal to register is affirmed.