

This Opinion is Not a
Precedent of the TTAB

Mailed: October 2, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

—————
Trademark Trial and Appeal Board
—————

In re True Value Company, L.L.C.
—————

Serial No. 88335947
—————

Lindsay M.R. Jones of Merchant & Gould P.C.,
for True Value Company, L.L.C.

Evelyn Kelley, Trademark Examining Attorney, Law Office 127,
Mark Pilaro, Managing Attorney.

—————
Before Bergsman, Shaw, and Johnson, Administrative Trademark Judges.

Opinion by Johnson, Administrative Trademark Judge:

I. Background

True Value Company, L.L.C. (“Applicant”) seeks registration on the Principal Register of the mark MASTER RANCHER, in standard characters (“Applicant’s Mark”), for “footwear” in International Class 25.¹

¹ Filed on March 12, 2019 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intent to use the mark in commerce.

Page references to the application record are to the downloadable .pdf version of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions, and orders on appeal are to the Board’s TTABVUE docket system.

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's Mark, as applied to the goods identified in the application, so resembles the Registered Mark RANCHMASTER, also in standard characters, for "footwear" in International Class 25,² as to be likely to cause confusion.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. We then suspended the appeal pending the filing of a Section 8 Declaration of Continued Use, 15 U.S.C. § 1058(a)(1), by the owner of the Registered Mark.³ After the declaration was timely filed, the appeal resumed. It is fully briefed. We affirm the refusal to register.

II. Likelihood of Confusion

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 or mistake, or to deceive. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative evidence in the record that is relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (cited in *B&B Hardware, Inc. v. Hargis*

² Registration No. 4605257, issued Sept. 16, 2014 [hereinafter the "Registered Mark" or "Registrant's Mark"]. Registrant filed a combined Section 8 and 15 declaration on September 16, 2020.

³ 13 TTABVUE.

Ind., Inc., 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015)); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor for which there is evidence and argument of record. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc'ns., Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the goods or services. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *see 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.”); *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus . . . on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (internal citation omitted)).

A. Similarity of the Marks

We commence with the *DuPont* likelihood of confusion factor which involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). “The proper test 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.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal citation omitted). The focus is on the recollection of the average consumer, who normally retains a general rather than a specific impression of trademarks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971). Because both descriptions of goods are “footwear,” the average purchaser is an ordinary consumer.

Our analysis cannot be predicated on dissection of the involved and cited mark. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). Rather, we are obliged to consider the marks in their entirety. *Id.*; see also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Nonetheless, 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 a consideration of the marks in their entirety. *Stone Lion*, 110 USPQ2d at 1161.

1. The meaning of “master.”

Applicant’s Mark is MASTER RANCHER, whereas Registrant’s Mark is RANCHMASTER. We find the marks highly similar because Applicant has separated the literal elements “ranch” and “master” of Registrant’s Mark, transposed those

elements, and added the suffix “er” to the element “ranch” to create MASTER RANCHER. These differences do not create significantly different meanings or engender significantly different commercial impressions. Where the primary difference between marks is the transposition of the elements that compose the marks, and where this transposition does not change the meaning or overall commercial impression of the marks, we may find the marks to be similar. *See, e.g., In re Wine Soc’y of Am. Inc.*, 12 USPQ2d 1139, 1142 (TTAB 1989) (holding THE WINE SOCIETY OF AMERICA and design for wine club membership services including the supplying of printed materials, and AMERICAN WINE SOCIETY 1967 and design for newsletters, bulletins, and journals, are similar); *In re Gen. Tire & Rubber Co.*, 213 USPQ 870, 871 (TTAB 1982) (holding SPRINT STEEL RADIAL for pneumatic tires, and RADIAL SPRINT for radial tires, are similar).

Applicant asserts that its mark, MASTER RANCHER, is not similar to the cited mark, RANCHMASTER, because the word “master,” as it is used in MASTER RANCHER, is an adjective defined as “having or showing very great skill or proficiency,”⁴ and that “master” describes the quality or a characteristic of a “rancher.” But that is only one possible definition of “master”: Applicant also made of record alternate definitions such as “main; principal,” “a person who has dominance

⁴ 8 TTABVUE 8. Applicant cites this definition of “master,” and we take judicial notice of the particular definition. LEXICO.COM U.S. ENGLISH DICTIONARY POWERED BY OXFORD (2020) (<https://www.lexico.com/en/definition/master>). 8 TTABVUE 29. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

or control of something,” and “a man in charge of an organization or group.”⁵ In a speculative attempt to distinguish the marks, Applicant uses one of the alternate definitions of “master”—“a man in charge of [a particular ranch]”—to argue that the meaning and commercial impressions of RANCHMASTER and MASTER RANCHER are distinct, making confusion therefore unlikely.⁶ However, we cannot base our decision on attorney argument alone. *See Zheng Cai, d/b/a Tai Chi Green Tea Inc. v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005)). The word “master,” as it is used in the Registered Mark, RANCHMASTER, could also evoke images of a greatly skilled or proficient rancher; we have no evidence to the contrary. In fact, on its website, Registrant uses the phrase “master the ranch” when describing its RANCHMASTER footwear, suggesting a meaning of the word “master” similar to the definition Applicant contends applies to the word “master” as it is used in MASTER RANCHER.⁷

2. Applicant fails to meet the legal standard necessary to show that “master” is a house mark or is used for a family of MASTER-formative marks.

In an attempt to further differentiate its mark, Applicant asserts that it uses the word “master” as a house mark, and claims that the use of such house mark not only creates a distinct commercial impression, but also distinguishes Applicant’s mark

⁵ LEXICO.COM U.S. ENGLISH DICTIONARY POWERED BY OXFORD (2020) (<https://www.lexico.com/en/definition/master>). 8 TTABVUE 27, 29. We take judicial notice of these definitions as well.

⁶ 8 TTABVUE 8-9.

⁷ Mar. 10, 2020 Request for Reconsideration After Final Action Denied, TSDR p. 2.

visually and aurally.⁸ First, although Applicant references its MASTER MECHANIC, MASTER ELECTRICIAN, MASTER PLUMBER, MASTER PAINTER, and MASTER TRADESMAN marks in its Appeal Brief,⁹ it fails to make any of those registrations of record or submit any other evidence of such use. Therefore, there is no evidence corroborating the argument. *See In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) (Board declined to take judicial notice of registrations owned by applicant); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208.02 (June 2020). As the Federal Circuit instructs, “[a]ttorney argument is no substitute for evidence.” *Cai*, 127 USPQ2d at 1799 (quoting *Enzo Biochem*, 424 F.3d at 1284).

Alternatively, Applicant asserts ownership of a family of MASTER-formative marks,¹⁰ but to prove the existence of a family of marks, Applicant “must show that its putative family: (1) has a recognizable common characteristic; (2) that is distinctive; and (3) that has been promoted in such a way as to create ‘recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods or services.’” *See J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) (“Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is

⁸ 8 TTABVUE 6, 8-10, 23.

⁹ 8 TTABVUE 8, 22.

¹⁰ 8 TTABVUE 22-23.

indicative of a common origin of the goods.”). As noted above, Applicant has not made such a showing here. Regardless, “a family-of-marks argument is not available to an applicant seeking to overcome a likelihood-of-confusion refusal.” *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1645-46 (TTAB 2009) (citations omitted).

3. The third-party registrations do not change the similar overall commercial impression of the marks at issue here.

Turning to the third-party registrations Applicant proffers, we first note that some of the registrations included in the record are cancelled,¹¹ so they are of no probative value except to show that the registrations issued. *In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1159 (TTAB 2019) (cancelled registrations, abandoned applications, and pending applications are not probative of “consumer perceptions [of the subject marks] in the marketplace”); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006) (expired or cancelled registrations generally are evidence only of the fact that the registrations issued); TBMP § 1208.02.

As to the remaining sixteen sets of registrations (which are for a multitude of goods and services),¹² it is Applicant’s position that the registrations show it is

¹¹ Request for Reconsideration Letter, Jan. 30, 2020, TSDR pp. 27-33, 39-42. In addition, one other third-party registration was registered under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141(f)(a). *Id.* at TSDR pp. 88-90. Third-party registrations that are not based on use in commerce, such as those registered under Section 66(a), or those registered solely under Section 44 of the Trademark Act, 15 U.S.C. § 1126(e), and for which no Section 8 or 71 affidavits or declarations of continuing use have been filed, have very little, if any, persuasive value. See *Calypso Tech., Inc. v. Calypso Capital Mgmt., LP*, 100 USPQ2d 1213, 1221 n.15 (TTAB 2011); *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

¹² 8 TTABVUE 13-22. Only one of the third-party registrations proffered by Applicant includes footwear: RESPECT DEMANDED (standard characters), Reg. 5042848, issued Sept. 13, 2016 for “athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps; athletic uniforms,” in International Class 25.

“common Trademark Office practice to allow transposed marks to coexist with each other in the marketplace the Federal Register [sic]”; therefore, Applicant’s MASTER RANCHER mark can coexist on the register without any likelihood of confusion with the Registered Mark, RANCHMASTER.¹³ We disagree.

As previously discussed, even considering Applicant’s transposition of the literal elements “ranch” and “master,” we find MASTER RANCHER and the Registered Mark, RANCHMASTER, similar in meaning and overall commercial impression. Where the primary difference between marks is the transposition of the elements that compose the marks, and where this transposition does not change the overall commercial impression, there may be a likelihood of confusion. *See, e.g., Wine Soc’y of Am.*, 12 USPQ2d at 1142; *Nationwide Indus.*, 6 USPQ2d at 1884; *Gen. Tire & Rubber*, 213 USPQ at 871.

In addition, although the third-party registrations show the existence of transposed marks on the register, they do not provide a basis for registrability of Applicant’s Mark. *See In re Total Quality Grp., Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999). Each case must be decided on its own merits. *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009). Previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding on the agency or the Board. *In re Davey Prods. Pty*, 92 USPQ2d 1198, 1206 (TTAB 2009).

In view thereof, we find that Applicant’s Mark, MASTER RANCHER, and Registrant’s Mark, RANCHMASTER, when considered in their entireties, are more

¹³ 8 TTABVUE 22.

similar than dissimilar in sight, sound, connotation, and commercial impression. This *DuPont* factor weighs in favor of a finding of likelihood of confusion.

B. Relatedness of the Goods and Channels of Trade

When analyzing the *DuPont* factors on the relatedness of the goods and channels of trade, we look to the identifications in the application and cited registration. *Stone Lion*, 110 USPQ2d at 1162; see *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.”).

The description of goods in both the application and cited registration is “footwear.” The description of goods is identical. As a result, we must also presume that the channels of trade and classes of purchasers for those goods are the same. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). These *DuPont* factors weigh heavily in favor of a finding of likelihood of confusion.

C. Applicant’s Prior Registration

Finally, Applicant owns a prior registration for the mark MASTER RANCHER, used in connection with “gloves,” in International Class 25.¹⁴ For that reason, Applicant argues the mere coexistence of this MASTER RANCHER registration with

¹⁴ Registration No. 5667470, issued Jan. 29, 2019.

Registrant's RANCHMASTER mark shows that consumers can distinguish between the applied-for mark and the Registered Mark, and therefore, confusion is unlikely between them.¹⁵

We consider Applicant's prior registration argument under the thirteenth *DuPont* factor, which relates to "any other established fact probative of the effect of use." See *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1745-46 (TTAB 2018). "Where an applicant owns a prior registration that is over five years old and the mark is substantially the same as in the applied-for application, this can weigh against finding that there is a likelihood of confusion." *Inn at St. John's*, 126 USPQ2d at 1746 (citing *In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012)).

In *Strategic Partners*, the Board addressed the "unique situation" of coexistence of an applicant's existing registration with a cited registration for over five years. In that case, the applicant's applied-for mark, ANYWEAR, was substantially similar to its existing registered mark, ANYWEARS, and identical goods were offered under both marks. The Board, noting that the ANYWEARS mark, registered later in time, had coexisted with the cited registration, ANYWEAR BY JOSIE NATORI (stylized composite design mark), for "jackets, shirts, pants, stretch T-tops and stoles," ultimately held:

Applicant's registered mark, a mark that is substantially similar to the applied-for mark, both covering "footwear," has coexisted with the cited mark for over five years. At this stage, applicant's existing registration is over five years old, and thus is not subject to attack by the owner of the cited registration on a claim of priority and likelihood

¹⁵ 8 TTABVUE 24.

of confusion. *Cf. In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994). We find that these facts tip the scale in favor of applicant and a finding of no likelihood of confusion.

Id. at 1399.

The circumstances here are readily distinguishable from those in *Strategic Partners*. Specifically, Applicant’s registration—which is for gloves, not footwear—is not even two years old. *Compare Inn at St. John’s*, 126 USPQ2d at 1745-46 (Board distinguished the circumstances of the appeal from *Strategic Partners* because “Applicant’s applied-for mark — 5IVE STEAKHOUSE and design — moves closer to the cited registration — 5IVESTEAK and design — than the mark in Applicant’s prior registration — 5IVE RESTAURANT and design — rendering the new mark more similar in appearance, sound, and meaning to Registrant’s mark.”). Accordingly, and in contrast to our finding in *Strategic Partners*, we find that Applicant’s prior registration does not “tip the scale” and obviate a likelihood of confusion between Applicant’s Mark and Registrant’s Mark.

III. Conclusion

After considering all evidence and arguments bearing on the relevant *DuPont* factors, including evidence and arguments that we have not specifically discussed herein, we find confusion is likely between Applicant’s mark, MASTER RANCHER, and the Registered Mark, RANCHMASTER.

Decision: The refusal to register Applicant’s Mark, MASTER RANCHER, is affirmed.