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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91222920
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No.: 86/377,838

For the mark: **TOOL USA.COM**

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Standard Tools and Equipment, Co.)	
Opposer,)	
)	
v.)	Opposition No. 91222920
)	
Dropship, LLC)	
Applicant.)	

**APPLICANT’S RESPONSE IN OPPOSITION TO OPPOSER’S MOTION FOR
SUMMARY JUDGMENT**

I. INTRODUCTION

The following is the Response in Opposition of Dropship, LLC (“Applicant”), owner under the trademark application Serial No. 86/377,838 for the mark TOOL USA.COM (the “Applicant’s mark”), by and through its counsel J. Curtis Edmondson, to the Motion for Summary Judgment (“Motion”) of Standard Tools and Equipment Co. (“Opposer”).

As shown below, Opposer is not entitled to summary judgment because there are genuine issues of material fact in this dispute.

II. STATEMENT OF FACTS

On August 26, 2014, Applicant filed U.S. Trademark Application Serial No. 86/377,838 with the U.S. Patent and Trademark Office (“USPTO”) on the Principal Register for the TOOL USA.COM trademark, using TEAS Plus. *Declaration of J. Curtis Edmondson*, at ¶ 3, attached as

Exhibit “1”, see also Applicant’s application printout from TSDR attached as **Exhibit A** to Mr. Edmondson’s Declaration. The description of goods was later amended to “manually operated hand tools, namely, hammers, trowels, sanding wire wool, drill accessories, namely, bits for hand drills” in International Class 8. *Edmondson Decl.* at ¶ 3. The trademark is shown below.



On June 2, 2015, the Examining Attorney approved Applicant’s trademark application for publication. *Edmondson Decl.* at ¶ 4. On July 7, 2015, the USPTO published Applicant’s application for opposition. *Edmondson Decl.* at ¶ 5. On July 23, 2015, Opposer filed a Notice of Opposition with the Trademark Trial and Appeal Board. Applicant answered on September 1, 2015, denying all relevant claims and raising a series of defenses.

Applicant’s domain name www.toolusa.com was first created on September 23, 1999. *Declaration of R. Baheti* at ¶ 4, attached as **Exhibit “2”** see also printout from domain name registry search website attached as **Exhibit A** to Mr. Baheti’s Declaration. Since as early as 2002, Applicant has utilized the domain name in connection with its business. *Id.* at ¶ 5. In the early stages of its business, Applicant’s website was used in the retail services of a limited set of hardware goods to its customers. *Id.* Over the next several years, Applicant’s inventory expanded and diversified while the core of the business sales centered around the retail of hand tools. *Id.* see also printout from California Secretary of State printout of Dropship, LLC business registry website attached as **Exhibit B** to Mr. Baheti’s Declaration.

Beginning in 2008 and from that date forward, Applicant has consistently labelled its hand tools inventory with TOOL USA.COM. *Id.* at ¶ 6 *see* also printout of Applicant's specimen from its federal trademark application, attached as **Exhibit C** to Mr. Baheti's Decl..

Notably, Applicant and its employees have never received an inquiry or contact from any person or entity seeking the goods or services of Opposer or requesting any goods from Applicant of the type and nature provided by Opposer in its business operations. *Id.* at ¶ 7.

On October 17, 2014, Opposer filed an application seeking to register the standard character mark TOOLS USA on the Principal Register. The USPTO assigned the application serial number 86/426,730. Opposer's mark is pending for "on-line retail store services featuring equipment for automotive, body shop, and painting industries" in International Class 35. Opposer disclaims the exclusive right to use the word TOOLS. Opposer's application is suspended pending the outcome of this dispute.

III. ARGUMENT

A. Standard Of Review

In a motion for summary judgment, the moving party has the burden of establishing that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986). A genuine dispute with respect to a material fact exists if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving party. *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 850, 23 USPQ2d 1471 (Fed. Cir. 1992). All doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 2020, 22 USPQ2d 1542 (Fed. Cir. 1992). In deciding a summary judgment motion, the

function of the Trademark Trial and Appeal Board is not to try issues of fact, but to determine if there are any genuine disputes of material fact to be tried. TMBP § 528.01; *see Dyneer Corp. v. Automotive Products, plc*, 37 USPQ 1251, 1254 (TTAB 1995).

For its part, in order to have the opportunity to submit proofs at trial, Applicant need only show that, on the evidence of record, a reasonable fact finder could resolve the matter in its favor. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 850, 23 USPQ2d 1471, 1472-73 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 202, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992); *see also Visa Int'l Serv. Ass'n v. Life-Code Sys., Inc.*, 220 USPQ 740, 742 (T.T.A.B. 1983) (on a summary judgment motion, “nonmoving party is not required to adduce evidence sufficient to prove its case . . .”; it need only show “that there is a genuine issue as to a material fact and that, therefore, there is a need for a trial”). The evidence should be viewed in a light most favorable to Applicant Dropship, LLC as the nonmovant, and all justifiable inferences should be drawn in Applicant’s favor. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 767, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 970 F.2d at 850, 23 USPQ2d at 1472.

In its Motion, Opposer claims it has priority in its use of its TOOLS USA Marks and that a likelihood of confusion exists between Applicant’s use of its mark TOOL USA.COM and Opposer’s use of TOOLS USA. (*Motion*, at 5-17). For the reasons given below, Opposer is not entitled to summary judgment on either claim; its Motion must be denied.

B. There Are Disputed Facts Regarding Priority

Turning to the issue of priority, Opposer has not shown by competent evidence, use of its mark prior to the earliest date upon which Applicant can rely; in this case, no earlier than 2007, which is Applicant’s date of first use. *See David Crystal, Inc. v. Estee Lauder, Inc.*, 167 USPQ

411 (TTAB 1970), *aff'd*, 476 F.2d 1373, 177 USPQ 461 (CCPA 1973); and *Levi Strauss & Co. v. R. Josephs Sportswear, Inc.*, 36 USPQ2d 1328 (TTAB 1994). Opposer bears the burden of establishing its priority. Section 2(d) of the Trademark Act bars registration if a conflicting mark has been “previously used in the United States by another and not abandoned.” As noted in its suspended application, Opposer claims first use anywhere and first use in commerce prior to Applicant’s date of first use. In this proceeding, Mr. Kestler, in his Declaration to the *Motion*, declares that “Standard Tools has been selling equipment and tools under the TOOLS USA trademark since at least 1996” *See Kestler Declaration to the Motion* at ¶ 6. Mr. Kestler further declares that Standard Tools “continually and without interruption used the TOOLS USA trademark as a source identifier for its goods and services” and also makes a statement about prior use dating back to 1985 through the acquisition of “Tools USA and Equipment Company.” *Id.* at ¶ 7 and ¶ 8.

In the instant case, Applicant submits that Opposer’s evidence of first use(s) is characterized by contradictions, inconsistencies or indefiniteness. Further, Mr. Kestler’s pertinent statements are not accompanied by documentary evidence. Instead, Opposer infers, under *Centraz* prior federal trademark registrations can be proffered as evidence of priority or at least as demonstrations to establish as much. *Motion*, at 6.

One of such Opposer’s registered trademarks (U.S. Trademark Registration No. 2,011,200 for the standard character mark TOOLS USA in Class 16, in connection with the goods for “equipment catalogs for vehicle repair shops” is a supplemental registration. This mark is merely descriptive and there is no evidence of secondary meaning offered in this proceeding. Its use for the goods as described cannot be used as evidence of first use for Opposer’s

suspended application because it is used in a different classification under a different description of goods or services.

The second of Opposer's registrations (U.S. Trademark Registration No. 2,041,542 for the stylized and design mark TOOLS USA in Class 16, on the Principal Registrar, in connection with the goods for "equipment catalogs for vehicle repair shops"), also cannot be used as evidence of first use for Opposer's suspended application. Again, as above, this registered trademark's use is identified as an equipment catalog, which can only be considered as ancillary to retail services.

Opposer claims ownership of a common law trademark (the "Banner Trademark") with a date of first use since at least the end of 1999. *Kestler Declaration to the Motion* ¶ 13; see **Exhibit A** to *Kestler Decl.* Applicant submits the Banner Trademark is not a mark. Rather, it is a designation that fails to function as trademark. The Trademark Act does not provide for registration of trade names. *See In re Letica Corp.*, 226 USPQ 276, 277 (TTAB 1985).

Applicant submits that a question of fact exists as to whether Opposer's Banner Trademark would be perceived by purchasers and prospective purchasers as a trade name serving to identify Opposer as a business entity (or a fictitious business entity under Standard Tools and Equipment Co.) rather than as a mark which identifies and distinguishes Opposer's goods and/or services from those of others. *See holding in In re Diamond Hill Farms*, 32 USPQ2d 1383, 1384 (TTAB 1994).

Accordingly, Applicant respectfully submits that there are genuine issues of fact regarding superior priority sufficient to preclude summary judgment.

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C. Opposer Cannot Show A Likelihood Of Confusion.

An examination of the factors set forth in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357; 177 USPQ 563 (CCPA 1973) reveals unresolved issues of material fact, precluding Summary Judgment in Opposer's favor. Opposer argues, in this case, that "[O]f these factors, the most important are (1) the similarities of the marks in their entireties as to appearance, sound, connotation, and commercial impression; (2) the relatedness of the goods or services as described in the application and registration(s); (3) the similarity of established, likely-to-continue trade channels viewed in their entireties as to overall appearance and commercial impression; and (4) the degree of actual consumer confusion. *See Motion*, page 6, *citing See generally Du Pont*, 177 USPQ at 567. However, Applicant submits, in this case, that these four Du Pont factors are not necessarily the most important, at least relative to the other nine Du Pont factors and the analysis under *Du Pont* as a whole.

As stated in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q 563 (CCPA 1973):

The ultimate question of the likelihood of consumer confusion has been termed a question of fact. If labeled a mixed question or one of law, it is necessarily drawn from the probative facts in evidence. As so often said, each case must be decided on its own facts. There is no litmus rule which can provide a ready guide to all cases.

Id. at 1361 (citations omitted).

Applicant takes the position that the many questions of fact here preclude summary judgment for the Opposer. TMBP §528.01; *See Dyneer Corp.*, 37 USPQ at 1254. Still, even if the matters of record allow a likelihood of confusion analysis, (a) the relevant factors favor Applicant; and (b) Opposer's evidence fails to adequately support its Motion.

The following are the thirteen Du Pont factors:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i.e. impulse vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, family mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark:
 - (a) a mere consent to register or use.
 - (b) agreement provisions designed to preclude confusion; i.e. limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration, and goodwill of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, i.e. whether *de minimis* or substantial.

(13) Any other established fact probative of the effect of use.

In re E.I. du Pont de Nemours & Co., 476 F.2d at 1361.

While it is true that the Board may focus on less than the full thirteen factors in a likelihood of confusion analysis (*Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557 (Fed. Cir. 2001)), Applicant does not fully agree with Opposer's conclusory statements as to which factors should be used to conduct the analysis. *Motion* pgs. 8-17 in which Opposer focuses on factors (1), (2), (3), and (7), only. Applicant submits, in this case, the remainder of the thirteen Du Pont factor ((4), (5), (6), (8), (9), (10), (11), (12), and (13)) are equally relevant, in order to properly conduct a likelihood of confusion analysis.

1. There Are Disputed Facts Regarding The Dissimilarity Of The Marks In Terms Of Appearance, Sound, Connotation, And Commercial Impression

While two marks may share a common word, courts have held that the inclusion of additional words is sufficient to avoid a likelihood of confusion. *Inc. Publ. Corp. v Manhattan Magazine*, 616 F. Supp. 370, 379–80 (S.D.N.Y. 1985) (holding MANHATTAN INC. not confusingly similar to INC. because the longer word “Manhattan exercises a visual dominance”); *Express Lane Limited Partnership v. Harold Scott Lanes*, 1990 U.S. Dist. LEXIS 16606, *11–12 (E.D. Wash. 1990) (holding that the inclusion of the additional words MUFFLER & BRAKE reduced the similarity in appearance between EXPRESS LANE and EXPRESS LANE MUFFLER & BRAKE); *First Sav. Bank v. First Bank Sys.*, 101 F.3d 645, 653 (10th Cir. 1996) (holding that FIRSTBANK and FIRSTBANK SYSTEM are not phonetically similar due to the inclusion of the additional word SYSTEM); *In re Bed & Breakfast Registry*, 791 f.2D 157 (Fed. Cir. 1986) (holding BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL not confusingly similar). In the instant case, the marks share the common

word, USA and the word, TOOL and the plural form, TOOLS. Still, Applicant's TOOL USA.COM mark is sufficiently different in terms of appearance from Opposer's applied-for mark, U.S. Trademark Application No. 86/426,730 for the standard character mark, TOOLS USA, to obviate any likelihood of confusion. Immediately upon viewing the marks, it is conspicuous that Applicant's mark consists of four words with two in a column configuration and having a stylized "TOOL" and "USA" while Opposer's mark in its application has no stylization. This creates a visual distinction based on the look of the parties' respective marks. The look of the marks is something that is memorable and becomes imprinted in consumers' minds.

Applicant's mark includes other elements that differentiate the mark from Opposer's registered marks, too. The terms, "dot com" (.COM) are not the sole distinction. The design that accompanies Applicant's mark, as well as the colors associated with the word, USA and the fonts chosen for Applicant's mark will be remembered or noted by the purchasing public to suggest a different source of goods than that of the Opposer.

In *Packman v. Chi Tribune*, where it was held that "although the words on the parties' products are the same, the words' appearances do not resemble each other and are not likely to cause confusion. Different packaging, coloring and labeling can be significant factors". *Packman v. Chi Tribune*, (267 F3d. 628 60 U.S.P.Q 2d 1245, 1255). Applicant's stylized mark has both visual and oral facets and with such marks there are "no general rules as to whether letters or design will dominate". (*In re Electrolyte Labs, Inc.*, 929 F2d 645, 647, 16 USPQ 2d 1239, 1240).

Under TTAB precedent, the marks are to be compared in their entirety, *In re Hearst Corp.*, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992) (holding that the TTAB erred in ignoring the term "girl" in the mark VARCAS GIRL to find it confusingly similar to the mark VARGAS);

Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399 (CCPA 1974) (holding that the TTAB erred in comparing “FIA” and “FIT” apart from the marks in their entireties to find confusion likely). Likewise, a composite mark should also be evaluated in its entirety, particularly where, as here, the non-similar portions of the mark are dominant portions. See, e.g. *In re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 646-647 (Fed. Cir. 1990) (where the Examining Attorney refused to register the marks K+ and Design and K+EFF, for similar goods, the Court held that “the TTAB erred in its dominant focus on the K+ in both marks,” particularly in light of the design component of the applicant’s composite mark.); *Rite Aid Corp. v. Rite-Way Discount Corp.*, 508 F.2d 828 (CCPA 1975) (It is improper to dissect a composite mark “since the visual impression likely to be remembered by purchasers will include the design, as well as the words.”).

Applicant respectfully submits that there is no likelihood of confusion due to the appearance and commercial impression of the marks while, at a minimum, states that there is at least a genuine issue of fact regarding whether the dissimilarity of the appearance, sound, connotation, and overall commercial appearance of the marks is sufficient to obviate a likelihood of confusion.

2. There Are Disputed Facts Regarding The Dissimilarity Of The Goods

The second Du Pont factor considers the similarity or dissimilarity and nature of the goods and services provided by the parties. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). If the goods and services offered are dissimilar, there is less likelihood of confusion. *Miss Universe LP, LLLP v. Community Marketing, Inc.*, 82 USPQ2D 1562, 1569 (TTAB 2007). In fact, when the goods and services are sufficiently dissimilar, even identical marks may not cause confusion. *America’s Best Franchising, Inc. v. Abbott*, 106

USPQ2d 1540, 1550 (TTAB 2013).

In the instant case, Applicant's mark is pending for "manually operated hand tools, namely, hammers, trowels, sanding wire wool, drill accessories, namely, bits for hand drills" in International Class 8. Applicant labels inventory for retail with TOOL USA.COM for source identification associated with the goods. *Baheti Decl.* at ¶ 6.

Opposer's applied-for services, on the other hand, are not related to Applicant's goods. *Id.* Opposer claims it uses the applied-for trademark, in connection with "on-line retail store services featuring equipment for automotive, body shop, and painting industries" in International Class 35. As such, the products are actually quite dissimilar and intended for different consumers (as discussed later). Accordingly, Applicant respectfully submits that there are genuine issues of fact regarding the dissimilarity of the parties' goods sufficient to preclude summary judgment.

3. There Are Disputed Facts Regarding The Dissimilarity Of Trade Channels

The third Du Pont factor considers the similarity or dissimilarity of the parties' respective trade channels. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). In this regard, if two marks travel through different trade channels, then the relevant public is unlikely to be confused. *Id.*; *Allergan, Inc. v. ATA Medical International, Inc.*, 2014 TTAB LEXIS 391, *16 (TTAB 2014) (different trade channels weighed in Applicant's favor); *NBC Fourth Realty Corp. v. Peavey Electronics Corp.*, 1997 TTAB LEXIS 519, *12 (TTAB 1997). A trade channel is how a good or service travels from the provider to the ultimate user or consumer. *Id.*

In the present case, Applicant's TOOL USA.COM branded goods travel through trade channels that are completely different from the trade channels used by Opposer, whose services

are directed to automotive industry businesses, such as auto body shops and auto body paint shops. Moreover, because Applicant does not, and will not, sell directly to auto body shops, it is unlikely for automotive industry professionals to accidentally or mistakenly purchase Applicant's product instead of Opposer's services for the retail of third-party, nationally branded products. *Baheti Decl.* at ¶ 8. As a result, the parties' use of distinct and separate trade channels obviates any likelihood of confusion. At a minimum, Applicant submits that there are genuine issues of fact relating to this Du Pont factor that preclude summary judgment.

4. There Are Disputed Facts Regarding The Conditions Under Which And The Buyers To Whom Sales Are Made

The fourth Du Pont factor considers the conditions under which and the buyers to whom sales are made (i.e., impulse versus careful, sophisticated purchasing). *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). If the goods at issue are being sold to unsophisticated purchasers or if the goods are typically impulse purchasers, then that weighs in favor of likelihood of confusion. *Board of Regents v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1193 (TTAB 2014) ("Purchaser sophistication may tend to minimize likelihood of confusion."). However, if the goods at issue are being sold to sophisticated purchasers or if the goods are purchased in a careful manner, then that weighs against a likelihood of confusion. In this case, Opposer's services are provided to sophisticated purchasers and any such purchases of the nationally branded type of goods offered by Opposer are purchased in a careful manner. Opposer directly targets businesses in the automotive industry. As such, there is a recognizable difference in the sales process to the purchasing public between a service offered by the Opposer and goods offered for retail by the Applicant, such that customers for each of the parties would not

experience consumer confusion. This Du Pont factor weighs against a likelihood of confusion. At a minimum, Applicant submits that there are disputes of fact precluding summary judgment.

5. The Fame Of Opposer's Mark Or Lack Thereof Favors Applicant

The fifth Du Pont factor considers the fame of opposer's mark. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). If the opposer's mark is famous, then this factor weighs in favor of opposer. *Id.* Otherwise, if the opposer's mark is not famous, then this factor weighs in favor of applicant. *Id.*

In order to be famous, a mark must be a household name. *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 875 (9th Cir. 1999); *Milbank Tweed Hadley & McCloy LLP v. Milbank Holding Corp.*, No. 06-187, 2007 U.S. Dist. LEXIS 97934, *11-12 (C.D. Cal. Feb. 23, 2007); *Thane Int'l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 911 (9th Cir. 2002). In other words, a "mark [must be] practically a household name, of the likes of such giants of branding as Exxon, Kodak, and Coca-Cola." *It's A 10, Inc. v. Beauty Elite Group, Inc.*, No. 13-60154, 2013 U.S. Dist. LEXIS 179596, *22 (S.D. Fla. Dec. 23, 2013).

Here, Opposer has not submitted any evidence proving its trademarks are famous. Accordingly, the Board should conclude Opposer's marks have not and will not ever achieve fame due to the marks' high level of descriptiveness. This fifth Du Pont factor weighs in Applicant's favor and against any likelihood of confusion.

6. There Are Disputed Facts Regarding The Number And Nature Of Similar Marks In Use

The sixth Du Pont factor considers the number and nature of similar marks in use on similar goods. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). If similar marks for similar goods exist, then this weighs against a finding of likelihood of

confusion. When a mark exists in a crowded field, the public is presumed to be able to distinguish the mark from other marks that may have only minor differences. *King Candy Co. v. Eunice King's Kitchen Inc.*, 182 USPQ 108 (C.C.P.A. 1974) (“confusion is unlikely because the marks are ... so widely used that the public easily distinguishes slight differences in the marks as well as differences in the goods ...”); *Jupiter Hosting Inc. v. Jupitermedia Corp.*, 76 USPQ2d 1042 (N.D. Cal. 2004); *In re Hamilton Bank*, 222 USPQ 174, 179 (T.T.A.B. 1984). Pursuant to *In re E.I. duPont de Nemours & Co.*, the “number and nature of similar marks in use on similar goods” must be taken into account when determining whether a likelihood of confusion exists. 476 F.2d 1357 (C.C.P.A. 1973).

In the instant case, TOOLS USA is part of a relatively crowded field. There are several other marks registered and applied for that include the word TOOL, TOOLS, and USA, including Applicant’s mark. *See Edmondson Decl.*, ¶ 6, *see also* Applicant’s printout of USPTO database page demonstrating examples of search results for the words TOOL(S) and USA attached as **Exhibit B** to Mr. Edmondson’s Declaration.

Accordingly, because the term TOOL(S) and USA are part of a crowded field of marks, the purchasing public is aware of the existence and use of multiple marks containing the term TOOL(S) and USA. Applicant’s TOOL USA.COM mark is just as, if not more, distinguishable from Opposer’s TOOLS USA marks as the many of the already co-existing TOOL(S) USA marks shown in **Exhibit B** from *Edmondson Decl.*, ¶ 6. In sum, consumers are conditioned to distinguish even slight differences between such marks in a crowded field, and there is no likelihood of confusion between Applicant’s mark and Opposer’s mark. At a minimum, Applicant respectfully submits that there is at least a genuine dispute of fact as to whether the existence of a crowded field obviates a likelihood of confusion.

7. Actual Confusion Is Not A Factor Despite Opposer's Claims

Opposer claims that numerous inquiries have been made by the purchasing public dating back to at least 2014 concerning actual confusion. Opposer offers only three documented incidences in the Motion. Applicant and its employees have never received an inquiry or contact from any person or entity seeking the services of Opposer or requesting any goods from Applicant of the type and nature provided by Opposer in its business operations. *Baheti Decl.* at ¶ 7. Moreover, Opposer does not provide competent evidence in support of its claim. Opposer's evidence is alternatively hearsay, does not involve the relevant purchasing public, or is merely a single instance and does not adequately support the Motion.

Opposer's "evidence" comes in the form of two packing slips and a "complaint" from a customer of Applicant. The packing slips are attached to Mr. Kestler's Declaration. Neither falls within 37 CFR § 2.122(e) as self-authenticating and neither is properly authenticated by affidavit or declaration as to the nature, source, and date of the materials. TMBP § 528.05(e). Applicant objects to the evidence as incompetent and irrelevant.

Concerning the "complaint" made by a customer of the Applicant (referenced in the Motion and Kestler Decl.), as well as any non-party statements attached to or incorporated in the packing slips, Opposer provides no foundation for any such non-party's statements. Applicant is not clear if Opposer is offering a communication into evidence. If such a communication is being proffered at this time, then Opposer has no foundation for the non-party's statements. When communications are introduced into evidence without proper foundation and are relied upon for the truth of what they purport to reveal, such evidence constitutes nothing more than hearsay, which is not competent evidence. Fed. R. Evid. 801-802; *cf. Gravel Cologne, Inc. v. Lawrence Palmer, Inc.*, 469 F.2d 1397, 1398, 176 USPQ 123 (CCPA 1972). None of the exceptions to the

rule against hearsay apply here. *See* Fed. R. Evid. 803-804. Furthermore, portions of the packing slip in Exhibit D to the Kestler’s Decl. contains double hearsay, as the principal nonparty refers to yet other nonparties (e.g., Amazon). *See* generally, *Exhibit D to Kestler’s Decl.* These portions also are not competent evidence and do not fall within any exception. Fed. R. Evid. 803-805. The Board should not consider this evidence.

The foregoing are the only three pieces of “evidence” proffered by Opposer with respect to what it claims is “actual confusion”, even if such evidence may be considered competent (which it is not), there is nothing in the record to indicate whether these emails constitute more than a negligible portion of the relevant market, *cf. T.A.B. Systems v. Pactel Teletrac*, 77 F.3d 1372, 37 USPQ.2d 1879 (Fed. Cir. 1996) (evidence, including that involving “seven potential customers” was “legally insufficient” to support opposer’s claim).

Thus, at a minimum, because the evidence is insufficient, this factor favors Applicant.

8. Concurrent Use Without Actual Confusion Favors the Applicant

As shown above under the discussion of the previous factor, Opposer presents no competent evidence of any actual confusion among the sophisticated professionals in the automotive industry who are or would be interested in Opposer’s services. Thus, during the entire time of the parties’ concurrent use there has been no actual confusion. This factor favors Applicant.

9. Opposer’s Mark Is Not A Family Mark

The ninth Du Pont factor weighs in favor of the opposing party when the opposer’s claimed mark functions as a house mark or family mark. *In re American Medical & Life Ins. Co.*, 2002 TTAB LEXIS 657, *2-3 (TTAB 2002); *Seaside Community Dev. Corp. v. Whitman*, 2014 TTAB LEXIS 258, *14-15 (TTAB 2014). The rationale is that, if opposer’s mark

constitutes a house mark used in connection with a wide variety of goods and services, then it should be given a wider scope of protection. *Id.* However, if this is not the case, then this Du Pont factor should weigh in favor of the Applicant.

Here, Opposer's TOOLS USA trademarks are not house marks or family marks. Notably, Opposer did not plead that the applied-for mark is a house mark or family mark in its Notice of Opposition. *See* ESTTA No 1. Likewise, in its Motion for Summary Judgment, Opposer does not even address this factor because it knows that neither of these marks are house marks or family marks. *See Motion.* These are essentially admissions by Opposer that this factor does not weigh in Opposer's favor. Accordingly, Applicant respectfully submits that the ninth Du Pont factor weighs in Applicant's favor and against any finding of a likelihood of confusion.

10. There Is No Market Interface Between Applicant And Opposer

The tenth Du Pont factor considers the market interface between the applicant and opposer, which was explained to mean whether the opposer had previously provided its consent to use or registration, whether there was an agreement in place between the parties to preclude confusion, whether there was any assignment documents between the parties, or whether there is any laches or estoppel attributable to opposer. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). In the instant case, there has been no market interface between the parties. Accordingly, this factor is inapplicable and, therefore, neutral and does not weigh in favor of either party. *Stoncor Group, Inc. v. Specialty Coatings, Inc.*, 2012 TTAB LEXIS 240, *24 (TTAB 2012) (no evidence under tenth *du Pont* means the factor is neutral).

11. There Are Disputed Facts Regarding The Extent To Which Opposer Has A Right To Exclude Others From Use Of Its Mark

Admittedly, the eleventh Du Pont factor traditionally focuses on the extent to which the applicant has the right to exclude others from use of its mark on its goods. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). However, Applicant respectfully submits that it is relevant to consider the extent to which Opposer has the right to exclude others from use of its mark. At a minimum, this would be properly considered under the thirteenth Du Pont factor, which allows the consideration of any relevant fact or argument relating to likelihood of confusion.

In the instant case, there is really no dispute that Opposer's mark is descriptive. And although incontestable on those grounds, incontestability does not prevent this Board from considering the descriptive nature of Opposer's mark and the scope of protection that should be afforded to it. *Jackson Winery, Ltd. V. E.& J. Gallo Winery*, 150 F.3d 1142 (9th Cir. 1998) (reviewing evidence of descriptiveness of the term in analyzing the scope of protection to be accorded EMI's "incontestable" trademark ENTREPRENEUR and finding that genuine issues of material fact remained for trial on the issue of the strength of EMI's mark, i.e., the scope of protection). In this regard, Applicant respectfully submits that because Opposer's mark is descriptive, it should be afforded only a narrow scope of protection, such that Opposer should only be able to exclude identical marks for identical goods. This is especially true considering the relatively crowded field of TOOLS marks discussed under the sixth Du Pont factor above. Accordingly, Applicant respectfully submits that there is a genuine issue of fact as to the scope of protection to be afforded to Opposer's mark in light of its descriptive nature and whether Opposer's rights should be construed narrowly in light of the descriptive aspect of the mark.

12. There Are Disputed Facts Regarding The Extent Of Potential Confusion

The twelfth Du Pont factor considers the extent to which any potential confusion will be *de minimis* or substantial. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). If the potential confusion is *de minimis* (i.e., minimal) as opposed to substantial, then this factor weighs against a likelihood of confusion. *Id.* In addressing this twelfth factor, the TTAB considers the facts, evidence, and arguments presented in connection with the other Du Pont factors, as well as the number of potential buyers. *In re Davey Products Pty Ltd.*, 2009 TTAB LEXIS 524, *26 (TTAB 2009).

In the instant case, any potential confusion would be *de minimis* for several reasons. The parties goods and services are too dissimilar and the parties use different trade channels and sell to different types of purchasers. As such, any potential confusion, which is unlikely to begin with, would be *de minimis*. Accordingly, this factor weighs in Applicant's favor and against a likelihood of confusion. At a minimum, there are questions of fact relating to this factor that preclude summary judgment.

13. There Are Disputed Facts Regarding Other Established Facts Probative Of The Issue of Likelihood Of Confusion

The thirteenth Du Pont factor permits the parties to submit any other probative facts or arguments that are relevant to the issue of likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973).

In the instant case, Applicant believes that the foregoing analysis demonstrates that the relevant Du Pont Factors favor Applicant, or at the very least, raise genuine issues of material fact precluding summary judgment for Opposer.

D. CONCLUSION

For all the foregoing reasons, Applicant respectfully submits that there are disputed issues of material fact regarding the determination of priority and likelihood of confusion, and therefore, respectfully requests that the Board deny Opposer's Motion for Summary Judgment.

Dated: August 11, 2016

Respectfully submitted,

/s/ Curt Edmondson
J. Curtis Edmondson

EXHIBIT 1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No.: 86/377,838

For the mark: **TOOL USA.COM**

Published in the *Official Gazette* on: **July 7, 2015**

Standard Tools and Equipment, Co.)
)
)
)
)
)
Dropship, LLC)
)
)
)
)

v.

Opposition No. 91222920

**DECLARATION OF J. CURTIS EDMONDSON IN SUPPORT OF APPLICANT
DROPSHIP, LLC’S OPPOSITION TO OPPOSER’S MOTION FOR SUMMARY
JUDGMENT**

I, J. Curtis Edmondson, pursuant to 28 U.S.C. § 1746, declare as follows:

1. I am over eighteen (18) years of age, of sound mind and I have firsthand knowledge of the matters contained in this Declaration.
2. I am an attorney who is counsel of record in the above-referenced Opposition Proceeding for Applicant Dropship, LLC d/b/a TOOL USA, LLC (“Applicant”).
3. On August 26, 2014, Applicant filed U.S. Trademark Application Serial No. 86/377,838 with the U.S. Patent and Trademark Office (“USPTO”) on the Principal Register for the TOOL USA.COM trademark, using TEAS Plus. Attached as **Exhibit A** is a true and correct copy of Applicant’s application printout from TSDR. The description of goods was later amended to “manually operated hand tools, namely, hammers, trowels, sanding wire wool, drill accessories, namely, bits for hand drills” in International Class 8.

4. On June 2, 2015, the Examining Attorney approved Applicant's trademark application for publication.

5. On July 7, 2015, the USPTO published Applicant's application for opposition.

6. TOOLS USA is part of a relatively crowded field. There are several other marks registered and applied for that include the word TOOL, TOOLS, and USA, including Applicant's mark. Attached as **Exhibit B** is a true and correct copy of a printout of the USPTO database page demonstrating examples of search results for the words TOOL(S) and USA.

Dated: August 11, 2016

/s/ Curt Edmondson
J. Curtis Edmondson

EXHIBIT A

1. The Post Registration "Maintenance Tab" has been temporarily disabled. It will return soon.
2. TSDR now displays information regarding **TM5 Common Status Descriptors**.

STATUS

DOCUMENTS

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Mark: TOOL USA.COM



US Serial Number: 86377838

Application Filing Date: Aug. 26, 2014

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark

**TM5 Common Status
Descriptor:**



LIVE/APPLICATION/Opposition Pending

The pending trademark application has been examined by published for opposition, at which time one or more opposit they have not yet been decided.

Status: An opposition after publication is pending at the Trademark Trial and Appeal Board. For further informatio Trademark Trial and Appeal Board web page.

Status Date: Jul. 23, 2015

Publication Date: Jul. 07, 2015

Mark Information

Mark Literal Elements: TOOL USA.COM

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the word "TOOL" in white with blue outlining and to the upper right the wording "USA the background of the letters with white stars and stripes, a blue background behind the stars and red stri; wording ".COM" in gray.

Color Drawing: Yes

Color(s) Claimed: The color(s) red, white, blue, black, and gray is/are claimed as a feature of the mark.

Disclaimer: "TOOL" AND "USA.COM"

Design Search Code(s): 24.09.05 - American flags; Flags, American
27.03.05 - Objects forming letters or numerals

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;

- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Manually operated hand tools, namely, hammers, trowels, sanding wire wool, drill accessories, namely, b

International Class(es): 008 - Primary Class

U.S Class(es): 023, 028, 044

Class Status: ACTIVE

Basis: 1(a)

First Use: Feb. 02, 2007

Use in Commerce: Feb. 02, 2007

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Ame
Filed ITU: No	Currently ITU: No	Ame
Filed 44D: No	Currently 44D: No	Ame
Filed 44E: No	Currently 44E: No	Ame
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Dropship LLC

DBA, AKA, Formerly: DBA Tool USA

Owner Address: 5155 West Tropicana Ave. #1144
Las Vegas, CALIFORNIA UNITED STATES 89103

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: NEVADA

Attorney/Correspondence Information

Attorney of Record - None

Correspondent

Correspondent Name/Address: J CURTIS EDMONDSON

LAW OFFICES OF J CURTIS EDMONDSON
3699 NW DONALDSON PL
HILLSBORO, OREGON UNITED STATES 97124

Phone: 7029669818

Fax: 8888665750

Correspondent e-mail: pete@toolusa.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

TM Staff and Location Information

Assignment Abstract Of Title Information - Click to Load

Proceedings - Click to Load

EXHIBIT B



United States Patent and Trademark Office

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Refine Search [\(tool usa\)\[COMB\]](#)

Current Search: S1: [\(tool usa\)\[COMB\]](#) docs: 27 occ: 124

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	86933029		BEST TOOLS HANDCRAFTED IN THE USA	TSDR	LIVE
2	86854102		DENT TOOLS USA WAREHOUSE	TSDR	LIVE
3	86377838		TOOL USA.COM	TSDR	LIVE
4	86426730		TOOLS USA	TSDR	LIVE
5	86388637		BLUE DIAMOND TOOLS MADE IN USA	TSDR	DEAD
6	85970165	4728258	RUSHMORE USA TOOLS	TSDR	LIVE
7	85740697	4653354	YESTOOL/ALORIS USA	TSDR	LIVE
8	78348561	2970210	TOOL TROLLEY, LLC WWW.TOOLTROLLEY.COM TOOL TROLLEY MADE IN USA HAND-HELD POWER TOOL TROLLEYS FOR IMPROVED ACCURACY AND SAFETY IN GOD WE TRUST	TSDR	DEAD
9	78062536		STRIKER TOOL COMPANY USA	TSDR	DEAD
10	77819114		USA TOOLS	TSDR	DEAD
11	77595142		MILLER CLASSIC USA TOOLS	TSDR	DEAD
12	77281327	3551252	PATOOLSUSA	TSDR	DEAD
13	77291356	3843478	BTW BOSS TOOL WORKS MADE IN USA	TSDR	LIVE
14	76694761	3717197	N NEIKO PRO TOOLS USA	TSDR	LIVE
15	76682631	3545652	EAGLE TOOL KING USA	TSDR	DEAD
16	76645881		TOOLKING USA	TSDR	DEAD
17	76645879		TOOLKING USA	TSDR	DEAD
18	75479185	2476123	HARBOR FREIGHT TOOLS USA	TSDR	LIVE
19	75479117	2438888	HARBOR FREIGHT TOOLS USA	TSDR	LIVE
20	74429611		USA TOOLS	TSDR	DEAD
21	74384362	2011200	TOOLS USA	TSDR	LIVE
22	74381421	2041542	TOOLS USA	TSDR	LIVE
23	74320903		USA TOOLS MOBILE EXPRESS	TSDR	DEAD
24	74065003	1697137	USA PROFESSIONAL TOOLS AND EQUIPMENT	TSDR	DEAD
25	73803488	1609316	TOOL MASTER USA	TSDR	DEAD
26	73590805		NORDIC TOOLS USA N	TSDR	DEAD

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **APPLICANT'S RESPONSE IN OPPOSITION TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT** was served via TTAB ESTTA and on this 11th day of August 2016, on Opposer's counsel of record at the following address:

Blake P. Hurt
Tuggle Duggins PA
100 N Greene Street, Suite 600
Greensboro, NC 27401

/s/ Curt Edmondson
J. Curtis Edmondson
Attorney for Applicant