

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Premier Accessory Group, LLC

v.

GastonCo, LLC

Cancellation No. 92066817


Michael Sarney, Brian Bloom, and Michael Schwab of Moritt Hock & Hamroff LLP,
for Premier Accessory Group, LLC

Malte L.L. Farnaes of Farnaes & Lucio, APC,
for GastonCo, LLC.

Before Bergsman, Heasley, and Lynch,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Respondent, GastonCo LLC,¹ owns a Principal Register registration for the

composite mark , for “Batteries and battery chargers;
Communications headsets for use with communication radios, intercom systems, or

¹ Respondent GastonCo, LLC acquired Registration No. 5001276 by assignment from the original registrant/Respondent, FLI Marketing, Inc., and has been substituted as the party defendant. 20 TTABVue.

other communications network transceivers; Ear buds; Ear phones; Megaphones; Microphones for communication devices; Speaker microphones” in International Class 9.²

Petitioner, Premier Accessory Group, LLC, applied to register the standard character mark CODE RED for “Portable backup batteries, power banks, all of the aforementioned goods for use with flashlights, outdoor portable lighting products, and lanterns for lighting” in International Class 9 and for “Flashlights; tactical flashlights; LED flashlights; outdoor portable lighting products, namely, headlamps; lanterns for lighting, all of the aforementioned for general and emergency, personal home-use” in International Class 11. Petitioner’s application, however, was refused registration and suspended due to a likelihood of confusion with Petitioner’s subject registration.³

Petitioner has therefore petitioned to restrict or rectify the subject Registration under Section 18 of the Trademark Act, 15 U.S.C. § 1068, as follows (proposed restrictions indicated in **boldface**):

Replacement batteries and battery chargers **for use with two-way radio communication devices**; Communications headsets for use with communication radios, intercom systems, or other communications network transceivers; Ear buds **for use with two-way radio communication devices**; ear phones **for use with two-way radio communication devices**; Megaphones; Microphones for **use with two-way radio** communication devices; Speaker microphones **for use with two-way radio communication**

² Registration No. 5001276 issued on July 19, 2016. The description of the mark states, “The mark consists of a silhouette of a man with a helmet and boom microphone with the words ‘codeRED’ appearing to the right of the silhouette.” Color is not claimed as a feature of the mark.

³ Application Serial No. 86819258, filed on Nov. 13, 2015, based on Petitioner’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act. 15 U.S.C. § 1051(b).

devices, all the above for use in the public safety, tactical, security and hospital industries and by airsoft and paintball hobbyists.⁴

Petitioner contends that this restriction—limiting Respondent’s goods to two-way radio communication devices and parts and accessories therefor, and to certain classes of customers—would limit Respondent’s goods to those it actually purveys



under the mark, and avoid a likelihood of confusion with Petitioner’s applied-for CODE RED mark.⁵ Respondent denies the salient claims in the Petition,⁶ and contends that Petitioner has failed to satisfy its burden of proving that the proposed restriction would avoid a likelihood of confusion.⁷

We find that Petitioner has failed to satisfy its burden of proof, and therefore deny the petition.

I. Standing

Standing is a threshold issue that must be proven by the plaintiff in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, has enunciated a liberal threshold for determining

⁴ Petitioner’s brief, 16 TTABVUE 8.

⁵ Petitioner also petitioned to restrict or rectify Registration No. 4209831, also owned by Respondent, but that registration was cancelled because Respondent discontinued its use and did not file a Section 8 declaration of Use. 21 TTABVUE. The petition to restrict or rectify Registration No. 4209831 was thus dismissed as moot. 24 TTABVUE.

⁶ Answer, 4 TTABVUE. Respondent also raised three affirmative defenses, 4 TTABVUE 3-4, but did not pursue them at trial or in its brief, so they are waived. *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1100-01 (TTAB 2019).

⁷ Respondent’s brief, 18 TTABVUE 11 et seq.

standing, namely that a plaintiff must demonstrate that it possesses a “real interest” in a proceeding and “a reasonable basis for his belief of damage.” *Id.* at 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie*, 50 USPQ2d at 1026.

Petitioner’s evidence that its pending trademark application has been refused registration based on Respondent’s registration demonstrates that Petitioner has a real interest in the proceeding and a reasonable belief that it would be damaged by the continued unrestricted registration of Respondent’s mark, thus establishing its standing. *See Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1699 (TTAB 2014). Respondent admits that “the USPTO issued its final office action refusing registration of Petitioner’s Mark based on a likelihood of confusion with Respondent’s Mark.”⁸ “To establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled [or restricted under Section 18 of the Trademark Act], a petition may assert a likelihood of confusion which is not wholly without merit ... or, as here, a rejection of an application during prosecution.” *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). *See also* Timothy A. Lemper & Linda K. McLeod, “Embracing Marketplace Realities: Rediscovering Section 18 of the Lanham Act on the Twentieth Anniversary of Its Revival,” 99 Trademark Rep. 1299, 1328 (2009) (“A party has standing to assert a Section 18 claim ... if its application has been refused registration on the principal

⁸ Respondent’s brief, 18 TTABVUE 10, citing the Office Action, reproduced in Petitioner’s first notice of reliance 13 TTABVUE 10-14.

register because of the defendant's application or registration on the principal register, or if it can otherwise show an interest beyond that of the general public.”).

II. The Record

The record consists of the pleadings, the file of the registration sought to be restricted and rectified; Petitioner's first notice of reliance, containing the prosecution history of its Application Serial No. 86819258 for the mark CODE RED, and Respondent's answers to interrogatories; Petitioner's second notice of reliance, containing Petitioner's requests for admission and Respondent's responses thereto; and Petitioner's third notice of reliance, containing documents produced by Respondent during discovery. Respondent has submitted no evidence.

III. Evidentiary Issues

Before proceeding to the merits of the refusal, we address an evidentiary matter. Petitioner objects that Respondent, which adduced no evidence at trial, nonetheless asserts purported facts in its brief—claiming, for example, that it advertises “its goods online on its retail website and Amazon and through its distributors and resellers on e-commerce sites such as Walmart.com,” and that it advertises through posts on social media such as Twitter and Instagram.⁹

We agree that “the facts and arguments presented in the brief must be based on the evidence offered at trial. A brief may not be used as a vehicle for the introduction of evidence.” TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 801.01 (2019). “Factual statements made in a party's brief on the case can be given

⁹ Petitioner's reply brief, 19 TTABVUE 6, citing Respondent's brief, 18 TTABVUE 8-10.

no consideration unless they are supported by evidence properly introduced at trial.” *Id.* at § 704.06(b); *Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (affirming Board’s exclusion of assertions of fact made in a brief and agreeing with the Board that they are not evidence introduced at trial).

Respondent may, however, rely on evidence introduced by Petitioner:

When a written disclosure, a discovery deposition, or a part thereof, or an answer to an interrogatory, or an admission, or an authenticated produced document has been made of record by one party in accordance with the provisions of paragraph (k)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.

Trademark Rule 2.120(k)(7); 37 C.F.R. § 2.120(k)(7).

In this case, Petitioner made of record Respondent’s answers to interrogatories and admissions made in response to requests for admission.¹⁰ Once these discovery responses were properly introduced by Petitioner, Respondent was free to refer to and rely upon them. “When an interrogatory answer, or an admission, has been made of record by one party in accordance with 37 C.F.R. § 2.120(k), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.” TBMP § 704.10 (2019).

Respondent’s discovery responses that were made of record indicate that it sells its goods “through distributors, resellers, and directly to institutions and general consumers.”¹¹ Its website lists five distributors.¹² Respondent further answers that it “has advertised its goods through mail, internet, trade journals, radio and

¹⁰ See Petitioner’s first and second notices of reliance, 13-14 TTABVUE.

¹¹ Respondent’s answer to interrogatory no. 5, Petitioner’s first notice of reliance, 13 TTABVUE 40.

¹² Petitioner’s third notice of reliance, 15 TTABVUE 65.

television.”¹³ Its product catalogs have also been made of record.¹⁴ But its discovery responses regarding its channels of distribution do not specify distribution through Amazon or Walmart. And its discovery responses regarding its social media accounts show its advertisement of CODERED products on Twitter,¹⁵ but not Instagram.

“The Board is capable of weighing the strength or weakness of objected-to testimony, including any inherent limitations.” *M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd. and Global Technology & Trade Marks Ltd.*, 2019 USPQ2d 149090, *3 (TTAB 2019). We therefore consider the evidence of record and disregard assertions in the briefs that are not supported by evidence. *See Enzo Biochem Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005) (“Attorney argument is no substitute for evidence.”).

Respondent’s brief also cites a dictionary to define the word “tactical,” as used in Petitioner’s identification of goods, “tactical flashlights.”¹⁶ Petitioner objects that:

[H]ad Respondent introduced the definition of the word ‘tactical’ into the record or presented the issue during discovery, Petitioner would have had the opportunity to present evidence and arguments to show that the term ‘tactical flashlight’ is generic for a type of flashlight crafted from tough, durable and lightweight material designed to produce a bright light and is often designed, marketed and sold for general and emergency personal home use. For example, Best Buy sells tactical flashlights for use in the home (<https://www.bestbuy.com/site/shops-small-tactical-flashlights>, last visited August 3, 2019).¹⁷

¹³ Respondent’s answer to interrogatory no. 10, Petitioner’s first notice of reliance, 13 TTABVUE 42.

¹⁴ Petitioner’s second and third notices of reliance, 14 TTABVUE 17-50, 67-143; 15 TTABVUE 23-40.

¹⁵ Petitioner’s second notice of reliance, 14 TTABVUE 52-65.

¹⁶ Respondent’s brief, 18 TTABVUE 18, Merriam-Webster.com.


¹⁷ Petitioner’s reply brief, 19 TTABVUE 7 n.4.

This objection is overruled. The Board frequently takes judicial notice of dictionary definitions, and this case is no exception. *DeVivo v. Ortiz*, 2020 USPQ2d 10153, *6 n. 26 (TTAB 2020) (citing *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983)). Since Respondent first raised this definition, and this issue, in its brief, we will, in fairness, consider Petitioner's response thereto in its reply brief.

IV. Applicable Law

Section 18 of the Trademark Act provides that “the Director may ... restrict or rectify with respect to the register the registration of a registered mark....” 15 U.S.C. § 1068. This Section “gives the Board the equitable power to, inter alia, restrict the goods or services identified in an application or registration.” *Embarcadero Technologies, Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1828 (TTAB 2013) (internal punctuation omitted). A party seeking to restrict a registrant's broadly worded identification of goods under Section 18 must plead and prove “(1) that the registrant is not using its mark on goods or services that would be excluded by the limitation, and (2) that the limitation would result in the avoidance of a finding of a likelihood of confusion.” *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 (TTAB 1998) (citing *Eurostar Inc. v. “Euro-Star” Reitmoden GmbH & Co.*, 34 USPQ2d 1266, 1271 (TTAB 1994)); TBMP § 309.03(d).



Petitioner contends (A) that Respondent uses its  mark on goods **for use with two-way radio communication devices, for use by those in the public safety, tactical, security and hospital industries and by airsoft**

and paintball hobbyists, not other ways, and (B) that limiting Respondent to those goods and classes of customers would avoid a likelihood of confusion with Petitioner's CODE RED mark as used on flashlights and other portable lighting products.

A. Respondent is Not Using its Mark on Goods
That Would be Excluded by the Limitation

We find that Respondent is using its mark on goods for two-way radio communication devices, not other goods.

Respondent admits that its goods consist, essentially, of two-way radio communication devices, with parts and accessories therefor:

Respondent offers a wide range of communication accessories including listen only earpieces, molded earpieces, surveillance microphones, ear microphones, speaker microphones, replacement radio batteries, battery chargers, and batteries. 1st NOR (13 TTABVUE 38)3; 2nd NOR (14 TTABVUE 17-50, 67-143). Respondent's listen only devices are used to listen to sound from any compatible device capable of producing sounds including cell phones. 1st NOR (13 TTABVUE 39). Respondent's speakers and microphones are used to create and listen to sound from any compatible device capable of receiving and delivering sound. Id.¹⁸

This admission is consistent with Respondent's answers to interrogatories, stating that "Registrant used the Subject Trademarks for listen only devices including earphones and headsets, speaker/microphone devices, and batteries," and "Listen only devices are used to listen to sound from any compatible device capable of producing sound. Speaker/microphones are used to create and listen to sound from any compatible device capable of receiving and delivering sound. Batteries are used to provide power for electrical devices."¹⁹

¹⁸ Respondent's brief, 18 TTABVUE 8.

¹⁹ Respondent's answers to interrogatory nos. 1 and 2, 13 TTABVUE 38-39.

There is some peripheral dispute as to whether Respondent's batteries may be used with flashlights (Petitioner's goods). Respondent denies Petitioner's request to admit that all of its batteries and battery chargers are advertised for use with radio communication devices:

REQUEST NO. 1:

Admit that all batteries and battery chargers, ear buds, earphones, communication headsets, and hearing protection headsets which Registrant's offers under CODERED Marks are advertised for use with radio communication devices.

...

Deny. Registrant offers batteries under Registrant's CODERED Marks for use with other products, including but not limited to Maglite flashlights.²⁰

However, "unlike an admission (or a failure to respond which constitutes an admission), the denial of a request for admission establishes neither the truth nor the falsity of the assertion, but rather leaves the matter for proof at trial." TBMP § 704.10. Respondent's brief asserts that "Finally, Respondent's batteries are used to provide power to electrical devices, including two-way radios **and flashlights. *Id.***"²¹ However, the interrogatory answer to which this "*id.*" refers simply states that "Batteries are used to provide power for electrical devices."²² In answer to another interrogatory, Respondent states that it "offers a wide variety of batteries and battery chargers, including batteries and battery chargers for 2-way radios, Family Radio Service (FRS) radios, pagers, **rechargeable flashlights**, and alkaline batteries."²³

²⁰ Petitioner's second notice of reliance, 14 TTABVUE 122-23.

²¹ Respondent's brief, 18 TTABVUE 8 (emphasis added).

²² Respondent's answer to interrogatory no. 2, 13 TTABVUE 39.

²³ Respondent's answer to interrogatory no. 15, 13 TTABVUE 43 (emphasis added).

But this assertion is unsubstantiated and contrary to the weight of the evidence.

The founder of Code Red Headsets states in its 2010 Product Catalog that its accessories focus on the two-way radio communications market:

The Code Red Headsets line offers a wide range of radio accessories to meet any communications requirement. These include listen only earpieces, molded earpieces, surveillance microphones, speaker microphones, tactical headsets, hearing protection, replacement radio batteries, radio chargers and even megaphones. Connectors are available for Motorola, Kenwood, Icom and Vertex radios. In an effort to assist you, the products in this guide are listed by groups of similar items.

Why us? With over thirty years of experience in the 2-way radio industry, we specialize in understanding our clients' needs and providing you with the best quality products on the market. I know, everyone says that, but our business model is based on repeat business and referrals. We wouldn't receive either of these if we didn't take great care of our clients and provide products that exceeded their expectations.

I hope that we have the opportunity of proving that statement to you by allowing us to assist you with your radio accessory requirements.

Please view the products on our "on-line catalog" to see what will work best to solve your communication problem. You can contact our office and a product specialist will be happy to assist you with any product or application questions. Thank you for the opportunity.

Farris Isaacson

Farris Isaacson
Founder

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Respondent's 2017 product catalog advertises its "radio batteries":

RADIO BATTERIES

WE SELL A LARGE SELECTION OF THE MOST POPULAR RADIO BATTERIES WITH VARIOUS CHEMISTRIES.

RADIO BATTERIES
We offer a complete and comprehensive product line of high quality two-way radio replacement batteries and chargers. Our two-way radio batteries are designed to be fully compatible with the original equipment.

If you are unable to locate the battery for your 2-way radio on our website please contact us for assistance. Make sure to send us the battery model that you are using and quantity needed for current pricing.

It's best to stick with the same battery chemistry when ordering a replacement battery. Many chargers will not accept a different chemistry from the original battery.

WE SELL BATTERIES FOR THE MOST POPULAR RADIO BRANDS LIKE:
Alan, Bendix, King, Reim, EF Johnson, Harris, Hytera, Icom, Jotron, Kenwood, MaCom, Maxon, Motorola, Motorola Tetra, Nokia Tetra, Novell, Simoco Tetra, Supura Tetra, Tait, and Vertex.

codeRED HEADSETS
WWW.CODEREDHEADSETS.COM | INFO@CODEREDHEADSETS.COM | (858) 486-9859

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²⁴ Petitioner's third notice of reliance, 15 TTABVUE 24.

²⁵ Respondent's 2017 Product Catalog, Petitioner's second notice of reliance, 14 TTABVUE 43.

Its 2018 product catalog is to the same effect, advertising its replacement radio batteries:



Respondent admits that the batteries and battery chargers pictured above are specifically designed, sized, shaped, and chemically formulated to be compatible only with radio communication devices.²⁷ Respondent denies that the batteries and battery chargers shown above are the only batteries and battery chargers it has offered in 2018.²⁸ But as noted above, this denial establishes neither the truth nor the falsity of the assertion, but rather leaves the matter for proof at trial. TBMP

²⁶ Petitioner's second notice of reliance, 14 TTABVUE 28.

²⁷ Respondent's responses to requests for admission nos. 10-12, 15-18, Petitioner's second notice of reliance, 14 TTABVUE 125-129.

²⁸ Respondent's response to request for admission no. 19, Petitioner's second notice of reliance, 14 TTABVUE 129.

§704.10. Petitioner has adduced multiple product catalogs showing that Respondent's goods, including its battery goods, focus on two-way radio communications devices.

Respondent offers nothing to controvert this evidence; no documentation of advertising or sales of goods, particularly battery goods, bearing the



mark for uses other than two-way radio communications. “We further note that, when it is within a party’s power to produce a certain kind of persuasive testimony or documentary evidence on an urged factual finding, and it fails to do so, a tribunal is at least permitted—perhaps even compelled—to draw the inference that that fact is unsupported and/or untrue.” *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1794 (TTAB 2017).

We find accordingly that Respondent is using its mark on goods for two-way radio communication devices, not other goods.

Petitioner also seeks to restrict use of Respondent’s goods to “the public safety, tactical, security and hospital industries and by airsoft²⁹ and paintball hobbyists.” A restriction may limit the trade channels to reflect the classes of customers to whom the goods are actually sold. *See North Face Apparel Corp. v. Sanyang Ind. Co., Ltd.*, 116 USPQ2d 1217, 1222 n. 6 (TTAB 2015) (“The primary purpose of a Section 18 modification is to avoid a likelihood of confusion by restricting a broad identification to the specific type of goods or services for which the mark is actually used, or by restricting the channels of trade to those in which the goods or services actually

²⁹ “Airsoft” is a competitive team shooting sport in which participants shoot air guns that fire small plastic BB projectiles. Petitioner’s brief, 16 TTABVUE 16 n. 2.

travel.”).

We will discuss this proposed restriction separately in the context of considering the third *DuPont* factor below. Suffice to say that, even though we have found that Respondent’s goods may be properly restricted to goods for two-way radio communication devices, and even if we assume *arguendo*, without finding, that its classes of customers could be restricted to the public safety, tactical, security and hospital industries, as well as airsoft and paintball hobbyists, these restrictions would not avoid a likelihood of confusion.

B. The Proposed Restrictions Would Not Avoid a Likelihood of Confusion

“[T]he Board will not entertain claims to modify overbroad descriptions of marks unless the proposed modification will avoid a finding of likelihood of confusion between the parties’ marks.” *In re Cook Med. Techs. LLC*, 105 USPQ2d 1377, 1384 (TTAB 2012). We base our determination of likelihood of confusion under Section 2(d) on an analysis of all of the probative facts of record. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In making our determination, the Board has considered each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019). *See Zheng Cai v. Diamond Hong*, 127 USPQ2d at 1800 (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.”)).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98

USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the similarities between the goods. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (“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.’”)); *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.”).

1. Similarity of the Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of the parties’ marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Zheng Cai v. Diamond Hong*, 127 USPQ2d at 1801; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.’ *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling

or sound alone is likely to cause confusion.”) (citation omitted).” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) *aff’d* 777 Fed. Appx. 516 (Fed. Cir. 2019).).



Petitioner contends that Respondent’s composite mark is significantly different from Petitioner’s standard character CODE RED mark:

The logo in Respondent’s Mark, as described by the Respondent in Respondent’s Registration, is the silhouette of man with a helmet and boom microphone, a critical part of a two-way radio, (the “Radio User Logo”). Use of the Radio User Logo in combination with the word “codeRED” in a distinctive stylized form has a strong impact on the appearance and connotation of Respondent’s Mark. The Radio User Logo is highly suggestive of Respondent’s Actual Goods. Consumers viewing the Respondent’s Mark will be struck first by the Radio User Logo which dominates the overall commercial impression generated by the Respondent’s Mark. As the Petitioner’s Mark does not begin with or contain any logo, design or stylization the Radio User Logo visually distinguishes the Respondent’s Mark from the Petitioner’s Mark.³⁰

Even though “both marks contain a version of the term CODE RED,” Petitioner maintains, “[c]onfusion does not automatically exist because two marks share the same word or phrase.” (Citing, e.g., *Food Specialty Co., Inc. v. Kal Kan Foods, Inc.* 180 USPQ 136, 138 (CCPA 1973) (KAL KITTY STEW and design not confusingly similar to KITTY); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.* 167 USPQ 529 (CCPA 1970) (PEAK PERIOD not confusingly similar to PEAK)).³¹

In this case, however, the marks do not just share a word; they comprise the same two words in the same order. As Petitioner concedes, “both marks contain a version of the term CODE RED....”³² The stylization of Respondent’s mark makes little

³⁰ Petitioner’s brief, 16 TTABVUE 26-27.

³¹ Petitioner’s brief, 16 TTABVUE 27.

³² *Id.*

difference, as Petitioner’s standard character mark could be depicted in any font size, style, or color, including Respondent’s style. *In re i.am.symbolic, LLC*, 123 USPQ2d at 1748 (quoting *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display.”)); Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a).

The term “code red” means:

1. A condition of heightened alertness or preparedness, especially to guard against imminent danger.
2. A warning of or signal indicating imminent danger.³³

The absence of a space between “CODE” and “RED” in Respondent’s mark does not meaningfully distinguish it from Petitioner’s CODE RED mark. *Stock Pot, Inc., v. Stockpot Rest., Inc.*, 220 USPQ 52, 52 (TTAB 1983), *aff’d* 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (“There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical.”). “The two words retain the same meanings when joined as a compound.” *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010) (finding ACTIVECARE and ACTIVE CARE confusingly similar).

Thus, the marks are identical in sound and meaning.

Respondent’s design element does not obviate the likelihood of confusion with Petitioner’s mark. Although it has some visual prominence, “[i]n the case of marks ...

³³ THE AMERICAN HERITAGE® DICTIONARY OF THE ENGLISH LANGUAGE, Fifth Edition 2020, AHDictionary.com, 4/22/2020. Again, the Board may take judicial notice of dictionary definitions. *DeVivo v. Ortiz*, 2020 USPQ2d 10153, *6 n. 26.

consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir 1983)). The verbal portion of a word and design mark “likely will appear alone when used in text and will be spoken when requested by consumers.” *Id.* at 1911; *see also In re Solid State Design Inc.*, 125 USPQ2d 1409, 1411 (TTAB 2018) (citing *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883, 1887 (TTAB 2007) (“[I]t is well settled that if a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods.”)).” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018).

We therefore find that the wording “CODE RED” is the dominant element of Respondent’s mark, and the entirety of Petitioner’s mark; the design element in Respondent’s mark is not sufficient to distinguish the marks. *See Orange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1116 (TTAB 2015) (finding same word element, not design elements, the dominant portion of the marks in Section 19 proceeding). Indeed, Respondent’s own product catalogs frequently refer to its brand by words only, with a space between the words:



**Reliable 2-way
radio accessories
from Code Red
Headsets. If it
isn't Code Red,
your comms could
be dead.**

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If anything, Respondent's logo reinforces the literal part of the mark, suggesting that the helmeted man in silhouette is prepared for a "code red" situation. Although the design element might suggest a particular context for a "code red" situation, this does not differentiate it from the reference to "code red" in Petitioner's mark that includes no design element and therefore brings to mind "code red" more generally. "Even those purchasers who are fully aware of the specific differences between the marks may well believe, because of the similarities between them, that the two marks are simply variants of one another, used by a single producer to identify and distinguish companion lines of products." *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985).

As the Examining Attorney found during examination of Petitioner's application, the involved marks are extremely similar, given that the most important, source-identifying literal portions of the marks are virtually identical.³⁵ The marks are

³⁴ Petitioner's third notice of reliance, 15 TTABVUE 39.

³⁵ Office Action of March 3, 2017 re Petitioner's Application Serial No. 86819258, Petitioner's first notice of reliance, 13 TTABVUE 11.

unchanged by Petitioner's proposed restrictions. The first *DuPont* factor thus weighs heavily in favor of finding a likelihood of confusion.

2. Relatedness of the Goods

The second *DuPont* factor concerns the "similarity or dissimilarity and nature of the goods...." *DuPont*, 177 USPQ at 567; *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1161. The great degree of similarity between the marks reduces the degree of similarity between the goods required to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Time Warner Ent. Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

Petitioner contends that "the Goods Sold Under the Marks are Highly Distinguishable."³⁶ It argues: "None of the goods as set forth in [Respondent's] Mark are the same as, related to, or overlap with the goods in the Petitioner's Mark."³⁷ Even though Respondent's goods and some of Petitioner's identified goods are both classified in International Class 9, "that does not mean they are sufficiently similar to create a likelihood of confusion."³⁸ Furthermore, it notes, "Respondent's arguments are inapposite because they are based on an analysis of the likelihood of confusion factors in the context of the unrestricted goods in its registration, rather than the restricted goods."³⁹ "Petitioner's Goods are so different and distinct from Respondent's Actual [restricted] Goods that no reasonable consumer would assume

³⁶ Petitioner's brief, 16 TTABVUE 21.

³⁷ *Id.* at 22.

³⁸ *Id.* at 23 (citing *In re Thor Tech, Inc.*, 113 USPQ2d 1546 (TTAB 2015) and *In re Princeton Tectonics, Inc.*, 95 USPQ2d 1509 (TTAB 2010)).

³⁹ Petitioner's reply brief, 19 TTABVUE 8.

the goods originate from the same source.”⁴⁰

Petitioner is correct in stating that the classification of the parties’ goods is immaterial. The Class number “is wholly irrelevant to the issue of registrability under section 1052(d), which makes no reference to classification.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993) *also quoted in Ricardo Media Inc. v. Inventive Software, LLC*, 219 USPQ2d 311355, *11 n. 16 (TTAB 2019)). We have also agreed that Respondent’s actual goods are two-way radio communication devices. Petitioner’s goods consist, essentially, of flashlights and other portable lighting products such as headlamps and tactical flashlights, as well as parts and accessories therefor.

Even with the restrictions Petitioner proposes, though, we find that the parties’ goods are sufficiently related to engender a likelihood of confusion. The issue is not whether the goods will be confused with each other, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.”); *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989) (“The issue to be determined in cases such as this is not whether the goods of plaintiff and defendant are likely to be confused but rather whether there is a likelihood that purchasers will

⁴⁰ Petitioner’s brief, 16 TTABVUE 23.

be misled into the belief that they emanate from a common source.”) A proper comparison “considers whether ‘the consuming public may perceive [the respective goods or services of the parties] as related enough to cause confusion about the source or origin of the goods and services.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard*, 62 USPQ2d at 1004) *quoted in In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018).

In this case, the purchasing public could easily perceive goods bearing the parties’ marks as related product lines from the same source. Both parties’ marks contain the highly similar wording “CODERED” and “CODE RED”. Both parties’ marks connote a condition or signal of heightened alertness or preparedness, especially to guard against imminent danger.⁴¹ And both parties’ goods could help prepare one for “code red” conditions. The proposed restriction of Respondent’s batteries and communications devices for use in industries that include public safety, tactical, and security make apparent that the settings for use of Respondent’s goods often also would necessitate the use of flashlights, headlamps, or lanterns. Petitioner’s “headlamps” could complement Respondent’s “headsets”. Petitioner’s “tactical flashlights” could provide illumination for persons wearing Respondent’s headsets. The website on which Petitioner relies shows that “tactical flashlights” are typically made of tough, durable materials, and are appropriate for conditions of heightened alertness. For example:

⁴¹ THE AMERICAN HERITAGE® DICTIONARY OF THE ENGLISH LANGUAGE, Fifth Edition 2020, AHDictionary.com, 4/22/2020.



Trust this Nite Ize INOVA T4R tactical LED flashlight for your professional security and outdoor use. Built to withstand tough conditions, this flashlight is crushproof and water-resistant.



Light up your path with the Police Security Zephyr flashlight.⁴²

“If goods are complementary in nature, or used together, this relatedness can support a finding of likelihood of confusion. *See, e.g., In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).” *In re Cook Medical Technologies, LLC*, 105 USPQ2d 1377, 1380 (TTAB 2012). In these circumstances, as we have noted, the purchasing public could easily perceive the parties’ goods as companion lines from a single source. *In re Great Lakes Canning*, 227 USPQ at 485 (the perception is that “the two marks are simply variants of one another, used by a single producer to identify and distinguish companion lines of products.”).

The second *DuPont* factor, relatedness of the goods, thus weighs in favor of a likelihood of confusion.

⁴² <https://www.bestbuy.com/site/shop/small-tactical-flashlights> 8/3/2019. Petitioner’s reply brief, 19 TTABVUE 7 n. 4.

3. Channels of Trade and Classes of Customers

The third *DuPont* factor concerns “[t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567.

In its trial brief, Petitioner seeks to restrict Respondent’s goods to **“use in the public safety, tactical, security and hospital industries and by airsoft and paintball hobbyists.”**⁴³ Petitioner contends in its brief that this restriction reflects Respondent’s actual channels of trade and classes of customers:

Respondent’s marketing channels are directed narrowly to businesses and governmental entities in the public safety, tactical, security and hospital industries and to airsoft and paintball enthusiast that utilize two-way radios and parts and accessories for two-way radios for a critical business function or to compete in airsoft and paintball competitions. ...

In contrast, Petitioner’s flashlights and other portable lighting products will be marketed in channels of trade directed towards products for use in the home such as home goods and general merchandise stores. Therefore, the goods of the Petitioner and Respondent are not likely to be marketed through the same channel of trade or encountered in the marketplace by the same consumers.⁴⁴

Petitioner further asserts that Respondent is unlikely to expand its marketing channels:

Further, because Respondent, since it was founded in 1999, has only operated in one limited and narrow field of trade, namely, providing two-radios and parts and accessories for two-way radios to businesses and airsoft and paintball hobbyists, it is unlikely to expand its channels of trade, but will continue to sell its products through the same narrow channels. Also, there is no evidence in the record that Respondent has any plans to expand the goods or marketing channels it utilizes in connection with Respondent’s Mark.⁴⁵

⁴³ Petitioner’s brief, 16 TTABVUE 8.

⁴⁴ Petitioner’s brief, 16 TTABVUE 25.

⁴⁵ Petitioner’s brief, 16 TTABVUE 26.

In response to Petitioner's interrogatories on the subject, Respondent answered:

"Registrant offers to sell such goods to public safety, security, tactical teams, sports enthusiasts, hospitality, institutions, and any general public consumer markets."⁴⁶

"Registrant's customers range from highly trained public safety professionals to unskilled general consumers, including adolescents."⁴⁷

"Registrant uses the CODERED and Designs Mark[] on its goods sold through distributors, resellers, and directly to institutions and general consumers including public safety professionals, security, tactical teams, sports enthusiasts, hospitality, institutions, and any general public consumer markets."⁴⁸

Respondent further avers that it "is continually expanding its business by targeting public safety, security, tactical teams, sports enthusiasts, hospitality, institutions, and the general public consumer markets."⁴⁹

The record also contains an excerpt from Respondent's product catalog listing its classes of customers:

⁴⁶ Respondent's answer to Interrogatory no. 4, Petitioner's first notice of reliance, 13 TTABVUE 40.

⁴⁷ Respondent's answer to Interrogatory no. 6, Petitioner's first notice of reliance, 13 TTABVUE 41.

⁴⁸ Respondent's answer to Interrogatory no. 18 [corrected numbering], Petitioner's first notice of reliance, 13 TTABVUE 44.

⁴⁹ Respondent's answer to Interrogatory no. 11, Petitioner's first notice of reliance, 13 TTABVUE 42.



Petitioner attempts to narrow the scope of this customer base by submitting 16 invoices issued by Respondent to its customers, ranging from police and corrections facilities to casinos and individuals.⁵¹ It submits Twitter tweets from Respondent stating “CODE RED HEADSETS HAS BEEN AROUND SINCE 1999. FOR OVER 18 YEARS WE HAVE BEEN PROVIDING LAW ENFORCEMENT, MILITARY AND PUBLIC SAFETY RADIO ACCESSORIES.”⁵² Petitioner also submits evidence of

⁵⁰ Excerpt from 2017 Product Catalog, Second notice of reliance, 14 TTABVUE 50.

⁵¹ Petitioner’s brief, 16 TTABVUE 12-14; Petitioner’s third notice of reliance, 15 TTABVUE 46-67.

⁵² Petitioner’s brief, 16 TTABVUE 15, Petitioner’s second notice of reliance, 14 TTABVUE 53.

Respondent's participation in trade shows directed to the shooting, hunting and outdoor trade, and commercial buyers and sellers of military, law enforcement, and tactical products, as well as Airsoft enthusiasts, military recruiters, and tactical special weapons law enforcement personnel.⁵³

This evidence falls short of proving that Respondent's channels of trade and classes of customers should be restricted to "use in the public safety, tactical, security and hospital industries and by airsoft and paintball hobbyists."⁵⁴ The evidence suggests where Respondent has focused its advertising efforts, but does not prove that Petitioner's proposed restriction reflects the full extent of Respondent's actual client base. Respondent's 16 sales receipts indicate sales to some governmental and business organizations, but do not foreclose the existence of sales to other entities, such as hotels, universities, retail and restaurant establishments. Respondent's receipts of sales to individuals give no indication of the context in which they would use the two-way communications equipment, and offer no reason to believe that airsoft and paintball competitors are the only sporting enthusiasts who use two-way radio communication devices. Petitioner could have shored up its proof by deposing Respondent under Fed.R.Civ.P. 30(b)(6), or by propounding more precise discovery requests definitively excluding other uses for Respondent's two-way radio communication devices, but did not do so. Petitioner's assertion that Respondent is unlikely to expand its channels of trade, and has no plans to do so, is unsupported

⁵³ Petitioner's brief, 16 TTABVUE 16-17; Petitioner's second notice of reliance, 14 TTABVUE 57-65.

⁵⁴ Petitioner's brief, 16 TTABVUE 8.

attorney argument. *See Performance Open Wheel Racing, Inc. v. United States Auto Club Inc.*, 2019 USPQ2d 208901, *8 n. 62 (TTAB 2019). And its assertion is controverted by Respondent's interrogatory answers and its product catalogs.

The restriction provisions of Section 18 are in the nature of an equitable remedy and may be invoked when the proofs show that restriction is equitable and appropriate—that is, when “the registrant has set forth its goods in terms that overstate the range of goods or the trade channels in which those goods move, so that fairness demands that an appropriate restriction to the registration be entered.” *Eurostar Inc. v. “Euro-Star” Reitmoden*, 34 USPQ2d at 1270, 1271 n. 3 (TTAB 1994). Petitioner met this burden as to Respondent's goods, but not as to its channels of trade or classes of customers. We find that Respondent's classes of customers extend to any businesses, governmental entities, associations, groups or individuals who may wish to purchase goods for two-way radio communication devices.

For the sake of completeness, we also find that even if Petitioner's proposed restrictions were imposed in full, as to goods, channels of trade, and classes of customers, they still would not suffice to obviate a likelihood of confusion. *See Orange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1114 (TTAB 2015) (“Despite the differences in the channels of trade, the same consumers are likely to encounter both parties' goods....”). A property manager seeking to equip his night watchmen or security guards with two-way radio communications headsets and other devices could also equip them with Petitioner's headlamps, tactical flashlights, or other portable lighting products. Petitioner limits its Class 11 lighting products to “general and emergency, personal home-use,” but purchasers are unaware of such limitations. *See*

In re The Clorox Co., 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978) (“[T]he locus of potential confusion is [not] in the files of the PTO.”) *quoted in In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1188 (TTAB 2018). And Petitioner’s identification of Class 9 portable lighting products contains no such limitation. “Moreover, while they might not be encountered in the same stores, both parties’ goods might be encountered by the same purchasers.” *Jeanne-Marc Inc. v. Cluett, Peabody & Co.*, 221 USPQ 58, 61 (TTAB 1984).

Accordingly, the third *DuPont* factor also weighs in favor of a likelihood of confusion.

4. Sophistication and Care of Purchasers

Under the fourth *DuPont* factor, we consider “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. Under this factor, Petitioner contends that:

Here consumers of Respondent’s Actual Goods are sophisticated business professionals active in the public safety, tactical, security and hospital industries or are individuals who participate in airsoft and paintball competitions who are seeking two-way radios and parts and accessories for two-way radios to assist in the performance of a key function of their business or competitions. Purchasers of these types of goods generally take great care and pay close attention to the identity of the company with whom they are entrusting to supply a critical tool needed to perform their public safety, security or tactical responsibilities or competitive aspirations. The decision to purchase two-way radios and parts and accessories for two-way radios will not be made lightly, on impulse or without careful consideration.⁵⁵

But even if Petitioner’s proposed restrictions were imposed in full, as to goods, channels of trade, and classes of customers, we find that this factor would not

⁵⁵ Petitioner’s brief, 16 TTABVUE 24.

mitigate the likelihood of confusion. “[B]eing knowledgeable and/or sophisticated in a particular field does not necessarily endow one with knowledge and sophistication in connection with the use of trademarks.” *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988) (citing *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983)). Nor does it render one immune from confusion. *See Stone Lion Capital*, 110 USPQ2d at 1163-64. “Human memories even of discriminating purchasers ... are not infallible.” *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) *quoted in In re Integrated Embedded*, 120 USPQ2d 1504, 1516 (TTAB 2016).

Even if Respondent’s customers were sophisticated and careful, they could still infer from the parties’ highly similar “CODERED” and “CODE RED” marks that the respective goods emanate from the same source. “[W]ith identical or similar marks used on such goods, even a careful, sophisticated consumer of these goods is likely to believe that the goods emanate from a common source. *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846. In other words, even careful purchasers who do notice the difference in the marks will not ascribe it to differences in the source of the goods, but will see the marks as variations of each other, pointing to a single source.” *In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1739 (TTAB 2018).

Consequently, the similarity of the marks outweighs any sophistication and care of the relevant purchasers.

V. Conclusion

For the foregoing reasons, we find that Petitioner has failed to carry its burden of proving that restricting and rectifying the subject Registration in the way it proposes will avoid a likelihood of confusion.

Decision: The Section 18 petition is denied.