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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Meramec Group, Inc.

Serial No. 75/435,108

Paul M. Denk, Esq. for Meramec Group, Inc.

Mary Rossman, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Hohein, Chapman and Rogers, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Meramec Group, Inc. (a Missouri corporation) has filed
an application, subsequently amended to the Supplemental
Register, to register the mark INDUSTRIAL STRENGTH
POLYURETHANE for goods ultimately identified as
"polyurethane furniture components, namely chair arms,
chair seats, and chair backs" in International Class 20,
and "footwear components, namely, inserts for shoe soles

and shoe heels" in International Class 25.¹ In response to a requirement of the Examining Attorney, applicant disclaimed the word "polyurethane."

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its identified goods, so resembles the registered mark INDUSTRIAL STRENGTH for "orthopedic braces" in International Class 10,² as to be likely to cause confusion, mistake or deception.

¹ Application Serial No. 75/435,108, filed February 17, 1998, which originally sought registration on the Principal Register, was based on applicant's assertion of a bona fide intention to use the mark in commerce. During the examination process, applicant filed an Amendment to Allege Use (claiming a date of first use and first use in commerce of August 14, 1998 with regard to the Class 20 goods, and a date of first use of December 30, 1997 and a date of first use in commerce of January 12, 1998 with regard to the Class 25 goods), and an amendment to the application seeking registration on the Supplemental Register, both of which were accepted by the Examining Attorney.

When an applicant originally files, seeking registration on the Principal Register based on Section 1(b)(intent-to-use), as in this application, the applicant may file an amendment seeking registration on the Supplemental Register only after it has begun using the mark and has filed an Amendment to Allege Use [Section 1(c)] or a Statement of Use [Section 1(d)] which meets the minimum filing requirements. The effective filing date of the application will then become the date on which applicant met the minimum filing requirements for the Amendment to Allege Use or the Statement of Use. See TMEP §§206.01 and 816.02 (Third edition 2002). In the application now before the Board, the effective filing date is December 26, 2001.

² Registration No. 1,846,639, issued July 26, 1994 on the Principal Register to Chase Ergonomics Inc. (a New Mexico corporation), Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed date of first use is May 14, 1991.

When the refusal was made final, applicant appealed. Briefs have been filed, but an oral hearing was not requested.

We affirm the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

The involved marks are virtually identical, differing only by applicant's addition of the generic word "polyurethane" to its mark. Applicant does not contest the similarity of the marks.

Applicant has not submitted evidence that the mark INDUSTRIAL STRENGTH is weak³ in the relevant fields of orthopedic braces, footwear components, namely, inserts for shoe soles and shoe heels, and furniture components, namely, chair arms, chair seats and chair backs.⁴

We note that the fact that an applicant which has selected the identical mark of a registrant "weighs [so] heavily against the applicant that applicant's proposed use of the mark on "goods... [which] are not competitive or intrinsically related [to registrant's goods]...can [still] lead to the assumption that there is a common source." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688-1689 (Fed. Cir. 1993). Thus, "[t]he greater the similarity in the marks, the lesser the similarity required in the goods or services of the parties to support a finding of

³ We specifically note that the cited registered mark is on the Principal Register with no claim of acquired distinctiveness under Section 2(f) of the Trademark Act; and it is, of course, entitled to the statutory presumptions under Section 7(b) of the Trademark Act.

⁴ We are aware that in applicant's December 26, 2001 response to the July 10, 2001 Office action, it argued with regard to the then refusal to register under Section 2(e)(1) (mere descriptiveness) that there are other marks including the word "industrial" which issued without being rejected or ultimately rejected as merely descriptive. However, importantly, applicant did not argue that the mark INDUSTRIAL STRENGTH is a weak mark in the relevant fields, nor did applicant provide copies of any third-party registrations. Thus, there is no argument of a weak mark, or any evidence relating thereto, in the record.

likelihood of confusion." 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §23:20.1 (4th ed. 2001).

We turn to a consideration of the cited registrant's goods and applicant's goods, as identified, in each class. Applicant essentially contends that the involved goods are "entirely distinct" from one another and are in different International Classes; that the goods are sold in entirely different channels of trade, with registrant's sold in medical appliance stores, hospitals and doctors' offices, while applicant's products are not for orthopedic purposes, and are marketed to furniture manufacturers and footwear manufacturers, respectively, and not to the retail trade.

The Examining Attorney essentially contends that registrant's goods and both classes of applicant's identified goods are closely related and/or complementary including in the activities surrounding their marketing; that classification in different International Classes is an administrative USPTO matter unrelated to the issue of likelihood of confusion;⁵ that both classes of applicant's identified goods are broadly worded, without limitation as to the nature or type of channels of trade or classes of purchasers; that applicant's assertions of where the

⁵ See e.g., *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, footnote 5 (TTAB 1990).

respective goods are marketed and to whom are not reflected in the identifications of goods of either registrant or applicant; that the record includes substantial evidence that these goods (registrant's orthopedic braces vis-a-vis applicant's specific furniture components and applicant's specific footwear components) are commercially related products; that applicant has offered no evidence in support of its arguments; that prospective purchasers would likely assume that applicant's footwear components (inserts for shoe soles and shoe heels) and furniture components (chair arms, chair seats and chair backs) and registrant's orthopedic braces, when sold under virtually the same mark, emanate from a single source; and that doubt on the issue of likelihood of confusion must be resolved against applicant as the newcomer.

The evidence submitted by the Examining Attorney includes printouts of pages from both applicant's and registrant's web sites showing both parties' goods are promoted as "ergonomic" and intended to attenuate shock and vibration, while offering superior cushioning, and applicant touts its products as ideal for ergonomic workstations; definitions from The American Heritage Dictionary (Third Edition 1992) of, inter alia, the words "brace" as "4. An orthopedic appliance used to support,

align, or hold a bodily part in the correct position" and "ergonomics" as "2. The applied science of equipment design, as for the workplace, intended to maximize productivity by reducing operator fatigue and discomfort. 3. Design factors, as for the workplace, intended to maximize productivity by minimizing operator fatigue and discomfort"; third-party registrations⁶ showing a single entity registered a mark for both parts of shoes (e.g., uppers, linings, insoles) and braces (e.g., back supports, wrist supports, knee supports); third-party registrations showing a single entity registered a mark for both ergonomic chair products and back supports (e.g., lumbar pillows, back supports for use with chairs); printouts from third-party web sites and catalogs (Sharper Image, High Street Emporium) showing that braces, supports and ergonomic products are available and are marketed together (e.g., heel cushions, heel and foot inserts, flexible supports for the back, shoulders, wrists, ankles); and photocopies of excerpted stories retrieved from the Nexis database, examples of which follow.

Headline: Ergonaut; One naut tests
some office comfort products

⁶ In reviewing all of the numerous third-party registrations submitted by the Examining Attorney, we note that a few are not based on use in commerce. In reaching our decision herein, the Board considered only those third-party registrations which are based on use in commerce.

...Wrist rest... Suspenders, Power braces for the '90s. Striking, no-nonsense style and exceptional lumbar support... Back Pad, Like a soft, nagging mom who reminds you to sit up straight... Chair, A chair's a chair, right? No way... Armrests... Footpedals.... "Computerworld," October 28, 1996; and

Headline: Sports-Related Injuries Raise Interest in Orthopedic Braces
...The most significant development in the orthopedic soft goods market has been its explosion on the retail market. "Of the 12 segments that comprise this industry," says Mach, "eight have penetrated mass merchandisers, sporting goods stores, drug chains and supermarkets." Most of these outlets now have special sections devoted solely to orthopedic soft goods, breeding intense competition for space among manufacturers. "PR Newswire," October 21, 1996.⁷

It is well settled that goods need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to

⁷ While normally newswire service stories are not considered because it is not clear whether such stories were available to the public, the Examining Attorney did not offer this story to establish descriptiveness as perceived by the purchasing public, but rather to show the possible marketing channels for registrant's and applicant's goods.

a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods or services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); and *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001).

When considering the third-party registrations submitted by the Examining Attorney, it is settled that third-party registrations are not evidence of commercial use of the marks shown therein, or that the public is familiar with them. Nonetheless, third-party registrations which individually cover a number of different items and which are based on use in commerce have some probative value to the extent they suggest that the listed goods emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

It is clear that the products involved herein are different products. Further, we recognize that the evidence is more definitive with regard to the relatedness of "orthopedic braces" and "footwear components, namely, inserts for shoe soles and shoe heels" than with regard to the relatedness of "orthopedic braces" and "furniture

components, namely, chair arms, chair seats and chair backs."

However, we find that the Examining Attorney has established that applicant's goods in each class and the goods in the cited registration are related in the mind of the consuming public as to the origin. See *Hewlett-Packard Company v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services").

We specifically note that registrant's goods are broadly identified as "orthopedic braces" and are not limited to technical, medical braces, but could encompass all types of "orthopedic braces," including simple wrist, ankle and knee braces sold to the general public. Moreover, applicant's identified goods (while each is identified as "... components, namely, ...") are not limited to components sold only to furniture manufacturers or shoe manufacturers, respectively. Thus, these goods (e.g., chair seats as a furniture component, inserts for shoe heels as a footwear component), as identified, could encompass furniture components and footwear components which can be purchased by the general public. That is,

applicant's goods, as identified, are broadly set forth, including all types of the specified furniture components and the specified footwear components, and must be deemed to be offered to all classes of customers through all normal channels of trade. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

The record before us establishes that the respective goods of the parties are associated or related goods in the minds of the consuming public. See *Heywood-Wakefield Co. v. Dayco Corp.*, 142 USPQ 381 (TTAB 1964).

Finally, we have no doubt on the question of likelihood of confusion as to applicant's footwear components in International Class 25, and what doubt remains as to applicant's furniture components in International Class 20, we must resolve such doubt against applicant as the newcomer, because it has the opportunity to avoid confusion, and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Based on the virtual identity of the marks, the relatedness of the parties' respective goods, and the overlapping trade channels and purchasers, we find that there is a likelihood that the purchasing public would be confused when applicant uses INDUSTRIAL STRENGTH POLYURETHANE as a mark for its identified goods.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed as to both classes of applicant's goods.