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This Opinion is Not
Citable as Precedent
of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Exel Oyj

Serial No. 75622840

Charles E. Burpee and James L. Scott of Warner Norcross & Judd LLP for Exel Oyj.

Leslie L. Richards, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).¹

Before Simms, Rogers and Drost,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Exel Oyj, a public limited company of Finland, has applied to register the mark set forth below for "exercise equipment, namely hand-held poles used to enhance the exercise benefits of walking or running," in Class 28.

nordic **walker**

¹ Judy Grundy and Richard S. Donnell examined the application.

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The application was filed January 19, 1999 based on applicant's statement of its bona fide intention to use the mark in commerce on or in connection with the identified goods. Applicant has disclaimed exclusive rights to the term "walker" apart from the mark as shown in the application.

The examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), originally citing a number of registrations but eventually issuing a final refusal of registration based on three. However, the examining attorney noted in her brief that one of these three has been cancelled and so the refusal is now based on only two registrations.² The first of the two remaining cited registrations is Registration No. 1488669 for the mark NORDICTRACK for a "cross country ski simulator and exercise unit," in Class 28;³ and the second is Registration No. 2652123 for the mark NORDICTRACK in stylized form for goods identified as "exercise equipment,

² The later-issued of the two registrations includes a claim of ownership of the earlier-issued registration. Thus, while the copies of USPTO records herein list different registrants, we assume that assignment records would reveal common ownership. Indeed, applicant has treated the registrations as if they are owned by one entity.

³ This registration issued May 17, 1988, and the USPTO has accepted and acknowledged, respectively, Section 8 and 15 affidavits filed by the registrant.

namely, aerobic exercise equipment, treadmills, stationary cycles, cross country ski simulator machines, elliptical cross trainers, rowing machines, stair climbers, rider-type exercisers, air walker-type exercisers, spot toning exercisers, strength training machines, and stepper exercise machines," in Class 28.⁴ The mark in the second registration is set forth below.

NordicTrack

The examining attorney has asserted that NORDIC is the dominant element of the involved marks and that these marks yield similar commercial impressions. In addition, the examining attorney argues that the involved goods are related because they are all items of exercise equipment and, even though applicant's goods are specifically different than registrant's goods, they would be within the natural zone of expansion for registrant.

In support of its application, applicant asserts that the mere fact that NORDIC is the first part of each of the involved marks does not necessarily make it the dominant part of each. In regard to its own mark, applicant asserts that WALKER is the dominant part, because of its visual

⁴ This registration issued November 19, 2002.

prominence, and contends that the disclaimer of rights in that term does not preclude it from being perceived as the dominant element of the composite mark. Applicant also contends, in essence, that "Nordic" is a weak term when used on or in connection with items related to "Nordic" skiing events, so that WALKER and TRACK, respectively, will be considered the dominant elements in applicant's and registrant's marks.

To support the contention that "Nordic" has a particular connotation and must be considered weak in connection with the involved goods, applicant relies on a definition of the term retrieved from an Internet-accessible dictionary and on the asserted issuance and existence of certain third-party registrations that include the term.⁵ Applicant asserts that, as of its April 22, 2004 visit to the site, www.merriam-webster.com defines "Nordic" as meaning "of or relating to competitive ski events

⁵ Though the web-based dictionary definition was not introduced until applicant filed its brief, the examining attorney has not objected to its introduction and we have considered it. In addition, though applicant has not introduced copies of the third-party registrations and has only referred to them in a list which provides the mark, the identification of goods or services (or a portion thereof), and the registration number, the examining attorney did not object to the introduction of the list and in fact has discussed the third-party registrations. Thus, we have considered the list, though its probative value is very limited because it does not provide information on the status of any of the registrations, whether they are registered on the

involving cross-country racing, ski jumping, or biathlon," and "of, relating to, or being cross-country skiing." In its main brief, applicant generally argues that "Nordic" is weak and suggestive, but in its reply brief, applicant more forcefully argues that, as used by registrant, "Nordic" is not suggestive but is merely descriptive.

In regard to the involved goods, applicant contends that they are not competitive; that registrant's goods are expensive items of indoor exercise equipment and would not be purchased on impulse; that the classes of customers differ because registrant's goods would be marketed to consumers seeking equipment for indoor exercise, while applicant's goods would be targeted to consumers engaging in outdoor exercise; and that even if we were to assume that the goods would be sold in the same stores, they would be sold in different sections of those stores.

We analyze the issue of likelihood of confusion using the factors that were articulated in the case of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

Principal or Supplemental Registers or under Section 2(f), or whether any include disclaimers.

"The likelihood of confusion analysis considers all *DuPont* factors for which there is evidence of record but 'may focus ... on dispositive factors.'" Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002) (citations omitted).

In many cases, two key, although not exclusive, considerations are the similarities or differences between the marks and the similarities or differences of the goods and services. See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

The similarity or dissimilarity of the marks is assessed by comparing the marks as to appearance, sound, connotation and commercial impression. Herbko International Inc. v. Kappa Books Inc., 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002). Moreover, it is well-settled that marks, when compared, must be considered in their entireties, not simply to determine what points they have in common or in which they may differ. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983). Nonetheless, "there is nothing

improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Moreover, it is not a necessary prerequisite for a finding of likelihood of confusion that marks be found similar in all respects, i.e., in sight, sound and meaning, and a likelihood of confusion may be found principally on similarity in one or two of these. See, e.g., In re Sarkli, Ltd., 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) ("the [USPTO] may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark").

We agree with applicant that WALKER is the visually dominant element in its mark. On the other hand, it will not be perceived as the most dominant or distinctive portion of the mark when it is spoken, as when the goods may be asked for by name. Further, in terms of the connotation of the mark, WALKER is clearly highly suggestive or descriptive when used on or in connection

with applicant's goods,⁶ so that it is the NORDIC portion that will contribute more to any distinctive meaning the composite may have in the mind of a consumer. Moreover, we disagree with applicant's contention that NORDIC, when used in its and registrant's composite marks, will have only the connotation of certain types of skiing.

Applicant has introduced what it states is the definition of "Nordic" at www.merriam-webster.com, but did not provide a printout of that definition. In our visit to the website, we found that the definition reported by applicant is the third of three definitions for "Nordic" as an adjective; there are also three definitions for the term as a noun. Of the six definitions, five refer to "Nordic" people, i.e., of the "Germanic peoples" of Northern Europe or Scandinavia. We have also referred to Webster's Third New International Dictionary (unabridged 1993) at page 1540.⁷ This dictionary includes two listings for "Nordic" alone and a total of seven definitions, but none of them refer to skiing.

⁶ It is obvious that "hand-held poles used to enhance the exercise benefits of walking" will be used by walkers, and thus WALKER may be viewed as descriptive of a class of consumers for applicant's goods.

⁷ We may take judicial notice of dictionary definitions. See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

When used as an element of applicant's composite mark, NORDIC is more likely to be perceived as a reference to Northern Europe and/or Northern Europeans than to particular forms of skiing, because applicant's goods are not used for skiing. Similarly, the majority of the items listed in the identification of goods for cited Registration No. 2652123 (for the mark NORDICTRACK in stylized form) are not for skiing or indoor training for skiing, e.g., "treadmills, stationary cycles, ...elliptical cross trainers, rowing machines, stair climbers, rider-type exercisers, air walker-type exercisers, spot toning exercisers, strength training machines, and stepper exercise machines." Thus, when NORDIC is used as an element in registrant's composite stylized mark, and is considered in relation to these goods, it is equally likely that consumers would perceive the mark as having a more general connotation of Northern Europe and not merely of particular types of skiing. In short, we find that the connotations of the respective marks will be much the same.⁸

⁸ We note that the other cited registration, for NORDICTRACK in typed form, is for only a skiing simulator. Thus, even though the record does not establish that the skiing definition of "Nordic" is the primary definition, it may be that when registrant uses NORDICTRACK in conjunction with a skiing simulator, it will have a skiing connotation. Even then, however, we find that the predominant meaning of "Nordic" is of the people of Northern Europe or Scandinavia.

Considering the marks in regard to sight, sound and meaning, we find the similarity in sound and meaning to outweigh the differences in appearance. Thus, if these similar marks were used on or in connection with goods that would be perceived as related, confusion would be likely. Thus, we now turn to consider the goods.

As the examining attorney has observed, goods need not be competitive or even likely to be used in conjunction with each other for there to be a likelihood of confusion. It is sufficient that they are of the type that consumers would conclude that there was some relationship, as through source or sponsorship. The examining attorney has not put any evidence in the record to establish that items of indoor exercise equipment are routinely or regularly produced or marketed by the same entities that produce or market hand-held poles for use in outdoor walking or running. Nonetheless, based on the involved identifications of goods, we find it obvious that the product of applicant (its hand-held poles for walking and running) and many of those of registrant (treadmills, stair climbers, air walker-type exercisers, and stepper exercise machines) are likely to be marketed to the same class of consumers, e.g., those who walk or run for exercise.

We are not persuaded that applicant and registrant must be viewed as marketing their products to different classes of consumers simply because registrant's products are for stationary, indoor use and applicant's product is for outdoor use. Applicant has provided no support for its contention that indoor exercisers and outdoor exercisers are distinctly different groups. We find it more likely that an individual who enjoys walking for exercise would be likely to do it indoors or outdoors, as the individual's schedule and the weather permit, and that such an individual would be a prospective purchaser of both products.

We also are unpersuaded that confusion will be avoided because registrant's products are asserted by applicant to be more expensive than applicant's product. While there is nothing in the record about the costs of the respective products, we accept for the sake of argument that registrant's goods are more expensive and purchasers of the same would be deliberative. It does not follow, however, that purchasers of registrant's goods, or those who may have considered purchasing registrant's goods but have not actually done so, will be deliberative in their purchasing decisions when contemplating a purchase of what applicant admits are its less expensive goods.

Finally, applicant has provided no support for its contention that items of indoor exercise equipment and outdoor exercise equipment are routinely sold in different sections of stores. Intuitively, it would seem that exercise products would be sorted in stores not by whether the activities are engaged in outdoors or indoors but rather, by the type of activity.

Based on the similarities in the marks, the related nature of the involved goods, and their likely marketing to the same class of consumers, we find that confusion is likely. We do not agree with applicant's argument that refusing registration of applicant's mark is tantamount to providing registrant with the exclusive right to use NORDIC in conjunction with exercise, fitness and/or sporting activities. Each application must be considered on its own merits, vis a vis marks previously registered. See In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Refusal of registration to applicant in this instance is simply that, a refusal to register applicant's mark for the identified goods, and has no bearing on the examination of future applications by applicant or others for other marks.

Decision: The refusal of registration under Section 2(d) is affirmed.