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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Great Neck Saw Manufacturers, Inc.

Serial No. 76170516

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Before Seeherman, Quinn, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On November 24, 2000, Great Neck Saw Manufacturers, Inc. (applicant) applied to register the mark TOOLS FOR THE PROFESSIONAL (typed) on the Principal Register for goods ultimately identified as:

Power tools namely saws, sanders, impact wrenches, grinders, star drivers, nut drivers, drills, bits for drills, driver bits, knives, grinding wheels, caulking guns, ratchets and ratchet drives, crimping tools, glue guns, screwdrivers, hammers, wire brushes, parts and fittings for all of the aforesaid goods in International Class 7.

The application was originally based on an intent to use the mark in commerce, but subsequently, applicant filed an amendment to allege use.¹ With the amendment to allege use, applicant also amended the application to seek registration on the Supplemental Register, and it submitted a disclaimer of the word "tools."

The examining attorney² has refused to register applicant's mark on the ground that the mark, as used on or in connection with the identified goods, so resembles the registered mark TOOLS FOR PROFESSIONALS (typed) for:

retail and wholesale store services and mail order catalog services all in the field of hand tools used in building construction and repair, namely automatic taping tools, drywall benches and lifts, brick cutters, texture brushes, bull floats, caulk guns, carpenter's chalk, mason' chisels, circle cutters, clamps, cornerbead tools, corner rollers, stud crimpers, darbys, edgers, floats, glitter, gloves, groovers, grout bags, hammers and hatchets, hawks, jointers, taping knives, utility knives, tool belts and pouches, levels, lifters, measuring tapes, mixers, mud pans, concrete placers, metal punches, rasps, rivet tools, sanders, saws, scaffolds, scrapers and scratchers, shovels, aviation snips, squares, staplers, stilts, stud shears, tampers, texture guns, texture sprayers, texture roller covers, brick tongs, [and] trowels in International Class 35

¹ The amendment to allege use asserts a date of first use of December 1, 2002, and a date of first use in commerce of December 1, 2001. Inasmuch as the amendment was filed in October of 2002, the 2002 date is clearly a typographical error and, in the event that the mark is eventually approved for registration on the Supplemental Register, this error will need to be corrected.

² The current examining attorney was not the original examining attorney in this case.

as to be likely to cause confusion, to cause mistake or to deceive. 15 U.S.C. § 1052(d). The registration (No. 2,519,212) contains a disclaimer of the word "Tools" and it is registered under the provision of Section 2(f) of the Trademark Act. 15 U.S.C. § 1052(f).

When the refusal was made final, applicant filed a notice of appeal.

The examining attorney maintains that the "marks are nearly identical in sound, appearance, and meaning" and that "applicant's goods and registrant's services are overlapping and highly related." Examining Attorney's Brief at 4 and 9. Applicant submits that the marks "look different, sound different and have different meanings." Applicant's Brief at 3. Applicant also points out that "the cited mark is for services, not goods. A mark for services is different from a mark for goods." Applicant's Brief at 6.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the

evidence of record on these factors, we must keep in mind that "[t]he 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." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor we will consider is the similarities or dissimilarities of the marks. Applicant's mark, TOOLS FOR THE PROFESSIONAL, and registrant's mark, TOOLS FOR PROFESSIONALS, have obvious similarities. Indeed, the only differences involve the fact that applicant's mark refers to "professional" in the singular and registrant's mark refers to "professional" in the plural. As a result of using the singular, applicant includes the definite article "the." The marks TOOLS FOR THE PROFESSIONAL and TOOLS FOR PROFESSIONALS would be pronounced very similarly and they would also look nearly the same.³ It is very questionable whether prospective purchasers, upon seeing or hearing the marks, would take note of the slight differences between

³ Applicant's argument concerning how its mark is displayed on its specimens is irrelevant inasmuch as applicant has presented the mark for which it seeks registration in typed form. Registrant's mark is also displayed in typed form and, even if applicant had displayed its mark in stylized form, the difference in stylization would not be relevant. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) ("[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display").

the marks. While applicant argues that the two marks are completely different because "the cited reference refers to many professionals [while applicant's] mark is addressed to one individual" (Applicant's Brief at 4), the difference between tools for "the professional" or "professionals" is slight indeed. Use of the singular form instead of the plural form is not significant here. Wilson v. Delaunay, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) ("It is evident that there is no material difference, in a trademark sense, between the singular and plural forms of the word 'Zombie' and they will therefore be regarded here as the same mark"). Both marks mean that the tools are designed for professionals.

We must consider the marks in their entireties to determine if they are similar. Also, we take into consideration that "[s]ide by side comparison is not the test," Grandpa Pigeon's of Missouri, Inc. Borgsmiller, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973), and that "[h]uman memories ... are not infallible." In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), quoting, Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970). In this case, when we consider the marks, we conclude that the similarities in sound, appearance, and meaning far outweigh

any differences. The overall commercial impressions of the marks are virtually the same.

Another important factor in determining likelihood of confusion is the similarity of the goods and services of the applicant and registrant. Applicant's goods include "power tools namely saws, sanders, impact wrenches, grinders, star drivers, nut drivers, drills, bits for drills, driver bits, knives, grinding wheels, caulking guns, ratchets and ratchet drives, crimping tools, glue guns, screwdrivers, hammers, and wire brushes."

Registrant's mark is for retail and wholesale store services and mail order catalog services all in the field of hand tools used in building construction and repair. Among the items registrant sells in connection with its retail, wholesale, and mail order services are caulk guns, hammers, tapping knives, utility knives, sanders, and saws. Registrant sells hand tool versions of many of applicant's power tools. Thus, at least in part, registrant's services involve selling items that are functionally identical to applicant's.

Applicant points out that its application is for goods but the cited registration involves services.⁴ The Federal Circuit has addressed this issue in a similar case.

The only aspect of this case which is unusual is that the marks sought to be registered are for services while the prior registration on which their registration is refused is for wares. Considering the facts (a) that trademarks for goods find their principal use in connection with *selling* the goods and (b) that the applicant's services are general merchandising -- that is to say *selling* -- services, we find this aspect of the case to be of little or no legal significance. The respective marks will have their only impact on the purchasing public in the same marketplace.

In re Hyper Shoppes (Ohio) Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (emphasis in original).

The services in the Hyper Shoppes case involved general merchandise store services. In this case, registrant's services are even more closely related. Instead of simply being for general merchandise services, registrant's retail and wholesale store and mail order services involve selling hand tool versions of applicant's identified goods. We conclude that power tools, namely, caulk guns, hammers, taping knives, utility knives,

⁴ While applicant argues that "the goods and services [are] so different from each other that they are placed in separate classifications" (Applicant's Brief at 8), the classification of goods and services does not establish that goods or services are or are not related. See 15 U.S.C. § 1112 ("The Director may establish a classification of goods and services, for convenience of Patent and Trademark Office administration, but not to limit or extend the applicant's or registrant's rights").

sanders, saws, and other tools are related to the retail and wholesale store and mail order services of selling the hand tool versions of these items. The question is not whether the goods and services are identical or even used together but whether prospective purchasers would assume that the goods of applicant and the services of registrant come from, or are associated with, the same source. Therefore, the goods and services are related and the purchasers would likely include many of the same consumers.

To the extent that applicant is arguing that its goods are not impulse purchases made after careful selection, there is no evidence of record on this subject. Furthermore, there is no reason apparent in the record why purchasers of screwdrivers, hammers, wire brushes, glue guns, and saws would necessarily be careful or sophisticated purchasers.⁵ Also, even if the purchasers are sophisticated, it would not lead to a conclusion that there was not a likelihood of confusion. In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999) (“[E]ven careful purchasers are not immune from source confusion”).

⁵ The mere fact that applicant’s mark is TOOLS FOR THE PROFESSIONAL does not act as a limitation for its identification of goods. Applicant’s identification of goods is not limited and we must assume that the goods move through “the normal and usual channels of trade and methods of distribution.” CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983).

Here, when the marks TOOLS FOR THE PROFESSIONAL and TOOLS FOR PROFESSIONALS are used on closely related goods and services, even sophisticated purchasers are likely to assume that the goods and services emanate from the same source.

In addition, applicant argues that there has been no actual confusion in this case and that it has adopted its mark in good faith. Inasmuch as there is no evidence as to the nature and extent of the use of the marks, there is little basis to find that the lack of actual confusion is significant. Even if there were evidence of the use of the marks, the "lack of evidence of actual confusion carries little weight." Majestic Distilling, 65 USPQ2d at 1205. Also, the fact that applicant may have adopted its mark in good faith cannot permit the registration of a confusingly mark.

Another factor we have considered is the strength of the registered mark. The marks in this case, TOOLS FOR PROFESSIONALS and TOOLS FOR THE PROFESSIONAL, are not arbitrary or suggestive marks. The cited mark is registered under the provision of section 2(f) and applicant seeks registration on the Supplemental Register, thus indicating that the phrases themselves are or were descriptive of the respective services and goods. However,

"even weak marks are entitled to protection against registration of similar marks, especially identical ones, for related goods and services." In re Colonial Stores, 216 USPQ 793, 795 (TTAB 1982); In re The Clorox Co., 578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978) (ERASE for a laundry soil and stain remover held confusingly similar to STAIN ERASER, registered on the Supplemental Register, for a stain remover).

When we consider the facts that the marks in this case are very similar in sound, appearance, meaning, and commercial impression; registrant's services and applicant's goods are closely related; and the other facts of record, we conclude that confusion is likely. We add that if we had any doubts about this conclusion, we would resolve them, as we must, in favor of the prior registrant and against the newcomer. In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973); Hyper Shoppes, 6 USPQ2d at 1026.

Decision: The examining attorney's refusal to register applicant's mark TOOLS FOR THE PROFESSIONAL for the identified goods on the ground that it is likely to cause confusion with the cited registration is affirmed.