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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re REMS-WERK Christian Föll und Söhne GmbH & Co.

Serial No. 76458557

Beate Boudro, Esq. for REMS-WERK Christian Föll und Söhne GmbH & Co.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Hairston, Holtzman and Cataldo, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

REMS-WERK Christian Föll und Söhne GmbH & Co. (a German corporation) has appealed from the final refusal of the trademark examining attorney to register the mark REMS for goods ultimately identified as follows:

Threading machines; power-driven threading tools; die heads; power-driven tube extractors; power-driven pipe expanders; power-driven pipe benders; power-driven pipe cutters; power-driven pipe deburrers; power-driven pipe cleaning machines; gas-operated soldering torches; power-operated

saws; electric welders for welding plastic pipes; power saw blades; dies for pipe threading; metal clamps for holding brackets, pipes and rods on a machine tool table; nipple chucks for internal clamping of pipe pieces; power-operated pipe cleaning tools comprised of a drain cleaning cable, a cable drum and accessories thereto; reciprocating pipe saws and circular metal saws; machines for pipe grooving; cutter wheels; power-driven pipe cutting and pipe chamfering tools; power-driven pumps for pressure and tightness tests of piping systems and receptacles and for pumping liquids; electrical water pumps for pressure and tightness test of piping systems and receptacles and for plumbing liquids; power-driven crimping tools in class 7; and

Hand tools, namely threading tools; tube extractors; tube expanders; pipe benders; pipe cutters; pipe deburrers; hand-operated pipe cleaning tools comprised of a drain cleaning cable, a cable drum and accessories thereto and; hand tools, namely; dies for pipe threading; ratchet handles for receiving die heads; hand tools, namely; metal clamps for pipes and rods, pipe roll groovers; pipe cutter wheels; hand-operated pipe shears; hand-operated pipe cutting and pipe chamfering tools; hand tools, namely pipe wrenches and crimping tools; hand tools, namely pipe tongs for making pipe pressure joints in class 8.¹

¹ Application Serial No. 76458557, filed on October 16, 2002. The application also covers goods and services in classes 4, 6, 9, 11, 20 and 37. The examining attorney has not refused registration of the goods and services in these classes. The application was filed based on an allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act as to all the goods and services in the application. With respect to certain goods/services, the application also was filed pursuant to Section 44(d); applicant later submitted a certified copy of its German Registration No. 3023955. As to other goods/services, the application also was filed pursuant to Section 44(e) based on ownership of German Registration No. 2096441.

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C 1052(d), in view of the previously registered mark REM LINE for "tool chests and tool boxes."²

Applicant and the examining attorney have filed briefs³, but an oral hearing was not requested.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. duPont 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, 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).

² Registration No. 681,316 issued July 7, 1959; second renewal.

³ With his brief, the examining attorney has submitted a dictionary definition. We grant his request that we take judicial notice of the definition. The Board may take judicial notice of dictionary definitions. *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).

Turning first to the marks, the examining attorney argues that REM is the dominant portion of the registrant's mark, that the additional word LINE is descriptive, and that REM and applicant's mark REMS are substantially similar in sound, appearance, connotation and commercial impression. Thus, the examining attorney argues that the marks REM LINE and REMS are very similar. The examining attorney submitted an excerpt from The American Heritage Dictionary of the English Language (Third edition 1992) wherein the word "**line**" is defined, inter alia, as "[m]erchandise or services of a similar or related nature: carries a complete line of small tools."

Applicant, however, argues that:

Although the Proposed Mark and Registrant's Mark have three letters (REM) in common, the two marks have a dissimilar appearance because the Proposed Mark consists of a single four-letter term "REMS" while the registrant's mark consists of a two-word combination of "REM" and the word "LINE." The two marks are also dissimilar in sound because the Proposed Mark "REMS" contains the clearly audible letter "S" at its end, which is missing in the Proposed Mark and the Proposed Mark comprises the additional word "LINE." (Brief at p. 11).

Further, applicant argues that this case is comparable to *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 USPQ 529 (CCPA 1970) [PEAK PERIOD for personal deodorants not confusingly similar to PEAK

for dentrifice] and The Conde-Nast Publications, Inc. v. Miss Quality, Inc., 507 F.2d 1404, 184 USPQ 422 (CCPA 1975) [COUNTRY VOGUES for women's dresses not confusingly similar to VOGUE for magazines].

Our consideration of the marks is based on whether applicant's mark and registrant's mark, when compared in their entireties are similar in terms of sound, appearance, connotation and commercial impression. Although the marks must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Furthermore, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Considering registrant's mark REM LINE, based on the dictionary definition submitted by the examining attorney, the word LINE is highly suggestive, if not descriptive, of registrant's goods. That is, the word LINE indicates that registrant offers a "line" of containers for carrying tools. Thus, it is clear that the dominant portion of registrant's mark, as asserted by the examining attorney, is the term REM, which is substantially similar in sound, appearance and connotation to applicant's mark REMS. The additional "S" in applicant's mark REMS does not serve to distinguish the marks. Nor does the fact that registrant's mark consists of two words whereas applicant's mark is a single term. Rather, based on our analysis of the marks, when considered in their entirety, REMS and REM LINE are similar in sound, appearance, connotation and are likely to create similar commercial impressions in the minds of prospective purchasers.

Applicant's reliance on the cases of Colgate-Palmolive Co. v. Carter-Wallace, Inc., supra and Conde-Nast Publications, Inc. v. Miss Quality, Inc., supra is not persuasive of a different result. The additional wording in those cases had a greater impact on the commercial impression of the marks. In this case, the highly

suggestive word LINE has little impact on the commercial impression of the cited mark.

This brings us to the goods. The examining attorney argues that registrant's tool chests and tool boxes, on the one hand, and applicant's tools, on the other hand, are related because such goods may be bought by the same purchasers. Further, the examining attorney contends that a tradesperson could carry applicant's tools in a tool chest or tool box. The examining attorney also argues that applicant's tools are within registrant's "zone of natural expansion." In support of his position that the goods are related, the examining attorney has submitted a large number of third-party registrations which he maintains show that "'hand tools' and 'tool chests and tool boxes' [are] sold under the same mark." (Brief at p. 4).

Applicant, however, argues that its goods are not identical or similar to registrant's goods. Applicant contends that its goods are used in pipe working, and in particular, for sanitary and heating installation. Further, applicant argues that the trade channels and purchasers are different. According to applicant, its goods are sold by plumbing tool dealers to sophisticated purchasers, namely, plumbers and installers of sanitary equipment, whereas registrant's goods are sold in home

improvement stores to "do-it-yourselfers". Insofar as the third-party registrations submitted by the examining attorney are concerned, applicant maintains that none of the registrations covers applicant's types of plumbing tools. In addition, applicant maintains that none of the third-party registrations supports the examining attorney's "zone of natural expansion."

Further, applicant submitted the declaration of its managing director, Dr. Rudolf Wagner, who states, in pertinent part:

4. I am familiar with REMS-WERK's U.S. trademark application Serial No. 76/458,557 and have reviewed the identification of goods and services. The trademark REMS has been in continuous use in commerce between Germany and the United States on most of the goods and services listed in this application for at least the past 5 years, and in connection with some of the goods in International Classes 07 and 08 for the past 22 years.

5. Any issues with regard to the REMS trademarks, including any instances of actual confusion, would immediately come or be brought to my attention.

6. I am aware that the mark REM LINE in U.S. Registration No. 0681316 for "tool chests and tool boxes" has been cited by the U.S. Patent and Trademark Office against REMS-WERK's U.S. trademark application on likelihood of confusion grounds.

7. During all the years of the use of the REMS trademarks in the United States, I am not aware of, and to the best of my knowledge and belief, there has never been, any instance of an actual

confusion of REMS-WERK's REMS trademarks in connection with the goods in this application or the goods of REMS-WERK's [prior] registration of the mark REMS, on the one hand, and the trademark REM LINE in U.S. Reg. No. 0681316, on the other hand.

The question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); and The Chicago Corp. v. North American Chicago Corp., 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used or intended to be used therewith, to 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 each parties' goods or

services. In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

In this case, we find that applicant's and registrant's goods are sufficiently related that, if sold under the respective marks, there would be a likelihood of confusion. There are no limitations as to trade channels or purchasers in either applicant's application or the cited registration. In the absence thereof, we must presume that registrant's tool chests and tool boxes are sold in all normal channels of trade for goods of this type, including plumbing tool dealers and home improvement stores, to all the usual classes of purchasers, including plumbers, sanitary installers and do-it-yourselfers.

Insofar as applicant's goods are concerned, we recognize that some of applicant's goods, on their face, appear to be specialized in nature such that they would be sold only by plumbing tool dealers to plumbers and sanitary installers (e.g., power-driven tool extractors, electrical water pumps for pressure and tightness test of piping systems and receptacles and for pumping liquids, and hand-operated pipe cutting and pipe chamfering tools). However, there is nothing inherent in the nature of certain of applicant's goods that they would be sold only by plumbing tool dealers to plumbers and sanitary installers (e.g.

power-operated saws, power saw blades, metal clamps for holding brackets, pipes and rods on a machine tool table in class 7; and clamps for pipes and rods, ratchet handles for receiving die heads, pipe wrenches in class 8). Thus, in the case of these goods, we must presume that they are sold in all normal channels of trade for goods of this type, including plumbing tool dealers and home improvement stores, to all the usual classes of purchasers, including plumbers, sanitary installers, and do-it-yourselfers. In short, the trade channels and purchasers of applicant's and registrant's goods are overlapping.

In addition, tool chests and tool boxes, on the one hand, and tools that may be carried therein, on the other hand, are complementary goods. Here, applicant's power saw blades, metal clamps for holding brackets, pipes and rods on a machine tool table, pipe wrenches and pipe cutters, for example, appear to be the types of tools that may be carried in a tool chest or tool box. In fact, applicant itself sells an "Electric die stock with quick-change die heads" in a "sturdy steel case" and "Single-hand tube bender" in a "sturdy steel case." Also, applicant sells as a separate item a "steel case" for its own reciprocating saw blades. See applicant's 2002 Product catalog, pages 12, 60, and 39 respectively. Thus, applicant's types of

tools that may be carried in a tool chest or tool box and registrant's tool chests and tool boxes are complementary goods.

In view of the complementary nature of certain of the goods and the overlapping trade channels and purchasers, we find that the goods of applicant and registrant are related.

We have reached this finding without giving much weight to the third-party registrations submitted by the examining attorney in his attempt to show a relationship between the goods. These registrations cover tool chests and/or tool boxes, on the one hand, and various types of hand tools, on the other hand. However, as applicant correctly points out, none of these registrations covers applicant's types of tools. Thus, the registrations are not particularly probative, in and of themselves, of whether tool chests and/or tool boxes and applicant's types of tools may emanate from, or are otherwise associated with a single source. Also, the third-party registrations do not support the examining attorney's contention that applicant's types of tools are within the registrant's zone of natural expansion. Nonetheless, for the reasons discussed above, we find that applicant's tools and registrant's tool chests and tool boxes are related goods.

Two additional arguments made by applicant require comment. Applicant argues that its goods are sold to sophisticated purchasers. Of course, applicant's assertion is based on the fact that applicant's goods are sold by plumbing tool dealers to plumbers and sanitary installers. As noted above, applicant's identification of goods is not restricted to such purchasers through such trade channels, and must be deemed to include do-it-yourselfers who would not be expected to exercise great care in their purchasing decisions. In any event, even assuming that the purchasers of applicant's goods are sophisticated, this does not mean that such purchasers are immune from confusion as to the origin of the respective goods, especially when sold under similar marks. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); and *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999).

Finally, according to applicant, there have been no instances of actual confusion notwithstanding the coexistence of applicant's mark and the mark in the cited registration. However, there is no evidence of applicant's and registrant's geographic areas of sales, or the amount of the sales under the respective marks. Further, there is no information about whether registrant has experienced any instances of confusion. In any event, the test is

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likelihood of confusion, not actual confusion. See *Weiss Associated Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984).

Finally, to the extent we have any doubt, we resolve it as we must, in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes*, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

Decision: The refusal to register under Section 2(d) is affirmed as the goods in both classes.