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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Menard, Inc.

Serial No. 76538809
Serial No. 76538810

Ernest Grumbles III and Danielle I. Mattessich of Merchant
& Gould P.C. for Menard, Inc.

Florentina Blandu, Trademark Examining Attorney, Law Office
117 (Loretta C. Beck, Managing Attorney).

Before Grendel, Drost and Cataldo, Administrative Trademark
Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant's appeals of the final refusals issued in
each of the above-captioned applications are hereby
consolidated and shall be decided in this single opinion.

In Serial No. 76538809, applicant seeks registration
of the mark depicted below



for goods identified in the application as "whirlpools, bathtubs, toilets, and sinks sold exclusively through applicant's home improvement retail stores," in Class 11.

In Serial No. 76538810, applicant seeks registration of the mark **AQUALUX** (in standard character form) for the same goods.¹

In each of the applications, the Trademark Examining Attorney has issued a final refusal to register the mark as to the goods identified as "whirlpools," "bathtubs," and "sinks,"² all of which are "sold exclusively through applicant's home improvement retail stores." The basis for the refusal in each application is that applicant's mark so resembles the mark **AQUALUX**, previously registered (in standard character form) for goods identified in the

¹ Both of these applications were filed on August 20, 2003, and are based on applicant's asserted intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

² In her Office action denying applicant's Request for Reconsideration in each application, the Trademark Examining Attorney expressly withdrew the Section 2(d) refusal as to "toilets." In view thereof, each application will proceed to registration as to "toilets sold exclusively through applicant's home improvement retail stores."

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registration as "water filtration units for domestic use; water treatment equipment, namely, cartridge filtration units," in Class 11, and "portable water dispensers," in Class 21, as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant has appealed the final refusal in each of the applications. Applicant and the Trademark Examining Attorney have filed main appeal briefs. After careful consideration of all of the evidence of record and the arguments of counsel, we affirm the refusal to register in each of the applications.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The first *du Pont* factor requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra*. The test, under the first *du Pont* factor, 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 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). Furthermore, although the marks at issue 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 Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applying these principles in the present case, we find that each of applicant's marks is similar to the cited

registered mark. Applicant's standard character mark, AQUALUX, indeed is identical to the cited registered mark in terms of appearance, sound, connotation and overall commercial impression. Although perhaps not identical, applicant's AQUALUX and design mark is highly similar to the cited registered mark in terms of appearance, sound, connotation and overall commercial impression. The only difference applicant's design mark and the cited registered mark is the presence in applicant's mark of the non-distinctive oval background carrier device in which the word AQUALUX prominently appears. However, it is the word AQUALUX which dominates the commercial impression and source-indicating significance of applicant's mark, and which therefore must be accorded greater weight, in our comparison of the marks, than the mark's minimal design element. See *In re Chatam International Inc.*, *supra*; *In re National Data Corp.*, *supra*. We do not ignore the design element, but we find that it does not suffice to distinguish applicant's mark from the cited registered mark when the marks are viewed in their entireties.

Contrary to applicant's argument, it is immaterial that applicant and registrant may use their marks in conjunction with house marks or with other additional wording in their advertisements. For purposes of

determining the registrability of applicant's marks, our analysis of the similarity of the marks must be based solely on the marks as they are depicted in the application and the registration, respectively.

For these reasons, we find that applicant's standard character AQUALUX mark is identical to the cited registered AQUALUX mark, and that applicant's design mark is highly similar to the cited registered mark. We find that the first *du Pont* factor accordingly weighs heavily in favor of a finding of likelihood of confusion.

We turn next to the second *du Pont* factor, which requires us to determine the similarity or dissimilarity of the goods identified in applicant's application vis-à-vis the goods identified in the cited registration. It is settled that it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. It is sufficient that the goods be related in some manner, or that the circumstances surrounding their use be 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 a mistaken belief

that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods.

See In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Furthermore, it is settled that the greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods and the registrant's goods that is required to support a finding of likelihood of confusion. Where the applicant's mark is identical to the registrant's mark, as it is in this case (with respect to applicant's standard character mark), there need be only a viable relationship between the respective goods in order to find that a likelihood of confusion exists. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); and *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Applicant goods at issue herein are identified as "whirlpools, bathtubs, ... and sinks sold exclusively through applicant's home improvement retail stores." The

goods identified in the cited registration include "water filtration units for domestic use; water treatment equipment, namely, cartridge filtration units." Applicant is correct in contending that these respective goods are different and non-competitive in terms of nature and function. However, as noted above, that is not the test under the second *du Pont* factor. We find that applicant's and registrant's goods are sufficiently related that source confusion is likely to result if they are marketed under the identical and/or highly similar marks at issue in this case.

The record shows that at least two third parties, Francke Faucets and Natural Choice, manufacture and sell both sinks and water filtration equipment. See the printout from the website www.plumbingworld.com attached to the Trademark Examining Attorney's final office action, which includes links to product categories including "sinks for the kitchen by Francke" and "replacement filters for Francke." The website www.designerplumbing.com similarly displays product listings for "Francke GNX110-18 EuroPro Sink" and "Francke MHX 710 Manor House Farm Sink," as well as for "Francke Filter Replacement Cartridge." The Natural Choice website (www.steamsaun.com) lists among its product categories "water filters" and "sinks and faucets."

The record also establishes that water filtration units and systems, on the one hand, and sinks, bathtubs and whirlpools, on the other hand, are related and complementary products, in that water filters can be and are installed and used to filter water in bathroom and kitchen sinks, showers and bathtubs, and whirlpools. Indeed, "Under Sink" units are one category of water filter system, as is shown by, *inter alia*, the website www.excelwater.com ("Under Sink Water Filtration Units" product category); the website www.home-water-purifiers-and-filters.com ("Under Sink Water Filter ... No under sink water filter system on the market offers such an attractive bundle of features ... The filtration unit mounts under your sink, out of sight..."); and the website www.realestatejournal.com ("many consumers are ... installing a variety of home-filtration systems, including ... elaborate under-sink systems").

The complementary relationship between applicant's and registrant's respective products is also established by other Internet evidence of record, such as:

www.realestatejournal.com (Eliminating fuss is the main focus of Clear Flow's mounted water filter, which is available for both kitchen and bathroom sinks");
www.pureelements.biz ("Whole House Water Filter");

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www.puresta.com ("Puresta Twinfilter - water for spas, jacuzzis"); www.omnifilter.com ("Whole house water filter; we make water filters for the do-it-yourselfer..."); www.superiorwatersupplies.com ("shower filters"); www.filters2000.com ("national distributor for Sprite shower filters, also counter top and under counter systems"); www.moen.com ("Aguasuite Water Filtration System... ideal for kitchen or bath installation ... filter easily installs under your sink"); www.aquasana.com ("RHINO Whole House Water Filtration System ... You can enjoy bottled water quality throughout your entire home, in your showers, sinks, bathtubs..."); www.multipure.com ("wonderfully delicious water filters right at your kitchen or bathroom sink"; and www.doultonusa.com (water filter "conveniently hides under the sink").

We note, finally, that one of applicant's own advertisements, made of record by applicant in response to the first office action, displays on the same page and in close proximity both applicant's AQUALUX products and a third party's (Omni) under counter "Reverse Osmosis Water Filtration System." A homeowner undertaking a kitchen or bathroom redecorating project which includes installation or replacement of a sink, bathtub or whirlpool is likely to also be in the market for a water filtration system to be

installed at the same time and as part of the same project. Applicant itself advertises these products side-by-side.

Based on this evidence, we find that applicant's goods and registrant's goods, as identified in the applications and the registration, respectively, are sufficiently related and complementary that purchasers are likely to assume the existence of a source connection if the goods are or were to be marketed under the confusingly similar marks involved in this case. The second *du Pont* factor accordingly weighs in favor of a finding of likelihood of confusion.

Under the third *du Pont* factor, we find that applicant's goods and registrant's goods, as identified in the applications and the registration, respectively, are or could be marketed in the same trade channels and to the same purchasers. With respect to trade channels, and as noted above, applicant's own advertisements display both sinks and water filtration systems in close proximity to each other. This evidence shows that these types of goods are or can be marketed in exactly the same trade channels.

We acknowledge that applicant's identification of goods in each application specifically limits applicant's goods to those which are "sold exclusively through applicant's home improvement retail stores." However, the

identification of goods in the cited registration includes no restrictions or limitations as to trade channels.

Applicant's declarant Mr. Radtke, who is identified as applicant's Merchandising Manager of the Plumbing Department, asserts that applicant currently does not sell registrant's AQUALUX products in applicant's stores.

However, nothing would preclude applicant from carrying registrant's products in the future. In any event, even if registrant's and applicant's products were not to be sold in the same stores, purchasers still would be likely to encounter both products and, given the complementary nature of the goods, they would be likely to assume that a source connection exists.

With respect to classes of purchasers of the respective goods, we find that they are the same. These purchasers would include ordinary homeowners who are redecorating or updating a kitchen or bathroom. When they are installing or replacing a new sink, bathtub or whirlpool, they likely also would be in the market for a water filtration system or unit to be installed at the same time or as part of the same project.

For these reasons, we find that the trade channels and classes of purchasers for applicant's and registrant's respective goods are similar or the same. The third *du*

Pont factor accordingly weighs in favor of a finding of likelihood of confusion.

The fourth *du Pont* factor requires us to consider the purchasing conditions in which the products are marketed, including the care with which they would be purchased. Again, we find that the purchasers of these goods would include ordinary homeowners, who would have only a normal degree of sophistication and who might be expected to exercise only a normal amount of care in purchasing these goods. Applicant contends that some of its whirlpools sell for approximately two thousand dollars. Although those particular items might be purchased with a greater degree of care, there is no evidence that the rest of applicant's goods, nor registrant's goods, are so expensive that extra care would be exercised in their purchase. We find that the fourth *du Pont* factor is neutral, at best, in our likelihood of confusion analysis.

We turn finally to the sixth *du Pont* factor, which requires us to consider the number and nature of similar marks in use on similar goods. Applicant's third-party registration evidence is not probative evidence of third-party use of AQUALUX marks. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). In any event, applicant has submitted only two

third-party registrations of AQUALUX marks, each of which are for goods which are quite different from the goods involved herein. We find that the sixth *du Pont* factor is neutral, at best, in this case.

More generally with respect to the strength of the registered mark, applicant argues that AQUALUX is a weak or highly suggestive term as applied to the registrant's goods, and that the scope of protection to be afforded the registered mark should be narrowed accordingly. We are not persuaded. Although AQUALUX is somewhat suggestive in that it combines AQUA, connoting water, and LUX, which arguably connotes "deluxe," we find that the mark nonetheless is inherently distinctive and should receive the normal scope of protection to which a distinctive mark is entitled.

Considering all of the evidence of record as it pertains to the *du Pont* likelihood of confusion factors, and for the reasons discussed above, we conclude that a likelihood of confusion exists as between applicant's AQUALUX sinks, bathtubs and whirlpools sold in applicant's stores, and registrant's water filtration units and equipment sold under the same mark. These goods are not identical, but they are complementary and related, and would be purchased by the same homeowners who would use both products in connection with their kitchen or bath

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redecorating or upgrade projects. We find that applicant's goods and registrant's goods certainly are sufficiently closely related that confusion is likely to result from the use of the identical and/or highly similar marks involved in this case. To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts against applicant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, *supra*.

Decision: The refusal to register in each application as to the goods identified as whirlpools, bathtubs and sinks is **affirmed**. In view of the Trademark Examining Attorney's prior withdrawal of the refusal as to "toilets," the identification of goods in each application shall be **amended** to "toilets sold exclusively through applicant's home improvement retail stores," and the applications, as amended, shall proceed to **publication**.