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May 12, 2006
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Group Design, Inc.

Serial No. 76586402
Serial No. 76586403
Serial No. 76586404
Serial No. 76586405

Ray R. Regan of Law Office of Ray R. Regan, P.A.. for The Group Design, Inc.

Sean W. Dwyer, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Quinn, Hohein and Zervas, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

The Group Design, Inc. has filed applications to register in standard character form on the Principal Register the marks "MERLIN I,"[1] "MERLIN SPORT & WORK,"[2] "MERLIN II"[3] and

[1] Ser. No. 76586402, filed on March 24, 2004, which is based on an allegation of a bona fide intention to use the mark in commerce.

[2] Ser. No. 76586403, filed on March 24, 2004, which is based on an allegation of a bona fide intention to use the mark in commerce. The phrase "SPORT & WORK" is disclaimed.

[3] Ser. No. 76586404, filed on March 24, 2004, which is based on a allegation of a bona fide intention to use the mark in commerce.

"MERLIN PROFESSIONAL"[4] for, in each instance, "knife sheaths" in International Class 8.

Registration has been finally refused in each case under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's marks, when applied to its goods, so resemble the mark "MERLIN TOOL," which is registered in standard character form on the Principal Register for "hand tools, namely screwdrivers, spanners, pliers, and hammers" in International Class 8,[5] as to be likely to cause confusion, mistake or deception.

Applicant, in each case, has appealed. Briefs have been filed, but an oral hearing was not requested. Because the issue of likelihood of confusion is substantially the same in each instance, the appeals are being treated in a single opinion. We affirm the refusal to register in each case.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion

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[4] Ser. No. 76585405, filed on March 24, 2004, which is based on an allegation of a bona fide intention to use the mark in commerce. The word "PROFESSIONAL" is disclaimed.

[5] Reg. No. 1,929,250, issued on October 24, 1995, which sets forth a date of first use anywhere of July 26, 1993 and a date of first use in commerce of December 16, 1993; renewed. The word "TOOL" is disclaimed.

analysis, two key considerations are the similarity of the goods and the similarity of the marks.[6]

Turning first to consideration of the respective goods, applicant argues in each of its initial briefs that (underlining in original):

> The goods are wholly unrelated. The goods are not related or marketed in a way that the respective goods would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, so even if the marks were identical, confusion is not likely. ....
>
> Knife sheaths are not even "tools." They are, at best, <u>holders</u> for tools.
>
> The knife sheaths of Applicant are arbitrarily associated with "hand tools" only to accommodate an inordinately broad category of goods included within International Class 008 ("Hand Tools"), probably having an historical antecedent in the absence of any other readily apparent alternative classification under which to include an item such as a knife sheath.
>
> Knife sheaths are no more "hand tools" than some other items capriciously, if not whimsically[,] forced into Classification 008, including, for example, aprons, belts, electrolysis apparatus, forks, leather strops, and similar goods arbitrarily aggregated under Classification 008.
>
> The use of Classification 008 is merely for the convenience of placing the knife sheath somewhere; but the evident inflexibility of the International Classification system for goods ought not to be the basis for rejecting the instant Application.

[6] The court, in particular, pointed out that: "The 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."

> Thus, Applicant submits that the goods associated with the Registered Mark, and the goods of the Applicant, are unrelated. ....

We agree with the Examining Attorney, however, that the goods at issue are related to the extent that, if marketed under the same or similar marks, confusion would be likely to occur as to their source or sponsorship. As the Examining Attorney correctly points out in each of his briefs, it is well settled that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same entity or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978); and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). Thus, as the Examining Attorney also properly notes:

> The fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein.

Here, the Examining Attorney asserts that "the evidence submitted with the final refusal shows that both the goods of the applicant and the goods of the registrant ... are often made by

the same manufacturers and sold under the same mark."[7] Specifically, the Examining Attorney refers to "copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods ... as those of applicant and registrant ...." According to the Examining Attorney, "[t]hese printouts have probative value to the extent that they serve to suggest that the goods ... listed therein, namely knife sheaths and hand tools, are of a kind that may emanate from a single source." The Examining Attorney contends, furthermore, that such "evidence shows [that] manufacturers often make knifes, knife sheaths,

[7] Applicant, in its reply brief, characterizes the Examining Attorney's evidentiary submission as a showing which "seeks to expand his argument that the goods are 'related' by reference to a large number of indiscriminately assembled computer printouts from a data base search (collectively, 'Printouts')." In particular, applicant states that it "rejects the implication either that any inductive leap germane to the issues before the Board may be presumed from the Printouts, or that the Printouts either individually or collectively may be considered as evidence in this proceeding" for the reasons, among other things, that "[t]he Printouts ... do not comply with the Trademark Manual of Examining Procedure ('TMEP'), §710.01 *et seq.*," in that they "do not indicate the specific search conducted; do not indicate all libraries or files searched; do not indicate in narrative form the results of the search; do not indicate if the Examining Attorney reviewed all search results; and give no indication if all results of the search are included for the Board's review." Applicant's criticisms, however, which are obviously taken from the requirements for presenting "Evidence From Research Database[s]" as set forth in TMEP §710.01(a), are without merit inasmuch as the Examining Attorney, with the exception of copies of definitions of "sheath" from two electronic dictionaries, has not otherwise relied upon evidence from a research database and the information made of record from the two dictionary sources sufficiently complies with the provisions of TMEP §710.01(a). The Examining Attorney, instead, primarily relies upon copies of third-party registrations, taken from Office records, and various Internet excerpts, all of which respectively comply with the guidelines set forth in TMEP §710.01(b) ("Internet Evidence") and TMEP §710.03 ("Evidence of Third-Party Registrations"). In addition, it should be noted that it is simply not the case that the Examining Attorney has burdened the record with "an undifferentiated mass of accumulated Printouts," as charged by applicant in its reply brief.

sheaths for tools and hand tools such as pliers, screwdrivers and hammers and market them using the same trademark." In view thereof, the Examining Attorney maintains that "a consumer buying a knife and/or a knife sheath ... could reasonably presume [that] the same manufacturer also made screwdrivers, pliers and sheaths for said products."

Moreover, the Examining Attorney observes that "the MSN Encarta dictionary definition of sheath, attached to the final refusal, defines the term as a 'close fitting covering; a covering or case that fits closely around something in the way that a sheath covers a blade'." Similarly, we note, that while not mentioned by the Examining Attorney, the record also contains a definition from the Wordsmyth dictionary which lists such term in relevant part as meaning "1. a tight[-]fitting case for the blade of a sword, knife or the like" and "2. any of various similar coverings." In consequence thereof, the Examining Attorney argues that "sheaths are not merely made for knives, [but that] they are also made for other goods such as hand tools, [like] the registrant's goods." Additionally, with respect to "the Internet evidence included in the ... final refusal," the Examining Attorney urges that such evidence "clearly shows that knife sheaths are often sold for and in combination with the registrant's goods." In particular, the Examining Attorney points to an "advertisement from 'The Tool Peddler'" in arguing that:

> [T]his piece of evidence, as well as the related evidence [noted below], is important to show that the applicant's goods, "knife

> sheaths," are often sold in combination with and made for the registrant['s] goods. For example, the combination "TOOL/UTILITY KNIFE SHEATH #449" is specifically made for knives and pliers, [the latter being] one of the registrant's goods. .... Further evidence such as the search of "THE OLD HOUSE WEB" and "SEARS" websites show[s] that sheaths are not only made for knives, they are also made for and sold in combination with hand tools, such as screwdrivers, spanners and pliers. .... The evidence taken as a whole clearly shows sheaths, both knife sheaths and tool sheaths, are closely related to the registrant's hand tools.

Although applicant, in reply, insists that "the Examining Attorney directs our attention to not a single example among the voluminous Printouts in which a manufacturer who makes knives <u>also uses the same trademark for sheaths</u>--more than likely because the world at large would consider sheaths not to be 'tools' under International classification 008" (underlining in original), the evidence submitted by the Examining Attorney is sufficient to demonstrate that applicant's knife sheaths are indeed closely related to registrant's screwdrivers, spanners, pliers and hammers. Specifically, it is settled that while use-based third-party registrations are not proof that the different marks shown therein are in use or that the public is familiar with them, it nevertheless is the case that such registrations have some probative value to the extent that they serve to suggest that the various goods listed therein are of the kinds which may emanate from a single source. <u>See</u>, <u>e.g.</u>, In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 at n.6 (TTAB

1988), *aff'd as not citable precedent*, No. 88-1444 (Fed. Cir. Nov. 14, 1988).

In this regard, the Examining Attorney has made of record copies of at least eight use-based third-party registrations in which, in each instance, a mark is registered in International Class 8 for products which include, like applicant's goods on the one hand and registrant's goods on the other, such pairs of items as: (i) "knives and sheaths" and "screwdrivers, ... wrenches, ... pliers, ... [and] hammers";[8] (ii) "knife sheaths" and "hammers, ... pliers ..., ratchet wrenches ..., [and] screwdrivers"; (iii) "knife sheaths" and "screwdriver[s]"; (iv) "knife sheaths" and "hammers ... [and] screwdrivers"; (v) "knife sheaths" and "screwdrivers" ... [and] pliers"; (vi) "sheaths for knives" and "pliers ... [and] screwdrivers"; (vii) "rigging knife and leather sheath[s]" and "wrenches, ... pliers, ... [and] hammer[s]"; and (viii) "[knife] sheaths" and "pliers." Here, the registrations introduced by the Examining Attorney serve to confirm the obvious, namely, that knives and accessories therefor, including utility knives and their sheaths for use in construction, remodeling and/or hobbyist

[8] We judicially notice, in this regard, that a "wrench" is also known as a "spanner." See, e.g., The American Heritage Dictionary of the English Language (4th ed. 2000), which at 1666 defines "spanner" in relevant part as a noun meaning "**1.** A wrench having a hook, hole, or pin at the end for meshing with a related device or another object. **2.** *Chiefly British* A wrench." It is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852, 860 n. 7 (TTAB 1981).

activities, are often available from the same source that makes or provides such hand tools as screwdrivers, pliers, hammers, and wrenches or spanners.

Moreover, as the Internet evidence introduced by the Examining Attorney makes clear, some knife sheaths can in fact also be used to hold narrow tools other than a utility knife, such as a pair of pliers or even a screwdriver, wrench or hammer. For instance, the "Tool/Utility Knife Sheath #449" mentioned by the Examining Attorney and available from "The Tool Peddler" at http://www.toolpeddler.com, is touted for such features as: "Holds knives and narrow tools." Applicant, in this regard, even admits that its knife sheaths, while not hand tools, are nevertheless "holders for tools." Furthermore, the Internet excerpts make plain that knife sheaths, like the knives which they are designed to fit, are often sold through the same channels of trade as such hand tools as screwdrivers, wrenches (or spanners), pliers and/or hammers, namely, hardware stores (e.g., "Aubuchon Hardware" and "Ace Hardware") and other tool retailers (e.g., "Northern Tool & Equipment Catalog Co."), including department stores (e.g., "Sears"). Accordingly, while applicant's knife sheaths are not themselves hand tools like knives are, because such sheaths are nonetheless a commonly available accessory for knives, they are closely related in a commercial sense to other everyday hand tools like registrant's screwdrivers, spanners, pliers and hammers and would be purchased by the same classes of consumers through identical channels of trade. If, therefore, applicant's and registrant's goods were to

be sold under the same or similar marks, confusion as to the origin or affiliation thereof would be likely to occur.

Turning to consideration of the marks at issue, applicant argues that when considered in their entireties, each of its marks is so dissimilar from registrant's mark in appearance, sound, connotation and commercial impression as to preclude any likelihood of confusion. Applicant contends, in particular, that unlike registrant's "MERLIN TOOL" mark, none of its marks contains the word "TOOL." Moreover, while not offering any specific discussion in its main briefs as to the additional differences in either its "MERLIN I" mark or its "MERLIN II" mark when compared to registrant's mark, applicant notes in its reply briefs that such marks, unlike registrant's mark, feature Roman numerals. As to its other marks, applicant asserts in its main briefs that, in light of the phrase "SPORT & WORK" in its "MERLIN SPORT & WORK" mark and the word "PROFESSIONAL" in its "MERLIN PROFESSIONAL" mark, "[i]t seems evident that the meaning and connotation of the word components of the two marks are different" in each instance from registrant's mark.

We concur with the Examining Attorney, however, that despite the differences pointed out by applicant, the marks at issue are sufficiently similar, especially in terms of overall commercial impression, as to be likely to cause confusion. In particular, as he properly notes in his briefs, a side-by-side comparison of the respective marks is not the proper test to be used in determining the issue of likelihood of confusion inasmuch as it is not the ordinary way that customers will be exposed to

the marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the concomitant lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is accordingly on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See, e.g., Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973); Envirotech Corp. v. Solaron Corp., 211 USPQ 724, 733 (TTAB 1981); and Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975).

Moreover, the Examining Attorney is also correct that while the marks at issue must be considered in their entireties, including any generic or descriptive matter therein, our principal reviewing court has indicated that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "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 [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive or generic with respect to the involved goods ... is one commonly accepted rationale for giving less weight to a portion of a mark ...." Id.

With the above principles in mind, we agree with the Examining Attorney that, when considered in their entireties, the

dominant and distinguishing portion of the marks at issue is the term "MERLIN." Clearly, as the Examining Attorney observes, the word "TOOL" in registrant's "MERLIN TOOL" mark is generic for its hand tools, as confirmed by the disclaimer of such word, and thus has essentially no source-indicative significance. Similarly, as the Examining Attorney also notes, the phrase "SPORT & WORK" in applicant's "MERLIN SPORT & WORK" mark as well as the word "PROFESSIONAL" in its "MERLIN PROFESSIONAL" mark are descriptive with respect to applicant's knife sheaths, as evidenced by the disclaimers thereof, and consequently have little source-distinguishing significance. In a similar vein, consumers are likely to regard the Roman numerals in applicant's "MERLIN I" mark and its "MERLIN II" mark merely as model or grade designations for its knife sheaths, much like they would view the descriptive terms "SPORT & WORK" and "PROFESSIONAL" in its other "MERLIN"-based marks as designating the uses and/or applications for its goods, and thus would not attribute much in the way of source-distinguishing significance to the presence of either the Roman numeral "I" or "II."

Accordingly, notwithstanding the differences between applicant's marks and registrant's mark in overall appearance, sound and connotation, the Examining Attorney convincingly notes in each of his briefs that: "The term MERLIN, the dominant term in each of the marks, is what is impressed upon the consumer as the source identifier," with the differences therein, in each instance, serving to "add little if anything to the overall commercial impression of a mark." Because, in each case, the

"dominant portion of the applicant's mark ... is identical to the dominant portion of the registrant's mark[,] ... confusion [is] likely."

We therefore conclude that consumers and prospective customers who are familiar or acquainted with registrant's "MERLIN TOOL" mark for "hand tools, namely screwdrivers, spanners, pliers, and hammers," would be likely to believe, upon encountering applicant's similar "MERLIN I," "MERLIN SPORT & WORK," "MERLIN II" and "MERLIN PROFESSIONAL" marks for, in each instance, "knife sheaths," that such closely related goods emanate from, or are sponsored by or associated with, the same source.

Decision: The refusals under Section 2(d) are affirmed as to each application.