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Mailed: 9/5/03

Paper No. 18

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Eagle Instruments, Inc.

Serial No. 78/050,941

Vicki Frazier, Esq. of American Eagle Instruments, Inc.

Dezmona J. Mizelle, Trademark Examining Attorney, Law  
Office 110 (Chris Pedersen, Managing Attorney).

Before Simms, Seeherman and Chapman, Administrative  
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

American Eagle Instruments, Inc. (applicant), a  
Montana corporation, has appealed from the final refusal of  
the Trademark Examining Attorney to register the mark TALON  
TOUGH ("TOUGH" disclaimed) for "dental instruments, namely  
curettes, scalers, explorers, angle forms, pluggers,  
carvers, chisels, excavators, burnishers, and margin  
trimmers having stainless steel tips for diagnostic,  
periodontal, hygiene, composite, operative, and endodontic

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use."<sup>1</sup> The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), on the basis of Registration No. 1,873,018, issued January 10, 1995 (Section 8 affidavit accepted, Section 15 affidavit acknowledged), for the mark TALON for "interocclusal dental appliances; namely, nightguards, antibruxism appliances, TMJ splints, myofascial pain dysfunction splints, and sleep disorder appliances," in Class 10, and "plastic molding compounds; namely a polymer composition for use in the manufacture of molded plastic articles," in Class 1. Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

We affirm.

The Examining Attorney argues that applicant's mark TALON TOUGH for its dental instruments so resembles the registered mark TALON for dental appliances and plastic molding compounds that confusion is likely. In comparing the marks, the Examining Attorney argues that one part of a mark may be more significant in creating a commercial impression--in this case the inherently distinctive word "TALON" in applicant's mark rather than the descriptive and disclaimed word "TOUGH." With respect to the goods, the

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<sup>1</sup> Application Serial No. 78/050,941, filed March 1, 2001, based upon allegations of use since March 10, 1992.

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Examining Attorney contends that applicant's dental instruments are sufficiently related to registrant's dental appliances and other goods that confusion as to source is likely. These goods are related, according to the Examining Attorney, because they are used in the same field (dentistry) and are sold to and used by the same class of purchasers (dentists and dental hygienists). The Examining Attorney states that applicant's dental instruments may be used during dental examinations and procedures while registrant's goods are used as a result of dental examinations and diagnoses. Finally, the Examining Attorney asks us to resolve any doubt in favor of registrant.

The Examining Attorney has made of record third-party registrations allegedly showing that goods similar to applicant's and registrant's may emanate from the same source and be sold under the same trademark. The Examining Attorney contends that purchasers of applicant's goods may, therefore, expect that both dental instruments and related dental products such as appliances will come from the same source if sold under similar marks.

It is applicant's position, on the other hand, that the marks TALON and TALON TOUGH create different commercial impressions and that, moreover, registrant's mark is

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suggestive because it suggests that registrant's product expands and contracts with one's mouth or jaw, and is weak because of the existence of third-party marks. In this regard, applicant points to third-party registrations for the mark TALON for curved needle drivers, for a device for immobilizing a patient's head during medical procedures and for balloon catheters. While applicant admits that both registrant's dental appliances and applicant's dental instruments are used in the dental field and are bought and used by the same classes of purchasers (dentists and dental hygienists), applicant maintains that the goods are nevertheless different and noncompetitive and have different uses and different end users (dentists and dental hygienists v. patients). In this regard, applicant states that a dentist would measure for and order registrant's goods, and that the registrant would have direct contact with the professional in order to make the dental appliances.

Furthermore, applicant argues that dentists and dental hygienists are sophisticated and discriminating buyers who would know the source of the dental instruments they are purchasing and would not be confused as to their source. Applicant maintains that these purchasers carefully select the product they use for their particular needs.

Applicant's attorney also states that there have been no instances of actual confusion since applicant's first use in 1992.

With respect to the third-party registrations, which the Examining Attorney has made of record, applicant points out that none of registrant's goods are specifically listed in those registrations. Applicant also asks us to take judicial notice of such definitions as "occlusal" ("of or relating to the grinding or biting surface of a tooth or occlusion of the teeth") and "bruxism" ("the habit of unconscious gritting or grinding of the teeth esp. in situations of stress or during sleep").<sup>2</sup>

In response, the Examining Attorney argues that, of the third-party registered marks, only three are in the medical field and just one (registrant's) is in the dental field. Also, the fact that a purchaser may be sophisticated or knowledgeable in a particular field does not mean that the purchaser is immune to confusion as to source or that he or she will not confuse similar trademarks, according to the Examining Attorney.

Our determination under Section 2(d) of the Act is based on an analysis of all of the probative facts in

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<sup>2</sup> We shall do so. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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evidence that are relevant to the factors bearing on the likelihood-of-confusion issue. See *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Two key considerations are the marks and the goods or services. *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.").

Furthermore, likelihood of confusion may be found when the goods are not the same or even competitive, it being sufficient if they are related in some way or that the circumstances under which they are marketed are such that persons encountering the goods would assume a relationship or common source because of the similarity of the marks. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Opus One Inc.*, 60 USPQ2d 1812, 1814-15 (TTAB 2001); and *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1898 (TTAB 1989). As the Court of Appeals for the Federal Circuit stated in the case of *Recot, Inc. v. M.C. Becton*, 214 F.3d 1332, 54 USPQ2d 1895, 1898 (Fed. Cir. 2000):

[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.

See also, *Bose Corporation v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309-1310 (Fed. Cir. 2002) ("Hence the products as described in the pertinent registrations are not the same. But they are related as required by DuPont."); and *Hewlett-Packard Company v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services").

Upon careful consideration of this record and the arguments of the attorneys, we conclude that confusion is likely. First, concerning the marks, the first word in applicant's mark TALON TOUGH is the more arbitrary and dominant portion and is identical to the registered mark. This is "a matter of some importance since often it is the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." *Presto*

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*Products v. Nice Pak Products*, 9 USPQ2d 1825, 1827 (TTAB 1988).

Contrary to applicant's argument that the registered mark TALON is suggestive of registrant's goods, at the very most this word, which signifies the claw of a bird of prey, is only vaguely suggestive of registrant's nightguards, antibruxism appliances, TMJ splints, and sleep disorder and other appliances. And, even if the registered mark were considered suggestive and weak in terms of its trademark significance, it is well established that a weak mark is entitled to protection against the registration of the same or a substantially similar mark for identical and/or closely related goods, and that confusion is to be avoided as much between weak marks as between strong marks. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974); *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 114 (TTAB 1978); and *In re Textron Inc.*, 180 USPQ 341 (TTAB 1973), citing *Eastern Industries, Inc. v. Waterous Co.*, 289 F.2d 952, 129 USPQ 422, 424 (CCPA 1961).

While we agree with applicant that the respective goods are not identical or competitive, we do agree with the Examining Attorney that they are related products sold to the same classes of purchasers in the same field.

Although dentists and dental hygienists are not average purchasers of the general public for these goods, this does not mean that they would not confuse the source of dental instruments and dental appliances when such goods are sold under the very similar marks TALON and TALON TOUGH.

It is our opinion that a dentist familiar with registrant's TALON dental appliances such as nightguards, TMJ splints, and other appliances, which he had distributed to patients, who then encounters applicant's TALON TOUGH dental instruments such as angle forms, pluggers, excavators, and margin trimmers is likely to believe, in view of the similarity of these marks, that applicant's TALON TOUGH instruments are a line or an extension of registrant's TALON dental appliances, or vice versa. In this regard, the Examining Attorney has made of record some evidence that both dental instruments, on the one hand, and dental appliances similar to registrant's, on the other, may come from the same source.<sup>3</sup> For example, one third-party registration (Reg. No. 543,962, issued June 19, 1951, third renewal) lists such goods as drills, burnishers, carvers, chisels and excavators, on the one hand, and plastic fillings, on the other. Plastic fillings could

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<sup>3</sup> We have disregarded those third-party registrations which are based on Section 44 of the Act and not on use in commerce.

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well be made from the polymer compositions listed in registrant's registration. Another registration (Reg. No. 1,376,831, issued January 7, 1986, partial Section 8 affidavit accepted) lists such dental equipment as angles and scalers, on the one hand, and retainers, wedges and tooth protectors, on the other, similar to registrant's nightguards, antibruxism and sleep disorder appliances.

We agree with applicant that dentists and dental hygienists are not ordinary members of the purchasing public. However, "even careful purchasers are not immune from source confusion." *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999). See also *In re Hester Industries, Inc.*, 231 USPQ 881, 883 (TTAB 1986) ["While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products"].

And, if we had any doubt concerning this issue, that doubt, in accordance with precedent, must be resolved in favor of registrant. In this regard, it is the duty of the Board to afford rights to registrants without constantly subjecting them to the financial and other burdens of opposition proceedings. See *In re Dixie Restaurants, Inc.*,

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105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Majestic Distilling Company, supra*.

Although applicant's attorney has represented that there have been no instances of actual confusion, such unsubstantiated statement is entitled to little weight. *Majestic Distilling Co., supra*, 65 USPQ2d at 1205 ("With regard to the seventh DuPont factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value."). Moreover, we have no information of record concerning the nature and extent of applicant's and registrant's sales and advertising or whether the respective goods are even sold in the same geographic areas. That is to say, the absence of evidence of actual confusion is offset by the absence of evidence that there has been a substantial opportunity for actual confusion to have occurred (i.e., evidence of an overlap in the respective actual trade channels). In these circumstances, we cannot conclude that the apparent absence of actual confusion is entitled to significant legal weight in the likelihood-of-confusion analysis. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992).<sup>4</sup>

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<sup>4</sup> The dissent makes a point of indicating that applicant's goods are different from registrant's because they are made of metal

Decision: The refusal of registration is affirmed.

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and would therefore "be fabricated in a different place, e.g., a factory, and in a different manner" from registrant's appliances. There is simply nothing in the record concerning these statements, and, in any event, we are mindful of what the Court noted in *Majestic Distilling, supra*, at 1204 (in a case involving entirely different goods (sold to the general public) from those involved herein, but nevertheless relevant to the extent that dentists and hygienists may not be aware of or concerned with an allegedly different manufacturing process):

The PTO responds, and we agree, that malt liquor and tequila are similar by virtue of the fact that both are alcoholic beverages that are marketed in many of the same channels of trade to many of the same consumers. Although the PTO apparently found no evidence of any manufacturer who both brews malt liquor and distills tequila, *Majestic* has not shown that the PTO's lack of evidence in that regard is relevant. Unless consumers are aware of the fact, if it is one, that no brewer also manufactures distilled spirits, that fact is not dispositive. The DuPont factors require us to consider only "trade channels," which may be, but are by no means necessarily, synonymous with manufacturing channels. In this case, *Majestic* has not demonstrated that consumers distinguish alcoholic beverages by manufacturer rather than brand name.

We also note that various goods in some of the third-party registrations are also apparently made of differing substances. Here, as in *Majestic*, all the goods are admittedly sold in the same channels of trade to the same classes of purchasers.

The dissent has also engaged in much judicial notice concerning the practice of dentistry and the knowledge of dentists and dental hygienists, matter which is simply not in the record (for example, "Dentists are sophisticated about the dental industry, and about the manufacturing and selling practices within that industry"). This case should be decided on the record and any reasonable inferences that can be drawn from it.

Given the limited resources of the Office, we believe that a sufficient relationship between the respective goods has been demonstrated.

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Seeherman, Administrative Trademark Judge, dissenting:

I respectfully dissent from the majority's decision to affirm the refusal of registration. I believe that the Office has failed to prove the relatedness of applicant's goods to those listed in the cited registration.

Aside from the fact that applicant's goods and the registrant's are used by dentists and go in people's mouths, the only evidence to show relatedness are third-party registrations made of record by the Examining Attorney. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993), stands for the proposition that third-party registrations which individually cover a number of different items and which are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods and/or services are of a type which may emanate from a single source.

In this case, the Examining Attorney has submitted twelve third-party registrations in an effort to show that goods such as those identified in applicant's application and the cited registration emanate from a single source. However, a closer examination of these registrations reveals that half are based, not on use in commerce, but on Section 44 of the Trademark Act. Third-party registrations which have issued under Section 44(e) of the Act, 15 U.S.C.

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1126(e), without any use in commerce basis, have very little persuasive value. Id. These registrations include many classes, and cover a wide range of goods, from windows to sunglasses to cures to paint brushes (Registration No. 2,495,400), and do not show that such goods are likely to emanate from a single source and be sold under a single mark.

There are six third-party registrations which are based on use in commerce. However, a closer look at these registrations shows that they seem to have been made of record only because the identifications contain words which are found in the applicant's identification and that of the cited registration. For example, Registration No. 1,793,554 includes a dental instrument "to remove plaque and food particles from the teeth and dental appliances." Obviously, this does not show that the registrant uses the mark on dental appliances of the type identified in the cited registration. Similarly, the listing of the "instruments and appliances for use in dentistry" in Registration No. 1,509,907 does not include any of the appliances identified in the cited registration; they are items such as "cotton roll holders." Two of the registrations (Nos. 1,167,128 and 1,196,155) which are owned by Healthco, Inc., are clearly house marks, and cover

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goods ranging from irrigation sets for irrigating foley catheters to dental tray covers to orthopedic appliances to enema sets; even with this broad list, the goods identified in the cited registration do not appear.

The majority refers specifically to Registration Nos. 543,962 and 1,376,831 as evidence that "dental appliances similar to registrant's" may come from the same source as dental instruments. As a general comment, I do not believe that the Board should interpret Trostel so broadly as to treat third-party registrations for goods which might be similar to, but not the same as, the goods in the cited registration and application as showing that the goods in the cited registration and application may emanate from a single source. Trostel makes it clear that the probative value of the third-party registrations is limited (it specifically notes that third-party registrations are not evidence that the marks shown therein are in commercial use). The fact that goods listed in a third-party registration may be related to goods in the cited registration or application does not show that the goods in the cited registration and application are of a type which may emanate from a single source.

With respect to Registration No. 543,962, the majority states that the "plastic fillings" listed in this

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registration "could well be made from the polymer compositions listed in registrant's registration." The identification in the cited registration, however, is for "plastic molding compounds, namely a polymer composition for use in the manufacture of molded plastic articles," in Class 1. Clearly, these molding compounds are used to make the registrant's nightguards, etc., rather than plastic fillings. Even assuming that plastic molding compounds could be used to fill cavities, if the registrant's goods could be used for this purpose they would fall in Class 10, as do the goods in Registration No. 543,962, not in Class 1.<sup>5</sup> To the extent that the majority suggests that the "plastic fillings" identified in Registration No. 543,962 encompass already molded plastic (perhaps something in the nature of a plug that fits into a cavity?), even if the cited registrant's polymer compositions could be used to manufacture such a supposed article, the third-party registration does not demonstrate that "plastic molding compounds, namely a polymer composition for use in the manufacture of molded plastic articles," and plastic

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<sup>5</sup> In point of fact, Registration No. 543,962 issued in U.S. class 44, prior to the adoption by the United States of the International Classification system. U.S. Class 44 is the equivalent of International Classes 5 and 10, as the registration indicates. It most definitely would not include goods in International Class 1.

fillings would be sold by the same source under a single mark.

The majority also points to Registration No. 1,376,831 as listing "such dental equipment as angles and scalers, on the one hand, and retainers, wedges and tooth protectors, on the other..." The majority states that the latter goods are similar to registrant's nightguards, antibruxism and sleep disorder appliances. However, there is no evidence in the record to show that retainers, wedges and tooth protectors are "similar to" the nightguards, antibruxism appliances, sleep disorder appliances, etc. listed in the cited registration.<sup>6</sup> Certainly, they are not the same goods.

Accordingly, the third-party registrations submitted by the Examining Attorney do not prove that the goods identified in applicant's application and the cited registration would emanate from the same source and be sold under a single mark. As a result, the only "evidence" to show that the goods are related is that they are all dental devices that would be used in a patient's mouth. However, I do not believe that this is a sufficient basis on which

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<sup>6</sup> In fact, retainers, wedges and tooth protectors would be appliances used during dental procedures or to maintain an arch.

to find the goods related, such that the use of similar marks on both is likely to cause confusion.

Dentists and, to a limited extent, dental hygienists, are the only purchasers/users of both applicant's and the registrant's products.<sup>7</sup> They are obviously sophisticated purchasers, as the majority acknowledges. They will not assume that, simply because goods are used in dentistry, (or even used in the mouth), all such goods come from the same source if they are sold under similar marks. In this case, the goods identified in the application and the cited registration are so different in nature and composition that dentists would not expect them to emanate from the same source. Specifically, the dental instruments identified in applicant's application are standard sized items which are made with metal, and would be fabricated in a different place, e.g., a factory, and in a different manner, from those identified in the cited registration. Goods such as nightguards and antibruxism appliances are made of molded plastic, and are made to fit the particular patient. As applicant indicates, a dentist would measure

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<sup>7</sup> Dental hygienists would use certain of the instruments identified in applicant's application as part of the dental cleaning/prophylaxis procedure. By the very nature of their job, they would not fit nightguards and the other interocclusal dental appliances identified in the cited registration, but might come in contact with such goods if they assist dentists in fitting them.

for and order registrant's goods, and the registrant would have direct contact with the professional in order to make the dental appliances. The makers of these nightguards and other appliances would be more in the nature of a laboratory than a factory that makes dental instruments.

Dentists are sophisticated about the dental industry, and about the manufacturing and selling practices within that industry, e.g., they would know the types of products that are made by laboratories and those that are not. The fact that, as the Examining Attorney states, applicant's dental instruments may be used during dental examinations and procedures while registrant's goods are used as a result of dental examinations and diagnoses, is not sufficient to establish that dentists would assume that these various goods would emanate from the same source. There is no evidence to show that this is a practice in the dental industry. Indeed, the fact that the Examining Attorney apparently conducted a thorough search of Office records and was unable to produce any third-party registrations listing both the goods identified in applicant's application and the cited registration indicates that such goods do not emanate from a single source. See *In re Federated Department Stores, Inc.*, 3 USPQ2d 1541, fn. 2 (TTAB 1987) (we must assume that the

three excerpts selected provide the best support of the Examining Attorney's refusal to register available from that source).

The majority opinion makes the point (as does the Examining Attorney) that even sophisticated purchasers are not immune from source confusion. I do not dispute that general proposition. Thus, in a situation such as that quoted in the majority opinion, with substantially identical marks applied to related products, even a sophisticated purchaser is likely to assume that the products emanate from the same source. Similarly, if goods are the same, and there are only slight differences between the marks, a sophisticated purchaser may not note such differences. However, in this case, because the purchasers are sophisticated about the practices of the industry itself, they will not see applicant's and the registrant's goods as related, and therefore are not likely to believe that the goods emanate from the same source, even though they are sold under similar marks.

I would reverse the refusal of registration.