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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hagemeyer North America, Inc.

Serial No. 78582380

Sidney R. Brown of Jones, Day for Hagemeyer North America,
Inc.

Katherine Stoides,¹ Trademark Examining Attorney, Law Office
101 (Ronald R. Sussman, Managing Attorney).

Before Walters, Grendel and Drost, Administrative Trademark
Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark **VERSAPRO**, in standard character form, for Class
17 goods identified in the application, as amended, as:

Tape, namely, pipe joint sealant tape, masking
tape, duct tape, adhesive tape for sealing
cartons, and strapping tape for industrial and

¹ A different Trademark Examining Attorney handled this case
prior to appeal.

commercial use; heavy duty air and water hoses made of rubber for industrial and commercial use; and heavy duty air and water hoses made of plastic for industrial and commercial use.²

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that the mark, as applied to the goods identified in the application, so resembles the mark **VERSAPRO**, previously registered³ on the Principal Register (in standard character form) for

Air compressors, tool bits for machines, bits for power drills, drill chucks for power drills, electric handle-held drilling machines and parts therefor, pile drivers, pneumatic hammers, impact wrenches, hydraulic jacks, electric knives, air brushes for applying paint, power-driven wrenches, extension bars for power tools, power tools, namely drills, routers, saws, screwdrivers, shears, wrenches and ratchet wrenches

in Class 7, and

Bits for hand drills, blades for hand saws, manual jacks, pocket knives, garden tools, namely trowels, weeding forks, spades, hoes, hand tools, namely pliers, shovels, wrenches, screwdrivers, hammers, saws, scrapers, ratchet wrenches, socket

² Serial No. 78582380, filed on March 8, 2005. The application is based on applicant's asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

³ Reg. No. 2540609, issued on February 19, 2002. Affidavits under Sections 8 and 15 accepted and acknowledged.

sets, clamps, drills, planners [sic - planers?],
tweezers, knives, scissors

in Class 8, as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).⁴

Applicant and the Trademark Examining Attorney have filed appeal briefs. After careful consideration of the evidence of record and the arguments of counsel, we affirm the Section 2(d) refusal to register.

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

⁴ Another issue identified in the Trademark Examining Attorney's appeal brief is the outstanding requirement for a more definite identification of goods, i.e., a clarification of whether the words "for industrial and commercial use" after the words "strapping tape" modify only "strapping tape" or also modify the other tape products listed prior to "strapping tape." Applicant has not responded to or addressed this issue in its appeal brief. For purposes of our Section 2(d) decision herein, we will interpret the words "for industrial and commercial use" as modifying each of the types of tape listed in the identification of goods. This assumption does not affect our decision on the Section 2(d) refusal on appeal. In the event that our decision affirming the Section 2(d) refusal is reversed on appeal, the application will have to be remanded to the Trademark Examining Attorney for issuance of an examiner's amendment in accordance with the provisions of TMEP §1402.13.

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).

We begin with the first *du Pont* factor, which 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*. We find that applicant's VERSAPRO mark is identical in every respect to the cited registered VERSAPRO mark. The first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The second *du Pont* factor requires us to determine the similarity or dissimilarity of the goods as recited in the application and in the cited registration. It is settled that it is not necessary that the 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. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). 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). Finally, in cases such as this where the applicant's mark is identical to the cited registered 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 (TTAB 2001); and *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Applying these principles in the present case, we find that certain of the goods identified in applicant's application and certain of the goods identified in the cited registration are similar and related, for purposes of the second *du Pont* factor.⁵ In particular, we find that

⁵ If confusion is likely as to any of the goods or services identified in a particular class in an application, Section 2(d)

applicant's "heavy duty air [and water] hoses made of rubber for industrial and commercial use" and "heavy duty air [and water] hoses made of plastic for industrial and commercial use" are related to the goods identified in the cited registration as "air compressors," "pneumatic hammers," and "air brushes for applying paint."

Applicant's air hoses are identified as being for industrial and commercial use. Because there is no restriction in the cited registration's identification of goods, we must presume that registrant's air compressors, pneumatic hammers, and air brushes for applying paint include those which are for industrial and commercial use.

Air hoses are components of or replacement parts for air compressors. The evidence attached to the final Office action includes a printout of the website of a company called PRI (www.pwmall.com), which offers for sale goods described as "air hose and pneumatic hose for consumer, commercial, contractor and industrial applications. Air and pneumatic hose made with EPDM rubber, PVC and reinforced polyurethane. ... Air hose and pneumatic hose

bars registration as to all of the identified goods or services in that class in the application. See *Shunk Mfg. Co. v. Tarrant Mfg. Co.*, 381 F.2d 328, 137 USPQ 881 (CCPA 1963); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1848 n.9 (TTAB 2004); *In re Alfred Dunhill Ltd.*, 224 USPQ 501, 504 (TTAB 1984); and *In re Multivox Corp. of America*, 209 USPQ 627, 632 (TTAB 1981).

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can be used with air compressors, jack hammers, nailers, pneumatic tools and staplers." The evidence attached to the first Office action shows that the Tyler Tool Company offers for sale the Makita MAC700KIT brad nailer and air compressor kit, which includes an air hose as standard equipment. See also the Porter-Cable CPFAC2600P "2 HP Air Compressor with Air Hose." Aubochoon Hardware sells the "Stanley Heavy Duty Air Hose," which is described as "one of many top quality items in our Air Compressor Hoses department." This Stanley heavy duty air compressor hose is found on the retailer's website by navigating from "Power Tools" to "Pneumatic Tools & Accessories" to "Compressors & Accessories" to "Air Compressor Hoses," a menu path which confirms that air hoses are components of or accessories to air compressors.

The evidence of record also establishes that applicant's air hoses are related to registrant's "pneumatic hammers." The PRI website noted above states that air hoses can be used with "pneumatic tools," which would include pneumatic hammers. Similarly, applicant's air hoses would be used with registrant's "air brushes for applying paint," which we presume to include air brushes used in commercial and industrial painting.

Based on the evidence of record and for the reasons discussed above, we find that applicant's heavy duty air hoses for industrial and commercial use are similar and related to the goods identified in the cited registration as air compressors, pneumatic hammers, and air brushes for applying paint. As noted above, because applicant's mark is identical to the cited registered mark, there need be only a viable relationship between the respective goods in order to support a finding of likelihood of confusion. We find that the requisite viable relationship between the goods exists in this case. The second *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The third *du Pont* factor requires us to determine the similarity or dissimilarity of the trade channels for the respective goods. Applicant's air hoses are identified as being for industrial and commercial use. Because there is no restriction in the registration's identification of goods as to registrant's air compressors, pneumatic tools, and air brushes for applying paint, we must presume that these goods are marketed in all normal trade channels for such goods. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Such normal trade channels would include the industrial and commercial trade channels in which applicant's air hoses are marketed, including in the hardware and industrial

supply trade channels. The third *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The fourth *du Pont* factor requires us to consider evidence pertaining to the conditions of purchase. To the extent that applicant's goods are identified as being for industrial and commercial use, we might presume that the purchasers of such goods are somewhat knowledgeable about the products involved. However, we cannot conclude on this record that such knowledge on the part of purchasers necessarily would eliminate the confusion likely to be caused by the use of the identical VERSAPRO mark on these related goods. See, e.g., *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). Nor does the record establish that these goods, as identified in the application and registration, are so expensive that the degree of care taken in purchasing them necessarily would immunize purchasers from confusion. For these reasons, we find that the fourth *du Pont* factor, if it weighs in applicant's favor at all, does so only slightly, and not enough to overcome the evidence of record on the other *du Pont* factors which supports a finding of likelihood of confusion.

Balancing all of the evidence of record as it applies to the relevant *du Pont* factors, we find that a likelihood of confusion exists. We have considered all of applicant's

arguments to the contrary, but we find them to be unpersuasive. To the extent that any doubts might exist as to the correctness of our conclusion that confusion is likely, 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 Section 2(d) refusal is affirmed.