

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Hearing:
September 19, 2007

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re KTS Co., LTD

Serial No. 79009205

Thomas J. Moore of Bacon & Thomas, PLLC for KTS Co., LTD

Richard F. White, Trademark Examining Attorney, Law Office
109 (Dan Vavonese, Managing Attorney)

Before Seeherman, Quinn and Holtzman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

KTS Co., LTD has appealed from the final refusal of the Trademark Examining Attorney to register POWER MAGNUM, in the stylized form shown below, and with POWER disclaimed, for goods which were ultimately amended to "air-operated hand-held tools, namely, air-operated impact wrenches, and air-operated ratchet wrenches."¹

¹ Application Serial No. 79009205, filed June 3, 2004, based on Section 66(a) of the Trademark Act, claiming a priority date of



Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark MAGNUM (in typed form), previously registered for "electrically powered tools—namely, drills and screwdrivers,"² that it is likely, when used on applicant's identified goods, to cause confusion or mistake or to deceive.

The appeal has been fully briefed, and applicant and the Examining Attorney appeared at an oral hearing before the Board.

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

January 20, 2004. It is noted that in the various responses in which applicant amended its identification of goods, applicant included a separate paragraph in which it stated that the amendment was made "without surrendering any of the scope of the previous identification of goods," and that applicant was therefore entitled to the full scope of the previous identification of goods. However, once an applicant has expressly amended the identification of goods and services to delete an item it may not be reinserted in a later amendment. See *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991). Thus, applicant cannot "reserve" its previous identifications of goods, and we have treated the identification of goods, as amended in applicant's request for reconsideration submitted on October 18, 2006, as the operative identification.

² Registration No. 1175844, issued November 3, 1981; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., 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).

Applicant's mark is POWER MAGNUM in stylized form. The cited mark is MAGNUM. Obviously the marks are similar in appearance and pronunciation to the extent that they both contain the identical word MAGNUM. Although applicant's mark is shown in stylized form, this is not sufficient to distinguish the marks. The particular type font used for the mark, and with POWER placed above MAGNUM and offset slightly to the left, is not so distinctive that consumers are likely to note or remember it. Moreover, the cited registration is for the mark in typed form, which means that the protection to be accorded the mark is not limited to any particular type font, and would extend to the font in which applicant's mark is shown. Nor does the descriptive word POWER in applicant's mark serve to

distinguish it from the registrant's mark. This word, which has been disclaimed, is descriptive of applicant's goods. Consumers will view the term as merely providing information about the goods, rather than as having source-indicating significance. Thus, the overall connotation and commercial impression of the marks, in addition to the similarities in appearance and pronunciation, are virtually the same. It is a well-established principle 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 the ultimate conclusion rests on a consideration of the marks in their entirety. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For the reasons we have given, we accord greater weight to the word MAGNUM in applicant's mark.

Accordingly, when the marks are compared in their entirety, they are similar in appearance, pronunciation, connotation and commercial impression. This du Pont factor favors a finding of likelihood of confusion.

As for the goods, there are specific differences between them, as applicant's goods are identified as "air-operated hand-held tools, namely, air-operated impact

wrenches, and air-operated ratchet wrenches" and the goods identified in the cited registration are "electrically powered tools—namely, drills and screwdrivers." As applicant points out, applicant's goods and the registrant's goods have specifically different purposes: drills may drill holes for screws and screwdrivers may drive a screw into a hole, while wrenches are used to grip nuts and bolts. Brief, p. 13. We agree that consumers will readily be able to tell the difference between drills and screwdrivers, on the one hand, and air-operated wrenches and ratchet wrenches on the other. However, it is not whether consumers are likely to confuse the goods, but whether they are likely to confuse the source of the goods that is the issue. Thus, it is not necessary that the goods or services of an applicant and a registrant be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Here, both applicant's and the registrant's goods are tools. Although they are specifically different, they can be used together, and both can be found in the same workroom. In view of the complementary nature of the goods, the du Pont factor of the similarity of the goods favors a finding of likelihood of confusion. We also note, as further support for this conclusion, that the Examining Attorney has made of record Internet evidence showing that third parties sell both air-operated tools and electrically powered tools. The website for Milwaukee products, www.milwaukeeconnect.com, shows both electric drills and pneumatic nailers and staplers; and the DeWalt website, www.dewalt.com, advertises, inter alia, drills, a pneumatic nailer trigger valve kit and pneumatic staplers. In addition, third-party registrations show that a single mark has been adopted for "pneumatic and electric tools for blowing air and driving nails, screws and staples" (Registration No. 2681753). In particular, there are third-party registrations for the same types of goods that are listed applicant's identification and that of the cited registration. See Registration No. 2872274 for, inter alia, pneumatic tools including impact wrenches, wrenches and ratchets, and for power screwdrivers and drills; Registration No. 2900086 for, inter alia, power tools,

including drills and screwdrivers, and pneumatic tools, including impact wrenches and drive ratchet wrench; Registration No. 2764298 for, inter alia, electric tools including drills and pneumatic tools, including wrenches and drills; Registration No. 3175161 for, inter alia, maintenance and power tools, including hammer drills and impact wrenches; and Registration No. 3176607 for, inter alia, cordless electric handheld power tools including drills, screw drivers and impact wrenches. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

With respect to the channels of trade, the websites that are of record do not show the specific items that are identified in applicant's identification as being offered for sale along with goods identified in the cited registration.³ However, the goods are all tools, and thus are items which can be sold in home improvement stores and the like. Moreover, there is no question that the goods

³ At the time the Examining Attorney submitted the Internet evidence, applicant's identification of goods was much broader, and the evidence did show items that were included in the identification at the time the evidence was made of record.

can be sold to and used by some of the same classes of customers; applicant acknowledged at the oral argument that its goods can be bought and used by homeowners/do-it-yourselfers. To this extent, at the very least, this du Pont factor favors a finding of likelihood of confusion.

Although neither applicant nor the Examining Attorney has discussed the factor of the conditions of purchase, we accept that these goods would be bought with some degree of care and, although they may be purchased by the general public, the consumers of power tools such as drills, and air-operated impact wrenches, would have some degree of knowledge about these items. Although to this extent this factor favors applicant, even a careful purchaser is not likely to distinguish between MAGNUM marks on the basis that one contains the descriptive term POWER.

This brings us to applicant's primary argument, which is that MAGNUM is a suggestive and "dilute" term, and that consumers can distinguish among various MAGNUM marks. In support of this argument, applicant has submitted copies of third-party MAGNUM marks, taken from the USPTO's TESS database, and excerpts from Internet websites. Applicant also has submitted a dictionary definition of "magnum," as meaning "high-powered due to a larger case and larger powder charge than other cartridges of approximately the

same caliber—used of cartridges and of weapons designed to use the cartridge,” and “magnum opus” as meaning “the greatest achievement of an artist.”

Of the eighteen third-party registrations made of record by applicant for MAGNUM per se marks, applicant has highlighted the following in its brief, presumably because applicant considers them the most relevant and persuasive:

air-applied friction disc brake units
and parts therefor used for industrial
machinery (Registration No. 2892316);

machines parts, namely, valves for
industrial fluid compressors
(Registration No. 2858248);

portable slurry pumps for construction
and restoration (Registration No.
2586581);

drilling jar amplifier tools
(Registration No. 2185428);

grinding tools for grinding machines
(Registration No. 2115877);

high performance segmented diamond
wheels for sawing, grooving and
grinding concrete/asphalt pavement and
gasoline, diesel and hydraulic powered,
liquid cooled saws for receiving said
diamond wheels (Registration No.
1418933); and

power operated airless paint sprayers,
power operated HVLP (high volume low
pressure paint sprayers), power
operated texture sprayers and parts for
the foregoing, namely airless spray
tips, airless spay guns, pressure
rollers and airless hose sold in the

home center channel (Registration No. 2745601).

The Examining Attorney pointed out at the oral argument that the last listed registration has been cancelled because the registrant did not file a Section 8 affidavit of use.

Third-party registrations may be used in the same manner as dictionary definitions, to show the meaning of a mark or a portion of a mark in the same way that dictionaries are employed. *Mead Johnson & Company v. Peter Eckes*, 195 USPQ 187 (TTAB 1977). Here, the marks that are the subject of the third-party registrations, and the evidence of third-party use, indicate that MAGNUM may have certain suggestive connotations. However, the goods listed in the third-party registrations, and which are the subject of the third-party uses, are so varied that it is not clear that MAGNUM has a single significance for such goods. Applicant argues that because "magnum opus" means the greatest achievement of an artist, MAGNUM per se "used as an adjective is suggestive of a great achievement." Brief, p. 9. In its reply brief, applicant takes this argument further, and says that because "magnum" suggests a great achievement, "magnum" in a trademark suggests a great product. We do not find this position particularly

persuasive, since it would require consumers to view MAGNUM as suggesting MAGNUM OPUS, then extrapolating from the meaning of MAGNUM OPUS in terms of artistic achievement that it means great achievement when applied to any product, and from this that MAGNUM suggests a great product.⁴ However, even if we were to accept that MAGNUM has a suggestive significance of a great achievement when it is used in connection with tools, the term can be considered only slightly suggestive. Even suggestive marks are entitled to protection against the use of similar marks for similar goods. Thus, the scope of protection of the registrant's mark extends to prevent applicant appropriating the registrant's mark in its entirety and merely adding the descriptive word POWER to it, and using it for tools that are complementary to the registrant's goods.

Third-party registrations, of course, are not evidence of the use of the marks shown therein or that the public is familiar with them. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993), supra. Applicant has, however, submitted Internet evidence that shows some third-party use

⁴ Based on the cartridge definition of "magnum," the term could just as easily suggest "high-powered." Also, another meaning of "magnum" is "a large wine bottle holding about 2/5 of a gallon." Thus, in some of the trademarks "MAGNUM" may suggest a larger size.

of MAGNUM.⁵ The webpages show or list a Quickpoint 1971 Power Caulker Magnum Quart Gun, www.epinions.com; Thunderbolt Magnum AA alkaline batteries, AAA alkaline batteries, 9V alkaline batteries, D alkaline batteries and C alkaline batteries, www.harborfreight.com; the STIHL chain saw price list which lists, as model numbers, the MS440 MAGNUM, MS260 MAGNUM, MS660 MAGNUM and MS088 MAGNUM, www.powerzoneinc.com; "Waterloo Tool Boxes MG5612BK 12 Drawer Magnum Cart-Black" for a tool cart with 3600 pound load capacity, www.toolrage.com; MAGNUM for a variety of dryer cords, www.sjgreatdeals.com; and Smith & Wesson Safety Eyewear, Magnum 3G Clear and Magnum 3G Yellow, www.professionalequipment.com.

There are also some websites which appear to be located in foreign countries, e.g., the listing for Stanley Screwdrivers Magnum Pozidriv Standard, Stanley Screwdrivers Mangum Pozidriv Long Reach and Stanley Screwdrivers Magnum Pozidriv Instrument for screwdrivers, www.shop4tools.co.uk,

⁵ In his brief the Examining Attorney states that these submissions should not be afforded any evidentiary consideration because "internet evidence introduced for the purpose of demonstrating dilution of a mark is not something that the examining attorney can consider in ex parte prosecution." p. 8. Although Examining Attorneys do not consider the ground of dilution, Internet evidence going to third-party use of a term or mark is relevant to the determination of likelihood of confusion, and we have considered applicant's evidence in our determination of this issue.

is a website with a United Kingdom url; and the BOSCH Magnum Impact Drill is from a website which appears to be located in India, www.boschindia.com. Thus, there is some question as to whether the goods listed in those webpages are sold in the United States, or whether U.S. consumers would be familiar with them. In addition, the webpage www.metabousa.com lists, under "Services," an explanation of "Magnum" as "The Metabo program of stationary and semi-stationary woodworking machines"; another webpage about the Metabo Group brand names says that "Metabo Magnum not yet available in the United States." Id.

Finally, there are pages from two other websites that applicant has made of record. The first, www.smallenginewarehouse.com, shows Kohler engines, made by Kohler, and lists an "18 HP Magnum Vertical 1" shaft Electric start with Muffler for Aztec, LP SETUP," which sells for \$1000.00. The second website, www.lincolnelectric.com, has several pages on the "Power MIG 215," which states that it "offers the autobody and sheet metal fabrication industries top welding performance." The base unit for this welding apparatus includes a "Magnum 250L gun", and recommended general options include a "Magnum Connection Kit and Magnum Spool Gun with Adapter Module & Gun Holder."

If it can be shown that the relevant purchasing public for the applicant's and registrant's goods have been exposed to numerous third-party marks using a common element, then an inference can be drawn that the public does not assume that all such goods and services emanate from a single source because of the common element, and that they will look to other elements of the marks to distinguish them. Based on the evidence of record herein, we are not persuaded that consumers will look to the word POWER in applicant's mark to distinguish it from the registrant's mark. First, many of the third-party uses are for goods that are different from applicant's and the registrant's goods, e.g., engines, welding apparatus for those in the autobody and sheet metal fabrication industries, and dryer cords. Second, many of the third parties use MAGNUM in the manner of a product mark or model number, such that consumers can differentiate among the different MAGNUM marks by another trademark that is used with MAGNUM. See, THUNDERBOLT MAGNUM batteries; WATERLOO MAGNUM tool carts; STIHL chain saws which specifically identify the MAGNUM listings as model numbers.

In the present case, however, registrant's mark is MAGNUM per se. As registered, there is no house mark or other mark appearing with it that consumers can look to as

a source-indicator. Similarly, applicant seeks registration for POWER MAGNUM, without any house mark. Although applicant's mark does contain the additional word POWER, for the reasons we have previously discussed, consumers are not likely to view this word as a distinguishing element, but will regard it as merely providing further information about the nature of the goods. Accordingly, the du Pont factor of the number and nature of similar marks in use on similar goods does not favor applicant.

The final du Pont factor on which there has been argument or evidence is that of the lack of actual confusion. With its notice of appeal applicant submitted a declaration by its president, dated November 29, 2006, stating that he was unaware of any instances of confusion. However, because applicant is a Japanese company whose application is based on Section 66(a) of the Trademark Act, and there is no indication that it has made any use of its mark in the United States, we can give no weight to the fact that there is no evidence of actual confusion. This du Pont factor, thus, is neutral.

After reviewing all the evidence and arguments with respect to the du Pont factors, we find that applicant's mark POWER MAGNUM in stylized form so resembles the mark

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MAGNUM, registered as a typed drawing, that applicant's use of its mark on its identified goods is likely to cause confusion or mistake or to deceive with respect to the cited registration. To the extent that there is any doubt on this issue, it is well established that such doubt must be resolved in favor of the registrant and prior user. In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

Decision: The refusal of registration is affirmed.