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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Workman Publishing Co., Inc.
v.
Lanard Toys, LTD

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Opposition No. 91112419
to application Serial No. 75426465

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Edward Klagsbrun of McLaughlin & Stern, LLP for Workman Publishing Co., Inc.

Paul J. Reilly of Baker Botts L.L.P. for Lanard Toys, LTD.

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Before Walters, Drost and Taylor, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On January 30, 1998, Lanard Toys, LTD (applicant) applied to register the mark WORKMAN (in typed form) on the Principal Register for "toy tools" in Class 28. The application (Serial No. 75426465) contains an allegation that applicant first used the mark anywhere and in commerce in July 1993.

After the mark was published for opposition, Workman Publishing Co., Inc. (opposer) filed a notice of opposition on November 9, 1998. Opposer alleges that it "has used its

mark WORKMAN in interstate commerce since at least as early as December 1985, in connection with a variety of toys and games" and that "priority of use belongs to Opposer." Notice of Opposition at 2. Opposer then alleges that applicant's mark, as applied to applicant's goods, is confusingly similar to opposer's mark as applied to its goods and is likely to cause confusion, mistake, or deception under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)). In its answer, applicant denied the salient allegations of the notice of opposition, and asserted several "affirmative defenses" that are more in the nature of a response to opposer's allegation of likelihood of confusion.[1]

The evidence of record consists of the file of the involved application; opposer's testimony deposition of Janet Harris, "publisher of Storey Books, which is a distributor line of Workman Publishing"[2] with exhibits;

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[1] Applicant's answer also asserted that it detrimentally relied on opposer's delay and inaction and that opposer "is barred from bringing this Notice of Opposition under the doctrines of estoppel by laches, estoppel by acquiescence and/or equitable estoppel." Notice of Opposition at 5. While these issues were not developed, we note that the Federal Circuit has clearly stated that the time for alleging estoppel by laches or by acquiescence does not begin until the mark was published for opposition. National Cable Television Association Inc. v. American Cinema Editors Inc., 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991) ("[I]n this case laches, with respect to protesting the issuance of the registration for the mark, could not possibly start to run prior to [the date when the] application for registration was published for opposition").

[2] Harris dep. at 17.

opposer's notice of reliance on applicant's responses and documents submitted in response to opposer's interrogatories[3]; the testimony deposition of James Hesterberg, applicant's managing director and founder, with exhibits; the testimony deposition of John Workman, owner of Workman's Specialty Merchandise, with exhibits; the testimony deposition of Shawn LaPoint, president of Twin Point Enterprises, with exhibits;[4] applicant's notice of reliance on various documents including opposer's discovery responses and printed publications as well as portions of the discovery depositions of opposer's Rule 30(b)(6) witnesses: Janet Harris, Peter Workman, and David Schiller; and the declarations of Frank DiAngelis and Nanette LoDolce, with exhibits, submitted pursuant to a stipulation of the parties.

First, we consider whether opposer has standing. "An opposer must have "a 'real interest' in the outcome of a proceeding in order to have standing." Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). "To establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled, a petition may assert a likelihood of confusion which is not

[3] This notice of reliance is a substitute for an earlier notice of reliance.
[4] The Hesterberg, J. Workman, and LaPoint depositions were depositions on written questions.

wholly without merit." Lipton Industries v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).[5] Opposer's evidence of use of the term WORKMAN on books with toys included with them establishes its standing to oppose applicant's WORKMAN mark for toy tools.

Regarding priority, opposer has submitted evidence that it has used the term WORKMAN on products consisting of a book with a physical object for a child to use such as the *Bug Book Bug Bottle* and the *Bones Book and Skeleton*. Harris Exhibits 3 and 6. Opposer's witness testified that these products were sold in June of 1987 and November of 1991 respectively. Harris dep. at 21 and 26 respectively. Both products appear in opposer's *Workman Spring 1992* catalog. Harris Ex. 32. Also, included in the catalog were such items as *BrainQuest* (a question and answer game) and *How To Kazoo* with a kazoo. At a minimum, by 1992, opposer was using its WORKMAN mark on books for children with playthings attached as well as games.

On the other hand, applicant filed its application on January 30, 1998, which is applicant's constructive date of first use. Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542, 1544 (TTAB 1991). Applicant's witness

[5] Because of the linguistic and functional similarities of the opposition and cancellation provisions of the Lanham Act, "we construe the requirements of those two sections of the Lanham Act consistently." Ritchie, 50 USPQ2d at 1025 n. 2.

has testified that the mark was first used in commerce with the United States in July 1993.[6] Hesterberg dep. at 9. However, even if we accept applicant's July 1993 date as its date of first use, it is subsequent to opposer's dates of first use. Inasmuch as opposer has shown that it has used the mark WORKMAN on a product that is a combination of a book with a child's toy-like object before applicant's first use, we find that opposer has shown that it has used its mark prior to applicant's earliest constructive or alleged date of first use.

Regarding priority, we are aware that in order to prevail, opposer must show not only that it has used its mark on its goods first but also that its mark is distinctive.

> Under the rule of Otto Roth, a party opposing registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning or through "whatever other type of use may have developed a trade identity." Otto Roth & Co. v. Universal Foods Corp., 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981).

Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990) (full citation added).

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[6] While applicant sold toy tools in 1992, it was under the mark POWER SOUND; the trademark WORKMAN was not selected until 1993. Hesterberg dep. at 10.

Applicant has submitted evidence and argues that the "company name 'Workman Publishing' also comprises a surname that, as such, is inherently weak and not protectable as a mark absent secondary meaning." Brief at 2.[7] Opposer "does not concede that the mark WORKMAN is primarily a surname (interestingly, the PTO did not object to registration of Applicant's mark or to the registration of third party WORKMAN marks on the Principal Register under Section 2(e) of the Trademark Law because the mark is a surname), Opposer submits that even if the Board were to agree with Applicant's contention, the record clearly establishes that Opposer's mark WORKMAN is entitled to protection." Reply Brief at 8 (citation to record omitted) (parenthetical in original).

In surname cases, if "the mark has well known meanings as a word in the language and the purchasing public, upon seeing it on the goods, may not attribute surname significance to it, it is not primarily a surname. 'King,' 'Cotton,' and 'Boatman' fall in this category." Ex parte Rivera Watch Corp., 106 USPQ 145, 149 (Comm'r 1955). See also In re Isabella Fiore LLC, 75 USPQ2d 1564, 1570 (TTAB

[7]Interestingly, applicant's managing director has admitted that it selected the name WORKMAN because "[w]e felt that a name should be adapted to the product that was more descriptive of what the product was… We felt that the name was descriptive of what the toy tools were used for in actual child involvement and play patterns, i.e., they were predominantly males. Children

2005) (FIORE, the Italian word for "Flower," not primarily merely a surname); In re United Distillers, 56 USPQ2d 1220, 1221 (TTAB 2000) (HACKLER not primarily merely a surname. Dictionary definition of "Hackler" as "one that hackles; esp.: a worker who hackles hemp, flax or broomcorn" considered); and Fisher Radio Corp. v. Bird Electronic Corp., 162 USPQ 265, 267 (TTAB 1969) (BIRD not primarily merely a surname). In this case, "workman" is a common English word.[8] While there is evidence that it is also a surname, we cannot find that it is primarily merely a surname. Therefore, inasmuch as opposer's mark is inherently distinctive, opposer has priority of use of its mark on book and toy combination products.

We will now briefly address several objections that applicant has raised to opposer's evidence. Applicant's objection to the evidence of secondary meaning is moot inasmuch as we have found that opposer's mark is inherently distinctive, which does not require a showing of secondary meaning.[9] We overrule applicant's objection to the testimony of Janet Harris because she is "unduly biased." (Applicant's Evidentiary Objection at 3). The witness, a former employee of opposer and now an employee of an

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would use the tools, the toys, as to emulate what they saw adults doing and that is acting as workmen." Hesterberg dep. at 10-11.

[8] "Workman" is defined as "1: Workingman 2. Artisan." *Merriam-Webster's Collegiate Dictionary* (10th ed. 1997) (Harris Ex. D).

affiliated company, is hardly *unduly* biased even if she did not reveal whether, during an earlier deposition, there was "anything put on the table at the time that you might be receiving additional compensation either directly or indirectly from Workman Publishing on the acquisition" of her current company. Harris dep. at 120. It is not clear why the testimony of an employee of a party or a company affiliated with a party should be stricken for this reason alone. Regarding the other objections, which go to the probative value of the evidence, "because an opposition is akin to a bench trial, the Board is capable of assessing the proper evidentiary weight to be accorded the testimony and evidence, taking into account the imperfections surrounding the admissibility of such testimony and evidence. Thus, we have considered the evidence, keeping in mind the objections, and have accorded whatever probative value the testimony and evidence merits." United States Playing Card Co. v. Harbro LLC, 81 USPQ2d 1537, 1540 (TTAB 2006).

We now turn to the issue of likelihood of confusion. When we are considering the question of likelihood of confusion, we look to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also Palm

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[9] We will discuss applicant's objection to opposer's evidence of

Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The first factor we consider is "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." Palm Bay Imports Inc., 73 USPQ2d at 1691 (quoting du Pont, 177 USPQ at 567).

Applicant is seeking registration for the mark WORKMAN in typed form. On the other hand, opposer is relying on its common law rights. Therefore, we do look to see how opposer uses its mark. Applicant points out that opposer uses the mark most commonly in the following stylization:

We will consider this display in our likelihood of confusion analysis.

Despite the fact that applicant has sought registration of its mark in typed form, applicant argues that it "uses WORKMAN in association with other distinguishing matter relating to its toy tools, or images and designs that relate to power tools and construction" (Brief at 18) and it has included a representation of how it uses its mark WORKMAN in association with the words "Power Tools" and design (Brief at 1). However, an "argument

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actual confusion subsequently.

concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a *difference* cannot legally be asserted by that party. Tomy asserts rights in SQUIRT SQUAD regardless of type styles, proportions, or other possible variations. Thus, apart from the background design, the displays must be considered the same." Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). See also Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) ("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce"); Phillips Petroleum Co. v. C. J. Webb, Inc., 442 F.2d 1376, 1378, 170 USPQ 35, 36 (CCPA 1971) ("The drawing in the [opposed] application shows the mark typed in capital letters, and … this means that [the] application is not limited to the mark depicted in any special form").

Also, applicant cannot point to other matter that it uses on its specimens or promotional material that are not part of its mark that it presented for registration to avoid confusion. Dan Robbins & Associates, Inc. v. Questor Corporation, 599 F.2d 1009, 202 USPQ 100, 104 n.6 (CCPA 1979) ("The mark, not the specimen, is submitted for registration").

We add that the use of a mark on the specimen may demonstrate that a mark depicted in typed or standard character form is even more similar to an opposer's mark. Phillips Petroleum Company, 170 USPQ at 36:

> We admit that on first sight the mark CRC MARINE FORMULA 6-66 bears little resemblance to Phillips' mark "66." However, we must not be misled by considering Webb's mark only in its printed or typewritten form, with all the characters being of equal height. The drawing in the instant application shows the mark typed in capital letters, and under Rule 2.51(d) of the Trademark Rules of Practice this means that Webb's application is not limited to the mark depicted in any special form. In trying to visualize what other forms the mark might appear in, we are aided by the specimens submitted with Webb's application as illustrating "the mark as actually used." The specimen included with the application papers in the record shows the 6-66 portion of the mark much more prominently than the CRC MARINE FORMULA portion. Moreover, the 66 portion appears at a different level from the first 6. The specimen is quite similar to the label shown in exhibit A-4, introduced by Webb, which we reproduce below.

However, the use of the mark on the specimen does not limit our consideration of applicant's mark depicted in typed form in the application. Fossil Inc. v. Fossil Group, 49 USPQ2d 1451, 1454 (TTAB 1998):

> Accordingly, in any likelihood of confusion analysis, we "must consider all reasonable manners in which [the word FOSSIL] could be depicted." INB National Bank v. Metrohost, 22 USPQ2d 1585, 1588 (TTAB 1992). Thus, opposer's typed drawing registrations of FOSSIL afford opposer a scope of protection which encompasses all reasonable manners in which the word FOSSIL could be depicted including, simply by way of example, all lower case block letters, all upper case block letters, a mixture of lower case and upper case block letters and various script forms.

Inasmuch as applicant is applying to register the mark WORKMAN, without regard to stylization or design feature, we will not consider that it is limited to any particular stylization or display and applicant's specimens of use do not limit applicant's mark for likelihood of confusion purposes.[10]

Except for the rather nondescript oval surrounding the word WORKMAN, opposer's mark is presented in ordinary block form. The simple overall design would not likely be a feature that would be relied upon by customers to distinguish the goods. In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) ("Neither the design element nor the generic term 'café' offers sufficient distinctiveness to create a different commercial impression. Indeed, as the board found, the design is an ordinary geometric shape that serves as a background for the word mark"). We conclude that the marks are very similar, if not virtually identical, in appearance.

Furthermore, applicant's argument that the "marks are pronounced differently" (Brief at 18) is not legally significant. Even if applicant or opposer promotes their marks with different pronunciations, many purchasers are

[10] Obviously, if applicant considered the scope of its mark to be limited, it could have filed a drawing with its application that depicted the mark in stylized form and with any additional words or designs.

likely to pronounce the same common English word identically. Centraz Industries Inc. v. Spartan Chemical Co., 77 USPQ2d 1698, 1701 (TTAB 2006) (There "is no correct pronunciation of a trademark, and it obviously is not possible for a trademark owner to control how purchasers will vocalize its mark").

Applicant also argues that the marks' meanings would be different inasmuch as opposer "uses the family name of its founder" while applicant's mark conveys "that the toy tools bearing that mark are intended for use by children in emulating jobs of a 'working man.'" Brief at 5. We cannot agree. Many purchasers are likely to attribute the same dictionary meaning to opposer's mark, unaware of the name of opposer's founder. In addition, the commercial impressions of the marks WORKMAN and WORKMAN and design are again similar, if not identical. Therefore, when we compare the marks, both applicant and opposer use the identical term WORKMAN. Even if we consider that opposer uses its mark with an oval design, we would have to conclude that the marks are virtually identical in appearance, pronunciation, meaning, and commercial impression.[11]

[11] Opposer has also used the term WORKMAN on its books as part of its trade name "Workman Publishing New York." However, opposer's argument is that the "applied mark WORKMAN is indistinguishable from opposer's mark WORKMAN" and "the dominant usage of the mark in its product and catalogs is the term WORKMAN, *solus*." Reply Brief at 3 and 5. Therefore, for our purposes, we will only consider opposer's mark WORKMAN without additional wording.

The next factor we consider is the similarity or dissimilarity of the parties' goods. As set out in its application, applicant's goods are toy tools. Examples of applicant's toy tools include "a work light, tool box with tools, toolbelt with tools, power drill, circular saw, power driver, saber saw, chain saw and hedgetrimmer." Hesterberg dep. at 9. Opposer is a book publisher who makes a series of books that include a toy related to the topic of the book. Applicant argues that: "Opposer clearly sells books, not toys" (Brief at 7); that "Clothing and microscopes are not toys" (Brief at 8); "even if these enhancements are deemed toys, toy sets or games, [opposer] is not selling power tools and accessories which are clearly distinct from Opposer's promotional items" (Id.). Opposer argues that it "does not sell books packaged with a novelty toy item but rather, products that are toys and games." Reply Brief at 6. "Toys" are defined as "an object, often a small representation of something familiar, as an animal or person, for children or others to play with, plaything." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987).[12] Opposer's cameras, puppets, beach buckets, microscopes, skeletons, and similar items

[12] We take judicial notice of this definition. 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).

sold as part of a set designed for children would be considered, at a minimum, children's educational toys. Opposer promotes its goods as more than simply books with a novelty item attached. Its goods are also toys that promote interaction with the book:

> Kids books with "attachments" – packaged items that promote interaction with the book – seem to be cascading from publishers.
>
> Parents, grandparents and teachers think kids will read educational books – and remember what they read – if they are accompanied by fun activities, said Sabra Smith of Running Press in Philadelphia, which first combined the "Velveteen Rabbit" book with a stuffed rabbit in 1985 and moved on to very complex kits with books…
>
> Workman Press fields the popular "Kirby Puckett Baseball Games" ($13.95) with a ball marked with finger positions; "The Bones Book" ($15.95) with a plastic skeleton to assemble; and animal figurines with booklets for the American Museum of Natural History ($10.95 each).

Plain Dealer, November 24, 1996 (Harris Ex. 49 (00885).

These book/toy kits are more than simply books with a promotional item, they are interactive kits that have characteristics of both books and toys. In addition, opposer has promoted the toy aspects of its products. See Harris dep. at 16, 73, and 110 (Opposer was "the first publisher to introduce toy products into the marketplace with the introduction of the How To Kazoo book"); ("All new children's toy titles are promoted heavily at the Toy Fair"); and (These photographs "would be Toy Fair booths where we would have been promoting our toy set product and

related calendars"). Opposer's witness testified that these products are "sold in toy stores and toy markets." Harris dep. at 145.

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 are related in some manner, or that the circumstances surrounding their use are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the involved marks, 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 Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991) and Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1661 (TTAB 2002).

Here, many consumers familiar with opposer as a source of WORKMAN book/toy kits are likely to believe that it is now also the source of or in some way associated with the toy tools sold with or without a related book. Therefore, we find that toy tools and book/toy kits are related products. Dan Robbins & Associates, 202 USPQ at 104 (Games,

toys, and children's building blocks and children's books are related); and Squirtco, 216 USPQ at 939 ("Nothing in the specific nature of balloons and floating water toys negates the likelihood that such goods could be thought to come from the same source").

The third likelihood of confusion factor is the similarity of trade channels. Opposer markets its goods through bookstores but also general merchandise stores. While applicant acknowledges that opposer "distributes its books through book stores or mass merchandise stores" (Brief at 9), it argues that "in those instances when [opposer's] books are sold at a store that sells Lanard's toys, they are not presented on the same shelves as Lanard's toys." Id.

The mere fact that goods are sold in the same stores is not necessarily conclusive on the subject of overlapping trade channels. Irwin Auger Bit Co. v. Irwin Corp., 134 USPQ 37, 39 (TTAB 1962) ("It is common knowledge that there are sold in many hardware, grocery, variety and drug stores an almost unlimited variety of goods including tools, housewares, electrical appliances, seed, fertilizer, furniture and toys. The public being well aware of the diversity of goods to be found in such stores is not going to believe that all of those goods could originate with a single source"). See also Federated Foods, Inc. v. Fort

Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (supermarkets).

Here, we tend to agree with applicant that the goods of applicant and opposer are unlikely to be found on the same shelf, however, that is not the requirement to resolve this factor in opposer's favor. It does appear that toy tools and book/toy kits would be found not only in the same stores but also in the same toy sections. Also, applicant's witness has indicated that its goods are sold "in some cases, in the preschool department." Hesterberg dep. at 27. Opposer's book/toy kits and similar products could also be found in this department inasmuch as they are promoted for preschool children. Harris Ex. 32 ("My First Play Town" (ages 3-7)); "My First Drawing Book" (ages 4-7)); and "My First Camera Book (ages 4-8)) and Ex. 33 ("Go to Bed, Fred A Good Night Book & Muppet Puppet" (ages 6 months and up). In addition, opposer's and applicant's goods have been promoted by the same catalog sales company. Harris dep. at 114 and Ex. 54. We conclude that the channels of trade for opposer's and applicant's goods are similar. See Dan Robbins & Associates, 202 USPQ at 104 ("Questor's games, toys, and children's building blocks, and Robbins' children's books, all have a common marketing environment, being sold generally in toy stores and toy departments of retail stores to the same purchasers").

Regarding the fourth factor, the conditions under which and buyers to whom sales are made, we must conclude that this factor favors opposer. While applicant argues that its "sales representatives make personal presentations to professional buyers" (Brief at 9), the ultimate consumers of both applicant's and opposer's products are parents and other ordinary consumers seeking gifts and items to amuse children. Furthermore, we cannot find, as applicant argues, that the purchasers would be discriminating as opposed to ordinary purchasers. In addition, the fact that some of applicant's products can "cost close to $50.00 and even [opposer's] books can sell at retail for near $20" (Brief at 29) does not disqualify them from being impulse purchases. Certainly, considering the nature and cost of applicant's and opposer's products, many consumers would purchase these goods as gifts for children without careful consideration.

The fifth *du Pont* factor requires us to consider evidence of the fame of opposer's mark and to give great weight to such evidence if it exists. See Bose Corp. v. QSC Audio Products Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002)

> Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the DuPont factors," Recot, 214 F.3d at 1327, 54 USPQ2d at 1456, and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id*. This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus

> more attractive as targets for would-be copyists. Id. Indeed, "[a] strong mark … casts a long shadow which competitors must avoid." Kenner Parker Toys [v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)]. A famous mark is one "with extensive public recognition and renown." Id.

Opposer argues that it "has used the mark WORKMAN for toys and game products for over twenty years. Moreover, Opposer has spent significantly in promoting its mark, to wit during the twelve year period of [1989] through March 2001, it spent close to $1,000,000 each year for this purpose. This evidence suffices to establish the 'fame' of Opposer's WORKMAN mark." Brief at 23. Opposer goes on to argue that "by virtue of its significant and long-term usage of the mark [it] is entitled to at least a presumption that its mark has become distinctive and famous." Brief at 24. While this evidence shows that opposer's mark is not a weak mark, we decline to find that opposer's mark is famous in the field of toys.

The sixth *du Pont* factor requires us to consider evidence of "use of similar marks on similar goods [or services]." See Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). Applicant has sought to include evidence of several registrations that include the word WORKMAN.[13] Evidence of third-party

[13] One registration was for the non-identical word WORKIN'MAN for board games. This registration expired in 2002. A "canceled registration does not provide constructive notice of anything."

registrations does not demonstrate that there is no likelihood of confusion. AMF Inc. v. American Leisure Prods., Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ("The existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them"). "While third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they cannot be used to justify the registration of another confusingly similar mark." In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987).

Regarding applicant's other evidence of third parties using the term WORKMAN, we note that it is not extensive. Applicant has submitted the testimony of John Workman and his company, Workman's Specialty Merchandise. However, the website associated with this company, as of the end of 2002, is no longer active. J. Workman dep. at 25 and Ex. BJ. Furthermore, the catalog that Workman's Specialty Merchandise published is actually entitled "World Of Products" and the "only reference to Workman is on the back page where there appears a reference to the trade name Workman's Specialty Merchandise followed by a business address and a web address http://www.workmans.com." J.

Action Temporary Services v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989).

Workman dep. at 24. In addition, this company was only in existence from 1997 to 2002 and the company's principal described its sales as: "Not much. With – I'd say an average of two to $5,000 a year in sales." J. Workman dep. at 5, 6 and 10. The witness also testified that "[n]o products bear the name Workman." J. Workman dep. at 24. This evidence hardly establishes that opposer's mark is weak and entitled to only a narrow scope of protection.[14] Also, the listing of various businesses in Yellow Pages directories (DeAngelis Dec., Ex. B) is not significant evidence that the mark WORKMAN is a weak mark for opposer's goods, i.e., book/toys kits. See Penguin Books Ltd. v. Eberhard, 48 USPQ2d 1280, 1284 n.5 (TTAB 1998):

> Opposer has objected to this evidence [telephone directories] on the ground that it does not show actual use of this name by others. Opposer is, of course, correct that these white pages listings of companies with the word Penguin in their names do not show actual use in the marketplace of these trade names and company names. These listings are of limited probative value because they do not demonstrate that these businesses actually exist or that the public is aware of them. See Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618, 1622 (TTAB 1989) and In re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983). However, they are admitted for what they show on their face. We should note, however, that the use of the name "Penguin" in connection with various companies whose businesses are as diverse as a laundry business,

[14] Applicant also submitted the testimony of Shawn LaPoint of Twin Point Enterprises, Inc. Mr. LaPoint testified that its subsidiary, Workman Electronic Products, is "a manufacturing importer of electronic parts and accessories for CB radio and amateur radio" (p. 6) and uses a WORKMAN mark. This testimony is hardly relevant in determining whether WORKMAN is weak for various toy items.

> a yogurt retailer, a cafe, a heating and air conditioning company, a company that sells pools and spas, and a sporting goods company, do not show that opposer's registered mark PENGUIN is weak for its goods.

We agree with applicant that when we consider the seventh and eight factors, the lack of any significant evidence of actual confusion and the period of concurrent use favors applicant's position that there is no likelihood of confusion. The parties have attended some of the same trade shows and opposer's witness "was alarmed to see [Lanard Toys product] being sold in the same venue as other Workman products." Harris dep. 114 and Ex. 54. However, despite this period of use, there has been no evidence of actual confusion.[15] Both parties have used their marks since at least 1993 and they have made a significant number of sales of their products under their respective marks. While the actual sales figures are confidential, applicant has enjoyed some success with its WORKMAN toy tools. However, the sales figures are not so large that we are convinced that there has been an adequate opportunity for confusion to occur and to be brought to the attention of the parties. See Hesterberg dep. at 19 and Ex. AP. While we

[15] Opposer refers to an instance where an unnamed sales representative inquired as to "why the name was being used on someone else's product." Harris dep. at 117. Not only are the facts surrounding this incident very nebulous, it appears that the unnamed representative was not a customer and recognized that the mark was not opposer's. Inasmuch as we do not consider this

have considered that there is no evidence of actual confusion, we are also aware that "the lack of any occurrences of actual confusion is not dispositive inasmuch as evidence thereof is notoriously difficult to come by." Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). The Federal Circuit has noted that: "Before this court, the test is likelihood of confusion not actual confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion." Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990) (Citations omitted). Therefore, while we find that this factor favors applicant, we do not find that it strongly supports applicant's position. Penguin Books Ltd. v. Eberhard, 48 USPQ2d at 1287 ("We have also considered the fact that there have been no instances of actual confusion despite approximately ten years' contemporaneous use of the respective marks, but we attribute such lack of actual confusion to such facts as applicant's actual manner of distribution and sale, which is irrelevant in the absence of a meaningful restriction in his application").[16]

When we consider all the evidence on the question of likelihood of confusion, we find that the marks are

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testimony as evidence of actual confusion, we find that applicant's objection to this testimony is moot.

virtually identical in sound, appearance, meaning, and commercial impression. The parties' goods, toy tools and book/toy kits are related and they would be found in the same stores in similar channels of trade. The customers of both parties goods would at least overlap. While there has been no evidence of actual confusion, we are convinced that confusion is likely under the facts of record here and because opposer has priority, it is entitled to prevail.

Decision: The opposition to the registration of application No. 75426465 is sustained.

[16] We add that the remaining factors do not significantly favor either party.