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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Erico International Corporation
v.
Crave Development Inc.

Opposition No. 91153021
to application Serial No. 78077141
filed on August 2, 2001

John W. Renner and Jonathan A. Platt of Renner, Otto,
Boisselle & Sklar for Erico International Corporation.

Beau D. Barberis of Marshall, Gerstein & Borun for Crave
Development Inc.

Before Quinn, Walters and Chapman, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Crave Development Inc. to register the mark CAN CADDIE ("CAN" disclaimed) for "metal ladder attachment in the nature of a paint can carrier" (in International Class 6) and "plastic ladder attachment in the nature of a paint can carrier" (in International Class 20).¹

¹ Application Serial No. 78077141, filed August 2, 2001, based on an allegation of a bona fide intention to use the mark in commerce.

Erico International Corporation opposed registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, if applied to applicant's goods, would so resemble opposer's previously used and registered mark CADDY (in typed form) for "fasteners for industrial purposes particularly for use in the construction industry, namely, channel brackets, bridle rings, conduit clips, hanger clips, and low voltage clips";² and the previously used and registered marks shown below, as to be likely to cause confusion.

CADDY

for "arc welding electrode holders, ground clamps and cable connectors"³; and



for "fasteners for industrial purpose."⁴

² Registration No. 757,140, issued September 24, 1963; renewed.

³ Registration No. 550,853, issued November 13, 1951; renewed.

⁴ Registration No. 1,128,804, issued January 8, 1980; renewed.

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Applicant, in its answer, denied the salient allegations in the notice of opposition.

The parties agree that the record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by each party; opposer's pleaded registrations, an excerpt from a printed publication, and a dictionary definition of "can" introduced by opposer; and copies of eight third-party registrations of marks employing "CADDY" (or, in one instance, "CADDIE"), and an excerpt from a printed publication, made of record by applicant. Both parties filed briefs.⁵ An oral hearing was not requested.⁶

Opposer, which celebrated its one-hundred year anniversary in 2003, is engaged in the manufacture and sale of fasteners used in the building construction industry.

⁵ The only pleaded issues in this case are priority and likelihood of confusion. Opposer, in its brief, makes allegations under the heading "Derogation," specifically asserting that its mark is "damaged and lessened" and "tarnished" by the registration sought by applicant. Applicant, in its brief, interpreted these contentions as a new claim of disparagement and/or dilution, and objected thereto as untimely. Opposer's reply brief is silent on this point. Suffice it to say, to the extent that opposer attempted to interject a new claim in its brief (and we are not entirely sure that it did), the claim obviously was neither pleaded nor tried, and is untimely raised for the first time in the brief. In view thereof, any disparagement and/or dilution claims have been given no consideration.

⁶ On page one of opposer's brief, under the heading "Certificate of Interest," opposer lists the names of the attorneys "that appeared for the Opposer who may be expected to appear at Oral Hearing." However, opposer never filed a request for oral hearing pursuant to Trademark Rule 2.129(a).

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According to the testimony of Raymond Laughlin, who designs and develops new products for opposer, opposer began use of the mark CADDY in 1962 to identify its product line of fasteners. Mr. Laughlin testified that the mark CADDY is used in connection with thousands of fasteners in opposer's product line, and that the goods are sold through distributors catering to the building trades, and through do-it-yourself retail stores such as Home Depot and Lowe's. Annual sales under the mark in this country approach \$100 million. Opposer's fasteners are promoted in trade magazines for the construction industry, and in opposer's product catalogs, information sheets, and newsletters. In addition, annual advertising expenditures are, according to Mr. Laughlin, in the "millions."

Applicant provides, according to its founder and president, Theodore Salani, engineering design services to a variety of small manufacturers, machine shops and the like. Applicant's product is an attachment for the easy handling of a one-gallon paint can (a wire handle is required) and paint brush, primarily while the user is standing on a ladder. The product can be used to hang not only on ladders, but on fences and railings as well during a painting job. Applicant intends to sell its product in the do-it-yourself home hardware market and in the paint contractor market. According to Mr. Salani, applicant's

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paint can carrier will be sold in paint stores, as well as in Home Depot, Wal-Mart and Target.

Before turning to the merits of the likelihood of confusion claim, we first direct our attention to applicant's evidentiary objections, and an evidentiary point concerning Mr. Salani's testimony.

The first objection relates to Exhibits A, B and F attached to the notice of opposition. With one exception (pertaining to a status and title copy of a plaintiff's registration), exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced in evidence as exhibits. Trademark Rule 2.122; TBMP §317 (2d ed. rev. 1, March 2004).

In view of the above, Exhibits A, B and F attached to the notice of opposition were not properly made of record later at trial and, thus, they have not been considered.

The second objection relates to opposer's mention, for the first time in its brief, of its ownership of a fourth registration. Inasmuch as this registration (Reg. No. 2,493,761) was neither pleaded nor made of record, we have not considered this registration in reaching our decision.

Applicant also has objected to several trial exhibits and testimony relating thereto (both in Mr. Laughlin's

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deposition and on cross-examination of Mr. Salani in his deposition). Exhibits 1 and 14 to the Laughlin testimony are opposer's catalogs for distribution in Europe. Use of opposer's mark overseas has no relevance to this proceeding. Accordingly, these European catalogs have not been considered.

Applicant objected to several other exhibits and related testimony on the grounds of relevance and lack of proper foundation or authentication. We have considered the objections, but they are overruled. We have taken this testimony and these exhibits into account in reaching our decision on likelihood of confusion, giving the testimony and exhibits whatever appropriate probative value the testimony and exhibits merit.

With respect to the Salani testimony, a question was posed on cross examination regarding a trademark search conducted at the time the involved application was filed. When asked whether any of opposer's marks were listed in the search report, applicant's counsel objected, and instructed Mr. Salani not to answer the question. According to counsel's objection made at the deposition, "[t]his is outside the scope, and I am not going to allow my witness to testify as to what was found at the search or anything related to the search results." (Dep., pp. 41-42).

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While the comments or opinions of attorneys relating to search reports are privileged, the results of the search report are appropriate subjects for questioning. TBMP §414 (2d ed. rev. 1, March 2004). We do not find that this specific cross examination exceeded the scope of direct and, therefore, the objection was not well taken. In view thereof, we presume that the answer would have been "unfavorable" to applicant. *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993); TBMP §707.03(d) (2d ed. rev. 1, March 2004). Thus, we presume that the search conducted by applicant revealed opposer's CADDY marks.

Turning now to the merits of this proceeding, priority is not an issue inasmuch as opposer has relied on its ownership of valid registrations for the mark CADDY. *King Candy Co. v. Eunice King's Kitchen*, 946 F.2d 1400, 182 USPQ 108 (CCPA 1974).

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 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 Company, 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

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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).

We first turn our attention to a comparison of the goods. It is not necessary that the goods be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the goods originate from or are in some way associated with the same source. *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Opposer's fasteners are used in connection with the installation of electrical, mechanical, communication and HVAC components in the building construction industry. Opposer's goods comprise a wide selection of clips, clamps, hangers and straps to be used by installers, and these goods adapt to beam, bar joist, decking, concrete and other structural shapes. Opposer, in its brief (7-8), describes the environment in which its fasteners are used:

Buildings, whether constructed of steel
or reinforced concrete, generally have

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concrete slab floors. Studs for interior partitions usually run from the slab floor to the ceiling slab, but the drywall for partitions may stop a few feet short of the ceiling or roof leaving an open space. A suspended ceiling is usually installed below the ceiling slab leaving a substantial open space to run utilities such as electric power, low voltage cabling such as computer and communication cabling, pipes, both water and sewer, and HVAC (heating, venting, air conditioning) systems and ducts. The latter (pipes and HVAC systems) are handled by the mechanical trades, while the former are handled by the electrical trades. Both trades may work concurrently side-by-side, usually on structures such as step ladders, platforms and scaffolds, or even stilts on the construction room floor providing access to above ground level areas such as the overhead open space before the suspended ceiling is finished or completely installed.

Mr. Laughlin testified that most of opposer's fasteners are in the form of hangers, clamps and supports which are designed to be installed above a suspended ceiling, thereby requiring an elevated structure to lift the installer. Mr. Laughlin estimated that 60% of opposer's sales volume would be installed with the assistance of a ladder, scaffold or some other type of elevating platform. In view of this, Mr. Laughlin indicated that opposer has designed fasteners specifically for installation when the installer is standing on a ladder or scaffold.

Applicant's product, on the other hand, is a simple painting tool accessory, that is, an attachment used

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primarily in connection with painting, but it also can be used to hold tools. The attachment can only be used with a one-gallon paint can which has a wire handle. The attachment fits on a ladder, fence or railing. Applicant's advertisement contains the following product description:

The Can Caddie carrier is a revolutionary new product designed to make painting easier. The Can Caddie carrier manages the can and brushes and lets you hang them securely where you need them...ladders, fences, railings or anywhere. Simply snap in the can, hook on the brushes and you're ready to paint. From the "do-it-yourselfer" to professional painter, the Can Caddie carrier provides a safe, easy means of simplifying all your painting jobs. Made of durable plastic, the Can Caddie carrier is designed to fit any standard gallon size paint can with wire handle and includes paint brush hooks. The Can Caddie carrier isn't just for painting...use it with an empty can and it also makes a great tool holder.

In the present case, the goods are specifically different and are entirely unrelated in function or purpose. The goods involved herein have very specific uses, neither of which are related nor competitive. Opposer contends that the parties' goods are both "hangers" sold in the construction industry. Although we acknowledge that, in the very broadest sense, both goods might be looked upon as "hangers," this similarity is purely semantic. Simply put, the goods are distinctly different, and this factor weighs heavily in applicant's favor.

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Opposer also attempts to draw a nexus between the products by essentially asserting that opposer's fasteners and applicant's paint can carrier attachment are both used in connection with ladders. In so doing, opposer states the obvious, that is, ladders are used throughout the building construction industry by contractors. Relying on Mr. Laughlin's testimony, opposer contends that "ladders are so important to [opposer's] CADDY product line that a number of parts have been designed specifically for use on ladders, and to overcome drawbacks of prior parts which become so irritating and apparent when the installer is on a ladder." According to opposer, these parts were made in response to the "dropsies" since it is an economic reality that when an installer drops a fastener, he/she is wasting time. (Brief, p. 9).

Opposer's contention that the parties' goods are related inasmuch as both are used with ladders is strained. Again, the goods are wholly unrelated and are non-competitive. The facts that both types of goods may be used in the building construction trade and in conjunction with ladders are not sufficient to show a commercial relationship between opposer's fasteners and applicant's paint can carrier. Further, contrary to opposer's contention, there is no showing that a product like that offered by applicant

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is a natural area of expansion for opposer's goods or vice versa.

As to trade channels, the goods, as identified, are presumed to travel in all of the normal channels for such goods. Moreover, the record establishes that the parties' goods will be available for sale in some of the same retail stores. Opposer's testimony shows that its goods are sold through distributors to the building construction trade, but that the fasteners are also sold at retail at stores such as Home Depot and Lowe's. Applicant's goods, while planned to be sold at paint stores catering primarily to the professional trade, are also intended to be sold at retail stores such as Home Depot. Neither of the identifications of goods bears any restriction on trade channels. Thus, at least insofar as the do-it-yourself market is concerned, the goods will move in the same channels of trade. The testimony of Messrs. Laughlin and Salani also shows, however, that the goods would be sold in different parts of these retail stores. Opposer's goods are sold in the electrical department and in the department containing wall products for metal stud and drywall, whereas applicant's product is intended to be sold in the paint department because it will be marketed for use with paint cans.

As to the classes of purchasers and conditions of sale, to the extent that the goods are sold to the professional

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building construction trade, these purchasers may be expected to exercise a greater degree of care in making their purchases. Moreover, the classes of professional users will be different, installers versus painters. The goods would also be purchased by do-it-yourselfers at retail outlets who would be expected to exercise nothing more than ordinary care. Nonetheless, in all instances, the goods would be bought for entirely different purposes.

We next turn to consider the marks. With respect to opposer's CADDY marks and applicant's mark CAN CADDIE,⁷ the marks bear similarities in appearance and sound in that both include CADDY or the phonetic equivalent CADDIE. In addition, the marks CADDY and CAN CADDIE, as applied to the respective goods, are suggestive in that both convey the idea that they hold something (in applicant's mark, specifically a paint can).⁸ Notwithstanding these similarities, the marks are specifically different. These differences, coupled with the significant distinctions

⁷ There clearly is no likelihood of confusion between applicant's mark and opposer's design mark which it characterizes as its "CADDYMAN" mark. The design mark does not include "CADDYMAN" or any other word for that matter; the mark is comprised entirely of a caricature of a man. This design mark of opposer's is entirely different in all respects from applicant's mark.

⁸ We are able to take judicial notice of dictionary definitions. The term "caddy" is defined as "any container or device for storing or holding frequently used things (as clothes or tools) when they are not in use." The term "caddie" (or "caddy") means "one that assists a golf player esp. by carrying his clubs around the course during play." Webster's Third New International Dictionary (unabridged ed. 1993).

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between the goods as discussed above, have the cumulative effect of ensuring that there is no likelihood of confusion as to source.⁹

Another duPont factor to consider herein is the fame of opposer's mark. The fame of a prior mark, when present, plays a dominant role in the likelihood of confusion analysis. *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); and *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Mr. Laughlin testified that opposer has used the mark CADDY since 1962, that opposer's annual domestic sales under its CADDY marks are just under \$100 million, and that annual advertising expenditures are in the "millions."

There is no question but that opposer's annual sales figures are impressive. As to advertising efforts, the term "millions," although certainly indefinite, suggests that opposer has been active in promoting its CADDY marks. Based on this evidence, we find that opposer's mark CADDY is a strong mark. This evidence standing alone, however, is insufficient to afford opposer's mark CADDY the exalted legal status of a "famous mark" as contemplated by case law.

⁹ In considering the marks, we must compare opposer's marks with the one applicant seeks to register. Thus, opposer's arguments premised on the possibility that applicant's mark will be shortened to CADDIE, or that applicant's counsel mistakenly referred to applicant's mark as CAN CADDY, are irrelevant.

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There is no evidence indicating the length of time that opposer has attained its impressive sales, nor any other evidence from which we can conclude that the mark CADDY is famous. Cf.: Bose Corp. v. QSC Audio Products Inc., 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002).

We hasten to add, however, that even if we found opposer's mark CADDY to be famous, that fame is confined to fasteners used in the building construction trade. While opposer's mark is strong for fasteners, we do not extend that view to a distinctly different product such as applicant's paint can carrier. That is to say, given the disparity between opposer's fasteners and applicant's ladder attachment in the nature of a paint can carrier, the fame of opposer's mark CADDY would not extend the ambit of protection afforded by the mark CADDY to cover the goods of applicant under the mark CAN CADDIE. G.H. Mumm & Cie v. Desnoes & Geddes Ltd., 917 F.2d 1292, 16 USPQ2d 1635, 1639 (Fed. Cir. 1990).

In reaching our decision, we have considered the eight third-party registrations submitted by applicant in its attempt to diminish the scope of protection of opposer's marks. Third-party registrations, without evidence of actual use, are of very limited value in the determination of the question of likelihood of confusion. Nevertheless, third-party registrations are entitled to some weight when

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they are offered to show the sense in which a term, prefix, suffix or other feature of a mark is used in ordinary parlance. They may show that a particular term has descriptive or suggestive significance as applied to certain goods. Stated somewhat differently, third-party registrations are entitled to weight to show the meaning of a mark in the same way that dictionaries are used. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *General Mill Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992); and *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172 (TTAB 1987). Thus, we have considered this evidence in conjunction with the dictionary evidence mentioned above.

Applicant's knowledge of opposer's previously used CADDY marks (presumed from Mr. Salani's refusal to answer the question at his deposition) is of no moment. Mere knowledge alone does not establish bad faith adoption. Moreover, given our finding as to the disparity between the goods resulting in no likelihood of confusion, there can be no bad faith in applicant's later adoption.

In sum, we conclude that, based on the preponderance of the evidence, confusion is not likely to occur among prospective purchasers. Just because the parties' goods may be subsumed under the very broad category of building construction products does not mean that such diverse goods

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would be likely to be regarded by consumers, both professional and do-it-yourselfers, as related, in the sense of coming from or being sponsored by or affiliated with the same source, when marketed respectively under the marks at issue herein. As our principal reviewing court has cautioned, "[w]e are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal." *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992). For the reasons discussed above, we find that the evidence of record does not support a finding that there is a likelihood, as opposed to merely a theoretical possibility, of confusion.

Decision: The opposition is dismissed.