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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: June 17, 2008

Opposition No. 91173739

Liberty Safe & Security
Products, Inc.

v.

Jeffrey P. Scarpelli

**Before Grendel, Holtzman and Bergsman,
Administrative Trademark Judges.**

By the Board:

This case is before the Board for consideration of opposer's motion for summary judgment and applicant's cross motion for summary judgment.

On August 26, 2005, Jeffrey P. Scarpelli ("applicant") filed an intent-to-use application (Serial No. 78701576) for the mark FREEDOM SECURITY, in standard character format, for services ultimately identified as follows:

Retail sales by mail solicitation, telephone solicitation, personal visitations to worksites, and at the applicant's place of business featuring safes, security filing cabinets, locks, multi-location lock systems, keys, key systems, video surveillance systems, identification badge readers, and access control systems having an input, such as an identification card reader or biometric reader, along with

electromechanical door and gate
latching mechanisms, in Class 35; and,

Installation and repair services for
safes, security filing cabinets, locks,
multi-location lock systems, keys, key
systems, video surveillance systems,
identification badge readers, and
access control systems having an input
such as a card reader or biometric
reader, along with electromechanical
door and gate latching mechanisms, in
Class 37.

Applicant disclaimed the exclusive right to use the word
"security."

Liberty Safe & Security Products, Inc. ("opposer")
opposed the registration of applicant's mark under Section
2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d).
Opposer alleged that applicant's use of the mark FREEDOM
SECURITY, in connection with applicant's services, is
likely to cause confusion with opposer's mark FREEDOM SAFE
for metal safes.¹

¹ Registration No. 2251255, issued June 8, 1999; Section 8 and 15
affidavits accepted and acknowledged. Opposer disclaimed the
exclusive right to use the word "safe."

Opposer also alleged that it has been using the marks FREEDOM
SECURITY and FREEDOM SECURITY BY LIBERTY for metal safes in
interstate commerce since at least as early as September 1, 2005
(Serial Nos. 78736196 and 78736186 both filed on October 19,
2005). Because the filing date of the application at issue
(August 26, 2005) predates opposer's first use (and filing dates)
of its "Freedom Security" marks, applicant has priority of use
vis-à-vis those marks. Therefore opposer's pleading is
inadequate to support the ground of priority of use and
likelihood of confusion, and it fails to state a claim upon which
relief can be granted. *Zirco Corp. v. AT&T*, 21 USPQ2d 1544 (TTAB
1991). See also *Jimlar Corp. v. Army & Air Force Exchange*

Applicant admitted that opposer is the owner of Registration No. 2251255 for the mark FREEDOM SAFE for metal safes, but denied the remaining allegations in the notice of opposition.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986). The evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Standing and Priority

Although applicant admitted that opposer is the owner of Registration No. 2151255 for the mark FREEDOM SAFE for metal safes, applicant did not admit that the registration

Service, 24 USPQ2d 1216, 1217 n.5 (TTAB 1992). In view thereof, we will focus our discussion on a comparison of opposer's mark FREEDOM SAFE and applicant's mark FREEDOM SECURITY.

is still active and valid, nor did opposer submit a status and title copy of the registration with its pleading or in support of its motion for summary judgment. Moreover, opposer did not produce any witness to testify that the registration is still active and valid. Therefore, opposer must rely on its common law use of the mark to FREEDOM SAFE to prove its standing and priority of use.

Opposer introduced the declaration of Kim Waddoups, the Chief Financial Officer of opposer. Mr. Waddoups testified that opposer "has continuously used the mark FREEDOM SAFE in commerce in connection with metal safe products since at least as early as May 1, 1997."² The testimony in Mr. Waddoups' declaration is sufficient to establish that opposer has a real interest in this proceeding and that opposer has made prior use of the mark FREEDOM SAFE in connection with metal safes. See *National Bank Book Co. v. Leather Crafted Products, Inc.*, 218 USPQ 826, 828 (TTAB 1993) (oral testimony may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, it is clear and convincing, and it has not be contradicted); *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 316 (TTAB 1979) (oral testimony may be sufficient to establish both prior use and

² Waddoups Dec. ¶5.

continuous use when the testimony is proffered by a witness with knowledge of the facts and the testimony is clear, convincing, consistent, and sufficiently circumstantial to convince the Board of its probative value); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576, 577 (TTAB 1976) (oral testimony may establish prior use when the testimony is clear, consistent, convincing, and uncontradicted). Inasmuch as opposer's testimony regarding the first use of its mark was proffered by someone with knowledge, and it was clear, convincing, consistent and uncontradicted, opposer has proven its standing and priority of use.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The

fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

A. The similarity or dissimilarity and nature of opposer's products and applicant's services.

The description of services in the application at issue comprise the sale, installation and repair of a wide variety of security products, including safes. On the other hand, opposer has been using the mark FREEDOM SAFE in connection with metal safes. Applicant has admitted that the services set forth in its description of services are related to opposer's metal safes.

With respect to request no. 10

Admit that both Opposer and Applicant use their respective marks in connection with metal safes.

Applicant admits only partially to the matter that Opposer and Applicant use their respective marks in connection with metal safes.

Applicant's listing of goods/services shows that Applicant's mark will be used in connection with safes and not necessarily metal safes.

With respect to request no. 11

Admit that Applicant uses or intends to use Applicant's mark in connection with the servicing of metal safes.

Applicant admits only partially to the matter that Applicant uses or intends to use Applicant's mark in connection with the servicing of metal safes. Applicant's listing of

goods/services clearly shows that Applicant's mark will be used in connection with the servicing of safes and not necessarily metal safes.

With respect to request no. 12

Admit that the goods/services for which Applicant is using or intends to use with Applicants (sic) mark are closely related to "metal safes" (sic)

Applicant admits only partially to the matter that the goods/services for which Applicant is using or intends to use with Applicant's mark are closely related to "metal safes".

Applicant's listing of goods/services for the mark FREEDOM SECURITY clearly show (sic) that the word safes as being used not "metal safes" (sic)³

It is well settled that likelihood of confusion is determined on the basis of the services as they are identified in the application. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). See also *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers

³ Applicant's response to opposer's requests for admissions attached to opposer's motion for summary judgment as Exhibit F.

to which the sales of goods are directed"). As the Court of Customs and Patent Appeals, the predecessor of our primary reviewing court, explained in *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981):

Here, appellant seeks to register the word MONOPOLY as its mark without any restrictions reflecting the facts in its actual use which it argues on this appeal prevent likelihood of confusion. We cannot take such facts into consideration unless set forth in its application.

As indicated above, the services described in the application are for the sale, installation and repair of a wide variety of security products, including safes. Because there are no restrictions or limitations as to the type of safes described in the description of services, we must presume that it includes all types of safes, including metal safes. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

To the extent that the application is for the sale, installation and repair of safes, including metal safes, and opposer is using its mark to identify metal safes, applicant's services and opposer's products are related. The fact that there are some differences in the description of services for the application and opposer's products does not obviate the fact that applicant's services and opposer's products are related. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 209 USPQ at 988.

In view of the foregoing, there is no genuine issue of fact regarding the similarity of applicant's services and opposer's products.

B. The similarity or dissimilarity of likely-to-continue trade channels.

As with the similarity or dissimilarity or nature of opposer's products and applicant's services, applicant has admitted that the products and services move in the same channels of trade.

With respect to request no. 13

Admit that Applicant does currently and/or does intend to offer its goods/services used in connection with Applicant's mark for sale in the same channels of trade as Opposer.

Applicant admits only partially to the matter that Applicant does currently and/or does intend to offer its goods/services used in connection with Applicant's mark for sale in the same channels of trade as Opposer.

Applicant's mark FREEDOM SECURITY will be used according to its listing of goods/services and will be working in the security marketplace as work or sales become available. Opposer's business practices or sales and manufacturing of products are directed according to its listing of goods/services specifically metal safes, whereas Applicant's mark is directed towards security marketplace in general.

Because there are no restrictions or limitations in applicant's description of services, we must presume that his services will be rendered in all channels of trade that would be normal for such services, and that they would be available to all classes of potential consumers, including those who might purchase metal safes. *See In re Linkvest S.A.*, 24 USPQ2d at 1716; *In re Elbaum*, 211 USPQ at 640.

In view of the foregoing, there is no genuine issue of fact regarding the similarity of the channels of trade between applicant's services and opposer's products.

C. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, *supra*. In a particular case, any one of

these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988).

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). As applicant stated in response to Request for Admission No. 13, the average consumer is in the security marketplace.

While marks must be compared in their entirety, it is not improper to accord more or less weight to a particular feature of a mark. *In re National Data Corp.*,

753 F.2d 1056, 24 USPQ2d 749, 751 (Fed. Cir. 1983). In the marks of the parties, the word "Freedom" is the dominant portion of the marks because the words "Security" in applicant's mark and "Safe" in opposer's mark are descriptive. With respect to opposer's mark, the word "Safe" is clearly descriptive, if not generic, for metal safes. With respect to applicant's mark FREEDOM SECURITY, the word "Security" is descriptive of applicant's services because it directly conveys information regarding the subject matter of the services (*i.e.*, security systems and equipment). Applicant acknowledged the descriptive nature of the word "Security" by disclaiming the exclusive right to use the word in response to the March 16, 2005 Office Action. Case law recognizes that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), *quoting, In re National Data Corp.*, 24 USPQ2d at 752 ("Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion"). *See also In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial

impression"). In this case, the descriptive words "Security" and "Safe" are unlikely to be used to distinguish the marks.

The significance of the word "Freedom" is further reinforced by its location as the first word of both marks. As such it is the first word consumers will see when encountering the marks of the parties, and therefore it is more likely to have a greater impact on purchasers and be remembered by them. *Presto Products Inc. v. Nice-Pak Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered). See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VUEVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word).

In comparing opposer's mark FREEDOM SAFE and applicant's mark FREEDOM SECURITY, we note that both marks consist of two words with the arbitrary word "Freedom" as the first word in each mark followed by a descriptive word.

Applicant's substitution of the descriptive word "Security" in its mark, FREEDOM SECURITY, for the descriptive word "Safe" in opposer's mark, FREEDOM SAFE, does not distinguish applicant's marks from opposer's mark. See *In re Xerox Corp.*, 194 449 (TTAB 1977) ("6500" and "6500 LINE" are basically the same because the addition of the descriptive word "line" does not distinguish the marks). See also, *The Wella Corp, v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (the inclusion of a suggestive or descriptive word to an otherwise arbitrary term will not preclude a finding of likelihood of confusion).

Moreover, because the word "Freedom" is an arbitrary term when used in connection with applicant's services and opposer's safes, consumers encountering the marks may believe that they are somehow connected or affiliated with each other. In this regard, we note that the words "Safe" and "Security" have similar meanings. "Safe" means "secure from liability to harm, injury, danger, or risk."⁴ Specifically with respect to opposer's safes, the word

⁴ The Random House Dictionary of the English Language (Unabridged), p. 1690 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

"Safe" means "a steel or iron box or repository for money, jewels, papers, etc." or "any receptacle or structure for the storage or preservation of articles."⁵ The word "Security" means "freedom from danger, risk, etc.; safety. . . . something that secures or makes safe; protection; defense."⁶ Because "Safe" and "Security" have essentially the same meaning, the commercial impression engendered by the marks FREEDOM SAFE and FREEDOM SECURITY is similar.

In view of the foregoing, there is no genuine issue of fact regarding the similarity of the marks in terms of appearance, sound, meaning, and commercial impression.

D. Balancing the factors.

After reviewing the arguments and supporting papers of the parties in a light most favorable to applicant, and drawing all justifiable inferences in favor of applicant, we find that no genuine issue of material fact exists as to the relevant likelihood of confusion factors made of record under Section 2(d) of the Trademark Act of 1946. See Fed. R. Civ. P. 56 (c). The marks of the parties are similar, the services of the applicant and the products of opposer are related, and the channels of trade and classes of consumers are the same. In view of the foregoing,

⁵ *Id.*

⁶ *Id.* at 1731.

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opposer's motion for summary judgment is granted, and applicant's cross motion for summary judgment is denied.

Decision: The opposition is sustained and registration to applicant is refused.