

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

Hearing: September 20, 2007

Mailed: January 16, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Pucel Enterprises, Inc.
v.
Grizzly Industrial, Inc.

Opposition No. 91123506
Cancellation No. 92031984
Cancellation No. 92032024
Cancellation No. 92032025

Kenneth L. Mitchell of Woodling, Krost and Rust for Pucel Enterprises, Inc.

Joseph F. Schmidt of Michael Best & Friedrich LLP for Grizzly Industrial, Inc.

Before Walsh, Mermelstein, and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

In these consolidated proceedings, Pucel Enterprises, Inc. (hereinafter "opposer") filed a notice of opposition and petitions for cancellation to the application and registrations owned by Grizzly Industrial, Inc. (hereinafter "applicant") that are listed below:

1. Application Serial No. 76088346 for the mark GRIZZLY.COM, in typed drawing form, used in connection with the following services:

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Retail store services, online retail store services, and mail order services featuring; abrasives; air cleaners; air compressors; air tanks; air tools; angle finders; anti-kickback devices; anti-vibration mounts; auger bits; bearings; belts; benders; bevels; blade stabilizers; bolt cutters; books and plans; buffing compounds; buffing machines; buffing wheels; burrs; cable ties; calipers; cement; center punches; chain hoists; chisels; chucks; clamps and vises; clamp heads; containers; cordless tools; cut-off wheels; cutters; dial indicators; dies; digital read outs; discs; dollies; dowel cutting saws; dowel pins; drafting boards; drill guides; dust collection accessories; dust pans; dust separators; electric motors; end mill holders; end mills; engine stands; feather boards; file card files; filter bags; flexible curves; gauges; gear puller; gloves; gouges; grinders; grinding wheels; hacksaws; hammers; hand cleaner; hand punches; hand screws; hand trucks; hex keys; hose reels; hoses; inserts for toolholders; jacks; jig saw blades; jointer knives; knee pads; knobs; laminate trimmer; lathe accessories; live centers; machine mounts; magnetic bases; magnetic shims; magnetic switches; mallets; mandrels; mats; micrometers; miter box; miter trimmer; mortiser machine; moulder/plane; moulding head; moulding head knives; multi-spur bits; nail puller; nailers; nails; notches; planer knives; pliers; protractor; pulleys; punches; push sticks; rasps; ratchet kits; remote controller; router pads; router table; routers; rust remover; safes; sanders; sanding boxes; sanding sealer; sandpaper; saw blades; saw stops; saws; scrapers; screw extractors; screw grabs; screwdrivers; screws; security; shovels; slide tables; slip rolls; sockets; spacers; spindles; sprayers; square; stains; staplers; staples; storage bins; switches; tapping machine; tie down ratchets; tile cutters; tin snips; tool tables; trammel points; wagons; welding rod; welding supplies; wood filler; wrenches; battery chargers; clothing; generators; levels; parts washers; pressure washers; sandblasters; saw horses; scaffolding; shop vacuums; tool boxes; tool organizers; wheel barrows; cutlery; cutting tools; drill presses; drilling and boring equipment, namely, brad point bits, countersinks, drill bits, extractors, forstner bits, hole saws, plug cutters, quick change bits, reamers, solid carbide bits, spade bits, step drill bits, tapered bits; dust collection systems; fasteners; finishing supplies, namely, brushes,

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finishes, finishing supplies, spray guns, sprayers; hand tools; hardware, namely, brackets, bumpers, door knockers, drawer pulls, drawer slides, hinges, lock sets, shelf supports; jigs, fixtures; machine accessories, namely, arbors, belt pulleys, blade guides, boring heads, bushings and shapers, chuck inserts, chucks, clamping kits, collet attachments, collets, dividing heads, dust hoods, electric switches; face plates, fences, lathe centers, magnetic chucks, milling attachments, miter gauge, mortising attachments, motors, phase converters, power feed, rails, rotary tables, rub collars, sanding attachments, sleeves, sliding tables, spindles, stands, tailstock turrets, tool holders, tool post sets, tool rests, V-belts, V-blocks, wings, material handling equipment, namely, carts, casters and wheels, mobile bases, outfeed tables and stands, roller stands, rollers, tables, work stands; measuring tools; metal stock; metalworking machines; pneumatic tools; power tools; router bits; safety equipment, namely, ear protectors, eye protection, first aid kits, gloves, respirators; shaper cutters. shop accessories, namely, anvils, arbor presses, belt cleaners, dowel centers, glue, glue bottles, glue brushes, laminating, lubricants, moisture meters, pads and mats, power bits, push blocks, saw gauges, sharpening equipment, namely, drill sharpeners, sharpening stone sets, stop blocks, tape, tweezers; optical equipment; hand tools; coffee; tooling equipment, namely, boring bars, center drills, countersinks, cut-off and parting, dovetail cutters, end mills, fly cutters, indexable tooling, inserts, key seats, multi-function tools, rotary burrs, slitting saws, taps and dies, tool bits; welding and cutting machines; wood products, namely, biscuits, detail kits, dowels, edge banding, pins, plugs, veneer; and woodworking machines, in International Class 35.¹

2. Registration No. 2166833 for the mark GRIZZLY, in typed drawing form, for the following goods:

Woodworking and metal working machinery, namely, table saws, jointers, shapers, planers, power feeders, molders, sanders, scroll saws, bandsaws, dust

¹ Application Serial No. 76088346, filed July 10, 2000, based on use in commerce. Applicant claimed June 30, 1999 as both its dates of first use anywhere and first use in commerce.

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collectors, woodworking lathes, metalworking lathes, drill presses, grinders, buffers, electric motors for machines, milling machines, power hacksaws, arbor presses, sheet metal machines, pneumatic air tools, namely, compressors, wrenches, sanders, die grinders, ratchets, screwdrivers, drills, spray guns, nailers, staplers, hammers, saw punches, grease guns and air brushes, parts washers, cut-off saws, rotary tables, dividing heads, and parts therefore, in International Class 7.²

3. Registration No. 2413625 for the mark GRIZZLY, in typed drawing form, for the following goods and services:

Nails; steel squares, in International Class 6;

Wood and metal working shop machinery, namely, air cleaners, air compressors and accessories for air compressors, meat cutting bandsaws, metal cutting bandsaws, wood bandsaws, buffing machines and buffing wheels for metal working, drill presses and accessories for drill presses, dust collectors and accessories for dust collectors, face plates for lathes bench grinders, flex shaft grinders, mini grinders, portable grinders, slow speed grinders, universal knife grinders, wide wheel grinders, grinding stands, wood lathes and accessories for wood lathes, lathe chucks, metal lathes and tooling for metal lathes, mortising machines, mortising attachments for drill presses, nail guns, planer knives, belt sanders, bench sanders, combination sanders, disc sanders, drum sanders, edge sanders, knife belt sanders, spindle sanders, sanders and accessories for sanders, sanding belts, sanding discs, sanding drums, sanding rolls, sanding sleeves, sanding wheels, saw blades for power operated saws, bandsaw saw blades, circular saw blades, scroll saw blades, shaper cutters, shop vacuums, steel squares for machines, table saws and accessories for table saws, milling machines, milling vises for milling machines, rotary tables and angle plates for milling machines, sheet metal machines for bending, cutting, notching, slip rolling, and punching flat and tubular sheet metal, sand blasting machines, welding machines, radial

² Registration No. 2166833, issued June 23, 1998; Section 8 affidavit accepted. Applicant claimed September 6, 1983 as both its dates of first use anywhere and first use in commerce.

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drills, and electric and battery operated power tools, in International Class 7;

Hand tools, namely, hammers, screwdrivers, chisels, wood carving knives, pliers, scrapers, hand saws, nail pullers, sanding blocks, saw blades, saw horses, socket sets, wrenches, anvils, tap and die sets, in International Class 8;

Measuring equipment, namely, dial indicators, dial calibrators, digital calipers and instruments, and measuring tapes; software, namely, software for disseminating information related to wood and metal working and wood and metal working equipment through a global information network; magnetic switches, in International Class 9;

Paint brushes, in International Class 16; and,

Mail order services, featuring abrasives, jigs, air cleaners, air compressors, air compressor accessories, anti-fatigue mats, aprons, back support belts, meat cutting bandsaws, metal cutting bandsaws, wood bandsaws, bandsaw accessories, biscuits, bit systems, blade cleaners, blade stabilizers, books, brad drivers, brad point bit sets, buffing compounds, buffing systems, buffing wheels, carbon paper, center finders, chisels, band clamps, bar clamps, C-clamps, T-clamps, hold-down clamps, pipe clamps, saddle clamps, specialty clamps, cleaners, combination squares, compressors, contact cement contour gauges, countersink sets, dado blades, dead blow hammers, depth stops, dovetail jigs, dowel plugs, doweling jigs, drafting boards, drawer slides, drill bits and guides, drill presses, drill press accessories, drill sharpeners, dust collectors, dust collection accessories, electric motors, emery clothes, face frame jigs, face plates, featherboards, files, glues, glue brushes, bench grinders, flex shaft grinders, mini grinders, portable grinders, slow speed grinders, universal knife grinders, wide wheel grinders, grinding stands, grinding stones, grinding wheels, hack saw kits, handscrews, hinges, hole restorer tools, hose reels, hollow chisel mortisers, jigs and fixtures, jointers, jointer clamp systems, knee pads, knife-setting jigs, wood lathes, metal lathes, wood lathe accessories, lathe chucks, levels, lubricants, magnetic switches, magnetizers and demagnetizers, mallets, marking gauges, measuring

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tools, miter boxes, miter saw work stations, miter trimmers, mobile bases, moisture meters, mortising attachments, moulding heads and knives, multi-spur bits, nail guns and nails, nail pullers, paint and stain kits, paint brushes, paint sprayers - HVLP, planes, planers, planer knives, planer/moulders, planer pals, plug cutters, pneumatic tools, power carvers, power feeders, power tools. pressure washers, push blocks, push sticks, rasps, rasp sets, remote controllers, right angle drives, roller stands, rosette cutterheads and cutters, router bits, router bit sets, router pads, router speed controls, router tables, router table accessories, rub collars, rub bushings, rub spacers, rubber gloves, rust removers, safety equipment, sandblasters, belt sanders, bench sanders, combination sanders, disc sanders, drum sanders, edge sanders, knife belt sanders, spindle sanders, sanding accessories, sanding belts, sanding discs, sanding drums, sanding rolls, sanding sleeves, sanding wheels, saw blades, bandsaw saw blades, circular saw blades, scroll saw blades, saw horse brackets, saw horses, scaffolding, scrapers, screws, screw accessories, scroll saws, shapers, shaper cutters, sharpening accessories, shop vacuums, snips, spokeshaves, spray guns, staplers, steel squares, step drills, stop blocks, table saws, table saw accessories, table saw inserts, table saw fences, tack cloth, tenon cutters, thickness gauge, toggle clamps, tool organizers, Trammel points, V-belts, varnishes, vise clamps, vises, wood parts, wood threading kits, and woodworking accessories, ordered from printed and on-line catalogs, in International Class 35.³

4. Registration No. 2312226 for the mark GRIZZLY

INDUSTRIAL, in typed drawing form, for the following goods:

Woodworking and metal working machinery, namely, table saws; jointers; shapers; planers; power feeders; molders; sanders; scroll saws; bandsaws; dust collection systems comprised of dust collectors, woodworking lathes; metalworking lathes; drill presses;

³ Registration No. 2413625, issued December 19, 2000; Section 8 affidavit accepted. Applicant claimed December 31, 1983 for both its dates of first use anywhere and first use in commerce for the goods and services set forth in Classes 7, 8, 9, 16, and 35, and it claimed December 31, 1986 as the dates of first use for the goods identified in Class 6.

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grinders; buffers; electric motors; milling machines; power hacksaws; arbor presses; sheet metal machines; pneumatic air tools, namely, impact wrenches, ratchet wrenches, grinders, drills, sanders, air brushes, staplers, and nailers; parts washers; cut-off saws; and parts therefore, in International Class 7.⁴

As ground for the opposition and cancellations, opposer pleaded priority of use and likelihood of confusion.⁵

Opposer claimed ownership of the following registrations:

1. Registration No. 0624055 for the mark GRIZZLY, shown below, for "shop equipment, namely, tables, benches, cabinets, racks, shelves, stands, desks, and parts thereof," in International Class 20;⁶

The image shows the word "Grizzly" written in a bold, cursive, handwritten-style font. The letters are thick and connected, with a slightly slanted, dynamic feel. The 'G' is particularly large and prominent.

⁴ Registration No. 2312226, issued January 25, 2000; Section 8 affidavit accepted. Applicant disclaimed the exclusive right to use the word "Industrial." Applicant claimed December 31, 1983 as both its dates of first use anywhere and first use in commerce. During the prosecution of these proceedings, applicant realized that the dates of first use were incorrect, and, on March 8, 2002, filed a "Request To Amend Certificate Of Registration No. 2,312,226 Pursuant To Section 7(h) Of The Lanham Act." "The date of first use and first use in commerce for the mark GRIZZLY INDUSTRIAL is August 1997." (Request To Amend, p. 2).

⁵ Opposer also pleaded dilution, but withdrew that claim.

⁶ Registration No. 0624055, issued March 27, 1956; Sections 8 and 15 affidavits accepted and acknowledged; third renewal.

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2. Registration No. 0704529 for the mark GRIZZLY, shown below, for "box trucks, dump trucks, hand trucks, dollies and wheeled platforms, wheeled racks and wheeled tables," in International Class 12;⁷

The word "Grizzly" is written in a bold, black, cursive script. The letters are thick and connected, with a slightly slanted, dynamic feel. The 'G' is particularly large and prominent.

3. Registration No. 0704589 for the mark for the mark GRIZZLY shown below, for "drum lifters, tilting arcs, drum cradles, drum up-enders, and hoist hooks," in International Class 7.⁸

The word "Grizzly" is written in a bold, black, cursive script, identical to the one above. The letters are thick and connected, with a slightly slanted, dynamic feel. The 'G' is particularly large and prominent.

4. Registration No. 0704530 for the mark comprising a grizzly bear design, shown below, for "box trucks, dump

⁷ Registration No. 0704529, issued September 20, 1960; Sections 8 and 15 affidavits accepted and acknowledged; second renewal.

⁸ Registration No. 0704589, issued September 20, 1960; Sections 8 and 15 affidavits accepted and acknowledged; second renewal.

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trucks, hand trucks, dollies and wheeled platforms, wheeled racks and wheeled tables," in International Class 12;⁹



5. Registration No. 0704631 for the mark comprising a grizzly bear design, shown below, for "shop equipment, namely, tables, benches, cabinets, racks, shelves, stands, desks and parts thereof," in International Class 20;¹⁰



6. Registration No. 0704588 for the mark comprising a grizzly bear design, shown below for "drum lifters, tilting arcs, drum cradles, drum up-enders, and hoist hooks," in International Class 7.¹¹

⁹ Registration No. 0704530, issued September 20, 1960; Sections 8 and 15 affidavits accepted and acknowledged; second renewal.

¹⁰ Registration No. 0704631, issued September 20, 1960; Sections 8 and 15 affidavits accepted and acknowledged; second renewal.

¹¹ Registration No. 0704588, issued September 20, 1960; Sections 8 and 15 affidavits accepted and acknowledged; second renewal.

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In our opinion, the most pertinent of opposer's marks are the *Grizzly* marks because they are word marks. By focusing on the word marks, we can simply compare all of the "Grizzly" word marks with each other, and we do not need to consider whether opposer's grizzly bear design marks are likely to trigger the recollection of the literal equivalent, or vice versa. Therefore, in the remainder of our analysis, we will refer only to opposer's "Grizzly" word marks.

Preliminary Issues

A. Opposer's Common Law Rights.

Applicant objected to opposer's assertion of common law rights in its GRIZZLY trademark to prove that opposer's products and applicant's products and services are related. Applicant argued that opposer did not plead any common law rights, and therefore in comparing the goods and services of

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the parties, the Board should consider only the goods set forth in opposer's pleaded registrations.¹²

In response to applicant's objection, opposer argued that it "clearly pleaded" common law rights in paragraph No. 4 of its Amended Notice of Opposition when it referred to "said above described products" and "said above products and services sold under, and in association with" opposer's trademarks.¹³ Opposer made a similar argument regarding its petitions for cancellation referencing its statements to "**previously used** goods which includes goods beyond the registrations."¹⁴ Although opposer did not expressly argue in the alternative that if the Board did not find that opposer had pleaded its common law rights, we should find that opposer's common law rights were tried by implied consent pursuant to Rule 15(b) of the Federal Rules of Civil Procedure, opposer did allude to that argument. Specifically, opposer contended that applicant conducted discovery in regard to goods and services beyond the scope of the registrations, that applicant's Rule 30(b)(6) depositions included inquiries regarding opposer's sale and advertising of all products and services under opposer's marks, and that opposer's trial depositions included

¹² Applicant's Brief, p. 12.

¹³ Opposer's Reply Brief, p. 18.

¹⁴ Opposer's Reply Brief, p. 19 (emphasis in the original).

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extensive testimony regarding opposer's common use of its marks.¹⁵

1. Whether opposer pleaded its common law rights.

The pertinent allegations in opposer's Amended Notice of Opposition may be summarized as follows:

Paragraph No. 1

Opposer has been engaged in the manufacture and sale of material handling and industrial equipment.

Paragraph No. 2

Opposer identified its pleaded registrations.

Paragraph No. 3

Opposer is the owner of the GRIZZLY trademark for the goods identified in the pleaded registrations.

Paragraph No. 4

"Opposer, for many years and long prior to the alleged first use or intent to use 'GRIZZLY.COM' by Applicant, has become widely known as a source of Opposer's said above described products having good quality and has acquired a favorable reputation for its said above described products and services sold under, and in connection with, the trademarks 'GRIZZLY' and 'GRIZZLY BEAR SYMBOL'. Opposer has acquired a favorable reputation and goodwill under the trademark 'GRIZZLY' AND 'GRIZZLY BEAR SYMBOL' as a dependable source of said above described products and services."

¹⁵ Opposer's Reply Brief, pp. 19-20.

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In paragraph No. 1, opposer identified itself as a company engaged in the manufacture and sale of material handling and industrial equipment. The sale of one's own products is not a separate and distinct service rendered to benefit the public, but rather it is an activity by and for the benefit of the manufacturer. *In re Dr. Pepper Co.*, 836 F.2d 836, 5 USPQ2d 1207, 1208 (Fed. Cir. 1987) ("the rendering of a services which is normally 'expected or routine' in connection with sale of one's own goods is not a registrable service"). Accordingly, the reference to opposer's "sale of material handling and industrial equipment" in paragraph No. 1 is too vague to put applicant on notice that opposer is claiming trademark rights to services related to the sale of its equipment.

A fair reading of paragraph No. 4, wherein opposer refers to its "said above described products" and "said above described products and services," leads us to conclude that it is a reference to the goods identified in the pleaded registrations set forth in paragraph No. 3. Opposer did not identify any services that would put applicant on notice that opposer was claiming trademark rights in any activity related to the sale of its products, or that opposer was claiming any trademarks rights in connection

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with any products other than those identified in its pleaded registrations.

In view of the foregoing, we find that opposer did not plead any common law rights in its Amended Notice of Opposition.

The pertinent allegations in Cancellation No. 92031984 may be summarized as follows:¹⁶

Paragraph Nos. 2-7

Opposer identified its pleaded registrations.

Paragraph No. 8

Opposer has continuously used its marks in connection with the goods identified in its pleaded registrations.

Paragraph No. 11

"The mark registered by Registrant [applicant], when used on or in connection with goods cited in the registrations, is the identical marks and/or so resembles the previously used and registered marks by Petitioner [opposer] for the same or similar goods so as to cause confusion or to cause mistake, or to deceive. Further, said marks registered by Registrant is the identical mark and/or so resembles the previously used and registered marks by the Petitioner for the same or similar goods so as to cause confusion."

¹⁶ The pleadings in Cancellation No. 92031984 are representative of the pleadings in the other petitions for cancellation.

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Opposer's references to its "previously used and registered marks" in paragraph No. 11 refers to opposer's marks used in connection with the goods identified in its pleaded registrations listed in paragraph No. 8. There is nothing the petition for cancellation that would put applicant on notice that opposer is asserting common law rights. Notice pleading does not require applicant to divine opposer's unstated intentions.

In view of the foregoing, we find that opposer did not plead any common law rights in its petitions for cancellation.

2. Whether opposer's common law rights were tried by applicant's implied consent.

Fed. R. Civ. P. 15(b) provides, in pertinent part, as follows:

When issues not raised by the pleadings are tried by express or implied consent of the parties, they shall be treated in all respects as if they had been raised in the pleadings. Such amendment of the pleadings as may be necessary to cause them to conform to the evidence and to raise these issues may be made upon motion of any party at any time, even after judgment; but failure to so amend does not affect the result of the trial of these issues.

Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and

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(2) was fairly apprised that the evidence was being offered in support of the issue. *Barbara's Bakery, Inc. v. Landesman*, 82 USPQ2d 1283, 1285 n. 4 (TTAB 2007); *Boise Cascade Corporation v. Cascade Coach Company*, 168 USPQ 795, 797 (TTAB 1970). Moreover, the nonoffering party may not stay quiet while evidence is being admitted and subsequently contend that the matter raised thereby should not be considered because it was not pleaded. *Cascade Corporation v. Cascade Coach Company, supra*.

After a thorough review of the record, we find that opposer's common law use of its GRIZZLY trademark was tried by the consent of the parties. During his trial testimony, Robert Mlakar, opposer's Vice President, testified extensively regarding opposer's common law use of its GRIZZLY trademarks.¹⁷ Applicant did not at any time during Mr. Mlakar's deposition object to opposer's introduction of evidence concerning opposer's common law use of its GRIZZLY trademarks. In fact, applicant extensively and effectively cross-examined Mr. Mlakar regarding opposer's common law use.¹⁸ Under the circumstances of this case, we find that

¹⁷ R. Mlakar Trial Dep., pp. 38-110.

¹⁸ R. Mlakar Trial Dep., pp. 238-245. Applicant's counsel established that, with the exception of a few products, opposer's purported common law use was for components of opposer's products rather than products that were separately sold and marked as GRIZZLY products.

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applicant by its failure to object to Mr. Mlakar's testimony regarding opposer's common law use of its GRIZZLY trademark impliedly consented to include opposer's common law use as part of opposer's case. Therefore, applicant's objection to opposer's testimony regarding its common law use of opposer's GRIZZLY trademark is denied and the pleadings are considered as having been amended to conform to the evidence.

B. Whether acquiescence has been tried by implied consent.

On April 11, 2000, opposer sent applicant a cease and desist letter demanding that applicant stop using the trademark GRIZZLY in connection with material handling and industrial equipment.¹⁹ In applicant's May 3, 2000 response, applicant denied that there was any likelihood of confusion because the parties have been concurrently using the GRIZZLY trademarks in connection with material handling and industrial equipment for 15 years without any reported instances of confusion.²⁰ Finally, in correspondence dated May 30, 2000, opposer stated that it did not have a problem with applicant's use of the GRIZZLY trademark in connection

¹⁹ Balolia Discovery Dep., pp. 166-168; Exhibit O/P-24; Balolia Trial Dep., Exhibit 63; A. Mlakar Discovery Dep., p. 13; Exhibit R-13.

²⁰ Balolia Discovery Dep., pp. 166-168; Exhibit O/P-24.

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with woodworking equipment, but inquired further as to the industrial tools on which applicant had been using the GRIZZLY mark.²¹

In the discovery deposition of Shiraz Balolia, applicant's President, Mr. Balolia testified that applicant did not take any action pursuant to the above-noted exchange of correspondence with opposer.

Q. Did you take Ms. Vickroy's letter as a complaint lodged by Pucel?

A. It is a complaint.

Q. Okay. And did you take any corrective action in regard to that letter?

A. No.

Q. No?

A. No.

Q. Did you take heed of that letter in any way?

A. Our attorney has responded to that telling them that we don't believe there's basis for a complaint. That's not exact words, but something to that effect.

Q. Well, since the time of Ms. Vickroy's letter of April 11th, 2000, did you expand your business in

²¹ Balolia Trial Dep., Exhibit 64; A. Mlakar Discovery Dep., p. 8; Exhibit R-14.

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regard to sales of material handling equipment
under the mark Grizzly?

A. I already mentioned to you several times that we
do not put the mark Grizzly on our material
handling products.²²

On the other hand, in his trial testimony, Mr. Balolia
testified that in reliance on the statements made in
opposer's May 30, 2000 correspondence, applicant instructed
its attorney to delete material handling equipment from its
registration.

Q. And what was your reaction to this letter?

A. Well, I didn't didn't (sic) agree with the letter.
And - -

Q. Well, did you rely on this letter in any way?

A. Yes, I relied on this letter. It's coming from
our attorney, obviously, and - -

Q. Well, did you take some action because of this
letter in connection with how you ran your
business?

A. Yes. Like I said, I didn't agree with it, but
since it dealt with a line of products, material-
handling products, that was a negligible part of
our business, less than half a percentage as I've

²² Balolia Discovery Dep., pp. 166-167.

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testified before, it - - I didn't feel it was
worth fighting over and - -

Q. What was worth fighting over?

A. This issue about material handling, what name to
put on it, and so on, and what rights their
clients had.

Q. So what - - what action did you take as a result
of this letter?

A. Well, as a result of this letter, I believe I
instructed my attorney to amend the registration
that we had for our Grizzly that included material
handling, to - - amend it to delete the material-
handling portions of the registration with the
trademark office.²³

* * *

Q. And in addition to filing that amendment, what
else did you do with respect to the use of the
Grizzly Imports' name on material - - or the
Grizzly Industrial name on material-handling
equipment?

²³ Balolia Trial Dep., pp. 63-64.

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A. We stopped using the Grizzly Imports or Grizzly Industrial name at that point on material handling and started using the name Panther.²⁴

Applicant did not plead acquiescence and estoppel as affirmative defenses in any of the consolidated proceedings, nor did applicant seek to amend its pleadings after the close of discovery. On the other hand, opposer did not object to the introduction into evidence of opposer's April 11, 2000 and May 30, 2000 correspondence during the Balolia trial deposition or to any of the testimony regarding applicant's reliance on the May 30, 2000 correspondence.

Applicant argued that the opposer's May 30, 2000 correspondence proves that opposer "did not object to and acquiesced to [applicant's] use of the marks/names GRIZZLY, GRIZZLY INDUSTRIAL and GRIZZLY.COM in connection with woodworking tools and machinery. Therefore, [opposer] is now estopped from objecting to [applicant's] registration of [applicant's] marks for woodworking tools and machinery."²⁵ However, in its Reply Brief, opposer objected to applicant's assertion of the acquiescence affirmative defense because applicant failed to plead it in any of applicant's

²⁴ Balolia Trial Dep., p. 65. On cross-examination, Mr. Balolia reiterated that in reliance on opposer's May 30, 2000 correspondence, applicant changed the name of its material handling products to Panther. (Balolia Trial Dep., pp. 87-88).

²⁵ Applicant's Brief, p. 10.

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answers.²⁶ Moreover, opposer argued that the correspondence applicant relied on to prove acquiescence is opposer's "offer or promise to furnish a valuable consideration in compromising or attempting to compromise claims.

[Opposer's] attorney was attempting to investigate and resolve issues concerning [applicant's] use of the GRIZZLY mark and thus Fed. R. Evid., R. 408, prohibits its admissibility into evidence."²⁷

Because applicant did not plead acquiescence as an affirmative defense, we must determine whether acquiescence was tried by implied consent pursuant to Fed. R. Civ. P. 15(b). In this case, we do not find that acquiescence was tried by implied consent. As indicated in the previous section of this decision, there are two elements to finding that an issue has been tried by implied consent: (1) the nonoffering party raised no objection to the introduction of evidence on the issue, and (2) the nonoffering party was fairly apprised that the evidence was being offered in support of the issue. *Barbara's Bakery, Inc. v. Landesman, supra*; *Boise Cascade Corporation v. Cascade Coach Company, supra*.

²⁶ Opposer's Reply Brief, p. 6.

²⁷ Opposer's Reply Brief, p. 7.

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During his discovery deposition, Mr. Balolia expressly testified that applicant did not take any action in reliance on opposer's May 30, 2000 correspondence.

Q. Okay. And did you take any corrective action in regard to that letter?

A. No.

Q. No?

A. No.²⁸

In light of this unequivocal testimony during the Balolia discovery deposition, opposer was within its rights to assume that applicant would not assert any affirmative defense based on the correspondence between the parties. When applicant subsequently decided to change (or clarify) Mr. Balolia's testimony and assert acquiescence as an affirmative defense, applicant had a duty to amend its pleading to insure that opposer was fairly apprised that applicant would be asserting acquiescence. Because opposer was acting under the assumption that acquiescence was not an issue in these proceedings, when Mr. Balolia testified at trial about the correspondence, opposer was not on notice that they were being introduced to prove acquiescence.

²⁸ Balolia Discovery Dep., pp. 166-167.

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Opposer may have thought that applicant was using them to prove that the goods of the parties were not related.²⁹

Under the circumstances of this case, opposer was misled by applicant's discovery testimony and was mistakenly lulled into believing that acquiescence was not an issue in these proceedings. Therefore, opposer was not fairly apprised that the correspondence was being introduced in support of the acquiescence affirmative defense. In view of the foregoing, we do not find that the affirmative defense of acquiescence was tried by implied consent and we give it no further consideration.³⁰

²⁹ In opposer's May 30, 2000 correspondence, opposer wrote the following: "While we do not have a problem with your client's use of Grizzly in conjunction with wood-working equipment, we are extremely concerned with and object to your client's crossing into our client's product line." Thus, opposer could reasonably have thought that applicant intended to use the correspondence to prove that woodworking equipment was not related to material handling and industrial equipment.

³⁰ Assuming that we determined that acquiescence was tried by implied consent, applicant failed to prove the defense. First, the May 30, 2000 correspondence does not constitute conduct or a statement that assents to, encourages, or furthers applicant's use of the GRIZZLY trademark in connection with any goods or services. It is more in the nature of a statement setting out the parameters for a potential resolution, and therefore applicant was not entitled to rely or act upon it. Second, because of the discrepancy in Mr. Balolia's discovery testimony and trial testimony, we do not find his trial testimony credible. If Mr. Balolia truly relied on the statements in opposer's May 30, 2000 correspondence (and if those statements were unequivocal statements of assent to applicant's actions), Mr. Balolia would have so indicated in his discovery deposition. Based on applicant's evidence, we do not find that applicant relied on opposer's May 30, 2000 correspondence, and therefore opposer is not estopped from prosecuting these proceedings. Finally, we agree with opposer that its May 30, 2000 correspondence was evidence of conduct or statements made in compromise

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C. The expert testimony of Sidney J. Levy, Ph.D.

Applicant took the testimony deposition of Sidney J. Levy, Ph.D, a faculty member in the Marketing Department of Eller College of Management at the University of Arizona.³¹ Applicant had requested that Dr. Levy review materials from the parties and provide an opinion regarding whether there is a likelihood of confusion.³² Dr. Levy opined that the use of applicant's "name, brands, and the URL Grizzly.com is not likely to cause confusion or damage to the reputation of" opposer.³³ At trial, and in its Brief and Reply Brief, opposer objected to Dr. Levy's expert report.

One problem that we have with Dr. Levy's expert testimony and report is that Dr. Levy rendered an expert opinion on the ultimate issue in these proceedings based, essentially, on the same factors the we use to analyze whether there is a likelihood of confusion, subject to the differences discussed *infra*. Applicant is, in essence, asking us to substitute Dr. Levy's findings of fact and conclusions of law for our own. Section 17(a) of the

negotiations, and it is therefore not admissible to prove liability or invalidity of a claim pursuant to Fed. R. Evid. 408.

³¹ Levy Dep., p. 4; Exhibit 67. Dr. Levy has outstanding credentials in the field of marketing.

³² Levy Dep., p. 21. Dr. Levy reviewed the amended notice of opposition, the petitions for cancellation, websites of the parties, catalogs, and Thomson & Thomson searches. (Levy Dep., Exhibit 68).

³³ Levy Dep., Exhibit 68.

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Trademark Act of 1946, 15 U.S.C. §1067(a), gives the Board the authority and duty "to determine and decide the respective rights of registration." This duty may not be delegated by adoption of conclusions reached by a party's witness. *Steiger Tractor, Inc. v. Steiner Corporation*, 221 USPQ 165, 169 (TTAB 1984); *Medtronic, Inc. v. Medical Devices Inc.*, 204 USPQ 317, 325 (TTAB 1979); *The Mennen Company v. Yamanouchi Pharmaceutical Co., Ltd.*, 203 USPQ 302, 305 (TTAB 1971).

The preceding cases do not mean that expert witness testimony may never be helpful. Fed. R. Evid. 704 provides that expert witness testimony is not inadmissible because it embraces an ultimate issue to be decided by the Board. However, Fed. R. Evid. 702 provides that if scientific, technical, or other specialized knowledge will assist the Board to understand the evidence or determine a fact issue, then expert testimony is appropriate. In this case, there is nothing extraordinary regarding the marks, the goods, the channels of trade, or the sophistication of the purchasers that requires expert testimony to help us understand the evidence.

In this regard, applicant explained that "Dr. Levy's expertise is the complexity that creates identity in the marketplace, and he concludes that [opposer] and [applicant]

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'have different identities.'"³⁴ However, Dr. Levy reached his conclusions using different parameters and without the constraints under which the Board operates. Two of the differences between Dr. Levy's and the Board's analysis are set forth below:

1. Dr. Levy noted that opposer often uses its GRIZZLY trademark in conjunction with or "in a subsidiary way" with its trade name. However, Dr. Levy's conception of opposer's mark is in error. One of the questions to be decided in these proceedings is whether applicant's use of GRIZZLY in connection with the products identified in its application and registrations so resembles opposer's GRIZZLY trademark, used in connection with the products identified in opposer's registrations, as to be likely to cause confusion. In this regard, opposer's use of the trade name "Pucel" in connection with the GRIZZLY trademark is not before us. The only marks that concern us are applicant's GRIZZLY trademarks and opposer's GRIZZLY trademark. Any affect on consumer perception caused by opposer's use of the "Pucel" trade name on packaging and advertising is a question of unfair competition and it is not relevant to these proceedings. *Hershey Goods Corp. v. Cerreta*, 195 USPQ 246, 253 (TTAB 1977); *Purex Corp., Ltd. v. Thompson-Hayward*

³⁴ Applicant's Brief, p. 31.

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Chemical Co., 179 USPQ 190, 191 (TTAB 1973) (any differences in labeling or the use of additional marks is immaterial and irrelevant to a determination of applicant's right to the registration sought); *The Tas-T-Nut Company v. Variety Nut & Date Company*, 128 USPQ 166, 167 n.2 (TTAB 1961); and,

2. Dr. Levy analyzed the parties' channels of trade, nature of their advertising and their presence in the marketplace and concluded that the products of the parties move in different channels of trade.³⁵ However, Dr. Levy's testimony is not relevant vis-à-vis the products listed in opposer's pleaded registrations because our determination of likelihood of confusion is based on the goods and services as they are identified in the application and registrations at issue. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976). We cannot read any limitations or restrictions into the description of goods and services. *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

³⁵ Levy Dep., pp. 24-27.

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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 to which the sales of goods are directed"); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983). If, as in the case *sub judice*, the application and registrations at issue describe the goods and services broadly, and there is no limitation as to their nature or type, channels of trade or class of purchasers, it is presumed that the application and registrations encompass all the goods and/or services of the type described, that they move in same channels of trade normal for these goods and/or services, and that they are available to all classes of purchasers for the described goods and/or services. *In re Linvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). Moreover, our likelihood of confusion analysis may not be unduly restricted to present modes of marketing when the descriptions of goods and services is unrestricted because such trade practices could be changed by either party when economics or other factors dictate a need for such change. *The Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 421 (CCPA 1977); *Sheraton Corp. of America v.*

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Sheffield Watch Co., Inc., 480 F.2d 1400, 178 USPQ 468, 469 (CCPA 1973). Thus, Dr. Levy analyzed the actual channels of trade and classes of consumers while the Board is constrained to analyze the channels of trade and classes of consumers as identified in the description of goods and services in the application and registrations at issue.

While we do not strike Dr. Levy's expert testimony and report, for the reasons identified above, the testimony offered by Dr. Levy is of no probative value.

D. Applicant's motion to amend its application and Registration No. 2413625.

Prior to trial, applicant filed a motion to amend its application and Registration No. 2413625 to restrict the description of goods and services to woodworking and metal working products and to delete "dollies, hand trucks, storage bins, tool tables, sliding tables, and material handling equipment, namely, carts, casters, and wheels, mobile bases, outfeed tables and stand, roller stands, rollers, tables, and work stands" from the list of products in the application.³⁶ Applicant argued that its motion should be granted because it narrows the scope of the goods and services.³⁷

³⁶ Applicant's motion to amend its application and registration, p. 2.

³⁷ Applicant's motion, p. 3.

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Opposer did not oppose the deletion of the list of specific goods from applicant's application. However, it did object to the proposed restriction to woodworking and metal working products because it "will exacerbate the likelihood of confusion and damage to" opposer.³⁸ In its trial Reply Brief, opposer expounded on its objection to applicant's proposed amendment to the channels of trade. Opposer argued that even with the proposed amendment there will still be a likelihood of confusion because applicant's application and registrations include products for which opposer has prior common law rights and because applicant's goods and services and opposer's products and related.³⁹

"The Board, in its discretion, may grant a motion to amend an application or registration which is the subject of an inter partes proceeding, even if the other party or parties do not consent thereto."⁴⁰ While we agree with opposer that the proposed amendment to restrict the channels of trade to woodworking and metal working products will not eliminate the likelihood of confusion because the goods and services will remain related,⁴¹ the amendment does narrow the category of users. Because opposer did not consent to

³⁸ Opposer's brief in opposition to applicant's motion, p. 1.

³⁹ Opposer's Reply Brief, pp. 8-18.

⁴⁰ TBMP §514.03 (2nd ed. rev. 2004), *citing* Trademark Rule 2.133(a), 37 CFR §2.133(a).

⁴¹ See the discussion *infra*.

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the proposed amendment and because applicant did not consent to judgment on the unrestricted description of goods and services, the Board's practice is to determine whether there is a likelihood of confusion with respect to the original and the amended description of goods and services.

If the Board ultimately finds that a defendant is not entitled to registration in the absence of a restriction that was timely proposed by the defendant, the proposed restriction will be approved and entered. . . . If, on the other hand, the Board ultimately finds that defendant is entitled to registration even without the proposed restriction, defendant will be allowed time to indicate whether it still wishes to have the restriction entered.⁴²

As indicated above, whether we analyze applicant's description of goods and services with or without the restriction to woodworking and metal working products, we find that applicant's products and services are related to the goods listed in opposer's registrations.⁴³ Accordingly, we only discuss applicant's proposed revision to its description of goods and services in the remainder of this decision.

⁴² TBMP 514.03 (2nd ed. rev. 2004).

⁴³ See the discussion *infra*.

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E. Evidence attached to the briefs.

Both parties submitted evidence with their briefs. However, a brief may not be used as a vehicle for the introduction of evidence. *Hard Rock Café Intentional (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1511 (TTAB 2000). See also TBMP §704.05(b) (2nd ed. rev. 2004) and the cases cited therein. Exhibits and other evidentiary materials attached to the briefs have been given no consideration unless they were properly made of record during the testimony periods of the parties.

The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and applicant's application and registration files. The record also includes the following testimony and evidence:

A. Opposer's evidence.

1. The discovery deposition of Shiraz Balolia, applicant's President, with attached exhibits;
2. The trial deposition of Anthony Mlakar, opposer's President, with attached exhibits;
3. The trial deposition of Robert Mlakar, opposer's Vice President, with attached exhibits, including certified

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copies of opposer's pleaded registrations showing that the registrations are subsisting and owned by opposer;

4. Opposer's notice of reliance on applicant's responses to opposer's interrogatories in the opposition; and,

5. Opposer's notice of reliance on applicant's response to opposer's interrogatories in the cancellation proceedings.

B. Applicant's evidence.

1. The discovery deposition of Anthony Mlakar, with attached exhibits;

2. The discovery deposition of Robert Mlakar, with attached exhibits;

3. The testimony deposition of Shiraz Balolia, with attached exhibits;

4. The testimony deposition of Sydney Levy, Ph.D, with attached exhibits; and,

5. Applicant's notice of reliance on third-party registrations for the mark GRIZZLY, in whole or in part.

Standing

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55

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USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in the opposition. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). However, in the cancellation proceedings, because opposer and applicant are both owners of registrations, opposer must prove priority of use. *Henry Siegel Co. v. M & R Mfg. Co.*, 4 USPQ2d 1154, 1160 n.9 (TTAB 1987); *American Standard Inc. v. AQM Corp.*, 208 USPQ 840, 841-842 (TTAB 1980); *SCOA Industries Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411, 413 (TTAB 1975). In proving its priority of use, opposer may rely upon the filing date of its applications for registration as evidence of its use of the mark. *Henry Siegel Co. v. M & R Mfg. Co.*, *supra*; *American Standard Inc. v. AQM Corp.*, *supra*. Opposer filed its applications to register the GRIZZLY marks on June 14, 1955 (Registration No. 0624055) and February 23, 1960 (Registration Nos. 0704529 and 0704589). On the other hand, applicant began using its GRIZZLY mark in commerce in

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August 1983.⁴⁴ In view thereof, opposer has proven that it has priority of use with respect to the GRIZZLY trademark with respect to the goods identified in its pleaded registrations.⁴⁵

Likelihood of confusion

Our determination of likelihood of confusion under Section 2(d) of the Lanham Act is based on an analysis of all the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are discussed below.

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

We turn first to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties 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

⁴⁴ Applicant's Response to Interrogatory No. 30 in all the cancellation proceedings; Balolia Trial Dep., p. 9 (Mr. Balolia founded applicant in 1983);

⁴⁵ As discussed *infra*, because we find that applicant's goods and services are related to the products listed in opposer's pleaded registrations, we have not considered opposer's common law use.

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

In comparing the marks, we are mindful that 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).

The word "Grizzly" is the dominant portion of applicant's marks GRIZZLY INDUSTRIAL and GRIZZLY.COM. With respect to GRIZZLY INDUSTRIAL, applicant disclaimed the exclusive right to use "industrial" in response to the Examining Attorney's requirement for a disclaimer on the

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ground that the word "industrial" is merely descriptive of a characteristic or function of applicant's woodworking and metal working machinery.⁴⁶ *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1442 (TTAB 2005); *See also Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972). Therefore, the word "Grizzly" is accorded more weight than the word "Industrial" in our comparison of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

With respect to the mark GRIZZLY.COM, the top level domain ".com" has no source indicating significance and does not serve any trademark purpose. *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791-1792 (TTAB 2002); *In re Martin Container Inc.*, 65 USPQ2d 1058, 1060 (TTAB 2002). *See also In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004). Therefore, the word "Grizzly" is accorded

⁴⁶ February 23, 1998 Office Action in application Serial No. 75303371 (Registration No. 2312226) for the mark GRIZZLY INDUSTRIAL. Although statements made in an application may not be relied on as evidence on behalf of the applicant, they may be used as evidence against applicant as an admission against interest. *See* TBMP §704.04 (2nd ed. rev. 2004). In this case, applicant's acquiescence to the Examining Attorney's disclaimer requirement may be construed as an admission that the word "industrial" used in connection with applicant's woodworking and metal working machinery is descriptive. *See American Rice, Inc., v. H.I.T. Corp.*, 231 USPQ 793,798 TTAB 1986) (the fact that opposer took position in its application regarding descriptiveness of term inconsistent with its position in *inter partes* proceeding may be considered as evidence, although earlier inconsistent position does not give rise to an estoppel).

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more weight in our analysis that the top level domain
".com."

The significance of the word "Grizzly" as the dominant element of applicant's marks is further reinforced by its location as the first word of the marks. *Presto Products Inc. v. Nice-Pak Products, 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 VEUVE 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, supra* (upon encountering the marks, consumers must first notice the identical lead word).

In view of the foregoing, opposer's  mark and applicant's GRIZZLY mark are essentially identical. The stylization of opposer's mark is not sufficient to distinguish the marks because applicant's marks have been applied for and registered in typed drawing form. By applying and registering its marks as typed drawings, applicant is asserting rights in its marks in any type style, proportions, or other possible variations, including

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opposer's script format. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). Thus, the word "Grizzly" in applicant's mark must be considered identical to opposer's GRIZZLY marks. In any event, opposer's script format is not so distinctive as to create a commercial impression separate and apart from the word "Grizzly" *per se*, especially because consumers are unlikely to remember this distinction between the marks. Rather, it is the word itself that will more likely be recalled. *In re Melville Corp.*, *supra*; *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987).

In view of the arbitrary nature of the word "Grizzly" when applied to the products of the parties,⁴⁷ the lesser weight to be accorded the word "Industrial" and the term ".com" in applicant's marks, and the identity of the word "Grizzly" in the marks at issue, we find that the marks are similar, if not identical.

B. The similarity or dissimilarity and nature of the goods.

As indicated above, it is well settled that likelihood of confusion is determined on the basis of the goods as they are identified in applicant's application and registrations

⁴⁷ See the discussion of the strength of the mark factor *infra*.

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and the cited registrations. *Hewlett-Packard Co. v. Packard Press Inc.*, *supra*; *In re Elbaum*, *supra*; *In re William Hodges & Co., Inc.*, *supra*. Moreover, the greater the degree of similarity between the applicant's mark and the mark in the cited registrations, the lesser the degree of similarity between the goods and services in applicant's application and registrations and the cited registrations is required to support a finding of likelihood of confusion. *In re Opus One, Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983). If the marks are the same, or almost so, as in the case *sub judice*, it is only necessary that there be a viable relationship between the goods and services to support a finding of likelihood of confusion. *In re Engine Supply, Inc.*, 225 USPQ 216, 217 (TTAB 1985); *In re Concordia International Forwarding Corp.*, *supra*. The goods and services of the applicant and the registrant do not have to be identical or directly competitive to support a finding that there is a likelihood of confusion. It is sufficient if the respective goods and services are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give

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rise to the mistaken belief that they emanate from or are associated with a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

The products identified in applicant's application and registrations are woodworking and metal working tools (e.g., table saws, planers, sanders, lathes, etc.) and the services comprise retail store services, mail order services, and online retail store services for woodworking and metal working tools. The cover of applicant's catalogs have the caption "Purveyors of Fine Machinery: High Quality Woodworking and Metalworking Tools & Accessories." The cover of the catalogs "gives anybody looking just at the cover, gives them an idea of what we sell, which is woodworking and metalworking tools."⁴⁸

Opposer has listed the following products in its registrations:

1. "shop equipment, namely, tables, benches, cabinets, racks, shelves, stands, desks, and parts thereof" (Registration No. 0624055);

⁴⁸ Balolia Testimony Dep., p. 26; Exhibit 5; Applicant's response to opposer's Interrogatory No. 19(b).

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2. "box trucks, dump trucks, hand trucks, dollies and wheeled platforms, wheeled racks and wheeled tables"

(Registration No. 0704529); and,

3. "drum lifters, tilting arcs, drum cradles, drum up-enders, and hoist hooks" (Registration No. 0704589).

Opposer is a manufacturer of shop equipment for material handling such as hand trucks, work benches, stands, dollies, lifts, carts, etc.⁴⁹ Opposer's products include, but are not limited to, shop desks, work benches, tool cabinets, heavy duty tool stands, heavy duty shop trucks, hand trucks, dollies, storage racks, and drum lifters (*i.e.*, hoists used to lift drums).⁵⁰ For example, opposer's PTC Series tool cabinet workbench is a workbench with a 9-drawer tool cabinet for the storage of tools, parts, and other items.⁵¹

Although the products listed in the respective description of goods and services are not identical, and they are not interchangeable, the products of the parties are complementary because they can be used together. It does not take much imagination to envision applicant's saws, lathes, planers, etc. being used in connection with opposer's work benches, and applicant's hammers, nails, saw

⁴⁹ R. Mlakar Trial Dep., Exhibits 13-16, 21-30.

⁵⁰ *Id.*

⁵¹ R. Mlakar Trial Dep., Exhibit 29, p. 8.

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blades, and hand tools, etc. being stored in opposer's tool cabinets. Complementary use is recognized as a relevant consideration in determining likelihood of confusion. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *Visual Information Institute v. Vicon Industries*, 209 USPQ, 179, 190 (TTAB 1980). In fact, in his discovery deposition, Mr. Balolia testified that material handling equipment, specifically roller stands, and mobile bases, are complementary to applicant's core products.⁵² Subsequently, during his trial deposition, Mr. Balolia testified that applicant's customers have requested material handling equipment to complement applicant's core products.

Q. And why do you - - well, why does Grizzly Industrial sell material handling equipment?

A. Essentially as an accommodation to our customers, just as a service. It's not - - you know, customers asked us for - - for certain products, material handling products to complement the machinery that we sold and to buy from the same company at the same time.⁵³

⁵² Balolia Discovery Dep., pp. 27-28; Balolia Trial Dep., Exhibit 1. Mobile bases are synonymous with racks with wheels. (R. Mlakar Trial Dep., p. 189).

⁵³ Balolia Trial Dep., p. 61.

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Moreover, opposer and applicant both sell carts, two-wheel dollies, drum dollies, storage bins, workbenches, tool stands.⁵⁴ The fact that applicant and opposer both sell the same products, albeit under different marks,⁵⁵ has a bearing on whether consumers believe, when the products do appear under the same mark, that they have the same source.

Sterling Drug Inc. v. Sebring, 515 F.2d 1128, 185 USPQ 649, 652 (CCPA 1975); *Black and Decker Mfg. Co. v. Bright Star Industries, Inc.*, 220 USPQ 890, 892 (TTAB 1983).

In view of the foregoing, we find that the products and services of the parties are related.

C. The similarity or dissimilarity of established, likely-to-continue trade channels and classes of purchasers.

As we noted in our discussion regarding Dr. Levy's testimony, if the application and registrations at issue describe the goods and services broadly, and there is no limitation as to their nature or type, channels of trade or class of purchasers, it is presumed that the application and registrations encompass all the goods and/or services of the type described, that they move in same channels of trade

⁵⁴ Balolia Discovery Dep., pp. 28-30; Balolia Testimony Dep., p. 61

⁵⁵ In his discovery deposition, Mr. Balolia testified that applicant sold material handling equipment with the mark GRIZZLY INDUSTRIAL (Balolia Discovery Dep., pp. 12-13), however, in his trial testimony, Mr. Balolia testified that applicant now sells its material handling equipment under the PANTHER trademark (Balolia Trial Dep., pp. 61-62).

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normal for these goods and/or services, and that they are available to all classes of purchasers for the described goods and/or services. *In re Linvest S.A., supra.*

Moreover, our likelihood of confusion analysis may not be unduly restricted to present modes of marketing when the descriptions of goods and services is unrestricted because such trade practices could be changed by either party when economics or other factors dictate a need for such change. *The Wella Corp. v. California Concept Corp., supra; Sheraton Corp. of America v. Sheffield Watch Co., Inc., supra.*

Because the goods of the parties are broadly identified, without any restrictions or limitations as to channels of trade or classes of consumers, we must presume that applicant and opposer sell their products in all the normal channels of trade for these products (e.g., retail store services, mail order services, Internet, distributors, etc.) to all classes of consumers who would buy such products. Accordingly, applicant's evidence regarding the different methods of distribution used by the parties is not relevant.⁵⁶

⁵⁶ Mr. Balolia's testimony that the parties sell their products in different channels of trade is not credible because applicant also sells the same type of material handling equipment sold by opposer. (Balolia Trial Dep., p. 61).

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Moreover, even if applicant's evidence regarding the different methods of distribution used by the parties was relevant, we would not find it persuasive because applicant's channels of trade argument is based on the false premise that the end users of the products are different. The evidence shows that applicant sells its products directly to end users (e.g., homeowners, small shops, as well as the "readily-identified, well-known companies"⁵⁷ identified in applicant's catalogs) through its retail stores, mail order services, and online sales.⁵⁸ By the same token, opposer sells its products through online sales.⁵⁹ In addition, many of opposer's distributors sell opposer's products through catalogs.⁶⁰ Opposer's products are also purchased by engineers and purchasing agents through the Thomas Register.⁶¹ Beside the fact that both parties sell their products online and through the mail, opposer's distributors sell its products to end users⁶² who could be anyone, including applicant's customers, such as

⁵⁷ Applicant characterized the sampling of its customers identified on page 3 of its catalogs as "readily-identified, well-known companies." (Balolia Trial Dep., p. 73).

⁵⁸ See also Balolia Discovery Dep., pp. 90-93, 142-143; Applicant's response to opposer's Interrogatory No. 22.

⁵⁹ A. Mlakar Discovery Dep., pp. 18-22; R. Mlakar Discovery Dep., p. 19.

⁶⁰ A. Mlakar Discovery Dep., pp. 21-22.

⁶¹ A. Mlakar Discovery Dep., p. 20.

⁶² R. Mlakar Discovery Dep., p. 64.

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home shops, small shops, or industrial purchasers.⁶³ The problem with applicant's argument is that it ignores sales of opposer's products beyond its distributors. Even where goods are sold through a distributor, rather than directly to end users, the ultimate sale to end users remains highly relevant in a likelihood of confusion analysis. That the goods of one party pass through an intermediary on the way to the end user has little relevance if the result is that they eventually end up in the hands of the same consumers.

In that regard, the most significant fact in the channels of trade analysis in these proceedings is that the same consumers may ultimately purchase both applicant's and opposer's products. As indicated *supra*, likelihood of confusion may be found where the conditions surrounding the marketing of the parties' products are such that they would be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from the same source. *In re Albert Trostel & Sons Co., supra; In re International Telephone & Telegraph Corp., supra.* Opposer sells its products to metal workers and woodworkers.⁶⁴ In fact, opposer sells to almost all of the customers that applicant identifies as representative

⁶³ R. Mlakar Discovery Dep., p.p. 75-76.

⁶⁴ R. Mlakar Trial Dep., pp. 147-149.

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customers in its catalogs.⁶⁵ By the same token, the majority of applicant's customers are woodworkers comprising homeowners with small shops and cabinet shops.⁶⁶ In addition, applicant sells its metalworking products to small repair shops, small machine shops, and homeowners.⁶⁷ While there may be some differences in how the parties actually sell their products, it cannot be denied that the products of the parties reach the same consumers.

In view of the foregoing, we find that the channels of trade and classes of consumers are similar.

D. The conditions under which and buyers to whom sales are made (i.e., the degree of consumer care).

Applicant contended that the customers of the parties exercise a high degree of consumer care when purchasing applicant's woodworking or metal working machinery or opposer's material handling and industrial equipment, and

⁶⁵ R. Mlakar Trial Dep., pp. 149-163; Exhibits 68 (applicant's 2005 catalog) and 34 and 37 (opposer's invoices). Although applicant objected to opposer's Exhibits 34 and 37 at the deposition of R. Mlakar, it did not renew that objection in its brief, and we therefore consider it waived. *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000) (objection to exhibit raised during deposition but not maintained in brief deemed waived); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.4 (TTAB 1990). See also TBMP §707.04 (2nd ed. rev. 2004). Applicant explained that the sample customers identified in its catalogs are "readily-identified, well-known companies" "to inspire confidence in our customers . . . if large corporations like this buy Grizzly Industrial products, well they must be good-quality products." (Balolia Trial Dep., p. 73).

⁶⁶ Balolia Trial Dep., p. 74.

⁶⁷ *Id.*

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therefore the likelihood of confusion will be minimal.⁶⁸

Applicant supported its argument by referencing the prices of the products and the process by which the products are purchased. Applicant's products range in cost from \$100 to \$20,000 with an average price of \$200.⁶⁹ In addition, applicant provides a customer representative on its toll-free telephone ordering system to answer technical questions.⁷⁰ Opposer's products average \$500 to \$800.⁷¹ However, Mr. Mlakar testified that the degree of care exercised by opposer's consumers varies.⁷²

It seems implausible the someone purchasing the products of either party would not exercise a heightened degree of care. The products are not everyday purchases. They are specific "shop" equipment or tools purchased for a specific purpose. On the other hand, the fact that the parties' consumers may be exercising a heightened degree of care and may even have a high level of sophistication in the field does not provide any assurance that the consumers and potential consumers are sophisticated or knowledgeable regarding trade identifications, or have such goods memories for minute differences in marks, that they could

⁶⁸ Applicant's Brief, pp. 44-47.

⁶⁹ Balolia Discovery Dep., p. 104; Balolia Trial Dep., p. 76.

⁷⁰ Balolia Trial Dep., p. 75.

⁷¹ R. Mlakar Trial Dep., p. 248.

⁷² R. Mlakar Trial Dep., p. 248.

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differentiate between the parties' marks or appreciate that their similarity does not imply some of kind of business relationship or affiliation. *Medtronic, Inc. v. Medical Devices, Inc.*, 204 USPQ 317, 326 (TTAB 1979); *Hydrotechnic Corporation v. Hydrotech International, Inc.*, 196 USPQ 387, 393-393 (TTAB 1977). This is especially true in a case like this where the marks are essentially identical and the goods and services are closely related.

In these proceedings, the evidence regarding the degree of care with which the ultimate consumers of the parties consider the trademarks or the source of the machinery and equipment sold by the parties was not developed in sufficient detail to permit us to draw any conclusions regarding the degree of consumer care. Accordingly, this *du Pont* factor is neutral.

E. The strength of opposer's mark.

Applicant argued that because GRIZZLY has been registered numerous times for a wide variety of goods and services that opposer's GRIZZLY marks are weak, and are entitled to only a narrow scope of protection or exclusivity of use.⁷³ In support of this argument, applicant submitted copies of twenty-eight (28) different registrations

⁷³ Applicant's Brief, pp. 52-53.

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consisting of the word "Grizzly" for a wide variety of goods and services.

Generally, third-party registrations, in and of themselves, cannot justify the registration of another mark that is so similar to a previously registered mark as to cause a likelihood of confusion. Third-party registrations are not evidence of what happens in the market place or that consumers are familiar with the marks. To the extent that such third-party registrations have any probative value in the likelihood of confusion analysis, they are relevant to show that the mark, or a portion of a mark, is descriptive or suggestive, and that therefore the public will look to other elements to distinguish the source of the products identified in the registrations. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269-270 (CCPA 1973); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.* 748 F.2d 669, 223 USPQ 1281, 1285 (Fed. Cir. 1984). Thus, third-party registrations may be used like dictionaries to demonstrate that the mark conveys a specific meaning. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-695 (CCPA 1976); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983).

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The third-party registrations do not show that the word "Grizzly" is suggestive of opposer's material handling or industrial equipment, nor does applicant assert that "Grizzly" is suggestive. The twenty-eight (28) third-party registrations of record are for a wide range of products in disparate fields (e.g., waste treatment equipment, tires, weightlifting equipment, farm equipment, etc.). The disparate nature of the goods in the third-party registrations do not shed any light on what common significance the word "Grizzly" might have for these different goods, or for opposer's identified goods. Accordingly, we do not believe that opposer's mark has been shown to be weak.

Moreover, even if we were to deem the protection accorded opposer's mark as being more limited than that for an inherently strong mark, the protection still extends to prevent the registration of marks that convey the same commercial impression and that is used for related goods. Likelihood of confusion "is to be avoided, as much between 'weak' marks as between 'strong' marks." *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974).

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F. The nature and extent of any actual confusion.

Opposer argued that the following exhibits constitute evidence of actual confusion (our analysis of the probative value of each exhibit is set forth immediately after the identification of the exhibit):

Exhibit 44

Opposer's catalog request form, dated September 9, 2003, wherein the company requesting the catalog told opposer's telephone operator that it had bought welding benches from Grizzly Industrial.⁷⁴ In Exhibit 44, the requestor had previously bought a product from applicant. We can infer from this exhibit that because of the identity of the marks and complementary nature of the products, the requestor mistakenly believed that there was an association between the parties;

Exhibit 45

A fax, dated August 27, 2003, from one of opposer's distributors requesting a quote for a number of products identified by the GRIZZLY trademark. Many of the products listed are not manufactured by opposer, but may be found in applicant's description of goods (*i.e.*, lathes,

⁷⁴ A. Mlakar Trial Dep., pp. 47-48.

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shapers, cutters, and spindle sanders).⁷⁵

Although we cannot be sure that the distributor requesting a quote had confused the parties, we can infer from this exhibit that because of the identity of the marks and complementary nature of the products the distributor mistakenly believed that there was some association between the parties;

Exhibit 46

A photocopy of a page from applicant's website depicting a shelf cart that one of opposer's customers faxed to opposer inquiring "can you come up with anything?"⁷⁶ Exhibit 46 is not evidence of actual confusion because opposer's customer is inquiring whether opposer has a similar product and the customer is not showing any confusion as to the source of the product displayed in the fax;

Exhibit 47

Opposer's catalog request form, dated October 17, 2000, indicating that the caller was looking for Grizzly Industrial.⁷⁷ We infer from this exhibit that the caller contacted opposer instead of

⁷⁵ A. Mlakar Trial Dep., pp. 48-51.

⁷⁶ A. Mlakar Trial Dep., pp. 51-52.

⁷⁷ A. Mlakar Trial Dep., pp. 52-53.

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applicant because of the similarity of the
trademarks;

Exhibit 48

Correspondence from Industrial Appraisal Company, dated August 16, 2000, to opposer requesting the selling price of a "Grizzly Spindle sander" for an insurance valuation appraisal. Opposer does not sell sanders, but they are listed in applicant's description of goods. Industrial Appraisal Company is not a purchaser or potential purchaser of the parties' products so it would not exercise the same degree of care as potential purchaser. However, the misdirected communication comprising Exhibit 48 is illustrative of the type of confusion that may occur because of the identify of the marks and complementary nature of the goods;

Exhibit 49

A fax, dated October 4, 2000, from Supply Depot Incorporated, addressed to Grizzly Industrial requesting a quote for tools manufactured by applicant (e.g., router, sander, jig saw, table saw, etc.).⁷⁸ This communication appears to be

⁷⁸ A. Mlakar Trial Dep., pp. 55-56.

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misdirected correspondence sent to opposer because of the similarity of the trademarks;

Exhibit 50

A copy of a request for a quote from Find MRO.com, dated May 16, 2001, for the type of equipment that is manufactured by applicant (*i.e.*, gauge sets, thread restorers, replacement blades, tap stick, and a circle marker set).⁷⁹ The request for a quote is addressed to Pucel Enterprises, and there is no reference to the trademark "Grizzly." Without testimony from the contact at Find MRO.com, we cannot draw any inferences regarding whether it mistakenly believed that there was an association between the parties; and,

Exhibit 51

A copy of a purchase order for drawers. However, because Mr. Mlakar could not testify as to whether it was or was not for opposer's products or applicant's products, Exhibit 51 is not evidence of actual confusion.⁸⁰

Applicant argued that in light of the facts that the parties have concurrently and extensively used and

⁷⁹ A. Mlakar Trial Dep., p. 56.

⁸⁰ A. Mlakar Trial Dep., pp. 56-57.

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advertised their marks on a national basis for twenty-three (23) years,⁸¹ opposer's five (5) credible instances of actual confusion are *de minimis*.⁸²

On the one hand, the above-noted five credible instances of actual confusion do not prove that someone bought applicant's products believing it to be opposer's products or vice versa, nor are only five credible instances of confusion especially impressive under the circumstances. On the other hand, the evidence demonstrates that because of the similarity of the marks and the complementary nature of the goods potential consumers have mistakenly believed the products and services emanate from the same source. While the relevant standard is likelihood of confusion, not actual confusion, any instances of actual confusion are clearly

⁸¹ The record clearly establishes that there has been ample opportunity for actual confusion to arise. Applicant has an average of 1.5 million customers per year. (Balolia Trial Dep., p. 12). It ships over 500,000 orders annually. (Balolia Trial Dep., pp. 40-41). Since 1996, applicant has been distributing approximately 2 million catalogs a year, and since 1983, it has distributed a total of approximately 25 million catalogs. (Balolia Trial Dep., pp. 17 and 40). Applicant's sales have grown from \$1 million per year in 1983 to over \$100 million per year in 2005. (Balolia Trial Dep., pp. 13-15; Exhibit 67). Opposer distributes approximately 15,000 catalogs per year. (R. Mlakar Trial Dep., p. 140). It has approximately 2,500 distributors, some of whom display opposer's products in their catalogs. (R. Mlakar Trial Dep., pp. 141-142). One of opposer's distributors, SMO, distributes over 1 million catalogs a year. (R. Mlakar Trial Dep., p. 143). In addition, some distributors link to opposer's website. (R. Mlakar Trial Dep., pp. 143-145). Opposer also advertises in the Thomas Register. (A. Mlakar Trial Dep., p. 22).

⁸² Applicant's Brief, pp. 27-28.

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probative of whether confusion is likely. Accordingly, we find that this *du Pont* factor favors finding that there is a likelihood of confusion.

G. Balancing the factors.

The *du Pont* factors require to us to consider the thirteen factors for which evidence has been made of record. The Court of Customs and Patent Appeals, the predecessor to our reviewing court, has observed that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). Because of the identity of the marks, the similarity of the goods set forth in each application and registration owned by both parties, and the absence of any evidence that militates against confusion, we conclude that applicant's GRIZZLY mark, as applied to applicant's woodworking and metal working machinery and tools and related services, so resembles opposer's GRIZZLY marks, as applied to material handling and industrial equipment, as to be likely to cause confusion.

Decision: The opposition is sustained and application Serial No. 76088346 is refused registration.

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The petitions for cancellation are granted and the registrations will be cancelled in due course.