

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Millers Falls Tool Company

Serial No. 74/587,902

B. Joseph Schaeff of Killworth, Gottman, Hagan & Schaeff for applicant.

Cindy B. Greenbaum, Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney).

Before Rice, Cissel, and Hohein, Administrative Trademark Judges.

Opinion by Rice, Administrative Trademark Judge:

An intent-to-use application has been filed by Millers Falls Tool Company to register the mark MOHAWK-SHELBURNE for hand powered construction tools, namely, saws, saw frames, saw blades and drill bits.¹

Registration has been finally refused under Section 2(d) of the Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with its specified goods, so resembles the mark MOHAWK, registered for hand

¹ Application Serial No. 74/587,902, filed October 20, 1994 under Section 1(b) of the Trademark Act of 1946, 15 U.S.C. §1051(b), based on applicant's allegation of its bona fide intention to use the mark in commerce.

operated tools, namely, spur gear drill, sander, floor jack, die grinder, impact wrench and ratchet,² as to be likely to cause confusion, or to cause mistake, or to deceive.

In support of the refusal to register, the Examining Attorney has made of record a number of third-party registrations and applications to show that third parties have registered, or sought to register, their marks both for one or more items of the type specified in applicant's application, and for one or more items of the type listed in the cited registration.³

² Registration No. 1,197,128 issued to Pacific Freight Supply, Inc., a.k.a. Certified Tool Co., on June 8, 1982; Sec. 8 affidavit accepted; Sec. 15 affidavit received.

The Examining Attorney initially cited two additional registrations, both issued to Precision Twist Drill Co. The first, Registration No. 1,565,493, issued November 14, 1989 for the mark MOHAWK for carbide tipped and high speed steel standard and special cutting tools, namely, end mills, counter borers, reamers, bull nose centers, full and half centers; cobalt high speed steel standard and special cutting tools, namely, end mills; solid carbide standard and special cutting tools, namely, end mills, drills, reamers, routers, grinding tools, slitting saws, and countersinks; and high speed steel aircraft tooling. During the course of the prosecution of this application, Registration No. 1,565,493 was cancelled under the provisions of Section 8 of the Act and was therefore withdrawn as a reference. The second registration, Registration No. 1,641,034, issued April 16, 1991 for the mark MOHAWK for drill bit blanks and reamer blanks; Sec. 8 affidavit accepted; Sec. 15 affidavit received. In her appeal brief, the Examining Attorney withdrew this registration as a reference against applicant's mark.

³ Examples of these applications and registrations, and the pertinent goods in each, include application Serial No. 74/600,982--saw blades, drill bits, and drills; application Serial No. 74/597,457--nonelectric hand-held tools, namely, drills and drill bits; application Serial No. 74/482,090--hand-operated tools, namely, wrenches, saws and saw blades, and drill bits; Registration No. 1,818,748--hand tools, namely, wrenches, saw blades, bits for hand drills, and hand saws; Registration No. 1,824,770--cutting tools for hand operated tools, namely, drills and drill bit; Registration Nos. 1,847,996 and 1,853,966 (owned by same third-party registrant)--hand tools, namely, drills, drill bits, manually-operated jacks for motor cars, saws

Applicant, in turn, relies upon approximately 100 active and inactive federal registrations and applications⁴ for marks which consist of or include the term MOHAWK.⁵

and blades therefor, and wrenches; Registration No. 1,776,931--hand tools and hand tool accessories, namely, drills and drill bits for hand drills; Registration No. 1,772,214--manually operated hand tools, namely, wrenches, saws, drills and drill bits; and Registration No. 1,824,896--hand tools, namely, wrenches, saws, and drill bits.

⁴ To make the applications and registrations of record, applicant submitted printouts of registration and application information from the CompuMark trademark search database. The Board ordinarily will not consider copies of a search report or information taken from a private company's database as credible evidence of the existence of the registrations and applications listed therein. In order to make third-party registrations of record, soft copies thereof, or the electronic equivalent thereof, i.e., printouts of the registrations taken from the electronic records of the Patent and Trademark Office's own database, must be made of record. See *In re Smith and Mahaffey*, 31 USPQ2d 1531 (TTAB 1994). The same is true with respect to third-party applications. However, the Examining Attorney, after noting that the registrations and applications relied on by applicant had not been properly made of record, waived this objection to them. Accordingly, we have considered them in our determination of this case.

⁵ The applications and registrations are for a wide variety of goods, most of which are totally unrelated to the goods in this case. The registrations with goods most pertinent to this case (in addition to the two registrations originally cited herein and withdrawn) are Registration No. 218,857, issued to Hudson Mfg. Company in 1926 and now expired, for the mark MOHAWK for portable and hand-operated sprayers and parts thereof; Registration No. 829,739, issued to Mohawk Equipment Company in 1967 and now expired, for the mark MOHAWK EQUIPMENT CO. TEMPLE, TEXAS QUALITY MACHINERY for mechanized rotary brush and weed cutters of the type designed to be drawn by farm tractors, tractor-drawn plant and crop cutters and shredders, etc.; Registration No. 1,369,824, issued to Mohawk Resources, Ltd. in 1985 and still subsisting, for MOHAWK for hydraulic lifts; Registration No. 1,376,538, issued to Mohawk Wire and Cable Corporation in 1985 and still subsisting, for MOHAWK for electrical and electronic cables and wires; Registration No. 375,932, issued to Behr-Manning Corporation in 1940 and now expired, for MOHAWK FLINT for coated abrasives; Registration No. 574,078, issued to Behr Manning Corporation in 1953 and now expired, for MOHAWK for flexible and inflexible abrasives; Registration No. 255,333, issued to F.W. Steadman Co. in 1929 and now expired, for MOHAWK for lubricating oils and compounds; and Registration No. 1,013,993, issued to Ranger Tool Co., Inc.

These registrations and applications are offered by applicant in support of its argument that MOHAWK is a weak mark because it "has been diluted by widespread use and registration by a very large number of companies" (page 3 of applicant's request for reconsideration filed May 9, 1996).

Turning first to the goods, the third-party registrations made of record by the Examining Attorney are probative to indicate that applicant's goods and at least some of the goods listed in the cited registration are of a type which may emanate from a single source under the same mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993), and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). Applicant argues, however, that its goods are sold to building contractors and carpenters, as reflected in its identification of goods (i.e., "hand powered *construction* tools, ..."); that applicant's goods are sold directly to these purchasers through applicant's catalogs; that goods of this type are also sold in hardware stores; that the goods identified in the cited registration are of a type used for industrial and/or automotive repair applications, not by building contractors; and that the goods of applicant and registrant travel through different channels of trade to different purchasers.

It is well settled that when evaluating the likelihood of confusion in proceedings involving the registrability of

in 1975 and renewed, for the mark MOHAWK for metal pipeline valves, namely, control valves.

marks, we must consider the identification of goods set forth in the relevant application and registration(s), regardless of what the evidence adduced (or which might have been adduced) may show as to the particular nature of the goods, their actual channels of trade, or the class of purchasers to which they are, in fact, sold. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983); and cases cited in the foregoing.

While applicant's identification in the present case is limited to hand powered *construction* tools, the identification is not limited to sales only through applicant's catalog. Moreover, registrant's registration contains no limitations as to channels of trade or classes of purchasers, and applicant's arguments do not persuade us that all of the goods listed in the cited registration are inherently inappropriate for use in the construction field.

Under the circumstances, we find that the goods specified in applicant's application and registrant's registration, or at least some of them, are related in nature, and that the contemporaneous marketing of these goods by applicant and registrant under the same or similar marks would be likely to cause confusion.

We turn then to the marks. Applicant's mark, MOHAWK-SHELBURNE, encompasses registrant's mark MOHAWK in its

entirety. We agree with applicant that its mark must be considered in its entirety, and that neither element thereof is more dominant than the other. At the same time, we cannot ignore the fact that MOHAWK appears at the beginning of applicant's mark, and hence is quite likely to be remembered.

Moreover, the third-party registrations relied upon by applicant in support of its "weak mark" argument are insufficient, in and of themselves, to establish that the marks shown therein are in use, or that purchasers are familiar with them. We also note that with the exception of the two registrations issued to Precision Twist Drill Co., which were cited by the Examining Attorney and then later withdrawn (one for unstated reasons, and the other due to its cancellation pursuant to Section 8 of the Act), none of the third-party registrations is for goods similar to those involved in this case. In short, the third-party registrations are insufficient to establish that the mark MOHAWK, which is arbitrary (insofar as the record shows) when applied to goods of the type specified in applicant's application and the cited registration, is a weak mark for tools.

Considering the relationship of the goods, and the similarities between the marks, we conclude that purchasers familiar with registrant's mark for the listed hand operated tools will be likely to believe, upon encountering goods of the type specified in applicant's application bearing the

mark MOHAWK-SHELBURNE, that the mark MOHAWK-SHELBURNE designates another line of hand powered tools emanating from, or licensed by or otherwise associated with, registrant. Accordingly, we agree with the Examining Attorney that there is, in this case, a likelihood of confusion.

Decision: The refusal to register is affirmed.

J. E. Rice

R. F. Cissel

G. D. Hohein
Administrative Trademark
Judge, Trademark Trial
and Appeal Board