

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Hearing:
October 17, 2000

Paper No. 19
RFC

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Red Wing Shoe Company, Inc.**

Serial No. 75/340,358

Paul A. Welter of Merchant & Gould P.C. for Red Wing Shoe Company, Inc.

Shari Sheffield, Trademark Examining Attorney, Law Office 109 (Ronald Sussman, Managing Attorney).

Before **Cissel**, Chapman and Wendel, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 13, 1997, applicant filed the above-referenced application to register the mark shown below

on the Principal Register for "footwear; utility clothing," in Class 25. The application was based on applicant's

assertion that it possessed a bona fide intent to use the mark on these goods in commerce. Prior to any examination of the application by the Patent and Trademark Office, applicant filed an amendment to allege use as of April 1, 1997 and use in interstate commerce as of the same date.

The Examining Attorney refused registration under Section 2(d) of the Act on the ground that applicant's mark, as applied to the goods set forth in the application, so resembles the mark "WERX," which is registered¹ for "utility gloves made of fabric coated with rubber or similar composition," in Class 25, that confusion is likely. The marks in several other registrations and co-pending applications were also raised as bars and potential bars to registration of applicant's mark, but they were subsequently withdrawn.

Applicant responded to the refusal to register with an amendment to the identification-of-goods clause and argument that confusion is not likely. As amended, the goods were stated to be "footwear, namely work boots and shoes; utility clothing, namely t-shirts, hats and stockings." Applicant included with its response copies of printouts from a private database of registration

¹ Reg. No. 604,513, issued to PDL Trust on April 4, 1955; renewed twice.

information listing third-party marks asserted to be registered for goods in Class 25. These marks include "WORK IN PROGRESS" for "clothing for women, children, and toddlers, namely sweaters"; "WORK EXPRESS" for "shoes, sandals and hats"; "WORK 1" and design for "shoes and boots"; "WORK AT IT!" for "clothing, namely t-shirts"; "Work At It!" for "knit shirts, caps and hats," and "retail clothing stores featuring t-shirts sweat shirts, knit shirts, caps and hats"; and "WORK IT" for "clothing, namely baseball caps, t-shirts, knit shirts, sweat shirts, gym shorts, sweat shorts, and sweat pants."

The Examining Attorney was not persuaded by applicant's evidence or arguments, and the second Office Action made final the refusal to register under Section 2(d) of the Act based on the cited registration of the mark "WERX." Attached to the final refusal were copies of third-party registrations wherein both protective gloves and other clothing items such as boots and hats are listed as the products with which the particular marks are registered. Also submitted were excerpts from published stories retrieved from the Nexis® database demonstrating that protective gloves and the items listed in the application are used together by the same people when they are working.

Applicant responded with a request for reconsideration and another amendment to the identification-of-goods clause. As amended, the application identified the goods as "footwear, namely work boots and shoes, and not utility gloves." Submitted with the request for reconsideration were additional exhibits, including printed advertising materials for applicant's boots, copies of pages from registrant's web site, and copies of third-party registration information obtained from the U.S. Patent and Trademark Office Trademark Text and Image Database. Each of the marks for which information is provided includes the word "work" or "works" as a component, and the goods listed in each registration include items of clothing.

Responsive to the request for reconsideration, the Examining Attorney accepted the amended identification of goods, but maintained the final refusal to register under Section 2(d) the Act. Attached to this response were copies of pages from applicant's web site showing the dealers and distributors through which applicant's products are available. Other information retrieved from the Internet by the Examining Attorney demonstrates that several of the listed distributors for registrant's gloves also sell protective work shoes or work boots.

Applicant timely filed a notice of appeal. Both applicant and the Examining Attorney filed briefs, and an oral hearing was conducted before the Board at applicant's request.

Based on careful consideration of the arguments and the record before us in this appeal, as well as the relevant legal precedent, we find that the refusal to register is appropriate in this case. Confusion is likely because the marks create similar commercial impressions, as applied to the products specified in the registration and application, respectively, and those goods are commercially related in such a way that purchasers of them are likely to assume that the use of similar trademarks on them is an indication that they emanate from the same source.

Citing *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973), applicant submits that there is no likelihood of confusion because the marks "are neither identical nor so similar in overall appearance, connotation, or commercial impressions as to cause confusion." Applicant asserts that "[t]he goods of the parties [sic] and the normal channels of trade for the goods differ, and the purchasers of each parties' [sic] goods are sophisticated and unlikely to make impulse

purchases or to be confused as to the source of the goods." (Brief p. 3).

We disagree. To the contrary, as noted above, the commercial impressions created by these two marks are quite similar, and the goods are related.

Turning first to the marks, under the du Pont case, supra, in order to determine whether confusion is likely, we must compare the marks in their entirety for similarities in sound, appearance, meaning and connotation. Similarity in any one of these elements is sufficient to find a likelihood of confusion. In re Mack, 197 USPQ 755 (TTAB 1977). Although the marks must be compared in their entirety, greater weight may be given to a dominant feature in any given mark. In re National Data Corp., 224 USPQ 749 (Fed. Cir. 1985). The words or literal portions of marks generally have more source-identifying significance than do the designs in marks which combine the two. In re Appetito Provisions Inc., 3USPQ2d 1553 (TTAB 1987); and In re International Components Corp., 191 USPQ 653 (TTAB 1976). Generally speaking, the addition of a design element does not eliminate the similarity between marks which have common literal portions. Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc., 526 F.2d 556, 188 USPQ 105 (CCPA 1975).

When these principles are applied to the facts presented by the instant case, it is clear that the mark sought to be registered is similar in sound and connotation to the registered mark and therefore creates a commercial impression which is similar to that created by the cited registered mark. The dominant portion of applicant's mark is the term "WORX." It is this word that will be used when the goods are requested, promoted, or recommended. Although the road-work style sign design on which this term is presented cannot be ignored, the design serves to emphasize the fact that the literal term in applicant's mark is the phonetic equivalent of the word "WORKS." The cited registered mark, "WERX," is also the phonetic equivalent of "WORKS." The Examining Attorney made of record excerpts from dictionary pronunciation guides which establish that the letters "ERK" and the letters "ORK" are pronounced the same way.

Applicant argues that the term "WORX" is entitled to only a narrow scope of protection because there are other registered marks in Class 25 which contain the word "WORK." The third-party registrations, however, are for marks which present completely different commercial impressions from the impression created by either the mark applicant seeks to register or the cited registered mark. Most of them

contain additional word elements, e.g., "WORK IN PROGRESS," "WORK EXPRESS," and "Work At It." As the Examining Attorney points out, the "X" at the end of applicant's mark and registrant's mark is a very distinctive feature and helps in these marks create commercial impressions which are are similar to each other, but separate and distinct from those created by any of cited third-party registered marks cited by applicant. In any event, third-party registrations are not persuasive that confusion is not likely in this case because, without evidence or testimony concerning the extent of the use and promotion of the marks therein, the registrations themselves do not provide a basis upon which we could conclude that the public has become so familiar with such marks that they look to small differences between them in order to distinguish among them. *The Conde Nast Publications, Inc., v. Miss Quality, Inc.*, 184 USPQ 422 (CCPA 1975).

Additionally, we note that applicant's mark is also similar to the registered mark in connotation. As noted above, both marks are essentially misspellings of the word "WORKS." Applicant's goods include "work boots." The text made of record by applicant from the web site of registrant states that registrant's gloves "have already taken the precision assembly market by storm wherever working hands

need lightweight protection..." The goods of both applicant and registrant are clearly intended to be used by people who are working. In this sense, both marks are not only suggestive, they both make the same suggestion.

The second step in our analysis of the issue of likelihood of confusion is whether the goods specified in the registration are related to those set forth in the application in some manner, or the conditions surrounding their marketing is such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a single source. In *re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

The goods in the instant case clearly are related. As noted above, the Examining Attorney made of record evidence showing that the same businesses that distribute registrant's gloves also sell boots and protective footwear. The excerpted articles and the third-party registrations listing both types of products establish that consumers have a basis upon which to assume that similar marks on these products indicate that they come from the same source. In *re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Applicant's argument that confusion is unlikely because the purchasers of these products are sophisticated is not well taken. Simply put, there is no support for it in this record. Applicant has not presented any evidence to show that the purchasers of applicant's or registrant's goods are any more sophisticated than the ordinary purchasers of any other retail goods, nor has applicant supported its argument that confusion is not likely because purchasers of applicant's footwear would know that applicant manufactures only footwear. As identified in the application and registration, respectively, these goods would seem to be appropriate for ordinary consumers who need protective gear for their hands and feet in order to accomplish particular types of work in comfort and safety. Moreover, even if we were presented with evidence that only technically sophisticated, particularly safety-conscious technicians purchase these goods, we would not be convinced that confusion is unlikely. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or that they are immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1998). As the Examining Attorney points out, the issue is not whether there is likely to be confusion

between the products, but rather whether confusion as to the source of the products is likely because of the similar marks used on them. In re Rexel Inc., 223 USPQ 831 (TTAB 1984). Even if applicant had established some basis for us to conclude that applicant's customers believe that applicant only produces shoes and boots, our ruling that confusion is likely would not change. Nothing would prevent applicant from expanding its product line in the future to include other items of protective clothing, such as gloves, in the future.

Even if we had doubt as to whether confusion is likely, we would have to resolve such doubt in favor of the registrant, and against applicant, who, as the second comer, had the duty to select a mark that is unlikely to cause confusion with one that is already in use on related goods. Squirrel Brand Co. v. Green Gables Investment Co., *in re* Green Gables Nut Farms, 223 USPQ 154 (TTAB 1984).

In summary, confusion is likely because applicant's mark, when considered in its entirety, creates a commercial impression which is very similar to that which is created by the registered mark, and the goods set forth in the registration are commercially related to those specified in the application.

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Decision: The refusal to register under Section 2(d) of Lanham Act is affirmed.

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