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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Allied Electronics, Inc.

Serial No. 78132209

Eric Von Vorys of Shulman Rogers Gandal Pordy & Ecker, P.A. for
Allied Electronics, Inc.

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(Meryl L. Hershkowitz, Managing Attorney).

Before Quinn, Hohein and Holtzman, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Allied Electronics, Inc. to
register the mark ALLIED ELECTRONICS ("ELECTRONICS" disclaimed)
for the following goods, as amended: "hand tools for use in the
electronics' industry, namely hand-held crimpers, wire cutters,
lead cutters, wire strippers, extractors for electrical and

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computer components, tweezers, punchdown tools, blow torches and metal vices," in International Class 8.¹

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the mark shown below for "hand- and machine-tools; namely, files, drill bits, trowels, screwdrivers, pliers, wrenches, chisels, punches, saws, snips and shears, scrapers, hammers, taps and dies," as to be likely to cause confusion.²



When the refusal was made final, applicant appealed.³
Briefs have been filed. An oral hearing was not requested.

¹ Application Serial No. 78132209, filed May 30, 2002, based on an allegation of first use and first use in commerce in 1929. The application includes a claim of ownership of Registration No. 2271634 for the mark ALLIED ELECTRONICS ("ELECTRONICS" disclaimed) for "catalogs, manuals and purchasing guides for industrial sale and distribution of passive and electronic components, electrical test equipment and experimental equipment," in International Class 16.

² Registration No. 568267, issued on December 23, 1952; third renewal. The class of goods is listed in the registration as "IC 007 008."

³ Together with its notice of appeal, applicant filed a request for reconsideration seeking to overcome the Section 2(d) refusal by amending its original identification of goods to delete "all tools that overlapped Registrant's goods" (Brief, p. 8), namely, punches, wrenches, pliers and screwdrivers. This amendment was ultimately

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Here, as in any likelihood of confusion analysis, we look to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), giving particular attention to the factors most relevant to the case at hand, including the similarity of the marks and the similarity of the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Turning first to the marks, applicant maintains that the examining attorney has improperly dissected the marks; that confusion is not automatically likely if an applicant has a mark that contains in part the whole of another's mark; and that considering the differences in the marks, including the disclaimed word in applicant's mark and the rectangle design in registrant's mark, the two marks, in their entireties, are dissimilar.

In addition, applicant argues that the term "ALLIED" in registrant's mark is weak and entitled only to a narrow scope of protection. Applicant maintains that "ALLIED" is a "common term used by producers in applicant's channels of trade." (Response dated March 5, 2003, p. 2).

In support of its position, applicant has submitted the following evidence: (1) a listing obtained from the TESS

accepted by the examining attorney who then continued the refusal on the basis of the identification of goods as amended.

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database of hundreds of live and dead applications and registrations that consist of or include the word "ALLIED," purporting to show that the term "is in wide use on different kinds of goods." (Request for Recon., p. 6); (2) a third-party registration for the mark WRIGHT ALLIED TOOLS (Registration No. 1313180) for "socket, wrenches, socket sets and wrench sets," maintaining that this registration coexists with the cited registration without confusion; (3) a 28-page printout of an Internet search summary which, according to applicant, reveals that the term "Allied" is referenced in over 494,000 websites that offer related tools for sale, and thereby shows that the registered mark should not be considered strong enough to prevent the registration of a mark merely because it contains the term "Allied" for tools; (4) portions of third-party websites showing, according to applicant, that 18 companies produce hand tools under a trade name that includes the term "Allied"; and (5) the form declarations of five individuals, each of whom is identified as being "employed in the electronic industry" and as having "extensive experience in this field," and each of whom states that Allied "is a commonly used term to designate tool manufacturers' and distributors' respective lines with or without other terms, designations or designs."

It is true that marks must be considered in their entireties. However, it is well settled that "there is nothing

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improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

When registrant's mark ALLIED (and design) and applicant's mark ALLIED ELECTRONICS are compared in their entireties, giving appropriate weight to the features thereof, we find that the marks, while not identical, are very similar in sound, appearance and meaning, and that they create similar overall commercial impressions. While we recognize that there are differences in the marks, we find that those differences are far outweighed by their similarities.

The term "ALLIED" is visually and aurally the most significant portion of both applicant's and registrant's mark. It is this portion of each mark that conveys the strongest impression. While the disclaimed and descriptive, if not generic, term "ELECTRONICS" in applicant's mark is not ignored, the fact is that the purchasing public is more likely to rely on the nondescriptive portion of the mark, that is, the word "ALLIED" as an indication of source. See *In re National Data Corp.*, supra at 751 ("That a particular feature is descriptive or generic with respect to the involved goods or services is one

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commonly accepted rationale for giving less weight to a portion of a mark").

The entire word portion of registrant's mark is "ALLIED." In addition, it is the word "ALLIED," itself, rather than the particular display of the word that is more likely to have a greater impact on purchasers and be remembered by them. The word portion of a composite word and design mark is generally accorded greater weight because it is used to call for and refer to the goods. See, e.g., *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531 (Fed. Cir. 1997). See also *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). This is particularly true in this case where the rectangle design in registrant's mark, functioning as a simple carrier for the word, is visually insignificant and does nothing to add to or change the commercial impression created by "ALLIED" alone.

Moreover, the term "ALLIED" appears to have no intrinsic meaning in relation to the identified goods. To the extent the word does have any suggestive meaning, even with the additional elements in each mark, that meaning would be virtually the same in both marks.

Applicant's evidence fails to convince us that the word "ALLIED" in registrant's mark is in "common use" or is otherwise weak and entitled to only a narrow scope of protection.

The evidence consisting of third-party applications and registrations is deficient for a number of reasons. We begin by noting that a mere listing of applications and registrations, without copies thereof, is generally insufficient to make the registrations of record. See *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998). Nevertheless, because the examining attorney did not object to the listing on this basis, this evidence has been treated as if properly of record and considered for whatever probative value it may have. That said, the probative value of this evidence is very limited. Inactive or "dead" applications and registrations are of no probative value, and moreover applications are not probative of anything except that they were filed in the Office. In addition, the list fails to identify any goods or services, making it impossible to draw any meaningful inferences or conclusions from this evidence about the alleged weakness of registrant's mark.

We would also point out that the factor to be considered in determining likelihood of confusion under *du Pont* is the number and nature of similar marks "in use on similar goods" (emphasis added). See *In re E.I. du Pont de Nemours & Co.*, *supra* at 567. Thus, the existence of registrations for "ALLIED" which, according to applicant, are for "different kinds of goods," is irrelevant to the question of whether the marks applied to the goods involved herein are likely to cause confusion.

Moreover, third-party registrations are not evidence that the marks therein are in use or that purchasers are aware of them. See *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973) and *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040 (TTAB 1989). Thus, the fact that the cited mark and the mark WRIGHT ALLIED TOOLS coexist on the register does not prove that they coexist in the marketplace. In any event, we note that applicant's mark is less similar to the mark in this registration than it is to the cited mark.

While third-party registrations are not evidence of use, they may be used to indicate that a commonly registered element has a suggestive or recognized meaning for particular goods or services such that differences in other portions of the marks may be sufficient to render the marks as a whole distinguishable. See, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588, 592 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). However, the existence of one third-party registration fails to show any suggestive or commonly understood meaning of "ALLIED" in the relevant field.

Applicant's 28-page listing of website summaries is not particularly useful either. For the most part, the summaries are so abbreviated that the specific nature of the business or the particular goods or services offered on the various websites

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cannot even be determined. The listing otherwise includes irrelevant references (e.g., "allied health"; "allied recruitment"; "allied investor tools"); or references where the context of use is ambiguous or unclear. For example, it is unclear whether "Allied" is used to identify products at all; and if so, whether the products are "tools"; and if the products are in fact "tools," whether the tools are similar to those herein or are for use in unrelated fields.

Only two of the 18 third-party websites made of record by applicant are arguably relevant: www.alliedtools.com and www.contractorstools.com. Hand tools may be offered on some of the other websites, but not under product names that include "Allied." The remaining websites offer products that are not related to those herein, such as machining tools, wire brushes, construction fastening systems, concrete and building materials, and industrial construction and demolition tools. There is nothing in the record to show that such goods are related to hand tools.

At best, the Internet evidence shows only a few instances of use of the term "Allied" by other companies in connection with the same or similar products. This evidence fails to show sufficiently widespread use of "Allied" to demonstrate that registrant's mark is weak in relation to the identified goods. Moreover, applicant has not shown how extensive these particular

third-party uses are. We have no information as to, for example, how long the websites have been operational or the extent of public exposure to the sites.

The uniform statements from the five declarants that "Allied" is "in common use" are conclusory and unsupported and entitled to little weight. The declarants have not identified a single third-party use of "Allied" let alone any use of that term for similar products.

Thus, the evidence as a whole fails to convince us that "ALLIED" is anything other than an arbitrary term for registrant's goods, or that it is entitled to anything less than a normal scope of protection. We accordingly find that the additional elements in applicant's and registrant's marks are not sufficient to adequately distinguish one mark from the other.

We turn then to a consideration of the goods. Applicant contends that the goods are used for different purposes. Pointing to a printout of a page from registrant's website, applicant argues that registrant's goods are general hand tools for "do-it-yourselfers" whereas applicant's hand tools are for use in servicing, maintaining, and installing specialized electronic equipment. Applicant further argues that registrant's general hand tools for "do-it-yourselfers" would be sold through normal retail channels for such products in contrast to applicant's specialized hand tools that are sold to technically

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trained individuals and are only available for purchase by wholesale consumers in applicant's own catalogs or on its own website.

In addition, applicant relies on the five declarations from "third-party representatives in Applicant's channels of trade" who state, according to applicant, that they are not confused by the marks on the respective goods because applicant's tools are for use in the electronics industry while registrant's tools are generally for "do-it-yourselfers," and that specialty electronics tools are not sold in the same channels of trade as general home and garden tools.

It is well settled that goods need not be similar or competitive in nature to support a finding of likelihood of confusion. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). It is sufficient if the respective goods 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 thereon, give rise to the mistaken belief that they emanate from or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Applicant's hand tools for use in the electronics industry, namely, hand-held crimpers, wire cutters, lead cutters, wire

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strippers, extractors for electrical and computer components, tweezers, punchdown tools, blow torches and metal vices, on the one hand, and registrant's hand tools which include files, drill bits, screwdrivers, pliers, wrenches, chisels, punches, saws, snips and shears, scrapers, hammers, and taps and dies, on the other, are closely related goods. Applicant's hand tools are used, according to applicant, for "servicing, maintaining, and installing" computers and other electronic systems. Registrant's hand tools can likewise be used for this purpose. Both types of hand tools can be used to perform complementary functions on the same electronic equipment.

We note that the examining attorney has submitted over 40 use-based third-party registrations showing that, in each instance, a single entity has adopted a mark for goods of the type listed in the application and for goods such as those identified in the cited registration. A number of those registrations specify that the hand tools are used for repair, installation and maintenance of electronic equipment or are otherwise used in connection with such equipment. For example, Registration No. 2540689, for the mark DATAWARE, lists crimpers, wire cutters/strippers, extractors and tweezers, as well as screwdrivers, pliers and wrenches, among the "manually operated hand tools" used for "assembling and disassembling computer equipment"; Registration No. 2033366, for the mark VANTAGE

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(stylized), lists hammers, pliers, punches, screwdrivers, wrenches, saws, snips and files, as well as tweezers, wire crimpers/strippers and extraction tools, as among the tools used for "home and office repair, servicing and maintenance of electronic equipment [and] computers"; and Registration No. 2247962, for the mark GC PROFESSIONAL, lists pliers, screwdrivers and wrenches, as well as wire strippers and crimpers, among the "hand tools for electronics."

Although, as applicant points out, use-based third-party registrations are not evidence that the marks shown therein are in commercial use or that the public is familiar with them, they nevertheless have some probative value to the extent that they serve to suggest that the goods listed therein may emanate from a single source. See *In re Albert Trostel & Sons Co.*, *supra*, and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

The fact that applicant itself originally listed in its own application some of the very goods identified in the registration (i.e., punches, wrenches, pliers and screwdrivers) further tends to suggest that a single source may make available both types of hand tools and may offer them under a single mark.

Applicant does not dispute that hand tools such as those identified in the cited registration can be used on computers and other electronic systems. Applicant instead maintains that registrant's particular tools are not used for this purpose. In

this regard, applicant has impermissibly attempted to limit the use, channels of trade and purchasers of registrant's hand tools to the "do-it-yourself" or "garden tool" market. The question of likelihood of confusion is based on the goods as identified in the application and cited registration rather than on what any evidence may show as to the actual use or purpose of the goods, or their actual channels of trade or classes of purchasers. See *J & J Snack Foods Corp. v. McDonalds' Corp.*, 932 F.2d 1460, 1464, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991) and *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

There is no question that registrant's goods, as identified, can be used for general purposes, but they are not restricted to such use.⁴ Nor are the goods restricted to particular channels of trade or classes of purchasers. Therefore, we must presume that registrant's hand tools would be used for all the usual purposes, including use in connection with electronic systems;⁵

⁴ We would also point out that the page submitted by applicant from registrant's website does not, in fact, show that registrant's hand tools are limited to the "do-it-yourself" market.

⁵ The case of *Bendix Aviation Corp. v. Ardor Mfg. Co.*, 331 F.2d 903, 141 USPQ 572 (CCPA 1964) on which applicant relies is distinguishable. In that case, the Court affirmed the Board's finding of no likelihood of conclusion between opposer's registered mark "BENDIX" for "tools and devices ... for testing and analyzing electrical systems and components thereof" and applicant's mark "BENDIT" for "hand tools for bending or shaping aluminum wire into hooks," based on both the differences in the marks (i.e., the highly suggestive meaning of BENDIT and the distinct differences in connotation) and the different nature of the goods. In

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and that they are sold in the same channels of trade to the same purchasers, including applicant's purchasers in the electronics industry. It is also reasonable to assume that the same individuals would make the purchasing decisions concerning both products.

With regard to the declarations from "representatives in applicant's channels of trade," there is no indication that these individuals are purchasers or potential purchasers for applicant's goods, or that they are qualified to speak for such purchasers. In fact, their relationship, if any, to applicant is not revealed. Further, contrary to applicant's contention, these individuals do not state they are not confused by these marks on the respective goods. Apart from their conclusory statement that "Allied" is commonly used, they do not even mention the marks involved in this case. Nor do the declarants state that registrant's hand tools are "do-it-yourself" tools. They each state only that "[t]here is a recognized difference between specialized hand tools for use in the electronics' industry and general hand tools for do-it-yourselfers," that such tools are sold in different markets, and that they are not aware of any hardware store that sells both types of products. Once again,

particular, the Board distinguished the specialized nature of opposer's goods from the stated function of applicant's hand tools, namely "bending wire into a wire hook." In the present case, registrant's hand tools are not limited to any specific function.

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applicant has impermissibly defined registrant's goods as "do-it-yourself" tools. The registration is not restricted to those goods or to that market.

The overlapping purchasers for applicant's and registrant's goods would be those in the electronics industry and it is reasonable to assume such purchasers are sophisticated and knowledgeable about those products, and that they would exercise greater care in making purchasing decisions. However, the fact that such purchasers would be sophisticated and knowledgeable does not compel a finding that there is no likelihood of confusion. See, e.g., *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). Even sophisticated persons would be susceptible to source confusion, particularly under circumstances where, as here, the goods are closely related and are sold under very similar marks. See *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962) and *In re Pellerin Milnor Corporation*, 221 USPQ 558 (TTAB 1983).

Finally, applicant's claim that there has been no actual confusion is entitled to little weight. While the absence of actual confusion is a factor indicative of no likelihood of confusion, it is meaningful only where the record demonstrates appreciable and continuous use by applicant of its mark in the same markets as those served by registrant under its mark. See

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Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). While we have applicant's statement of use of its mark, we have no information as to its sales or advertising expenditures, or the geographic areas served by applicant. Moreover, there is no evidence of any use of the registered mark, let alone information relating to the extent of such use. Cf. In re General Motors Corp., 23 USPQ2d 1465 (TTAB 1992).

In view of the foregoing, we find that purchasers familiar with registrant's hand tools provided under its ALLIED and design mark, would be likely to believe, upon encountering applicant's mark ALLIED ELECTRONICS for closely related goods, that the goods originated with or are somehow associated with or sponsored by the same entity.

To the extent that there is any doubt on the issue of likelihood of confusion, such doubt must be resolved in favor of the prior registrant. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

Decision: The refusal to register is affirmed.