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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Microsoft Corporation

Serial No. 78144053

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Before Chapman, Holtzman and Zervas, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, Microsoft Corporation, has filed an application
to register the mark BRUTE FORCE for goods ultimately identified
as "action figures in the nature of science fiction and military
characters, marketed in connection with computer and video games
and other media" in International Class 28.¹

The trademark examining attorney has refused registration
under Section 2(d) of the Trademark Act on the ground that

¹ Serial No. 78144053, filed July 15, 2002, based on an allegation of a
bona fide intention to use the mark in commerce.

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applicant's mark, when applied to applicant's goods, so resembles the registered mark BRUTE FORCE for "toys, namely, toy cars, model kits, die cast toy cars, and toy helmets" as to be likely to cause confusion.²

When the refusal was made final, applicant appealed. Briefs have been filed. An oral hearing was requested, but the request was subsequently withdrawn by applicant.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue, including the similarities of the marks and the similarities of the goods. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We turn first to the marks. Applicant's mark BRUTE FORCE and registrant's mark BRUTE FORCE are identical word marks displayed in identical (standard character) form. Applicant, however, argues that in relation to the respective goods the two marks convey different commercial impressions.

In particular, applicant argues that registrant, who applicant identifies as John Force, is a "funny car" race driver

² Registration No. 2270312; issued August 17, 1999 to John Harold Force and Laurie A. Force; Section 8 affidavit accepted, Section 15 affidavit acknowledged. The examining attorney also initially referenced pending application Serial No. 76032651 as a potential cite against the present application. Applicant advised the examining attorney that applicant was the owner, by assignment, of the application and, accordingly, the reference was withdrawn. That application was abandoned on November 16, 2003.

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who has won 12 national championships; that he is well known in the race car community; and that BRUTE FORCE toy cars are actual replicas of the funny cars Mr. Force raced in the 1970s which are "apparently called 'Brute Force' to play off John Force's surname." (Response filed May 22, 2003 at 2.) Applicant has submitted pages from a third-party website (www.dancys.com) which, according to applicant show various toy car replicas of those race cars including the "BRUTE FORCE" models. Applicant concludes that "in the context of the goods, as recited in the registration" the consumers of registrant's goods "will immediately make a connection between the toy car and helmet and the famous racecar and its driver, both widely known to racing fans by the 'Brute Force' nickname." (Req. for Recon. at 2.)

Applicant argues that, in contrast to the association evoked by registrant's mark, applicant's action figures in the nature of science fiction and military characters will be associated with applicant's video games. Applicant points to its ownership of a registered mark (Registration No. 2832923) for BRUTE FORCE for video games which, as described by applicant, is "an action-packed sci-fi, quad-based shooter game." Applicant concludes that in view of the differences in the goods "the consumer will come away with a completely different commercial impression" of each mark. (Req. for Recon at 2.)

Applicant's arguments and evidence are not persuasive. While John Force, who is only one of the two joint owners of the cited registration, may be a "funny car" race driver, the evidence fails to show how or why consumers would associate toy cars with his name. The website, which appears to be that of a gift shop, does not explain who John Force is, let alone prove that he is well-known or that purchasers of toy cars are aware of him. We also note that the pages displaying the "BRUTE FORCE" model cars do not contain a website name or any other information identifying their source. Nor is there any information on these pages which would connect these cars to John Force, and moreover nothing is displayed on the cars themselves which would evoke an association with his name or persona.

We find that when viewed in relation to the goods as identified in the application and registration, the term BRUTE FORCE projects the same suggestive image in connection with toy action figures as it does in connection with toy cars, that is, toys with imaginary attributes of great strength and power, and that the commercial impression is the same.

Thus, applicant's mark is identical in all respects to registrant's mark.

It is applicant's contention that registrant's mark is entitled to only a narrow scope of protection and that registrant's rights "only extend to the toy cars and related

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goods listed in the registration." (Brief at 8.) In support of its position, applicant has submitted printouts of two third-party registrations for BRUTE FORCE (owned by different entities) in International Class 28 -- Registration No. 2215425 for "fishing tackle and fishing floats" and Registration No. 1949588 for "multi-station exercise machines."³ Applicant argues that "with two additional registered marks in Class 28, there can be no claim that Registrant's mark is a strong mark in this class"; that third-party registrations can be relevant to show that a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services; and that "by using all three registrations [including the cited registration] as a dictionary for the term BRUTE FORCE, it is evident that the term is in common use, and that it is capable of different meanings by different consumers." (Reply Brief at 5,6.)

There are a number of problems with applicant's arguments. To begin with, the classification of goods is purely an administrative matter and, in and of itself, is of no significance in determining the relative strength or weakness of a mark. See *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d

³ These printouts are not copies of official USPTO records but rather were obtained from a private Internet website. However, because the examining attorney did not object to the evidence, it is considered of record.

1771 (Fed. Cir. 1993). Further, 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, third-party registrations of BRUTE FORCE for fishing tackle and exercise machines, goods completely dissimilar to action figures and toy cars, are irrelevant to the question of whether the marks applied to the goods involved herein are likely to cause confusion. In addition, it is well settled that third-party registrations are not evidence of use. 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).

While it is true that third-party registrations can be relevant to show that a commonly registered term has a suggestive meaning for particular goods such that differences in other portions of the marks may be sufficient to distinguish them, in this case the marks are identical. There are no other portions to distinguish them.

We recognize that BRUTE FORCE is a somewhat suggestive mark, and as such perhaps not entitled to the broadest scope of protection. However, the mark would at least be entitled to protection from registration of applicant's identical mark for related goods. See, e.g., *King Candy Co. v. Eunice King's*

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Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974)
(likelihood of confusion is to be avoided as much between weak marks as between strong marks).

We turn to a consideration of the goods, keeping in mind that where the marks are identical, less similarity is required of the products on which they are used in order to support a finding of likelihood of confusion. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

We find that applicant's "action figures in the nature of science fiction and military characters" with or without a connection to video games, and registrant's goods which include toy cars and toy helmets are closely related, complementary toys that are likely to be used by children of the same age group and for the same play activity. We also note that the examining attorney has submitted numerous use-based, third-party registrations showing that, in each instance, a single entity has adopted the same mark for action figures on the one hand, and for toy cars and accessories on the other. Although the third-party registrations are not evidence of use of the marks in commerce, the registrations have probative value to the extent that they suggest that the respective goods are of a type which may emanate from the same source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988).

Applicant argues that the respective goods are sold to different customers contending that registrant's toy cars are sold to race car enthusiasts familiar with John Force's funny car racing antics whereas applicant's toys are designed to appeal to consumers who are fans of applicant's BRUTE FORCE video game, an "action-packed sci-fi, quad-based shooter game." (Brief at 4.)

Applicant also argues that that the goods will be offered in different channels of trade and in particular that applicant's goods will be sold through science fiction and fantasy websites, video game websites, and the action figure sections of toy stores, whereas registrant's toy cars are sold on websites for race car fans and in different sections of toy stores. Relying on *In re The Shoe Works Inc.*, 6 USPQ2d 1890 (TTAB 1988) which applicant claims is "analogous to the current facts," applicant maintains that the restriction of the marketing and trade channels in its identification of goods eliminates a likelihood of confusion. In this regard, applicant refers to its ownership of Registration No. 2832923 for BRUTE FORCE for goods, described in part by applicant as "computer and video game programs" and a published application (Serial No. 78116214) for BRUTE FORCE for goods including, according to applicant, comic books in the field

of computer games.⁴ Based on this evidence, applicant concludes that its toy action figures are a natural expansion of applicant's use of BRUTE FORCE in connection with its video games and that "consumers viewing the Applicant's action figure toys, marketed in connection with Applicant's BRUTE FORCE video game, will understand that Applicant is the owner of the action figures." (Brief at 5.)

Applicant has not shown that any asserted expansion of its use from video games to action figures would be considered "natural"⁵ but more important, this entire argument misses the point. The question is not whether consumers would expect applicant's toy action figures and video games and/or comic books to both come from applicant, but whether consumers would expect registrant's toy cars and applicant's toy action figures to come from the same source.

Moreover, in arguing that the purchasers and trade channels for the goods are different, applicant has read impermissible limitations into the application and registration. As our

⁴ Applicant did not properly introduce its claimed application and registration but because the examining attorney has not objected, we have considered them of record.

⁵ Applicant claims that it is a common practice to market action figures in association with video games and refers, for the first time in its brief, to the alleged existence of a number of registrations that list both goods. Although this evidence is untimely and otherwise not properly of record, because the examining attorney has not objected to the evidence, we have treated it as of record. However, this evidence has no bearing on whether goods at issue would be perceived as emanating from the same source.

primary reviewing Court has often stated, the question of likelihood of confusion is determined on the basis of the identification of goods set forth in the application and registration, rather than on the basis of what evidence might show the actual channels of trade or purchasers to be. See *J & J Snack Foods Corp. v. McDonalds Corp.*, 932 F.2d 1460, 1464, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

There are no restrictions in either the application or registration that effectively limit the trade channels or the purchasers for the goods. Further, there is nothing inherent in the nature of either applicant's or registrant's goods which would indicate or even suggest that the toys are not offered in the same trade channels to the same purchasers. Unlike the restriction to the goods in *Shoe Works*, the language "marketed in connection with a video game" in this application, while perhaps indicating that applicant's toys and video games are promoted together, in no way serves to limit the channels of trade or the purchasers for those goods.

Thus, it must be presumed that registrant's toy cars and applicant's toy action figures, which are marketed in connection with a video game, would be sold in all the usual retail outlets

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for toys including toy stores and toy departments of other stores as well as on the same Internet websites where other toys are sold. In this regard, we note the website printouts submitted by the examining attorney (for example, www.entertainmentearth.com, www.matchbox.com and www.masteroftheuniverse.com) showing that action figures along with a variety of other toys, including toy cars, are sold and/or advertised on the same websites. There is no evidence that action figures and toy cars typically would be displayed in different sections of a store nor do we find that to be an important consideration since the toys may not even be purchased at the same time. We can also presume that both applicant's and registrant's toys are offered to all the usual purchasers, including the general public.

In view of the foregoing, and because the identical marks are used in connection with closely related goods, we find that there is a likelihood of confusion.

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