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Hearing: June 15, 2005

Mailed: September 16, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lawman Armor Corporation

Serial No. 75982984

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(Meryl L. Hershkowitz, Managing Attorney).

Before Holtzman, Drost and Kuhlke, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Lawman Armor Corporation
(applicant) to register UNBREAKABLE for "security devices,
namely, metal anti-theft locks" in Class 6. The application was
filed on November 21, 2001 based on an allegation of a bona fide
intention to use the mark in commerce.¹ In addition, the

¹ The application was originally assigned Serial No. 76340443 and
included an additional class of goods, Class 9, for "security devices,
namely, computer security software for managing, monitoring and
controlling data access in computers located in residential dwellings

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application was filed seeking registration of UNBREAKABLE under Section 2(f) of the Trademark Act, based on applicant's ownership of the following three registrations on the Principal Register (all registered without a claim of distinctiveness).

Registration No. 2493196:²

THE UNBRAKEABLE BOAT LOCK

For: "Anti-theft locks for securing boat equipment, namely motors, propellers, and boat trailers" in Class 12.

Registration No. 2489742:³

THE UNBRAKEABLE AUTO LOCK

For: "Anti-theft locks for use on motor vehicle brakes and clutches" in Class 12.

and commercial buildings." On September 6, 2002, applicant filed a request to divide the Class 6 goods out of the application. The request was subsequently approved and the Class 6 application was assigned Serial No. 75982984. Along with the request to divide, applicant had filed an amendment to allege use with respect to the Class 6 goods. The examining attorney rejected the specimen submitted with the amendment to allege use but inasmuch as applicant, in its brief, has withdrawn the amendment to allege use, the specimen requirement is moot.

² Issued September 25, 2001; alleging first use in March 1999 and first use in commerce in May 1999; "BOAT LOCK" is disclaimed.

³ Issued September 18, 2001; alleging first use and first use in commerce on July 1, 1998; "AUTO LOCK" is disclaimed.

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Registration No. 2303431:⁴



For: "Anti-theft locks for use on motor vehicle brakes and clutches" in Class 12.

The application included a declaration of applicant's president, Robert Vito, who states that the "UNBRAKEABLE" mark and line of products have achieved national recognition; that the line was recently featured on the "Good Morning America" television program and in the magazines of "Time" and "Popular Mechanics"; and that "[t]o date Applicant has advertised the 'UNBRAKEABLE' line of products in all 50 states totaling approximately \$12 million in [expenditures]."

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of its services and that applicant's evidence is insufficient to show acquired distinctiveness of the mark under Section 2(f) of the Act.

When the refusal was made final, applicant appealed.⁵

⁴ Issued December 28, 1999; alleging first use and first use in commerce on July 1, 1998; "AUTO LOCK" is disclaimed.

⁵ At the examining attorney's request, the subject application (Serial No. 75982984) was consolidated for purposes of appeal with related application Serial Nos. 76357601, 76357600, 76357349 and 76340443 (the

Applicant and the examining attorney have filed briefs, and an oral hearing was held.

Applicant having filed the application seeking registration under Section 2(f) has conceded that the mark is merely descriptive under Section 2(e)(1).⁶ See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) and *General Foods Corporation v. MGD Partners*, 224 USPQ 479, 485 (TTAB 1984). Thus, the sole issue on appeal is whether applicant has carried its burden of establishing, by a preponderance of the evidence, a prima facie case that its merely descriptive mark has acquired distinctiveness under Section 2(f). See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, supra; and *In re Rogers*, 53 USPQ2d 1741 (TTAB 1999).

Trademark Rule 2.41(b) provides that ownership of a registration of "the same mark" on the Principal Register may be accepted as prima facie evidence of acquired distinctiveness. In relying on this rule, an applicant is essentially seeking to "tack" the use of the registered mark to its use of the present mark for purposes of transferring distinctiveness to the new

divided application). All of the related applications are now abandoned. Accordingly, the appeal is going forward solely on the present application.

⁶ In any event, the record in this case, including the dictionary definitions and Nexis and Internet references made of record by the examining attorney, clearly demonstrates that the relevant public would perceive UNBREAKABLE as merely descriptive of applicant's goods.

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mark. See *In re Flex-O-Glass, Inc.*, 194 USPQ 203 (TTAB 1977). Thus, the analysis used to determine whether applicant's present mark is "the same mark" as its previously registered mark, for purposes of the rule, is the analysis used in tacking cases, i.e., whether the marks are legal equivalents. See *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991). See also *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

To meet the legal equivalents test, the marks must be indistinguishable from one another or create the same, continuing commercial impression such that the consumer would consider both as the same mark. See *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, *supra*; and *In re Dial-A-Mattress Operating Corp.*, *supra*. Therefore, a minor difference in the marks, such as an inconsequential modification or modernization of the later mark, would not be a basis for rejecting application of the rule. See *In re Loew's Theatres, Inc.*, 223 USPQ 513 (TTAB 1984) *aff'd*, 769 F.2d 764 (Fed. Cir. 1985) and *In re Flex-O-Glass, Inc.*, *supra*. On the other hand, it has been made clear that two marks are not necessarily legal equivalents merely because they would be deemed confusingly similar. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, *supra*.

Aside from the identity of the marks in the registration and the application, applicant is also required to establish,

through submission of relevant evidence rather than mere conjecture, a sufficient relationship between the goods in the prior registration and the goods identified in the application to warrant the conclusion that the distinctiveness of the mark associated with the goods in the registration will "transfer" to goods listed in the application. See *In re Rogers*, supra.

It is applicant's contention that UNBREAKABLE and UNBRAKEABLE create the same continuing commercial impression and that a consumer would consider the two marks to be the same. In particular, applicant argues:

First, both marks are pronounced exactly the same. Second, the marks look the same. The only minor difference...is that a letter "E" falls between the "R" and "A" in the UNBREAKABLE mark and the same letter "E" is between the "K" and "A" in the UNBRAKEABLE marks. In essence, the difference is merely the position of one letter in the middle of both marks. (Brief, pp. 4-5.)

Citing the *Dial-A-Mattress* case, applicant asserts that the minor spelling difference between UNBREAKABLE and UNBRAKEABLE is immaterial and that the two marks are legal equivalents. In support of its contention, applicant has relied on a survey conducted by Bruno and Ridgway Research Associates ("Consumer Survey Regarding Automobile Anti-Theft Devices") showing, according to applicant, that automobile owners who have used an automobile anti-theft device do not distinguish between UNBRAKEABLE and UNBREAKABLE and further that consumers understand

that the marks are "for all intents and purposes the same and identify the same product." (Brief, p. 1.)

The examining attorney, finding applicant's arguments and the survey evidence unpersuasive, maintains that the two marks are not legal equivalents. As described by the examining attorney, the registered term "UNBRAKEABLE" is a coined word formed by an unusual spelling of "unbreakable" with a double meaning evoking not only the indestructibility of the goods but also alluding to their use, i.e., a device which locks around a vehicle's brake pedal. The examining attorney argues that in contrast to UNBRAKEABLE which creates an unusual and unique commercial impression as a play on the descriptive word "unbreakable," the applied-for mark UNBREAKABLE simply and succinctly describes a salient and desirable feature of anti-theft locks, i.e., that the locks are incapable of being broken. The examining attorney has submitted a dictionary definition from *The American Heritage Dictionary of the English Language, Third Edition* (1992) of "unbreakable" as "impossible to break; able to withstand rough usage"; a page from that same dictionary containing no entry for the registered term "UNBRAKEABLE"; and excerpts from the Nexis database and third-party websites showing, according to the examining attorney, that "unbreakable" is a highly descriptive term used to describe a desirable feature

of an anti-theft lock. Examples of such references are as follows (emphasis added):

Fortify the wall and door behind the cockpit; give the cockpit door an **unbreakable** lock; *Los Angeles Times* (September 19, 2001).

After spending more than \$400 for my bicycle, I'm not about to leave it on a city street. Those supposedly **unbreakable** locks can't be trusted. *Chicago Tribune* (March 3, 1997).

Baskin said there were 34 separate entrances to the complex and no locks. They put locks on all the gates and doors, and they lasted two days. Then they put in **unbreakable** locks, which lasted two weeks. *Chicago Tribune* (November 12, 1995).

...Bicycle lock program--\$20 for **unbreakable** lock that can be returned. www.darkicon.com.

We agree with the examining attorney that applicant's present mark UNBREAKABLE, while perhaps confusingly similar to, is clearly not the legal equivalent of any of the registered marks, THE UNBRAKEABLE BOAT LOCK, THE UNBRAKEABLE AUTO LOCK, and THE UNBRAKEABLE AUTOLOCK and design. Unlike the *Dial-A-Mattress* case on which applicant relies, the differences between the marks involved in this case go far beyond a minor difference in spelling. The evidence made of record by the examining attorney clearly shows, and there is no dispute, that the applied-for mark UNBREAKABLE is an ordinary dictionary word that does nothing more than describe a significant feature, i.e., the strength, of applicant's anti-theft locks. In the registered marks, the

misspelling of the term as UNBRAKEABLE adds a new dimension and meaning to the dictionary word. It transforms "unbreakable" into a term that only suggests rather than describes the strength of the goods and moreover suggests a new and additional meaning relating to a function of the goods, i.e., that they lock a vehicle's brake pedal. Thus, the misspelling results in a term that while identical in sound and similar in appearance to UNBREAKABLE, creates a different commercial impression than UNBREAKABLE. Therefore, the two marks cannot be considered "the same" for purposes of Trademark Rule 2.41(b).

We further note that while applicant is seeking registration for the word UNBREAKABLE alone, the term "UNBRAKABLE" is registered as part of composite marks that include other word and design elements ("THE UNBRAKEABLE AUTO LOCK" with and without a design feature and "THE UNBRAKEABLE BOAT LOCK"). The change from UNBRAKEABLE with these other elements to UNBREAKABLE alone does not continue the commercial impression of the registered marks, but instead impermissibly broadens it. See, e.g., *American Paging, Inc. v. American Mobilphone, Inc.*, 13 USPQ2d 2036, 2039 (TTAB 1989) (finding AMERICAN MOBILPHONE PAGING more informative than and hence legally different from AMERICAN MOBILPHONE notwithstanding that "PAGING" was merely descriptive of the services), *aff'd unpub'd*, 923 F.2d 869, 17 USPQ2d 1726

(Fed. Cir. 1990). See also *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, supra.

We do not find the results of applicant's survey to be persuasive. The survey was comprised of 200 owners of automobiles who have used automobile anti-theft devices sampled from ten different cities. The respondents were divided into two groups, each presented with one of two lists displaying the names and logos of five brands of automobile anti-theft devices. The names on the two lists were identical except for the display of applicant's mark on one list in the form shown below on the left and on the other list in the form shown below on the right.

**The UnBRAKEable
AutoLock PRO®**

**The UnBREAKable
AutoLock PRO®**

Of the 200 respondents, 97 were given the list of names with the "UNBRAKEABLE" version of the designation and 103 were given the list with the "UNBREAKABLE" version. The respondents in each group were asked to identify which of the devices, if any, shown on the list (1) they had ever used, (2) they had seen or heard of, and (3) they had seen or heard advertising for. The survey shows that 11 participants in the group shown the "UNBRAKEABLE" spelling (or 11%) and 8 participants shown the "UNBREAKABLE" spelling (or 8%) indicated that they had seen or heard of the mark. Applicant concludes, based on the survey results, that any

minor difference between the marks will not be perceived by consumers.

The examining attorney argues that the respondents were not presented with the involved marks; that the respondents were not questioned as to whether they recognized any spelling errors in the marks; and that the findings of the survey are statistically insignificant.

Applicant, however, maintains that the display of the marks used in the survey instead of the actual applied-for and registered marks is actually weighted against applicant. In particular, applicant argues that the capitalization of "BRAKE" and "BREAK" emphasizes the minor difference in the marks such that if customers perceived no difference when the minor difference was emphasized, no difference will be perceived when the marks are presented as actually used. Further, applicant contends that a question regarding spelling errors would be "a wholly inappropriate query"; and moreover that the survey is "directional" and that it is proper to rely on small samples as "directional evidence."

We find that the survey fails to show, or even measure, the identity or continuity in commercial impression of the marks at issue in this case. The most significant problem is that the two designations presented to the respondents were neither the marks contained in the prior registrations nor the mark for which

registration is now sought and they differed from the actual marks in significant ways. Notwithstanding that "BRAKE" and "BREAK" were emphasized in the display, we have no way of determining the extent to which the other differences in the presentation of the marks affected or influenced the responses and it is quite possible that they did. Moreover, the small number of relevant participants undercuts the reliability of the survey even if it had been a survey directed to the marks actually at issue in this proceeding.

At best, the survey shows what we already know; that the marks have some similarities. However, the survey is entitled to little probative value on the question of whether the two marks are perceived as the same.

Because the marks are not the same, Trademark Rule 2.41(b) cannot be used to establish that UNBREAKABLE has acquired distinctiveness as a mark for any goods, let alone the goods for which registration is now sought.⁷ Thus, it is unnecessary to consider the relationship between the goods for which the marks

⁷ We also find that applicant's evidence of the asserted strength and recognition of the registered marks while perhaps relevant to the question of whether the registered and applied-for marks would be perceived as "similar," has no bearing on the question of whether the marks would be perceived as "the same."

have been registered and the goods identified in the application.⁸

In view of the foregoing, we find that the evidence of acquired distinctiveness is insufficient to permit registration of UNBREAKABLE for metal anti-theft locks under Section 2(f).

Decision: The refusal to register is affirmed.

⁸ Nevertheless, even if the marks were the same, we would find that the registrations are insufficient in and of themselves to establish that the distinctiveness of the registered marks for very narrowly described goods has transferred to the far broader goods identified in this application. See, e.g., *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1310 (Fed. Cir. 2002) ("as a general proposition...a broad general market category is not a generally reliable test of relatedness of products."). See also *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985) ("[n]othing in the statute provides a right *ipso facto* to register a mark for additional goods when items are added to a company's line or substituted for other goods covered by a registration."); *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (prior registration for specific services involving credit cards does not automatically entitle applicant to a registration for broader financial services); and *Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 6 USPQ2d 1475 (TTAB 1988) (preexisting registration of gold ring device for rifle scopes insufficient to demonstrate that the gold ring device has become distinctive of applicant's binoculars and spotting scopes).