

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Leatherman Tool Group, Inc.
Serial No. 88/845,465
Mark: BOND
Filing Date: March 24, 2020
International Class: 8

In an Office Action issued June 20, 2020, the Examining Attorney refused registration of Applicant’s mark BOND (“Applicant’s Mark”) because of an alleged likelihood of confusion with two prior registrations for BOND under Registration No. 3,392,004 (“Cited Mark 1”) and BOND & Design under Registration No. 3,261,213 (“Cited Mark 2”). Applicant submits this Response to the Office Action, asserting that there is no likelihood of confusion between Applicant’s Mark and the Cited Marks for at least the reasons discussed below. In addition, the Examining Attorney required revisions to the description of goods in Class 8, and Applicant has amended its Application accordingly. Applicant therefore respectfully requests that its Application be advanced to publication.

Section 2(d) of the Lanham Act bars registration of an applied-for mark that so resembles a registered mark such that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and prior registrant. 12 U.S.C § 1052(d). The United States Patent and Trademark Office (“USPTO”) has the burden of proving a likelihood of confusion. *In re Giovanni Food Co.*, 97 U.S.P.Q.2d 1990, 1992 (T.T.A.B. 2011). The principal factors to be considered when determining whether there is a likelihood of confusion are described in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). However, not all of the *Du Pont* factors are relevant or given equal weight in the analysis, and any one factor may be dominant in a given case. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003); *Du Pont*, 476 F.2d at 1361–62. Significantly, even a single

Du Pont factor may be dispositive in a likelihood of confusion analysis. *Kellogg Co. v. Pack'Em Enters., Inc.*, 951 F.2d 330, 333 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive.”).

In this case, Applicant submits that confusion is not likely because the goods offered under Applicant’s Mark are distinguishable from those offered under the Cited Marks. The goods Applicant will offer under its mark are “folding multipurpose hand tool[s] comprised of multiple blades and one or more of the following hand tools, namely, scissors, pliers, wire-cutter, wire stripper, straight screwdriver, square head screwdriver for driving screws with recessed heads, saw, file, can opener, and bottle opener; fabric and leather sheaths for knives; fabric and leather sheaths for folding multipurpose hand tools; and tool pouches for attachment to tool belts” in Class 8. Both Cited Marks are registered in connection with, “hand-held garden tools, namely, shovels, rakes, shears, saws, pruners and loppers; gardening supplies, namely, bulb planters” in Class 8, and, “gardening supplies, namely, non-metal stakes” in Class 20.¹ Although Applicant’s goods and the goods covered by the Cited Marks are in the same class (Class 8), the goods associated with each mark are distinguishable.

It is well-settled that even identical or nearly identical marks, when used in connection with dissimilar goods, are not likely to result in confusion, even when those dissimilar goods can be grouped into the same general category. *See, e.g., In re Shivworks Prods. Grp., LLC*, 2020 TTAB LEXIS 429 (Sept. 4, 2020) (determining no likelihood of confusion between CLINCH PICK for military, tactical, and fixed bladed knives and CLINCH DRIVE for hand tools, namely, wrenches); *In re Hagemeyer N. Am., Inc.*, 2007 TTAB LEXIS 400, at *7 (Aug. 30, 2007) (finding VERSAPRO for weed killers, insecticides, and herbicides not confusingly similar to

¹ Cited Mark 2 is also registered in connection with “metal plant holders” in Class 21.

VERSAPRO for garden tools); *In re Mars, Inc.*, 741 F.2d 395 (Fed. Cir. 1984) (finding no likelihood of confusion between CANYON covering candy bars and CANYON covering citrus fruits); *King Research Inc. v. Shulton, Inc.*, 454 F.2d 66 (2d Cir. 1972) (concluding SHIPSHAPE for men’s hairspray is not confusingly similar to SHIP-SHAPE for comb and brush cleaner).

In addition, it is well-established that the nature and scope of a party’s goods must be determined on the basis of the goods as recited in its application or registration. TMEP § 1207.01(a)(iii). Here, the Examining Attorney argues that both Applicant and Registrant produce “hand tools,” such as the identical “saw” and other closely-related hand tools, including pliers, files, shears, scissors, pruners, screwdrivers, shovels, rakes, and bottle openers. Reading the descriptions of goods in this piecemeal fashion, however, disregards the actual and fundamental nature of both parties’ goods because it ignores important characteristics and qualifying information about the goods. Such a reading thus results in an inaccurate perception of the relatedness of the parties’ goods.

The description of goods covered by the Cited Marks contains an important qualifier: “hand-held garden tools.” The fact that the items listed in the description are specifically for gardening cannot be ignored. Indeed, the specimens submitted to renew the Cited Marks (attached hereto as Exhibits A and B) demonstrate that the goods covered by the Cited Marks are specifically gardening supplies.

More significantly, based on the description of goods in the Application, Applicant intends to offer a “folding multipurpose hand tool comprised of multiple blades and one or more [additional hand tools]”; accordingly, the description makes clear that Applicant’s Mark will not cover saws on their own, nor individual pliers, files, scissors, screwdrivers, or bottle openers, let alone gardening tools (which saws, pliers, files, scissors, screwdrivers, and bottle openers are

not). Instead, Applicant will offer a single instrument that incorporates multiple blades and one or more additional tools.² An assertion that Applicant offers a saw by itself, for example, is a fundamental misreading of the description of Applicant's goods because it disregards the multi-tool nature of the goods.

Importantly, there is no indication in the Cited Marks' descriptions of goods that Registrant offers any of its goods as a combined, single instrument, or that it offers any multi-tools at all. Moreover, the gardening tools offered by Registrant, specifically shovels, rakes, shears, pruners, loppers, and bulb planters, are not compact hand-tools, and they could not reasonably be expected to be combined into a single handheld instrument. Consequently, the fact that Applicant offers (and specifically recites in its description of goods) a multi-tool is crucial in distinguishing the goods offered under the marks. *See Shivworks*, 2020 TTAB LEXIS 429 (reversing refusal to register CLINCH PICK for "military and tactical knives; fixed bladed knives" based on alleged likelihood of confusion with third-party registration for CLINCH DRIVE covering "hand tools, namely, wrenches," and rejecting Examining Attorney's argument that the goods were highly similar and complementary because manufacturers frequently offer multi-tools that include knives and wrenches as components within the same tool, as knives included in multi-tools are "distinctively different goods" from applicant's standalone military and tactical knives and fixed bladed knives, and also recognizing that a multi-tool is a distinct product such that the Examiner's comparison to multi-tools was misleading because both parties did not offer such goods). Accordingly, comparing an individual garden saw from Registrant's

² For example, Applicant's best-selling multi-tool is a single instrument that contains all of the following: needlenose pliers, regular pliers, wire cutters, hard-wire cutters, electrical crimper, wire stripper, 420HC knife, 420HC serrated knife, saw, spring-action scissors, ruler, can opener, bottle opener, wood/metal file, diamond-coated file, large bit driver, and small bit driver. *See* webpage advertising Applicant's WAVE+ product attached hereto as Exhibit C (<https://www.leatherman.com/wave-10.html>). Applicant recognizes such outside evidence does not dispose of the issue, but it does provide an illustration of and context for the type of tool described in the Application.

description of goods to a saw incorporated into Applicant's multi-tool is misplaced: Applicant's multi-tool, comprised of several handheld tools, is highly distinguishable from an otherwise individual gardening saw.

Indeed, merely because Applicant's claimed goods and those covered by the Cited Marks share some similar wording does not mean that the goods are confusingly similar. That is, the similarity of the terms "hand," "tool," and "saw" used in the descriptions of goods for each mark is not enough to create a likelihood of confusion given the differences in the goods themselves. *See, e.g., Giovanni Food*, 97 U.S.P.Q.2d at 1992 (reversing refusal to register JUMPIN' JACKS for barbecue sauce based on a prior registration for JUMPIN JACK'S for coffeehouse and catering services, finding that some overlap in restaurants providing catering services and those selling barbecue sauce was insufficient proof of a relationship between catering services in general and barbecue sauce); *Harvey Hubbell Inc. v. Tokyo Seimitsu Co.*, 188 U.S.P.Q. 517, 520 (T.T.A.B. 1975) (observing that the mere fact that the term "electronic" can be used to describe any product that includes an electronic device does not make all electronics similar, and finding applicant's machine control gauges and opposer's telecommunications equipment dissimilar).

Apart from arguing that the goods are similar in nature, the Examining Attorney also concludes that the parties' respective goods travel in similar channels of trade. The Examining Attorney includes as evidence "third-party marks registered for use in connection with the same or similar goods and/or services as those of both" Applicant and Registrant. None of the examples, however, demonstrate that a single entity offers both Applicant's multi-tools and Registrant's gardening supplies. Instead, the registrations capture tools generally, but no registration covers both Applicant's and Registrant's goods where they are accurately described

(and, in fact, no registration covers both tools generally and garden supplies).

The fact that Applicant's and Registrant's goods may be classified in the same shopping category of "tools" does not, in itself, demonstrate that the goods are likely to cause confusion. "The mere fact that two products may move in the same channels of trade to the same class of purchasers does not, ipso facto, prove that there is a definite relationship between the goods." *Shivworks*, 2020 TTAB LEXIS 429, at *13 (quoting *Champion Int'l Corp. v. Genova, Inc.*, 199 U.S.P.Q. 301, 305 (T.T.A.B. 1978)). Indeed, a retailer offering "tools" would likely delineate the parties' respective goods such that a consumer would encounter garden tools separately from multi-tools. See webpages from general purpose store attached hereto as Exhibit D; *Shivworks*, 2020 TTAB LEXIS 429, at *13–14 (finding the fact that applicant's military, tactical, and fixed bladed knives and registrant's wrenches can be found under same general shopping category of "knives and tools" does not demonstrate that the goods are necessarily related for likelihood of confusion purposes, particularly where the shopping category delineates goods by identifying them separately). Even if a single retailer offers both types of products, such companies sell a wide variety of products, which lessens the probative weight of the trade channels. See *Hagemeyer*, 2007 TTAB LEXIS 400, at *8 (lessening probative weight accorded to similarity of trade channels in which applicant's weed killers, insecticides, and herbicides and registrant's garden tools traveled because "hardware stores and industrial supply companies sell quite a wide variety of products").

Overall, as the description of goods specifies, Applicant will offer a compact multi-tool, which combines several types of tools (knife, scissors, and pliers, for example) into one distinct and compact instrument. Conversely, the Cited Marks cover garden supplies. A consumer looking for Applicant's multi-function pocket tool would not be confused into thinking that the

Cited Marks appearing on gardening supplies are affiliated with Applicant's goods, or vice versa. Accordingly, the goods offered under Applicant's Mark and the Cited Mark are sufficiently different such that there is no likelihood of confusion as to the source of the goods offered under Applicant's Mark.

Conclusion

The goods offered under each mark are highly distinguishable such that there is no likelihood of confusion between Applicant's Mark and the Cited Marks. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw the refusal based on the Cited Marks and advance the application for BOND to publication.