

5/16/01

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Paper No. 8
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Henry Company

Serial No. 75/578,506

Marvin E. Jacobs of Koppel & Jacobs for Henry Company.

Won T. Oh, Trademark Examining Attorney, Law Office 104
(Sidney Moskowitz, Managing Attorney).

Before Hairston, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

Henry Company (applicant) has filed an application to register the mark FLASHMASTER for goods ultimately identified as "asphalt-based roofing mastic for sealing flashing and patching roofs" in International Class 19.¹ The Examining Attorney has refused to register the mark under Section 2(d) because of the registration of the mark

¹ Serial No. 75/578,506 filed on October 28, 1998, claiming a date of first use and date of first use in commerce since July 31, 1988.

MASTER FLASH for "non-metallic roof flashing including a metal sheet portion" in International Class 19.² Both applicant's and registrant's marks are depicted in a typed drawing.

After the Examining Attorney made the refusal final, this appeal followed. Both applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

The Examining Attorney's position is that the marks of the parties, FLASHMASTER and MASTER FLASH, are highly similar, with applicant's mark being essentially a transposition of the registrant's mark. The Examining Attorney determined that this transposition did little to alter the commercial impression. As to the goods, the Examining Attorney found them to be related.

The registrant's goods are non-metallic roof flashing including a metal sheet portion. The flashing itself is not made of metal, but merely contains a metal sheet. Applicant's goods are mastic that are intended to be used with flashing. Thus applicant's goods are complementary to the registrant's goods and are therefore in the same channels of trade. Office Action dated March 23, 2000, p. 2.

Finding that the marks were highly similar and the goods were related, the Examining Attorney refused to

² Registration No. 1,497,753, issued July 26, 1988. A Section 8 affidavit has been accepted. The word "flash" is disclaimed.

register applicant's mark for the goods identified in its application.

Applicant responded to this refusal to register by arguing that the goods are not related. Applicant maintains that the identification of goods in the registration is inconsistent and misleading. In addition, with its Appeal Brief applicant submitted printouts from its website and registrant's website.³ Because applicant believes it is famous for asphalt-based products for products such as roof sealing and driveway coatings, it argues that purchasers would not expect it to be marketing a metal product, such as a roof flashing. In addition, applicant submits that the marks have different connotations. Finally, applicant claims ownership of a registration for the mark FLASHMASTIC for non-metallic building materials and other goods.⁴ Because the MASTER FLASH mark did not prevent the registration of applicant's claimed registration, applicant argues that this supports its position that there is no likelihood of confusion in this case.

³ The Examining Attorney did not object to, and in fact discussed, this evidence on the merits. Therefore, we will consider this evidence to be of record.

⁴ Registration No. 2,050,456.

After considering the arguments and evidence of the applicant and the Examining Attorney, the Examining Attorney's refusal to register the mark FLASHMASTER for asphalt-based roofing mastic for sealing flashing and patching roofs, because it is confusingly similar to the mark MASTER FLASH for non-metallic roof flashing including a metallic sheet portion under Section 2(d), is affirmed.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first question we address is whether applicant's and registrant's marks, when compared in their entireties, are similar in sound, appearance or meaning such that they create a similar overall commercial impressions. The test is not whether the marks can be distinguished in a side-by-side comparison, but whether they are sufficiently similar

Ser. No. 75/578,506

in their overall commercial impression so that confusion as to the source of the goods marketed under the respective marks is likely to result. In this analysis, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Regarding the marks, we find that they are very similar. In fact, the only differences between the mark FLASHMASTER and MASTER FLASH is the fact that the words are transposed and applicant's mark does not have a space between the words. While the transposition of words may create a different commercial impression, that is not the case here. While applicant argues that "master" is used as a verb in one mark and an adjective in another mark, it is unlikely that prospective purchasers will make such a fine distinction. Both marks contain the laudatory term "master" and the highly descriptive term "flash." Regardless of the order of the words, they create the same impression. Compare In re Akzona Inc., 219 USPQ 94 (TTAB 1983) (SILKY TOUCH creates a different commercial impression than TOUCH O' SILK) with In re Nationwide

Ser. No. 75/578,506

Industries Inc., 6 USPQ2d 1882 (TTAB 1988) (Marks RUST BUSTER and BUST RUST did not create distinctly different commercial impressions).

Next, we must determine whether the goods are related. To determine whether the goods are related, we look to the identification of goods in the application and registration. In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). While applicant has submitted evidence of how registrant is currently marketing its goods, this does not limit the identification of goods in the registration. Both applicant's and registrant's goods are roofing products. Applicant's product is a mastic for sealing roof flashing, and registrant's product is a non-metallic roof flashing. They would be sold through the same channels of trade to the same purchasers. We agree with the Examining Attorney that the goods are clearly complementary. Purchasers familiar with registrant's product are likely to believe that applicant's product sold under a very similar mark comes from the same source.

While applicant argues that purchasers would not expect that it is marketing a metal product such as a roof flashing, even if this were true, this is not the complete test. The question is also whether purchasers familiar with registrant's mark would likely believe that it is the source of FLASHMASTER asphalt-based roofing mastic for sealing flashing and patching roofs. Since we hold that this is likely, we affirm the Examining Attorney's refusal to register.

Applicant's final point is that it owns a registration for the mark FLASHMASTIC for non-metallic building materials. The registration of a different mark for different goods does not indicate that there would not be a likelihood of confusion in the present case. This registration is not a simple transposition of words. It involves different words, which does not create the identical commercial impression as applicant's present mark. The registration of this mark does not mean that confusion would not be likely when applicant takes registrant's identical mark and simply transposes the words without a space.

Decision: The refusal to register is affirmed.