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Paper No. 13
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Johns Manville International, Inc.

Serial No. 75/632,215

Robert D. Touslee, Esq. for Johns Manville International, Inc.

Tami Cohen Belouin, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Simms, Walters and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Applicant has applied to register the mark ISO 1 on the Principal Register for "polyisocyanurate roof insulation" in International Class 17.¹

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used on or in connection with its specified goods, so resembles the mark POLY ISO 2, which is registered for "polyisocyanurate foam roofing insulation in

¹ Application Serial No. 75/632,215, filed February 2, 1999. The application is based on a claimed date of first use and first use in commerce of January 1991.

the form of rigid boards, used in the repair, renovation and construction of improvements to real property" in International Class 17,² as to be likely to cause confusion, or to cause mistake, or to deceive.³

When the refusal was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have briefed the issue before us. An oral hearing was not requested.

Upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), for determining whether a likelihood of confusion exists, we find that confusion is likely.

Before turning to the merits, we must address some evidentiary matters. First, applicant attached three exhibits to its brief on appeal (two declarations of

² Registration No. 1,977,174, issued May 28, 1996. The claimed dates of first use and first use in commerce are October 7, 1993 and January 2, 1994, respectively.

³ We take judicial notice of the following definition from the Means Illustrated Construction Dictionary (Third Edition 2000):

"polyisocyanurate (polyiso) A polymer with a high R-value commonly used as insulation in the form of rigid, glass fiber-reinforced foam boards, usually faced with a foil paper. Increasingly, polyiso board products are also being used for sheathing. Often specified for applications where increased fire resistance is desired." (Emphasis in original.)

See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §712.01.

employees of applicant regarding no instances of actual confusion, and an exhibit consisting of photocopies of three pages from the website of a third-party registrant. The Examining Attorney objected to this untimely additional evidence, and requested that it be excluded.

The record in an application should be complete prior to the filing of an appeal, and additional evidence filed after appeal will be given no consideration by the Board. See Trademark Rule 2.142(d), and TBMP §1207.01. Inasmuch as the exhibits attached to applicant's brief were first filed after the appeal, and the Examining Attorney objected thereto, this additional evidence is untimely pursuant to Trademark Rule 2.142(d). Accordingly, these three exhibits have not been considered in making our decision.⁴

The second evidentiary matter relates to applicant's submission of third-party registrations. In its response to the first Office action applicant merely referred therein to a few third-party registrations; and later, with its request for reconsideration, applicant submitted

⁴ In any event, even if we had considered the employee declarations, the evidence would not be persuasive of a different result herein. See *In re The Bissett-Berman Corporation*, 476 F.2d 640, 177 USPQ 528, 529-530 (CCPA 1973). See also, *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

Also, the evidence from a third-party registrant's website, even if considered, would not have persuaded us of a different result in this case.

photocopies of numerous third-party registrations from a private database search report. However, neither mere typed listings of third-party registrations, nor reports from private database searches are appropriate ways to enter such material into the record, and the Board does not take judicial notice of registrations in the USPTO. See *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *Cities Service Company v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978); and *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). Importantly, in this case applicant was twice advised by the Examining Attorney that third-party registrations are properly made of record by submitting either photocopies of the registrations or photocopies of the appropriate USPTO electronic printout. (Final Office action, p. 3, and Office denial of applicant's request for reconsideration, pp. 1-2.) In her brief, the Examining Attorney objected to consideration of these third-party registrations. These registrations are not properly of record; however, later in this decision, we will discuss generally the probative value of said registrations.

We now turn to the merits of the appeal. Applicant contends that confusion is not likely in this case "because of (1) differences in the marks, (2) the sophistication of prospective and actual purchasers, (3) the coexistence of

similar marks without any evidence of confusion, and (4) the long history of and continued coexistence of Applicant's mark and the cited mark without any complaints or evidence of confusion." (Brief, p. 3.)

We consider first the respective goods. Applicant's goods are identified as "polyisocyanurate roof insulation," and registrant's are identified as "polyisocyanurate foam roofing insulation in the form of rigid boards, used in the repair, renovation and construction of improvements to real property." Applicant's identification is broad and certainly encompasses the goods in the cited registration. Both entities sell polyisocyanurate roofing insulation. Applicant did not contend otherwise; and we find the goods are legally identical.⁵

Applicant contends that the purchasers of both entities' goods are professionals, specifically "commercial builders and roofers" (brief, p. 11). However, there is no such limitation in either identification of goods. It has

⁵ In response to a request from the Examining Attorney for promotional materials or product literature about applicant's goods, applicant submitted (on January 27, 2000) photocopies of "marketing brochures" obtained as pages from applicant's website. The following is quoted therefrom:

Description

ISO 1 is a rigid roof insulation board composed of a closed cell polyisocyanurate foam core bonded in the foaming process to universal fiber glass reinforced facers. (Emphasis in original.)

been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to decide the issues based on the goods (or services) as identified in the application and as identified in the registration, regardless of what the record may reveal otherwise. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Inasmuch as there are no restrictions in either applicant's or registrant's identifications of goods as to purchasers or channels of trade, the Board must assume that applicant's goods could move through all the ordinary and normal channels of trade for such goods, and would be offered to all the usual purchasers (including not only commercial builders and roofers, but the general public) for such products. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, *supra*; and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

We turn to a consideration of the similarities and dissimilarities of the involved marks, ISO 1 and POLY ISO 2. Both marks share the syllable ISO, and both are

followed by a single Arabic numeral. It is true that applicant left off the syllable "POLY" and used the number "1" instead of the number "2." These minor differences do not obviate the likelihood of confusion in the minds of purchasers because they are unlikely to remember the specific differences between the marks due to the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of the many trademarks encountered. That is, the purchaser's fallibility of memory over a period of time must be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

Further, even if purchasers noticed and recalled the specific differences in the marks, purchasers familiar with registrant's goods sold under the registered mark POLY ISO 2, upon seeing applicant's mark ISO 1 on essentially identical goods, would assume that applicant's goods come from the same source as registrant's goods, and merely refer to a different model or grade or series of polyisocyanurate roofing insulation.

In terms of connotation, inasmuch as the goods are polyisocyanurate products, it is clear that portions of

both marks relate thereto.⁶ That is, POLY ISO and ISO would have the same or very similar meaning or connotation in relation to these goods, namely, polyisocyanurate roofing insulation. The minor differences in the marks do not offer sufficient differences to create separate and distinct commercial impressions. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We find that the marks, considered in their entirety, are similar in sound, appearance, connotation and commercial impression.

Applicant strongly urges that it found over 75 third-party registrations of marks which include ISO; that "the use of ISO as a component of registered marks for similar goods is highly prevalent"; and that these registrations establish "that they are weak marks that are readily distinguishable by consumers." (brief, pp. 6-7). These arguments are unpersuasive. As explained previously in this order, applicant never submitted proper copies of the third-party registrations. However, in order to

⁶ In the first Office action, the Examining Attorney had refused registration of applicant's mark as merely descriptive under Section 2(e)(1), and as failing to function as a trademark under Sections 1, 2 and 45 of the Trademark Act. However, the Examining Attorney withdrew those grounds for refusal in the final Office action.

present a more complete opinion here, we will briefly discuss the limited probative value of these third-party registrations.

The Board acknowledges (based on the dictionary definition which we have judicially noticed earlier herein) that both POLY ISO and ISO have highly suggestive meanings with respect to polyisocyanurate roofing insulation. Also, it is well settled that third-party registrations, while not evidence of third-party use or that the purchasing public is aware of the marks, are competent evidence (when properly and timely introduced into the record) to show that others in a particular industry have registered marks incorporating a particular term, or that the common term in the marks has a normally understood meaning or suggestiveness in the industry. See *In re Hamilton Bank*, 222 USPQ 174 (TTAB 1984). See also, *In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985).

In this case, applicant's submission of photocopies of third-party registrations from a private database report includes references to pending applications, cancelled and expired registrations, and registrations based not on use in commerce, but on foreign registrations. Further, most of the marks and/or the involved goods in these third-party registrations are irrelevant in this case, for example,

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they include the following: UNISORB for "vibration absorbing materials for acoustic, mechanical insulating, and similar purposes consisting of felt bodies" (Reg. No. 570,210); ISOTEMP for "metallic and synthetic filaments for power driven brushes" (Reg. No. 841,835); ISOCORE for "fluid conveying hoses" (Reg. No. 1,394,862); and ISOCAP for "plastic in the form of rolls, which is used as surfaces for skis and snowboards" and "ski parts, namely, surfaces in the nature of plastic sheets for skis and snowboards" (Reg. No. 1,940,500).

Applicant specifically emphasizes the coexistence of the cited registration of the mark POLY ISO 2 for "polyisocyanurate foam roofing insulation in the form of rigid boards, used in the repair, renovation and construction of improvements to real property" (Reg. No. 1,977,174), issuing in May 1996 over an October 1993 registration for ISO-25 for "polyisocyanurate rigid closed cell foam insulating materials used for a variety of commercial and industrial uses, for example; storage, prefabricated cooler and freezer boxes and refrigerated transportation" (Reg. No. 1,800,767). We agree with the Examining Attorney that the goods in these two registrations clearly are differentiated. While it is true that the listing of examples in Reg. No. 1,800,767 is not

all-inclusive, it nonetheless provides clear and specific examples of the uses of that specific insulating material, and all of those uses are related to storage and refrigeration. A reasonable reading and interpretation of the goods in the ISO-25 registration would not include roofing insulation.

For all of the above reasons, applicant has not established that the cited mark is weak. Even if applicant had established that fact, weak marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or related goods.⁷ See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

According to applicant, there have been no instances of actual confusion in seven years of coexistence of applicant's mark and the mark in the cited registration. However, there is no evidence of applicant's and registrant's geographic areas of sales, or the amount of the sales under the respective marks. Further, there is no

⁷ We specifically note that the cited registered mark is on the Principal Register with no disclaimer and no claim of acquired distinctiveness under Section 2(f) of the Trademark Act; and it is, of course, entitled to the statutory presumptions under Section 7(b). In fact, during the prosecution of this application, applicant argued that its mark is not merely descriptive; and the Examining Attorney did not request a disclaimer of any portion of applicant's mark.

information from the registrant. In any event, the test is likelihood of confusion, not actual confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, supra; and *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984). This factor is not persuasive in applicant's favor in the overall balancing of the du Pont factors in this case.

While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) of the **Trademark Act** is affirmed.