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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Hearing:
May 15, 2002

Paper No. 14
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Standard Plywoods, Inc.

Serial No. 75/653,692

Richard M. Moose of Dority & Manning, Attorneys At Law,
P.A. for Standard Plywoods, Inc.

Laura Gorman Kovalsky, Trademark Examining Attorney, Law
Office 110 (Chris A. F. Pedersen, Managing Attorney).

Before Cissel, Hanak and Rogers, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On March 4, 1999, applicant filed the above-identified application to register the mark "DUCK GLUE" on the Principal Register for "adhesives for wood flooring," in Class 1. The basis for filing the application was applicant's assertion that it had used the mark in interstate commerce in connection with these goods since September 3, 1998.

The Examining Attorney, in addition to requiring a more definite identification-of-goods clause and a disclaimer of the descriptive word "glue," refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that applicant's mark, as applied to adhesives for wood flooring, so resembles the marks "DUCK" and "DUCK TAPE," which are registered¹ for "elongated tape having a pressure sensitive adhesive on one side," in Class 17, that confusion is likely. She reasoned that in view of the descriptiveness of the word "GLUE" in connection with the goods set forth in the application, the word "DUCK" is the dominant portion of the mark applicant seeks to register, and that this is identical to one of the cited registered marks in its entirety and quite similar to the other cited registered mark, which combines "DUCK" with another disclaimed, generic, term. She concluded that when these similar marks are used in connection with the goods specified in the application and the cited registrations, confusion is likely because the goods are related and move in the same

¹ Reg. No. 1,391,591, issued to Manco, Inc. on the Principal Register on April 29, 1986; combined affidavit under Sections 8 and 15 accepted and acknowledged; Reg. No. 1,223,446, issued on the Principal Register to the same business on January 11, 1983; combined affidavit under Sections 8 and 15 accepted and acknowledged.

channels of trade.

Applicant responded to the first Office Action by amending the identification-of-goods clause to read as follows: "adhesives for applying wood flooring." Applicant also disclaimed the exclusive right to use the word "GLUE" apart from the mark as shown.

Additionally, applicant argued that confusion with the cited registered marks is not likely because the goods set forth in the application and the registrations "differ as to their character and potential uses." Applicant noted that its goods are, as the specimen label shows, liquid adhesives, and stated that "it is literally impossible for the products constituting pressure sensitive adhesives on one side of elongated tape to be used to install wood flooring, as is the specific purpose, character and use of Applicant's goods." Additionally, applicant stated that it is unaware of any instances of actual confusion.

The Examining Attorney accepted the disclaimer of the descriptive word "GLUE" and the amendment to the identification-of-goods clause in the application, but maintained and made final the refusal to register under Section 2(d). Submitted in support of the refusal were copies of printouts from five different commercial Web sites wherein different businesses promote their products.

The first set of Web pages is from Mapei Corp., which promotes the sale of its "ULTRA/BOND" adhesives, which are liquids sold in pails. One is used to secure parquet flooring and another is used for wood planks and parquet. A third is described as a "premium pressure sensitive wood flooring adhesive specially designed for the installation of pre-finished engineered wood flooring and parquet." No mention is made of any kind of tape in this advertisement.

The second set of Web pages are from the site of Basic Adhesives, Inc., which states that it offers "Pressure Sensitive" types of adhesives to the flooring industry for use with "wood, vinyl, ceramic and cork." Tape is not listed among the goods this business provides.

The 3M Corporation's Web site, under the heading of "General Assembly Adhesives," promotes "industrial-quality formulations for bonding a wide variety of non-load bearing materials to themselves and metal, wood, plastics, and more." A tube of the product is pictured on this page. Another page from the 3M site promotes "3M Structural Bonding Tapes," which "... can help speed throughput and reduce processing costs compared to liquid adhesives, rivets and welds in many applications such as the bonding of hardware, high stress nameplates, sheet metal, plastic panels, ceramics and magnets."

The Hillas Packaging Network Web site discusses various industrial tapes, including one with "strong adhesive on one side of the carrier; repositionable adhesive on the other." It notes that "[d]ifferent tapes in this line offer different levels of adhesion on each side of the carrier. You can join substrates that include glass, metals, wood, paper, painted surfaces, and many plastics." There are no non-tape adhesive products featured on this Web site.

The fifth set of printouts is from the site of the National Starch & Chemical Co., which promotes "Bondmaster" adhesives for "millwork, wood assembly & furniture." It mentions "edge gluing, finger jointing and laminating veneer to plywood or vinyl to particle board" as uses to which Bondmaster adhesives can be put. Describing its other products under the heading "Pressure Sensitives," it lists "adhesives used in the construction of pressure sensitive labels, tapes, decals and transfer films." Although this company's adhesives can be used to manufacture such labels, films and tapes, the company does not apparently make or sell these products. A third page from this Web site lists eight different products in the "Bondmaster" line, which includes one for "edge gluing, veneering and edgebanding"; another for "assembly and

laminated adhesives, for wood, particleboard, high-pressure laminate, hardboard or veneer"; and yet another as "multi-purpose wood adhesives for use under demanding service conditions."

None of the promotional materials from these five Web sites refers to using tape of any kind to install wood flooring.

Applicant timely filed a Notice of Appeal, and, after the application was reinstated by the Commissioner after having been declared abandoned, applicant filed an appeal brief. The Examining Attorney filed her brief on appeal, and the oral hearing before the Board was conducted on the date indicated above. Applicant did not file a reply brief.

The predecessor to our primary reviewing court listed the principal factors to be considered in determining whether confusion is likely in the case of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the similarity of the goods.

Notwithstanding applicant's arguments to the contrary, we find that the mark applicant seeks to register is similar to both of the cited registered marks. As the

Examining Attorney points out, one of the registered marks is the word "DUCK" by itself and the other combines "DUCK" with the generic name of the goods with which the mark is used. Applicant has adopted the first registered mark in its entirety and the dominant portion of the second registered mark, using "DUCK" in combination with the generic, and hence disclaimed, name for its goods, "GLUE." Plainly, if the goods on which applicant uses its mark were commercially related to the goods identified in the cited registrations, confusion would be likely.

The record before us in this appeal does not show this to be the case, however. Notwithstanding the Examining Attorney's contentions, the case law and the record do not establish that prospective purchasers of adhesives for installing wood flooring have any reason to expect pressure sensitive tape with adhesive on one side to emanate from the same source as the glue with which wooden flooring is installed, or vice versa.

The Examining Attorney argues that the relationship between the goods set forth in the application and the goods identified in the cited registration is established by prior court and Board decisions in *Borden, Inc. v. Woodhill Chemical Sales Corp.*, 183 USPQ 380 (TTAB 1974); *Johnson & Johnson v. Eckel Corp.*, 129 USPQ 365 (TTAB 1961);

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and G. H. Packwood Mfg. Co. v. Cofax Corp., 183 F.2d 196, 86 USPQ 410 (CCPA 1950). Mere citation of prior decisions wherein particular products were found to be related does not, however, establish that the goods set forth in the instant application are related to the products specified in the registrations cited as a bar to registration of this applicant's mark. Case law can and does establish legal principles, but the facts needed to demonstrate the relationship between two different products must be established by the evidence in each application file where this is an issue.

The Examining Attorney states (in her brief, p. 8) that "the relevant factor here is that both goods are adhesives, not that one is a tape adhesive and the other is a liquid." She argues (at pp. 6 and 7) that because the identification in the registrations "is broad and does not specify its intended use or users, it is assumed that the registration encompasses all goods of the type described, including those in the applicant's more specific identification, that they move in all normal channels of trade and that they are available to all potential customers."

The record before us in this appeal, however, provides no basis for assuming that applicant's adhesives for

installing wood floors are somehow encompassed within the terms used in the registrations, "elongated tape having a pressure sensitive adhesive on one side," much less that they move in similar trade channels or are used by the same people for similar purposes. The products are not competitive or even complementary just because each has adhesive properties. One is tape--the other is glue. That registrant's tape has adhesive on one side of it does not somehow make adhesive tape a subset of Class 1 adhesives.

As applicant points out in its brief, the Website pages submitted by the Examining Attorney certainly do not establish that the goods in question in this appeal would be expected to emanate from a common source. As noted above, the Mapei Corp. promotional material makes no mention of any kind of tape. The Basic Adhesives, Inc. pages do not show that this business involves tape either. The information concerning 3M Corporation discusses tape products for industrial assembly. The Hillas Packaging Network site discusses various industrial tapes which can be used to secure the assembly of items made of many different materials, but there is no mention of any tape product which could be used to install wood flooring. Lastly, the information about products available from National Starch & Chemical Co. make it clear that this

company does not manufacture tape, but rather sells adhesives which can be used by tape manufacturers to make their own products. This evidence makes it clear that this business is concerned with adhesives, not tapes. Four of the five Web sites feature only products which can be termed similar to applicant's or registrant's, but not both. Only the 3M Corporation's Web site arguably involves both tapes and adhesives which do not relate to tape, but even here, there is no reference to the possibility of using tape of any kind to install wood flooring.

Simply put, the Examining Attorney has not established that anyone would have a basis upon which to assume that the goods with which applicant uses its mark emanate from the same source that provides the product identified in the cited registrations. Significantly, nowhere in any of the evidence submitted by the Examining Attorney is there even a hint that anyone makes or sells adhesive tape with which wooden flooring can be installed, or that the adhesive used to install wooden floors is made, much less sold under the same or similar marks, by the same businesses which make or sell adhesive tapes.

We have already noted that evidence that confusion has actually occurred is not necessary in order for us to conclude that confusion is likely, so applicant's argument

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that confusion is not likely because there has been none, is not the reason we rule in its favor. Similarly, we are not persuaded to reach a different result by the Examining Attorney's argument that we should resolve doubt in favor of the owner of the cited registrations. We have no doubt this record does not make out a prima facie case for refusal, so this principle has no application in the instant appeal.

In summary, to the Examining Attorney had the burden of establishing that confusion is likely, but the evidence she submitted fails to satisfy her burden. Even though these marks are similar, she has not demonstrated that prospective purchasers of adhesive for installing wood flooring are likely to assume, mistakenly, that the source of these products also makes or sells under a similar mark tape with adhesive on one side. We note in addition that in an inter partes case, based on a different record, the result might be different.

DECISION: The refusal to register is reversed.