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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Certainteed Corporation

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Serial No. 75/790,432

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Roberta Jacobs-Meadway of Ballard Spahr Andrews &  
Ingersoll, LLP for Certainteed Corporation.

Lauriel Dalier, Trademark Examining Attorney, Law Office  
116 (Meryl Hershkowitz, Managing Attorney).

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Before Simms, Cissel and Chapman, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On September 28, 1999, applicant filed the above-  
identified application to register the mark CLAREMONT on  
the Principal Register for "polyvinyl chloride (PVC)  
windows and patio doors," in Class 19. The basis for  
filing the application was applicant's assertion that it  
possessed a bona fide intention to use the mark in commerce  
in connection with these goods.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), on the ground that applicant's mark so resembles the mark CLERMONT, which is registered<sup>1</sup> for "interior doors and door facings made of construction board, namely composite board, fiberboard, hardboard and synthetic lumber or artificial lumber," also in Class 19, that if applicant were to use the mark it seeks to register in connection with polyvinyl chloride windows and patio doors, confusion would be likely.

In response to the refusal to register, applicant argued that confusion would not be likely because the "vast majority" of the products applicant intends to sell under the mark are windows, rather than doors, and applicant's "window customers are primarily specialized installers of exterior building products such as asphalt roofing shingles, vinyl siding and vinyl windows and patio doors. These installers generally do not install interior products such as the interior doors sold by Masonite under the CLERMONT mark." (Response to first Office Action, p. 3). Additionally, applicant argued that such specialized

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<sup>1</sup> Reg. No. 1,953,493, issued on the Principal Register on January 30, 1996 to Masonite Corp.; affidavits under Sections 8 and 15 of the Act accepted and acknowledged, respectively.

installers are "relatively sophisticated and are not likely to be confused between a vinyl window or patio door on the one hand and an interior door made of fiberboard or synthetic lumber on the other hand." (p. 2 of the response). Applicant submitted no evidence in support of any of its arguments.

The Examining Attorney was not persuaded to withdraw the refusal to register, and in her second Office Action, she made the refusal to register under Section 2(d) final. Submitted in support of the refusal were a number of use-based third-party registrations wherein the lists of goods include doors and windows that can be used for the interior and/or the exterior of a home or building. For example, in Reg. No. 2,294,916, the list of goods includes window frames made of wood and vinyl and doors and doorframes made of wood, without any restriction or limitation to interior or exterior installation; Reg. No. 2,276,946 lists installation services, including the installation of "metal and wood bifold doors," "interior doors," "interior pre-hung door," "interior slab door," "mirror doors" and "exterior doors"; and Reg. No. 2,361,014 lists "window assemblies" as well as "patio doors" and "patio door tracks" not made of metal, without regard to whether said

products are for use inside of a structure or outside of it.

Also submitted in support of the refusal to register was an entry from the Thomas Register website describing a company in Oregon as a manufacturer of both doors and windows of several varieties and describing another company in Wisconsin as a "supplier of steel entry doors/entrances including ... interior doors [and] window trim." The Examining Attorney asserted that this evidence demonstrates that the same sources make doors and windows that can be used for the interiors of buildings and doors and windows for use on the exteriors of buildings.

Applicant filed a Notice of Appeal concurrently with a request for suspension of action on the appeal in view of applicant's statement that it was seeking a letter of consent from the owner of the cited registration. The designated suspension period expired without submission of such a consent, however, and following an additional extension granted by the Board, applicant was advised that action on the appeal was resumed, and applicant would have to file its brief on appeal.

The Board dismissed the appeal because no brief was filed within the time period it had set, but in view of the fact that applicant had actually timely filed an additional

request for an extension of time, the Board's dismissal was vacated, and applicant was allowed additional time in which to submit its brief on appeal. Applicant timely did so, and the Examining Attorney filed her appeal brief, but applicant did not request an oral hearing before the Board.

The sole issue before us in this appeal is whether confusion would be likely if applicant were to use the mark CLAREMONT for "polyvinyl chloride windows and patio doors" in view of the registered mark CLERMONT for "interior doors and door facings made of construction board, fiberboard, hardboard and synthetic lumber or artificial lumber." Based on careful consideration of the record in this application and the written arguments of applicant and the Examining Attorney, we hold that the refusal under Section 2(d) of the Lanham Act is well taken. Confusion would be likely because these two marks are similar in appearance, pronunciation and commercial impression, and the goods specified in the application are commercially related to those identified in the registration.

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. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these factors are (1) the similarity of

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the marks as to appearance, pronunciation, meaning and commercial impression; and (2) the similarity of the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Notwithstanding applicant's arguments to the contrary, these two marks are quite similar. Applicant argues that the differences in the ways the marks are spelled require that they be pronounced differently; and that they have different geographic meanings. The issue is not whether a side-by-side comparison of the marks would make distinctions apparent, but rather whether the marks create similar overall commercial impression in connection with the goods with which they are, or are intended to be, used. *Visual Information Institute, Inc. v. Vicon industries Inc.*, 209 USPQ 179 (TTAB 1980). In determining what the overall commercial impressions of the marks are, we must focus on the perception and recollection of the average purchaser of the goods in question, recognizing that people normally retain general, rather than specific, impressions of trademarks. *Chemtron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979). In keeping with the decision in the duPont case, *supra*, although the marks are compared for similarities in pronunciation, appearance and connotation, similarity in any one of these factors may be

a sufficient basis upon which to conclude that confusion would be likely.

Recognizing that there is no necessarily "correct" pronunciation of either of these two marks, we nonetheless conclude that they are likely to be pronounced similarly, i.e., we agree with the Examining Attorney that CLAREMONT and CLERMONT are essentially phonetic equivalents. These marks are similar in appearance and pronunciation, and if they have any connotations, they would appear to be place names or surnames, so their connotations are also similar. Plainly, if these marks were to be used in connection with the same or similar products, confusion within the meaning of Section 2(d) of the Lanham Act would be likely.

We thus turn to the relationship between the goods listed in the registration, interior doors and door facings made of different kinds of board and synthetic or artificial lumber, and the goods identified in the cited application, polyvinyl chloride windows and patio doors. Applicant argues that the goods are used for different purposes; that they are not likely to move in the same channels of trade; and that the customers who buy them are sophisticated.

To the contrary, the record shows that doors, whether interior or exterior, are available from the same suppliers

and that the same people who install interior doors also install exterior doors. Contrary to the argument presented by applicant responsive to the first Office Action, the question is not whether purchasers are likely to confuse applicant's products with those specified in the cited registration, but rather whether the use of similar marks in connection with both is likely to lead to confusion as to the source of the goods. In re Mucky Duck Mustard Co., 6 USPQ2d 1467 (TTAB 1988).

Similarly, the fact that applicant intends to sell more windows under the mark than doors is not persuasive on the issue of likelihood of confusion. The relative proportions of the sales of these two related products have no bearing on whether applicant's mark is unregistrable because confusion with the cited registered mark would be likely.

Applicant's argument that its products are expensive goods which are marketed to specialized installers who are sophisticated, non-impulsive purchasers as regards these goods is not supported by any evidence. As identified without restrictions or limitations in the application and the cited registration, respectively, these products could also be sold in home improvement stores, in which case ordinary consumers would be one class of purchasers. Even

if applicant's assertions with regard to trade channels and the sophistication of purchasers of its products had been established as facts, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily translate into sophistication or knowledge regarding trademarks. Even sophisticated and knowledgeable people are susceptible to source confusion caused by the use of similar marks on related products. In re Decombe, 9 USPQ2d 1812 (TTAB 1988).

In summary, the record demonstrates that prospective purchasers would be likely to conclude that use of similar marks in connection with polyvinyl chloride windows and patio doors, on the one hand, and interior doors and door facings made of construction board, on the other, indicates that a single source is responsible for these products.

We have no doubt regarding this conclusion, but if we did, such doubt would necessarily be resolved in favor of the prior user and registrant, and against the applicant, who, as the second comer, has a duty to select a mark which is not likely to cause confusion with one that is already in use in the same field of commerce. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1998).

DECISION: The refusal to register under Section 2(d) of the Lanham Act is affirmed.