

Hearing:
April 2, 2003

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pyro-Stop, LLC

Serial Nos. 76/061,827 and 76/065,119

Robert H. Cameron and G. Franklin Rothwell of Rothwell Figg
Ernst & Manbeck, P.C. for Pyro-Stop, LLC.

Amos Matthews, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Hanak, Hairston and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Pyro-Stop, LLC seeks registration on the Principal
Register for the marks PYRO-STOP¹ and PYRO-STOP and design,²
as shown below:



¹ Application serial no. 76/061,827 was filed on June 2, 2000 based upon applicant's allegation of use in commerce at least as early as March 1991.

² Application serial no. 76/065,119 was filed on June 7, 2000 based upon applicant's allegation of use in commerce at least as early as April 10, 2000.

for services recited as follows:

"installation and maintenance of penetration fire stopping and life safety equipment, namely passive fire protection systems for pipe, duct, conduit, cable tray and bus duct penetrations, grease duct wrap and enclosures, interior and exterior architectural, construction and seismic control expansion joints, critical fire walls and fire doors for use by facility owners, general contractors, and mechanical and electrical contractors," in International Class 37, and

"penetration fire stopping and life safety equipment consultation services provided to facility owners, general contractors, and mechanical and electrical contractors in the field of construction or renovation and restoration of commercial buildings and industrial facilities," in International Class 42.

This case is now before the Board on appeal from the final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). The Trademark Examining Attorney has held that applicant's marks, when used in connection with the identified services, so resemble the mark PYROSTOP registered for "fire-resistant glass" in International Class 19,³ as to be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney have fully briefed these appeals and both appeared before the Board at the oral hearing requested by applicant.

We reverse the refusals to register.

The Trademark Examining Attorney herein argues that "[t]he record consists of evidence which clearly indicates that the goods and services involved are related." (Trademark Examining Attorney's appeal brief, p. 5). He argues that "both [registrant's goods and applicant's services] have as their purpose the prevention of fires." (Trademark Examining Attorney's final refusal of September 19, 2001, p. 2).

By contrast, applicant argues that the Trademark Examining Attorney has not properly considered all the relevant du Pont factors, placing too much weight on the similarity of the marks. For example, applicant contends that registrant's suggestive mark should be accorded a narrower scope of protection than that given it by the Trademark Examining Attorney. Applicant points to the specialized trade channels recited in these applications. Additionally, applicant emphasizes the fact that its relatively expensive services are promoted in a different marketing context, and as such, that they are directed to a sophisticated class of purchasers who would generally not be involved in purchasing registrant's goods.

Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to

³ Registration No. 1,597,443, issued on May 22, 1990, section 8 affidavit accepted and section 15 affidavit acknowledged; renewed.

the factors bearing on the issue of likelihood of confusion.

In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We turn then to a discussion of the respective marks. Applicant's marks are substantially identical to registrant's mark as to sound and connotation, and quite similar as to appearance. While applicant's marks have a hyphen (PYRO-STOP), registrant's mark does not (PYROSTOP). Moreover, one of applicant's involved marks includes a design feature that cannot be ignored in any analysis of the dissimilarities in the appearance of the marks. Nonetheless, this du Pont factor clearly favors the position of the Trademark Examining Attorney. On the other hand, our likelihood of confusion analysis cannot disregard the evidence in the record as to the other relevant du Pont factors. In short, the definite similarity of the marks herein cannot trump all other relevant considerations.

This is particularly true if we should find, as applicant contends, that the cited mark should be accorded a narrow scope of protection. Applicant has submitted copies of fourteen subsisting federal registrations having PYRO-formative marks registered for goods modified with terms like "fire-resistant," "fire-retardant," "fire-extinguishing," "fire-protective," "fire-fighting," "fire-control," "fire-

prevention," "flame-resistant," and the like.⁴ Given the dictionary definition of the term "pyro-,"⁵ we have to conclude that PYRO-STOP (or PYROSTOP) is quite suggestive for something designed to stop fire or flames. Accordingly, while we accord the cited registration the protection warranted under Section 7(c) of the Trademark Act,⁶ this particular du Pont factor weighs in applicant's favor.

We turn next to the relationship of applicant's services to registrant's goods. Screen prints of pages from applicant's website placed into the record by the Trademark Examining Attorney make it clear that applicant is a firestop contractor specializing in firestop joint systems, floor perimeter/slab edge/exterior wall cavity systems and through penetration systems. As a specialist contractor, applicant complies with the detailed codes of the Firestop Contractors International Association (FCIA) as to insulation, penetration seals, and passive fire protection, as well as the life safety

⁴ PYROGUARD (Reg. No. 1,641,712), PYROPAK (Reg. No. 1,581,497), PYRO-PAD (Reg. No. 1,916,426), PYRO-FLEX (Reg. No. 1,491,141), PYROLITE (Reg. No. 1,833,335), PYROKNIT (Reg. No. 1,832,250), PYROCOOL (Reg. No. 1,922,668), PYROSWISS (Reg. No. 1,737,640), PYRO-GUARD (Reg. No. 1,563,376), PYRO-CHEK (Reg. No. 1,143,013), PYRO-CHEM (Reg. Nos. 1,224,720 & 1,248,206), PYROCUSHION (Reg. No. 1,394,867), and PYRO-KINETIC (Reg. No. 1,514,581).

⁵ **PYRO-** Indicates: 1. fire or heat; for example, **pyrotechnic**.
2. Resulting from or by the action of fire or heat
The American Heritage Dictionary of the English Language (1975).

⁶ For example, even weak or highly suggestive marks are entitled to protection against the identical mark for goods used for related purposes. See In re Textron Inc., 180 USPQ 341 (TTAB 1973).

requirements of the National Fire Prevention Association (NFPA) as to construction, protection and occupancy features to minimize danger to life from fires, smoke and fumes. Applicant stressed in its brief and again at the oral hearing that it is in the business of preventing the spread of fire, smoke and heat from one compartment (of large industrial or commercial facilities) to another through services penetrations. By contrast, applicant argues that registrant's goods are first and foremost goods designed for visibility in windows, doors, sidelights and partitions.

By contrast, the Trademark Examining Attorney argues that evidence in the file shows that some of the same companies that produce fire-resistant glass are also involved in consultation over, and installation of, passive fire prevention systems. He also points out that fire-resistant glass used in industrial projects requires "installation" - the first word in applicant's recitation of services in International Class 37.

Clearly, applicant's services and registrant's goods may both be purchased for the same commercial buildings or industrial facilities, and both would be selected with an eye toward fire safety. Both involve the creation of a barrier against heat, smoke, flames and hot gasses, each could be installed within a building's interior walls, and the record

shows that both would be listed in Underwriters Laboratories' (UL) fire testing programs.

Nonetheless, we find that applicant's services are not closely related to registrant's goods.⁷ We begin our analysis by conceding the obvious - whether the setting is new construction or remodeling, registrant's fire-resistant glass and its framing will always require "installation." On the other hand, we find that the Trademark Examining Attorney's statement in his brief⁸ is not an accurate summary of the evidence in the file. The Google hits in the record do not show that companies involved in the installation of passive fire prevention systems (such as those recited by applicant) are also involved in the installation of fire-resistant glass for windows, doors, sidelights, partitions, etc.

⁷ Having found that the marks are not identical in overall commercial impression and that registrant's mark is highly suggestive for the goods in the cited registration, we find this is not a case warranting application of the ostensibly lower standard of whether applicant's services are "related in any viable manner" to registrant's goods [See e.g., In re Whittaker Corporation, 200 USPQ 54 (TTAB 1978)], as argued by the Trademark Examining Attorney herein.

⁸ "The record consists of evidence, which clearly indicates that the goods and services involved are related. This evidence is in the form of: ... advertisements from the Google search engine of companies that produce fire resistant glass, passive fire stopping equipment and provide some type of installation and/or consultation of such items. This evidence is offered to show that fire resistant glass and installation, maintenance and consultation of penetration fire stopping and life safety equipment may emanate from the same source under a single mark... ."

(Trademark Examining Attorney's appeal brief, pp. 5 - 6).

As to the related du Pont factor focusing on the similarity or dissimilarity of established, likely-to-continue trade channels, we note that applicant's recitation of services explicitly states that its services are provided to "facility owners, general contractors, and mechanical and electrical contractors in the field of construction or renovation and restoration of commercial buildings and industrial facilities." In this connection, applicant has provided a declaration of its vice president, Michael J. Bernstein, that applicant's customers - large general contractors and owners of hotels, hospitals, casinos, airports, offices and pharmaceutical plants - generally are not involved in ordering fire-resistant glass products. This claim is uncontroverted by anything else in the record.

As to the conditions under which and buyers to whom sales are made, Mr. Bernstein's declaration also states that "[t]he average price for Pyro-Stop's specialty contractor services is \$25,000.⁰⁰." Based upon this evidence, we conclude that in making a decision to purchase applicant's services, the relevant facility owners and general contractors are all sophisticated, discriminating purchasers exercising heightened care in selecting a firestop contractor. This du Pont factor weighs heavily in favor of reversing the Trademark Examining Attorney, and having this mark published in the Trademark

Official Gazette for possible opposition.⁹

We turn next to the question of the length of time during and conditions under which there has been concurrent use without evidence of actual confusion. Mr. Bernstein's declaration states that "the PYRO-STOP mark has been continuously used in commerce for over ten years for firestopping and life safety contracting services without any known instances of actual confusion with the [cited] mark ..."

In the present case, we find Mr. Bernstein's declaration as to the absence of actual confusion of limited value. Although the absence of actual confusion over a long period of time might be indicative of no likelihood of confusion, it is a meaningful factor only where the record has information about the scope or extent of applicant's and registrant's use of the respective marks, as to applicant's and registrant's respective market shares, and as to whether applicant and registrant actually sell in the same geographic areas. An appreciable and continuous use by applicant of its marks in

⁹ "Further, because of the nature and cost of opposer's services and applicant's goods, both parties' offerings would be carefully scrutinized by prospective purchasers, and any purchasing decisions would be made after careful consideration. The sophistication and discrimination of purchasers also support our conclusion that confusion is not likely to result from the contemporaneous use of the parties' marks on their respective services and goods."

Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460, 1465 (TTAB 1992).

the same markets as those served by registrant under its mark would constitute a showing that there has been an opportunity for incidents of actual confusion to occur. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed Cir. 2000) and Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). Accordingly, we find that the probative value of this alleged absence of actual confusion is negated by the absence of any evidence in the instant record as to the sales of applicant's services and registrant's goods under their respective marks.

In any event, because the test is likelihood of confusion, the absence of any evidence of actual confusion does not equate to no likelihood of confusion. J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); and In re Azteca Restaurant Enterprises Inc., 50 USPQ2d 1209 (TTAB 1999).

We note that this claim does comport with the other relevant du Pont factors supporting applicant's position, and therefore, we accord the apparent absence of actual confusion slight weight in applicant's favor.

In the disagreement between applicant and the Trademark Examining Attorney as to whether Autac Incorporated v. Walco Systems, Inc., 195 USPQ 11 (TTAB 1977) supports a finding of an absence of likelihood of confusion herein, or can be distinguished from the present case, we agree with applicant that Autac supports reversal of the Trademark Examining Attorney's position. The evidence of record, and particularly the declaration of Mr. Bernstein, demonstrates that these goods would not be encountered in the same marketing context, sophisticated, technical persons will be making the purchasing decision, and there has apparently been a decade of contemporaneous usage without actual confusion.¹⁰

¹⁰ "In this regard, we note that petitioner's "AUTAC" retractile cords and respondent's "AUTAC" thermocouple automatic temperature regulators for brushless wire preheaters are noncompetitive; differ completely in utility, price and sophistication; have nothing in common with respect to their essential characteristics or sales appeal; and are not used together or in any kind of a complementary fashion. Additionally, we cannot overlook the fact that the responsibility for deciding to purchase the goods here involved, especially those of the respondent, rests with technical personnel, not with the purchasing agent or purchasing department that ultimately places the order therefor; that the parties made substantial, contemporaneous use of the mark "AUTAC" in connection with their respective products for a significant number of years without ever learning or hearing of one another; and that while it is true that likelihood of confusion has been found to exist in a number of other cases where the same or similar marks were used on different kinds of electronic equipment... nevertheless each case must still be determined on its own facts as established by the testimony and other evidence of record [citations omitted]"

Autac Incorporated v. Walco Systems, Inc., supra at 16.

In conclusion, while applicant's mark is nearly identical to registrant's mark, and that weights heavily in favor of a finding of likelihood of confusion, we also find that the remainder of the relevant du Pont factors favor applicant's position herein - that registrant's mark is highly suggestive, that applicant's services are not actually that closely related to registrant's goods, that applicant's expensive services are targeted to sophisticated purchasers who generally would not be making decisions on purchasing registrant's goods, that the overall marketing contexts are widely different, and that there has apparently been more than ten years of concurrent usage without applicant being aware of a single case of actual confusion. Hence, we find that there is not a likelihood of confusion herein.

Decision: The refusal to register applicant's mark under Section 2(d) of the Act is hereby reversed.