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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lafarge Road Marking, Inc.

Serial No. 76359028

Kenneth A. Clark of Rankin, Hill, Porter & Clark LLP for
Lafarge Road Marking, Inc.

Brian D. Brown, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Walters and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Lafarge Road Marking, Inc. (a Delaware corporation)
filed an application on January 15, 2002, to register on
the Principal Register the mark SAHARA SAND for goods
amended to read as follows: "drying agent used in the
manufacture of road and traffic marking paint, and during
the formation of markings on roadways" in International
Class 1. The application is based on applicant's assertion

of its bona fide intention to use the mark in commerce on the identified goods.

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 applied to its identified goods, so resembles the registered mark SAHARA for "masonry waterproofing coating" in International Class 1,¹ as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed, but applicant did not request an oral hearing.

We reverse the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

Turning first to the involved goods, the Examining Attorney contends that the goods are related, and as evidence thereof he submitted (i) printouts from a few web sites (including that of the cited registrant) showing that companies offer both traffic/zone marking paint and masonry

¹ Registration No. 2,311,751 issued January 25, 2000.

waterproofing coatings (some of these companies offer these products under the same mark, while others offer them under different marks);² and (ii) printouts of two third-party registrations showing that entities offer both traffic paint and masonry coatings under a single mark.³

The problem with the Examining Attorney's position is that applicant's involved goods in this application are not traffic marking paint, but rather are a drying agent used in the manufacture of road and traffic marking paint, or used separately during the formation of traffic markings on roads. There is no evidence of record that the same entity offers masonry waterproofing coatings and drying agents which are used in or in conjunction with traffic marking paint.

Moreover, it is clear from applicant's identification of goods that applicant offers a specialized product sold to sophisticated purchasers. That is, the customers for applicant's product would necessarily be governmental agencies, construction contractors and the like. Based on

² See Davis Paint -- "SAHARA Masonry WaterProofer" and "DAVIS Latex Traffic & Zone Marking Paint" (registrant's web site); Bennette Paint -- "Traffic Paint" and "Masonry Coating"; Coronado Paint -- "Masonry Surface Conditioner" and "Traffic Paint"; and Century Labs -- "Water Based Sealer" and "Traffic Paint."

³ Registration No. 2273781 for, inter alia, "traffic paint" and "masonry coatings for chemical resistance and waterproofing"; and Registration No. 0613418 for, inter alia, "traffic paint" and "foundation coatings."

the identification of goods in the cited registration, it appears that the only overlap in the customers for the parties' goods, if there is any overlap at all, would be professionals, not the general public.⁴ Such purchasers are sophisticated, knowledgeable purchasers, who are not likely to assume that a paint drying agent and a masonry waterproofing coating come from the same source simply because they are sold under similar marks.

Simply put, we cannot conclude from the evidentiary record furnished by the Examining Attorney that drying agents used in the manufacture of traffic marking paint or used during the formation of markings on roadways, and masonry waterproofing coating, emanate from a single source, such that the sophisticated consumers who are the common purchasers of such goods would assume a common source.

As a result, even though the respective marks are very similar, we cannot conclude that the contemporaneous use of the mark SAHARA by registrant for masonry waterproofing

⁴ Applicant originally argued that registrant's goods would be sold to purchasers who "buy paint off the shelf in stores where the products are available to the general public." (Applicant's response filed September 9, 2002, p. 4.) In its brief on appeal (p. 4), however, applicant changed its argument (without submitting any evidence in support thereof), and asserted that registrant's goods are "marketed and sold to architectural building contractors and persons who maintain such masonry structures."

coatings and applicant's SAHARA SAND mark for its drying agent used directly in or in connection with traffic marking paint is likely to cause confusion. See *In re Digirad Corp.*, 45 USPQ2d 1841, 1844 (TTAB 1998); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

In reaching this conclusion, we note that the marks SAHARA and SAHARA SAND are both suggestive in relation to the respective goods -- a masonry waterproofing coating and a drying agent used in or on traffic marking paint. The word "SAHARA" suggests something dry and arid.⁵

Decision: The refusal to register under Section 2(d) is reversed.

⁵ We take judicial notice of The American Heritage Dictionary (1976) definition of "Sahara" as "A vast arid area of northern Africa, occupying over 3,000,000 square miles and extending from the Atlantic coast to the Nile Valley and from the Atlas Mountains south to the Sudan. ... Usage: *Sahara*, or *the Sahara* is the preferred form, especially in formal and scholarly usage. *Sahara Desert*, though widely used, involves redundancy, since desert is implicit in Sahara." See TBMP §704.12(a) (2d ed. June 2003).