

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
July 31, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Carlisle Intangible Company

Serial No. 76541147

Gregory J. Lunn and Sarah Otte Graber of Wood, Herron & Evans, L.L.P. for Carlisle Intangible Company.

Tasneem Hussain, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Grendel, Zervas and Kuhlke, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark depicted below

The logo for EcoStar features the word "EcoStar" in a stylized, outlined font. The letter "O" is replaced by a sunburst or starburst graphic with multiple points radiating from a central circle.

for goods identified in the application, as amended, as "roofing products, namely, sealing tape and self adhering membrane sheeting, all of the above for use on steep slope roofing," in Class 17, and "roofing products, namely, non-metal roofing shingles and walking pads, all of the above for use on steep slope roofing," in Class 19.¹

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that the mark, as applied to the goods identified in the application, so resembles the mark ECOSTAR, previously registered on the Principal Register (in standard character form) for goods identified in the registration as "coatings for use on the exteriors of buildings, roofs, pond and water ducts; equipment shell coatings; coatings for traffic, airport and runway striping; bridges coatings; and paints for interior and exterior use," in Class 2; "rubber-based sealants and caulk grade sealants for general use," in Class 17, and "asphalt

¹ Serial No. 76541147, filed on August 18, 2003. The application is based on use in commerce, Trademark Act Section 1(a), 15 U.S.C. §1051(a), and September 1998 is alleged in the application to be the date of first use of the mark anywhere and the date of first use of the mark in commerce.

coatings and bitumen-based sealants for asphalt, driveways, and roofing," in Class 19.²

The appeal is fully briefed. After careful consideration of all of the evidence of record and the arguments of counsel, we affirm the refusal to register.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The first *du Pont* factor requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc.*, *supra*. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a

² Registration No. 2027391, issued on December 31, 1996. Affidavits under Sections 8 and 15 accepted and acknowledged.

side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applying these principles in the present case, we find as follows. First, we find that the dominant feature in the commercial impression created by applicant's mark is the literal portion, i.e., the word ECOSTAR. Applicant's argument to the contrary, i.e., that the dominant feature of the mark is the star design element, is unpersuasive. It is the word ECOSTAR, not the design element, that will be recognized and used by purchasers as the primary means

of source identification. Indeed, the star design element would be seen simply as a visual depiction or reinforcement of the STAR element of the term ECOSTAR. We have considered applicant's mark in its entirety, as we must, but for the reasons discussed above, we find that the term ECOSTAR is the dominant feature in the commercial impression created by applicant's mark. That feature therefore is to be accorded more weight in our comparison of the marks under the first *du Pont* factor. See *In re Chatam International Inc.*, *supra*; *In re National Data Corp.*, *supra*.

We turn now to a comparison of the marks themselves. In terms of appearance, we find that the marks are identical to the extent that both marks include the term ECOSTAR. The marks are dissimilar to the extent that applicant's mark includes the star design element while the cited registered mark does not. On balance, and when we accord to the ECOSTAR literal element of applicant's mark the greater weight it should be given due to its dominance in the commercial impression of the mark, we find that the marks are similar rather than dissimilar in terms of appearance.

In terms of sound, we find that applicant's mark and the cited registered mark are identical.

In terms of connotation, we find that applicant's mark and the cited registered mark are identical. To the extent that the term ECOSTAR has any specific connotation as applied to applicant's and registrant's goods, we find that that connotation would be the same in both cases.

In terms of overall commercial impression, we find that applicant's mark and the cited registered mark are highly similar due to the fact that purchasers are likely to recognize and use the term ECOSTAR in each mark as the primary source indicator. Applicant's addition of a star design element to its mark, which would be viewed as merely illustrating or reinforcing the word STAR in the term ECOSTAR, does not suffice to render its mark dissimilar to registrant's mark in terms of overall commercial impression.

In summary, when we compare applicant's and registrant's marks in their entireties in terms of appearance, sound, connotation and overall commercial impression, we find that the marks are highly similar. The first *du Pont* factor clearly weighs in favor of a finding of likelihood of confusion.

The second *du Pont* factor requires us to determine the similarity or dissimilarity of the goods as identified in the application and in the cited registration. It is

settled that it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). It is sufficient, instead, that the goods be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Applying these principles in the present case, we find as follows. Obviously, the products identified in applicant's application and the products identified in the cited registration are similar and related to the extent that they all are used in the roofing industry and as

elements of roofing systems. However, the record also shows that there is a more direct source relationship between applicant's and registrant's types of goods. The Trademark Examining Attorney has submitted evidence of ten use-based third-party registrations in which the identifications of goods include both one or more of the products identified in applicant's application and one or more of the products identified in the cited registration.³ Although such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). We find that this evidence supports a finding that the respective goods are related in such a manner that confusion as to source, sponsorship or affiliation is likely to result from contemporaneous use of the respective ECOSTAR marks involved herein.

³ These are Reg. Nos. 1548315, 2150355, 2010138, 1917594, 2782310, 2390161, 2392668, 1550546, 1332181, and 1375335.

Applicant's assertions and arguments to the contrary are unsupported in the record and are unpersuasive in any event. First, applicant's reliance on *In re Trackmobile Inc.*, 15 USPQ2d 1152 (TTAB 1990), for the proposition that we should look outside the respective identifications of goods in the application and the registration, to applicant's evidence showing the nature of the goods actually being marketed by applicant and registrant, is misplaced. *In re Trackmobile* is apposite only where the nature of the goods cannot be ascertained from the face of the identification of goods. In this case, we have no trouble ascertaining the nature of the goods as identified in the application and in the registration. Our analysis of the relatedness of the respective goods therefore can and must be made on the basis of how the goods are identified in the application and in the registration, respectively.

Applicant's identification of goods, as amended, specifically limits applicant's roofing products to those which are used in connection with steep slope roofs. Applicant contends that steep slope roofs have special installation and maintenance requirements and that they generally are used in connection with residential buildings. Applicant further contends that registrant's

roofing coatings and products are not suitable for use in connection with steep slope roofs due to their low viscosity, and that they instead are for use on flat roofs generally found on commercial and industrial buildings.

We find that the record does not support applicant's contentions on this point. There is nothing in the record beyond counsel's unsupported assertion which establishes that the roofing products identified in the cited registration are not or could not be used in connection with steep slope roofs. Indeed, evidence submitted by applicant itself (the approved products listing for the "cool roof" incentive program sponsored by the Sacramento Municipal Utility District (SMUD)) shows that at least six companies on the approved product list market particular products which are suitable for both low slope roofs and steep slope roofs.⁴ The list also shows that one of registrant's products is on the approved products list, and that this product is for use only on low slope roofs, not steep slope roofs. However, and contrary to applicant's argument, it does not follow that this particular low slope roof product is the only product that registrant sells. It

⁴ These companies are Acrymax Technologies, Acry-Tech Coatings, Inc., Advanced Coating Systems, Inc. (11 different products), ALCO/NVC, Inc., ALSO Products Company, Inc., and Flex Coatings Inc.

may be the only product of registrant's that is approved for SMUD's "cool roof" incentive program, but that does not mean that registrant (like at least six other companies) does not also market products suitable for use on steep slope roofs. Certainly, registrant's identification of goods is not limited in any such manner.⁵

In any event, even if the evidence showed that registrant's roofing products and applicant's roofing products are not competitive or would not be used together on a particular roofing project, such evidence would not establish that both types of products necessarily would not come from a single source. To the extent that applicant is correct in contending that the roofing industry is divided into two market segments, i.e., steep slope residential buildings, and flat or low slope commercial and industrial buildings, nothing in the record establishes that purchasers would assume that a single company does not or

⁵ Applicant notes that guidelines of the SMUD "cool roof" incentive program state that only commercial and industrial buildings are eligible for the program's incentive benefits, and further notes that registrant's products are on the approved products list for the program. Contrary to applicant's contention, however, it does not follow from these facts that registrant only manufactures products for use on commercial and industrial buildings. The limitation to commercial and industrial buildings is an eligibility requirement of the SMUD program, not a limitation of registrant's goods to commercial and industrial buildings. Again, no such limitation is present in registrant's identification of goods.

could not produce roofing products for use in each of the market segments. Again, applicant's own evidence shows that there are at least six other companies doing just that.

For these reasons, we find that applicant's goods, as identified in the application, and registrant's goods, as identified in the registration, are similar and related. The second *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The third *du Pont* factor requires us to determine the similarity or dissimilarity of the trade channels in which the identified goods are marketed. We note first that neither applicant's identification of goods nor the identification of goods in the cited registration include any restrictions or limitations as to trade channels. We therefore must assume that the respective goods are marketed in all normal trade channels for such goods and to all normal classes of purchasers of such goods. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). To the extent that both applicant's goods and registrant's goods are roofing products, the normal trade channels for the respective goods would be the same or overlapping, as would the normal classes of purchasers.

Applicant contends that steep slope roofing products, which (according to applicant) are used primarily for residential buildings, and flat or low slope roofing products, which (according to applicant) are used primarily for commercial and industrial buildings, constitute different market segments within the roofing industry. There is no evidence in the record to support this contention. Moreover, even if we assume that this market segmentation exists within the roofing industry, there is nothing in the record which establishes that roofing products companies like applicant and registrant cannot or do not manufacture and market products for use in both segments of the industry. As noted above, applicant's own evidence shows that at least six companies market products for use with both steep slope roofs and flat or low slope roofs. Likewise, nothing in the record establishes that registrant's roofing products could not be used in connection with steep slope residential buildings as well as with flat or low slope commercial and industrial buildings.

Based on this record, we find that applicant's roofing products and registrant's roofing products move in the same or overlapping trade channels and to the same or overlapping classes of purchasers. The third *du Pont*

factor weighs in favor of a finding of likelihood of confusion.

The fourth *du Pont* factor requires us to consider the conditions under which the respective products are purchased, including the sophistication of purchasers and the care with which the goods are purchased. Applicant argues that the purchasers of the respective products are roofing contractors who are knowledgeable and sophisticated and who would know with whom they are dealing when purchasing the products. However, even if these contractors are knowledgeable with respect to roofing products, they are not necessarily immune to source confusion when faced with roofing products sold under the highly similar marks involved in this case. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). Moreover, roofing contractors are not the only persons to whom these goods are marketed; applicant's own website shows that applicant markets its goods directly to homeowners. On this record, we find that the fourth *du Pont* factor may weigh in applicant's favor, but that it does so only slightly.

Applicant argues, under the seventh and eighth *du Pont* factors, that applicant is unaware of any instances of actual confusion as to the source of applicant's and registrant's respective goods, despite seven years of

contemporaneous use. However, the absence of actual confusion is entitled to limited probative value in the likelihood of confusion analysis in an ex parte case. See *In re Majestic Distilling Co.*, *supra*. Even if applicant knows of no instances of actual confusion, we do not know whether registrant may have encountered such instances. We do not know the extent of applicant's and registrant's sales and advertising of their respective products, nor whether the respective goods are even marketed in the same geographic areas. On this record, we cannot conclude that there has been any significant opportunity for actual confusion to have occurred, and we therefore cannot conclude that the asserted absence of actual confusion is factually surprising or legally significant in this case. We find that if the seventh and eighth *du Pont* factors relating to actual confusion weigh in applicant's favor, they do so only slightly.

Balancing all of the evidence of record as it pertains to the *du Pont* factors, we conclude that a likelihood of confusion exists. We have considered all of applicant's arguments to the contrary, but we find them to be unpersuasive. To the extent that any doubts might exist as to the correctness of our conclusion on the likelihood of confusion issue, we resolve such doubts against applicant.

Ser. No. 76541147

See In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, *supra*.

Decision: The refusal to register is affirmed.