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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kiltie Corporation

Serial No. 77091957

Gerald E. Helget of Briggs and Morgan, P.A. for Kiltie Corporation.

Mary E. Crawford, Trademark Examining Attorney, Law Office 102 (Karen M. Strzyz, Managing Attorney).

Before Quinn, Drost, and Wellington, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On January 26, 2007, applicant, Kiltie Corporation, applied to register the mark VERANDA, in standard character form, on the Principal Register for "concrete blocks for constructing mortarless freestanding and retaining walls" in Class 19. Serial No. 77091957. The application is based on a bona fide intention to use the mark in commerce.

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act

(15 U.S.C. § 1052(d)) because of a registration for the mark VERANDA, in standard character form, for "non-metal building materials for use in building decks; non-metal fencing; non-metal lattices" in Class 19.¹ When the refusal was made final, this appeal followed.

Evidentiary Issues

Before we address the merits of this appeal, we must discuss several evidentiary issues. The examining attorney has submitted printouts of "applications and registrations" to "show that the goods, while not identical, are indeed related." Final Office Action at 4. Applicant has objected to these registrations and applications to the extent that the examining attorney did not include search strategy results. Applicant also points to the diversity of goods and services in some of the applications and registrations and questions their persuasiveness.

We have more fundamental problems with many of the references. First, we count 24 applications and registrations that were attached to the first and final Office actions. Of these, five are duplicates and therefore, we will not consider them separately. Thirteen printouts are for registrations or applications filed under Section 44 of the Trademark Act without any indication that

¹ Registration No. 3178672 issued November 26, 2006.

the marks have been used. To the extent that some are applications, they are simply not probative on the issue of whether the goods are related. *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002) ("While applicant also submitted a copy of a third-party application ..., such has no probative value other than as evidence that the application was filed"). Furthermore, registrations (or even applications if we did consider them) that are based on foreign filings with no indication of use are entitled to little, if any, weight. *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n. 6 (TTAB 1988):

In the instant case, however, 11 of the 15 third-party applications and registrations which cover both restaurant services and mustard were filed under the provisions of Section 44 of the Act, that is, they are based on foreign registration rather than on use in commerce, and most of their owners appear to have simply copied large parts of the title (including, in some cases, even the punctuation used therein) of International Class 30. Such registrations and applications are not even necessarily evidence of a serious intent to use the marks shown therein in the United States on all of the listed goods and services, and they have very little, if any, persuasive value on the point for which they were offered.

In addition, we note that Registration Nos. 2908614 and 3125908 are for different marks and their owners are identified as different corporations.² However, both

² The '614 registration has now apparently been assigned to the same corporation as the '908 registration, RMF Holdings, LLC. See Reel/Frame No. 3072/0543.

registrations have curiously similar identifications of goods, i.e., "Aquarium gravel, aquarium sand, aviaries not of metal..." We will treat these registrations as registrations from a common source and we will not separately consider the '908 registration. Therefore, we are left with five relevant registrations to support the examining attorney's position.

In its reply brief, after the examining attorney's last opportunity to respond, applicant also requests that we take into consideration TESS search results that show the total number of results for the term "fence" and for the term "concrete" and "block." Applicant argues that the examining attorney did not provide "any record of how the search was conducted, the search term used, the number of documents responsive to the search query, or how many of the responsive documents were actually produced." Reply Brief at 2.

When an examining attorney waits until the examining attorney's brief to object to applicant's earlier submission of a list of registrations, we have held that any objection to this evidence has been waived:

Although the Examining Attorney, in her brief, has objected to such evidence "as being unsupported" in that a mere listing of third-party registrations "is not credible evidence of the existence" thereof and that copies of such registrations or their electronic

equivalents, in the form of printouts from the electronic records of the United States Patent and Trademark Office, need to be submitted in order to make the registrations properly of record," the objection is considered to have been waived since it was not interposed in response to applicant's reliance on such listing in its response to the initial Office Action.

In re Broyhill Furniture Industries Inc., 60 USPQ2d 1511, 1513 n.3 (TTAB 2001). Similarly here, where, if applicant objected earlier, the examining attorney could have provided the search strategy or an explanation of why one was not required, we deem applicant to have waived its objection by waiting until the reply brief to raise this question.

We add that applicant's reliance on TMEP § 701.01(a), "Evidence from Research Database," is misplaced inasmuch as the evidence that the examining attorney submitted was not an article from a research database as the section discusses, e.g., LEXIS®, but rather third-party registrations from the USPTO's own search system. TMEP § 710.03 (5th ed. rev. September 2007) sets out how to make third-party registrations of record:

To make registrations of record, soft copies of the registrations or the complete electronic equivalent (*i.e.*, printouts or electronic copies of the registrations taken from the electronic search records of the USPTO) must be submitted.

See also TMEP § 1207.01(d)(iii).

The examining attorney's search results did comply with this provision.

Regarding applicant's other evidence, in its response to the first Office action (p. 4), it simply included a statement that "VERANDA is a weak mark, as shown by the number of registrations in the USPTO TESS database. According to a TESS search conducted on April 19, 2007, there are 134 registrations for the mark." In the Final Office Action at 3, the examining attorney pointed out that "applicant argues that the marks are 'weak.' However, the applicant has not submitted any evidence to substantiate this claim." When applicant referred to these registrations in its appeal brief, the examining attorney objected (Brief at unnumbered p. 5) and pointed out that applicant did not seek reconsideration in order to submit any evidence." We agree with the examining attorney that the copies of the registrations should have been submitted earlier. 37 CFR § 2.142(d). We do not take judicial notice of third-party registrations. *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998) ("The Board does not take judicial notice of third-party registrations, and the mere listing of them is insufficient to make them of record"). The fact that that other registrations (perhaps as many as 134) contain the word "Veranda" for

various unidentified goods and services, hardly establishes that it is a weak mark for the goods at issue in this case. *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366 (TTAB 2007) (“[E]ven if there were evidence that MVP is used for non-related goods or services, this would hardly establish by itself that it is weak for casino services”).

Likelihood of Confusion Issue

Next, we move on to the main issue here which is whether there is a likelihood of confusion. In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that “[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin our analysis by looking at the similarities and dissimilarities of the marks in the application and

registration. In this case, the marks are identical. Both are for the word VERANDA in standard character form.

Therefore, there are no differences in the marks. This factor supports a conclusion that there is a likelihood of confusion. Indeed, the Federal Circuit has held that "[w]ithout a doubt the word portion of the two marks are identical, have the same connotation, and give the same commercial impression. The identity of the words, connotation, and commercial impression weighs heavily against the applicant." *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993).

Next, we look at the goods to see if they are related. Applicant's goods are concrete blocks for constructing mortarless freestanding and retaining walls. Registrant's goods are non-metal building materials for use in building decks; non-metal fencing; non-metal lattices. It is obvious that the goods are not identical. Applicant argues that its "concrete blocks are not used for building decks. Similarly, 'fencing' is not the same as 'retaining walls.' Finally, 'lattices' are not the same as retaining walls." Brief at 5. Applicant also points out that:

Applicant's products are specifically intended for the structural application of constructing retaining walls.

The Veranda Web site also states:

Can Veranda decking be used as planters or edging? Veranda decking is not recommended for ground contact applications. It is to be used as a deck surface only.

In contrast, Applicant's concrete blocks are specifically intended to be used in constructing retaining walls, that is, to hold soil within the retaining wall (a ground contact application).

Thus, the products of the registrant and the applicant are clearly non-competitive, and may likely be non-related.

Brief at 5.

First, applicant is apparently reading limitations into registrant's goods based on how registrant describes the goods on its website. An applicant's or registrant's identified goods are not limited by how they are actually used. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the

basis of the respective descriptions of goods").

Therefore, registrant's building materials for use in building decks are not limited to building materials that are not used in contact with the ground or to expensive materials.

Second, goods or services can be related even if they are not identical, competitive, or combinable. "[G]oods that are neither used together nor related to one another in kind may still 'be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.'" *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (citing *Recot, Inc. v. Becton*, 54 USPQ2d at 1898). See also *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1898 (TTAB 1989) ("In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources").

Here, the examining attorney has submitted trademark registrations to help show that the goods of applicant and the registrant are related. Even after we discard the registrations that have little or no probative value, there are five registrations that provide at least some evidence that the goods are related.

No. 2280617 for parquet wood flooring, floor panels, non-metal floor tiles; non-metal building panels, namely, floor, roofing, ceilings, wall, door and fence panels; non-metal building materials, namely, concrete blocks,³ concrete slabs, bricks, mortars

No. 2908614 for, inter alia, "concrete blocks" and "non-metal lattices," "non-metal fencing" and "stone for building"

No. 3013629 for building materials, namely wall, hardwood, decking, wood, ceramic enamel tiles, ceramic tiles, concrete, concrete blocks, floor panels, glass tiles, granite, hardboard, marble, non-metal roof coverings, non-metal ceiling panels, non-metal curtain walls, non-metal door panels, non-metal floor tiles, non-metal floors, and nonmetal tiles

No. 2791615 for, inter alia, "concrete blocks" and "erosion control fencing and mats," "non-metal pre-fabricated building sets" and "non-metal floor construction materials, namely, tiles of clay, glass, gypsum, ceramic or earthenware for wall, floor or ceiling, paving tiles, roofing tiles, wood tile flooring and flooring underlayments, frameworks, sheathing boards, cement and concrete slabs, wood and concrete beams"

No. 2562369 for on-metal ceiling panels, non-metal door panels, non-metal roofing panels, non-metal wall

³ We note that the term "concrete blocks" would include "concrete blocks for constructing mortarless freestanding and retaining walls."

panels, concrete blocks, and prefabricated non-metal buildings

"Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source." *Mucky Duck*, 6 USPQ2d at 1470 n.6. We agree that these registrations suggest that applicant's and registrant's goods may originate from a single source. Even if we accept applicant's argument that many sources of fencing, lattices, and building materials for decks are not the source of concrete blocks, it does not mean that the goods are not related or that the registrations of record do not suggest a relationship. *Id.* at 1467 n.3 (Four use-based registrations for mustard and restaurant services). *In re Association of the United States Army*, 85 USPQ2d 1264 (TTAB 2007) ("We find, first, that applicant's 'association services' are related to the Class 35 and Class 42 services recited in the '479 and '969 registrations. The Trademark Examining Attorney has made of record six use-based third-party registrations...").

We also have no basis to hold that the channels of trade and the purchasers of these products would not be similar. Applicant's and registrant's goods are likely to be purchased by contractors or do-it-yourself homeowners who are adding or replacing a deck and also landscaping the area around the deck. Their channels of trade would also be similar to the extent that they would be sold where building and construction materials and supplies would be sold.

Applicant also argues (Reply Brief at 5) that "in the present matter technical or product sophistication typically of purchasers of the relevant goods would render them more likely to appreciate the difference between Applicant's structural goods, and Registrant's non-structural goods - leading to an opportunity and basis to distinguish the marks." The fact that purchasers would appreciate the difference between the products is not necessarily determinative. Confusion is frequently found even when the goods are not the same. The question would be whether even sophisticated purchasers would assume that these products sold under identical marks would come from the same source. *In re Hester Industries, Inc.*, 231 USPQ 881, 883 (TTAB 1986) ("While we do not doubt that these institutional purchasing agents are for the most part

sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products"). See also *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999) ("[E]ven careful purchasers are not immune from source confusion"). In this case, even sophisticated purchasers are likely to assume that the sources of these goods sold under the same mark are related or associated in some way.

Of course, to the extent that we have any doubt we must resolve this doubt in favor of the prior registrant. *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1948 (Fed. Cir. 2004) and *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

When we consider the fact that the marks are identical and the goods are related, we conclude that there is a likelihood of confusion here.

Decision: The examining attorney's refusal to register applicant's VERANDA mark under Section 2(d) is affirmed.