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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Marvin Lumber and Cedar Company

Serial No. 78118743

Eric D. Paulsrud of Leonard, Street and Deinard for Marvin Lumber and Cedar Company.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

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

Opinion by Drost, Administrative Trademark Judge:

On April 1, 2002, Marvin Lumber and Cedar Company (applicant) applied to register the mark INFINITY, in typed or standard character form, on the Principal Register for "non-metal exterior doors; non-metal exterior patio doors; non-metal exterior sliding doors" in Class 19. The application (Serial No. 78118743) is based on applicant's allegation of a bona fide intention to use the mark in commerce. Applicant claims ownership of Registration No. 1,552,89 for the mark INFINITY in typed or standard

character form for "windows and plastic window frames" in Class 19.

The examining attorney[1] 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 INFINITY ENCORE BY AMERICAN in the form shown below for "wooden residential interior doors" in Class 19.

The registration (No. 2,498,383) issued October 16, 2001, and the registrant is identified as American Building Supply, Inc. (ABS).

The examining attorney argues that "the marks contain the same dominant wording, 'INFINITY,' and are thus similar sounding… Further, the word 'INFINITY' is the prominent visual portion of the registered mark." Brief at unnumbered p. 4. In addition, the examining attorney maintains that "applicant's exterior doors and the registrant's interior doors are so highly related… that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief

[1] The current examining attorney was not the original examining attorney in this case.

that the goods come from a common source." Brief at unnumbered p. 7.

In response, applicant argues that "Registrant's INFINITY ENCORE BY AMERICAN and design trademark registration is part of a unitary phrase and does not create a separable impression of 'INFINITY' alone." Brief at 11. Regarding the goods, applicant argues that while "both are in the same broad category of 'doors,' they are in two distinct markets. Consumers looking for an interior door will not be interested in exterior doors and vice versa." Brief at 13.

Inasmuch as the question here is whether applicant's mark as used on its goods is confusingly similar to the mark in the cited registration, we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); 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).

"The first DuPont factor requires examination of 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting du Pont, 177 USPQ at 567). Applicant's mark is for the single word INFINITY without any claimed stylization or design. Registrant's mark is for the words INFINITY ENCORE BY AMERICAN (stylized). The stylization of registrant's mark emphasizes the "Infinity" portion of its mark inasmuch as the "By American" part is in much smaller type and it is harder to notice.

The word "Infinity" is in the largest type. While "Encore" is in darker print, it is displayed in smaller type. Thus, the word "Infinity" is a prominent part of the registered mark. Inasmuch as "Infinity" and "Encore" are displayed in different type fonts (script v. block), different shading (empty v. filled), and different color (light v. dark), prospective purchasers would not be inclined to view the

words as unitary. Instead, they would see the mark as three terms, "Infinity" and "Encore" and "By American." The word "American" would appear to refer to a trade name, "Infinity" looks like a mark for a line of products, and "Encore" would appear to be a specific model.

We must also add that applicant's mark is displayed in a typed or standard form drawing. As a result, we must consider that applicant's mark can be displayed in script that is identical to registrant's. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) ("[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a *difference* cannot legally be asserted by that party. [Applicant] asserts rights in [its mark] regardless of type styles, proportions, or other possible variations. Thus, apart from the background design, the displays must be considered the same"). See also Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) ("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce"); Phillips Petroleum Co. v. C. J. Webb, Inc., 442 F.2d 1376, 1378, 170 USPQ 35, 36 (CCPA 1971) ("The drawing in the

[opposed] application shows the mark typed in capital letters, and … this means that [the] application is not limited to the mark depicted in any special form").

When we compare applicant's and registrant's marks in their entireties, it is clear that they share the identical word "Infinity." It is the only element in applicant's mark and it is a prominent part of registrant's mark. We must also assume that the word "INFINITY" is displayed in the identical script. The words "By American" in registrant's mark would not be as significant and to the extent that they are noticed in registrant's mark, their absence in applicant's mark would likely be attributed to registrant choosing not to use its corporate or trade name on a particular item. The similarities in sound, appearance, meaning, and commercial impression between applicant's and registrant's marks outweigh the difference created by the absence of the words "Encore" and "by American." See In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Federal Circuit held that, despite the addition of the words "The" and "Cafe" and a diamond-shaped design to registrant's DELTA mark, there was a likelihood of confusion).

Another key question in any likelihood of confusion analysis is the relatedness of applicant's and registrant's

goods. Applicant's goods are non-metal exterior doors, patio doors, and sliding doors. Registrant's goods are wooden residential interior doors. Because applicant's doors are "non-metal," they would include wooden doors. Also, applicant's identification of goods is broad enough to encompass residential doors. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981)("[W]here the goods in a cited registration are broadly described and there are no limitations in the identification of goods as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers"). Therefore, applicant's and registrant's goods would both include wooden residential doors. The only difference between the goods is that applicant's goods are exterior doors while registrant's goods are interior doors.

Applicant argues (Brief at 15) that:

> Interior and exterior doors are not competitive products. Exterior doors are typically much heavier, larger and substantially more expensive than interior doors. Exterior doors must be built and finished in a manner that they are able to withstand the exterior weather without damage or deterioration of the door. Exterior and interior doors are marketed differently

> and are clearly segregated in the purchasing environment. The cost alone of an exterior door will readily distinguish it for the buyer from an interior door.

The examining attorney has submitted Internet evidence to show that the sources of interior and exterior doors are often the same. See, e.g., www.solid-wood-doors.com ("Harvest Creek Millwork is a manufacturer of solid wood doors, both interior doors and exterior doors, that are available in standard and custom sizes and styles"); www.jeld-wen.com ("As a JELD-WEN customer, you can count on us to provide reliable products and service. We are a comprehensive source for… wood and wood composite interior doors; and wood, steel, wood composite and fiberglass exterior doors"); www.nicksbuilding.com ("Rustic Knotty Alder Doors – Exterior & Interior"); www.trustile.com ("Trustile is proud to offer the following products: Interior & Exterior paint-grade MDF doors; Interior & Exterior stain-grade wood doors in 12 Wood species"); www.masonite.com ("Masonite is constantly expanding its diverse line of interior and exterior doors"); and www.door.cc (Homestead exterior oak doors and in-stock interior doors).

The record convinces us that the same entities are the source of both interior and exterior wooden doors, and that

these goods are closely related. In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991) (For goods to be related, "it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could 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 producer or that there is an association between the producers of each parties' goods or services").

Regarding the purchasers and channels of trade for these goods, we find that they are also likely to be similar, if not overlapping. Individuals interested in improving their homes and contractors are likely to purchase both interior and exterior doors. They are sold by the same retailers. See www.lowe's.com, www.nicksbuilidng.com, and www.door.cc. The evidence suggests that the prices of doors very considerably (See www.hometime.com - "It's not unusual to find exterior door units priced over $1000. And a solid interior door can run half that"). While the purchase of a door is unlikely to be an impulse purchase, we cannot hold that these purchasers are necessarily sophisticated. Indeed, the evidence suggests that doors are purchased by ordinary

purchasers. See www.hometime.com ("At the risk of stating the obvious, your first consideration will be whether you need Interior Doors or Exterior Doors").

There is one other factor that we need to address in this case and that is applicant's reference to statements made by the registrant. Applicant in its Reply Brief (p.3) argues:

> ABS has filed a separate pending trademark application for the mark INFINITY BY ABS, Serial No. 76/590,716… Applicant's prior registration for INFINITY, Reg. No. 1,552,897, was cited against ABS under Section 2(d) as a basis for refusing that application… ABS again concedes that there is no likelihood of confusion.

Applicant, recognizing the late submission of this material, as an alternative, requests that the case be remanded to the examining attorney. Applicant reports that it "has contacted ABS counsel after Applicant filed it[s] opening brief in this appeal to discuss a possible formal consent agreement between the parties. Although counsel have conversed on this issue, ABS has not further responded to the overture, perhaps waiting to see the outcome of this proceeding." Reply Brief at 4.[2]

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[2] Applicant had previously made of record three abandoned applications owned by the registrant. These applications are only evidence that the application was filed. Glamorene Products Corp. v. Earl Grissmer Co., Inc., 203 USPQ 1090, 1092 n.5 (TTAB 1979) ("The filing of a notice of reliance upon third-party applications is a futile act because copies of those applications or the publication thereof in the Official Gazette is evidence only of the filing of the applications and nothing else").

We begin by pointing out that the statements of registrant that applicant seeks to rely on are directed to applicant's registration for windows and plastic window frames and they are not directed to the issue in this case, i.e., whether there is a likelihood of confusion when applicant's and registrant's marks are used on interior and exterior doors. Secondly, the reply brief is not the appropriate time to submit new evidence in a case. 37 CFR § 2.142(d). We also do not find it appropriate to remand the application to consider the statements of the registrant in an unrelated case. Even if this were an inter partes proceeding where the registrant was a party, such statements would not prove that confusion was not likely.

> While certain statements made by a party in an ex parte proceeding may, under particular circumstances, be considered to be admissions against interest in a subsequent inter partes proceeding, any representations made by petitioner in attempting to overcome a cited reference in order to secure its registration cannot preclude or, if you will, in respondent's terms "estop" petitioner from taking a different position in a proceeding to cancel said registration. To hold otherwise would be to deprive petitioner of its right to proceed under Section 14 to cancel a registration which it believes is damaging to it and to avail itself of FRCP 8(e)(2) which provides for inconsistent and hypothetical proceedings.

Lia Jene Inc. v. Vitabath, Inc., 162 USPQ 469, 470 (TTAB 1969). See also International Wholesalers, Inc. v. Saxons

Sandwich Shoppes, Inc., 170 USPQ 107, 109 (TTAB 1971) ("Turning now to applicant's contention that opposer is estopped from asserting a likelihood of confusion because of statements made in its application out of which its registration issued, it is well settled that any such statements do not give rise to estoppel in subsequent proceedings").

We add that even if the statements in an application were considered, they are entitled to only limited weight in an opposition proceeding involving the party.

> The opinion of an interested party respecting the ultimate conclusion involved in a proceeding would normally appear of no moment in that proceeding. Moreover, it is known at the outset. One may assume, for example, that an opposer believes confusion likely and that a defending applicant does not. That a party earlier indicated a contrary opinion respecting the conclusion in a similar proceeding involving similar marks and goods is a fact, and that fact may be received in evidence as merely illuminative of shade and tone in the total picture confronting the decision maker. To that limited extent, a party's earlier contrary opinion may be considered relevant and competent. Under no circumstances, may a party's opinion, earlier or current, relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record.

Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978) (footnote omitted). See also Specialty Brands, Inc. v. Coffee Beans Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1283 (CCPA 1984).

We also note that these statements were not made in the application that issued as the cited registration but in an unrelated application. Even if statements made by a party in the application process can be used as an admission against the party in a subsequent proceeding, the registrant is not a party to this ex parte proceeding. Therefore, the statements cannot be used as an admission against registrant here. Accord In re Wilson, 57 USPQ2d 1863, 1869 n.13 (TTAB 2001) ("[W]e have found no reported cases in which the 'laches and estoppel' provision of the tenth du Pont factor was applied in the context of an ex parte appeal, nor has applicant cited any such cases… We think that the clear intent of Congress was that section 19 be limited to inter partes proceedings").

Also, we will not remand the case to consider statements made by a non-party registrant regarding whether there is confusion between a different mark of the registrant and a registered mark owned by applicant for different goods. We add, of course, that if "those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted." du Pont, 177 USPQ at 568. See also Bongrain International (American) Corp. v. Delice De France Inc., 811 F.2d 1479, 1 USPQ2d

1775, 1778 (Fed. Cir. 1987) ("We have often said in trademark cases involving agreements reflecting parties' views on the likelihood of confusion in the marketplace, that they are in a much better position to know the real life situation than bureaucrats or judges and therefore such agreements may, depending on the circumstances, carry great weight … Here, the board appears effectively to have ignored the views and conduct of the parties"). We do not have a situation in this case where registrant has consented to the registration of applicant's mark. Indeed, registrant has not responded favorably to applicant's request for a consent agreement.

We, therefore, will not consider applicant's evidence submitted with its reply brief nor do we find it appropriate to remand for the examining attorney to review this evidence. When we consider that the marks in this case are similar and the goods are closely related as well as the other evidence of record here, we determine that there is a likelihood of confusion.

Decision: The examining attorney's refusal to register applicant's mark on the ground that it is likely to cause confusion with the cited registered mark used in connection with the identified goods under Section 2(d) of the Trademark Act is affirmed.