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February 28, 2007

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July 18, 2007
Bucher

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Masonite International Corporation

Serial No. 78389392

William C. Schrot and Joseph W. Berenato, III, of Berenato
White & Stavish, LLC for Masonite International
Corporation.

Josette M. Beverly, Trademark Examining Attorney, Law
Office 112 (Angela Bishop Wilson, Managing Attorney).

Before Hairston, Bucher and Taylor, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Masonite International Corporation seeks registration
on the Principal Register of the mark **CAVALIER** (*in
standard character format*) for goods identified in the
application, as amended, as "non-metal doors made from

wood composite and solid wood components" in International Class 19.¹

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has found that Applicant's mark, when used in connection with the identified goods, so resembles the mark **CAVALIER** (*also in standard character format*) for "non-metallic railings, guardrails, handrails and banisters for use in and/or on buildings" in International Class 19,² as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and Applicant have fully briefed the case, and both appeared at an oral hearing held before this panel of the Board.

We affirm the refusal to register.

¹ Application Serial No. 78389392 was filed on March 23, 2004 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

² Registration No. 2651882 issued to American Vinyl Concepts, Inc. dba AVCON on November 19, 2002 based upon an application filed on January 22, 2002 claiming first use anywhere and first use in commerce at least as early as June 1, 2000.

Applicant argues that the cited registration is relatively narrow in scope. Applicant also contends that evidence it has placed into the record demonstrates that Registrant does not sell its products at retail through building and home centers, but rather, that prospective purchasers will need to have blueprints and detailed specification in order to buy Registrant's products directly from the manufacturer. Applicant contends that inasmuch as Applicant and Registrant have used their marks contemporaneously since 2004 without a single instance of actual confusion, it corroborates the realities of the marketplace that consumers seeking to purchase Applicant's doors would not confront Registrant's railings, nor would consumers seeking to purchase Registrant's railings confront Applicant's doors.

By contrast, the Trademark Examining Attorney argues that inasmuch as the marks of Registrant and Applicant are identical, the relationship between the respective goods need not be as close in order to support a finding of likelihood of confusion as might apply where differences exist between the marks. She argues that purchasers would believe that Applicant's wooden doors are within Registrant's "logical zone of expansion." She points to third-party websites and third-party registrations to

support her position that the goods of Registrant and of Applicant are commonly produced by the same entity and marketed under the same trademark. She contends that both Registrant and Applicant will be sharing some common channels of trade and that relevant consumers will include ordinary members of the general public.

Preliminary Matters

In order to demonstrate that Registrant's mark should be accorded a narrow scope of protection, Applicant submitted TARR registration data and Internet evidence for the first time with its brief. The Trademark Examining Attorney explicitly objected to the submission of the exhibits of third-party claims of uses of CAVALIER for related goods and/or services as untimely.

Another tact that Applicant took with third-party registrations was to show the ways in which third-party merchants and manufacturers of other building products have surrounded Registrant's other marks registered in connection with "railings, guardrails, handrails and banisters."

The Trademark Examining Attorney is correct in noting that the record in any application must be complete prior

to appeal. See 37 C.F.R. § 2.142(d); and TBMP § 1207.01 (2d ed. rev. 2004).

In response to the Trademark Examining Attorney's objection, Applicant has argued that her objection to the submissions is disingenuous in light of the prosecution history. Applicant contends that in its oral and written exchanges with the Trademark Examining Attorney around the time of its filing its request for reconsideration, Applicant believed that additional evidence was unnecessary in light of an amendment it had proposed that might well overcome the refusal (in the mind of Applicant's counsel, at least). As a fall-back position, Applicant specifically stated in its request for reconsideration of December 23, 2005 that if the Trademark Examining Attorney's refusal was not going to be withdrawn, "[a]lternatively, Applicant can submit a supplemental response" containing additional evidence. The Trademark Examining Attorney rejected the amendment and the request for reconsideration.

Applicant goes on to argue that despite the objection of the Trademark Examining Attorney, she has actually considered the evidence contained in these TARR records and Internet evidence:

In any event, the Examining Attorney has already considered the TARR and website submissions and maintained her refusal. The Examining Attorney states: "Even if applicant has shown that the cited mark is 'weak,' such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services." See Examining Attorney's Appeal Brief, p. 6. The Examining Attorney therefore maintains her refusal after considering the submissions. As such, remanding this application back to the Examining Attorney for further consideration would be counter-productive. Given the Examining Attorney has already considered all evidence provided in Applicant's Appendix, the Board may also properly consider all of Applicant's submissions.

Applicant's reply brief at 4.

We find that the Trademark Examining Attorney's objection to this late-filed evidence is well taken. She did not mislead Applicant into believing that the discussed amendment explicitly *excluding* railings, guardrails and handrails from Applicant's identification of goods would resolve the refusal to register based on likelihood of confusion. Additionally, we cannot fault her for merely stating her position that even if the record accurately revealed these common law and registered marks that incorporate the word "Cavalier," there would still be a likelihood of confusion under the circumstances of this case. This "alternative" argument seems perfectly

appropriate. The best practice for Applicant would have been to have submitted this evidence along with its Request for Reconsideration, if not earlier in the prosecution of the application. Accordingly, we have given no consideration to this TARR registration data [Appeal brief, Appendix B] or Internet evidence [Appeal brief, Appendix C]. We hasten to add that even if we were to consider these submissions, it would not change the result herein.

Likelihood of Confusion

We turn then to a consideration of the issue of likelihood of confusion. Our determination is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the relationship between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also In*

re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The marks

We look first at the similarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. It is beyond dispute that the involved marks are identical in every way. While Applicant argues that this is the only *du Pont* factor supporting the position of the Trademark Examining Attorney, the Trademark Examining Attorney takes the position that the identical nature of the two marks means that the goods need not be as closely related in order to support a finding of likelihood of confusion as might apply where differences exist between the marks. In any case, this *du Pont* factor clearly favors a finding of likelihood of confusion.

Relationship of the goods

We turn next to the *du Pont* factor focusing on the relationship of the goods identified in the involved application and the goods of the cited registration. In support of her position that doors and railings are related, the Trademark Examining Attorney included excerpts from third-party websites

*Manufacturers of
Windows, Doors, Fences, Decks & Railings*

Windows



Windows are one of the most visual assets of your home, inside and out. Windows can dramatically change the look and feel of any room in any home. With the proper combination...

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Doors



The Superior Seal Door System is simply the best steel door system available on the market today. Superior Seal doors are a perfect fit...

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Vinyl Fences / Decks & Railings



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Doors	Windows	Hardware	Railings	Bath Accesories
<ul style="list-style-type: none"> ◆ Hollow Metal ◆ Architectural ◆ Aluminum/PGT ◆ Residential 	<ul style="list-style-type: none"> ◆ Commercial ◆ Aluminum/PGT ◆ Residential ◆ Wood Clad 	<ul style="list-style-type: none"> ◆ Architecural ◆ Residential 	<ul style="list-style-type: none"> ◆ Aluminum ◆ Glass 	<ul style="list-style-type: none"> ◆ Grab Bars ◆ Mirrors ◆ Dispensors ◆ Hand Dryers ◆ Changing Tables

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The Examining Attorney also submitted for the record the following third-party registrations where the same mark is allegedly used in connection with the type of goods identified in Applicant's and in Registrant's description of goods, including doors and railings:



for "staircase components, namely, all kinds of steps, ramps, **banisters**, grooves, interior doors and wood mouldings, **sliding doors for bathrooms and closets**, and fireplace mantels" in International Class 19;⁷

DREAM

for "windows, **doors**, patio enclosures, finished and semi-finished glass for doors and windows, **decks constructed primarily of vinyl and railings therefor**, and boat docks constructed primarily of vinyl and railings therefore" in International Class 19;⁸

⁷ Registration No. 1465480 issued to Colonial Elegance Inc., a Canadian corporation, on November 17, 1987 based upon an application filed on November 17, 1986 claiming first use anywhere and first use in commerce at least as early as May 1985; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the word "Colonial" apart from the mark as shown.

⁸ Registration No. 2133038 issued on January 27, 1998 based upon an application filed on September 1, 1995 later claiming first use anywhere and first use in commerce at least as early as February 1996; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

AMERICAN HERALD

for "vinyl building products, namely, siding, soffit, trim coil, gutters and down spouts, roof vent and roof edgings, non-metal windows, **doors**, **railings** and columns" in Int. Claiming first use anywhere and first use in Int. Cl. 19;⁹



for "non metallic windows and **doors**, vinyl decking, **vinyl railings**, and vinyl fencing" in International Class 19;¹⁰

DAYTECH

for "building products made of extruded vinyl, namely, windows, **doors**, decking, **railings**, soffits, channel extrusions, siding trim, fencing and parts therefore" in International Class 19;¹¹

HIGHWOOD

for, *inter alia*, "non-metallic building products, namely synthetic wood made of extruded plastic; synthetic wood door frames, door sills, **doors**, garage doors ... fencing, **railings**, window slats, and trellis" in International Class 19.¹²

⁹ Registration No. 2169432 issued on June 30, 1998 based upon an application filed on May 12, 1997 claiming first use anywhere and first use in commerce at least as early as January 1, 1994; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the word "American" apart from the mark as shown.

¹⁰ Registration No. 2423444 issued on January 23, 2001 based upon an application filed on March 3, 2000 claiming first use anywhere and first use in commerce at least as early as January 31, 1991.

¹¹ Registration No. 2670009 issued on December 31, 2002 based upon an application filed on February 28, 2001 claiming first use anywhere and first use in commerce at least as early as August 18, 1997.

¹² Registration No. 2887319 issued on September 21, 2004 based upon an application filed on March 4, 2003 claiming

The Trademark Examining Attorney points out that third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Infinity Broadcasting Corporation*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); see also *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

We note that with the third-party registrations and the several Internet excerpts, all of these manufacturers and/or vendors appear to distribute building products that share the same material composition - DREAM, AMERICAN HERALD, POLARIS and DAYTECH as well as SUPERIOR SEAL and ALLIS in vinyl; TREBOR in metal; CANEX and COLONIAL ELEGANCE products in wood and HIGHWOOD, a synthetic wood made of extruded styrene structural foam. In determining the appropriate evidentiary weight to give to these specific third-party registrations, we find this pattern that each vendor's building material tend to be made of the same material composition to be instructive.

first use anywhere at least as early as February 25, 2003 and first use in commerce at least as early as April 6, 2003.

In the instant case, Applicant's "non-metal doors" are clearly further identified as being wooden doors. Without resort to extrinsic evidence, we must presume that Registrant's "non-metallic railings, guardrails, handrails and banisters" might also be primarily composed of wood, and intended for homes or other residential buildings. The CANEX web pages, for example, show non-metallic railings and banisters made of wood. The one item in Registrant's identification of goods that on its face may suggest something other than wooden rails intended for residential purposes is the term "guardrail." This term alone conjures up heavy railings required on the sides of porches, balconies, landings or other elevated walking surfaces, or as part of high-rise, commercial construction. Nonetheless, there is no evidence in this record that in the building field, Registrant's individually named, non-metallic building products could not be made primarily of wood. Accordingly, we cannot so restrict Registrant's goods.

Applicant argues that rather than relying on presumptions, we should consider Registrant's actual field of business. Hence, Applicant has submitted a copy of Registrant's website revealing maintenance-free,

thermoplastic railing systems reinforced with galvanized steel. These are clearly not wooden rails. The photographs show outdoor stadiums, high-rise apartments and hotels with exposed balconies - virtually all of them being commercial applications. Furthermore, the website makes it clear that the ordering of these railing systems are dependent upon detailed architectural specifications, data generated by computer aided design, etc.¹³ Applicant argues that in the real world, we should consider Registrant's actual business practices in making our determination of likelihood of confusion herein.

However, the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in an applicant's application vis-à-vis the goods and/or services recited in the cited registration, rather than what the evidence shows the actual goods and/or services to be. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *In re William Hodges & Co., Inc.*, 190 USPQ 47 (TTAB 1976). In this regard, we cannot diminish the scope of Registrant's registration based on extrinsic evidence Applicant has produced from Registrant's website.

¹³ <http://www.avconrail.com/>

As to the Trademark Examining Attorney's argument that purchasers would believe that Applicant's wooden doors are within Registrant's "logical zone of expansion," it is neither necessary nor possible to determine that from this record. Inasmuch as some manufacturers and merchants make and market both doors and railings of the same material composition, we simply find that these respective goods are related for purposes of this *du Pont* factor.

The similarity of established, likely-to-continue trade channels

As to the related *du Pont* factor focusing on the similarity or dissimilarity of established, likely-to-continue trade channels, Applicant argues that the trade channels are dissimilar.

Of course, on their faces, there are no restrictions on the channels of trade for either set of products. Applicant contends that its doors "are stocked 'on the shelves' at building and home centers," but they are not so limited in the identification of goods. Accordingly, we must presume that Applicant's doors may also be sold to builders and contractors. On their face, it seems that railings and banisters for residential improvement projects may be primarily installed by builders and contractors, but in some cases will also be purchased and installed by

do-it-yourself homeowners. Hence, the respective goods are presumably both sold in the retail trade, as well as to contractors and builders, and this *du Pont* factor appears to favor the position of the Trademark Examining Attorney.

Sophistication of purchasers

As to the *du Pont* factor focusing on the conditions under which and buyers to whom sales are made, we find that ordinary consumers comprise the least sophisticated class of purchasers that Registrant and Applicant might have in common. While doors and railings are not the equivalent of impulse purchases of inexpensive building supplies, neither would we consider them to be "big ticket" items within the scheme of home improvements or construction. Hence, under our precedents, we cannot presume that ordinary purchasers making decisions about doors or railings will necessarily be immune from confusion. This *du Pont* factor also appears to favor the position of the Trademark Examining Attorney.

Similar marks registered for related goods

As seen above, applicant argues that Registrant's mark should be accorded a narrow scope of protection based upon third-party claims or uses of composite marks

containing the word "Cavalier" in connection with related goods and/or services, and of various examples where merchants and manufacturers of other building products have surrounded Registrant's other marks registered in connection with "railings, guardrails, handrails and banisters." Given the fact that applicant submitted this evidence for the first time with its brief, and our finding that the Trademark Examining Attorney correctly objected to these exhibits as untimely, and did not consider this evidence to be of record, this factor has to be seen as a neutral factor in our likelihood of confusion determination herein.

Other probative evidence

Finally, we turn to other potentially relevant *du Pont* factors, such as any possible market interface between Applicant and Registrant, or other established facts probative of the effect of use. Applicant argues that with its recent intent-to-use application for its **CAPE COD** mark (also in connection with wooden doors), Registrant had another prior registration for that identical mark (also in connection with similar non-metallic railings), but did not oppose Applicant's application when it was published for opposition. To the

extent that Applicant and Registrant are indeed promoting themselves to very different markets, we are most sympathetic to Applicant's position that AVCON and Masonite International are both informed business entities, and neither has any concerns about a likelihood of confusion in the real world, for either their CAVALIER or CAPE COD marks. However, such a situation would seem to cry out for a well-drafted consent agreement, which would likely result in years of peaceful coexistence, and under the clearly-stated precedent of our primary reviewing court on this matter, nearly guarantees Applicant's mark being published for opposition without further objection from the assigned Trademark Examining Attorney.

In conclusion, the *du Pont* factors favoring a finding of likelihood of confusion include identical marks herein, the presumed relationship of the goods, as well as the presumption that the respective goods will move through the same channels of trade to the same classes of ordinary purchasers. Neutral factors include whether similar marks are used or registered for related goods, any indications of an absence of actual confusion over the past several years, and the renown of the cited mark.

Finally, to the extent that the likelihood of confusion issue is close, we are obligated to resolve doubts in favor of the registrant and prior user. *In re Hyper Shoppes*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Decision: The Section 2(d) refusal is hereby affirmed.