

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Hearing:
September 7, 2006

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Masonite Holdings, Inc.

Serial No. 78413461

William C. Schrot of Berenato, White & Stavish, LLC for
Masonite Holdings, Inc.

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Office 106 (Mary Sparrow, Managing Attorney).

Before Seeherman, Kuhlke and Walsh, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Masonite Holdings, Inc. has filed an application to
register the mark SELECT SERIES (in standard character
form) for goods ultimately identified as "non-metal
interior entry doors" in International Class 19.¹ In

¹ Application Serial No. 78413461, filed May 5, 2004, alleging a
bona fide intention to use the mark in commerce under Section
1(b) of the Trademark Act. 15 U.S.C. §1051(b). In its June 13,
2005 response, applicant, in addition to amending its
identification of goods in International Class 19, deleted the
identified goods in International Class 6, namely, "doors
primarily made of metal."

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response to a request from the examining attorney,
applicant disclaimed the word SERIES.

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 used on its identified goods, so resembles the registered mark SELECT (in typed form) for "metal clad, wood core, storm and screen doors" in International Class 6,² as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed, and an oral hearing was held. We affirm the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth 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 Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper*

² Registration No. 2232512, issued March 16, 1999, Section 8 and 15 combined declaration accepted and acknowledged.

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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).

As a preliminary matter, applicant attached exhibits to its brief that contained documents not previously submitted. Inasmuch as the exhibits are untimely, they will not be considered except for the print-outs of third-party registrations which were either previously submitted or which were not objected to and were substantively addressed by the examining attorney. See Trademark Rule 2.142(d); and *In re Urbano*, 51 USPQ2d 1776, 1778 n.4 (TTAB 1999). In addition, we take judicial notice of the dictionary definition submitted by applicant. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

We turn now to a consideration of the goods identified in the application and the cited registration. It is well settled that goods need not be similar or competitive in nature to support a finding of likelihood of confusion. The question is not whether purchasers can differentiate the goods themselves, but rather whether purchasers are likely to confuse the source of the goods. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618

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(TTAB 1989). Further, we must consider the cited registrant's goods as they are described in the registration and we cannot read limitations into those goods. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). If the cited registration describes goods or services broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all channels of trade normal for these goods, and that they are available to all classes of purchasers for the described goods. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

Applicant argues that applicant's and registrant's respective doors differ in their specific characteristics and that registrant's "metal clad storm and screen doors would not be used as an interior entry door." Br. pp. 4-5. The examining attorney contends that "when all is said and done, the fact remains that the goods manufactured and sold by both applicant and registrant are doors," and takes the position that "the registration is so broad with respect to the identification that they could include the type of

doors for which applicant is seeking" and applicant's goods are "within registrant's logical zone of expansion." Br. p. 4.

We find that applicant's and registrant's goods are related and that consumers would likely confuse the source of the goods. While we appreciate applicant's argument that these particular doors have different characteristics, metal clad storm and screen doors versus non-metal interior entry doors, they both provide the same function in that they are doors. Moreover, the goods do not need to be directly competitive to be related. Because a homeowner is likely to purchase both types of doors, and may seek doors that are of a similar style, it is likely that consumers upon encountering applicant's mark SELECT SERIES for doors for the interior of the house could believe that these doors are an extension of registrant's brand of metal-clad storm and screen doors. We further note that one of the third-party registrations submitted by applicant includes metal and non-metal doors under a single mark, and even applicant's application, as originally filed, included metal doors under the same mark. See *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

With regard to the channels of trade, applicant states that its products are sold at "various building and home

centers such as Home Depot.” Br. p. 5. These centers are included in the ordinary channels of trade for registrant’s goods. In addition, exterior and interior doors, because they are of the same product category, are likely to be sold in close vicinity in such a store. Applicant’s arguments regarding its search of various home center websites are unavailing because that evidence is untimely, as discussed supra, and do not address what occurs in the brick and mortar stores.

In view thereof, the du Pont factors of the similarity of the goods and the channels of trade favor a finding of likelihood of confusion as to the cited registration.

Certainly, registrant and applicant would have overlapping purchasers in terms of either building contractors or of homeowners repairing or enhancing their homes. Applicant argues that these goods are relatively expensive and consumers would exercise care in the purchase of the respective doors. We agree that doors would not fall into the category of impulse items and are relatively expensive items for the house. However, this does not serve to diminish in any meaningful way the likelihood of confusion because potential purchasers could include people of varying sophistication (contractors and homeowners) and even sophisticated purchasers are not immune from trademark

confusion. In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983).

With regard to applicant's arguments on the factor of fame, we agree there is no evidence of record to support a conclusion that the registered mark is famous. Thus, this du Pont factor must be considered neutral.

We turn now to the first du Pont factor, i.e., whether applicant's mark SELECT SERIES and registrant's mark SELECT are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. It is well settled that marks must be considered in their entireties, not dissected or split into component parts and each part compared with other parts. This is so because it is the entire mark which is perceived by the purchasing public and, therefore, it is the entire mark that must be compared to any other mark. It is the impression created by the involved marks, each considered as a whole, that is important. See Kangol Ltd. V. Kangaroo U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). Finally, "[w]hen marks would appear on virtually identical goods or services, the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 877,

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23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert denied, 506 U.S. 1034 (1992).

The examining attorney argues that applicant has "appropriated the sole component of registrant's mark and merely added a generic term to it." Br. p. 2. Further, the examining attorney states that "applicant has agreed to disclaim the word SERIES [and although a disclaimed portion of a mark certainly cannot be ignored and the marks must be compared in their entireties, as applicant notes, one feature of a mark may be more significant in creating a commercial impression." Br. p. 3. The examining attorney required the disclaimer in the first Office action, noting that SERIES "is merely descriptive because it tells the public that applicant produces a product line of doors." Office Action p. 2 (December 11, 2004).

In traversing the refusal, applicant argues that the addition of SERIES to applicant's mark is sufficient to distinguish it from registrant's mark SELECT. Br. p. 3. Because of this additional word, applicant states that the marks are different in sound and appearance. As to connotation, applicant submitted the following dictionary definition:

SERIES: 1. a group or number of similar or related things arranged in a row 2. a group or number of related or similar persons, things, or

events coming one after another; sequence; succession 3. a number of things produced as a related group; set, as of books or television programs, related in subject, format, etc., or dealing with the same characters.

Webster's New World Dictionary of American English (3rd College ed. 1988).

Thus, applicant argues that SERIES creates a different connotation in applicant's mark.

We find that applicant's mark, SELECT SERIES, is highly similar to the mark, SELECT, in the cited registration. Applicant's mark incorporates the entirety of registrant's mark, and the addition of the descriptive term SERIES does not serve to distinguish the marks. In re Rexel Inc., 223 USPQ 830 (TTAB 1984). In fact, it gives the impression that applicant's goods may be part of a series of door products, which has the effect of creating a stronger likelihood of confusion with registrant's one word SELECT mark. Moreover, the common word SELECT has the same connotation in each mark. We take judicial notice of the following relevant dictionary definitions for SELECT: "1. Singled out in preference; chosen; 2. of special quality or value." The American Heritage Dictionary of the English Language, (4th ed. 2000). The additional element SERIES in applicant's mark does not change the identical connotation derived from the common element, SELECT, in the marks.

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Viewing the marks in their entireties, they are similar in appearance, pronunciation, and connotation, and they convey a similar commercial impression. Thus, the factor of the similarity of the marks also favors a finding of likelihood of confusion.

Applicant's attempt to characterize the word SELECT as weak based on the coexistence of third-party registrations that contain the word SELECT, is not persuasive.³ While third-party registrations may be relevant to show that a mark is descriptive, suggestive, or has a commonly understood meaning such that the public will look to other elements to distinguish the source of the goods or services, see, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (CCPA 1973), here applicant has submitted only two active third-party registrations containing the term SELECT for doors and that is simply not sufficient. Further, each of the third-party registrations contain more distinguishing elements than does applicant's mark. See Reg. No. 2902043 (CRESTLINE SELECT for non-metal windows and doors and aluminum clad windows and doors); and Reg. No. 2556954

³ The third-party applications also submitted by applicant have no probative value other than as evidence that the applications were filed. In re Phillips-Van Heusen Corp., 63 USPQ2d 1047, 1049 n. 4 (TTAB 2002).

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(CONTRACTOR'S SELECT WINDOWS AND DOORS in stylized form for vinyl windows and doors and parts therefor). While we acknowledge that the term SELECT does have a somewhat laudatory quality, even weak marks are deserving of protection, in particular here where the goods are closely related and the marks are so similar. King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974); and Hollister Incorporated v. IdentAPet, Inc., 193 USPQ 439 (TTAB 1976). That is, the scope of protection to which the cited registration is entitled certainly extends to prevent the registration of the same word, SELECT, to which the descriptive word SERIES has been added, used for the same general type of product, a door.

Finally, applicant contends that there has been no instance of actual confusion during eight months of coexistence. We do not accord significant weight to applicant's contention that there have been no instances of actual confusion despite contemporaneous use of the respective marks. The Federal Circuit has addressed the question of the weight to be given to an assertion of no actual confusion by an applicant in an ex parte proceeding:

With regard to the seventh DuPont factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. See In re Bissett-Berman Corp., 476 F.2d

640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, [citation omitted], especially in an ex parte context.

Majestic Distilling, 65 USPQ2d at 1205.

Accordingly, while examples of actual confusion may point toward a finding of a likelihood of confusion, an absence of such evidence is not as compelling in support of a finding of no likelihood of confusion. Moreover, eight months is very little time upon which to make any inferences as to the meaning of a lack of actual confusion. Thus, we cannot conclude from the lack of instances of actual confusion that confusion is not likely to occur.

In conclusion, we find that because the marks are similar, the goods are closely related, and the channels of trade are the same, confusion is likely between applicant's mark and the cited registration.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.