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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re R E P Technology Ltd.

Serial No. 78457589

Peter D. Sabido of Kolisch Hartwell, P.C. for R E P Technology Ltd.

Darryl M. Spruill, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

Before Holtzman, Drost and Taylor, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by R E P Technology Ltd. (applicant) to register the mark FIREXBOARD (in standard character format) for goods which were ultimately identified as

> "fire-resistant, non-combustible (according to British Standard 476: Part 4 and American Society for Testing and Materials E136-04), moisture-resistant, non-toxic, and non-metal boards and panels for structural and non-structural construction that are suitable for outdoor use" in Class 9.[1]

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[1] Application Serial No. 78457589, filed July 27, 2004, alleging dates of first use and first use in commerce on December 18, 2003.

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the mark FIRE-X GLASBORD (in typed form) for "glass fiber reinforced plastic panels for walls and ceilings" in Class 19 (Registration No. 2334279), and the mark shown below for "glass fiber reinforced plastic panels" in Class 19 (Registration No. 1082107),[2] as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Briefs have been filed.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the

[2] Registration No. 2334279, issued March 28, 2000 under Section 2(f); Sections 8 and 15 affidavits accepted and acknowledged. Registration No. 1082107 issued January 1, 1978 without a Section 2(f) claim; renewed. Both registrations are owned by Crane Composites, Incorporated.

goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to a consideration of the goods. Applicant argues that the goods are "definitely distinct." In particular, applicant argues that its goods are suitable for fire prevention purposes; that they meet a particular standard of non-combustibility; that they are non-toxic because they contain no hazardous ingredients; and that they may be used for structural and non-structural construction and are suitable for outdoor use. Applicant argues that, in contrast to its own goods, registrant's panels are not suitable for fire prevention because fiberglass reinforced plastic panels are combustible; that toxic materials are used in making registrant's panels and that the panels generate toxic waste; that registrant's panels are not suitable for wet areas, and are therefore not suitable for structural construction or outdoor use; and that registrant's panels are only suitable for interior wall and ceiling finishes. To support these arguments, applicant has submitted copies of applicant's and registrant's product literature and a printout of a "Waste Study Audit" concerning fiberglass reinforced plastic products.

Applicant's and registrant's goods may be "definitely distinct" as applicant claims. However, it is well settled that goods need not be similar or competitive in nature to support a finding of likelihood of confusion. See Helene Curtis Industries

Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989). It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with, the same source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

Applicant's goods are non-metal boards and panels for structural and non-structural construction that are suitable for outdoor use. The goods are described as fire-resistant, non-combustible, moisture-resistant and non-toxic. Registrant's goods, as identified in Registration No. 2334279, are "glass fiber reinforced plastic panels for walls and ceilings."[3] The respective goods are closely related. We accept that registrant's panels are only suitable for ceilings and interior walls. However, applicant's panels, as described in its identification of goods, are also suitable for interior walls and non-structural construction. Applicant's own product literature states that the properties of applicant's boards and panels make them "ideal for [among other things]" "ceilings" and "interior

[3] We will focus on this registration for purposes of a comparison of the goods. If we find the goods are related as to this registration, the goods would also be related as to the broader identification of goods in Registration No. 1082107 which are not restricted to use for walls and ceilings.

walls." To that extent, both applicant's and registrant's products can be used for precisely the same purpose and to perform the same ultimate function. That is, they are alternative products for constructing interior walls and ceilings. In addition, the examining attorney submitted printouts from the websites of a number of manufacturers and/or suppliers of building materials showing that there are a variety of types of panels and boards that can be used for the construction of interior walls and ceilings.

Applicant's goods may have a superior fire rating to registrant's goods and may in fact be non-combustible, and they may even have other qualities or attributes that are allegedly superior to registrant's goods. Because of the differences in the properties or characteristics of the respective goods, consumers may not confuse the products themselves. However, that is not the issue. The issue is whether purchasers are likely to confuse the source of the products. See Truescents LLC v. Ride Skin Care LLC, 81 USPQ2d 1334 (TTAB 2006). While the different attributes of the respective panels may affect a purchaser's decision to buy one type of panel over the other, they would not necessarily affect a consumer's perception that the two products are related. See Recot Inc. v. M.C. Becton, 214 F.3d 1332, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("Even if the goods in question are different from, and thus not related to, one another

in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods"). We find that, notwithstanding any asserted differences in the particular attributes of the respective boards and panels, the fact remains that either type of board or panel is suitable for constructing interior walls and ceilings, and to that extent the products are closely related, if not the same.

Applicant argues that its goods are sold in bulk directly to fire services contractors, fire services engineers, fireproof product manufacturers, and fire door manufacturers because the goods are "highly specialized building materials." Applicant contends that registrant's goods, on the other hand, are generally sold in general building product stores and retail outlets, such as Lowe's and The Home Depot, because registrant's goods are interior finish products for general applications. We note, in this regard, that the evidence submitted by the examining attorney shows that at least one manufacturer/supplier of building panels (*www.suntuf.com*) provides "an assortment of building panels" for the "do-it-yourself customer."

Absent any restrictions in the respective application and registration, we must presume that applicant's and registrant's boards and panels for interior use are sold through all normal channels of trade for those goods and to all the usual purchasers See Canadian Imperial Bank v. Wells Fargo, 811 F.2d 1490, 1

USPQ2d 1813 (Fed. Cir. 1987). The fact that applicant has limited the sale of its goods to professionals in the construction industry does not mean that goods of this type are only sold to these purchasers or in these trade channels. We see no reason why the normal trade channels for applicant's non-metal boards and panels for interior walls and ceilings would not also include retail channels, and why applicant's goods could not be purchased by the same "do-it-yourself" customers that would purchase registrant's glass fiber panels. We note, for example, that applicant's products are touted in its product literature as being "lightweight" and "easy to install."

In any event, it is reasonable to assume that even the "do-it-yourself" customers who would purchase applicant's and registrant's materials would be knowledgeable about such products and would exercise some degree of care in their purchasing decisions. However, even knowledgeable and careful purchasers of goods can be confused as to source under circumstances where similar marks are used on closely related goods. See In re Research Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) citing Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers...are not infallible.").

Thus, we turn to a consideration of the marks. In evaluating the marks, we will focus on the cited mark that is closest to applicant's mark, that is, the mark FIRE-X GLASBORD in typed form.[4]

Applicant argues that its mark, as a whole, looks, sounds and means something very different from the cited mark. Applicant argues that FIREXBOARD is a single word with three syllables while registrant's mark is two words with each word having two syllables; and that consumers will focus on the hyphen in registrant's mark because "it splits registrant's marks into three separate parts." Applicant contends that the meaning and commercial impression of the respective marks is different because registrant's mark FIRE-X GLASBORD connotes a board of glass while applicant's mark "does not have that connotation."

In determining the similarity or dissimilarity of marks, we must consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See du Pont, supra. See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

Applicant's mark FIREXBOARD and registrant's mark FIRE-X GLASBOARD are very similar in sound. The first two syllables of

[4] If there is no likelihood of confusion as between applicant's mark and the registered mark in typed form, then there is no likelihood of confusion as between applicant's mark and registrant's FIRE-X GLASBORD in stylized form.

the marks are the same. The hyphen would not be pronounced and the terms FIRE-X and FIREX would sound the same when spoken. It is possible that FIREX in applicant's mark could be pronounced as FI-REX instead of FIRE-X. However, there "is no correct pronunciation of a trademark, and it obviously is not possible for a trademark owner to control how purchasers will vocalize its mark." Centraz Industries Inc. v. Spartan Chemical Co., 77 USPQ2d 1698, 1701 (TTAB 2006). Furthermore, it is far more likely that the term will be perceived and pronounced by consumers as a word they know, the familiar term FIRE followed by an "X," particularly when considered in relation to applicant's "fire-resistant, non-combustible" goods. The marks not only begin with the same two-syllable term but they also end with the equivalent words, BOARD and BORD. The one additional word, GLAS, in registrant's mark, is not sufficient to distinguish the marks as a whole because the two marks sound, in substantial part, the same.

There are some differences in appearance. At the same time, however, applicant's mark FIREXBOARD incorporates most of the essential elements of registrant's mark with only a slight variation in form and spelling. The hyphen in registrant's mark is not significant. This punctuation mark would not distinguish one mark from the other. See In re General Electric Co., 180 USPQ 542, 544 (TTAB 1973) ("Notwithstanding the hyphen in

applicant's mark, it is fair to assume that applicant's insulating material would ordinarily be called for and referred to by the designation 'REX.' Accordingly, it is concluded that the resemblances between the marks 'BRAND REX' and 'RE-X' are such as to be reasonably likely to cause persons to ascribe a common origin to the products sold thereunder"). Nor is it significant that applicant's mark is presented as a single term. See Seaguard Corp. v. Seaward International, Inc., 223 USPQ 48, 51 (TTAB 1984) (SEA GUARD and SEAGUARD are "essentially identical").

The differences in appearance become even less significant when we consider that the marks are substantially similar in meaning and in their overall commercial impressions. As applicant notes, GLASBORD is equivalent in meaning to "GLASS BOARD." When FIRE-X GLASBORD and FIREXBOARD are considered as a whole, they both suggest, in relation to the respective goods, the fire-resistant quality of applicant's and registrant's boards. The term GLAS in registrant's mark may suggest a particular type of board that is fire-resistant but it does not create a meaning that is new or different than FIREXBOARD and it does not alter the commercial impression in any significant way. Purchasers may simply assume that FIRE-X GLASBORD identifies a special line of FIRE-X BOARDS, that is, boards that are glass-fiber reinforced.

In support of its contention that the marks are not similar, applicant relies on Cortex Corp. v. W.L. Gore & Associates, 1 F.3d 1253, 28 USPQ2d 1152 (Fed. Cir. 1993), finding the marks GORE-TEX and CORTEX distinguishable in appearance because of, inter alia, the hyphen in GORE-TEX. That case is marked as an "unpublished" decision and it will not be considered.[5] Even if considered, however, the case would not be persuasive. The Court in that case specifically found that marks CORTEX and GORE-TEX "differ significantly in connotation" stating that "CORTEX is suggestive of the brain, especially in the context of Cortex's computer program products" whereas the GORE-TEX mark "has no such connotation." In the present case, however, neither the hyphen in registrant's mark nor the compressed form of the words in applicant's mark has any affect on the meaning the two marks convey.

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[5] We note that, effective December 1, 2006, the Federal Circuit added Rule 32.1 that permitted the citation of non-precedential opinions issued after January 1, 2007:

> (c) Parties' Citation of Nonprecedential Dispositions. Parties are not prohibited or restricted from citing nonprecedential dispositions *issued after January 1, 2007*. (Emphasis added.) This rule does not preclude assertion of claim preclusion, issue preclusion, judicial estoppel, law of the case, and the like based on a nonprecedential disposition issued before that date.
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> (d) Court's Consideration of Nonprecedential Dispositions. The court may refer to a nonprecedential disposition in an opinion or order and may look to a nonprecedential disposition for guidance or persuasive reasoning, but will not give one of its own nonprecedential dispositions the effect of binding precedent. The court will not consider nonprecedential dispositions of another court as binding precedent of that court unless the rules of that court so provide.

We find that the overall similarities in the marks far outweigh their differences. Keeping in mind that the comparison of the marks is not necessarily made on a side-by-side basis and that recall of purchasers is often hazy and imperfect, the differences in the two marks are not so significant that they are likely to be remembered by purchasers when seeing these marks at different times on closely related goods. Even if purchasers remember the specific differences in the marks, they are likely to perceive FIREXBOARD as simply a slightly different version of registrant's mark FIRE-X GLASBORD, or as identifying a different line of boards, rather than as identifying a different source for the goods.

Applicant argues that the registered marks are weak with respect to building materials and only entitled to a narrow scope of protection in that field. In support of its position applicant submitted a list of third-party registrations for marks consisting of FIREX or FIRE-X for a variety of products. Applicant also points to an additional third-party registration (Reg. No. 1037082), issued to Hoover Treated Wood Products, Inc., for the mark shown below for "lumber which has been impregnated with a fire retardant chemical" in Class 12.[6]

[6] The examining attorney, for the first time in his brief, objected to the list of third-party registrations, including the above registration, as being unsupported by copies thereof. The objection is considered waived. Although applicant had relied on the listing in its response to the initial Office action, the examining attorney did not

FIRE-X

Applicant argues that the existence of this registration "by itself is sufficient to demonstrate that in the field of building materials, FIRE-X is used by more than one party and therefore is a term to which no one party has exclusive rights for the entire spectrum of building materials."[7]

Applicant's third-party registrations for FIREX or its equivalents do not persuade us that registrant's mark is weak. The factor to be considered in determining likelihood of confusion under *du Pont* is the number and nature of similar marks "in use on similar goods." See In re E. I. du Pont de Nemours & Co., supra at 567 (emphasis added). First, third-party registrations are not evidence that the marks shown therein are in use. See AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Moreover, with one possible

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object to the evidence either in his final refusal or his denial of applicant's request for reconsideration, and furthermore, the examining attorney treated the registrations as of record. Accordingly, this evidence will be considered for whatever probative value it may have.

[7] Applicant claims that the examining attorney "admitted" during a telephone interview with applicant's counsel that the examining attorney "should have also cited the FIRE-X mark" which according to applicant was "in effect" an admission by the examining attorney that the cited marks are weak. (Reply Brief at 1). These arguments have no merit. It is the written record in a case that is controlling, and besides, the examining attorney denied making any such statement. Further, whether or not that registration should have been cited against the application is irrelevant to the question of whether the cited marks are weak.

exception, the third-party registrations are not for similar goods. In fact they are for distinctly different goods. These registrations are irrelevant to our determination. See In re Melville Corporation, 18 USPQ2d 1386 (TTAB 1991).

The existence of one third-party registration for "FIRE-X" that is arguably in a similar field is hardly sufficient to show that the term has been frequently adopted and registered to indicate some meaning in connection with building materials.[8] Furthermore, even assuming FIRE-X is suggestive, the case relied on by applicant, In re Melville, supra, and similar cases, do not compel a finding that marks are not confusingly similar merely because they contain a shared suggestive element. Marks must be considered in their entireties, and the commercial impressions are conveyed by the marks as a whole, including the suggestive elements. See Sundure Paint Corporation v. Maas & Waldstein Co., 267 F.2d 943, 122 USPQ 377, 378 (CCPA, 1959) (the fact that a term may be common to other marks in the same field "is of no significance if the use of the two marks, when they are viewed in

[8] Applicant argues that during prosecution of the underlying application for that registration, the registrations cited herein were also initially cited against that application and subsequently withdrawn; and that the applicant therein made "admissions" about the weakness of its mark in an attempt to overcome the refusal. Applicant did not make the contents of the file for the registration of record; and regardless, any asserted statements, arguments or admissions, by a third-party in support of registration, or by a prior examining attorney in refusing registration or withdrawing a refusal to register, are not evidence in the case before us, and they have no bearing on the determination of whether the marks in this case are likely to cause confusion.

their entireties, as they must be, is likely to cause confusion of source"). When the marks in this case are considered in their entireties, we believe that the similarities between them are such that purchasers are reasonably likely to ascribe a common source to the boards and panels offered under the marks.[9]

Finally, we point out that the asserted absence of evidence of actual confusion does not, as applicant claims, weigh in favor of applicant. We have no information regarding the nature or extent of applicant's and registrant's use or whether a meaningful opportunity for actual confusion ever existed. See Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768 (TTAB 1992). Thus, we consider this factor to be neutral. See Blue Man Productions Inc. v. Tarmann, 75 USPQ2d 1811 (TTAB 2005).

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

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[9] To the extent that applicant is arguing that in view of the coexistence of the "FIRE-X" mark on the register, applicant's mark should be entitled to register as well, this argument is not persuasive. The Board has often noted that each application must be decided on its own merits. The determination of registrability of that particular mark cannot control our decision in the case now before us. See In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court."). The coexistence of that third-party registration with the cited registrations, even assuming they are confusingly similar, does not justify registration of yet another confusing mark. See AMF Inc. v. American Leisure Prods., Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973).