

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: January 18, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jenisys Engineered Products, Inc.

Serial No. 78656734

Todd Deveau of Thomas, Kayden, Horstemeyer & Risley LLP for
Jenisys Engineered Products, Inc.

Russ Herman, Trademark Examining Attorney, Law Office 101
(Ronald R. Sussman, Managing Attorney).

Before Hohein, Hairston and Kuhlke, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Jenisys Engineered Products, Inc. seeks registration
on the Principal Register of the mark PRESTIGE PANEL (in
standard character form with PANEL disclaimed) for goods
identified as "metal panels for use in construction of
building roofs" in International Class 6.¹

Registration has been refused under Section 2(d) of
the Trademark Act, 15 U.S.C. §1052(d), on the ground that

¹ Application Serial No. 78656734, filed on June 23, 2005,
alleging July 16, 2001 as the date of first use anywhere and in
commerce under Section 1(a) of the Trademark Act. 15 U.S.C.
§1051(a).

Serial No. 78656734

applicant's mark, when used with its identified goods, so resembles the registered mark PRESTIGE SERIES (in typed form with SERIES disclaimed) for "metal structural roof decking for use as vertical and interior walls, fascias and soffit ceiling panels" in International Class 6 as to be likely to cause confusion, mistake or deception.²

When the refusal was made final, applicant appealed and briefs have been filed. 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, however, two key considerations are the similarities between the marks and the similarities between the goods. 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).

² Registration No. 2820579, issued March 9, 2004, setting forth August 1989 as the date of first use anywhere and in commerce.

We first consider the goods, the channels of trade and the class of purchasers. In making our determination, we must consider the cited registrant's and applicant's goods as they are described in the registration and application, and we cannot read limitations into those descriptions of the 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 and application describe the goods broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration and application encompass all goods of the type described, that they move in all channels of trade normal for those 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 the fact that the goods are all "materials for building construction does not per se establish a likelihood of confusion." Br. p. 10. Applicant contends that the goods at issue are different inasmuch as the goods in the cited registration are "for use as vertical and interior walls, fascias and soffit ceiling panels ... intended for interior use, as opposed to

exterior use" and therefore "are not intended for the same use as Applicant's goods, namely in construction of building roofs." Br. p. 11.

The examining attorney states, on the other hand, that:

[R]egistrant's goods, as described in the cited mark, are not all limited to interior applications as claimed by applicant. After all, fascias and soffits are exterior boards that form part of a cornice, the exterior projection of a roof overhang at the eaves ... Roof construction includes both vertical and horizontal framing elements involving rafters, joists and trusses that require both interior and exterior wall construction. "Decking" can be laid between joints in horizontal flooring applications as well as between rafters in vertical roofing applications.

Br. p. 9.

We take judicial notice of the following dictionary definitions:³

Fascia: 1.b. a horizontal piece (as a board) covering the joint between the top of a wall and the projecting eaves - called also fascia board. Merriam-Webster's Collegiate Dictionary (10th ed. 1999);

Soffit: n. The underside of a structural component, such as a beam, arch, staircase, or cornice. The American Heritage Dictionary of the English Language (4th ed. 2006); and

³ The Board may take judicial notice of dictionary definitions. *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).

Decking: 1. material, as paper or fiberboard, treated in various ways as a waterproof covering for a deck or roof. 2. material of concrete, asbestos, steel, or the like in the form of self-supporting flooring or roofing units laid between joists or rafters. Random House Unabridged Dictionary (2006) retrieved from www.dictionary.com.

Applicant's interpretation of registrant's goods imposes a limitation that is not there. The term "vertical walls" in the identification of such goods encompasses interior and exterior walls. In addition, the word "interior" therein appears to apply only to "interior walls," and the fascias and soffit ceiling panels are not limited to interior applications. As shown by the dictionary definitions, fascias and soffit ceiling panels have both interior and exterior applications and in some applications are closely tied to construction of the roof. In view thereof, we find the goods to be closely related.

Considering the channels of trade and class of purchasers, inasmuch as there are no limitations in either the registration or the subject application, we must presume that applicant's and registrant's closely related goods will be sold in the same channels of trade and will be bought by the same classes of purchasers. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d

Serial No. 78656734

1813 (Fed. Cir. 1987); and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

In view of the above, the du Pont factors of the similarity of the goods, the channels of trade and class of purchasers favor a finding of likelihood of confusion as between applicant's mark and the mark in the cited registration.

With regard to the conditions of sale, applicant argues that its goods would be purchased by more sophisticated consumers such as architects and designers. Applicant argues that "[a] nonprofessional is highly unlikely to purchase metal panels for construction of roofs." Reply Br. p. 8. While the identification of goods does not contain a specific limitation, the reference to "building" in applicant's identification could indicate a more sophisticated consumer base. However, even if we consider the overlapping customers to be more informed and discriminating, they are not immune from confusion in connection with the use of trademarks. *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

We next consider whether the marks PRESTIGE PANEL and PRESTIGE SERIES are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression.

In arguing that the marks are dissimilar, applicant contends that the term PRESTIGE is a weak, laudatory term and the addition of different words to applicant's and registrant's marks sufficiently distinguishes the marks. In support of this argument applicant submitted a listing retrieved from the Trademark Electronic Search System (TESS) that includes 681 "live" and "dead" applications and registrations that contain the word PRESTIGE in the mark, and printouts of three registrations from TESS. In addition, applicant, in its request for reconsideration, referenced three other registrations that contain the word PRESTIGE and noted the goods for which they are registered. Submission of a listing and references in a response do not properly make the registrations of record; however, inasmuch as the examining attorney has not objected to this deficiency and has treated such matter as being of record by addressing it, we consider it to be of record for whatever probative value it may have. See *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1456 n.2 (TTAB 1998) and *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 n. 6 (TTAB 1999).

Applications serve no evidentiary purpose other than to show that they were filed. *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002); *Glamorene*

Serial No. 78656734

Products Corp. v. Earl Grissmer Co., Inc., 203 USPQ 1090, 1092 n. 5. (TTAB 1979). Further, it is well settled that registrations are not evidence of use and, thus, are not probative for purposes of analyzing the sixth du Pont factor. AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269-70 (CCPA 1973); In re Comexa Ltd., 60 USPQ2d 1118 (TTAB 2001). Moreover, the "existence on the register of confusingly similar marks cannot aid an applicant in its effort to register another mark which so resembles a registered mark as to be likely to cause confusion." In re Total Quality Group Inc., supra at 1479. See also Lilly Pulitzer, Inc. v. Lilli Ann Corp., 376 F.2d 324, 153 USPQ 406 (CCPA 1967). However, registrations may serve to show, in the nature of a dictionary definition, how language is used. Specialty Brands, Inc. v. Coffee Bean Distributors Inc., 748 F.2d 669, 675, 223 USPQ 1281, 1285-86 (Fed. Cir. 1984). Thus, third-party registrations may be relevant to show that a term is descriptive or suggestive such that the public will look to other elements to distinguish the marks. See Textronix, Inc. v. Dactronics, Inc., 53 F.2d 915, 189 USPQ 693 (CCPA 1976).

With regard to the TESS listing, because we do not know from the listing the goods or services for which the marks are registered, such necessarily limits our analysis.

Serial No. 78656734

However, we do have more detailed information as to the six registrations from the three TESS full record printouts and the three references in applicant's request for reconsideration and they are set forth below:

Reg. No. 2417018 for the mark PRESTIGE SERIES (SERIES disclaimed) for door locks made primarily of metal, namely, deadbolts, knobsets, handlesets, leversets, and parts thereof;

Reg. No. 2034256 for the mark PRESTIGE for bathroom accessories, namely, soap dishes, toothbrush and tumbler holders, toilet paper holders, towel bars and towel rings;

Reg. No. 680909 for the mark PRESTIGE for seals of metal, metal with cardboard and/or paper inserts, plastic, plastic with cardboard and/or paper inserts, and a combination metal and paper to be applied to shipping containers and consumer goods;

Reg. No. 2023339 for the mark PRESTIGE for non-metal windows and patio doors;

Reg. No. 2287012 for the mark PRESTIGE HARDWOOD FLOORS for wood flooring, particularly strips and planks; and

Reg. No. 3044687 for the mark PRESTIGE SERIES for architectural masonry units, namely, glazed concrete blocks used for interior walls.

In addition, applicant submitted the following dictionary definition for the word PRESTIGE as evidence that it is a laudatory term:

Prestige: 1. standing or estimation in the eyes of people: weight or credit in general opinion.

The Merriam-Webster Online Dictionary.

The examining attorney, however, also submitted the following dictionary definition of such word:

PRESTIGE: 2. distinction or reputation attaching to a person or thing and thus possessing a cachet for others or for the public.

Random House Unabridged Dictionary (2006), retrieved from www.dictionary.com.

The six registrations are not sufficient for us to conclude that PRESTIGE has been so widely registered because of a particular meaning in the field of structural metal building materials. Three of the registrations do not include metal building materials and none of the goods include metal panels used for roofing or ceiling applications or structural construction applications. However, as shown by the dictionary definitions, the term PRESTIGE may suggest a general attribute of the goods to the extent it evokes something that has a high level of distinction or reputation, but even weak marks are protected, in particular, where as here, the goods are closely related. *Hollister Inc. v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

Applicant further argues that the marks, when compared in their entirety, are different due to the addition of the words SERIES and PANEL to the respective marks. Specifically, applicant argues that due to the weakness of

the word PRESTIGE consumers would not rely on the word "prestige" alone "as the sole indication of source." Br. p. 7. Applicant further contends that, in addition to a difference in sound and appearance, the addition of those words creates a different meaning in that PRESTIGE SERIES "has the meaning 'a number of things of the same class coming one after another having standing or estimation in the eyes of people'" and PRESTIGE PANEL has the meaning of "a flat usually rectangular piece of construction material having standing or estimation in the eyes of people." Br. p. 8.

We find these differences are not sufficient to distinguish the marks. We must determine whether the marks are sufficiently similar that there is a likelihood of confusion as to source and, in doing so, we must consider the recollection of the average purchaser, who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Despite any suggestiveness the word PRESTIGE may have, in comparison to the other elements, the dominant element in both marks is the word PRESTIGE. The additional words in the marks have been disclaimed and are, if not generic, at least descriptive of the goods. The word "panel" is the name of applicant's goods which consist

Serial No. 78656734

of metal panels. The word "series" in registrant's mark simply alerts the consumer that this is one of many products offered and could even serve to increase the likelihood of confusion by indicating it is part of a series.

Overall, we find that the marks are similar in sound, appearance and connotation, and have a very similar commercial impression. Therefore, the factor of the similarity or dissimilarity of the marks in their entireties weighs in favor of there being a likelihood of confusion.

In conclusion, we find that because the marks are similar, the goods are related, and the channels of trade and purchasers overlap, confusion is likely between applicant's mark and the mark in the cited registration. To the extent we may nonetheless have any doubt, we must resolve that doubt in favor of the registrant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

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