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*Decision Mailed:
March 26 2008
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re CCA Global Partners, Inc.

Serial No. 78693773

Alan S. Nemes, Alisha L. Huls and Wendy Boldt Cohen of Blackwell Sanders Peper Martin LLP for CCA Global Partners, Inc.

Jenny Park, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Quinn, Hohein and Holtzman, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

CCA Global Partners, Inc. has filed an application to register on the Principal Register in standard character form the mark "RESISTA" for "synthetic fiber comprising an integral component of carpet; [and] textile fiber comprising an integral component of carpet" in International Class 27.¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the

¹ Ser. No. 78693773, filed on August 16, 2005, which is based on an allegation of a bona fide intention to use such mark in commerce.

mark "RESISTAT," which is registered, by the same registrant, on the Principal Register in standard character form for "textile fiber" in International Class 22² and "synthetic textile yarn" in International Class 23,³ as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed and briefs have been filed.⁴ We affirm the refusal to register.

² Reg. No. 1,609,129, issued on August 7, 1990, which sets forth a date of first use anywhere and in commerce of October 30, 1989; renewed.

³ Reg. No. 1,609,132, issued on August 7, 1990, which sets forth a date of first use anywhere of August 20, 1977 and a date of first use in commerce of November 9, 1989; renewed.

⁴ In addition, on the day prior to filing its initial brief, applicant submitted an amendment to allege use ("AAU") of its mark. However, as noted by the Examining Attorney in her brief, because she "did not have jurisdiction over the file and the case was not remanded to her except for submission of the brief, the merits of the AAU have not been reviewed." TBMP §1206.01 (2d ed. rev. 2004) provides in relevant part that where, as here, "an applicant which has filed a timely appeal to the Board files an amendment to allege use, in the application which is the subject of the appeal, more than six months after issuance of the appealed action, the Board may, in its discretion ... continue proceedings with respect to the appeal, thus deferring examination of the amendment to allege use until after final determination of the appeal. If the final determination of the appeal is adverse to applicant, the amendment to allege use will be moot."

Also, with its initial brief, applicant for the first time attached copies of the file histories for registrant's two cited registrations along with what it refers to as a printout of a brochure for registrant's goods which it obtained from registrant's website. Although offering no reason for its failure to submit such evidence prior to appeal, as to the printout of the brochure, applicant specifically "requests that the Board take judicial notice" thereof. The Examining Attorney, citing *inter alia* Trademark Rule 2.142(d), states in her brief that she "objects to the applicant's inclusion of a printout of a brochure for the registrant's goods from the registrant's website and the printouts of the ... file history" for the cited registrations, based upon applicant's untimely submission of such printouts "for the first time with its appeal [brief]." Irrespective thereof, she also "objects to the applicant's request for the ... Board ... to take judicial notice of a printout of a brochure of the registrant's goods," contending that such a brochure "is not an appropriate matter" for judicial notice. We agree with the Examining Attorney that the evidence submitted with applicant's initial brief is manifestly untimely under Trademark Rule 2.142(d) and thus should not be further considered. Moreover, while applicant urges in its reply

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.⁵ See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Here, as pointed out by the Examining Attorney in her brief, inasmuch as applicant has not offered any argument with respect to the similarity or dissimilarity in the goods at issue and, thus, appears to concede

brief that such evidence nonetheless is proper subject matter for judicial notice, given that Fed. R. Evid. 201 "states that a judicially noticed fact must be one not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned," we disagree. Plainly, the information which applicant requests that the Board take judicial notice of is not generally known nor, in the case of evidence taken from the Internet, can its accuracy not be reasonably questioned, given the well known changeability of websites. It is settled, furthermore, that the Board does not take judicial notice of third-party registrations, a practice which extends to the file histories thereof. See, e.g., In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974). In any event, we hasten to add that even if such evidence were to be treated as part of the record herein, it is essentially cumulative in nature and hence would make no difference in the outcome of this appeal.

⁵ The court, in particular, pointed out that: "The 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." 192 USPQ at 29.

that such goods are commercially related as contended by the Examining Attorney, the primary focus of our inquiry is on the similarities and dissimilarities in the respective marks, when considered in their entireties, along with, as applicant also asserts, the additional *du Pont* factors of the number and nature of similar marks in use on similar goods and the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion.

Nonetheless, as a preliminary matter, we observe that registrant's "textile fiber" and "synthetic textile yarn" are closely related in a commercial sense to applicant's "synthetic fiber comprising an integral component of carpet; [and] textile fiber comprising an integral component of carpet" in that registrant's goods may be used in the manufacture of, *inter alia*, carpet fiber as an integral component of carpets, which appears to be the same use as in the case of applicant's goods. Applicant, as the Examining Attorney points out in her brief, does not contend to the contrary and, in support of her position, the Examining Attorney has made of record copies of various use-based third-party registrations which show the goods identified therein as (i) "raw synthetic textile fiber sold as a component of carpet"; (ii) "nylon textile fiber for use in the manufacture of carpet"; (iii) "synthetic fibers ... for use in the manufacture of ... carpets, namely, polyester fiber sold as a component of carpet"; (iv) "polypropylene fiber sold as a component of carpet"; (v) "nylon fiber for such purposes as manufacture of ... carpet"; (vi) "solution dyed nylon fiber used

in the manufacture of carpet"; (vii) "nylon fiber used in the manufacturing of carpet"; (viii) "nylon fiber used as a component of carpet"; (ix) "synthetic fibers, featuring a heat treatment to reduce fuzz, for use in the manufacture of carpet; synthetic fiber"; (x) "textile fibers for use in the manufacture of carpet"; and (xi) "synthetic fiber for use in the manufacture of carpet." In view thereof, registrant's goods would appear to be suitable for use for the same purpose as applicant's goods and, hence, would be sold through the same channels of trade to the same classes of purchasers.

Turning, then, to the respective marks, applicant argues in its initial brief that, in essence, its mark "RESISTA has a much different connotation and commercial impression" than that of registrant's mark "RESISTAT," notwithstanding that the marks differ by only one letter. This is because, according to applicant, "[t]he STAT portion of the ... [Registrant's mark] connotes that the Registrant's goods are 'resistant' to 'static.'" Applicant asserts, based on the copies of numerous third-party registrations which it has made of record, that "[t]he many marks on the Principal Register that incorporate the term STAT for goods for or relating to 'anti-static' properties demonstrate that the suffix STAT is clearly associated with the term 'static.'" Applicant contends, in this regard, that "purchasers will understand that the term STAT in the ... [Registrant's mark] means or refers to anti-static textile fibers and synthetic textile yarn, which is exactly how the Registrant has marketed its products." Applicant therefore maintains that

its mark "RESISTA has a much different connotation than the ... [Registrant's mark]." Based, furthermore, on a list which it has made of record of various additional third-party registrations, applicant "notes that ... numerous other RESIST marks co-exist on the Principal Register in connection with the same or similar goods as the ... [Registrant's mark]." Applicant insists that because "there are many companies owning registrations incorporating the term 'RESIST' with distinctive additional elements ... for flooring and fiber products," "consumers can distinguish between these various RESIST marks." Thus, applicant urges, "[t]he co-existence of these many marks for similar goods indicates no customer confusion is likely with respect to Applicant's mark in connection with its goods." Finally, noting that "it recently amended its application to allege use in commerce" and that it "has been selling its goods under the current mark since January of 2006 without any known instances of consumer confusion with the ... [Registrant's mark]," applicant concludes that such contemporaneous use "without confusion is highly probative of the absence of likelihood of confusion."

We agree with the Examining Attorney, however, that the marks at issue, when considered in their entirety, are so substantially similar that confusion as to the source or sponsorship of the respective goods is likely to occur. As the Examining Attorney points out in her brief, both "applicant's mark and registrant's mark share the common term 'RESIST.'" While, we note, applicant's mark adds the letter "A" at the end thereof and registrant's mark similarly ends with the additional

letters "AT," the Examining Attorney maintains that "the overall commercial impression of the marks derives largely from the meaning and significance of the term 'RESIST.'" In view thereof, the Examining Attorney asserts that the fact that applicant's mark, in effect, deletes the end letter "T" from registrant's mark "does not change the overall commercial impression of the marks" inasmuch as purchasers of the respective goods "are likely to recollect [the term] RESIST." Such term, we note, also gives the marks at issue a substantial similarity in connotation, with both marks suggesting that the goods associated therewith have the property of being resistant to something, e.g., stains and/or static electricity. Moreover, because applicant's "RESISTA" mark is incorporated in its entirety by registrant's mark "RESISTAT," such marks are substantially similar in overall sound and appearance.

As to applicant's contention that the "STAT" portion of registrant's "RESISTAT" mark will be understood by purchasers as connoting that registrant's goods "are 'resistant' to 'static'" and that such portion sufficiently serves to distinguish the mark from applicant's "RESISTA" mark, the Examining Attorney, citing *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988), for the proposition that, as stated therein, "[i]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered," argues that it is the shared term "RESIST" in both marks which "consumers are more inclined to focus on" and thus would lead to a likelihood of confusion. Furthermore, the Examining Attorney

argues that, even if the term "STAT" in the registrant's mark "refers to antistatic properties of its goods, the issue at hand is whether the applicant's mark and the registrant's mark when viewed in their entireties create a confusingly similar commercial impression." We concur that even though registrant's mark "RESISTAT" could be specifically said to project the connotation and commercial impression of a textile fiber and synthetic textile yarn which, when used as integral components of carpet, are resistant to static, that does not mean that such mark is sufficiently distinguishable from applicant's "RESISTA" mark, which as noted previously engenders a substantially similar connotation and commercial impression, when used in connection with a textile fiber and synthetic fiber which comprise an integral component of carpet, of goods that are likewise resistant to something, including static and/or stains.

With respect to applicant's assertion that the record shows that "there are many companies owning registrations incorporating the term 'RESIST' with distinctive additional elements ... for flooring and fiber products"⁶ such that it may be assumed that "consumers can distinguish between these various RESIST marks," as well as applicant's mark, without there being a

⁶ The list of third-party registrations which applicant has made of record, however, consists of just seven registrations (owned by four registrants) for the following marks and goods: "RESISTRON" for "carpeting"; "REGGIE RESISTANT" for "carpets"; "NICCARESIST" for a "concentrated stain resist agent for nylon carpets"; "ANSO CRUSHRESISTER" (stylized) for "nylon carpet yarn"; "ANSO CRUSHRESISTER III ACT" for "nylon fiber sold as an integral component of carpets"; "ANSO CRUSHRESISTER III TLC" for "nylon fiber sold as an integral component of carpets"; and "ASTROTURF UV SHIELD ULTRAVIOLET RESISTANT FORMULA" and design for "ultraviolet radiation resistant synthetic turf systems."

likelihood of confusion, it is well settled that third-party registrations do not demonstrate use of the marks which are the subjects thereof in the marketplace or that the purchasing public is familiar with the use of those marks and has learned to distinguish between them. See, e.g., *Olde Tyme Foods, Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); and *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Furthermore, as our principal reviewing court noted in *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001), "[e]ven if some prior registrations had some characteristics similar to [applicant's] application, the ... allowance of such prior registrations does not bind the Board or this court." See also, *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 (TTAB 2001); and *In re Pennzoil Products Co.*, 20 USQP2d 1753, 1758 (TTAB 1991). In any event, even if applicant had established that the third-party marks on which it relies are in use and that the public has learned to distinguish between them, it is still the case that none of such marks is as substantially similar to applicant's "RESISTA" mark in sound, appearance, connotation and commercial impression as is the cited registrant's "RESISTAT" mark. Thus, the *du Pont* factor of the number and nature of similar marks in use on similar goods is neutral rather than in favor of applicant.

Finally, as to applicant's argument that it has been selling its goods under its mark "since January of 2006 without

any known instances of consumer confusion with the ... [Registrant's mark]" and that such contemporaneous use "is highly probative of the absence of likelihood of confusion," suffice it to say that, aside from the meager evidence offered by applicant with respect thereto, an asserted lack of any incidents of actual confusion is a meaningful factor only where the record demonstrates that there has been appreciable and continuous use by applicant of its mark in the same market(s) as those served by registrant under its mark. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Specifically, there must be evidence showing that there has been an opportunity for instances of actual confusion to occur and here the record is devoid of any such proof. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). In particular, other than applicant's claim to have used its "RESISTA" mark in connection with its goods only since January of 2006, there is no proof as to the extent of applicant's sales and advertising, nor is there any evidence that such took place in the same markets as those served by registrant under the "RESISTAT" mark for its products. It consequently is the case that the *du Pont* factor of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion must be considered neutral instead of being in applicant's favor.

Accordingly, weighing all the relevant *du Pont* factors, we conclude that purchasers who are familiar or otherwise acquainted with registrant's "RESISTAT" mark for "textile fiber"

and "synthetic textile yarn" would be likely to believe, upon encountering applicant's substantially similar "RESISTA" mark for "synthetic fiber comprising an integral component of carpet; [and] textile fiber comprising an integral component of carpet," that such closely related goods emanate from, or are sponsored by or affiliated with, the same source. Purchasers, for example, could readily regard the goods sold by applicant under its "RESISTA" mark as a new, expanded or up-graded line of synthetic fiber and textile fiber, each of which comprises an integral component of carpet, that is resistant to stains as well as static electricity and is from the same source as the antistatic textile fiber and synthetic textile yarn marketed by respondent under its "RESISTAT" mark.

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