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Mailed:
6 February 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Solvay (Societe Anonyme)

Serial No. 79015810

Mark B. Harrison of Venable LLP for Solvay (Societe Anonyme).

Kristina Morris, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

Before Drost, Zervas, and Bergsman, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On April 7, 2005, applicant Solvay (Societe Anonyme) applied to register the mark NIDACELL, in standard character form, on the Principal Register for goods ultimately identified as follows:

> Semi-processed plastic in the form of films, sheets, tubes, bars, or rods; packing, stopping and insulating resins in the form of bars, rods, sheets, or tubes for general industrial use and for use in further manufacture in Class 17
>
> Non-metallic building materials, namely, doors and windows; non-metallic rigid panels for building,

namely, wall panels, door panels, and ceiling panels; non-metallic transportable buildings in Class 19.[1]

The application (Serial No. 79015810), a request for extension of protection, was filed under the provision of Section 66(a) of the Trademark Act. 15 U.S.C. § 1144f(a). The application has a priority date of October 12, 2004.

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of a registered mark (No. 2692408 issued March 4, 2003) for NIDAPLAST, in typed or standard character form, for "semi-processed plastic with honeycomb core for the construction, manufacturing and transportation industries; weatherstripping for use in the construction, manufacturing and transportation industries; stuffing of plastic; insulating materials, namely, plastic padding for shipping containers" in Class 17. The registration is owned by Nidaplast-Honeycombs, a French limited liability company.

The examining attorney maintains that the marks are dominated by the term NIDA and that the "remaining portions of the marks, PLAST and CELL are highly suggestive of the term 'plastic,' of which registrant's goods are composed.

[1] The application contains three other classes of goods and services (1, 12, and 42) but there is no longer any refusal pending for these classes.

The term CELL is evocative of the appearance of applicant's goods made from honeycomb materials, which consist of a number of small cells." Brief at unnumbered pp. 8-9. The examining attorney also argues that:

> Applicant's identification does not limit the channels of trade or classes of purchasers for its semi-processed plastic goods and registrant does not limit the type or nature of its semi-processed plastic to indicate which forms it is offered. Because applicant's identification of goods encompasses "semi-processed plastic with honeycomb core for the construction, manufacturing and transportation industries," the goods are identical in part.

Brief at unnumbered p. 5. Also, "weatherstripping and insulating materials and doors, windows, building panels, and transportable buildings are of a kind that emanate from a single source." Brief at unnumbered p. 6.

Applicant maintains that its mark "differs from the cited mark NIDAPLAST visually, aurally and in meaning and commercial impression." Brief at 3. Applicant also argues that the "cited registration does not cover 'Building materials" (Brief at 6) and the its goods "do not overlap with the registrant's goods." Brief at 5.

After the examining attorney made the refusal final, this appeal ultimately followed.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d

1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

"The first *DuPont* factor requires examination of 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). Here, the marks are NIDACELL and NIDAPLAST. Inasmuch as the marks are depicted in typed or standard character form, there is no difference in the marks' displays, and they are also similar because they contain the same initial term, "Nida-." There is no evidence of record that indicates that this term has any relevant meaning, nor are we aware of any,[2] so we will presume that the term is arbitrary in relation to the identified goods.

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[2] We note that "Nida" is defined as "a female given name, form of Nydia." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987). We take judicial notice of this definition. *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). Applicant also submitted evidence that "Nida" is a surname. Request for Reconsideration dated December 12, 2006, Exhibit B. In addition, the fact that the term appears in a cancelled registration or an application does not support an argument that the term is weak or unlikely to be the dominant part of the mark. *In re Phillips-Van Heusen Corp.*,

The marks differ because the final portions of the marks are dissimilar. Applicant's final term is the word "-cell"; registrant's is "-plast." The examining attorney has argued that the endings "cell" and "plast" are highly suggestive of honeycomb materials made of small cells and plastic. We agree that the term "-plast" in the mark NIDAPLAST is likely to have a suggestive connotation when viewed in relation to the goods, semi-processed plastic. We note that applicant's press release describes its goods as "NIDACELL™, new honeycomb materials." www.solvaypress.com. The word "Honeycomb" is defined, inter alia, as:

> A structure of rows of hexagonal wax *cells*, formed by bees in their hive for the storage of honey, pollen, and their eggs.
>
> anything whose appearance suggests such a structure, esp. in containing many small units or holes: The building was a honeycomb of offices and showrooms.

The Random House Dictionary of the English Language (unabridged) (emphasis added). To the extent that "honeycomb" can be described as having a cell-like structure, potential purchasers are likely to understand

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63 USPQ2d 1047, 1049 n.4 (TTAB 2002) (application) and *Sunnun Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744, 1746-47 (TTAB 1987) (expired registration).

that the term "cell" would be at least somewhat suggestive of a feature of applicant's goods.

Moreover, inasmuch as the term "Nida-" has no apparent meaning for the goods at issue and it is the first term in both marks, it would be the dominant term. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005)("To be sure, CLICQUOT is an important term in the mark, but VEUVE nevertheless remains a 'prominent feature' as the first word in the mark and the first word to appear on the label. Not only is VEUVE prominent in the commercial impression created by VCP's marks, it also constitutes 'the dominant feature' in the commercial impression created by Palm Bay's mark"). The second portions of the marks do not significantly change the arbitrary meanings of the marks. Furthermore, the commercial impressions of the marks would also be similar inasmuch as they would point to plastic and honeycomb-like products from an entity that identifies its products by an initial "NIDA-" prefix. While the marks differ because of the concluding portions of the marks, the identical nature of the dominant portion results in marks that are similar in sound, appearance, meaning, and commercial impression when they are considered in their entireties. *Plantronics*

Inc. v. Starcom Inc., 213 USPQ 699, 702 (TTAB 1982) ("Accepting that the marks have differences in sound and appearance, they are identical in respect of their dominant features i.e. the prefix 'STAR'. Similarity of dominant features must be accorded greatest weight"). *See also In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (discussng *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992)) (JOSE GASPAR GOLD and GASPAR'S ALE held to be similar).

Next, we look at whether the goods of applicant and registrant are related. The registrant's goods are:

> semi-processed plastic with honeycomb core for the construction, manufacturing and transportation industries;
>
> weatherstripping for use in the construction, manufacturing and transportation industries;
>
> stuffing of plastic; and
>
> insulating materials, namely, plastic padding for shipping containers.

Applicant's goods are:

> Class 17 -
> Semi-processed plastic in the form of films, sheets, tubes, bars, or rods;
>
> packing, stopping and insulating resins in the form of bars, rods, sheets, or tubes for general industrial use and for use in further manufacture
>
> Class 19 -
> Non-metallic building materials, namely, doors and windows;

non-metallic rigid panels for building, namely, wall panels, door panels, and ceiling panels;

non-metallic transportable buildings

Applicant's "semi-processed plastic" is not limited to any specific industries and these plastics would include registrant's semi-processed plastic for the construction, manufacturing and transportation industries. We agree with the examining attorney that applicant's semi-processed plastic, as identified, would include plastic with a "honeycomb core." Therefore, these goods at least overlap at this point. When goods are identical, the marks do not need to be as close before there is a likelihood of confusion. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines"). Furthermore, when the goods overlap, the channels of trade and purchasers must also be presumed to overlap. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold

to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

In addition, the examining attorney points to registrant's website, which reports that: "Semi-finished product, nidaplast® honeycombs have been used as a core for sandwich panels (structural or not) in building, transport, capital good or the marine and leisure industries." www.nidaplast.com. Applicant argues that "[w]hether or not the registrant's web site indicates that the registrant's goods may be used as 'building materials' is not relevant here if the cited registration does not cover 'building materials.' And it does not." Brief at 6. While it is literally true that registrant's identification of goods does not include the word "building," it is clear that registrant's identified goods include plastics in the "construction [and] manufacturing … industries."[3] The examining attorney argues that a "consumer purchasing a

[3] Construct is defined as "to build or form by putting together parts." *The Random House Dictionary of the English Language (unabridged)*. If the examining attorney is also arguing that registrant is a source of finished products in the construction industry that are not in the identification of goods, we have not considered this as a factor in support of a likelihood of confusion in this case.

NIDACELL panel featuring a NIDAPLAST core is likely to believe that the core and finished panel emanate from a single source." Brief at unnumbered p. 5. To the extent that registrant's goods include "semi-processed plastic with honeycomb core for the construction, manufacturing and transportation industries" and, therefore, would include such items as cores for doors and applicant's goods would include plastic rigid panels for building, namely, wall panels, door panels, and ceiling panels," the goods are related. Moreover, registrant's and applicant's goods may be purchased by the same purchasers (door manufacturers) to assemble doors.

The examining attorney has also included several registrations to show that the goods of applicant and registrant are related. See, for example:

> No. 1836776 for, inter alia, "weatherstripping" and "doors and windows"
>
> No. 2371404 for "air filtration and weather barrier for use in building construction" and "non-metal windows; non-metal doors"
>
> No. 3060955 for "weatherstripping for doors" and "building materials, namely, non-metal door components, namely, sills, header, corner pads, astragals, caps and door bottoms"

These registrations suggest that weatherstripping and doors and parts for doors would be marketed by the same entity under a common mark. *In re Mucky Duck Mustard Co.*,

6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations are "not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may nonetheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source"). *See also In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993). We add that goods are related if they are marketed in such a way that it "could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services." *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). Here, the evidence suggests that these goods would originate from the same source and the same purchasers (*e.g.*, those engaged in a building project) are likely to purchase both weatherstripping and doors and parts for doors.

Another factor that applicant mentions is the sophistication of the purchasers. There is no doubt that if the purchasers of a product are sophisticated, this factor can significantly impact the question of likelihood of confusion. *In re Amsted Industries Inc.*, 972 F.2d 1326,

24 USPQ2d 1067, 1068 (Fed. Cir. 1992) ("[C]onsidering particularly the sophistication of wire rope purchasers, we are of the opinion that the concurrent use of the marks of the references and the mark sought to be registered is not likely to cause confusion or mistake or to deceive") (different color schemes associated with wire rope). In the present case, applicant has not submitted evidence that establishes the level of sophistication of the relevant purchasers. We point out that we are reluctant to assume that all purchasers of weatherstripping and doors and parts for doors would necessarily be sophisticated. Indeed, it appears that these purchasers could include ordinary homeowners involved in home improvement projects.

We also add that even if all purchasers were considered to be sophisticated, it does not by itself lead to a conclusion that there is no likelihood of confusion. *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999) ("We recognize applicant's attorney's point that its software is expensive and that purchasers of it are likely to be sophisticated. Suffice it to say that no evidence in support of these assertions was submitted. In any event, even careful purchasers are not immune from source confusion") and *In re Hester Industries, Inc.*, 231 USPQ 881, 883 (TTAB 1986) ("While we do not doubt that these

institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here, substantially identical marks are applied to related products"). When the goods are as closely related as in this case and the buyers are identical, even if the buyers are sophisticated, it is likely that there would be confusion when these purchasers encounter the marks NIDAPLAST and NIDACELL on the same goods.

Therefore, when we compared the marks NIDACELL and NIDAPLAST, we concluded that their similarities outweighed their differences. In addition, the goods are at least identical in part or related. When we consider all the evidence in this case relevant to the *du Pont* factors, confusion is likely here.

Decision: The refusal to register applicant's mark for the goods in Classes 17 and 19 under Section 2(d) of the Trademark Act is affirmed.