

THIS DISPOSITION IS  
NOT CITABLE AS  
PRECEDENT OF THE TTAB

Hearing:  
December 21, 2004

Mailed:  
May 26, 2005

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

Rutland Fire Clay Company, dba Rutland Products  
v.  
Joseph Enterprises and C.S.L., LLC, joined as party defendant

Opposition No. 91123898

Donald S. Holland of Holland & Bonzagni, P.C. for Rutland Fire  
Clay Company dba Rutland Products.

Paul Vapnek of Townsend and Townsend and Crew LLP for Joseph  
Enterprises and C.S.L., LLC.

Before Hanak, Holtzman and Rogers, Administrative Trademark  
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Joseph Enterprises and  
C.S.L., LLC, joined as party defendant, (applicant) to register  
the mark CHIMNEY SWEEPING LOG on the Principal Register ("LOG"

disclaimed) for "fireplace logs made of compressed wood fiber and being chemically treated" in International Class 4.<sup>1</sup>

Rutland Fire Clay Company, dba Rutland Products (opposer, Rutland Products, or Rutland) filed an opposition to registration of the mark in the above application. In the notice of opposition, opposer alleges that it has previously used, through its predecessor, CHIMNEY SWEEP in connection with repair, installation and maintenance of stoves, fireplaces and other heating systems since at least as early as August 7, 1941; that opposer's "products bearing its registered 'CHIMNEY SWEEP' trademark have been extensively and continuously offered to the public (since before Applicant's application)..."; and that opposer is the owner, by assignment, of Registration No. 405562 (issued February 8, 1944) for the mark shown below for "chemical powder used as a fire scale and soot eradicator" in International Class 6.

**CHIMNEY  
SWEEP**

Opposer alleges that applicant's mark CHIMNEY SWEEPING LOG when applied to applicant's goods so resembles opposer's previously used and registered "CHIMNEY SWEEP" mark as to be likely to cause confusion or mistake or to deceive.

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<sup>1</sup> Application Serial No. 76071935, filed on June 14, 2000, based on an allegation of a bona fide intention to use the mark in commerce.

Applicant, in its answer, has denied the salient allegations in the opposition.

The record includes the pleadings; the file of the involved application; the testimony of opposer's president, Thomas P. Martin, with exhibits that include a status and title copy of opposer's pleaded registration, and, by stipulation of the parties, two discovery depositions, with exhibits, of Mr. Martin (taken on April 15, 2002 and June 26, 2002); and the testimony of opposer's sales manager, Vicky Matteson, with exhibits that include, by stipulation, the discovery deposition of Ms. Matteson. Applicant's evidence consists of the testimony of its vice president, Michael P. Hirsch, with exhibits including, by stipulation, the discovery deposition of Mr. Hirsch; and a notice of reliance on opposer's responses to admission requests with attached documents including TARR printouts of third-party registrations, printouts of Internet search summaries and portions of third-party websites, and articles from printed publications.

Both opposer and applicant filed briefs. An oral hearing was held.

Before proceeding to the merits, some evidentiary issues need to be addressed. Opposer has objected to applicant's notice of reliance on TARR printouts of third-party registrations (Item 1, exhibits A, C, E, G and I) for marks that include "CHIMNEY

"SWEEP" arguing that the printouts are not complete records because, according to opposer, they do not include a listing of the goods and services and are not certified status and title copies of the registrations. This objection is not well taken. The printouts are indeed complete records and, moreover, third-party registrations are not required to be certified or contain status and title information in order to be considered properly of record. See TBMP §704.03(b)(1)(B) (2d ed. rev. 2004). Of course, though this evidence will be considered, it will be accorded only the probative value to which it may be entitled.

On the other hand, opposer has properly objected to applicant's notice of reliance on Internet search summaries and pages from third-party websites (Item 1, exhibits C, D, F, H, J and K). Such evidence is not proper subject matter for introduction by notice of reliance and accordingly will not be considered. See *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301 (TTAB 2004); and *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999). See also TBMP §704.08 (2d ed. rev. 2004).

In addition, opposer has objected, on hearsay grounds, to Item 1, exhibit B, and Item 3 of applicant's notice of reliance which consists of articles from publications entitled *Beacon* and *Hearth and Home*. Printed publications made of record by notice of reliance under Trademark Rule §2.122(e) are admissible but

probative only for what they show on their face, rather than the truth of the matters discussed therein. To the extent that applicant is relying on these articles for the truth of the matters contained therein, the articles will not be accorded any probative value. See TBMP §704.08 (2d ed. rev. 2004).

Applicant's objection to the introduction, during the testimony of Mr. Martin, of opposer's responses to applicant's document requests (exhibits 1-3) is sustained. Applicant's objection to the introduction of responses to applicant's interrogatories (exhibits 4-10) is overruled. See TBMP §704.10 (2d ed. rev. 2004) and *West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co.*, 2 USPQ2d 1306, 1308 n. 3 (TTAB 1987). Applicant's objections to exhibits 14-16 consisting of the USPTO documents reflecting the recordation of assignment documents relating to opposer's pleaded registration are overruled as those documents were properly introduced through the testimony of Mr. Martin. The documents were sufficiently identified by Mr. Martin and, as official records of the USPTO, are self-authenticating. See TBMP §704.07 (2d ed. rev. 2004). Moreover, offering this evidence on the record during a testimony deposition is the equivalent of offering it under a notice of reliance.

We turn then to the merits of this case. Opposer introduced, during the testimony deposition of Mr. Martin, a copy

of its pleaded registration for CHMINEY SWEEP (stylized) showing the status of the registration and ownership (by assignment) in opposer.<sup>2</sup> Therefore, opposer's standing has been established, and its priority with respect to the registered mark for the goods identified therein is not in issue. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, the evidence shows, and there is no dispute, that opposer has used the word mark CHIMNEY SWEEP in connection with creosote remover and soot remover products since at least as early as 1993 which predates applicant's June 14, 2000 constructive date of first use.

Opposer, Rutland Products, manufactures and sells a variety of home repair and stove and fireplace products including lines of products under the "RUTLAND" and "CHIMNEY SWEEP" brand names. Two of opposer's products in the "CHIMNEY SWEEP" line are the CHIMNEY SWEEP soot remover and CHIMNEY SWEEP creosote remover. These products are used to clean chimneys and, specifically, to

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<sup>2</sup> The Board takes judicial notice of the current status of opposer's pleaded registration and specifically that the registration was renewed for a third time on February 14, 2004. See TBMP §704.03(b)(1)(A) (2d ed. rev. 2004) [when a registration owned by a party has been properly made of record, and there are changes in the status of the registration between the time it was made of record and the time the case is decided, the Board will take judicial notice of, and rely upon, the current status of the registration as shown by the records of the USPTO].

Although applicant objected in its brief to opposer's introduction of the registration in this manner, the objection is overruled inasmuch as applicant had stipulated to its introduction during Mr. Martin's testimony deposition. Moreover, applicant specifically withdrew the objection at the oral hearing.

remove the build-up of soot and creosote from the chimneys of wood burning stoves and fireplaces. According to Mr. Martin, the product labeled as a soot remover is actually used to remove creosote as well as soot from the chimney, and it is a less potent version of the product sold specifically as a creosote remover.

The soot remover is available in 16-ounce and 38-ounce containers. It is a powdered product that is measured out and sprinkled on an active wood burning fire in a fireplace or in a wood stove. Mr. Martin states that the soot removal product should be used on a weekly basis.

The creosote remover is also a powdered product that is used by sprinkling it onto a wood burning fire. It is available in a one-pound and a two-pound container and is a higher strength version of the product labeled as a soot remover. Mr. Martin states that this product is used more for woodstoves, and where creosote is a more serious problem.

Mr. Martin explains that these products work through a chemical reaction; the heat from the fire carries the active ingredients in the products up the chimney where they "attach to the creosote and soot prevalent there and change it to a more ashlike [sic] structure that can then be removed from the chimney." Test. Dep., pp. 43-44.

According to Mr. Martin, the CHIMNEY SWEEP soot and creosote removal products are used primarily by homeowners who have wood burning fireplaces or wood burning stoves in their homes. Test. pp. 41-42. They are sold through sales representatives to retail outlets including hardware stores, home centers, mass merchandisers and fireplace specialty shops who in turn sell the products to the general public. The products are often displayed with other wood burning accessories, such as fireplace tools, within the heating sections of the stores. We have no direct evidence regarding the retail price of opposer's products but one of opposer's advertising circulars shows that a 16 oz. container of CHIMNEY SWEEP soot remover retails for under \$3.00.

Opposer advertises its goods to the public through retailers' print ads and direct mailings to consumers; and promotes its products to the trade through annual catalogs and at industry trade shows.

Like opposer's products, applicant's CHIMNEY SWEEPING LOG product is used to eliminate creosote that lines the chimney of a fireplace or the pipe of a wood stove.<sup>3</sup> Mr. Hirsch explains that

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<sup>3</sup> We note applicant's contention that its goods, as identified, are "fireplace logs," and that they should be compared with opposer's products solely on that basis without regard to the actual function they perform, i.e., creosote removal. However, applicant's fireplace logs are also identified as "being chemically treated" which raises a question, at least in our minds, as to the purpose and function of the product. Thus, we find it necessary and appropriate to turn to extrinsic evidence to make that determination. See *In re Trackmobile, Inc.*, 15 USPQ2d 1152, 1153-54 (TTAB 1990).

this product is a pressed log made up of sawdust, wax and certain chemicals that are melded together and that the chemicals in the log act as a creosote remover. According to Mr. Hirsch, when the log is burned, it produces an hour and a half fire in a fireplace or wood stove, and at the end of the burning of the log, the chemicals are released up into the chimney or stove flue, attach themselves to creosote, dry the creosote out and allow the soot to fall back into the chimney. There is no direct testimony as to how often the log should be used but the package for the product recommends use every 50 fires, or at least once a year.

Although the application was filed as an intent-to-use application, the record shows that applicant actually began using the mark CHIMNEY SWEEPING LOG in 2000 and that nearly four million logs have been sold since that time. Applicant sells its product to discount department stores, chain drugstores, home centers, supermarkets and hardware stores which in turn sell the products to the public. Applicant sells its fire log at retail for \$14.95, and the product is displayed either in the area of the store where other chimney logs or fireplace logs are located, or in the promotional aisle or near the checkout counter of the stores.

Applicant markets its CHIMNEY SWEEPING LOG product through advertisements on network television and promotes the product at industry trade shows attended by its retailers. The log is

promoted as an "As Seen on TV" product along with other such products marketed by applicant including the CHIA PET and the CLAPPER.

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, including the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Turning first to the goods, it is true that opposer's powdered chemical product and applicant's chemically treated fire log are distinctly different products. Applicant's product is a log with embedded chemicals whereas opposer's product is a powder that is sprinkled on burning wood logs. However, 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 (TTAB 1989). Thus, it is not necessary that the goods of the applicant and opposer be similar or even competitive to support a finding of likelihood of confusion. 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).

We find that the products, if not competitive, are at least closely related in the sense that they are used for precisely the same purpose and perform precisely the same ultimate function.<sup>4</sup> That is, they provide alternative methods for homeowners to clean the inside of their fireplaces and wood burning stoves.<sup>5</sup> Each product may have perceived advantages and disadvantages. Applicant's log performs a decorative as well as practical function but is more expensive and is only good for a single use. Opposer's powdered product, on the other hand, is less expensive and is good for multiple uses. While these differences may affect a consumer's decision to buy one product 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

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<sup>4</sup> Mr. Martin and Ms. Matteson testified that the respective products are competitive. Ms. Matteson did state, however, that she did not believe the products are "interchangeable" because in her view opposer's product would be used for ongoing maintenance whereas her perception of applicant's product is that it would only need to be used once a year or one time per season. Disc. Dep. p. 67.

<sup>5</sup> Although, as applicant points out, there is no mention of creosote removal on the front of the package for its goods, we note that the creosote removal function is fully described on the back of the package in the instructions for use.

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").

The evidence also shows that the respective products are sold in directly overlapping channels of trade to the same ultimate consumers, i.e., homeowners who have fireplaces and wood stoves. Contrary to applicant's contention, the overlap is significant. The parties sell their products to the same types of retail outlets, including home centers and hardware store chains and, in fact, to some of the very same hardware store chains. Mr. Martin and Ms. Matteson identified at least three hardware store chains that carry both the CHIMNEY SWEEP and CHIMNEY SWEEPING LOG products.<sup>6</sup> The two products may even be displayed in the same sections or aisles of those stores, such as the area where other logs or cleaners are located. In any event, both products might very well be encountered by the same purchasers in the same retail outlets, regardless of the specific location of each product in a particular store. Those consumers who had previously purchased opposer's powdered product and used it to remove creosote from the chimney, upon later encountering applicant's fireplace log which performs the identical function, regardless of where or when they found it, are likely to believe,

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<sup>6</sup> The identity of the particular stores is the subject of a stipulated protective order and thus is confidential.

if these products are sold under similar marks, that they emanate from the same source or that there is otherwise some connection or sponsorship.

Applicant contends that opposer's product, as a chemical, requires more expertise by the user and that as a result, opposer's soot and creosote remover are used more by professional chimney sweeps than the everyday consumers that purchase applicant's product. However, the evidence clearly shows that opposer's products are marketed to precisely the same purchasers as applicant's product,<sup>7</sup> and there is no evidence whatsoever that use of opposer's product requires any particular expertise or, in any event, any more expertise than any other chemical cleaning product used by consumers in the home. Furthermore, there is no evidence that either product would be purchased by such consumers with anything more than ordinary care.

We turn next to a consideration of the marks. We find that the marks, when considered in their entireties, are substantially similar in sound, appearance and meaning. Opposer's entire mark is the phrase CHIMNEY SWEEP.<sup>8</sup> A slight variation of that phrase,

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<sup>7</sup> Applicant incorrectly asserts, based on statements made by Mr. Martin during his discovery deposition, that opposer's CHIMNEY SWEEP products are marketed primarily to professional chimney sweeps. Mr. Martin was specifically referring to a creosote remover sold by opposer under a different mark, not the creosote remover sold under the CHIMNEY SWEEP mark. Disc. Dep., p. 19.

<sup>8</sup> In comparing the marks, neither party addressed the stylized version of opposer's mark as it appears in its pleaded registration. In view

"CHIMNEY SWEEPING," is visually and aurally the most significant portion of applicant's mark. Applicant's use of SWEEPING instead of SWEEP in its mark and its addition of the disclaimed and descriptive, if not generic, term "LOG" are insufficient differences on which to distinguish the marks as a whole.

The differences in sound and appearance between the two marks become even less significant when we consider that, in relation to the goods, the marks convey very similar, if not the same, meanings. As described by applicant, CHIMNEY SWEEPING LOG suggests the activity of cleaning or "sweeping" a chimney and CHIMNEY SWEEP suggests the person, a "chimney sweep," who performs this activity. Keeping in mind that the comparison of the marks is not made on a side-by-side basis and that recall of purchasers is often hazy and imperfect, it is the overall "chimney sweep" concept that purchasers are likely to remember when seeing these marks at separate times on closely related goods, not the slight difference in meaning. Moreover, applicant acknowledges in its brief that CHIMNEY SWEEP also suggests a product that cleans or "sweeps" a chimney, thus making the meaning of the two marks virtually the same. Brief, p. 12.

Applicant argues that opposer's mark is used in a manner on its containers, i.e., in varying colors, sizes, and placement,

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thereof, we will focus solely on opposer's typed version of the mark, which is, in any event, the closer of opposer's marks to the challenged mark.

that is completely different in appearance and commercial impression from the manner of use on the packaging for applicant's product. The actual manner of use is not relevant to our determination because both opposer and applicant are asserting rights to their marks in typed form. As such, the parties are not limited to a depiction of their marks in a particular color or form nor, in any event, to any particular size or placement of the marks on the packaging. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000) (typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce).

To the extent, if any, that opposer is claiming that its CHIMNEY SWEEP mark is strong and well-recognized by the public, we do not find opposer's evidence persuasive in this regard. Long use alone is insufficient to show public recognition of the mark, and opposer's evidence of the extent of exposure is not particularly significant. Opposer refers to Mr. Martin's statement in his discovery deposition that opposer has a large market share for creosote removing compounds (Brief, p. 10; Disc. Dep., p. 51) but opposer also sells creosote removal products under other marks including its house mark "RUTLAND," and there is no indication that Mr. Martin is specifically referring to the size of the market for opposer's CHIMNEY SWEEP line of products.

Opposer provided an estimate of advertising expenditures for only a one-year period and moreover could not identify what portion of the total amount was spent on products sold under the CHIMNEY SWEEP mark. With regard to sales, Mr. Martin indicated that half of opposer's business is in the stove and fireplace product line (Disc. Dep., p. 14) but based on Mr. Martin's testimony, it appears that only a very small percentage of that line is CHIMNEY SWEEP products. In addition, the sales figures for its CHIMNEY SWEEP products for the years 1999 through 2001 do not seem particularly impressive on their face and we have no context for these figures.<sup>9</sup>

On the other hand, applicant's contention, based on the appearance of "CHIMNEY SWEEP" in a number of third-party registrations, that the mark is so highly suggestive and commonly used that, in effect, it is entitled to virtually no protection is not convincing either.

To begin with, third-party registrations are not evidence of use. They may, of course, may be used to indicate that a commonly registered element has a suggestive meaning for particular goods or services such that differences in other portions of the marks may be sufficient to render the marks as a whole distinguishable. See, e.g., *Tektronix, Inc. v. Daktronics*,

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<sup>9</sup> Opposer's exact sales and advertising figures are the subject of a stipulated protective order.

Inc., 187 USPQ 588, 592 (TTAB 1975), aff'd, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976). However, none of the third-party registrations submitted by applicant is for similar products. They are all for chimney sweeping services. In fact, neither Mr. Martin nor Mr. Hirsch could identify a single third-party use of CHIMNEY SWEEP or variations thereof for similar products. We accordingly find that the additional elements in applicant's mark are not sufficient to adequately distinguish the parties' marks.

We recognize that the mark CHIMNEY SWEEP is suggestive of opposer's goods, and therefore not entitled to a broad scope of protection. However, the mark is at least entitled to protection from registration of applicant's very similar mark for closely related goods. See, e.g., King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974) (likelihood of confusion is to be avoided as much between weak marks as between strong marks).

Finally, we note opposer's claim that it has encountered a number of instances of actual confusion since applicant began use of its mark in 2000, but we find the evidence unpersuasive. Ms. Matteson testified that during at least six different trade shows potential customers approached the Rutland Products' booth either to inquire about or to try to purchase the CHIMNEY SWEEPING LOG. Rutland Products sells a wide variety of stove and fireplace

products, and these products are produced not only under the CHIMNEY SWEEP mark, but also under other marks including opposer's "RUTLAND" house mark. The problem is that it is not clear from Ms. Matteson's testimony, and the evidence is not sufficient to infer, that these individuals were even aware of opposer's CHIMNEY SWEEP mark and products when they inquired about or asked to purchase the CHIMNEY SWEEPING LOG. Therefore, we cannot determine whether they were actually confused as to the source of the products or whether their confusion was based simply on a mistaken assumption that opposer, as a stove and fireplace supply company, would naturally be expected to sell such products.

Nevertheless, it is not necessary to show actual confusion in order to establish a likelihood of confusion, and we find, in view of the similarity of the marks, and because the marks are used in connection with at least closely related goods that are sold in the same channels of trade to the same ultimate consumers, that confusion is likely.<sup>10</sup>

**Decision:** The opposition is sustained and registration to applicant is refused.

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<sup>10</sup> To the extent that opposer is arguing in its brief that the Board should presume bad faith merely on the basis of applicant's prior knowledge of opposer's mark, that argument is not well taken. Moreover, opposer confirmed at the oral hearing that it is making no such claim.