

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Hearing: January 11, 2007

Mailed: May 23, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

BFS Diversified Products, LLC
v.
L & P Property Management Company

Opposition No. 91151220
to application Serial No. 76277374
filed on June 27, 2001

Peter G. Mack of Foley & Larnder, LLP for BFS Diversified
Products, LLC.

Jonathan M. Pierce of Conley Rose, P.C. for L & P Property
Management Company.

Before Rogers, Taylor, and Bergsman, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

L & P Property Management Company filed a use-based application for the mark HARTEX for "carpet underlay" claiming January 1969 as its date of first use anywhere and first use in commerce.¹ BFS Diversified Products, LLC opposed the registration of applicant's mark on the ground of priority of use and likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d). Opposer alleged that applicant's mark HARTEX for "carpet underlay" so

¹ Application Serial No. 76277374, filed June 27, 2001.

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resembles opposer's mark HARTEX for pale crepe rubber and natural latex rubber as to be likely to cause confusion. Applicant denied the salient allegations in the notice of opposition. Both opposer and applicant have filed briefs and an oral hearing was held. For the reasons set forth below, we dismiss the opposition.

The Record

By operation of the rules, the record includes the pleadings and the application file for applicant's mark. The record also includes the following testimony and evidence:

A. Opposer's evidence.

1. The testimony deposition of John M. Vasuta, opposer's Vice President, General Counsel, and Secretary, with attached exhibits;
2. The testimony deposition of Rodney K. Blalock, a senior account executive for Firestone Natural Rubber Company, one of opposer's divisions, with attached exhibits;
3. The testimony deposition of Richard F. Stupp, Vice President of Sales and Marketing for Firestone Polymers, LLC, one of opposer's divisions, with attached exhibits;
4. Opposer's First Notice of Reliance on certified copies showing status and title of opposer's HARTEX registrations: Registration No. 701,581 for "pale crepe

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rubber"² and Registration No. 1,004,811 for "natural latex rubber";³

5. Opposer's Second Notice of Reliance on the following items:

- a. Applicant's responses to Interrogatories 7, 18, 19, and 24;
- b. Excerpts from printed publications; and,

6. Opposer's Third Notice of Reliance on dictionary definitions for the word "underlay."

B. Applicant's evidence.

1. The testimony deposition of Gene B. Kartchner, applicant's Vice President, with attached exhibits;

2. The testimony deposition of Norman Floyd Manning, applicant's Vice President in charge of carpet cushion sales, with attached exhibits;

3. The testimony deposition of Franklin Horwich, President and owner of Franklin Associates, a selling agent for applicant, with attached exhibits; and,

² Registration No. 701,581 was registered on July 26, 1960, claiming November 30, 1959 as the date of first use anywhere and first use in commerce. The registration has been renewed twice, most recently on July 26, 2000. Title is in the name of opposer.

³ Registration No. 1,004,811 was registered on February 18, 1975, claiming January 24, 1974 as the date of first use anywhere and first use in commerce. The registration has been renewed twice, most recently on February 18, 2005. Title is in the name of opposer.

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4. Applicant's Notice of Reliance on the following items:
- a. A certified copy showing status and title of Registration No. 865,405 for the mark HARTEX for "carpet cushion";⁴
 - b. A certified copy of an assignment of Registration No. 865,405 to Hartex Manufacturing Co. from Harper Manufacturing Co. recorded on May 8, 1985, at reel 494, frame 460;⁵
 - c. Opposer's Supplemental Responses to Applicant's First Set of Interrogatories: Interrogatory Nos. 1, 2, 6, 8, 15, 17, 21, 23, 24, and 27; and,
 - d. Opposer's Responses to Applicant's Second Set of Interrogatories: Interrogatory No. 1.

⁴ Registration No. 865,405 issued on February 25, 1969, claiming April 15, 1967 as the date of first use anywhere and first use in commerce. The registration expired in 1989.

⁵ Applicant's parent corporation, Leggett & Platt, Incorporated, acquired the HARTEX trademark and registration through an asset purchase agreement with O'Neill Brothers, Incorporated and its wholly owned subsidiary Hartex Manufacturing Co. dated June 26, 1986. (Kartchner Dep., pp. 11-16; Exhibit 55). An assignment of the HARTEX registration to Leggett & Platt, Incorporated dated July 3, 1986, was recorded in the U.S. Patent and Trademark Office Assignment Section on December 22, 1986, at reel 547, frame 994. (Kartchner Dep., p. 16; Exhibit 56). Subsequently, Leggett & Platt, Incorporated assigned the HARTEX trademark to applicant. (Kartchner Dep., p. 20).

Findings of Fact

A. Opposer

Opposer is a multi-division conglomerate better known as "Firestone".⁶ It owns Firestone Natural Rubber Company, a rubber manufacturer and sales company, as well as the Bridgestone/Firestone tire companies.⁷

Opposer uses the mark HARTEX to identify its natural rubber products. Natural rubber comes in solid and liquid forms. "Pale crepe rubber" is solid natural rubber. "Natural latex rubber" is liquid natural rubber.⁸ All of the HARTEX natural latex is produced on opposer's estates in Liberia, Africa.⁹ Further references to "rubber" in our decision include both solid natural rubber and natural latex rubber.

Opposer is the owner of Registration No. 701,581 for the mark HARTEX for "pale crepe rubber."¹⁰ Opposer has been using its HARTEX mark for pale crepe rubber since at least as early as 1959.¹¹ Opposer sells its solid rubber to its sister tire companies.¹²

⁶ Vasuta Dep., p. 8.

⁷ Vasuta Dep., pp. 10, 19; Stupp Dep., pp. 55-56.

⁸ Vasuta Dep., pp. 33-34, and 66; Stupp Dep., pp. 17, 38, 72.

⁹ Stupp Dep., pp. 22, 59.

¹⁰ Opposer's First Notice of Reliance; Vasuta Dep., p. 30; Exhibit 5.

¹¹ Vasuta Dep., Exhibit 12; Stupp Dep., pp. 17-18.

¹² Vasuta Dep., pp. 78-79; Stupp Dep., pp. 18-19.

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Opposer is also the owner of Registration No. 1,004,811 for the mark HARTEX for "natural latex rubber."¹³ Opposer has been using its HARTEX mark for natural latex rubber since at least as early as 1974.¹⁴ Technical expertise is required to keep the natural rubber in a liquid state because it naturally coagulates.¹⁵ Opposer sells its natural latex rubber to internal and external customers.¹⁶ External customers include the medical field, the carpet industry for manufacturing of carpet backing, and the dip goods industry (e.g., rubber gloves and condoms).¹⁷ By "carpet backing," opposer is referring to the foundation upon which carpets are placed and also to carpet padding.¹⁸

Opposer's HARTEX rubber is well known in the rubber industry and with opposer's customers for its high quality.¹⁹ Because of opposer's quality control, HARTEX latex rubber is known for its purity, cleanliness, and consistency.²⁰ Accordingly, opposer's HARTEX brand latex

¹³ Opposer's First Notice of Reliance; Vasuta Dep., pp. 31-32; Exhibit 6.

¹⁴ Vasuta Dep., p. 82; Exhibit 15; Stupp Dep., p. 72. Rodney Blalock testified that when opposer first employed him in 1972, opposer was selling HARTEX natural latex. (Blalock Dep., pp. 58-59).

¹⁵ Vasuta Dep., pp. 35-36; Blalock Dep., pp. 43-44, Exhibit 28; Stupp Dep., pp. 20-22, 54.

¹⁶ Vasuta Dep., pp. 78-79.

¹⁷ Deposition of John Vasuta, pp. 19-20.

¹⁸ Vasuta Dep., p. 20.

¹⁹ Vasuta Dep., pp. 38-39

²⁰ Blalock Dep., pp. 21-22, 69.

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rubber commands a premium price in comparison to competitive rubber.²¹

There are two main suppliers of rubber in the United States: opposer and Centrotrade, a European company. Opposer and Centrotrade control approximately 70-75% of the rubber market in the United States.²² Specifically, HARTEX natural latex has approximately 40% of the U.S. latex market.²³ That translates to approximately \$35 million in sales.²⁴ HARTEX natural latex is the largest selling brand of natural latex in the United States.²⁵

Generally, customers purchase opposer's HARTEX natural latex rubber by the tanker truck or railroad tanker car ("they buy it by the tanker load predominantly").²⁶ The rubber is shipped in 10,000 or 20,000-gallon railroad cars and transferred to 5,000-gallon trucks.²⁷ Ninety-eight percent (98%) of the sales to the carpet industry are in the 5,000-gallon tank trucks.²⁸ Opposer will also ship HARTEX

²¹ Vasuta Dep., p. 40; Blalock Dep., 23.

²² Vasuta Dep., p. 70; Blalock Dep., pp. 18 and 57; Stupp Dep., p. 24. Mr. Vasuta estimated that opposer and Centrotrade controlled 90% of the market, but Mr. Blalock, a senior account executive responsible for selling HARTEX natural latex, appears more knowledgeable regarding the latex market than Mr. Vasuta, an attorney responsible for opposer's intellectual property.

²³ Blalock Dep., p. 15; Stupp Dep., pp. 92, 131.

²⁴ Blalock Dep., p. 17.

²⁵ Blalock Dep., pp. 17-18; Stupp Dep. p. 24.

²⁶ Vasuta Dep., pp. 74-75 and 79; Blalock Dep., pp. 71-72; Opposer's response to Interrogatory No. 6.

²⁷ Blalock Dep., p. 8, Exhibit 31.

²⁸ Blalock Dep., pp. 73, 75.

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in tote bins (*i.e.*, 275 gallon plastic containers placed inside a steel cage) and in 55-gallon drums.²⁹

Rodney Blalock, a senior account executive, is responsible for selling HARTEX natural latex rubber from coast-to-coast throughout the southern United States.³⁰ There is one other account executive that sells HARTEX throughout the northern United States.³¹ HARTEX is sold only through opposer's two-person sales force.³² As indicated *supra*, HARTEX natural latex is sold to the carpet industry, the dip goods industry, the adhesives and coatings industry, and other miscellaneous fields.³³ The dip goods industry includes condoms, catheters, medical tubing, and balloons.³⁴ Because there are only a limited number of companies that use natural latex, opposer's account executives make regular sales calls on these accounts to discuss their product needs and pricing.³⁵

The carpet industry is opposer's largest customer for its HARTEX natural latex rubber.³⁶ It purchases

²⁹ Blalock Dep. p. 72. The 55-gallon drums are a very small percentage of sales. Blalock Dep., p. 102.

³⁰ Blalock Dep., p. 11.

³¹ Blalock Dep., p. 70. Therefore, if someone wanted to purchase a small amount of HARTEX or open a new account, they would have to contact either Mr. Blalock or Mr. Bailey, the second account executive. Blalock Dep., p. 70.

³² Blalock Dep., p. 81.

³³ Blalock Dep., pp. 11 and 13; Stupp Dep., p. 29.

³⁴ Blalock Dep., p. 13; Stupp Dep., p. 29.

³⁵ Blalock Dep., pp. 69-70.

³⁶ Blalock Dep., pp. 14 and 26; Stupp Dep., pp. 29, 31-32. Carpet industry sales are exclusively natural latex. (Blalock Dep., p. 53). Opposer has never sold natural solid rubber to compounders

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approximately 25% of opposer's HARTEX natural latex rubber. Accordingly, opposer maintains a shipping terminal in Savannah, Georgia to be close to the carpet industry that is concentrated in and around Dalton, Georgia.³⁷ HARTEX natural latex rubber is used to make carpet backing and carpet padding. Carpet backing includes "the coatings for the back of carpets to give them nonskid qualities and cushioning."³⁸ With respect to automotive carpeting, HARTEX natural latex provides sound barriers and extra padding.³⁹ HARTEX natural latex is also used in carpet underlays to provide a nonskid surface and padding.

Because the carpet industry is a volume purchaser of latex, its purchasers generally demand price concessions. However, because opposer can charge a premium for its HARTEX natural latex rubber, opposer has been selling an increasing percentage of its product to the dipped goods industry because dipped goods require higher quality latex than the carpet industry.⁴⁰ Nevertheless, the carpet industry still purchases approximately 25% of opposer's HARTEX natural latex.⁴¹

for the carpet industry, carpet mills, carpet wholesalers or retailers, or carpet installers. (Blalock Dep., pp. 63-64).

³⁷ Blalock Dep., pp. 22 and 26; Stupp Dep., p. 139.

³⁸ Blalock Dep., p. 14.

³⁹ Blalock Dep., p. 14.

⁴⁰ Blalock Dep., pp. 27-29, 84-85.

⁴¹ Blalock Dep., p. 28.

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Opposer's carpet industry customers are material compounders. Compounders have the technical expertise to process the natural latex rubber and combine it with other products to make compounds used in carpet backings and padding. There are several formulations of HARTEX natural latex available to users depending upon their requirements.⁴² Carpet mills do not compound their own latex because there is too much risk involved. "The compounder provides technical services, expertise geared to the specific carpet mills."⁴³ Opposer has made only one sale of natural latex directly to a carpet mill.⁴⁴

Opposer advertises its HARTEX rubber in Rubber World, a technical magazine for the rubber industry, and Rubber & Plastics News, a newspaper for the rubber industry. These publications are directed to manufacturers of rubber products, industrial users of rubber products, and rubber suppliers.⁴⁵ Opposer promotes its HARTEX natural latex at the International Latex Conference and the ACS (American Chemical Society) Rubber Division Rubber Expo.⁴⁶

⁴² Stupp Dep., pp. 53-54; Exhibits 30, 42, 43.

⁴³ Blalock Dep., pp. 32-33.

⁴⁴ Blalock Dep., pp. 31-33, 64-66; Stupp. Dep., p. 52. "I sell to the compounder, who sells to companies that make some padding that is stand-alone." Blalock Dep., p. 54.

⁴⁵ Opposer's Second Notice of Reliance, Exhibits E and F; Blalock Dep., pp. 37-38; Exhibit 27. In this advertisement, HARTEX is displayed in text with an upper case "H". However, the FIRESTONE logo is prominently featured.

⁴⁶ Blalock Dep., pp. 45 and 76; Stupp Dep., p. 96; Opposer's Response to Interrogatory No. 8.

Opposer's promotion of HARTEX natural latex has been conducted under the umbrella of Firestone Polymers and it has typically been promoted in connection with other Firestone products. Accordingly, opposer is unable to apportion advertising expenditures dedicated to the HARTEX brand.⁴⁷ All of opposer's advertisements, invoices and bills of lading feature the FIRESTONE trademark.⁴⁸

Opposer's witnesses have no knowledge whether any manufacturer of finished products, including carpet manufacturers who sell carpet backing and padding, ever specifies or identifies that its products are made from HARTEX rubber.⁴⁹ However, Mr. Blalock did recall that in the late 1970's there was a labeling program where an iron-on label was placed on a carpet pad identifying Firestone synthetic latex as a component.⁵⁰ Opposer does not license the use of the HARTEX mark to others.⁵¹

B. Applicant

Applicant, a wholly owned subsidiary of Leggett & Platt, Incorporated, is a holding company responsible for managing its parent corporation's property, including intellectual property such as the HARTEX trademark.⁵²

⁴⁷ Blalock Dep., pp. 51-52; Stupp Dep. 93-94.

⁴⁸ Blalock Dep., pp. 77-78; Stupp Dep. 36-37; Exhibits 38, 45-52.

⁴⁹ Vasuta Dep., pp. 62-63; Blalock Dep., pp. 55-56.

⁵⁰ Blalock Dep., pp. 98 and 105-106.

⁵¹ Vasuta Dep., p. 77; Opposer's Response to Interrogatory No. 24.

⁵² Kartchner Dep., p. 7.

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Leggett & Platt, Incorporated commercializes the HARTEX carpet underlay pursuant to a license agreement with applicant.⁵³

Applicant began using the mark HARTEX in connection with its carpet underlay in 1969 and its use has been continuous.⁵⁴ Carpet underlay is a mat or cushion placed between the floor and carpet.⁵⁵ From 1986 through 1990, HARTEX carpet underlay was manufactured in East Point, Georgia. In 1990, the manufacturing process was moved to Villa Rica, Georgia. Today, HARTEX is manufactured in Nashville, Tennessee, Mexia, Texas, Villa Rica, Georgia, and Conover, North Carolina.⁵⁶

Applicant's HARTEX carpet underlays are sold for use with wall-to-wall carpets used in high traffic areas such as hotels, office buildings, timeshares, banks, and other commercial applications.⁵⁷ Applicant markets HARTEX carpet underlays to people responsible for purchasing or specifying furniture, fixtures, and equipment in those industries, as

⁵³ Kartchner Dep., pp. 7 and 21-23.

⁵⁴ Opposer's Second Notice of Reliance, Applicant's response to Interrogatory No. 24. Norman Manning testified that applicant began selling HARTEX carpet underlays upon the closing of the O'Neill Brothers acquisition in 1986. (Manning Dep., p. 19). Mr. Manning further testified that he was personally familiar with HARTEX carpet underlays since 1977 when he worked for Steiner-Liff, a competitor of Hartex Manufacturing Co. (Manning Dep., pp. 92-97, 105, 135-138).

⁵⁵ Kartchner Dep., p. 8; Manning Dep., p. 11.

⁵⁶ Manning Dep., pp. 12-16.

⁵⁷ Manning Dep., pp. 16-17, 30.

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well as interior designers.⁵⁸ Approximately 25% of applicant's HARTEX carpet underlays are sold to the Hilton, Hampton Inn, and Hyatt hotel chains, as well as the Higgins design firm.⁵⁹ Applicant's carpet underlay is not used as matting or cushioning for area rugs or for use in automobiles.⁶⁰ HARTEX carpet underlays are not sold to any compounders or carpet mills.⁶¹

HARTEX carpet underlays are made from recycled, synthetic fibers that applicant collects from carpet mills in the Dalton, Georgia area. Dalton, Georgia is the center of the carpet industry in the United States. The fibers are shredded and then reformulated into a pad. HARTEX carpet underlays do not contain any rubber.⁶² Carpet cushions made from synthetic fibers are superior to cushions made from rubberized hair jute because they do not contain any deteriorating products and, therefore, when they get wet they will not develop mold, mildew, or odor.⁶³

In 2005, applicant acquired a company that manufactures and sells a synthetic latex rubber carpet cushion for use in

⁵⁸ Manning Dep., p. 30.

⁵⁹ Manning Dep., p. 31. Prior to 1998, applicant sold its HARTEX carpet underlays to carpet retailers and distributors. In 1998, applicant changed its business model and focused its sales on the hospitality industry. (Manning Dep., pp. 129-130).

⁶⁰ Manning Dep., p. 17.

⁶¹ Manning Dep., p. 17.

⁶² Manning Dep., pp. 17-18, 100-101.

⁶³ Manning Dep., pp. 115-116.

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high traffic areas. However, the synthetic latex rubber carpet cushion is not sold under the HARTEX mark.⁶⁴

Carpet underlays and carpet backing are different products. Carpet backing is a component of a carpet product (*i.e.*, it is attached to the carpet) whereas a carpet underlay is never attached to the carpet.⁶⁵

HARTEX carpet underlays are sold by the square yard. In 2005, applicant sold approximately three million square yards of HARTEX carpet underlays. Because the average sale price is between \$1.25 and \$1.50 per square yard, in 2005, applicant's revenues for HARTEX carpet underlays were between \$3,750,000 and \$4,500,000.⁶⁶ HARTEX sales have been growing at approximately 5% a year.⁶⁷

HARTEX carpet underlays were the original synthetic fiber carpet cushions, and the HARTEX brand enjoys significant name recognition. Within the hotel industry, carpeting contracts often specifically request the HARTEX brand carpet underlay.⁶⁸

Applicant promotes its HARTEX carpet underlays in the following manner:

⁶⁴ Manning Dep., pp. 143-150; 164; Exhibits 96-101.

⁶⁵ Manning Dep., p. 18.

⁶⁶ Manning Dep., p. 25.

⁶⁷ Manning Dep., p. 26.

⁶⁸ Manning Dep., pp. 31-33. Mr. Manning testified that the HARTEX brand is specified in approximately 75% of applicant's sales. (Manning Dep., p. 123).

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1. Advertisements in trade publications such as Interior Design, Flooring, Floor Covering Weekly, Western Floors, Eastern Floors, Hotel Business, Hotel and Motel Management, and Architectural Digest;⁶⁹
2. Exhibits at trade shows;⁷⁰ and,
3. Distribution of architect kits.⁷¹

With respect to trade shows, applicant attends and exhibits at the International Hotel and Motel Show in New York City, the Hospitality Design Show in Las Vegas, and the HD Boutique in Miami. In addition, applicant exhibits at trade shows organized by its customers, such as Best Western, Hilton, and others. Applicant has never exhibited at the International Rubber Congress or ACS Rubber Division Expo trade shows.⁷² Applicant promotes HARTEX carpet underlays at the trade shows through samples, advertisements, brochures, and architect kits.⁷³ Applicant's promotional materials reference Leggett & Platt.⁷⁴

⁶⁹ Manning Dep., pp. 35-36.

⁷⁰ Manning Dep., p. 35.

⁷¹ Manning Dep., p. 35. An architect kit is a large brochure with small samples of product sent to architects and designers to promote HARTEX carpet underlays. (Manning Dep., p. 62).

⁷² Manning Dep., pp. 69, 151-152. Applicant's customers organize and conduct trade shows where their approved suppliers exhibit their products for franchisees. Manning Dep., p. 73.

⁷³ Manning Dep., p. 70.

⁷⁴ Manning Dep., p. 36; Exhibits 66, 67, 69-75, 77-80.

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Applicant sells its HARTEX carpet underlays through its own salespeople and through sales agents.⁷⁵ Franklin Associates has been a sales agent for applicant's HARTEX carpet underlays since the early to mid-1980s.⁷⁶ It represents applicant in the greater Chicago metropolitan area and in parts of the Midwest. Franklin Associates sells the HARTEX carpet underlays to carpet stores and department stores in the Chicago metropolitan area and throughout the Midwest.⁷⁷ With reference to the hospitality industry, Franklin Associates represents applicant nationwide.⁷⁸ Franklin Associates also sells sponge rubber carpet underlays manufactured by Sponge Cushion, Inc.⁷⁹

C. Miscellaneous facts.

Opposer's witnesses are not aware of any company that sells carpet backing, carpet padding, carpet underlay and natural latex.⁸⁰ In addition, prior to this proceeding, opposer's witnesses were not aware that applicant sold HARTEX brand carpet underlay.⁸¹ By the same token, prior to this proceeding, applicant's witnesses were not aware of opposer's HARTEX rubber products or that HARTEX latex rubber

⁷⁵ Manning Dep., pp. 78-80.

⁷⁶ Horwich Dep., pp. 11, 15. Franklin Associates originally sold HARTEX carpet underlays for Harper Manufacturing Co. (Horwich Dep., p. 12).

⁷⁷ Horwich Dep., p. 35.

⁷⁸ Horwich Dep., pp. 18, 21, 28.

⁷⁹ Horwich Dep., pp. 35, 36

⁸⁰ Blalock Dep., p. 58.

⁸¹ Blalock Dep., p. 103.

had been used as an ingredient of carpet backing or padding.⁸²

Neither opposer, nor applicant, was aware of any reported instances of confusion or instances of persons mistakenly associating HARTEX natural latex and applicant's HARTEX carpet underlay.⁸³

Standing

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

⁸² Manning Dep., pp. 99-100; Horwich Dep., p. 32.

⁸³ Blalock Dep., 85-86; Opposer's Response to Interrogatory No. 21; Horwich Dep., p. 42.

Likelihood of confusion

Our determination of likelihood of confusion under Section 2(d) of the Lanham Act is based on an analysis of all the 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, 567 (CCPA 1973). The relevant *du Pont* factors are discussed below.

A. Similarity or dissimilarity of the marks.

Because the marks are identical, the similarity of the marks is a factor that weighs heavily in favor of finding a likelihood of confusion.

B. Similarity or dissimilarity of the goods.

Opposer uses HARTEX for pale crepe rubber and natural latex rubber. Applicant uses HARTEX for carpet underlays. Although natural latex rubber may be used as a component for carpet backing, that fact alone is insufficient to establish a commercial relationship between opposer's rubber and applicant's carpet underlays (*i.e.*, that rubber and carpet underlay emanate from a single source). Where, as here, the goods of the opposer are distinctly different from those of the applicant, it is the opposer's burden to prove that the goods of the parties are related in some manner or that the conditions surrounding the marketing thereof are such that they would be likely to be encountered by the same persons

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under circumstances that give rise to the mistaken belief that they originate with the same source. *Pasco, Inc. v. Diamond Shamrock Corporation*, 191 USPQ 59, 63 (TTAB 1976).

Opposer has failed to sustain its burden of proof on this factor. We are not persuaded that simply because rubber may be a component of carpet backing that rubber and carpet underlays are related. See *Cooper Industries, Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81, 84 (TTAB 1983) (the mere fact that products with significant differences in character are sold in the same industries does not itself provide an adequate basis to find that they are related). Opposer has failed to show that any company sells both rubber and carpet underlays (let alone under the same or similar marks). There is no evidence that any carpet manufacturer promotes HARTEX rubber (or any rubber) as a component of its carpet backing, cushion, or underlay. Moreover, although opposer has provided testimony that its rubber is a superior product, there is no evidence that carpet purchasers care about the rubber in carpet backing.⁸⁴ While opposer argued that it has promoted and marketed its HARTEX rubber as a key component of carpet backing and padding, those advertisements are directed to purchasers of

⁸⁴ We note that although a carpet manufacturer may care about the quality of the rubber used in the carpet (e.g., carpet backing used in automobile carpets for sound insulation and cushioning), those in the carpet industry may be more concerned about volume pricing.

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rubber as opposed to purchasers of carpet backing and padding. In other words, opposer has not promoted its rubber to purchasers of carpet backing and padding, but to manufacturers of such products and to rubber compounders. Finally, prior to this proceeding, neither party was aware of the other party even though they have purportedly been concurrently selling their products in the carpet industry since at least as early as the 1970s. Under these circumstances, the mere potential use of rubber, particularly latex rubber, as an ingredient of carpet backing and carpet padding does not establish the type of relationship between the products of the parties that is likely to lead to confusion of source in the marketplace.

In view of the foregoing, the similarity or dissimilarity of the goods is a factor that weighs against finding a likelihood of confusion.

C. The similarity or dissimilarity of established, likely to continue trade channels.

The differences in the parties' products are even more significant in light of how opposer and applicant do business. Opposer sells its natural latex rubber to "compounders," who have the technical expertise to process the product for use by carpet mills. Carpet mills do not process the natural rubber themselves. The latex rubber is shipped to the compounders in 5,000-gallon tank trucks.

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Opposer advertises and promotes its products in magazines and newspapers directed to the rubber industry and companies that use rubber in their products. In addition, it promotes its natural latex rubber at International Latex Conference and the ACS (American Chemical Society) Rubber Division Rubber Expo.

Applicant, on the other hand, sells its carpet underlays for use with wall-to-wall carpets used in high traffic areas such as hotels, office buildings, timeshares, banks and other commercial applications. Nevertheless, because applicant's description of goods is not limited in any way, we must construe applicant's carpet underlays as potentially being sold anywhere such products are normally sold (e.g., carpet and rug retailers and distributors).⁸⁵

Applicant advertises and promotes its carpet underlays in hospitality trade magazines, interior designer magazines, and flooring magazines. It exhibits its HARTEX carpet underlays at hospitality industry trade shows.

Based on the record in this case, there is no evidence that purchasers of carpet underlay are exposed to opposer's mark or that purchasers of rubber, particularly latex rubber, are exposed to applicant's mark. Accordingly, we find that opposer's rubber and applicant's carpet underlay

⁸⁵ We note that applicant's sales agent Franklin Associates sells HARTEX carpet underlays to carpet retailers and distributors in the Chicago metropolitan area and throughout the Midwest.

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are not sold to the same consumers. In view of the foregoing, opposer's HARTEX rubber and applicant's HARTEX carpet underlays move in different channels of trade. Therefore, the channels of trade factor weighs against finding that there is a likelihood of confusion.

D. The conditions under which and buyers to whom sales are made.

The inherent nature of purchasing natural rubber, specifically natural latex rubber that is used in the carpet industry, dictates that purchasers will be sophisticated and exercise a high degree of care. As noted above, 98% of the purchases by compounders for use in the carpet industry are through 5,000-gallon tank trunks. This means that the compounders must have the capability and expertise to handle and store large quantities of liquid rubber, particularly because liquid latex has the tendency to naturally coagulate. In addition, since there are several HARTEX natural latex formulations, the compounders need to know the qualities and characteristics of each in order to choose the best formulation for their application. The compounders are knowledgeable purchasers who have a specific purpose or plan for the HARTEX natural latex.

Because there are only a limited number of companies that use natural latex, opposer's two account representatives responsible for the sale of HARTEX natural latex make regular, personal sales calls on their natural

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latex rubber accounts to discuss customer requirements and pricing. HARTEX sales are personal sales by knowledgeable persons who ensure that the carpet industry compounders know that they are purchasing genuine HARTEX natural latex from opposer.

Finally, because HARTEX natural latex rubber is a high quality product, opposer charges a premium. On the other hand, the rubber compounders in the carpet industry are a volume purchaser of latex, and they demand price concessions. Accordingly, over time, the percentage of opposer's HARTEX natural latex sold in the carpet industry rubber compounders has been declining. Under these circumstances, carpet industry rubber compounders will exercise a high degree of care before purchasing the higher priced HARTEX natural latex.

As noted above, applicant's HARTEX carpet underlays are sold for use in wall-to-wall carpet applications for high traffic areas such as hotels, office buildings, timeshares, banks, and other commercial applications. The people responsible for fixtures, furniture and equipment in the hospitality field are the ones who purchase applicant's HARTEX carpet underlays. These would be professional buyers with a focused need for applicant's product.

Applicant sells its HARTEX carpet underlays through its own salespeople and through sales agents such as Franklin

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Associates. Franklin Associates has been selling HARTEX carpet underlays since the early to mid-1980s. Accordingly, knowledgeable sales persons, touting the reputation of applicant and its products, sell applicant's HARTEX carpet underlays.

Both opposer and applicant sell their products to knowledgeable consumers under conditions calculated to ensure care in discerning the source of the goods. Under the sales circumstances described above, we perceive little chance of confusion as to source to occur. Accordingly, the conditions under which and buyers to whom sales are made is a factor that weighs against finding that there is a likelihood of confusion. We would not conclude otherwise, even if we were to focus on theoretical sales of applicant's carpet underlays to carpet retailers or distributors, as opposed to the commercial or hospitality industries, for such purchasers would be no more likely than applicant's actual customers to also be purchasers of natural latex rubber or pale crepe rubber.

E. The fame of opposer's HARTEX mark.

Opposer's HARTEX natural latex rubber is well known in the rubber industry for its consistent high quality. Opposer controls over half of the U.S. market for natural rubber, including approximately 40% of the natural latex market. That translates to approximately \$35 million in

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sales per year, making HARTEX natural latex the largest selling natural latex in the United States. However, the record does not show that the public recognition and renown of opposer's HARTEX mark extends beyond the rubber industry or, specifically, to carpet underlays. Accordingly, this factor does not make confusion more likely. It is neutral.

F. The number and nature of similar marks in use on similar goods.

Opposer's HARTEX mark is an inherently strong mark because it is a coined term derived from the combination of the name of opposer's principal (Harvey Firestone) and/or the name of opposer's rubber estate (Harbel) and latex.⁸⁶

There is only one other active registration for HARTEX: Registration No. 824,525 for canned fruit and tomato sauce.⁸⁷

There is no evidence of record regarding third party use of any marks similar to HARTEX in connection with rubber or carpet underlays.

This is a factor that favors opposer, but it does not necessarily make confusion more likely.

G. The nature and extent of any actual confusion and the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

Despite at least twenty (20) years, and possibly as many as thirty-eight (38) years, of concurrent use and

⁸⁶ Vasuta Dep. pp. 41-42; Stupp Dep., pp. 37-38).

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millions of dollars in sales enjoyed by each party for products used in the carpet industry which is centralized in and around Dalton, Georgia, opposer was unable to show any reported instances of actual confusion. In fact, opposer was not aware of the existence of applicant and its use of the HARTEX trademark prior to the publication of the mark for opposition, again notwithstanding applicant's use of the mark HARTEX since at least as early as 1986, sales of approximately three million square yards of carpet underlay generating revenues of approximately \$4,000,000, and an open and notorious presence in the center of the carpet industry. The absence of actual confusion under the circumstances presented on this record underscores that the dissimilarity of the goods and the trade channels, as well as the degree of care exercised by the relevant consumers, greatly reduces or negates any possibility of confusion. Although opposer argues that proof of actual confusion is not necessary to show likelihood of confusion (e.g., *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1662 (TTAB 2002); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738, 742 (TTAB 1978)), its absence in this case strongly reinforces the lack of a likelihood of confusion.

Where, as here, there has been considerable activity by the parties under their respective marks over a long period

⁸⁷ Vasuta Dep., Exhibit 4.

of time, it may be assumed with some reasonable degree of certainty that if confusion has not occurred in the past, the chances for confusion to result in the future are slim. *Haveg Industries, Incorporated v. Shell Oil Company*, 199 USPQ 618, 626 (TTAB 1978). Accordingly, the lack of actual confusion is a factor that weighs against finding likelihood of confusion.

H. Balancing the factors.

If, as argued by opposer, the goods are closely related (Opposer's Brief, p. 35), and the parties "operate in interrelated trade channels, namely, carpet industry channels; and the end use, carpet underlay, is the same or virtually the same" (Opposer's Brief, p. 38), the question that cries out is why there have not been any reported instances of confusion or misdirected inquiries coming to the attention of the parties. That question can be answered by a combination of factors that include the following:

1. Opposer's rubber and applicant's carpet underlays are distinctly different products;
2. The products move in different channels of trade; and,
3. Knowledgeable and technically oriented individuals purchase rubber and carpet underlays.

Pursuant to the record established in this case, opposer's rubber products and applicant's carpet underlays are used in such different settings that the parties have been able to live side-by-side for at least twenty years without

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conflict. Moreover, there is nothing in the record to indicate that this market distinction is not likely to continue in the future. Accordingly, HARTEX, when used in connection with carpet underlays, is not likely to cause confusion with HARTEX used in connection with natural rubber.

Decision: The opposition is dismissed with prejudice.