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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Glacier Northwest, Inc.

Serial Nos. 75/672,578, 75/672,573, 75/878,230 & 75/878,231

William O. Ferron, Jr. and David W.C. Chen of Seed
Intellectual Property Law Group, PLLC for Glacier Northwest,
Inc.

Idi Aisha Clarke, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Hanak, Hohein and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Glacier Northwest, Inc.¹ seeks registration on the
Principal Register for the mark GLACIER NORTHWEST for
"concrete additives sold in bulk" in International Class 1;²

¹ Although the two first-filed applications involved herein
(March 1999) were filed by Lone Star Northwest, Inc., applicant's
change of name to Glacier Northwest, Inc. was correctly recorded
with the Assignment Division of the United States Patent and
Trademark Office at Reel 2105, Frame 0605.

² Application Serial No. 75/672,578, filed on March 31, 1999,
is based upon applicant's allegation of use of the mark in
interstate commerce at least as early as November 1, 1998. In

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for the mark GLACIER NORTHWEST for "building materials, namely stone, gravel, sand and concrete all sold in bulk," in International Class 19;³ for the mark GLACIER NORTHWEST and design, as shown below, for "concrete additives," in International Class 1;⁴ and for the mark GLACIER NORTHWEST

response to the requirement of the Trademark Examining Attorney to disclaim the word NORTHWEST, applicant instead submitted a claim of acquired distinctiveness for the entire composite mark under Section 2(f) of the Act, which showing was accepted by the Trademark Examining Attorney.

³ Application Serial No. 75/672,573, filed on March 31, 1999, is based upon applicant's allegation of use of the mark in interstate commerce at least as early as November 1, 1998. In response to the requirement of the Trademark Examining Attorney to disclaim the word NORTHWEST, applicant instead submitted a claim of acquired distinctiveness for the entire composite mark under Section 2(f) of the Act, which showing was ultimately accepted by the Trademark Examining Attorney.

⁴ Application Serial No. 75/878,230, filed on December 21, 1999, is based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. An amendment to allege use was filed in June 2001, alleging first use in commerce as of October 1, 1999.

Despite the Trademark Examining Attorney's initially requiring a disclaimer of the word NORTHWEST, this requirement was withdrawn prior to the appeal of this case, and that in spite of the fact that no Section 2(f) affidavit was ever submitted with specific regard to the mark which is the subject of the '230 application.

We also note that as sometimes happens during the prosecution of trademark applications through the examining operation, goods were correctly moved from one application to another (having identical marks) based upon the Trademark Examining Attorney's applying the Nice International Classification system. As they stand at the moment of appeal, there is a certain symmetry to these four applications. The two applications filed in March 1999 have typed drawings for goods in classes 1 and 19. Similarly, the two applications filed in December 1999 have special form drawings for the same goods in classes 1 and 19.

Applicant assumed that this '230 application is for a slightly different mark (having a special form drawing) but for the same goods as the earlier '578 application. Yet, of all four

and design, as shown below, for "building materials, namely gravel, sand and concrete, all sold in bulk," in

International Class 19⁵:



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of these applications, this is the only one where neither the Trademark Examining Attorney nor applicant chose to modify the identification of goods with the phrase "... sold in bulk." Nonetheless, as in the other three applications, the acceptable specimen of record in this application is a photograph depicting the same large concrete truck. Furthermore, in its brief on this application, applicant argues similarly about the "... large volume with which such additives are typically purchased." (brief, p. 7).

Hence, the author of this opinion is comfortable, in this decision, treating this identification of goods as if it too were modified by the language "sold in bulk," rather than presuming that the goods in this application alone are a completely different product that includes small retail quantities of additive used by the weekend, do-it-yourself handyperson.

⁵ Application Serial No. 75/878,231, filed on December 21, 1999, is based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. An amendment to allege use was filed in June 2001, alleging first use in commerce as of October 1, 1999.

Despite the Trademark Examining Attorney's initially requiring a disclaimer of the word NORTHWEST, this requirement was withdrawn prior to the appeal of this case, and that in spite of the fact that no Section 2(f) affidavit was ever submitted with specific regard to the mark which is the subject of the '231 application.

⁶ This special form drawing is described in the application papers as "... the words GLACIER NORTHWEST, below a letter G. Four angular designs and one elongated member extend outwardly from the

Registration was refused in each of these four applications under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's marks, when applied to its listed goods, so resembles the mark GLACIER, which is registered for "manufactured stone,"⁷ as to be likely to cause confusion, to cause mistake or to deceive.

The prosecution histories of these four applications, while not identical, follow the same general pattern. Accordingly, given the similarity in the issues before us in connection with each application, the four cases have been consolidated and this single opinion has been issued for all four cases.

Applicant has appealed the refusals to register. Both applicant and the Trademark Examining Attorney have fully briefed these appeals. We reverse the refusals to register with regard to all four applications.

In the course of rendering this decision, we have followed the guidance of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). The du Pont case sets forth each factor that should be considered, if relevant information is of record, in determining likelihood of confusion.

G, with the elongated member forming part of the letter A in GLACIER."

We will consider first the similarity or dissimilarity and nature of the goods as described in the applications - concrete, concrete additives,⁸ stone, gravel and sand, all sold in bulk - and in connection with registrant's use of its mark on manufactured stone. Without additional details, upon consideration of registrant's listed goods, we assume that registrant's "manufactured stone" includes an array of interior and exterior uses (*inter alia*, structural walling, garden landscaping and interior flooring). The Trademark Examining Attorney argues that applicant's building materials and registrant's manufactured stone are "highly related" goods because, as shown by copies of certain third-party registrations which she has made of record, several merchants and manufacturers have in each instance registered the same mark for construction materials, such as concrete additives, as well as for manufactured stone. By contrast, applicant argues that its goods are all sold in large volumes to construction professionals having significant technical expertise.

Of the third-party registrations submitted by the Trademark Examining Attorney, several are irrelevant to our determination herein as the registrations are based upon

⁷ Reg. No. 1,100,766, issued on August 29, 1978, Section 8 affidavit accepted and Section 15 affidavit acknowledged; renewed.

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Section 44 of the Act rather than being based upon use in commerce. Of the remaining ones, we note that none of the use-based third-party registrations establishes that the same companies offer for sale the raw components for poured concrete *sold in bulk* as well as items of manufactured stone. Rather, in every case, judging by the context of the entire registration, these marks are registered for retail quantities of concrete-making components that may well be purchased by the do-it-yourself homeowner or weekend handyperson.

In point of fact, all of applicant's goods appear to be ingredients for poured concrete *sold in bulk*, meaning that they are sold to manufacturers or construction professionals, and are then delivered from a central mix plant to a proximate construction site on a large commercial truck. Thus, there are significant differences between applicant's concrete, stone, gravel and sand sold in bulk or even specialized, construction chemicals designed to alter the properties of various concrete products and applications, and registrant's manufactured stone. We acknowledge that it is possible that registrant's manufactured stones may have been made using components like

⁸ See footnote 4 for a discussion of the one exception to the explicit characterization of the goods as being "sold in bulk."

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small stones, gravel, sand and concrete as well as premium admixtures such as retarding agents or accelerators. However, it also appears as if the only common purchasers of both types of products herein would be construction professionals. Hence, we believe that when selecting concrete, stone, gravel, sand and/or concrete additives *sold in bulk* for large construction projects, construction professionals would exercise a very high level of care.

This finding as to significant differences in the nature of the respective goods leads us to conclude that two other related du Pont factors also favor a reversal herein. Namely, to the extent that the registrant's goods are available in, for example, large home-improvement centers, hardware stores or similar retail outlets, there appears to be dissimilarity in the established, likely-to-continue trade channels. In all four applications, the recurring specimen for applicant's goods is a photograph of a large truck-mounted cement mixer. Moreover, as to the conditions under which and buyers to whom sales are made, the only common purchaser of registrant's and applicant's goods would clearly not involve "impulse" purchasers. Rather, this would involve purchasing decisions by careful, sophisticated contractors.

We turn next to consider the similarity or dissimilarity of the marks as to overall commercial impressions. In this regard, the Trademark Examining Attorney argues that the dominant and most distinctive portion of applicant's marks is GLACIER - the entirety of the cited mark. Furthermore, she argues that GLACIER NORTHWEST is not a unitary mark, but rather, that "[c]onsumers may even be led to believe that GLACIER NORTHWEST is merely a regional division of the owner of the cited mark GLACIER, or that the parties are otherwise related." (Trademark Examining Attorney's appeal brief, p. 4).

Applicant argues in response that GLACIER NORTHWEST is a "unitary term" in each of its marks, and that there is no basis for the position of the Trademark Examining Attorney that the word NORTHWEST is subordinate matter to the lead word, GLACIER.

The Trademark Examining Attorney's position seems to be that a potential consumer located in California who is acquainted with registrant's manufactured stone, upon finding applicant's bulk products for poured concrete located in the "Pacific Northwest," will assume that the word "Northwest" simply identifies a regional division of

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registrant. Consistent with this approach, she initially asked for a disclaimer of the arguably descriptive word, NORTHWEST. However, as noted earlier, in each of these applications, applicant clearly refused to disclaim this matter. As to the two Section 1(a) applications filed on March 31, 1999 (Serial Nos. 75/672,573 and 75/672,578), applicant choose instead to counter this requirement with a supporting declaration claiming acquired distinctiveness for the combined term, GLACIER NORTHWEST.⁹

Despite her initial reluctance, the Trademark Examining Attorney's ultimately withdrawing on the requirement for a disclaimer in all the applications, and her apparent acceptance in the two used-based applications of applicant's showing of acquired distinctiveness for the two words GLACIER NORTHWEST together, appears seriously to undercut her conclusions as to the relative strengths of the respective components of this combined term.¹⁰ Hence, in

⁹ The declaration of Allen Hamblen, vice president and general manager of applicant's Washington Division, claims annual gross sales under the GLACIER NORTHWEST mark of approximately \$200 million per year.

¹⁰ We agree with the Trademark Examining Attorney that applicant has failed to demonstrate that this composite ("Glacier Northwest") creates a "unitary mark." Hence, it seems so basic as not to require citation that if applicant had admitted the descriptive nature of the word NORTHWEST in any of these four applications by disclaiming that word, the Trademark Examining Attorney would have retained a compelling argument - namely, that the word GLACIER is the stronger component within the composite mark. On the other hand, we note that in the two use-based

spite of the apparent similarities as to appearance, sound and meaning between GLACIER and GLACIER NORTHWEST, on this record, we find that there are significant differences as to overall commercial impressions between registrant's mark and applicant's marks.

We turn next to the du Pont factor that focuses on the number and nature of similar marks in use on similar goods. In each of these cases, after receiving a final refusal, applicant argued (e.g., in several cases, along with its request for reconsideration) that the term GLACIER is "diluted" on the federal register, and in support thereof, submitted copies of very limited data on more than a hundred federal trademark registrations drawn from www.trademarks.com in which registrations the marks contain the word GLACIER. In denying the request for reconsideration, the Trademark Examining Attorney mentioned neither the form nor the content of these third-party registrations. It was not until the time of her appeal brief that the Trademark Examining Attorney objected to the

applications having typewritten marks, the Trademark Examining Attorney expressly withdrew the disclaimer requirement in response to applicant's strong showing of acquired distinctiveness for the two words combined into a single composite. Hence, the strength of the junior party's mark in the marketplace clearly lies in these two equal and undifferentiated components within the composite.

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form of this data because it did not contain critical bibliographic data (such as the goods or services covered by each registration) and was not drawn directly from the records of the United States Patent and Trademark Office. In its reply briefs filed in several of these cases, applicant argues that we should consider this data despite its source and format because the Trademark Examining Attorney failed to object when issuing earlier actions. In the alternative, the reply brief has attached detailed copies of federal trademark registrations correctly drawn from www.uspto.gov.

Clearly, if the Trademark Examining Attorney had objected earlier to the form of the submission, applicant could have corrected this informality prior to filing its appeal briefs. Accordingly, although applicant did not comply with the established rules as to the form and timing for the submission of the evidentiary record in an application, we find that the Trademark Examining Attorney waived her objections by not raising them in response to the request for reconsideration. Hence, we have considered these listings of third-party registrations, along with the later-submitted bibliographic data, as evidence of record in reaching our decision.

However, we do not agree with applicant that these third-party registrations are persuasive of the fact that the term GLACIER is "diluted" on the federal register and hence weak as to registrant's or applicant's goods. This is true because the majority of these registrations are for totally dissimilar goods, such as bottled water, other beverages or food items, travel-related services, etc. On yet the other hand, there are two third parties having subsisting registrations for the word GLACIER for, respectively, vinyl siding and ceramic tiles, both of which, like registrant's goods, fall into the general category of building materials. Hence, this du Pont factor, if given full consideration, appears to be somewhere between a neutral factor and one slightly favoring the position of applicant herein.

In summary, we find that the goods are not closely related, that their channels of trade are different, that the mutual customers are sophisticated and would make purchases of concrete products in bulk with a high degree of care, and that based upon this entire record, the respective marks create overall different commercial impressions.

Decision: The refusals to register are reversed.

Hohein, Administrative Trademark Judge, concurring in part and dissenting in part:

I agree that, in light of the limiting language "sold in bulk" in the identifications of goods for three of applicant's four applications, the refusals to register in view of the cited registration for the mark GLACIER for "manufactured stone" should be reversed, inasmuch as in those cases the channels of trade and methods of distribution of applicant's bulk products would appear to be different from those for registrant's goods and the only common purchasers would seem to be "construction professionals," who would be expected to "exercise a very high level of care" in their selection of building materials. However, as further explained below, because the restriction "sold in bulk" is lacking in the identification of goods for applicant's application for the mark GLACIER NORTHWEST and design for "concrete additives," and because the cited registration is not limited to depiction of the subject mark in any particular special form which is sufficiently dissimilar to applicant's above-referenced mark, I would affirm the refusal to register in such case.

Specifically, turning first to consideration of the respective goods, it is a well established rule of law that the issue of likelihood of confusion must be determined on

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the basis of the goods as they are set forth in the involved application and the cited registration, and not in light of what the specimens or other evidence shows such goods to actually be. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). In fact, such proposition is so well settled that, as stated in Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990):

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Thus, where applicant's and registrant's goods are broadly described as to their nature and type, it is presumed in each instance that in scope the application and registration encompass not only all goods of the nature and type described therein, but that the identified goods move in all channels of trade which would be normal for those goods and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640

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(TTAB 1981). Moreover, as the Examining Attorney correctly points out, it is well settled that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient, instead, that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same entity or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

Accordingly, absent the limitation "sold in bulk," applicant's goods must be considered, like registrant's goods, to be suitable for sale not only by the truckload to construction professionals such as building contractors, but the respective goods would also be found in what the majority characterizes as "large home-improvement centers, hardware stores or similar retail outlets" for purchase by "do-it-yourself homeowner[s] or weekend handyman[s]." It is obvious, furthermore, that manufactured stone and concrete, as well as concrete additives, would often be used

together or in close proximity for a variety of home improvement projects. However, unlike the expertise acquired by construction professionals, the ordinary retail consumers of applicant's and registrant's goods, who do not frequently buy such products, would not be familiar with the marks used by various suppliers of building materials and the products commonly used in connection therewith, nor would they be inclined to exercise the same higher degree of care in their purchasing decisions. A weekend do-it-yourselfer, desiring for example to install a spa, porch, patio, walkway or other decorative home improvement, could therefore reasonably believe that, if sold under the same or similar marks, such basic building materials as manufactured stone, on the one hand, and concrete additives (including those for natural and artificial stone concrete), on the other hand, emanate from or are associated with or sponsored by the same source.

Turning, then, to consideration of the specific marks at issue, the majority acknowledges "the apparent similarities as to appearance, sound and meaning between GLACIER AND GLACIER NORTHWEST." It must be kept in mind, however, that registrant's mark is in typed form rather than displayed in any distinguishing special form. The significance thereof, of course, is that not only is the

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word "GLACIER" identical in sound and meaning in both applicant's "GLACIER NORTHWEST" and design mark and registrant's "GLACIER" mark, but such word must also be considered to be identical in appearance in both marks rather than, due to its stylized lettering, being distinctively displayed only in applicant's mark. As stated, for instance, in *Squirtco v. Tomy Corp.*, supra at 939 (*italics in original*):

[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a *difference* cannot legally be asserted by that party. Thus, ... the displays must be considered the same.

Here, because registrant's "GLACIER" mark is in typed form, it consequently may be displayed in any reasonable format, including the same bold or block style of lettering as that utilized by applicant in its mark. See, e.g., *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992), citing *Phillips Petroleum Co. v. C. J. Webb, Inc.* 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). While, unlike registrant's mark, applicant's mark also includes a star design which, in addition to encompassing a stylized letter "G," has an elongated point which forms part of the letter "A" in the word "GLACIER," such design simply does not sufficiently distinguish applicant's mark. This is

especially so given the well recognized principle that, as properly noted by the Examining Attorney, where a mark consists of both a word portion and a design portion, it is generally the word portion which is more likely to be impressed upon a consumer's memory and to be used in calling for and/or asking about the goods. See, e.g., In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987).

In view thereof, I agree with the Examining Attorney that, when viewed in its entirety, the dominant portion of applicant's "GLACIER NORTHWEST" and design mark is the word "GLACIER." As the Examining Attorney accurately observes, such word is substantially "the largest and most prominent term in the mark." I concur with the Examining Attorney that, overall, the word "NORTHWEST" is plainly subordinate matter and, to the extent that it would even be noticed, it would most likely be regarded by ordinary consumers as suggesting a regional area rather than serving, in conjunction with the word "GLACIER," as an indicator of source.¹

¹ While I agree with the Examining Attorney that applicant has failed to demonstrate that either of its marks is unitary, I disagree, especially as to applicant's "GLACIER NORTHWEST" and design mark, with the majority's view that the Examining Attorney lacks a compelling argument that "the word GLACIER is the stronger component within the composite mark." Plainly, as shown in each

Consequently, for the above reasons I would find that when considered in their entireties, applicant's and registrant's marks are substantially identical in commercial impression and that their contemporaneous use in connection with such closely related building materials as concrete additives and manufactured stone would be likely to cause confusion as to the origin or affiliation of the respective goods. To the extent, moreover, that ordinary retail consumers would notice the differences in applicant's "GLACIER NORTHWEST" and design mark for its concrete additives, they would most likely regard it as designating a new or expanded product line from the same entity that produces registrant's "GLACIER" manufactured stone and vice versa.

Finally, as to applicant's contention that the term "GLACIER" is diluted on the federal register due to its widespread use by third parties, I would observe that the third-party registrations upon which applicant purports to rely in support of its position do not constitute proof of any actual use of the registered marks and, thus, fail to establish that the purchasing public, having become

of the specimens of use, the word "GLACIER" predominates over the word "NORTHWEST" and is thus the stronger component.

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conditioned to encountering certain goods and services thereunder, is able to distinguish the source thereof based upon differences in the elements of such marks other than the word "GLACIER."² See, e.g., *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); and *In re Hub Distributing, Inc.*, 218 USPQ 284, 285-86 (TTAB 1983). The number and nature of any similar marks in use on the same or similar goods is simply not a relevant *du Pont* factor herein.

² The copies thereof, submitted by applicant in the present case with its reply brief, are plainly untimely under Trademark Rule 2.142(d) and should not be given consideration. Instead, what is of record, due to the waiver of the objection raised by the Examining Attorney, is a mere listing of third-party registrations as to the subject mark, the International Class involved and whether the registration is subsisting. Clearly, given the absence of information as to the specific goods or services covered by each registration, the list of third-party registrations essentially is of no probative value.