UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/233386

APPLICANT: United Coatings

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MARK: ROOF MATE

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	United Coatings	:	BEFORE THE
Trademark:	ROOF MATE	:	TRADEMARK TRIAL
Serial No:	76/233886	:	AND
Attorney:	Mark W. Hendrickson, Esq. Wells, St. John, Roberts, Gregory & Matk, P.C	:	APPEAL BOARD
Address:	601 West First Avenue Suite 1300 Spokane, Washington 99201-3828	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

I. STATEMENT OF THE CASE

Applicant appeals the Trademark Examining Attorney's Final Refusal to register the proposed trademark ROOF MATE for "acrylic elastomer coating fluid applied roofing membrane; exterior

paint; paint primer." The Examining Attorney refused registration on the Principal Register under Section 2(d) of the Trademark Act, 15 U.S.C. Section *1052(d)*, on the ground that the mark, when applied to the goods of the applicant, is likely to be confused with United States Registration No. 0728153 for ROOFMATE for "roof insulation." The examining attorney also required a disclaimer of the descriptive word element ROOF contained in the proposed mark under Section 6(a) of the Trademark Act, 15 U.S.C. Section *1056(a)*.

II. FACTS

On March 30, 2001, applicant, United Coatings, applied for registration of the trademark ROOF MATE on the Principal Register for "acrylic elastomer fluid applied membrane; paint; caulking; paint primer."

On August 13, 2001, the Examining Attorney refused registration under Section 2(d) of the Trademark Act based on the prior Registration No. 0728153 for the mark ROOFMATE for "roof insulation", issued a requirement as to the identification and classification of goods and issued a requirement for a disclaimer of the descriptive wording in the proposed mark.

On February 12, 2002, the applicant filed its response satisfying the outstanding identification and classification procedural issues. The applicant made no response as to the disclaimer requirement. Applicant also argued that there have been no known instances of actual confusion and that during eighteen years of continuous and concurrent use applicant received no request to cease and desist. Applicant speculates that the reason that there has been no confusion is that the market channels are different, that the products are different, and that the products are classified in different classes. The applicant provided no evidence or documentation to support its claims. The applicant concluded that based on the above factors, applicant's mark is not to be confused with the mark of the registrant. See Applicant's response of February 12, 2002.

On May 03, 2002, the Examining Attorney accepted the applicant's procedural amendments as to the identification and classification of goods. However, the Examining Attorney continued the requirement for a disclaimer, continued the refusal on the grounds of likelihood of confusion and issued a final refusal based on Registration No. 0728153 and made final the requirement as to the disclaimer.

On November 4, 2002, in response to the Examining Attorney's final action, applicant filed its Notice of Appeal. On January 3, 2003 the applicant submitted its Appeal Brief.

The issues to be decided on appeal are whether there is a likelihood of confusion between the mark and goods of the applicant and the mark and goods of the registrant and whether the requirement for a disclaimer of the word element ROOF in applicant's mark is necessary.

III. ARGUMENT

THE APPLICANT'S PROPOSED MARK IS NOT ENTITLED TO REGISTRATION BECAUSE IT SO RESEMBLES THE CITED REGISTERED MARK AND THE GOODS ARE HIGHLY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

The court in *In re du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563(CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d) of the Trademark Act. Any one of the factors listed may be compelling in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, relatedness of the goods and similarity of the channels of trade.

Any doubt as to the issue of likelihood of confusion must be resolved in favor of the registrant and against the applicant who has a legal duty to select a mark that is totally dissimilar to trademarks already being used. *See in re Hyper Shoppes (OHIO), Inc.*, 837 F.2d 463, 6 USPQ2d

1025 (Fed. Cir. 1988).

A. THE GOODS ARE HIGHLY RELATED

The applicant's goods are identified in the application as "acrylic elastomer coating fluid applied roofing membrane; exterior paints, paint primer." The registrant's goods are "roofing insulation."

It is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank,* 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); see also, Monarch *Marking Systems, Inc. v. Elan Systems, Inc.*, 39 USPQ2d 1032 (TTAB 1996). Furthermore, the goods of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

The goods in the instant case are highly related and overlapping. The applicant's goods wholly encompass the registrant's goods and the goods can and are used together. Applicant's specimens of record state "Superior weatherability, ultraviolet resistance, fire retardancy, elongation, flexibility, adhesion and ease of application make the ROOF MATE system an excellent protective elastomeric barrier for extending the life of most roofing substrates." Additionally, the specimens of record indicate that the product is a "...coating for roofing system". See Applicant's specimens. The goods of the applicant are an elastomer roofing product with insulating properties. Moreover,

just as roofing insulation is applied to a roof substrate for weatherability, ultraviolet resistance and fire retardancy before the shingles, tiles or other top coat roofing materials are applied, so too is the applicant's acrylic roofing membrane applied as a roofing insulation or before the installation of traditional roofing insulation and/or the top coating of roofing material. The goods can and are used together in roofing applications.

As to the similarity of the goods, the applicant stated in it its reply to the initial refusal that "the market channels are different and the products are so different." The applicant offered no supporting evidence for these statements. In response and in support of the relatedness of the goods and the channels of trade, the examining attorney in his Final Refusal provided twenty-five (25) abstracts of registrations on the Principal Register showing insulation, insulation materials, exterior paint and paint primer together with all types of roofing materials and products, including damp proofing and water proofing-materials, adhesives and roofing barriers, all marketed and sold under the same trademark. Clearly, consumers are used to seeing the applicant's and registrant's goods sold and marketed under the same trademark in the same channels of trade. As such, the goods are likely to be encountered and purchased by the same consumers who will be exposed to the advertisements and other marketing strategies for the roofing goods of both parties.

Finally, the applicant again stated in its brief that there "are multiple factors why there is not a likelihood of confusion in this case including the differences in the goods, the relative marketing channels, the level of sophistication of the purchasers and the scope of protection given similar mark in the class." Again, the applicant offers no additional argument, explanation or evidence in support of these broad statements.

In response to the sophisticated purchasers statement, the applicant is reminded that the fact that purchasers are sophisticated or knowledgeable in a particular field, and there has been no

evidence or showing that the relevant purchasers here are in fact sophisticated or knowledgeable, does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

The goods of the respective parties are roofing materials used on all types of roofs to aid in the insulation and sealing of the roofing substrate and can and are used together, as demonstrated by the evidence of record. Additionally, the goods are marketed in the same channels of trade to the same consumers and purchasers and, as such, the goods are highly related.

B. THE MARKS ARE CONFUSINGLY SIMILAR

The marks must be compared for similarities in sound, appearance, meaning or connotation. *In re E.I. du Pont de Nemours,* 1476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack,* 197 USPQ 755 (TTAB 1977).

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison but whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries, Inc.,* 209 USPQ 179 (TTAB 1980). The overriding concern is to prevent buyer confusion as to the source of the goods. *Miss Universe, Inc. v. Miss Teen US.A., Inc.,* 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974). Additionally, the focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Spoons Restaurants, Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), affd., No. 92-1086 (Fed. Cir. June 5, 1992).

The applicant is seeking to register the mark ROOF MATE. Registrant's mark is ROOFMATE. The applicant makes no arguments as to similarity of the marks based on sound, appearance, connotation or overall commercial impression.

In this case, the only difference between the marks is a space between the two word elements ROOF and MATE in the applicant's mark. Similarity in sound alone is sufficient to find a likelihood of confusion. *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975). Here, the applicant's mark is identical in sound, appearance, connotation and overall commercial impression to the registered mark.

The Applicant's main contention is that there has been no actual confusion and therefore there is no likelihood of confusion. The applicant has argued that the mark has been in use since 1983 and that there has been no actual confusion and therefore no likelihood of confusion can exist. In support of this statement the applicant cites five (5) *inter partes* trademark infringement cases for the proposition that concurrent use for an adequate period of time without a showing of actual confusion means that there is no likelihood of confusion. In ex partes cases, it is well established that the standard of review under Section 2(d) of the Trademark Act is whether there is a likelihood of confusion, and it is unnecessary to show actual confusion in establishing likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and cases cited therein. With respect to the applicant's claim of no actual confusion over the years, it is clear that while this may be a factor to be considered, the lack of actual confusion is not determinative of the question of likelihood of confusion especially in an *ex partes* proceeding such as this where there is no opportunity for a registrant to show instances of actual confusion or to indicate geographical areas of use, extent of use, sales and advertising expenditures under the mark I order to ascertain whether opportunities for such actual confusion have existed. See e.g., *In re Sieber v McIntyre, Inc.* 192 U.S.P.Q. 722 (TTAB 1976); *In re*

Trelleburgs Gummifrabriks Aktiebolag, 189 U.S.P.Q. 106 (TTAB 1975) and cases cited therein.

Applicant's entire argument consists of its alleged concurrent use and no showing of actual confusion. The applicant provides no other evidence that the marks are not confusingly similar. As such, the argument and cases cited by applicant should be given no consideration.

APPLICANT NEVER ADDRESSED THE DISCLAIMER REQUIREMENT

Trademark Act Section 6(a), 15 U.S.C. Section 1056(a), states that the Commissioner may require the applicant to disclaim an unregistrable component of a mark. Trademark Act Section 2(e), 15 U.S.C. Section 1052(e), bars the registration of a mark which is merely descriptive or deceptively misdescriptive, or primarily geographically descriptive or deceptively misdescriptive of the goods. Therefore, the Commissioner may require the disclaimer of a portion of a mark which, when used in connection with the goods or services, is merely descriptive or deceptively misdescriptive, or primarily geographically descriptive or deceptively misdescriptive. Moreover, if an applicant does not comply with a disclaimer requirement, the examining attorney may refuse registration of the entire mark. TMEP section 1213.01(b).

The word element ROOF is merely descriptive because it describes a feature, function, use and/or characteristic of the goods as identified in the application. Applicant has identified its goods as "Acrylic elastomer coating fluid applied roofing membrane; exterior paint and paint primer." The goods are used on or in connection with a roof. Applicant neither addressed the propriety of the disclaimer requirement in its Response to the initial Office Action, nor raised the issue on appeal. Accordingly, the Board should affirm the examining attorney's final refusal as to the disclaimer requirement based on applicant's failure to either enter the required disclaimer or demonstrate that it is inappropriate.

IV. CONCLUSION

The marks are almost identical and the goods identical or at the very least highly related. Consumers encountering applicant's mark and the cited registered mark in the marketplace are likely to mistakenly believe that the goods derive from a common source. The mark contains a descriptive element and the disclaimer requirement is appropriate. For the foregoing reasons, the refusal to register under Section 2(d) of the Trademark Act should be affirmed.

Respectfully Submitted,

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