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Mailed: November 30, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re No-Burn Investments, L.L.C.

Serial No. 76629397

Christopher John Rudy, Esq. for No-Burn Investments, L.L.C.

Odessa Bibbins, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Bucher, Grendel, and Wellington, Administrative
Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

On January 25, 2005, No-Burn Investments, L.L.C.
("applicant") filed an application for registration of the
mark SILENT FIREMAN (in standard character form) for
certain fire retardant and fire reactant goods in
International Class 2, and fire prevention inspection
services in International Class 42 on the Principal
Register under Section 1(a) of the Trademark Act, 15 U.S.C.
§ 1051(a). The specimens of use consist of printouts from
applicant's website, a fire resistance certificate, a

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letter from a customer, and photographs of applicant's products, as illustrated below:

No. NBI 70000010

Fire Resistive Class Rating Certification

NO-BURN

Your Silent Fireman

No-Burn, Inc. 1392 High Street, Suite 211 Wadsworth, OH 44281 1-800-989-8577

The structure listed below has been treated with No-Burn by the authorized No-Burn dealer listed. The Client/Owner of this property understands that No-Burn is not a fireproofing agent and is not capable of preventing any type of fire from occurring. No-Burn is a fire retardant/reactant, when applied correctly, can slow the forward spread of fire throughout the structure. No-Burn is not intended to protect this structure from fires of a criminal or suspicious nature in which an accelerant is used. The Client further understands that the FRCR of this structure does not include any type of interior/exterior home furnishing(s). The client fully understands the recommendation from No-Burn, Inc. and its authorized dealer that all interior home furnishings should be treated with No-Burn Fabric Gard for maximum protection from fire. The client understands that any alterations or additions to this structure must also be treated with No-Burn in the same manner in order to maintain this structure's FRCR. PRODUCT, SERVICE, and APPLICATION WARRANTY ARE AS FOLLOWS: No-Burn, Inc. (parent company) warrants that the No-Burn formula will be manufactured to the same specifications and quality, and will perform equally to the test performed by the independent laboratories when properly applied by an authorized No-Burn dealer. No-Burn, Inc. warrants the product only to the cost of product. The authorized No-Burn dealer warrants that the product, in its original form from the Manufacturer, will be mixed, stirred and/or applied as directed in the guidelines from No-Burn, Inc., to every reasonably accessible area that is specified to protect. All implied warranties, from No-Burn, Inc. or its authorized dealer are excluded. The use of any sub-contractors utilized for the application of any No-Burn product, certify that the product was applied as directed in the guidelines from No-Burn, Inc. This structure has been inspected and meets the Fire Resistive Class Rating listed below.

Protected Structure

Name/Owner: _____
Address: _____
County Tax ID#: _____

Fire Resistive Class Rating

FRCR-1 ☐ FRCR-2 ☐ FRCR-3 ☐ FRCR-4 ☐ FRCR-5 ☐

Place FRCR Hologram sticker here.
This certificate is not valid without the FRCR Hologram

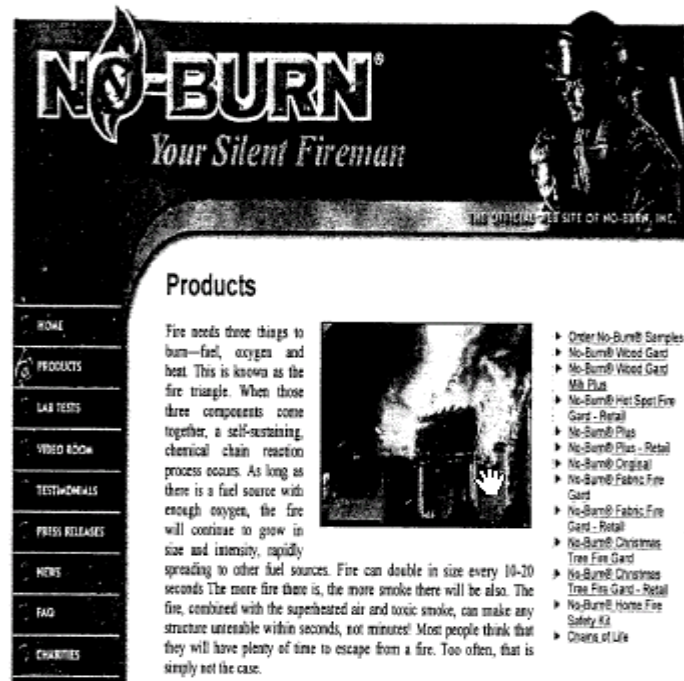
Dear Prospective Buyer,

My name is Bob Kingsley and I am the producer and host of American Country Countdown. My wife Nan and I are in the process of building a home in North Texas. Prior to construction we saw an ad for No Burn Fire Retardants and decided to check into the company and it's line of products. We asked our painter to test No Burn Plus by burning two samples of wood, one treated with the product and one without. The results were truly amazing. We could clearly see how No Burn Plus would help to save lives. The untreated piece of wood was reduced to ash, while the sample treated with No Burn Plus remained completely in tact.

Six months later we have treated our new home with over 300 gallons of No Burn Plus. We are sold on No Burn and their family of products. No Burn is truly "Your Silent Fireman."

Sincerely,

Nan and Bob Kingsley



[The specimens have been cropped for space consideration.]

In her initial Office Action (dated August 24, 2005), the examining attorney, inter alia, refused registration of applicant's mark because the mark in the drawing in the application, SILENT FIREMAN, is not an exact representation

of the mark shown in the specimens, YOUR SILENT FIREMAN. Trademark Rule 2.51, 37 C.F.R. § 2.51. She required substitute specimens and advised the applicant that it may not amend the drawing to conform with the specimens, i.e., by adding the word YOUR to the mark. She stated that such an amendment would be impermissible because it would create a different commercial impression and constitutes a material alteration of the original mark, citing Trademark Rule 2.72, 37 C.F.R. § 2.72. The examining attorney also required applicant to confirm that it seeks registration of the mark in standard character format.

On January 6, 2006, applicant filed a response to the first Office Action containing: a proposed amendment to the mark to YOUR SILENT FIREMAN; a statement confirming it is seeking registration of the mark in standard character format; and a disclaimer of the term YOUR. In its response, applicant argued that the proposed amended drawing does not constitute a material alteration and, in support of its position, attached the declarations of Jeannine H. Hayman and William L. Welch.

On February 7, 2006, the examining attorney issued an Examiner's Amendment/ Priority Action, after having a telephone conference with applicant's counsel. The Examiner's Amendment confirmed applicant's withdrawal of

the disclaimer of YOUR. And, by way of the Priority Action, the examining attorney maintained the substitute specimens requirement and denied the proposed amendment to the mark in the drawing.

On May 24, 2006, applicant filed a response to the Priority Action and again argued that the proposed amendment of the mark does not constitute a material alteration. Again, in support of its position, applicant filed supplemental declarations of Ms. Hayman and Mr. Welch, in addition to the declaration of Irene J. Rudy. Applicant argued that, in the alternative, in the event that the examining attorney maintains the refusal to permit the amendment, substitute specimens should not be required because the specimens submitted with the application show use of the mark SILENT FIREMAN.

On July 3, 2006, the Examining Attorney issued an Office Action making final the requirement for substitute specimens and, again, refusing to accept the proposed amendment.

The examining attorney denied applicant's request for reconsideration. This appeal was subsequently filed. Both applicant and the examining attorney have filed briefs.

There are two issues before us. The first issue is whether the mark, as it appears in the drawing in the

application, is a substantially exact representation of the mark as shown in the specimens, as required by Trademark Rule 2.51(a), 37 C.F.R. § 2.51(a). The second issue is whether applicant's proposed amendment materially alters the mark in the drawing in the application and thus is impermissible under Trademark Rule 2.72, 37 C.F.R. § 2.72.

We can quickly resolve the first issue inasmuch as there is no dispute that all of the specimens display the mark YOUR SILENT FIREMAN. This clearly is not a substantially exact representation of the mark in the drawing, SILENT FIREMAN. The word YOUR cannot be dissected from the mark as it appears in the specimens and, as discussed more below in the context of a material alteration, it modifies the mark as a whole.

Applicant argues that the specimens should not be refused because in the prosecution of another registration for the mark SELBY-NOACK, specimens were accepted that showed the mark with an additional term "VOLATILITY TEST."¹ This argument is not well taken. It is well settled that the Board is not bound by prior decisions of examining attorneys. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); and *In re Sunmarks*

¹ Registration 2262666 issued July 20, 1999.

Inc., 32 USPQ2d 1470 (TTAB 1994). Nonetheless, we would be remiss if we did not point out that the goods identified in the registration cited by applicant involve a "testing apparatus used in volatilization." Thus, the term "volatility test" was evidently seen as non-source indicating, generic matter that could be separated from the trademark SELBY-NOACK.

We now turn to applicant's proposed amendment.

If an amended drawing is submitted in connection with an application based on use in commerce, the applicant may amend the description or drawing of the mark only if "(1) the specimens originally filed ... support the proposed amendment; and (2) the proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application." Trademark Rule 2.72. See also *In re Who? Vision Systems Inc.*, 57 USPQ2d 1211, 1217-18 (TTAB 2000) ("[U]nder the new rules, any and all proposed amendments are subject to the material alteration standard, and no amendment is permissible if it materially alters the mark sought to be registered, i.e., the mark depicted on the drawing").

In determining whether a proposed amendment to a mark is material, "[t]he *modified* mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark." *Id.*, quoting *Visa International Service Assn. v. Life-Code Systems*, 220 USPQ 740, 743 - 744 (TTAB 1983). (Emphasis in the original.) "[T]he new and old forms of the mark must create essentially the same commercial impression." *In re Nationwide Industries Inc.*, 6 USPQ2d 1882, 1885 (TTAB 1988). One factor to be considered in this analysis is whether a follow-up search (by the Examining Attorney for conflicting marks) would be necessary as a result of the amendment. *In re Who? Vision Systems Inc.*, 57 USPQ2d at 18.

We find that the mark in the proposed amendment is a material alteration of the mark depicted in the original drawing. By changing SILENT FIREMAN to YOUR SILENT FIREMAN, the meaning and commercial impression of the mark is changed. Specifically, the addition of the term YOUR injects a possessive component and creates the impression, albeit figuratively, that the purchaser will have his/her own fireman protecting them. This new connotation is acknowledged in the declaration submitted by applicant wherein the declarant, Mr. Welch, states that "[t]he word,

'Your,' in the specimens and proposed mark conveys a sense of possession by the customer or potential customer, but possession only of the actual goods or services strongly designated and identified by 'Silent Fireman.'" The possessive or personal connotation is also evidenced by applicant's specimens wherein the proposed mark is usually immediately preceded by applicant's house mark, NO BURN. Again, the resulting impression is that No Burn products are protecting the purchaser, i.e., acting as "your silent fireman." Indeed, the customer letter submitted by applicant as a specimen of use is full of praise for applicant's products and ends with the customer stating that "No Burn is truly 'Your Silent Fireman.'" Without the addition of the term YOUR, the intended meaning of that sentence is lost.

Applicant's arguments and materials submitted in support of registration, including the declarations, are not persuasive. As to the declarants Welch and Hayman, there is no indication that either person has expertise in trademarks or how trademarks are perceived by customers. Therefore, their averments as to the trademark significance, or lack thereof, of the term YOUR, is of little value. Their unfamiliarity with trademarks is demonstrated by their pronouncements that the term YOUR is

"generic." Clearly, the term "your" is not generic inasmuch as it does not describe the genus of goods or services identified in the application. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001) ("Generic terms are common names that the relevant purchasing public understands primarily as describing the genus of goods or services being sold.")

Applicant's argument that the proposed amendment should be allowed because it would not necessitate a subsequent search (for other similar marks) is also unconvincing.² To the contrary, we find that it would stand to reason that adding the word YOUR to the mark would likely require an additional search for conflicting marks. Thus this factor also weighs in support of the examining

² Applicant relies on the declaration of Irene J. Rudy, who states that she searched the Trademark Office's TESS electronic database and found approximately thirty thousand marks containing the term "your," only one result for search of "SILENT FIREMAN," and no results for search of YOUR SILENT FIREMAN. Ms. Rudy avers that she performed a basic search for both "live" and "dead" marks. These search results have little, if any, probative value as to whether the term "your" is weak or whether a search would be necessary. On its face, the search is deficient because the results include "dead," or cancelled records. Also, to the extent that applicant relies on the search results to show weakness of the term "your," we note there is no indication how many of the records are for registered marks and are for goods or services similar to those in the application. Finally, to the extent that applicant relies on the search results to show that a search for conflicting marks is unnecessary, we note the overly simplistic search strategy used by Ms. Rudy would not find potentially confusingly similar marks using similar wording, e.g., YOUR UNSEEN FIREMAN or YOUR SILENT PROTECTION.

attorney's contention that the proposed amendment constitutes a material alteration.

In summary, we find that it would be a material alteration to change the mark from SILENT FIREMAN to YOUR SILENT FIREMAN. Therefore, the examining attorney correctly did not allow the drawing to be amended as proposed by applicant. Also, because the mark shown on the specimens submitted with the application does not agree with the mark shown on the drawing, the requirement for substitute specimens that agree with the drawing is proper.

Decision: The examining attorney's refusal on the ground that the mark on the specimens does not agree with the mark in the drawing and her refusal to accept the amendment to the drawing are affirmed. The requirement for specimens which show the mark sought to be registered used in connection with the goods and services set forth in the application is also affirmed.