IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Regarding: No-Burn Investments, L.L.C.
Application No. 76/716,810
Mark: FABRIC FIRE GARD
International Class No. 001
Filing Date August 25, 2014
First Use Anywhere and in Commerce (Originally Stated): As Early as 2001
First Use Anywhere and in Commerce (Amended): As Early as 1998 by Appellant's Predecessor in Title

TTAB

Brief for Appellant

Attention: Trademark Trial and Appeal Board (TTAB)
Appeal from Examining Attorney Ira Goodsaid, Law Office 101

I certify that this correspondence is deposited with the U.S. Postal Service in an envelope having sufficient postage as first class mail addressed to the Office address below on September 6, 2016.
Christopher John Rudy: Christopher John Rudy (9 pages) Sep. 6, 2016, Tuesday after Labor Day.

Commissioner for Trademarks
Post Office Box No. 1451
Alexandria, VA 22313-1451

To the Commissioner for Trademarks:

Please consider this brief in support of registration of the mark identified above.

In the record and in this brief, all grounds of refusal and adverse statements are traversed. In support of the registration of the present mark, the Appellant contends the following:

The mark sought to be registered is **FABRIC FIRE GARD**. The goods are water-based fire retardant compositions for commercial and domestic use on fabrics, textiles, cloth, paper, wood and other porous materials such as on or in couches, mattresses, carpets, drapes, camping equipment, homes, autos, boats, and recreational vehicles – in international class 1.

In the FEB – 1 2016 REQUEST FOR RECONSIDERATION DENIED action, the Examining Attorney maintained his final refusal set forth in the JUL – 6 2015 OFFICE ACTION based on likelihood of confusion with Reg. No. 3,869,687 for the mark **FireGuard** for fire retardant chemicals – in international class 1 (copy attached). The refusal is in reversible error.

The mark **FABRIC FIRE GARD** is not likely to cause confusion.

The case of *In re du Pont de Nemours & Co.*, 476 F.2d 1357 [177 USPQ 563] (CCPA), provides an analytical framework for approving trademarks under Section 2(d). All factors must be considered. *du Pont*, 476 F.2d 1357 [177 USPQ at 567]. Analysis is made on a *case-by-case* basis, and any one of the factors may control a particular case. *Id.*; *In re Dixie Rests Inc.*, 105 F.3d. 1045 [41 USPQ2d 1531, 1533] (Fed. Cir. 1997).

Analysis under these factors weighs in favor of the Appellant.

1. Similarity or Dissimilarity of the Marks, Taken in Their Entireties, as to Appearance, Sound, Connotation, and Commercial Impression

The Examining Attorney posits that the registered mark is FIREGUARD and then goes on to say that the present mark merely adds a term to the registered mark, reasoning that that

09-28-2016
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #25

generally does not obviate similarity between the marks; actually, he deemed that the marks are identical in part, save for the addition of the word, "FABRIC." No further details of analysis were provided, and there was no analysis according to appearance, sound, connotation, and commercial impression, as required by *du Pont*. Improperly, the marks were taken piecemeal.

The Appellant, through Mr. William Kish, however, provides necessary, practical detail, which was brushed aside by the Examining Attorney. Thus, in the Declaration by William Kish filed on January 11, 2016, it is verified:

> I am Member/Owner of the Applicant, No-Burn Investments, L.L.C., which has authorize[d] marketing of the water-based fire-retardant compositions of this application through No-Burn, Inc. under the trademark FABRIC FIRE GARD. I am President of No-Burn, Inc., and have been through the introduction and life of FABRIC FIRE GARD water-based fire retardant.
>
> I stand by my Declaration of William Kish timely filed under a certificate of mailing on June 10, 2015 and received (filed) in the Patent and Trademark Office on June 15, 2015. I add the following:
>
> ...
>
> My earlier declaration verified that the trademarks of this application and the registration differ significantly, contrasting the mark FABRIC FIRE GARD with FIREGUARD; noting that the goods when sold by dealers are carefully protected, and the marks making a significantly different presentation as well, with visual impressions and stimulations a prime distinguishing factor at retail. Thus, there is a phrase, "FABRIC FIRE GARD," versus just one word. In the phrase, "FABRIC FIRE GARD," the customer notices the word, "GARD," which attracts and stimulates the mind in a unique way through its unique spelling and visual and mental appeal, with the words, "FABRIC FIRE," also playing a significant role in identification of us as sole source of the water-based fire-retardant compositions. Moreover, the customer is attracted by and distinguishes the source of our goods with reference to the entire mark, FABRIC FIRE GARD, which informs with particularity the goods, their benefits and uses, and their source. Note how the commercial impression of the marks contrast further by contrast of the Jo-Ann fabric and craft store® printout advertising ForceField® FireGuard® [CJR: attached to his declaration filed on January 11, 2016] with the specimens of the present mark of record with the original application papers filed on August 25, 2014. Also note that the State of California had no trouble distinguishing the products or their marks per pages 8 and 12 of the list [CJR: attached to his declaration filed on January 11, 2016]. Thus, the compared marks taken in their entireties convey a significantly different commercial impression.

Thus, the marks have different appearances, which would be recognized in the memories of potential buyers. The applied mark is one word, a modern, electronic-age derived word having an initial capital letter and a middle capital letter, otherwise spelled conventionally: FireGuard. The present mark consists of three separate words, the last deliberately misspelled, as it were: FABRIC FIRE GARD. From the evidence quoted above, the Examiner presenting no evidence to the contrary, Mr. Kish verifies that the two marks make significantly different presentations, with visual impressions and stimulations a *prime* distinguishing factor at retail.

The sounds of the marks, each taken as a whole, also differ. In standard pronunciation, the applied mark has two syllables spoken without pause and without a change in pitch, being in the same word, with an accent on the first syllable, thus (accent marked in **bold** typeface): **Fire**Guard. In standard pronunciation, the present mark has three words, spoken with a standard pause between the words and a raised pitch for the first word in comparison to the last two, and four syllables, the first two spoken without pause, being in the same word, and an accent on the first word of the mark, first syllable, thus: **FAB**RIC FIRE GARD.

The connotations of the marks differ as well. The mark FireGuard connotes protection from fire somewhat ambiguously whereas the mark FABRIC FIRE GARD connotes protection from fire definitely, especially as regards fabrics and the like, and from a special source owing at least in part to the presence of the uniquely presented, noteworthy word, "GARD."

For the differences in commercial impression – and these are important and actually present *versus* what the Examining Attorney merely deemed conclusorily in his final action – the Board is referred to the quoted material above. "Thus," Mr. Kish concludes, "the compared marks taken in their entireties convey a significantly different commercial impression."

This factor, when viewed in the real-world detail it requires, favors the Appellant.

2. Similarity or Dissimilarity and Nature of the Goods

The goods for FireGuard are fire retardant chemicals, a broad category, indeed, one that does not distinguish them with particularity, save that the word, "chemicals," in the eye of a consumer frequently implies organic or harsh formulations. In contrast, the goods for FABRIC FIRE GARD are water-based fire retardant compositions for commercial and domestic use on fabrics, textiles, cloth, paper, wood and other porous materials such as on or in couches, mattresses, carpets, drapes, camping equipment, homes, autos, boats, and recreational vehicles – which describes particular goods that distinguish over those of the applied mark. The present goods are "water-based," i.e., aqueous, which practically sets off little if any alarm in the mind of the consumer, and the word "compositions," is neutral if not favorable in the consumer's mind.

The Examining Attorney without analysis merely deemed the goods similar.

This favors the Appellant. At worst, it would be neutral or only slightly unfavorable.

3. Similarity or Dissimilarity of Established, Likely to Be Continued Trade Channels

Products covered by both marks are marketed nationally. In various situations they do not compete side-by-side as on retail shelves or online outlets. See, the first set of online search results for "flame retardant spray for fabric, clothing, drapes and carpet," 2 of 2 pages in that first set for January 4, 2016, and of a printout of ForceField® FireGuard® product as sold through Jo-Ann fabric and craft stores® attached to the Declaration by William Kish filed on January 11, 2016. And, Mr. Kish in that declaration, page 2, verifies, "[T]he goods when sold by dealers are carefully protected." Thus, the established, likely to be continued trade channels are dissimilar.

The Examining Attorney failed to address this factor.

This favors the Appellant.

4. Conditions under Which Buyers Make Purchases

Purchases are made to protect buyer's lives, their children's lives, and their property from fire. This is a most grave consideration, and *serious* reflection is engaged. Thus, purchases are

not "impulse" purchases, but ones that employ careful, sophisticated purchasing. As Mr. Kish verified in both of his declarations of record, quoting from page 2 of his second declaration:

> [T]he customers who purchase fire retardant products are very careful about the brand and source of the product they would purchase since their property and very lives depend on it, as is the case with potential customers as well. The mark, FABRIC FIRE GARD, enjoys strong brand recognition.

The Examining Attorney failed to address this factor.

This factor, taken in the real-world situation it is, strongly favors the Appellant.

5. *Fame of the Applied Mark*

The applied mark is not famous, but weak, which the Examining Attorney ignored. As the undersigned verified in the Declaration of Christopher Rudy filed on January 11, 2016:

> Attached [CJR: to the declaration] are prints from a TESS search conducted on this January 6th, 2016, as follows:
>
> Record List Display for the search (Fabric Fire Gard)[COMB], 3 records found:
> Serial No. 76/716,811 for NO-BURN FABRIC FIRE GARD (LIVE);
> Serial No. 76/716,810 for FABRIC FIRE GARD (LIVE); and
> Serial No. 76/529,667 for FABRIC FIRE GARD (DEAD).
>
> Record List Display for the search (FireGuard)[COMB], 35 records found. These include LIVE files for the marks FIREGUARD 45®; FIREGUARD 45 (pending); FIREGUARD X®; FIREGUARD E-84®; FIREGUARD C®; and FIREGUARD® (6 registrations). Among all 35 records, the term, FIREGUARD," appears within 31 records; the term, "FYRGUARD," in 2 records; and the terms, "FIREGARD" and "RED-L FIREGARD," in one record each. No record is displayed for the two-word term, "FIRE GUARD," nor is any record displayed for the two-word term, "FIRE GARD."
>
> Record List Display for the search (Fire Guard)[COMB], 76 records found. These include 21 LIVE files for the marks FIREGUARD 45 (pending); FIRE-GUARD® (2 records); FIREGARD®; FIRELINE 520 WALLGUARD SERIES®; FIREGUARD E-84®; SPRINKGUARD INDUSTRIAL STRENGTH PROTECTION FOR FIRE SUPPRESSION SYSTEMS®; HSI FIRE & SECURITY GROUP®; FIREGUARD C®; FYREGUARD®; FIREGARD®; FIRE-GARD®; FIRE-GUARD®; FIRE GUARD® (2 records); FIREGUARD® (6 records); and NO-BURN FABRIC FIRE GARD (pending) and FABRIC FIRE GARD (pending) – the Trademark Electronic Search System (TESS) records printed out on this January 6th for each of these also attached.
>
> These help show – in addition to the Declaration of William Kish filed on June 15, 2015, and the Declaration by William Kish [CJR: filed on January 11, 2016] – that the present mark for use with the above-identified goods distinguishes over the other marks noted above, to include Reg. No. 3,869,687. Among other things, these illustrate perceptible differences in the marks, and the weak nature of the FireGuard mark.
>
> This favors the Appellant.

6. Number and Nature of Similar Marks in Use on Similar Goods

As the Board can appreciate from factor No. 5 above, many registered marks are in use, which the Office appears to consider similar, a number on similar goods. This was not addressed by the Examining Attorney.

This factor favors the Appellant.

7. Nature and Extent of Any Actual Confusion

There is no actual confusion. There has been no actual confusion – and this for some 18 years throughout the sales life of FABRIC FIRE GARD water-based fire retardant composition, to include none in the last 13 years of concurrent sales of FireGuard fire retardant chemical. As Mr. Kish verifies in the Declaration by William Kish filed on January 11, 2016 in response to the Examining Attorney's brushing aside of the Declaration of William Kish filed on June 15, 2015 and denigrating of Mr. Kish's integrity:

> My earlier declaration verified that, in all those years, I was aware of *no* case of actual customer confusion of No-Burn's FABRIC FIRE GARD with any other product, including FIREGUARD® fire retardant from Shield Industries, Inc., which according to the Patent and Trademark Office records for registration No. 3,869,687 was first used on February 26, 2003 and first used in commerce on March 1, 2003, and nationally sold as ForceField FireGuard thereafter per the June 18, 2010 Response to Office Action (copy attached to the Declaration of William Kish) in Serial No. 77/957,283 that led to the registration under consideration. I am *still* aware of *no* case of actual customer confusion of No-Burn's FABRIC FIRE GARD with any other product, including FIREGUARD® fire retardant. And, that lack of any actual customer confusion is found in a very crowded and active field of business, including among many others the prominent display, "Shield Industries, Inc – FireGuard® For Fabrics ...," which is the eleventh entry on the list. Plus, the Response to Office Action filed in the '283 application, of record, shows that Mr. Bilbro verified: "We have been selling ForceField FireGuard nationally for seven years. During those seven years we have had no incident of conflict in brand recognition." That unqualified "no incident of conflict" statement shows among other things that there is no conflict of FIREGUARD in brand recognition with the present, widely earlier-used mark, FABRIC FIRE GARD, and how careful and discriminating customers and potential customers actually are in the pertinent field.
>
> ...
>
> I have no reason to state anything but the truth and what I believe to be the truth here, and in my Declaration of William Kish. My declarations were and are made under penalty of perjury and with the knowledge that willful false statements may jeopardize the validity of this application or any registration issued on it. Accordingly, an invalid registration would be of no commercial value; rather, it would be a commercial liability. So, commercial realities would appear to compel giving weight to my declarations.

This factor, taken in the practical light it sheds, strongly favors the Appellant.

8. Duration and Conditions under Which There Was Concurrent Use without Actual Confusion

Mr. Kish in his second declaration verifies further in this regard as follows:

My earlier declaration verified that No-Burn's FABRIC FIRE GARD water-based fire-retardant has been marketed since at least about 2001 through authorized No-Burn dealers plus since about June 7, 2003 through retail sales, and that this marketing has been and is national in scope, with substantial and vigorous advertising and sales. The certificate [CJR: of a Registered Flame Resistant Product from the California Department of Forestry and Fire Protection, Office of the State Fire Marshall, Registration No. C-21501, as posted on the website of No-Burn, Inc. (www.noburn.com), attached to his second declaration; and of the California State Fire Marshall Flame Retardants – Chemicals List of Active Record(s), pages 8 and 10 of 12, as posted on the Office of the State Fire Marshall website (osfm.fire.ca.gov) also attached to his second declaration] shows that the present mark designates a product that is a Registered Flame Resistant Product of No-Burn, Inc. in California, with page 8 of the List of Active Record(s) showing that it was originally on that list as of February 9, 1999; the online search results [CJR: for "flame retardant spray for fabric, clothing, drapes and carpet," 2 of 2 pages in that first set for January 4, 2016, attached to his second declaration; and of a printout of ForceField® FireGuard® product as sold through Jo-Ann fabric and craft stores®.] show just one example of national scope marketing of the product designated by the present mark, as, for example, the fifth entry, Amazon.com: No-Burn Fabric Fire Gard Spray ..." Other marketing avenues are employed.

Sales of the product designated by the present mark remain substantial and vigorous as well. Substantial and vigorous advertising and sales that is national in scope is not a nebulous claim. Any reasonable person in the field knows with reasonable certainty what is conveyed by such language. In fact, similar claim was properly made by Richard T. Bilbro in the Response to Office Action filed in the '283 application, of record, which led to the registration of the mark FireGuard.

... I am *still* aware of *no* case of actual customer confusion of No-Burn's FABRIC FIRE GARD with any other product, including FIREGUARD® fire retardant. And, that lack of any actual customer confusion is found in a very crowded and active field of business, including among many others the prominent display, "Shield Industries, Inc – FireGuard® For Fabrics ...," which is the eleventh entry on the list. Plus, the Response to Office Action filed in the '283 application, of record, shows that Mr. Bilbro verified:

> We have been selling ForceField FireGuard nationally for seven years. During those seven years we have had no incident of conflict in brand recognition.

That unqualified "no incident of conflict" statement shows among other things that there is no conflict of FIREGUARD in brand recognition with the present, widely earlier-used mark, FABRIC FIRE GARD, and how careful and discriminating customers and potential customers actually are in the pertinent field.

This factor, too, taken in the practical light it sheds, strongly favors the Appellant. It is submitted also that this factor, alone or taken especially in conjunction with the seventh factor, and in relation to the other factors, is dispositive of there being no likelihood of confusion, for if there were such a likelihood it would have materialized into actual confusion over those long, long years. It did not. It will not. As Mr. Kish puts it in his second declaration:

> As I verified previously, a practical matter, if there were a likelihood of confusion, it would have materialized through actual confusion during the *long* years of active

marketing as noted above. It did not. It did not because the commercial realities of the marketplace, to include the facts that the marks significantly differ in important details, and the market is very crowded and active, and that, as I also verified previously, the customers who purchase fire retardant products are very careful about the brand and source of the product they would purchase since their property and very lives depend on it, as is the case with potential customers as well. The mark, FABRIC FIRE GARD, enjoys strong brand recognition.

I believe that these factors are of overwhelming importance, especially in this crowded field with respect to discriminating customers and potential customers, over such a long time, now over a decade without actual confusion. To repeat, if there were any *likelihood* of confusion, if it had been truly likely, ample opportunity was provided for confusion, and confusion would have materialized in the over *dozen* years since FireGuard was used in national commerce. Again, it has not.

9. Variety of Goods on Which a Mark Is or Is Not Used

Regarding goods of the Appellant and the owner of the applied registration in international class 1, the mark FABRIC FIRE GARD appears on one product of the Appellant, and the mark FireGuard apparently appears on one product. (The mark FIREGUARD itself or within a mark containing it also appears for other goods in international classes 1, 2, 6 and 19.) Customers and potential customers are facilely apprised of the different sources for the products.

This factor favors the Appellant.

10. Market Interface between Appellant and Registration Owner

On or about July 24, 2014, Mr. Bilbro of Shield Industries called No-Burn, Inc., and asked to speak with a manager. He said that there was an issue with No-Burn using FABRIC FIRE GARD, and that he had a registered trademark with FireGuard. Later that day he sent a communication via No-Burn's online contact form, identifying himself, his entity, and his contact information, stating that he had a personal use interest, and that a message had been left that day regarding what he thought was infringement of their trade mark FireGuard registration, as presented to him by one of his employees, and requesting Mr. Kish to immediately cease and desist using FABRIC FIRE GARD in print advertising, literature, and web site, requesting written confirmation that that had been carried out by No-Burn, and stating that if the confirmation was not received by August 15, 2014, he would turn it over to his legal counsel to resolve the issue. Mr. Kish thought that the mark FireGuard was not even being close to being similar, and continued, and yet continues, to use the mark FABRIC FIRE GARD, filing the present application on August 25, 2014. No follow up communication ensued. And, again, no actual confusion was encountered with respect to FireGuard.

Thus, the FireGuard owner apparently retreated from conflict with the Appellant concerning the present mark, a mark that was used in commerce nationally before the mark FireGuard, and which is dissimilar to the present mark. Shield Industries, however, now advertises online for FireGuard for Fabrics.

This favors the Appellant.

11. Extent to Which Appellant Can Rightfully Exclude Others from Using Its Mark

Owing to its national scope advertising and broad sales, years before any use of the mark FireGuard, No-Burn Investments, L.L.C. is in a good position to rightfully exclude others, to include Shield Industries, from using the present mark, which was used first and in commerce at least as early as 1998. The mark FireGuard (filed on March 12, 2010) was apparently only first used in 2003, anywhere on February 26th, in commerce on March 1st. If the present mark and FireGuard are similar and are likely to be confused (which in the real world they are not and should not be) then No-Burn would be able to exclude Shield Industries to a substantial extent.

This favors the Appellant.

12. Extent of Potential Confusion

As explained in this brief and found of record, there is no realistic potential for confusion.

This factor also favors the Appellant.

13. Other Established Probative Facts

According to TESS search of September 6, 2016 (updated 10:09:03 EST), on November 2, 2015, the Office sent a Courtesy E-Reminder to Shield Industries regarding the due date for a section 8 affidavit of use for FireGuard. Apparently, no such declaration has been filed to then. It is possible that Shield Industries could allow its registration to be canceled.

If canceled, this would render the present refusal moot.

In sum, careful review of the declarations and remarks of record, in addition to the present remarks and applicable case law, shows that the present mark distinguishes over the mark FireGuard of Registration No. 3,869,687. Palpable differences exist between the marks, which are perceptible to customers and potential customers in the field. Ample opportunity was provided for any actual confusion to arise, and no such thing occurred, showing that confusion was not likely and so never occurred (zero chance) and accordingly is not likely. The customers and potential customers take great care in deciding whether to purchase the products owing to, among other things, the critical nature of the goods, and the extremely high cost of the substrates and hence associated structures protected thereby, not to forget their very lives. They carefully perceive the differences in the words and presentation. Consideration of the *du Pont* factors, which the Examining Attorney did not address except in an improper, piecemeal manner, favors the Appellant. Taken in its entirety, in light of practical commercial realities, the present mark makes a completely different commercial impression than the applied mark.

Therefore, reversal of the Examining Attorney's refusal is in order, and is requested.

Respectfully,

Dated: Tuesday, September 6, 2016 A.D.

Christopher John Rudy

Christopher John Rudy
USPTO Reg. No. 31,873
209 Huron Avenue, Suite 8
Port Huron, Michigan 48060
Telephone (810) 982-4221

Attmt

United States of America

United States Patent and Trademark Office

FireGuard

Reg. No. 3,869,687

Registered Nov. 2, 2010

Int. Cl.: 1

TRADEMARK

PRINCIPAL REGISTER

SHIELD INDUSTRIES, INC. (GEORGIA CORPORATION), DBA SHIELD INDUSTRIES, INC
131 SMOKEHILL LANE
WOODSTOCK, GA 301887362

FOR: FIRE RETARDANT CHEMICALS, IN CLASS 1 (U.S. CLS. 1, 5, 6, 10, 26 AND 46).

FIRST USE 2-26-2003; IN COMMERCE 3-1-2003.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 77-957,283, FILED 3-12-2010.

ESTHER BELENKER, EXAMINING ATTORNEY

David J. Kappos

Director of the United States Patent and Trademark Office