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Subject: U.S. TRADEMARK APPLICATION NO. 76716811 - NO-BURN FABRIC FIRE GARD - N/A - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 76716811

MARK: NO-BURN FABRIC FIRE GARD



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** No-Burn Investments, L.L.C.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

## **EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant has appealed the trademark examining attorney's refusal to register the trademark NO-BURN FABRIC FIRE GARD on the ground that it is likely to cause confusion with FIREGUARD (Reg. No. 3869687), per Trademark Act Section 2(d), 15 U.S.C. §1052(d).

FACTS

The application to register NO-BURN FABRIC FIRE GARD was filed August 25, 2014. The goods are identified as 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. The refusal to register based on likelihood of confusion with the mark in U.S. Registration No. 3869687 (FIREGUARD) was issued December 10, 2014. The registrant's goods are fire retardant chemicals. The first refusal also included a requirement to disclaim the descriptive words "FABRIC FIRE." Applicant's traversal of the refusal was submitted July 1, 2015. It included both the required disclaimer and a self-serving declaration from William Kish, the president and owner of the applicant. The declaration avers that there is no known actual confusion, and that the differences in the marks, along with the care that consumers of fire retardant compositions normally exercise, preclude any likelihood of confusion. The FINAL refusal to register was sent July 6, 2015. Although no request for reconsideration appears to be of record, an action continuing the final refusal and denying a request for reconsideration was sent February 1, 2016. This Office action appears to have been sent in error, and apology is made for this unnecessary Office action. This appeal followed.

## ARGUMENT

### THE MARKS ARE CONFUSINGLY SIMILAR

NO-BURN FABRIC FIRE GARD and FIREGUARD are similar in appearance, sound and spelling. When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *Id.* FIRE GARD and FIREGUARD have the same commercial impression. The absence of the “U” in the former does not change the pronunciation, as “GARD” and “GUARD” are phonetic equivalents and consequently, there is no difference in sound or commercial impression. The fact that the applicant’s FIRE GARD is two terms while FIREGUARD is a single term also has minimal impact on the visual impression of the marks.

Adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar). Here, “NO-BURN” is the desired result of use, and is therefore suggestive of the goods. “FABRIC” is descriptive of the goods because it indicates what the goods protect. Thus, “FABRIC” has little or no distinctiveness as a source identifier. In the present case, the marks are identical in part.

THE GOODS ARE ESSENTIALLY IDENTICAL

The applicant's goods and those of the registrant are both fire retardant compositions. The applicant's identification of goods limits the fire retardant compositions to those that are water-based and for use on particular materials for commercial and domestic use. Therefore, applicant's identification of goods is completely subsumed by the registrant's identification of goods. The fire retardant "compositions" identified in the application encompass the fire retardant chemicals identified in the registration since "chemicals" are a subset of "compositions" in this context. The definition of "composition" from *The American Heritage Dictionary*<sup>1</sup>:

**com-po-si-tion** (kŏm'pə-zīshən)

*n.*

**1.**

- a.** The combining of distinct parts or elements to form a whole.
- b.** The manner in which such parts are combined or related.
- c.** General makeup: *the changing composition of the electorate.*
- d.** The result or product of composing; **a mixture or compound.**

<https://www.ahdictionary.com/word/search.html?q=composition&submit.x=52&submit.y=24> [emphasis added]

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<sup>1</sup> The Trademark Trial and Appeal Board may take judicial notice of dictionary definitions that (1) are available in a printed format, (2) are the electronic equivalent of a print reference work, or (3) have regular fixed editions. TBMP §1208.04; see *In re Driven Innovations, Inc.*, 115 USPQ2d 1261, 1266 n.18 (TTAB 2015) (taking judicial notice of definition from *Merriam-Webster Online Dictionary* at [www.merriam-webster.com](http://www.merriam-webster.com)); *In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1334 n.1 (TTAB 2009) (taking judicial notice of definition from Dictionary.com because it was from *The Random House Unabridged Dictionary*); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006) (taking judicial notice of definition from *Encarta Dictionary* because it was readily available in specifically denoted editions via the Internet and CD-ROM); TMEP §710.01(c); see also Fed. R. Evid. 201; 37 C.F.R. §2.122(a).

“Compositions” and “chemicals” will therefore be understood by the relevant purchasers to mean the same thing with respect to the goods at issue. Where the goods of an applicant and registrant are identical or virtually identical, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014) (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)).

It is the applicant’s assertion, via the declaration of William Kish, that

The customers who purchase fire retardant products are very careful

about the brand and source of the product they would purchase.

There is no evidence of record to support this statement, and even if consumers are sophisticated or knowledgeable in a particular field, it does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014).

The similarity of the marks and the relatedness of the goods “outweigh any presumed sophisticated purchasing decision.” *In re i.am.symbolic, Llc*, 116 USPQ2d 1406, 1413 (TTAB 2015) (citing *HRL Assocs., Inc. v. Weiss Assocs., Inc.*, 12 USPQ2d 1819, 1823 (TTAB 1989), *aff’d*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990)).

Mr. Kish also states that he is “aware of no case of actual consumer confusion” between the marks at issue. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant’s assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

*In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).

## CONCLUSION

NO-BURN FABRIC FIRE GARD and FIREGUARD are confusingly similar marks. The goods are legally identical fire retardant products. The use of such similar marks on the same fire retardant products portends a great likelihood of confusion. The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002).

For the foregoing reasons, the refusal to register on the basis of §2(d) of the Trademark Act, 15 U.S.C. §1052(d), for the reason that NO-BURN FABRIC FIRE GARD is likely to cause confusion with Reg. No. 3869687 FIREGUARD, should be affirmed.

Respectfully submitted,

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