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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ameristar Fence Products, Inc.

Serial Nos. 77955361 and 77955366¹

Gary S. Peterson of Tomlinson & O'Connell PC for Ameristar Fence Products, Inc.

David Yontef, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Zervas, Kuhlke and Shaw, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

On March 10, 2010, Ameristar Fence Products, Inc. applied to register the stylized mark 440² and the standard character mark 440³ on the Principal Register under Section 1(a) of the Trademark Act, 15 U.S.C. §1052(a), for goods ultimately identified as "metal fences and gates and

¹ These proceedings were consolidated by Board order on August 17, 2011.

² Application Serial No. 77955361, claiming March 9, 2010, as the date of first use and first use in commerce.

³ Application Serial No. 77955366, claiming March 9, 2010, as the date of first use and first use in commerce.

structural component parts thereof for ranching use" in International Class 6.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used with its identified goods, so resembles the registered mark **440-XH** for "steel in the form of metal powder and compacted metal powder and wrought products, namely wire, rod, bar, strip, billet, and other shapes," in International Class 6, as to be likely to cause confusion, mistake or deception.⁴

When there is a question of likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

While we will address the factor of the similarity of the marks, *infra*, the key issue in this case is how to read

⁴ Registration No. 2837897, issued May 4, 2004, Sections 8 and 15 declarations accepted and acknowledged.

the registrant's identification of goods and based on that understanding determine whether the goods, channels of trade and potential customers are related in such a manner that confusion is likely. The interpretation of the identification is critical because, in considering the goods, we must evaluate the relatedness of the goods as they are identified in the registration and application. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

The examining attorney contends that registrant's identification of goods encompasses applicant's goods. Specifically, he argues that:

The goods associated with the cited registration are identified as "steel in the form of metal powder and compacted metal powder and wrought products, namely wire, rod, bar, strip, billet, and other shapes". [Emphasis added]. Contrary to Applicant's limited interpretation of this description, these products are identified broadly and are not restricted to unmanufactured raw materials. Therefore, it is presumed that the application encompasses all goods of the type described, including wrought fence and gate products made of steel such as wires, posts, bars and rails, which are undeniably commercially-related to Applicant's goods and move in the same channels of trade to the same consumers.

Ex. Att. Br. p. 7.

In addition, the examining attorney points to the definitions of the words wrought, shape, wire and post⁵ and from them concludes that:

Based on these definitions, the "wrought products, namely wire, rod, bar, strip, billet, and other shapes" covered by the registered mark include steel wire fences, steel posts for fences and gates and other manufactured products for metal fences and gates. Moreover, contrary to Applicant's assertion, the registered goods must not be "construed to cover only shapes similar to the five listed solid steel mill products."

Ex. Att. Br. p. 8.

We do not agree with the examining attorney's interpretation of the scope of the identification of goods listed in the registration, "steel in the form of metal powder and compacted metal powder and wrought products, namely wire, rod, bar, strip, billet, and other shapes." This identification, clearly and unambiguously does not

⁵ Wrought: 3. processed for use; manufactured. Shape: form, create; especially: to give a particular form or shape to. Merriam-Webster's Collegiate Dictionary (10th ed. 2000). The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (Board may take judicial notice of dictionary definitions).

Wire: fencing; fence of usually barbed wire. Post: a strong thick pole made of wood or metal that is put upright in the ground, used as part of a fence, gate, etc. Final Office Action mailed January 31, 2001, respectively, Merriam-Website Online Dictionary 2011 and MacMillan Online Dictionary 2011.

include finished products, such as fencing or fence posts, made of steel. Taken as a whole, registrant's identification is not so open-ended to include finished products, such as fencing and structural component parts thereof. The wording, "steel in the form of" clearly limits "and other shapes" to steel products used as raw materials for further manufacture into end products. The examining attorney's contention that "wire" in this identification would include "barbed wire" or "fencing wire," simply does not comport with the common understanding of that term in the steel industry and as used in registrant's identification of goods, as demonstrated by the record. See, e.g., App. Recon. Exhibit 7 (United States International Trade Commission Report on Steel Consuming Industry 2003). The wire referred to in the context of this identification does not encompass an end use product. Rather, it is in a form that would only be sold to a steel fabricator for further processing into an end use product. Id.

The identification is clearly limited to raw steel products for use in the manufacture of other products. Not that it is necessary, but, registrant's website corroborates this interpretation wherein it states that it is "a leading manufacturer and distributor of specialty

alloys, including stainless steel and titanium." App. Recon. Exhibit 5.

Thus, the questions are (1) whether applicant's metal fencing for ranching use is commercially related to registrant's steel in raw material form, (2) whether the goods travel in the same channels of trade, and (3) whether they are purchased by the same classes of customers.

In support of his position, the examining attorney submitted 48 third-party registrations and excerpts from 12 third-party websites. The bulk of this evidence, at best, does not support his position, and at worst, undercuts his position in that they show only evidence of end use steel products, such as fencing, and do not include registrant's goods. This is not surprising given the structure of the industry where steel mills forge and extrude the steel shapes, steel distributors broker with fabricators who further manufacture the wire, rod or billet into end use products for as many fields of use as can be imagined. There are a handful of registrations that include "fencing" and some of registrant's goods (see, e.g., Reg. No. 2061006 for, inter alia, "steel in sheet, rod, billet form" and "metal fence posts"); however, given the structure of this industry, as reflected in the evidence of record regarding the steel industry, see, e.g., App. Recon. Exhibit 7, the

way in which steel raw material is sold, and the number of third-party registrations that pointedly do not include both registrant's and applicants' goods, we do not find these third-party registrations probative on this issue. If anything, the majority of the third-party registrations reveal the distinction between the steel mill/manufacturer and the steel fabricator that further processes the steel for some limited end products or for use for further processing into other end products made of steel. Moreover, 11 out of the 12 third-party websites are for retail operations such as Lowe's, Home Depot and Jim's Supply that merely offer manufactured end use steel products, and certainly not steel in "wire, rod, strip or billet" shapes. Thus, in considering the respective goods we find that they are not so related that the use of the respective marks is likely to cause confusion.

In view of our findings regarding the differences in the goods, we cannot presume an overlap in trade channels and, indeed, the record points to the conclusion that the trade channels do not overlap, other than to the extent a steel fabricator manufacturing the component parts for a fence may purchase the steel raw material from a steel manufacturer such as registrant. See, e.g., App. Recon. Exhibit 7 (flow diagram in U.S. International Trade

Commission report on the steel industry) and Exhibit 16 to (declaration of Keith Armour, applicant's Vice President). In that instance, however, the purchasing decision is made very carefully by sophisticated consumers. See Armour Dec. Exhibit 16. We further note that even if we relied on those third-party registrations that include both applicant's and registrant's goods as sufficient to find the goods to be related, the only overlapping trade channel would still be at the level of purchasing a raw steel product inasmuch as registrant's identification does not include the end use products. Here, also, the sophisticated nature of the purchase would obviate likely confusion. *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992); *In re N.A.D., Inc.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985); *In re Digirad Corp.*, 45 USPQ2d 1841 (TTAB 1998); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006).

In view thereof, we find that applicant's goods are not related to registrant's goods. Moreover, to the extent there is any overlap in the channels of trade and classes of customers, applicant's goods are sufficiently distinct from registrant's goods and would be purchased with sufficient care to preclude likely confusion. The nature

of registrant's goods is such that any potential consumer would be knowledgeable or discriminating and the purchasing decision would not be based on impulse but rather would be subject to a more deliberative process.

We turn now to consider the marks. In determining the similarity between the marks, we analyze "the marks in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) quoting *du Pont*, 177 USPQ at 567.

Applicant argues that the XH in registrant's mark is the dominant element because the 440 in the steel industry has a descriptive or highly suggestive connotation and, therefore, the presence of the XH is sufficient to distinguish the marks. Conversely, the examining attorney rejects applicant's evidence on this point and contends that 440 is the dominant portion of registrant's mark because "consumers are more inclined to focus on the first word, prefix or syllable in any trademark." *Ex. Att. Br.* p. 4.

We find applicant's evidence probative to show that the number 440 has a specific meaning in the steel industry. In support of this contention applicant

submitted: (1) excerpts from websites wherein registrant's product is described as having the "high hardness Type 440C stainless steel" (see, e.g., App. Response filed on December 13, 2010, Exhibit B, www.carttech.com); an excerpt from the Wikipedia website wherein 440 is described as a type of steel grade originally developed by the American Iron and Steel Institute (AISI) and followed by the Society of Automotive Engineers (SAE) that is "one of the hardest stainless steel" (id., Exhibit C, <http://wikipedia.org>); (3) registrant's U.S. patent for a steel alloy described as providing "corrosion resistance that is similar to Type 440C alloy" and explaining that "AISI Type 440C alloy has been used in applications, such as bearings and bearing races," (id., Exhibit D); (4) a technical data sheet for registrant's goods describing it as having the "high hardness 440C stainless steel" (App. Req. for Recon. filed on May 18, 2011, Exhibit 4); (5) the Handbook of Stainless Steels (McGraw Hill 1977) (id., Exhibit 13); and (6) the index of the Society of Automotive Engineers standards for metals and alloys (9th ed. 2001) (id. Exhibit 14).

Thus, the common element is the weaker portion of registrant's mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (It is well settled that one feature of a mark may be more significant

than another, and it is not improper to give more weight to this dominant feature when evaluating the similarities of the marks.) That being said, the XH is not particularly distinctive and is subordinate to the 440 in that it appears as a specific designation under the 440 category and to that extent applicant's mark could appear as another variant in registrant's line of goods if applicant's goods were related. However, we must consider this factor in the context of the respective goods. With regard to applicant's fencing for ranching use, applicant contends and the examining attorney does not dispute, that "[i]f '440' means anything at all to these customers, it merely evokes the equestrian context of the 440-yard quarter horse racing event. Such agricultural customers would not associate '440' with a specialty steel of any kind..." App. Br. p. 2.

Thus, the dissimilarities in connotation and overall commercial impression engendered by the differences in the goods outweighs the similarities in sound and appearance. *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600 (TTAB 2010), aff'd and remanded on different issue, ___ F.3d ___, 101 USPQ2d 1713 (Fed. Cir. 2012); *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987); *In re British Bulldog*,

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Ltd., 224 USPQ 854 (TTAB 1984); and In re Sydel Lingerie Co., Ltd., 197 USPQ 629 (TTAB 1977).

In conclusion, we find that because the marks are dissimilar, the goods are not related, and to the extent the channels of trade overlap at the manufacturing level, registrant's goods are subject to careful purchasing by sophisticated purchasers, confusion is not likely between applicant's mark for its identified goods and the mark in the cited registration.

Decision: The refusal to register under Section 2(d) of the Trademark Act is reversed.