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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/389392

APPLICANT: Masonite International Corporation

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

CORRESPONDENT ADDRESS:
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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's FINAL refusal to register the proposed mark CAVALIER for "non-metal doors made from wood composite and solid wood components," in International Class 19. Registration was refused on the Principal Register pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1152(d) on the ground that the applicant's mark is likely to be confused with the prior registered mark U.S. Reg. No. 2651882, CAVALIER, for "non-metallic railings, guardrails, handrails and banisters for use in and/or on buildings," in International Class 19. It is respectfully requested that this refusal be affirmed.

FACTS

On March 23, 2004, the applicant filed an application to register the standard character mark **CAVALIER for "non-metal doors made from wood composite and solid wood components,"** in International Class 19. In an office action dated October 4, 2004, the examining attorney refused registration based upon Section 2(d) of the Trademark Act, citing U.S. Reg. No. 2651882 for the mark **CAVALIER for "non-metallic railings, guardrails, handrails and banisters for use in and/or on buildings."** The applicant did not respond to the office action, and the application was abandoned on May 2, 2005. The applicant submitted a Petition to Revive and a response to the previously issued office action on June 27, 2005. In its response, the applicant argued against the substantive refusal of registration. In traversing the examining attorney's refusal based upon Section 2(d) of the Trademark Act, the applicant asserted that the marks and the goods of the parties are sufficiently dissimilar to avoid a likelihood of confusion. The applicant argued that " a non-metal door marketed under the mark "Cavalier" would not create confusion in the marketplace as to its source." The applicant also argued that "a consumer purchasing an exterior railing system for a commercial building is not likely to confuse such products with doors. Furthermore, consumers of railing and guardrail systems used on buildings are relatively sophisticated, given such systems are quite expensive and are not impulse purchase-type products."

The examining attorney, finding the applicant's arguments unpersuasive, made the refusal of registration FINAL in an office action dated August 31, 2005. The examining attorney provided additional excerpts from the *Trademark X-Search Database* and third-party website excerpts as further evidence that the applicant's and registrant's goods are likely to be marketed under circumstances leading to confusion within the

marketplace. The applicant requested a reconsideration of the refusal of registration under Section 2(d) on December 23, 2005. On February 28, 2006, the examining attorney denied the request for reconsideration of the final refusal. On April 13, 2006, the applicant filed an appeal brief.

ARGUMENT

Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark, that it is likely, when applied to the goods or services, to cause confusion, or to cause mistake or to deceive. TMEP section 1207.01. The Court in *In re E. I. DuPont 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). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and services, and similarity of trade channels of the goods and services. The overriding concern is to prevent buyer confusion as to the source of the goods and services. *Miss Universe, Inc. v. Miss Teen U.S.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).

A. The Marks Are Confusingly Similar

The applicant does not dispute that the marks are identical. If the marks of the respective parties are identical, the relationship between the goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981); TMEP §1207.01(a).

B. <u>The Goods Are Related</u>

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 goods and services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

The applicant submits that the "Applicant's goods are used as entry doors, such as residential entry doors," and "does not include non-metallic railings, guardrails, handrails or banisters used on or in buildings." Therefore the applicant asserts that "[a] consumer

would not confuse a railing for a door. Nor are railing and doors likely to be substituted for each other." Although the applicant "recognizes that there is no restriction in the registration about trade channels," the applicant still submits that "commercial reality establishes how the registrant distributes its products to consumers." Applicant's Appeal Brief, pages 4-5.

A determination of whether there is a likelihood of confusion is made solely on the basis of the goods and/or services identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999). If the cited registration describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639 (TTAB 1981); TMEP §1207.01(a)(iii). Therefore, the examining attorney must consider how the goods are marketed within the confines of the registration, and cannot rely upon the registrant's website as to how the goods are marketed.

The fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein. Any goods or services in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's goods or services are related to

the applicant's identified goods or services for purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe the product or service is within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v).

In the initial and final office actions, the examining attorney provided evidence that the goods of the respective parties are commonly produced by the same party and used for the same purposes. The examining attorney included excerpts from third-party websites [1) www.superiorseal.com; 2) www.allisind.com; 3) www.treborusa.com; 4) www.canexbuilding.com/doors_moldings.htm], and seven third-party registrations of marks (Registration Nos. 1465480, 2133038, 2169432, 2329505, 2423444, 2670009 and 2887319) marketing similar type of goods identified in the applicant's and registrant's identifications, including doors and railings. The examining attorney provided this evidence to support the position that the goods of the respective parties are commonly produced by the same party and marketed under the same trademark.

Clearly, the evidence demonstrates that the goods are related and are likely to be marketed within the same channels of trade. The applicant's reliance on the "sophisticated purchaser" is not persuasive. Where the relevant consumer is comprised of both professionals and the general public, the standard of care when purchasing the goods is equal to that of the least sophisticated purchaser in the class. *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1304 (TTAB 2004) (as stated in *KOS Pharmaceuticals Inc., v. Andrx Corp.*, 369 F.3d 700, 70 USPQ2d 1874 (3d Cir. 2004), and citing *Checkpoint Sys., Inc., v. Check Point Software Techs., Inc.*, 269 F.3d 270, 285,

60 USPQ2d 1609, 1617-1618 (3d Cir. 2001)). Therefore, the applicant's assertion that "a skilled contractor would not be confused between a non-metal door and a railing, handrail, guardrail or banister," is not persuasive. Applicant's Appeal Brief, page 6. The fact that purchasers are sophisticated or knowledgeable in a particular field 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); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). TMEP §1207.01(d)(vii).

The applicant has submitted in its Appeal Brief copies of results from TARR web server and internet searches including the word 'cavalier.' Applicant's Appeal Brief, page 7; Exhibits B, C and E at Appendix pgs. 12-27,33-71. The examining attorney objects to the submission of these exhibits as untimely. The record in any application must be complete prior to appeal. 37 C.F.R. §2.142(d); TMEP §710.01(c); TBMP §§1207.01 *et seq.* *See Rexall Drug Co. v. Manhattan Drug Co.*, 284 F.2d 391, 128 USPQ 114 (C.C.P.A. 1960); *In re Psygnosis Ltd.*, 51 USPQ2d 1594 (TTAB 1999). Even if applicant has shown that the cited mark is "weak," such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services. *See Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976) and cases cited therein.

Purchasers encountering the marks are likely to assume that the applicant's and registrant's goods emanate from a common source. These potential purchasers are likely to erroneously believe that the applicant's "non-metal doors made from wood composite and solid wood components" are an expansion product or complementary product in the

registrant's product line of "non-metallic railings, guardrails, handrails and banisters for use in and/or on buildings."

The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990), and cases cited therein. *See also In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984), wherein the 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 registrant has no chance to be heard (at least in the absence of a consent agreement, which applicant has not submitted in this case). *Id*. at 1026-1027.

Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

CONCLUSION

The applicant's mark CAVALIER is confusingly similar to the registered mark CAVALIER because the marks are identical. The marks are used on goods that are produced by the same parties and marketed through similar channels of trade. For the foregoing reasons, the refusal to register on the basis of § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), should be affirmed.

Respectfully submitted,

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