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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Duro-Last, Inc.

Serial No. 85746099

Richard W. Hoffmann of Reising Ethington PC for Duro-Last, Inc.

Fred Carl III, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence,
Managing Attorney).

Before Taylor, Shaw, and Gorowitz, Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Applicant, Duro-Last, Inc., filed an application to register on the Principal Register the mark DURO-LIGHT in standard characters for goods identified as: “metal skylights” in International Class 6 and “non-metal skylights” in International Class 19.¹

The examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of a likelihood of confusion with the

¹ Application Serial No. 85746099, filed on October 4, 2012 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on a bona fide intent use of the mark in commerce.

mark in U.S. Registration No. 2002140, DURULITE, (in typed form²) for “non-metal doors” in international Class 19.³

When the refusal was made final, Applicant filed this appeal and requested reconsideration. Upon reconsideration, the Examining Attorney maintained the refusal to register. The case is fully briefed. For the reasons discussed below, we affirm the refusal to register.

Evidentiary Objection

Before addressing the substance of this appeal, we first consider the Examining Attorney’s objection to Applicant’s submission of new evidence with its appeal brief as untimely, namely, exhibits A and C-I.⁴ Trademark Rule 2.142(d) provides in relevant part that “[t]he record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed.” Insofar as the Examining Attorney has timely interposed an objection to Applicant’s late-filed evidence in its brief, the objection is sustained, and exhibits A and C-I submitted concurrently with Applicant’s appeal brief have been given no consideration.⁵ *See e.g., In re Fiat Group Mktg. & Corporate Commc’ns S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014) (Examining

² Prior to 2003, “standard character” marks were known as “typed” marks, but the nomenclature was changed to conform to the Madrid Protocol. The change to “standard character” from “typed” marks does not change the interpretation of the scope of such marks.

³ Issued September 24, 1996, Section 8 filed, renewed.

⁴ Examining Attorney’s Appeal Br. at 2.

⁵ We hasten to add that this evidence, even if considered, would not have changed the result herein.

Attorney's objection to Applicant's submission of registrations with appeal brief sustained.).

Analysis

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (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/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). In this case, Applicant also submitted evidence regarding the strength of the marks and the use of similar marks by Applicant and third parties.

A. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression

We begin by considering the marks, comparing them for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Applicant's mark is DURO-LIGHT in standard characters. Registrant's mark is DURULITE in typed form.

The Examining Attorney argues that the marks sound "essentially identical," share "most of the same letters . . . in the same order," and have the same meaning, connotation and commercial impression, in that they "call to mind" a combination of

the words durable and light.⁶ Applicant argues that the differing characters and the addition of a hyphen to its marks serve to distinguish the marks in appearance and sound.⁷

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). We find that the difference in sound between DURO-LIGHT and DURULITE is, at best, very slight and is unlikely to be noticed when the marks are spoken. Additionally, we find that the marks are similar in appearance in that they both begin with the term DUR- followed by LIGHT or its alternative spelling, LITE.

Applicant also argues that the connotation of the marks is distinct as well because its mark connotes Applicant’s goods’ “ability to illuminate or transmit sunlight” whereas registrant’s use of LITE connotes that its goods are “light-weight.”⁸ This argument is unpersuasive. Both marks are similar in meaning, connotation and commercial impression because they both suggest a combination of “durability” and “light.” There is nothing inherent in the nature of the respective goods that prevents them from both transmitting light and being light-weight. That is, it is just as plausible for consumers to think that both parties’ goods will

⁶ Examining Attorney’s Appeal Br. at 4-5.

⁷ Applicant’s Appeal Br. at 5.

⁸ *Id.*

transmit light as it is for consumers to think that the parties' goods are light-weight.

Lastly, Applicant argues that the marks are distinguishable because Registrant, seeking to overcome a likelihood of confusion refusal in its underlying application, “acknowledged that marks with common DUR prefixes can be different in sight and sound.”⁹ This argument fails for several reasons. We do not have the complete record of the application underlying the cited registration, thus, we do not know the full context in which the statement was made. Additionally, the marks and identified goods cited against Registrant in its underlying application were different from the marks and the goods in this case. We cannot find that Registrant’s argument compels the conclusion that any DUR- formative mark with a differing suffix is thus entitled to registration. Finally, we are not bound to accept Registrant’s earlier arguments because “[s]uch statements cannot be viewed as binding judicial admissions, since a decision maker may not consider a party’s opinion relating to the ultimate legal conclusion of likelihood of confusion (particularly in another case) as a binding admission of a fact.” *In re Sela Prods., LLC*, 107 USPQ2d 1580 (TTAB 2013) citing *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 929, 198 USPQ 151, 154 (CCPA 1978) (“that a party earlier indicated a contrary opinion respecting the conclusion in a similar proceeding involving similar marks and goods is a fact, and that fact may be received in evidence as merely illuminative of shade and tone in the total picture confronting the decision maker.”). *See also, In re Majestic Distilling*, 65 USPQ2d at

⁹ *Id.* at 6.

1206 (Arguments regarding likelihood of confusion made by Registrant in earlier applications may no longer be valid in light of changing circumstances.).

In sum, we find the slight differences between the marks are insufficient to outweigh their greater similarities. Slight differences in marks do not normally create dissimilar marks. *See, e.g., In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985); *In re Bear Brand Hosiery Co.*, 194 USPQ 444, 445-46 (TTAB 1977).

B. The similarity or dissimilarity and nature of the goods described in the application and registration

We next turn to the goods. It is settled that goods need not be similar or competitive in nature to support a finding of likelihood of confusion. The question is not whether purchasers can differentiate the goods themselves, but rather whether purchasers are likely to confuse the source of the goods. *See Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Further, in an *ex parte* appeal, likelihood of confusion is determined on the basis of the goods and services as they are identified in the application and the cited registration. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Applicant's goods are "metal skylights" and "non-metal skylights." Registrant's goods are "non-metal doors." It is clear that the goods are not the same or even complementary. The Examining Attorney, nevertheless, argues that "manufacturers sell both skylights and doors under a single trademark" and that "within the industry these goods are considered related to each other."¹⁰ In support

¹⁰ Examining Attorney's Appeal Br. at 7.

of the refusal, the Examining Attorney made of record six third-party registrations showing that both Applicant's and Registrant's types of goods are offered under a single mark by others:¹¹

- U.S. Registration No. 3510003 for the mark CONSERVAFRAMING used on skylights and doors in both classes 6 and 19;
- U.S. Registration No. 3192082 for the mark RINTAL and design used on skylights and doors in both classes 6 and 19;
- U.S. Registration No. 1869215 for the mark CRESTLINE used on skylights and doors in both classes 6 and 19;
- U.S. Registration No. 3302374 for the mark THERMABOND PLUS used on metal doors and skylights;
- U.S. Registration No. 4034600 for the mark 24 HOUR ROOM used on skylights and doors; and
- U.S. Registration No. 4040704 for the mark YOUR FENESTRATION SOLUTION CENTER used on retail store services featuring windows, doors, and skylights.

Although such third-party registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless may have probative value to the extent they are based on use in commerce and serve to suggest that the goods and services identified therein are of a kind which may emanate from a single source under a single mark., i.e., that the same entity may provide skylights and doors under the same mark. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); and *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

¹¹ Office Actions of February 8, 2013 and August 27, 2013.

The Examining Attorney also made of record a number of internet web pages, including the following five pages, suggesting that both Applicant's and Registrant's identified goods are offered under a single mark by others:¹²

- pella.com – a website showing a line of doors and skylights offered by the same manufacturer;
- wdma.com – the website of a trade group called the Window & Door Manufacturers Association discussing industry news. Several stories describe events involving the “window, door, and skylight industry” or legislative policies affecting “windows, doors, and skylights;”
- ecobrownstone.com – a home renovation website with an article on energy efficiency entitled “Window, Skylight and Door Basics—Increasing Energy Efficiency;”
- cadillacwindow.com – a retail website offering window, door, and skylight installation; and
- beharwindows.com – a manufacturer's website offering impact resistant windows, doors, and skylights.

As with the third-party registrations, the examining attorney argues that this internet evidence shows “that skylights and doors are related because at all stages they are found together, from manufacture through use.”¹³

We find that the third-party registrations suggest that skylights and doors may emanate from a common source and that the third-party website evidence is competent to show that some manufacturers use a single mark to identify both Applicant's and Registrant's types of goods. This evidence shows that consumers searching for information about doors or skylights will likely see them commonly associated with each other, either by brand, by retailer, or by installation. Based upon this evidence we find that Registrant's goods are related to those provided by

¹² *Id.*

¹³ Examining Attorney's Appeal Br. at 8.

Applicant for purposes of our determination herein. As a result, this *du Pont* factor favors a finding of likelihood of confusion.

C. Purchaser sophistication

Applicant argues that there is less of a potential for confusion because its skylights and Registrant's doors are relatively expensive and they are sold to "business contractors who are sophisticated and knowledgeable professionals."¹⁴ Our consideration of relevant customers is not limited to the types of customers identified by Applicant in its arguments. Rather, we must look to the identification of goods in the application and the registration and assume that the goods are available to all classes of purchasers for such goods. *See Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."). The Pella, Anderson, Cadillac, Ecobrownstone, and Behar websites show that information about doors and skylights is often directed to homeowners as well as to professionals in the building and home improvement trade. We see no reason to assume that the goods will only be sold to "business contractors who are sophisticated and knowledgeable professionals."

¹⁴ Applicant's Appeal Br. at 8.

Even assuming that Applicant's and Registrant's goods may involve a careful purchase, it is settled that 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, especially in cases such as the instant one involving similar marks and related goods. *See, e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014). As a result, we find little to persuade us that any consumer sophistication would play a role in avoiding a likelihood of confusion. This factor favors a finding of likelihood of confusion.

D. The number and nature of similar marks in use on similar goods

We next consider the strength of the marks and third-party use of similar marks on similar goods. Evidence of third-party use falls under the sixth *du Pont* factor: the “number and nature of similar marks in use on similar goods.” *Du Pont*, 177 USPQ at 567. If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imports*, 73 USPQ2d at 1693. Applicant contends that the existence of other similar marks in use on similar goods entitles Registrant's mark to only a narrow scope of protection, specifically, “to the goods described in its registration.”¹⁵ We disagree.

Absent evidence of actual use, third-party registrations are of limited probative value for the *du Pont* factor showing a crowded field and relative weakness.

¹⁵ *Id.* at 9.

Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 917, 189 USPQ 693, 694 (CCPA 1976) (third-party registrations “are entitled to little weight on the question of likelihood of confusion where there is no evidence of actual use” of the marks therein.). *See also In re Nett Designs Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if prior registrations had some characteristics similar to [Applicant 's] application, the PTO's allowance of such prior registrations does not bind the Board or this court.”).

Moreover, based on the limited record before us, we have no way of knowing whether any of the owners of the other marks are related or whether they have entered into consent-to-use agreements permitting use of the marks on the various products. Accordingly, this *du Pont* factor is neutral.

E. The nature and extent of any actual confusion

Applicant states that it is “unaware of any existence of actual confusion between the DURULITE and DURO-LIGHT marks.”¹⁶ Additionally, Applicant claims that Registrant’s mark was “able to coexist for years” with the previously registered mark, DURA-LIGHT, also for skylights.¹⁷ Thus, Applicant argues, “any potential for confusion . . . is theoretical speculation that is not sufficient to support a rejection based on likelihood of confusion.” We disagree.

As we have stated before, “[t]he fact that an applicant in an *ex parte* case is unaware of any instances of actual confusion is generally entitled to little probative

¹⁶ *Id.* Inasmuch as Applicant’s application is based on an allegation of an intent to use the mark and no affidavit of use has been filed, we see no opportunity for confusion to have occurred.

¹⁷ *Id.*

weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion. Nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred.” *In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001); *see also In re Nett Designs*, 57 USPQ2d at 1566 (“The Board must decide each case on its own merits.”).

F. Other established fact probative of the effect of use

Applicant also argues that it is entitled to registration because it is the owner of numerous registrations containing the “formative DURO- prefix” for roofing products.¹⁸ This argument is unpersuasive. A family of marks argument is not available to an Applicant seeking to overcome a likelihood of confusion refusal in an *ex parte* proceeding. The focus of the likelihood of confusion analysis must be on the mark Applicant seeks to register vis-à-vis the cited mark, not other marks Applicant may have used or registered. *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1645 (TTAB 2009).

G. Balancing the factors

After considering all of the applicable *du Pont* factors, we find that Applicant’s mark, DURO-LIGHT, for both metal and non-metal “skylights” is likely to cause confusion with the cited mark, DURULITE, for “non-metal doors.”

Decision: The refusal to register is affirmed.

¹⁸ *Id.* at 11.