

**THIS OPINION  
IS NOT A PRECEDENT OF  
THE TTAB**

Mailed: March 21, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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A Corp. *dba* Rooter Man  
v.  
Pete Wood Plumbing and Heating Co.

—————  
Opposition No. 91187976  
to Application No. 77374984  
filed on January 18, 2008  
—————

Jenny J. Liu of Jenny J. Liu Law Office for A Corp. *dba*  
Rooter Man.

Peter J. Wood of Pete Wood Plumbing and Heating Co., *Pro Se*.

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Before Walters, Bergsman and Mermelstein, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

A Corp. *dba* Rooter Man filed its opposition to the application of Pete Wood Plumbing and Heating Co. to register the mark ROOTER, MD for "plumbing services," in International Class 37.<sup>1</sup> The application includes a disclaimer of ROOTER apart from the mark as a whole.

<sup>1</sup> Application Serial No. 77374984, filed January 18, 2008, based upon use of the mark in commerce, alleging dates of first use and first use in commerce as of October 8, 2004.

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's services so resembles opposer's previously used and registered marks shown below as to be likely to cause confusion, under Section 2(d) of the Trademark Act.<sup>2</sup> Opposer also asserts a claim of false suggestion of a connection with opposer, under Section 2(a) of the Trademark Act, and a claim of dilution, under Section 43(c) of the Trademark Act.

**Registration No. 1654512** (registered 8/20/91; Section 15 affidavit acknowledged; renewed)

**Mark:**



**Services:** "cleaning and repairing septic systems and clearing clogged pipes and drains," in International Class 37.

**Registration No. 1655782** (registered 9/3/91; Section 15 affidavit acknowledged; renewed)

**Mark:**



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<sup>2</sup> Although opposer also asserted a claim of false suggestion of a connection with opposer, under Section 2(a) of the Trademark Act, although opposer did not pursue this claim in its brief and, therefore, we consider it waived. Additionally, opposer's pleading includes a claim that the parties' Internet domain names are confusingly similar. The Board determines only trademark registrability, not the validity of domain name registrations. Therefore, this claim has been given no consideration except as any such facts established may be relevant to the Section 2(d) claim.

**Services:** "cleaning and repairing septic systems and clearing clogged pipes and drains," in International Class 37. [The lining is a feature of the mark and does not indicate color.]

Applicant, in its answer, denied the salient allegations of the claims.

*The Record*

By operation of the Trademark Rules, the record includes the pleadings and the file of the involved application. Additionally, opposer has made of record, by notice of reliance, copies of its pleaded Registration Nos. 1654512 and 1655782 showing status and title; various specified responses of applicant to opposer's interrogatories; and printouts from the USPTO database showing status and title of the opposed application and of an application previously filed by applicant. Opposer has also made of record the testimony deposition by opposer of Donald F. MacDonald, the founder of opposer's A Corp Rooter Man Franchise Systems, with accompanying exhibits.<sup>3</sup> Both parties filed briefs on the case.

*Factual Findings*

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<sup>3</sup> During its testimony period, applicant submitted a written statement of Peter Wood. Opposer filed a motion to strike this statement, which was granted in the Board's order of July 28, 2010. Mr. Wood's statement and the affidavit of Mr. MacDonald submitted by opposer with its motion to strike have been given no consideration herein. Applicant also submitted a notice of reliance on opposer's notice of reliance and supporting documents, which is unnecessary as opposer has already made these documents of record.

Opposer, in business since 1970, is a plumbing, sewer and drain cleaning business that is also a franchise system. It began using the marks shown in its pleaded registrations in the 1980's. In 2009, opposer had 108 franchisees operating 461 units in 39 states, including Michigan, Massachusetts, New Hampshire, and Maine. Opposer has used its mark in advertising in Yellow Pages ads, on trucks, billboards, coupons and fliers. Opposer also conducts direct mail campaigns. For each year from 2003 to 2007, *Entrepreneur Magazine* ranked opposer No. 1 in its plumbing category within its Annual Franchise 500 listing. The magazine also ranked opposer as No. 119 in 2007, and no. 87 in 2008, among the top 500 franchises in the United States.

Opposer regularly attends and has booths at trade shows for the sewer, drain and plumbing industry. Mr. MacDonald, opposer's principal, acknowledges meeting Mr. Wood, applicant's principal, at these shows, in particular at the 2007 pumper show in Nashville, TN, and at the 2008 pumper show in Louisville, KY.

Applicant began using its mark in connection with the identified services on October 10, 2004. Applicant renders its services to home owners, commercial property owners and property management companies. Applicant advertises on the Internet, in the Yellow Pages, in magazines and on the radio. Applicant became aware of opposer's ROOTER MAN brand

when Mr. Wood, applicant's principal, visited opposer's booth at the pumper trade show in Nashville, TN, in February, 2007. Mr. Wood also attended the pumper trade show in Louisville, KY, in 2008 and attended a seminar given by Mr. MacDonald, opposer's principal.<sup>4</sup>

*Analysis*

*Standing*

Because opposer has properly made its pleaded registrations of record, we find that opposer has established its standing to oppose registration of applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

*Section 2(d) Claim*

*Priority*

In view of opposer's ownership of valid and subsisting registrations, there is no issue regarding opposer's priority. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Thus, the only issue to decide with respect to this claim is likelihood of confusion.

*Likelihood of Confusion*

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<sup>4</sup> Factual findings about applicant are based on applicant's responses to opposer's interrogatories made of record by opposer.

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein. The relevant *du Pont* factors in the proceeding now before us are discussed below.

#### *Fame*

Opposer alleges that its marks are famous in connection with its services. Fame of the prior mark plays a dominant

role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public...recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1694. As previously noted, given the nature of opposer's services, the relevant consuming public herein comprises, at least in part, the general public.

Opposer's only evidence going to the renown of its mark is its years of use, its ranking in the *Entrepreneur Magazine* annual top franchisee listings, and the extent of its franchising operation. However, there is no evidence indicating opposer's volume of sales or advertising expenses, where opposer advertises, how many consumers encounter opposer's marks and how many times consumers encounter those marks, any context for its achievements in the field (e.g., marketshare), or any information from which we can infer the renown of the mark to the consuming public. See *In re Bose, supra*. Because of the extreme deference that we accord a famous mark in terms of the wide latitude

of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

In this case, we find that opposer has not established the renown of its marks to any degree and, in particular, opposer has not established that its marks are famous. This *du Pont* factor is, thus, neutral in our evaluation of the likelihood of confusion.

#### *The Services*

It is well established that the goods and/or services of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue,



of course, is not whether purchasers would confuse the goods and/or services, but rather whether there is a likelihood of confusion as to the source of the goods and/or services. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). The question of likelihood of confusion must be determined based on an analysis of the goods and/or services recited in applicant's application vis-à-vis the goods and/or services identified in opposer's pleaded registration(s). *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992).

Applicant's broadly identified "plumbing services" clearly encompass opposer's identified "cleaning and repairing septic systems and clearing clogged pipes and drains." Thus, the parties' goods are overlapping and, to this extent, identical.

This *du Pont* factor supports a finding of likelihood of confusion.

#### *Trade Channels and Classes of Purchasers*

As indicated above, applicant's services encompass opposer's services and, to this extent, the services are legally identical. Thus, we must presume that they are rendered in identical trade channels and are purchased by the same consumers. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003); *In re Smith and Mehaffey*, 31 USPQ2d 1531,

1532 (TTAB 1994). The purchasers include the general public.

These *du Pont* factors support a finding of likelihood of confusion.

#### *The Marks*

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the services offered under the respective marks is likely to result. However, we are guided, equally, by the well established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Our focus is on the recollection of the average purchaser, who normally retains a general rather than a

specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Applicant's mark is ROOTER, MD in standard characters. We will focus our analysis on a comparison of opposer's first design mark, in Registration No. 1655782, to applicant's mark because it is the most similar of the two marks owned and established by opposer in this record. The mark is repeated below:



Opposer's mark consists in part of the word ROOTER-MAN with a design that appears as a reinforcement and carrier partially surrounding the word portion of the mark. The design consists of a man with wings to the left of the wording holding a line that goes between two lines under the wording portion of the mark. In the context of opposer's services, the design portion of the mark suggestively connotes a plumber snaking a line through a clogged plumbing or sewer pipe. We find that the word portion of the mark is dominant. Moreover, it is the wording ROOTER-MAN that would be used by purchasers asking for opposer's services. Thus, the wording would make a greater impression on purchasers and is the portion that is more likely to be remembered as the dominant and source-signifying portion of the registered mark. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593 (TTAB

2001) ("words are normally accorded greater weight because they would be used by purchasers to request the goods"). See also, e.g., *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (1987).

The terms ROOTER and MAN in opposer's mark are visually distinct from one another because, not only are they separated by a small hyphen, but ROOTER appears in dark letters and MAN appears as an outline of white letters. Within the word portion of the mark, we find that ROOTER is the dominant portion thereof. Not only is it the first word in the mark and appears in dark letters, but MAN is likely to be understood as suggesting the person who renders opposer's services. In this regard, we note that the second term in applicant's mark is MD and it too is likely to be understood as suggesting the person who renders the services.

Furthermore, there is absolutely no evidence of any meaning of the term ROOTER in relation to the services, nor is there any evidence of third-party use or registration of the term ROOTER in connection with the same or similar services. In this regard, we remind the parties that we make our determination based only on the evidentiary record before us. As such, we must conclude that ROOTER is an arbitrary and strong term in connection with the respective services of the parties and the identical word appears as the first word in applicant's mark. *Palm Bay Imports, Inc.*

*v. Veuve Clicquot*, 73 USPQ2d at 1690. See also *Presto Products v. Nice-Pak Products*, 9 USPQ2d 1895, 1897 (TTAB 1998) (The fact that two marks share the same first word is generally "a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.").

Therefore, although the marks have certain differences, when we compare them in their entireties we find that on the whole they are similar in appearance, sound, connotation and commercial impression, and that the additional words, MD in applicant's mark and MAN in opposer's mark, and the design element in opposer's mark, are not sufficient to distinguish them when used on legally identical overlapping services.

This *du Pont* factor favors a finding of likelihood of confusion.

#### *Conclusion*

We find that the *du Pont* factors, on balance, weigh in favor of our finding of likelihood of confusion. We conclude that consumers familiar with opposer's services of "cleaning and repairing septic systems and clearing clogged pipes and drains" identified by its ROOTER-MAN and design mark in Registration No. 1655782 would be likely to believe, upon encountering applicant's mark ROOTER, MD for plumbing services, that the services originate from or are associated with or sponsored by the same entity.

*Dilution*

In view of the decision to sustain the opposition on the ground of likelihood of confusion, it is not necessary to consider opposer's dilution claim.

*Decision:* The opposition is sustained on the ground of likelihood of confusion, and registration to applicant is refused.