

THIS OPINION
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Hearing:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Andersen Corporation
v.
Freud TMM, Inc.

Cancellation No. 92042430

Randel S. Springer and Anne C. Fleeson of Womble Carlyle Sandridge & Rice for Andersen Corporation.

Alice Carmichael Richey and Allison G. Runge of Kennedy Covington Lobdell & Hickman for Freud TMM, Inc.

Before Quinn, Grendel and Mermelstein, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Andersen Corporation has petitioned to cancel the registration owned by Freud TMM, Inc. for the mark PERMA-SHIELD for "coatings sold as a component part of power saw blades"¹ in International Class 8.

As grounds for cancellation, petitioner alleges that respondent's mark, as used in connection with respondent's goods, so resembles the previously used and registered marks

¹ Registration No. 2660281, issued December 10, 2002.

PERMA-SHIELD, PERMA SHIELD, PERMASHIELD and ANDERSEN PERMA-SHIELD for a variety of window and door products, including protective cladding, as to be likely to cause confusion.

Respondent, in its answer, denied the salient allegations of the petition for cancellation.²

The record consists of the pleadings; the file of the registration sought to be cancelled; trial testimony, with related exhibits, taken by each party; certified copies of petitioner's pleaded registrations, respondent's responses to certain of petitioner's interrogatories, a discovery deposition with related exhibits, and excerpts from printed publications, all introduced by way of petitioner's notices of reliance; and petitioner's responses to certain of respondent's interrogatories made of record in respondent's notice of reliance. An oral hearing was held before the Board at which counsel represented each party.

Standing

Petitioner has established its standing to seek cancellation of respondent's registration. In particular, petitioner has properly made its pleaded registrations of record, and petitioner further has shown that it is not a mere intermeddler. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton*

² Respondent also set forth "affirmative defenses." These defenses were pursued neither at trial nor in its brief. Accordingly, we deem the defenses to be waived.

Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Priority

Petitioner owns the following registered marks: PERMA-SHIELD for "assemblies of window sash, frames, and hardware sold together as window units";³ PERMA SHIELD and ANDERSEN PERMA-SHIELD for "windows, doors and shutters, and related hardware, sold as units";⁴ PERMA-SHIELD for "extruded vinyl profiles and vinyl covered building materials, namely, extruded rigid vinyl trim strips, vinyl wrapped auxiliary window casings, and vinyl coated plywood and laminated filler boards";⁵ PERMASHIELD for "expanded polystyrene foam sheeting for use as wall insulation sold wholesale directly to contractors in multiple pallet quantities";⁶ PERMA-CLEAN for "window units, including frames for double glazing panels and screens";⁷ and PERMA-FIT for "window units including grilles and muntins."⁸ Maurice McClurg, petitioner's brand marketing manager, testified about petitioner's prior use of the mark PERMA-SHIELD in connection with exterior cladding for its products. Thus,

³ Registration No. 832,822, issued August 1, 1967; renewed.

⁴ Registration No. 1,026,750, issued December 9, 1975; renewed, and Registration No. 1,051,867, issued November 2, 1976; renewed, respectively.

⁵ Registration No. 1180190, issued December 1, 1981; renewed.

⁶ Registration No. 2051094, issued April 8, 1997; combined affidavit under Sections 8 and 15 accepted.

⁷ Registration No. 886165, issued February 17, 1970; renewed.

⁸ Registration No. 896729, issued August 18, 1970; renewed.

in addition to the rights stemming from the registrations, petitioner has established prior common law rights in the mark PERMA-SHIELD for protective cladding (vinyl, aluminum and spray-on) used in connection with windows and patio doors.

The record establishes, and respondent does not seriously dispute, that petitioner has priority of use of the mark PERMA-SHIELD, as well as priority of its other marks.

Before turning to the likelihood of confusion claim, one additional comment is in order. Respondent contends that petitioner no longer uses its PERMA-SHIELD mark on certain goods listed in the pleaded registrations. Such an argument, however, is an impermissible collateral attack on the pertinent registrations. No counterclaim grounded on abandonment was ever filed and, accordingly, respondent's contention will not be considered. *Cosmetically Yours, Inc. v. Clairol, Inc.*, 424 F.2d 1385, 165 USPQ 515 (CCPA 1970). Thus, the registrations are presumed to be valid.

The Parties

Petitioner is the largest manufacturer of windows and patio doors in the United States. In 1966, petitioner began offering an alternative to window casements with wood exteriors; petitioner began selling casements clad in vinyl to prevent moisture from decaying the wooden casement. In

later years, the mark PERMA-SHIELD was extended to, among other products, a line of gliding patio doors. Through the years, the mark has been used in connection with different types of protective cladding, including vinyl, aluminum and liquid spray-on finishes. The goods are sold through independent dealers of building supplies, and home improvement stores such as Home Depot. The goods are bought mainly by builders and remodelers. Petitioner promotes its goods through product catalogs, its website, and advertisements in trade magazines.

Respondent is engaged in the manufacture and sale of woodworking cutting tools, including saw blades. Respondent chose the mark "Permanent Shield" for the alloy coating for its saw blades and router bits, but the mark was shortened to PERMA-SHIELD due to space constraints on product and packaging. Respondent promotes its coated saw blades through woodworking publications; these advertisements constitute 99% of its promotional efforts. The remaining print advertising is directed to the building contractor. Respondent also uses catalogs, its website, and point-of-sale displays, and respondent attends tradeshow.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the 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). Petitioner must establish that there is a likelihood of confusion by a preponderance of the evidence. The relevant *du Pont* factors in the proceeding now before us are discussed below.

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*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

As indicated above, petitioner has established its prior rights in the marks PERMA-SHIELD and PERMASHIELD.⁹ Respondent's mark PERMA-SHIELD is identical to petitioner's mark PERMA-SHIELD, and essentially identical to petitioner's mark PERMASHIELD. *See, e.g., Seaguard Corp. v. Seaward International, Inc.*, 223 USPQ 48 (TTAB 1984). The parties' marks are identical or essentially identical in appearance. The marks also are identical in sound (the hyphen would not be pronounced in PERMA-SHIELD) and meaning, both conveying the idea of a permanent shield. Further, the marks engender identical overall commercial impressions.

⁹ We will focus on these marks, as petitioner has done, given that they are the ones the most similar to respondent's mark.

The identity or virtual identity between the parties' marks weighs heavily in petitioner's favor.

Third-Party Marks

The record is devoid of evidence of any third-party uses or registrations of the same or similar marks for the types of goods involved herein. This factor weighs in favor of petitioner.

Fame

Petitioner specifically claims that its PERMA-SHIELD mark is famous. Petitioner asserts that due to the extensive use and promotion of its inherently distinctive PERMA-SHIELD mark, it has created "a famous mark that is recognized by a significant portion of the consuming public, in this case contractors, remodelers, and other purchasers of home improvement and building supplies." (Brief. pp. 11-12). In support of this position, petitioner relies upon its use of PERMA-SHIELD dating back to 1966 (see Brief, p. 11), the large number of its catalogs distributed each year, the substantial number of unique visitors to its website, and unsolicited articles in printed publications in which petitioner's PERMA-SHIELD cladding product is mentioned. Petitioner also points to its advertising expenditures that annually total tens of millions of dollars. In making this argument, petitioner also relies upon a prior decision, *Andersen Corp. v. Therm-O-Shield International, Inc.*, 226

USPQ 431 (TTAB 1985), wherein the Board found that petitioner's PERMA-SHIELD mark is a "strong trademark which is entitled to a relatively broad scope of protection." Id. at 435.¹⁰

The evidence of record suggests that there has been a degree of exposure of petitioner's PERMA-SHIELD mark in the marketplace. While this evidence shows petitioner's attempts at creating a strong mark, there is little probative evidence indicating that this attempt has borne fruit; and there is no evidence regarding, as for example, sales figures for the PERMA-SHIELD brand or any brand awareness.

Accordingly, we find that while the record may establish that petitioner's mark is a relatively well-known mark, the proofs fall short of establishing fame. *Cf. 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). In saying this, we want to make clear that we are not bound by the Board's finding of fact regarding the strength of petitioner's mark in a

¹⁰ The Board found a likelihood of confusion between petitioner's registered PERMA-SHIELD marks involved herein and the applied-for mark THERM-O-SHIELD for "polyester film sheets applied to glass surfaces to reduce glare and heat."

decision rendered over twenty years ago. We have made our factual determination based on the record presently before us. Although we do not find petitioner's mark "famous," we have nevertheless considered the degree of public knowledge of petitioner's mark which it has demonstrated as a factor weighing in its favor.

In attacking the strength of petitioner's PERMA-SHIELD mark, respondent asserts that petitioner's mark is "descriptive of the attributes of petitioner's cladding." (Respondent's Brief, p. 25). As mentioned above, petitioner's mark conveys the idea that its product forms a permanent shield around the window or patio door, thereby protecting it from the elements. But the mark, in our view, is inherently distinctive and, at worst, is just suggestive of this attribute.

The strength of petitioner's mark weighs in favor of petitioner, but this factor obviously weighs much less than if fame were found.

The Goods

The parties have focused their attention on this factor and, indeed, the similarity or dissimilarity between the parties' goods forms the crux of this controversy.

With respect to the goods, it is well established that the goods 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 of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods 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 & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Mr. McClurg testified that the parties' goods are "quite disparate." (McClurg dep., p. 42). Further, petitioner acknowledges that the goods are "perhaps different in composition and function." (Brief, p. 18). Petitioner contends, however, that these differences are outweighed by the facts that the goods travel in the same trade channels and are purchased by the same consumers. Petitioner contends that the goods are used "for the identical purpose, namely, for constructing buildings, and even more specifically, to function as protective coverings

for construction supplies." (Brief, p. 21). Petitioner also points to the purported common practice in the building products industry of licensing and brand extension.

Petitioner's goods comprise a variety of window and door products, including an exterior cladding material used as a protective coating to prevent moisture damage to wood. As noted above, petitioner's cladding is of different types, including vinyl and aluminum cladding, and liquid spray-on finishes.

Respondent's coating is an aluminum alloy that is applied to its saw blades. According to its advertising, respondent "was the first manufacturer to apply coatings to saw blades." Respondent's coating reduces the amount of friction between the blade and the wood, and yields an easy-to-clean blade that is protected from corrosion. More specifically, the coating makes respondent's blades more resistant to friction and heat build-up and, according to respondent, thereby helps the wood glide by the blade with less effort in comparison to conventional blades. The coated blades therefore stay sharp longer, and the smoother cutting action means less wear and tear on the power saw motor. In the advertisement "WHY Perma-SHIELD COATING?" (Kohl 10/22/04 dep., ex. no. 9), applicant lists the benefits of reduced blade drag, prevention of rust, and prevention of pitch build-up:

Perma-SHIELD coating significantly reduces blade drag keeping the blade cool, improving the quality of cut, and extending the life of the blade.

Perma-SHIELD coating protects the blade from humidity and corrosion (rust) therefore improving feed rate and extending the life of the blade.

Perma-SHIELD coating reduces the pitch build-up maintaining the reliability of cut and reducing blade clean up time.

We acknowledge petitioner's point that the parties' goods are both used in the construction industry. But, this industry is enormously broad, and this commonality simply is too tenuous of a connection upon which to find that the goods are commercially related. The goods are non-competitive and clearly have significant differences in utility and essential characteristics. Further, to say, as petitioner urges, that the goods are related because petitioner makes "protective" cladding and respondent makes "protective" coatings is off base; given the distinct and substantial differences between the goods, this common aspect of the goods hardly rises to the level of causing a purchaser to assume that the goods originate from a common source.

Even if we were to accept petitioner's claim that licensing and brand extension is common in the building construction trade, nothing in the record suggests that this practice involves or would involve a mark for windows and

cladding being extended to coatings for saw blades. Mr. McClurg testified, "what I know about our brand equity tells me that saw blades is not a place that Andersen Windows should take its brand. And there are other categories of goods that we could take our brand to, but saw blades isn't one of them..." (McClurg dep., p. 42). Not surprisingly, the record is devoid of even a single instance where one entity manufactures both windows, doors or protective cladding on the one hand, and coatings for saw blades on the other.

We note that petitioner has, in one instance, licensed its mark to a third-party for use with wall insulation. (McClurg dep., p. 110). Mr. McClurg did not give any details about this licensed use, so we do not know the extent or the success of this use. This sole example of opposer's licensing activity hardly establishes that such practice is commonplace in the industry or more specifically, that purchasers would be likely to believe that respondent's coating is a licensed product of petitioner.

The dissimilarity between the goods weighs heavily in favor of respondent.

Conditions of Sale and Purchasers

The identifications of goods in petitioner's pleaded registrations and respondent's registration do not contain

any limitations.¹¹ Where the goods in a registration are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses all the goods of the nature and type described therein, that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof.

Paula Payne Products Co. v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Petitioner sells its goods through retailers of building materials and home improvement products. This includes not only the windows and doors listed in the registrations, but petitioner's cladding as well. Respondent's traditional trade channel comprises dealers whose primary focus is the enthusiast woodworker.

¹¹ In saying this, we recognize that one of petitioner's pleaded registrations, namely Registration No. 2051094, includes a trade channel/purchaser class limitation. The identification of goods reads "expanded polystyrene foam sheeting for use as wall insulation sold wholesale directly to contractors in multiple pallet quantities." Inasmuch as these goods do not employ petitioner's protective cladding, petitioner barely mentioned these goods in discussing the similarities between the goods. In any event, we have considered this limitation for these particular goods, and this limitation serves to further distinguish these goods from respondent's goods.

Respondent's goods also move through industrial trade channels to cabinet shops or other production shops.

The record also reveals that the parties' goods are sold in overlapping trade channels, albeit limited. Both are sold at Home Depot. As respondent points out, however, this mass merchandiser sells a wide variety of goods, and petitioner's goods are sold in an entirely different department than the hardware section where respondent's goods are sold. Russell Kohl, respondent's president and chief executive officer, testified that respondent's saw blades are sold in the hardware department of home center stores, whereas windows and patio doors are sold in the millwork or building materials section of the stores. Given the environment of modern mega-stores, as described by Mr. Kohl, the mere fact that two products are sold there is hardly determinative. What the predecessor of our primary reviewing court stated about supermarkets is equally applicable to mega-stores like Home Depot:

A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on any goods so displayed. See *Canada Dry Corp. v. American Home Products Corp.*, 468 F.2d 207, 175 USPQ 557 (CCPA 1972). The means of distribution and sale, although

certainly relevant, are areas of peripheral inquiry. The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks. [emphasis in original]

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See *Recot Inc. v. M.C. Becton*, 54 USPQ2d at 1899-1900 [the law is that products should not be deemed related simply because they are sold in the same kind of establishments; to merit weight in the analysis, there must be evidence that the products are sold in close proximity to one another]. See also *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 152-53 (CCPA 1978); *Canada Dry Corp. v. American Home Products Corp.*, 468 F.2d 207, 175 USPQ 557 (CCPA 1972); and *Shoe Factory Supplies Co. v. Thermal Engineering Co.*, 207 USPQ 517 (TTAB 1980).

The fact that the respective products are of such diverse nature and utilized for such different purposes ensures that, even if both products were sold in the same store, even a smaller retail outlet, they would be offered for sale in different sections of the store. *Champion International Corp. v. Genova, Inc.*, 199 USPQ 301, 305 (TTAB 1978) [the mere fact that products may move in the same trade channels to the same class of purchasers does not, ipso facto, prove that there is a definite relationship

between the goods]. See *Fruit of the Loom Inc. v. Fruit of the Earth Inc.*, 3 USPQ2d 1531, 1533 (TTAB 1987).

Petitioner also asserts that the parties promote their goods "through similar venues" such as the Internet and catalogs. Petitioner points out one instance when the parties' ran advertisements in the same publication, "Journal of Light Construction."

The fact that both parties, like most manufacturing entities, use the Internet and catalogs to promote their products is not a basis upon which to find the goods to be related. Further, except for the one instance highlighted by petitioner, the record establishes that the parties advertise their products in different trade and consumer publications directed to different classes of purchasers.

Petitioner points to the price of respondent's product and posits that consumers are not likely to give much thought to their purchasing decision. What petitioner fails to mention, however, is the price of its own products with cladding, around \$1000, which greatly exceeds the \$9-\$60 price range of respondent's coated saw blades. Thus, the purchase of petitioner's goods likely involves a deliberate decision and we disagree that consumers of respondent's product "will simply assume these goods are related to petitioner's well-known PERMA-SHIELD mark." (Brief, p. 17).

In any event, whether homebuilders or building contractors or woodworking enthusiasts, these prospective purchasers would tend to be more discriminating in their buying decisions than everyday, do-it-yourselfers.

Petitioner posits two scenarios in which a consumer "might" purchase both parties' products. (Brief, pp. 14-15). The first scenario involves a small contractor who undertakes a variety of construction jobs, including window replacement. This contractor purchases supplies primarily from Home Depot. In the course of replacing a window, the contractor must cut holes in a wall with a saw and, according to Mr. McClurg (dep., pp. 40-41), would be exposed to both marks:

So the scenario I worry about is the contractor who has a skill saw in one hand, cutting a hole in a wall or modifying an opening in a wall, who then - and has a Freud saw blade on it that says Perma-Shield, that it has this protective coating, and he sets that saw down after using it and turns and picks up the Andersen Windows box on which the mark Perma-Shield appears, and he pulls it out of the box and installs it in the opening. To me, that contractor is a purchaser of both products, saw blades and windows and patio doors, and they are actually used in the same sequence of events that need to occur to install a window in a wall.

The second scenario involves a homebuilder that buys all the building material needed for a job from a local lumberyard,

and in doing so, encounters the marks of both parties. Mr. McClurg testified as follows (dep. pp. 41-42):

And oftentimes, these lumberyards have very small showrooms, so it's conceivable to me that you could be in a retail establishment - I'll call it a lumberyard - as a small home builder there to pick up your supplies or your complete load of building materials, and there being a Freud display of saw blades in the exact same room where there's a display of Andersen windows and patio doors bearing the Perma-Shield mark. So I'm concerned about the likelihood of confusion because, as Freud says, its Perma-Shield is a coating that does something for saw blades - I don't know what - but our Perma-Shield is well-known as a coating, a protective coating on the outside of windows, and so I'm concerned about the confusion that would result from seeing Perma-Shield on those two quite disparate products.

Based on the record before us, we see the likelihood of confusion claim asserted by petitioner as amounting to only a speculative, theoretical possibility. Language by our primary reviewing court is helpful in resolving the likelihood of confusion controversy in this case:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), citing *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*,

418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g* 153 USPQ 412 (TTAB 1967).

Actual Confusion

The parties are unaware of any instances of actual confusion. Although the parties' marks have been in contemporaneous use for at least five years, we agree with petitioner that, in the absence of information about the extent of use of respondent's mark, it is difficult to gauge whether there has been a meaningful opportunity for confusion to occur in the marketplace.

In any event, as often stated, the test here is likelihood of confusion, not actual confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842 (Fed. Cir. 1990).

We view this *du Pont* factor as neutral.

Conclusion

The connection between petitioner's goods and respondent's goods is so tenuous that the public would not view the goods as having a common source, even when sold under identical marks.

We have carefully considered all of the evidence pertaining to the relevant *du Pont* factors, as well as all of the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in

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this opinion), and we conclude that petitioner has not proved its Section 2(d) claim of likelihood of confusion.

Decision: The petition for cancellation is denied.