

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/659425

MARK: NUORTE

CORRESPONDENT ADDRESS:

MARK P. STONE
25 3RD ST FL 4
STAMFORD, CT 06905-5100



RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Home Decor Holding Company

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE:

The Office has reassigned this application to the undersigned examining attorney.

Upon further consideration, the TTAB has restored jurisdiction to the trademark examining attorney under 37 C.F.R. §2.84(a). The Office apologizes for any inconvenience this may cause.

Prior Pending Application

The final office action issued on July 2, 2007 was premature, because prior pending serial number 78211151 referenced in the first office action is still pending (see attached).

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Initially registration of the applied-for mark was refused solely because of a likelihood of confusion with the mark in U.S. Registration No. 2878139. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* The newly assigned examiner has

cited a second registration owned by the same registrant, Registration No. 3310213 (see attached).

The applicant applied to register the mark NUporte for close doors not made of metal. The registered mark is NEWPORT DOORS RIGID VINYL PREMIUM SWINGDOORS. Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). See TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. See *In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

COMPARISON OF THE MARKS

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); see TMEP §1207.01(b).

In the present case, applicant's mark Nuporte is similar to the registered mark NEWPORT DOORS RIGID VINYL PREMIUM SWINGDOORS in sound, appearance and connotation. The dominant portion of the marks is essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975); see TMEP §1207.01(b)(iv).

In addition, the registrant has disclaimed the descriptive word "doors rigid vinyl premium swingdoors" leaving the dominant portion of the mark as NEWPORT. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. Disclaimed matter is typically less significant or less dominant when comparing marks. See *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d

1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii).

COMPARISON OF GOODS

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

The applicant goods "closet doors not made of metal" are highly similar to the registrant's goods, "vinyl swing doors." It is conceivable that the applicant's closet doors could be vinyl swing doors. Even assuming applicant's closet doors are not vinyl swing doors, any goods or services in the registrant's normal fields of expansion should be considered when determining whether the registrant's goods and/or services are related to the applicant's goods and/or services. TMEP §1207.01(a)(v); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581 1584 (TTAB 2007). The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

If the goods and/or services of the respective parties are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b). Since the marks are similar and the goods are related, there is a likelihood of confusion as to the source of applicant's goods. Therefore, applicant's mark is not entitled to registration.

RESPONSE GUIDELINES

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Applicant should include the following information on all correspondence with the Office: (1) the name and law office number of the trademark examining attorney, (2) the serial number and filing date of the application, (3) the mailing date of this Office action, (4) applicant's name, address, telephone number and e-mail address (if applicable), and (5) the mark. 37 C.F.R. §2.194(b)(1); TMEP §302.03(a).

To expedite prosecution of this application, applicant is encouraged to file its response to this Office action online via the Trademark Electronic Application System (TEAS), which is available at <http://www.uspto.gov/teas/index.html>.

Gina Hayes, Esq.
/GH/
Trademark Examining Attorney
U.S. Patent and Trademark Office
Law Office 103
571-272-9407

RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office action should be filed using the form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

Mark
NEWPORT
Goods and Services

IC 006. US 002 012 013 014 023 025 050. G & S: METAL DOORS, STORM
DOORS AND WINDOW GUARDS. FIRST USE: 19971101. FIRST USE IN
COMMERCE: 19971101

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

78211151

Filing Date

February 5, 2003

Current Filing Basis

1A

Original Filing Basis

1A

Owner Name and Address

(APPLICANT) Lehigh Consumer Products Corporation CORPORATION
PENNSYLVANIA 2834 Schoeneck Road Macungie PENNSYLVANIA 180629679

Assignment Recorded

ASSIGNMENT RECORDED

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Timothy D. Pecsénye, Esquire

Mark

NEWPORT DOORS RIGID VINYL PREMIUM SWINGDOORS

Goods and Services

IC 019. US 001 012 033 050. G & S: VINYL SWING DOORS. FIRST USE:
19980900. FIRST USE IN COMMERCE: 19980900

Standard Characters Claimed

STANDARD CHARACTERS CLAIMED

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Serial Number

76273892

Filing Date

June 20, 2001

Current Filing Basis

1A

Original Filing Basis

1A

Publication for Opposition Date

July 31, 2007

Registration Number

3310213

Registration Date

October 16, 2007

Owner Name and Address

(REGISTRANT) ACADIA WINDOWS & DOORS, INC. CORPORATION
MARYLAND 9611 Pulaski Park Drive Baltimore MARYLAND 21220

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "DOORS RIGID
VINYL PREMIUM SWING DOORS" APART FROM THE MARK AS SHOWN

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Deborah J. Westervelt