TTAB

402-084-500

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

Applicant:	Home Decor Holding Company	: Examining Atty. - Kenneth E. Sharperson
Mark:	NUporte	: Law Office: 103
Serial No.	76/659,425	:
Filed:	May 2, 2006	:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

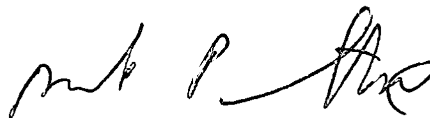
Attn: Trademark Trial And Appeal Board

TRANSMITTAL OF APPEAL BRIEF

Enclosed herewith is Applicant's Appeal Brief.

The Appeal Brief is being filed within the time permitted by the Decision by the Board dated March 10, 2008, extending Applicant's time for filing its Brief through and including May 3, 2008.

Respectfully submitted,



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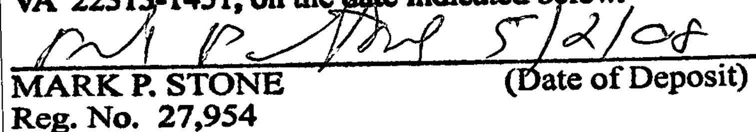
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on the date indicated below.



MARK P. STONE (Date of Deposit)
Reg. No. 27,954

05-06-2008

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #

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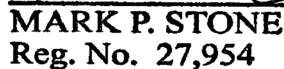

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APPEAL BRIEF

I. INTRODUCTION -

A Notice of Appeal, in response to the Final Action dated July 2, 2007, was filed in the Patent & Trademark Office on January 4, 2008.

On March 10, 2008, the Trademark Trial & Appeal Board granted Applicant's request to extend the time for filing the Appeal Brief, through and including May 3, 2008.

II. DESCRIPTION OF THE RECORD -

The Record on Appeal in connection with the present trademark application is identified as follows:

1. Original trademark application filed on May 2, 2006;

2. Office Action dated October 13, 2006;

3. Amendment filed on April 11, 2007 in response to Office Action dated October 13, 2006;

4. Office Action dated July 2, 2007 placing application under final refusal to register; and

5. Notice of Appeal filed on January 4, 2008.

III. STATEMENT OF THE ISSUES -

The single issue presented to the Board for review in the present Appeal is whether the Examining Attorney has properly refused to register Applicant's mark under Section 2(d) of the Trademark Act based upon the mark of United States Reg. No. 2,878,139.

IV. RECITATION OF THE FACTS -

Applicant seeks to register the trademark "NUporte" for closet doors not made of metal. The application was filed on May 2, 2006, based on intent to use.

The Examining Attorney has refused registration of Applicant's mark under Trademark Act, Section 2(d), based upon U.S. Reg. No. 2,878,139. The cited registration is for the mark "NEWPORT DOORS" which has been registered for "non-metal doors, namely, vinyl doors". The term "DOORS" has been disclaimed, apart from the registered mark.

V. ARGUMENT -

Applicant seeks to register the word mark "NUporte", in which the letters "NU" are presented in upper case format, while the letters "porte" are presented in lower case format. The mark of the cited registration is "NEWPORT DOORS", which has been registered in a typed format. It is immediately apparent that the respective marks are readily visually distinguishable from each other in that Applicant's mark consists of a single word presented in a stylized format, while the mark of the cited registration consists of two separate words, neither of which are the same as the single word which Applicant seeks to register. Accordingly, the relevant consuming public will be capable of

distinguishing between the respective marks based upon the usual differences therebetween.

It is axiomatic that in determining likelihood of confusion between marks, the marks are compared in their entireties, and as a whole. The marks must be compared in their entireties to determine if a conflict exists because the overall commercial impression made by a mark on the consuming public is as a whole and in its entirety. See, Massey Junior College v. Fashion Institute of Technology, 181 USPQ 272 (CCPA 1974); Franklin Mint Corp. v. Master Mfg. Co., 212 USPQ 233 (CCPA 1981); Spice Islands Company v. Frank Tea & Spice Company, 184 USPQ 35 (CCPA 1974); Colgate-Palmolive Company v. Carter-Wallace, Inc., 167 USPQ 529 (CCPA 1970); and Conde-Nast Publications, Inc. v. Miss Quality Inc., 184 USPQ 422 (CCPA 1975).

Moreover, even if a portion of a composite mark has been disclaimed, the total composite (including the disclaimed matter) will be considered in determining likelihood of confusion with regard to another mark. In re Knights Home Products, Inc., 173 USPQ 566 (TTAB 1971); In re Buty-Wave Products Co., Inc., 198 USPQ 104 (TTAB 1978); In re Offshore Technology Corp., 201 USPQ 861 (TTAB 1978); and Trademark Manual Of Examining Procedure, 5th Ed., Section 1213.10. The disclaimed portion of an overall mark must still be considered in determining likelihood of confusion because a perspective purchaser views the mark as a whole, and it is the mark in its entirety which makes the commercial impression

on the purchaser. In re William Intner Co., 155 USPQ 101 (TTAB 1967). It is immaterial to the consumer that a disclaimer has been made since likelihood of confusion is determined by the reaction of reasonable prudent buyers, who neither know or care about disclaimers, the disclaimed material thereby being irrelevant in determining likelihood of confusion. See, Industria Espanola de Perlas Imitacion, S.A. v. National Silver Co., 173 USPQ 796 (CCPA 1972); American Home Products Corp. v. B.F. Ascher & Co., 176 USPQ 532 (CCPA 1973); V-M Corp. v. Mayfair Sound Products, Inc., 178 USPQ 477 (CCPA 1973); and In re National Data Corp., 224 USPQ 749 (Fed. Cir. 1985).

Applying the principles of the cited authorities to the present application, Applicant's mark, "NUporte", is visually distinguishable from the mark of the cited registration "NEWPORT DOORS". Although the term "DOORS" has been disclaimed from the mark of the cited registration, the overall mark "NEWPORT DOORS" must nonetheless be considered in its entirety in determining whether any conflict exists between the respective marks.

Although the mark of the cited registration has been registered in a "typed" format and thus is not limited to any particular form or style, and Applicant seeks to register its mark in a stylized format, the form of the cited registration is nonetheless not unlimited. On the contrary, a mark presented in a "typed" format requires consideration of "...all ordinary and reasonable manners" in which the mark could be depicted. Jockey

International Inc. v. Mallory & Church Corp., 25 USPQ 2d 1233 (TTAB 1992). There is no evidence of record that an "ordinary and reasonable" manner of depicting the mark of the cited registration would be to present portions of one or more of the two words of the mark in a combined upper case/lower case format. Moreover, even if the mark "NEWPORT DOORS" were to be presented in a stylized format, none of the two words of the mark are common to the single word of Applicant's mark, and thus the respective marks would still be readily visually distinguishable by the relevant consuming public.

The respective marks also have different connotations, thereby generating different commercial impressions on the relevant consuming public. Applicant's mark "NUporte" has a French flavor or suggestion to it, while the term "NEWPORT", one of the two words of the cited registration, has a geographical or nautical connotation associated with it. Thus, Applicant's mark, in the form in which Applicant seeks registration, generates a commercial impression on the consuming public which is distinctly different from the connotation and commercial impression generated by the mark of the cited registration when the respective marks are considered in their entireties.

Applicant respectfully submits that as a result of the differences in visual appearance between its mark and the mark of the cited registration, and as a result of the differences in overall connotation and commercial impression generated on the

consuming public by its mark and the mark of the cited registration, no likelihood of confusion exists between Applicant's mark and the mark of the cited registration when the respective marks are considered in their entireties.

Applicant notes that the mark of Serial No. 78/032,967 for "NEWPORT" for "metal door hardware", was approved by the Patent & Trademark Office for registration, notwithstanding prior U.S. Reg. No. 2,878,139, the registration which has been applied to refuse registration of Applicant's mark. Serial No. 78/032,967 was subsequently abandoned for failure to file a Statement Of Use in response to the Notice of Allowance issued by the Patent & Trademark Office. Nonetheless, it is clear that the Patent & Trademark Office did not consider that a conflict existed between the mark "NEWPORT" for goods related to doors, and the mark "NEWPORT DOORS" for doors. Applicant respectfully submits that the mark "NEWPORT" for the related goods is significantly closer to the mark "NEWPORT DOORS" than Applicant's mark "NUporte".

Third party uses and registrations of allegedly similar marks constitutes evidence that the Patent & Trademark Office considers the consuming public to be able to distinguish between different marks owned by non-related entities, and that respective marks including a common or similar term are entitled to only a narrow scope of protection as a result of third party uses and registrations. See, for example, Tektronix, Inc. v. Daktronics, Inc. 189 USPQ 693 (CCPA 1996); Sun Bank of Florida,

Inc. v. Sun Federal Savings & Loan Assoc., 211 USPQ 844 (Fed. Cir. 1981); General Mills, Inc. v. Kellogg Co., 3 USPQ 2d 1442 (8th Cir. 1981); Western Publishing Co. v. Rose Art Industries, Inc., 15 USPQ 2d 1545 (2d Cir. 1990); Ocean Bio-Chem, Inc. v. Turner Network Television, Inc., 16 USPQ 2d 1264 (S.D. Fla. 1990); Homeowner's Group, Inc. v. Home Marketing Specialists, Inc., 18 USPQ 2d 1587 (6th Cir. 1991); Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Ctr., 42 USPQ 2d 1173 (6th Cir. 1997); and Petro Shopping Centers L.P. v. James River Petroleum, 44 USPQ 2d 1921 (4th Cir. 1997).

Applicant further submits that no likelihood of confusion exists between its "NUporte" trademark for closet doors, and the mark of the cited registration, because purchasers of Applicant's goods can be expected to use a high degree of care in making and selecting their purchases, and are unlikely to be confused. The closet doors to be marketed under Applicant's "NUporte" trademark are relatively expensive, and thus purchasers will exercise a higher degree of care in making these purchases than would be exercised for purchasing less expensive goods. See, for example, McGregor-Doniger, Inc. v. Drizzle, Inc., 202 USPQ 81 (2d Cir. 1979). Moreover, the closet doors to be marketed under Applicant's "NUporte" trademark are likely to be installed in the residences of the purchasers, who thereby can be expected to use a higher degree of care and discrimination in selecting products to be installed within their households.

VI. <u>SUMMARY</u> -

Applicant respectfully submits that there is no likelihood of confusion between its trademark "NUporte" presented in stylized format for closet doors, and the mark "NEWPORT DOORS" for the goods identified in U.S. Reg. No. 2,878,139 as a result of:

1. differences in the visual appearance of the respective marks which enable the relevant consuming public to visually distinguish the respective marks when each of the marks is considered as a whole, and in its entirety;

2). differences in connotation and commercial impression generated by the respective marks on the relevant consuming public when the respective marks are considered as a whole and in their entireties;

3). The high degree of care to be exercised by purchasers of Applicant's goods in making and selecting their purchases; and

4). the approval by the Patent & Trademark Office of an application seeking to register a mark closer to the mark of the cited registration than to Applicant's mark for related goods.

Applicant respectfully requests that the Examining Attorney's refusal to register Applicant's mark under Trademark

Act, Section 2(d) based upon the mark of U.S. Reg. No. 2,878,139, be reversed.

Respectfully submitted,

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