

From: Hampton, Charisma L.

Sent: 11/30/2009 4:21:07 PM

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Subject: U.S. TRADEMARK APPLICATION NO. 77421279 - USG - N/A

Attachment Information:

Count: 1

Files: 77421279.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/421279

MARK: USG



CORRESPONDENT ADDRESS:

Pradip Sahu
USG Corporation
550 West Adams Street #189
Chicago IL 60661

GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: USG CORPORATION

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

trademarks@usg.com

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's final refusal to register the trademark **USG** in class 025, for "*shirts, caps with visors, and jackets all sold through the building and construction industry channels of trade*" on the grounds that applied-for mark is likely to be confused with the mark in U.S. Registration No. 2915250, **US&G** in class 025 for "hat[s]," pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). It is respectfully requested that this refusal be affirmed.

FACTS

Applicant, USG Corporation, seeks registration on the Principal Register for the mark **USG** in stylized form, for goods ultimately identified as "*shirts, caps with visors, and jackets all sold through the building and construction industry channels of trade*" in International Class 025. On June 20, 2008, the examining attorney refused registration of the mark pursuant to Section 2(d), the Trademark Act, 15 U.S.C. Section 1052(d), based

on the confusingly similar mark **US&G** in standard character form, for goods identified as “*hat[s]*,” in class 025. The examining attorney made final the refusal to register on January 7, 2009 and denied applicant’s request for reconsideration on August 7, 2009. This appeal now follows. The sole issue before the Board on appeal is the refusal to register under Section 2(d) of the Trademark Act.

PRELIMINARY MATTERS

As a preliminary matter, the examining attorney objects to applicant’s submission of supplemental evidence at the time of filing its appeal brief. Applicant submitted “Exhibit A” with the appeal brief. However, the record in an application must be complete prior to the filing of an appeal.. 37 C.F.R. §2.142(d); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). In this case, applicant did not make this evidence of record prior to filing its appeal brief. As such, the evidence is untimely and the examining attorney has not considered it and requests that the Trademark Trial and Appeal Board not consider this evidence in making its decision.

ARGUMENT

THE MARKS ARE CONFUSINGLY SIMILAR BECAUSE THEY BOTH CONSIST OF AN IDENTICAL SEQUENCE OF LETTERS AND THE GOODS ARE HIGHLY RELATED AND IDENTICAL SUCH THAT CONSUMERS ARE LIKELY TO BE CONFUSED OR MISTAKEN OR DECEIVED AS TO THE SOURCE OF THE GOODS UNDER SECTION 2(D) OF THE TRADEMARK ACT

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 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).

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods. See *In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); TMEP §§1207.01 *et seq.*

The overriding concern is not only to prevent buyer confusion as to the source of the goods, 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).

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002).

I. THE MARKS ARE CONFUSINGLY SIMILAR

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*, 476 F.2d at 1361, 177 USPQ at 567. 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).

Here, the applicant's mark, **USG**, is confusingly similar to the registered mark, **US&G**. Specifically, the marks share the letters, "U," "S" and "G" in an identical sequence. Moreover, both marks begin with the identical letters, "U" and "S" and end in "G." As such, purchasers will not only call for the goods of both parties using the identical arbitrary sequence of letters, but will also call for the goods using the same pronunciation of the first two terms of the mark. The only difference in the marks is applicant's deletion of the ampersand from the registered mark, **US&G**. As a result, applicant's mark does not create a distinct commercial impression because it contains the identical letters as registrant's mark, and there are no other literal elements present to distinguish it from registrant's mark.

Moreover, when comparing marks that consist of a series of two or more letters, confusion may be likely even if the letters are not identical or in the same order. It is more difficult to remember a series of arbitrarily arranged letters than to remember words or figures; that is, confusion is more likely between arbitrarily arranged letters than between other types of marks. *See, e.g., Weiss Assoc. v. HRL Assoc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (finding confusion between TMS and TMM). Here,

applicant's and registrant's arbitrary arrangement of letters in an identical sequence results in the same overall commercial impression.

This principle was set forth in *Crystal Corp. v. Manhattan Chem. Mfg. Co.*, 75 F.2d 506, 506, 25 USPQ 5, 6 (C.C.P.A. 1935), wherein the Court of Customs and Patent Appeals applied the following reasoning in holding Z.B.T. likely to be confused with T.Z.L.B. for talcum powder: "We think it is well known that it is more difficult to remember a series of arbitrarily arranged letters than it is to remember figures, syllables, words or phrases. The difficulty of remembering such lettered marks makes confusion between such marks, when similar, more likely."

Even lettered marks having only two letters in common, used on identical or closely related goods, have been held likely to cause confusion. *See, e.g., Feed Serv. Corp. v. FS Servs., Inc.*, 432 F.2d 478, 167 USPQ 407 (C.C.P.A. 1970) (finding confusion between FSC and S). In this case, the application and registration *share the same three letters*, which are arranged in the same order and used on identical goods.

Applicant asserts that purchasers are not likely to be confused because they will understand that "USG" appearing in the applied-for mark refers to one of applicant's operating companies, United States Gypsum, whereas the registrant's mark, "US&G" has no meaning. Applicant's arguments are unpersuasive. In the instant case, applicant did not seek registration for the mark, USG with United States Gypsum featured on the drawing page. Likewise, the cited registration did not provide the meaning of the letters, "U," "S," "G," appearing in the drawing of the registration. As such, purchasers are likely to be confused as to the sources of the goods upon encountering the letters, "U,"

“S,” “G” in the applied-for mark and the letters, “U,” “S,” ampersand “G” appearing in the registered mark, featured on identical goods.

The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979).

Moreover, it is well established when applicant’s mark is compared to a registered mark, “the points of similarity are of greater importance than the points of difference.” *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 40, 108 USPQ 161 (D.C. Cir. 1956) (internal citation omitted). In the present case, both the applicant and the registrant’s marks feature the identical literal elements, “U,” “S,” “G,” arranged in the same order, with the first part of the mark, “US,” likely to be pronounced similarly. Moreover, the registered mark is displayed in standard character form and thus may be presented in any lettering style, including one similar to the mark appearing in the application. TMEP §1207.01(c)(iii); see 37 C.F.R. §2.52(a). As such, purchasers calling for the goods are likely to be confused by the contemporaneous use of USG marks.

In the Appeal Brief, the applicant takes exception to the examining attorney's explanation of why a mark presented in stylized characters or otherwise in special form generally will not avoid likelihood of confusion with a mark in typed or standard characters. Specifically, in explaining that the registrant's standard character mark could be presented in the same manner of display as the applied-for mark, the examining attorney stated, "the registered mark could be displayed in a style similar to the applied for mark, for example, with big block letters "U" "S" "G" and an almost imperceptible ampersand." *See Out-going Denial of Reconsideration dated 08/07/2009*. However, the applicant argues that the hypothetical provided by the examining attorney is unsubstantiated with actual evidence that the registrant would use its mark in any way other than that displayed in the specimen of record. *Applicant's Appeal Brief, at 3*. However, it is well established that if a mark is presented in standard characters, the owner of the mark is not limited to any particular depiction of that standard character mark. Moreover, this Office has held that "when the applicant submits a standard character, the mark shown in the drawing does not necessarily have to appear in the same font style, size, or color as the mark shown on the specimen of use." *See TMEP* §807.03(e). In other words, the registrant of a standard character mark may display its mark on its specimen in any font style, size, or color. As such, the law is clear on this matter and contrary to applicant's assertions, the examining attorney is not required to show actual evidence of the registrant's use of its mark in a manner different than that appearing on the specimen.

In the present case, the applicant's mark does not create a different commercial impression because it contains the same letters, "U," "S" and "G" in an identical

sequence as the registrant's mark. Moreover, despite the additional syllable created by the presence of the ampersand in the registrant's mark, purchasers will pronounce the literal elements in the marks identically. Furthermore, slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983). Here, purchasers are likely to believe, ***mistakenly***, that the goods offered under the respective marks emanate from a common source because the marks create a similar overall commercial impression.

Ultimately, when purchasers call for the goods of applicant and registrant, they are likely to be confused as to the sources of the goods by the contemporaneous use of marks with the identical letters "U," "S" and "G".

II. THE GOODS ARE IDENTICAL AND HIGHLY RELATED

The goods 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). Rather, it is sufficient that the goods are related in some manner and/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 come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999).

In the present case, applicant good's "*shirts, caps with visors, and jackets all sold through the building and construction industry channels of trade,*" are identical to and highly related to the registrant's "*hat[s].*" Specifically, both the applicant and the registrant identify headwear. In the Denial of Reconsideration, dated 08/07/2009, the

examining attorney attached dictionary definitions to show a cap – “a soft flat hat,” and “a usually soft and close-fitting head covering either having a brim or with a visor” is a type of hat – “a covering for the head usually having a shaped crown and brim.” *See Out-going Denial of Reconsideration dated 08/07/2009 - Attachment 2*. As such, the goods are identical and overlapping. Additionally, the examining attorney provided evidence to demonstrate that purchasers are accustomed to encountering “shirts,” “caps with visors,” “jackets” and “hats,” offered under the same or similar mark, in the same channels of trade. *See Out-going Final Office Action dated 01/07/2009 - Attachment 3 and Out-going Denial of Reconsideration dated 08/07/2009 - Attachment 2*. For example, in U.S. Registration Number 3379442, the goods are listed, in pertinent part as “baseball caps, caps with visors, golf shirts, hats, polo shirts, short sleeved and long sleeved T-shirts, tops clothing, visors, sweatshirts.” In U.S. Registration Number 3186715, the goods are listed as “headwear, headgear, namely, hats, caps, visors, baseball caps, sports caps, beanies, caps with visors, chef’s hats, rimless caps, golf caps, skull caps, swimming caps, knitted caps.”

Additionally, U.S. Registration Numbers 3183895, 3551862, 3469656 include the identical wording, “hat” found in the cited registration as well as a listing of the applicant’s goods. For example, in U.S. Registration Number 3183895, the goods are listed as “belts, belts made of leather, belts of textile, bermuda shorts, blazers, blouses, bottoms, camp shirts, capri pants, capris, cardigans, clothing, namely, wrap-arounds, coats, coats for women, coats made of cotton, coats of denim, culottes, dress suits, dresses, dusters, fabric belts, footwear, gaberdines, gauchos, hat, jackets, jumpsuits, kilts, knit shirts, ladies' suits, leather belts, leather coats, leather jackets, leather pants, long

jackets, long sleeved vests, women jackets, trousers, vests, women's suits, miniskirts, mock turtle-neck sweaters, open-necked shirts, over coats, pants, pantsuits, pedal pushers, piquet shirts, polo shirts, pullovers, quilted vests, rain coats, raincoats, sashes, scarves, shirts, shirts for suits, shoes, short trousers, short-sleeved shirts, silk scarves, skirt suits, skirts, skirts and skorts, slacks, sport coats, suede jackets, suit coats, suits, suits of leather, sweaters, top coats, topcoats, tops, trench coats, trousers, trousers of leather, tunics, turtleneck sweaters, turtlenecks, twin sets, vested suits, vests, v-neck sweaters, waistcoats, wraps.” In U.S. Registration Number 3551862, the goods are listed as “clothing, headgear and footwear, namely, T-shirts, tops, shorts, pants, sweatshirts, jackets, parkas, vests, anoraks, hat, caps.” Finally, in U.S. Registration Number 3469656, the goods are listed as “coats; dresses; gloves; hats; headgear, namely, hat, caps; jackets; pants; scarves; shirts; shorts; skirts; skirts and dresses; sweaters; undergarments.” As such, it is clear that the same class of purchasers shop for these similar items in the same channels of trade and that consumers are accustomed to seeing them sold under the same or similar trademarks.

Applicant argues that the applied-for mark is not likely to cause confusion with the registered mark because of the lack of fame associated with the registered mark and because applicant’s mark is well-known in its industry. To support this contention the applicant supplied several U.S. Registration Numbers for the marks USG, USG ACTION, USG CEILINGS and USG IMPROVING THE FINISH, for “limeproof colors and wall coatings in the nature of paint”, “plaster, tile, and wall board”, “metallic components used in framing construction of buildings-namely, studs, runners, channels”; “wallboard joint compounds; wallboard joint tape”, “computer software used to provide

technical information in the field of construction” and “information services, namely providing technical information to architects, designers, engineers, specifiers and construction industry professionals by means of computer software,” “non metal acoustical ceiling tiles and panels” “promoting sports competitions and/or events of others” and “providing incentives by way of awards to recognize outstanding achievements in the field of car racing.” These arguments are unpersuasive.

Firstly, a cited registration does not have to be famous in order to receive protection against a subsequent user of a nearly identical mark for identical and highly related goods. The overriding concern in a Section 2(d) likelihood of confusion analysis is 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). Secondly, through the submission of its prior U.S. Registrations it appears that applicant is asserting a claim of acquired distinctiveness, i.e., that purchasers familiar with its prior registrations for the same mark, USG, for building and construction products and services will associate that same mark with clothing provided by the applicant. However, a claim of distinctiveness pursuant to 15 U.S.C. §1052(f) is inapplicable to this likelihood of confusion analysis. Even if applicant’s claim of distinctiveness were relevant, this Office requires that the goods in the application be sufficiently similar to the goods or services named in the prior registrations. *See Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 6 USPQ2d 1475, 1478 (TTAB 1988) (“Applicant’s almost total reliance on the distinctiveness which its gold ring device has achieved vis-à-vis rifle scopes and handgun scopes is simply not sufficient by itself to establish that the same gold ring device has become distinctive vis-à-vis binoculars and

spotting scopes.”). Here, applicant has provided no evidence to show that its prior registrations for ceiling tiles and panels, computer software, metallic goods, wallboards, paint, plaster and tile are remotely related to clothing goods. On the other hand, the examining attorney has provided dictionary definitions as well as third party registrations to show that the applicant’s goods are highly related and identical to the registrant’s hat[s] such that purchasers encountering the goods are likely to mistakenly believe that they are provided by a common source.

Additionally, applicant argues that the restriction placed on the channels of trade for its goods further obviates a likelihood of confusion determination. However, it is not clear how clothing goods are sold in the building and construction channels of trade. Even if applicant targets purchasers in those industries, the goods are likely to be sold in the usual retail channels of trade for clothing. Moreover, the registrant’s goods are identified broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers. Therefore, it is presumed that the registration encompasses all goods of the type described, including those in applicant’s more specific identification, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii). Additionally, the Trademark Trial and Appeal Board has held that evidence that third parties offer the goods of both the registrant and applicant suggest that it is likely that the registrant would expand their business to include applicant’s goods. In that event, customers are likely to believe the goods at issue come from, or are in some way connected with, the same source. *In re 1st USA Realty Prof’ls*, 84 USPQ2d at 1584 n.4; *see* TMEP §1207.01(a)(v).

Finally, the applicant does not seek registration for specialized clothing particular to the building and construction industry, such as hard hats, protection masks, gloves and eyewear, etc., but rather for shirts, caps with visors, and jackets in International Class 025. Moreover, both the applicant and the registrant are providing goods that are likely to be similarly priced. The risk of likelihood of confusion is increased for inexpensive products that are purchased on impulse. Therefore, in a likelihood of confusion determination, purchasers of such products are held to a lesser standard of purchasing care. *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). Additionally, the decisions in the clothing field have held many different types of apparel to be related under Trademark Act Section 2(d). *Cambridge Rubber Co. v. Cluett, Peabody & Co.*, 286 F.2d 623, 128 USPQ 549 (C.C.P.A. 1961) (women's boots related to men's and boys' underwear); *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992) (underwear related to neckties); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991) (women's pants, blouses, shorts and jackets related to women's shoes); *In re Pix of Am., Inc.*, 225 USPQ 691 (TTAB 1985) (women's shoes related to outer shirts); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397 (TTAB 1982) (hosiery related to trousers); *In re Cook United, Inc.*, 185 USPQ 444 (TTAB 1975) (men's suits, coats, and trousers related to ladies' pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400 (TTAB 1964) (brassieres and girdles related to slacks for men and young men).

Thus, when purchasers encounter the applicant's and registrant's clothing goods, they are likely to be confused as to the sources of the goods by the obvious overlap and clear association between them. Accordingly, because the marks are confusingly similar

and the goods and services are closely related, purchasers encountering these goods are likely to mistakenly believe that they are provided by a common source.

III. CONCLUSION

The applicant's proposed mark **USG** is confusingly similar to the registered mark **US&G** because the marks share the same identical literal elements, "U," "S," "G," which are arranged in the same order, and the first part of the marks are likely to be pronounced identically. Additionally, the marks are used in connection with identical and highly related goods that are commonly offered by a single entity under the same trademark, marketed through similar channels of trade to the same class of purchasers.

Consequently, purchasers encountering these confusingly similar marks for identical and highly related goods are likely to be mistakenly believe that the goods originate from a common source, or that applicant's mark represents a new product offered by the registrant, due to the overall similarities in the sound, appearance and commercial impression in the respective marks.

For the foregoing reasons, the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), should be affirmed.

Respectfully submitted,

Charisma Hampton

Trademark Examining Attorney

Law Office 112

Phone: 571-270-1522

Fax: 571-270-2522

Angela Wilson

Managing Attorney

Law Office 112