

This Opinion is Not a
Precedent of the TTAB

Mailed: July 16, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Soletanche Freyssinet

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Serial No. 79194724

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John J. O'Malley of Volpe and Koenig PC.,
for Soletanche Freyssinet.

Matt Einstein, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

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Before Zervas, Larkin, and Coggins,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Soletanche Freyssinet (“Applicant”) seeks registration on the Principal Register of the standard character mark CMC for “Non-metallic underground columns for land stabilization and reinforcement that are fabricated and installed on site” in International Class 19.¹

¹ Application Serial No. 79194724, filed on August 24, 2016 pursuant to Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), based upon Applicant’s ownership of International Registration No. 1315847.

The Examining Attorney refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark is likely to cause confusion with the registered composite word-and-design mark



and the standard character word mark CMC,² both registered on the Principal Register to the same owner for the same goods and services including, inter alia, a “full line of metals in sheet, rod, bar, angle, round, beam, castellated beam, cellular beam, flat beam, joist, strip, tube, plate, billet, square, and wire form” in International Class 6; and “retail store services and distributorships featuring ... construction products, and accessories” in International Class 41.

After the refusal was made final, Applicant appealed and filed a request for reconsideration. On remand from the Board, the Examining Attorney denied the request for reconsideration. The Board resumed the appeal, and Applicant and the Examining Attorney filed briefs. We reverse the refusal to register.

² Registration Nos. 4052766 and 4052767, respectively. Both registered November 8, 2011; Section 8 affidavits accepted and Section 15 affidavits acknowledged for both registrations. The composite mark is described as consisting of a stylized globe with a banner containing the letters “CMC.”

I. Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) (“*DuPont*”); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that “[t]he 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.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). “Not all of the [*DuPont*] factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)).

We confine our analysis to the identical cited CMC word mark. If confusion is likely between this mark and Applicant’s mark, there is no need for us to consider the issue with respect to Registrant’s composite mark, while if there is no likelihood of confusion between Applicant’s and Registrant’s word marks, then there would be no likelihood of confusion with Registrant’s composite mark. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

a. Similarity of the Marks

There is no dispute that Applicant's and Registrant's word marks are identical. This *DuPont* factor thus supports a finding of a likelihood of confusion.

b. Similarity of Goods/Services

The goods need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

We evaluate the relatedness of the respective goods and services based on their identifications in the subject application and cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014). See also *Paula Payne Prods. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). We are mindful of the limitations to Applicant's "columns" in the identification of goods, namely, that they are non-metallic, fabricated and installed on site, underground, and intended for land stabilization and reinforcement.

The Examining Attorney first argues that Applicant's and Registrant's goods are "pieces of construction equipment used for building and/or support and thus, likely to be encountered by the same purchasers and found in the same channels of trade."³ However, there may be hundreds of "pieces of construction equipment" used for building and support in any construction project; therefore, this alone is not a basis to find that the identified goods are related or that they are likely to be offered in the same channels of trade and to the same class of purchasers.

Next, the Examining Attorney argues that "[R]egistrant's goods could be metal rods, and/or beams for land stabilization and reinforcement. Therefore, the goods could have the same function or purpose."⁴ The columns identified in the application are "non-metallic," and the Examining Attorney does not point to any evidence in the record to support his contention that metal rods or beams are similarly used for land stabilization or land reinforcement. Without evidence, we do not accept this theoretical representation.

The Examining Attorney also argues that "[w]here evidence shows that the goods at issue have complementary uses, and thus are often used together or otherwise purchased by the same purchasers for the same or related purposes, such goods have generally been found to be sufficiently related such that confusion would be likely if they are marketed under the same or similar marks."⁵ He relies on general websites

³ Brief, 16 TTABVUE 10.

⁴ *Id.* at 11.

⁵ *Id.*

such as www.basiccivilengineering.com, www.understandconstruction.com, and www.differencebetween.com to support his contention that beams and columns are used for making frames, support, etc. in general construction.⁶ There are three problems with the Examining Attorney's argument and evidence. First, they ignore the various limitations in Applicant's identification of goods, which goods are not simply building or general construction columns but are particular columns for a particular purpose and location, "fabricated and installed on site," and the evidence he relies on is not particularly relevant to Applicant's goods. Second, as the declaration of Frederick Masse, President of Applicant's subsidiary Menard Group USA, explains, Applicant's specialized goods are not used for the general construction of structures and "[t]here is no direct connection between [such] structure[s] and the Applicant's [land stabilization and reinforcement columns]. They are decoupled from each other."⁷ Specifically, Applicant's specialized goods "strengthen soft and compressible foundation soils and modify the overall behavior of the soils to provide bearing capacity and settlement control so the improved soils can support the structure without failure or excessive deformations."⁸ This is borne out by the plain (and detailed) language of the identification. Third, the Examining Attorney's argument assumes that all building elements are related to one another simply because they appear in the same structure, a proposition which we do not accept,

⁶ *Id.* at 12-13.

⁷ Masse Decl. ¶ 20, Request for Reconsideration, 4 TTABVUE 14.

⁸ *Id.*

certainly in the absence of supporting evidence. There is no such per se rule. Even if the goods are within, or supporting, the same structure, we are not persuaded that such disparate goods may be related to one another simply for that reason.⁹

As noted above, the Examining Attorney does not refer in his brief to any evidence that suggests that metal goods of the kind identified in Registrant's identification of goods are used in connection with land stabilization and reinforcement. Aside from one webpage which refers to "soil nailing [which] uses grouted, tension-resisting steel elements (nails) installed to reinforce the soil creating a gravity retaining wall for permanent or temporary excavation support,"¹⁰ and has "[t]ension resisting steel bars ... inserted into the holes and grouted in place,"¹¹ the record is bare of any structural elements of the type and use identified by Applicant having metal components. Mr. Masse also states that "CMC products are not fabricated as such but formed and installed directly into the ground from non-metallic raw material (i.e., concrete)."¹² We are not persuaded by this single webpage reference that Applicant's and Registrant's goods are related.

The Examining Attorney also argues that the use of similar marks on or in connection with products, and retail store services offering such products, has been

⁹ We do not agree with the Examining Attorney that Mr. Masse's statement at Paragraph 20 (Applicant's goods "are installed into a ground to create a composite material with enhanced characteristics to support a structure") contradicts Applicant's representation that Applicant's goods "do not directly support the load of a structure." Brief, 16 TTABVUE 14. It appears to us that Mr. Masse is referring to the ground, whose load strength has been increased through the installation of Applicant's goods.

¹⁰ Request for Reconsideration Denied, 5 TTABVUE 9 (haywardbaker.com).

¹¹ *Id.* at 10.

¹² Masse Decl. ¶ 11, 4 TTABVUE 12.

held likely to cause confusion where the evidence showed that the retail-store services featured the same type of products. He then labels Applicant's goods "construction products," and finds Registrant's retail stores and distributorships feature construction products related to Applicant's "construction products."¹³ We disagree. First, the identification of goods specifies that Applicant's goods are fabricated and installed on site: as such, they are not a type of goods that are offered in retail stores or through distributorships. Second, the Examining Attorney points to no evidence to support his arguments, and it seems unlikely that beams for land stabilization and reinforcement would be offered or purchased in retail stores.

In sum, we find that the Examining Attorney has not established that there is a viable relationship between Applicant's goods and Registrant's goods or services.¹⁴

c. Purchasing Conditions

Applicant argues that "the degree of sophistication of Applicant's potential purchasers and the nature and cost of the goods sold would result in a more careful perusal of the goods and respective marks than that involved in a typical purchase by an ordinary consumer."¹⁵ The unusual nature of Applicant's goods make them of a type which would necessarily be selected with care by purchasers familiar with the

¹³ 16 TTABVUE 10-11.

¹⁴ The Examining Attorney also submitted third-party registrations to show a relationship between the goods with his Office Actions. He does not rely on them and with the exception of one registration, we find them to be irrelevant. A single registration does not establish the Examining Attorney's burden of showing even a viable relationship between the involved goods.

¹⁵ 14 TTABVUE 13-14. Applicant identifies its consumers as "general contractors, owners, developers and geotechnical engineers." Masse Decl. ¶ 10, 4 TTABVUE 11.

source or origin of the products. *See In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985). By definition, buyers of Applicant’s “[n]on-metallic underground columns for land stabilization and reinforcement that are fabricated and installed on site” either know their specific product needs, or obtain them through consultation with Applicant, and in either instance they would be expected to exercise significant care in their selection. *See Republic Steel Co. v. M.P.H. Mfg. Corp.*, 312 F.2d 940, 136 USPQ 447, 449 (CCPA 1963) (stating “the goods are of a character usually purchased with care and discernment by technically trained persons,” involving sheet metal structural members for prefabricated buildings vs. plain deformed and sheared steel bars as reinforcing elements for concrete; pressed-steel beams, joists, studs, plates, and channels for use in walls, ceilings, or floors of all types of building; columns, and girders, etc.). The *DuPont* factor regarding purchaser sophistication and care weighs against finding a likelihood of confusion.

d. Conclusion

We have considered all of the evidence in the record and the arguments of the Examining Attorney and Applicant. The marks are identical. Given the sophistication of purchasers and their deliberation involved in determining the suitability of particular columns for land stabilization and reinforcement and metal building materials, and fact that the Examining Attorney has not established that the goods are related, we conclude that confusion as to the origin or affiliation of Applicant’s and the registrant’s goods/services would not be likely to occur even with identical

marks. The Board's conclusion *In re Massey-Ferguson Inc.*, 22 USPQ 367, 36 (TTAB 1983) is worth repeating here;

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.

In the case at hand the differences between the goods of the registrant and the services of the applicant are simply too great, even though the marks are almost identical, for confusion to be more than a remote possibility. The Examining Attorney has simply not built a record that convinces us to the contrary.

Decision: The refusal to register is reversed.