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Subject: U.S. TRADEMARK APPLICATION NO. 85908555 - DESIGNER DOORS BY AUTUMNWOOD -
AE/TM-101 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85908555 MARK: DESIGNER DOORS BY AUTUMNWOOD	
CORRESPONDENT ADDRESS: DALE F REGELMAN QUARLES & BRADY LLP 1 S CHURCH AVE STE 1700 TUCSON, AZ 85701-1630	GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp
APPLICANT: Architectural Elements, LLC	
CORRESPONDENT'S REFERENCE/DOCKET NO: AE/TM-101 CORRESPONDENT E-MAIL ADDRESS: tm-dept@quarles.com	

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, Architectural Elements, LLC, has appealed the examining attorney's refusal to register the mark DESIGNER DOORS BY AUTUMNWOOD & design for "non-metal doors," in International Class 019, under Trademark Act Section 2(d); 15 U.S.C. §1052(d) on the ground that the

applied for mark is likely to cause confusion, or to cause mistake, or to deceive. The refusal to register based upon a likelihood of confusion is the only issue on appeal.

FACTS

On April 18, 2013, applicant filed the instant application seeking to register the mark DESIGNER DOORS BY AUTUMNWOOD & design for “non-metal doors,” in International Class 019. In an Office action dated August 6, 2013, the examining attorney refused registration under Trademark Act Section 2(d) based upon a likelihood of confusion between the applied for mark and the registered mark AUTUMNWOOD COLLECTION (U.S. Reg. No. 2124818) for “vinyl siding, soffits and parts therefor,” in International Class 019.

Applicant responded to the initial refusal on February 6, 2014 by presenting arguments in favor of registration. On March 18, 2014, the examining attorney made final the refusal to register. Applicant subsequently filed an appeal brief on June 12, 2014.

ISSUE ON APPEAL

Whether applicant’s use of the mark DESIGNER DOORS BY AUTUMNWOOD & design for “non-metal doors,” in International Class 019 creates a likelihood of confusion with the registered mark AUTUMNWOOD COLLECTION for “vinyl siding soffits and parts therefor,” in International Class 019.

ARGUMENTS

I. INITIAL CONSIDERATIONS

Applicant has submitted new evidence with its appeal brief. Specifically, Figures 1, 2, and 3 and Exhibits 1, 2, 3, and 4.

The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. See *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d 1593, 1596 (TTAB 2014); *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

II. LEGAL CONSIDERATIONS

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination.

Citigroup Inc. v. Capital City Bank Grp., Inc., 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 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 and nature of the goods, and similarity of the trade channels of the goods. See *In re Viterro Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

A. THE MARKS ARE SIMILAR

As stated in the first and final Office actions, applicant's mark and the registered mark are similar in sound, appearance, and commercial impression. Both marks contain the term AUTUMNWOOD, which is spelled the same and presented as a compound word in each instance. Given that this term is part of both marks, there is a visual similarity in this case. Applicant argues that the marks are not similar visually because its mark contains design elements and other wording that distinguishes its mark from the registered mark. In addition to making the argument that the marks are not similar visually, applicant provided evidence showing use of registrant's mark in commerce in its response to the first Office action and in its appeal brief (Fig. 4 in applicant's brief). The examining attorney disagrees with applicant's assertions for the same reasons that were detailed in the final Office action.

First, the registered mark is presented in standard characters. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. See *In re Vittera Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. See, e.g., *In re Vittera Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”).

Second, the dominant portion of both marks is the term AUTUMNWOOD. Despite the additions of descriptive and generic wording in both marks, and design elements in applicant’s mark, the term AUTUMNWOOD in each case is dominant because it appears to be suggestive if not arbitrary when used to identify the respective goods. As such, although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Vittera Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for an applicant’s goods 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 at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii).

Further, for a composite mark (like applicant’s) containing both words and a design, the word portion may be more likely to be impressed upon a purchaser’s memory and to be used when requesting the goods. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB

2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entirety, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Applicant also argues that the marks are not similar in sound. In making this argument, applicant also referred to instances in which the mark is used in commerce. With regard to this issue, the examining attorney also disagrees with applicant's assertions. The examining attorney reiterates that the cited registration shows the registered mark in standard characters. Thus, when comparing the marks as they are presented in the application and registration, there is a clear similarity in sound between the marks in the instant case. As previously stated, both marks contain to dominant term AUTUMNWOOD, and when the marks are spoken or heard, this term produces the same sound in both marks. The examining refers again to the cases *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, *In re Viterra Inc.*, in which it is stated that the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar. Applying this case law to the sound similarities of the mark, it is clear that there is a likelihood of confusion in this situation because AUTUMNWOOD is the more dominant term, and consumers would experience confusion when hearing or speaking this term in both marks.

The previously detailed similarities of the marks in sound and appearance, also contribute to the commercial impression created by the marks. As stated above, the shared term AUTUMNWOOD

appears to be suggestive, if not arbitrary, when used to identify the respective goods. Consequently, the connotation and thus the commercial impression of the term AUTUMUNWOOD is the same in each case.

Given the above analysis and case law, it is clear that the marks are similar in sound, appearance, and commercial impression.

B. THE GOODS ON WHICH THE MARKS ARE USED ARE SIMILAR

Turning to the similarities of the goods in this case, applicant argues that “the conditions under which and buyers to whom sales are made [differ], i.e., ‘impulse’ vs. ‘careful’, sophisticated purchasing.” Again, the examining attorney respectfully disagrees with this assertion. As stated in the final refusal, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, ___ F.3d ___, ___, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

Applicant also argues that there has been no actual confusion between the marks. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); TMEP §1207.01(d)(ii). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

The examining attorney provided evidence in the first and final Office actions showing that applicant's goods (doors) and registrant's goods (vinyl siding) are related in that they are frequently sold in the same marketplaces. In the first Office action, evidence in the form of third party registrations, illustrated that the respective goods are often provided under the same mark. This evidence shows that the goods listed therein, namely doors (applicant's goods) and vinyl siding and soffits (registrant's goods), are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). Thus, consumers would encounter the goods in the same trade channels and upon seeing or hearing very similar marks identifying those goods, would experience confusion as to the source.

In the final Office action, the examining attorney attached screenshots from various websites showing that doors and vinyl siding are frequently sold together. This evidence shows for example:

- *ProVia*® "The Professional Way" (See page 2 of final Office action dated March 18, 2014) markets entry doors and registrant's Autumnwood® vinyl siding via its retail outlet.

- The company *Champion* (See page 3 of final Office action dated March 18, 2014), markets both vinyl siding and doors through its online retail website.
- *Norandex*, (See page 4 of final Office action dated March 18, 2014) also provides various types of vinyl siding and doors under the same marketing conditions.

Material obtained from the Internet is generally accepted as competent evidence. See *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (accepting Internet evidence to show relatedness of goods in a likelihood of confusion determination); *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (accepting Internet evidence to show genericness); *In re White*, 80 USPQ2d 1654, 1662 (TTAB 2006) (accepting Internet evidence to show false suggestion of a connection); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (accepting Internet evidence to show geographic significance); *In re Consol. Specialty Rests. Inc.*, 71 USPQ2d 1921, 1927-29 (TTAB 2004) (accepting Internet evidence to show geographic location is well-known for particular goods); *In re Gregory*, 70 USPQ2d 1792, 1793, 1795 (TTAB 2004) (accepting Internet evidence to show surname significance); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060-61 (TTAB 2002) (accepting Internet evidence to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

The above specified evidence, as well as all of the other evidence that is of record, clearly establishes that the goods are at the very least related. It should be noted that the respective goods need only be "related in some manner and/or if the circumstances surrounding their marketing [be] 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*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

III. CONCLUSION

The characteristics of the marks, the relatedness of the goods, the evidence of record, and application of the relevant case law firmly establish that a likelihood of confusion exists between applicant's mark and the registered mark. For the foregoing reasons, the refusal to register on the basis of §2(d) of the Trademark Act, 15 U.S.C. §1052(d), for the reason that there is a likelihood of confusion between the applied for and cited marks, should be affirmed

Respectfully submitted,

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