

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: September 28, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

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WFI Global, LLC

v.

MCNS Polyurethanes USA Inc.

—————
Opposition No. 91227865
—————

Elizabeth E. Fabick of Fabick Inc.,
for WFI Global, LLC.

Jae Youn Kim and Harold L. Novick of Novick Kim & Lee PLLC,
for MCNS Polyurethanes USA Inc.

—————
Before Shaw, Pologeorgis and Coggins,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

MCNS Polyurethanes USA Inc. (“Applicant”) seeks registration on the Principal Register of the mark SuperCore (in standard characters) for “Polyurethanes;

Polyurethane for use in manufacture of foams” in International Class 1, and “Insulating materials, namely, polyurethane foam” in International Class 17.¹

WFI Global, LLC (“Opposer”) opposes the registration of Applicant’s mark on the following two grounds: (1) likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and (2) misuse of the registration symbol pursuant to Section 29 of the Trademark Act, 15 U.S.C. § 1111.² In support of its claims, Opposer pleaded ownership of a registration for the mark U-CORE (in standard characters) for “Insulating material in the nature of polyurethane foam and polyethylene foam for use in the manufacture of fenestration; polyurethane spray foam containing two formulated components for injection into extrusion and pultrusion frame and sash cavities to improve overall window thermal performance and enhance window condensation resistance” in International Class 17.³ Additionally, Opposer pleaded prior common law use of the mark U-CORE used in connection with the sale, marketing, advertising, and promotion of the same goods identified in its pleaded registration.⁴

In its answer, Applicant denied the salient allegations in Opposer’s pleading and asserted the affirmative defense that “there is no likelihood of confusion, mistake or

¹ Application Serial No. 86739506, filed on August 27, 2015, based on an allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Notice of Opposition; 1 TTABVUE.

³ Registration No. 4569638, issued on July 15, 2014; Notice of Opposition ¶ 1, 1 TTABVUE 4.

⁴ Notice of Opposition ¶¶ 2 and 5; 1 TTABVUE 4.

deception because, *inter alia*, Applicant's mark and the pleaded marks of Opposer are not confusingly similar."⁵ Applicant's affirmative defense is not a true affirmative defense but rather is simply an argument that goes to the merits of a central issue in this proceeding. Accordingly, the Board construes Applicant's defense as a mere amplification of Applicant's denials to the salient allegations set forth in Opposer's notice of opposition. *See Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995).

I. Procedural Background/Accelerated Case Resolution

On August 12, 2016, the parties submitted a stipulation regarding the introduction of evidence in this proceeding.⁶ Specifically, the parties stipulated that (1) all documents produced by either party in this proceeding shall be deemed authentic business records and that objections to admissibility of such documents on the grounds of authenticity or genuineness are waived, and (2) testimony may be introduced by sworn declaration or affidavit in lieu of live deposition, with exhibits attached thereto, subject to the right of the party against whom the evidence is introduced to object to such evidence on any applicable ground, including but not limited to competency, relevance, and materiality, and further subject to the parties' right to cross-examine declarants by live deposition. On August 23, 2016, the Board approved the parties' stipulation.⁷

⁵ 4 TTABVUE 5.

⁶ 6 TTABVUE.

⁷ 7 TTABVUE.

On September 23, 2016, the parties filed a stipulated motion to use Accelerated Case Resolution (“ACR”) to resolve this proceeding (“ACR Stipulation”),⁸ in which they agreed, inter alia, that (1) evidence may be submitted in the form of declarations or affidavits, and exhibits thereto, similar to the format used for summary judgment, (2) evidence that under normal trial procedures could be submitted by notice of reliance also may be submitted as attachments or exhibits to the parties’ briefs, and (3) documents and things produced in response to requests for production, or reprints of pages retrieved from the Internet, may be submitted as exhibits without the need for accompanying testimony. Additionally, the parties consented to the Board’s resolution of any and all disputed issues of material fact and to the Board rendering a final decision based on the pleadings, stipulated facts, briefs, and evidence. The Board approved the parties’ ACR Stipulation on October 18, 2016.⁹

II. Record

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant’s application file. The record also comprises the evidence summarized below.¹⁰

⁸ 9 TTABVUE.

⁹ 10 TTABVUE.

¹⁰ We note that some of the evidence proffered by both parties has been designated confidential and filed under seal. We have discussed only in general terms the relevant evidence submitted under seal. However, to the extent the parties have improperly designated testimony and evidence as confidential, the Board may disregard the confidential designation when appropriate. Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g) (“[t]he Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.”); *see also Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014). We further note that, effective June 24, 2016, the Board instituted a revised standard protective order for

1. The parties' stipulation of facts.¹¹
2. Exhibits accompanying the parties' stipulation of facts consisting of:¹²
 - Copy of Opposer's pleaded U-CORE registration;
 - Status and title copy of Opposer's pleaded U-CORE registration obtained from the USPTO's electronic database;
 - Status and title copy of Applicant's involved application;¹³
 - Dictionary definitions of the terms "U-value," "U-factor," "core," and "super";
 - Opposer's customer list;
 - Opposer's advertising materials for goods offered in connection with its U-CORE mark;
 - Media articles regarding Opposer's U-CORE mark;
 - Article regarding recognition award bestowed on Opposer for its U-CORE goods;
 - Screenshot from the website www.glassbuildamerica.com identifying attendees at the GlassBuild America trade show;
 - Copies of the National Fenestration Rating Council's ("NRF") 2014 and 2017 rating reports;

currently pending inter partes cases. However, insofar as the parties had already designated materials as confidential pursuant to the tiers of confidentiality under the Board's former protective order, those designations remain in effect. As such, the former standard protective order applies for this proceeding. Further information regarding the Board's new standard protective order is available under the "Standard documents & guidelines" section at www.uspto.gov/ttab.

¹¹ 30 TTABVUE. We note that neither party submitted any testimony, either by live deposition or by declaration or affidavit.

¹² The parties stipulated to the authenticity and admissibility of the exhibits attached to the parties' stipulation of facts. 30 TTABVUE 3.

¹³ It was unnecessary to submit a copy of Applicant's involved application since it is automatically of record. *See* Trademark Rule 2.122(b).

- Applicant’s customer list;
 - Applicant’s advertising material for its SuperCore product;
 - Email communications between Applicant and (1) Craig Gilbert, Applicant’s former Director of Technical Sales, and (2) Applicant’s advertiser, ADCOM;
 - Copy of an invoice of Applicant’s SuperCore product displaying the ® symbol; and
 - Copies of third-party registrations and applications for marks containing the suffix “CORE” for various insulation products.
3. Exhibits Accompanying Applicant’s ACR Brief comprising of:
- Email communications between Applicant’s president, Jin Park, and Craig Gilbert, Applicant’s former Director of Technical Sales, including a list of proposed trademarks for Applicant’s foam insulation goods;¹⁴
 - Portions of the discovery deposition of Applicant’s 30(b)(6) witness, i.e., Jin Park, Applicant’s president;¹⁵ and
 - Safety Data Sheets of Applicant’s SuperCore insulation product.¹⁶
4. Exhibits Accompanying Opposer’s ACR Reply Brief consisting of:
- Email communications between Applicant’s president, Jin Park, and Craig Gilbert, Applicant’s former Director of Technical Sales;¹⁷
 - Applicant’s supplemental responses to Opposer’s First Set of Document Requests;¹⁸ and

¹⁴ 40 TTABVUE 2-5; 41 TTABVUE 2-8.

¹⁵ 40 TTABVUE 6-14.

¹⁶ 43 TTABVUE 2-41.

¹⁷ 45 TTABVUE 27-31.

¹⁸ 45 TTABVUE 32-49.

- Portions of the discovery deposition of Applicant's 30(b)(6) witness, i.e., Jin Park, Applicant's president.¹⁹

III. Standing

Standing is a threshold issue that must be proven by the plaintiff in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, has enunciated a liberal threshold for determining standing, namely that a plaintiff must demonstrate that it possesses a "real interest" in a proceeding beyond that of a mere intermeddler, and "a reasonable basis for his belief of damage." *Empresa Cubana Del Tabaco* 111 USPQ2d at 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). A "real interest" is a "direct and personal stake" in the outcome of the proceeding. *Ritchie v. Simpson*, 50 USPQ2d at 1026.

Opposer has demonstrated through the USPTO database printout made of record that it is the owner of its pleaded registration and that the registration is valid and subsisting.²⁰ Because Opposer's registration is of record, Opposer has established its standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Ind., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

¹⁹ 45 TTABVUE 50-60.

²⁰ Statement of Facts, Ex. B.; 30 TTABVUE 23-26.

IV. Section 2(d) Claim

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). To prevail on its Section 2(d) claim, Opposer must prove, by a preponderance of the evidence, that it has priority in the use of its mark and that use of Applicant’s mark is likely to cause confusion, mistake, or deception as to the source or sponsorship of Applicant’s goods, *Cunningham*, 55 USPQ2d at 1848, even in the absence of contrary evidence or argument. *Threshold TV, Inc. v. Metronome Enters., Inc.*, 96 USPQ2d 1031, 1040 (TTAB 2010).

A. Priority

Because Opposer’s pleaded registration for the mark U-CORE is of record and since the Statement of Facts submitted by the parties establishes that Opposer has used its pleaded U-CORE mark in commerce prior to Applicant’s first use of its involved mark,²¹ priority is not an issue with respect to the goods identified in Opposer’s registration, *see Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy, Inc. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)), nor is priority an issue with regard to Opposer’s common law use of its pleaded U-CORE mark in connection with the same goods

²¹ Statement of Facts, ¶¶ 5 and 7, 30 TTABVUE 4.

identified in its pleaded registration.

B. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). For example, the Board can “focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (quoting *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001)). The fame of the prior mark can also be critical. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). These factors, and the other relevant *du Pont* factors are discussed below.

1. Similarity of the Goods, Trade Channels and Classes of Purchasers

We first address the second *du Pont* likelihood of confusion factor focusing on the comparison of the goods identified in Applicant’s application vis-à-vis the goods identified in Opposer’s pleaded registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

At the outset, we note that the involved application and Opposer's pleaded registration include goods that are identical, at least in part. Applicant's application and Opposer's registration both include insulating material in the nature of polyurethane foam. With regard to Applicant's Class 1 goods, Applicant concedes that these goods are similar to the goods identified in Opposer's pleaded registration.²² Given that the parties' Class 17 goods are identical in part and in light of Applicant's concession that its Class 1 goods are related to Opposer's goods, this *du Pont* factor weighs in favor of finding a likelihood of confusion.

Because the parties' Class 17 goods are legally identical in part, and since neither Opposer's registration nor the involved application contain any limitations on the channels of trade and classes of purchasers, we must presume that the trade channels and classes of purchasers are the same for these identical goods. *See Stone Lion*, 110 USPQ2d at 1161; *In re Yawata Iron & Steel Co., Ltd.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011). With regard to Applicant's Class 1 goods, Applicant concedes that these goods travel in similar trade channels as Opposer's goods and are available to the same or overlapping consumers.²³ As such, the third *du Pont* factor regarding the similarity or dissimilarity of established, likely to continue trade channels and classes of

²² Applicant's ACR Brief, pp. 6-7, 39 TTABVUE 11-12.

²³ *Id.* at p. 7, 39 TTABVUE 12.

purchasers also favors a finding of likelihood of confusion.



2. Strength of Opposer's U-CORE mark

The fifth *du Pont* factor, the fame of the prior mark, and the sixth *du Pont* factor, the number and nature of similar marks in use for similar goods, *du Pont*, 177 USPQ at 567, are considered in tandem to determine the strength of Opposer's mark and the scope of protection to which it is entitled. *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017).²⁴ "In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition." *Bell's Brewery*, 125 USPQ2d at 1345 (citing *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014)); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).").

In assessing the conceptual strength of Opposer's U-CORE mark, we note that the record includes copies of third-party registrations for marks that include the term CORE as a suffix for various insulation products.²⁵ As example:

²⁴ The Federal Circuit recently reiterated that "[w]hile dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame varies along a spectrum from very strong to very weak." *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *Palm Bay Imps. Inc. v. Veuve Cliquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (internal quotation omitted)).

²⁵ Stipulation of Facts, Ex. HH, 30 TTABVUE 425-79. The record also includes pending and abandoned applications for "–CORE" formative marks for various insulation products. *Id.*, 30 TTABVUE. Applications, whether live or abandoned, are not evidence of anything except for the dates on which they are filed. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *Interpayment Servs. Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1467 n.6 (TTAB 2003)

-  (Reg. No. 4763096) for, among other things, “foam insulation, namely, expanded polystyrene for use in building and construction”;
- PINKCORE (Reg. No. 3134201) for “building insulation”;
- J-CORE (Reg. No. 4305883) for “foam sheeting for use as a building insulation”;
- IPN-Quadcore (Reg. No. 4647736) for, among other things, “insulating materials”;
- AEROCORE (Reg. 3739324) for “electric, thermal and acoustic insulators”;
-  (Reg. No. 1780288) for “thermal and acoustical insulating material for walls and partitions, for air conditioning equipment and for lighting equipment”;
- SAFECORE (Reg. No. 2792389) for “insulating mineral material sold in bonded slab, bonded sheet or bonded board form, for fire protection, fire proofing or fire retardation, to be used in the manufacture of doors, wall and ceiling panels and indoor furniture”;
- STRUCTURE CORE (Reg. No. 2944956) for “insulating structural panels for placement on edifices”;

(applications are only probative to show that the application has been filed). It is certainly not evidence of the weakness or usage of the “-CORE” formative marks for insulation products. Thus, we accord the third-party applications little, if any, probative value. Additionally, the record includes third-party registrations for marks encompassing the term CORE but for goods unrelated to those at issue. *See, e.g.*, GLIDE SMOOTH CORE (Reg. No. 5041493) for “plastic film for industrial and commercial packing use” and HI-CORE (Reg. No. 1866366) for “plastic sheet material; namely, polypropylene and polyethylene corrugated sheets for use in manufacturing.” These third-party registrations have no probative value in our analysis herein. *See In re Melville Corp.*, 18 USPQ2d 1386, 1388-99 (TTAB 1991) (“Registrations for goods unrelated to the clothing field are irrelevant to our discussion”); *Anderson, Clayton & Co. v. Christie Food Prods. Inc.*, 4 USPQ2d 1555, 1557 n.7 (TTAB 1987) (“The other third-party registrations relating to marks in unrelated fields are of no probative value”).

- UTILICORE (Reg. No. 4654162) for “insulating materials.”²⁶

In *Juice Generation Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015), our reviewing court, the U.S. Court of Appeals for the Federal Circuit, stated the following with regard to the probative value of third-party registrations when analyzing the strength or weakness of a mark or a portion thereof:

In addition, “[a] real evidentiary value of third party *registrations* per se is to show the sense in which ... a mark is used in ordinary parlance.” 2 McCarthy on Trademarks and Unfair Competition § 11:90 (4th ed. 2015) (emphasis added). “Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Id.*; see *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917 [189 USPQ 693] (CCPA 1976) (even if “there is no evidence of actual use” of “third-party registrations,” such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”). Marks that are descriptive or highly suggestive are entitled to a narrower scope of protection, *i.e.*, are less likely to generate confusion over source identification, than their more fanciful counterparts. See, *e.g.*, *Drackett Co. v. H. Kohnstamm & Co.*, 404 F.2d 1399, 1400 [160 USPQ 407] (CCPA 1969) (“The scope of protection afforded such highly suggestive marks is necessarily narrow and confusion is not likely to result from the use of two marks carrying the same suggestion as to the use of closely similar goods.”).

In the present case, the third-party registrations of record are sufficient to show that that the term CORE, when used in association with insulation products

²⁶ The record also includes third-party registrations of marks with a “-CORE” suffix for goods in the nature of acoustical insulation. See *e.g.*, ACOUSTICORE (Reg. No. 3281353) for “acoustical insulation barrier panels”; DBCORE (Reg. No. 2916582) for “thermal and acoustical insulation pads for automotive applications”; HUSHCORE (Reg. No. 2294156) for “acoustical insulation barrier panels, baffles and partitions”; PURECORE (Reg. No. 3784171) for “architectural acoustic products, namely, acoustic infill for use as sound absorbers, sound insulators, sound deflectors, sound reflectors and/or sound diffusers”; TERRA CORE (Reg. No. 4585269) for, among other things, “acoustical insulation for buildings”; and ZORBICORE (Reg. No. 3684350) for “acoustical insulation barrier panels.”

generally or with insulation products with thermal or acoustical barrier applications specifically, has been extensively adopted and registered as part of a trademark for such insulation goods. We therefore find the term CORE has a significance in the insulation industry which makes its suggestive of these types of insulation goods.

The record demonstrates that Opposer, in choosing a trademark for its polyurethane foam, wanted a name that was easy to spell and pronounce, and that also was suggestive of the benefits its goods provide.²⁷ Opposer chose its U-CORE mark because the polyurethane foam impacts the “U-value” of the window extrusion into which its goods are injected, providing enhanced insulation benefits.²⁸ The record also demonstrates that “U-value” (or “U-factor”) is a recognized term in the fenestration²⁹ industry, and, according to Merriam-Webster, is “a measure of the heat transmission through a building part (as a wall or window) or a given thickness of a material (as insulation) with lower numbers indicating better insulating results.”³⁰ Accordingly, we find that the “U-“ prefix of Opposer’s mark is also suggestive of

²⁷ Statement of Facts, ¶ 14, 30 TTABVUE 5.

²⁸ *Id.*, 30 TTABVUE 5-6.

²⁹ We take judicial notice of the definition of “fenestration” which includes “1: the arrangement, proportioning, and design of windows and doors in a building.” See www.merriam-webster.com. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016). The Board may notice dictionary definitions sua sponte. See *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

³⁰ Statement of Facts, ¶ 15 and accompanying Exh. D, 30 TTABVUE 6 and 98-99.

Opposer's identified goods inasmuch it suggests to consumers that the polyurethane foam impacts the degree of the U-value or U-factor.

While there is no evidence of record of any third-party registrations or third-party uses of the term U-CORE, as a whole, for the goods at issue, we nonetheless find that, with regard to conceptual strength, the components of Opposer's U-CORE mark are suggestive of the identified goods. As a result, Opposer's U-CORE mark is not as conceptually strong as a term that is entirely arbitrary.³¹ Accordingly, the sixth *du Pont* factor, i.e., the number and nature of similar marks in use on similar goods, slightly favors Applicant.

In determining the commercial strength of Opposer's U-CORE mark, such strength "may be measured indirectly by the volume of sales and advertising expenditures in connection with the [goods] sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the [goods] identified by the mark []; and the general reputation of the [goods]." *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017).

To demonstrate the commercial strength of its U-CORE mark, Opposer provided a variety of evidence, some of which is confidential and therefore will be discussed

³¹ Even if Opposer's pleaded U-CORE mark is considered somewhat suggestive of Opposer's attendant goods, *see infra*, we find that the suggestiveness of the mark does not detract from the fact that Opposer's U-CORE mark is inherently distinctive. *See generally Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1083 (1992) (suggestive, arbitrary and fanciful marks are deemed inherently distinctive).

only in general terms. We initially note that Opposer operates in a niche market. The evidence of record shows, *inter alia*, that (1) Opposer has been using its U-CORE mark in connection with its polyurethane foam insulation since April 18, 2013;³² (2) since Opposer began offering its polyurethane foam under its U-CORE mark, Opposer's sales have been on an upward trend despite the fact that its advertising expenditures have not been significant; (3) Opposer has marketed its goods offered in connection with the U-CORE mark through direct sales, third-party sales representatives, equipment distributors, tradeshow attendance, and an online presence through its website; (4) Opposer's U-CORE goods have been the subject of several articles in publications concerning the window foam industry, namely, *Plastic News*, *Window & Door*, and *Door & Window Market Magazine*; (5) Opposer has advertised and marketed its U-CORE polyurethane foam product at the following tradeshows: (i) Northeast Window & Door Association in Mount Laurel, New Jersey on January 28-29, 2013; (ii) GlassBuild America in Las Vegas, Nevada on September 9-11, 2014, and (iii) GlassBuild America in Atlanta, Georgia on September 16-18, 2015; and (6) in 2014, Opposer was awarded the *Door & Window Market Magazine's* Green Award for goods sold in connection with Opposer's U-CORE mark.

While this evidence supports a finding of some renown attributable to Opposer's pleaded U-CORE mark since 2013, we find that Opposer's mark has only achieved a marginal degree of fame under the fifth *du Pont* factor to the extent that it would not outweigh all the other *du Pont* factors in Applicant's favor. Additionally, Opposer has

³² Statement of Facts, ¶ 5, 30 TTABVUE 4.

failed to submit any evidence of (1) how its sales and advertising figures compare to its competitors in the industry (except for Applicant), (2) how many times consumers encounter its U-CORE mark for polyurethane foam, or (3) any context for its achievements in the polyurethane foam window insulation industry, e.g., market share. Without comparative numbers or market share percentages, it is difficult to place the apparent success or renown of Opposer's U-CORE mark into context. *Bose Corp.*, 63 USPQ2d at 1309. Ultimately, Opposer's evidence falls short of establishing that its pleaded U-CORE mark falls on the "very strong" end of the spectrum of fame for likelihood of confusion purposes.

"In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, we think that it is the duty of a plaintiff asserting that its mark is famous to clearly prove it." *Blue Man Prods. Inc. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005). Based on the evidence of record, we find that Opposer's U-CORE mark has only achieved a marginal degree of fame for likelihood of confusion purposes. That is, Opposer's U-CORE mark has achieved a limited level of recognition amongst consumers of polyurethane insulating foam.

The determination of the strength or fame of a mark is not a binary analysis, but rather is the examination of a continuum from the weakest to the most famous. *Joseph Phelps Vineyards*, 122 USPQ2d at 1734. Based on the totality of the evidence submitted by Opposer which the Board may consider, including the evidence submitted under seal as confidential by both parties, we find that, while Opposer has

demonstrated its U-CORE mark has achieved commercial success when used in association with polyurethane foam, Opposer has only shown that its U-CORE mark has achieved a marginal degree of fame in the spectrum of fame for purposes of the likelihood of confusion analysis. The fifth *du Pont* factor therefore only slightly favors Opposer, if at all. *Id.* at 1734-35; *Tao Licensing*, 125 USPQ2d at 1056.

C. Similarity of the Marks

We next consider the first *du Pont* likelihood of confusion factor, which involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imps.*, 73 USPQ2d at 1691 (quoting *du Pont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal citation omitted). Moreover, our analysis cannot be predicated on dissection of the involved marks. *Stone Lion*, 110 USPQ2d at 1161. Rather, we are obliged to consider the marks in their entireties. *Id.*; see also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Nonetheless, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1161.

Furthermore, the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Finally, keeping in mind that where the goods are identical or identical in part, as is the case here, the degree of similarity necessary to support a conclusion of likely confusion declines. *Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Applicant's mark is SuperCore in standard characters. Opposer's pleaded mark is U-CORE in standard characters. The parties have stipulated that the common term between Applicant's mark and Opposer's mark is the last portion of the marks, i.e., the term CORE.³³ The parties have also stipulated that term "core" is defined as "a central and often foundational part usually distinct from the enveloping part by a difference in nature."³⁴ The record demonstrates that term "super" is defined as "of high grade or quality."³⁵ While there is no dictionary definition of record for the designation "U-," as noted supra, "U-value" (or "U-factor") is a recognized term in the fenestration industry, and Opposer chose the U-CORE mark because its insulation material impacts the "U-value" of the window extrusion into which the goods are

³³ Statement of Facts, ¶ 75, 30 TTABVUE 17.

³⁴ Exh. F of Statement of Facts (www.merriam-webster.com), 30 TTABVUE 111-22.

³⁵ Exh. P of Statement of Facts (www.merriam-webster.com), 30 TTABVUE 266-67.

injected, resulting in enhanced overall window energy-related performance.

Keeping these definitions in mind, as well as the suggestive nature of the prefix U- and the term CORE in relation to insulation products as discussed above, we find that even though both marks share the common suggestive suffix –CORE, when the marks are viewed in their entirety, they convey differing connotations and commercial impressions. Opposer’s U-CORE mark conveys that its foundational product affects the U-value or U-factor of the goods on which it is used. In contrast, Applicant’s SuperCore mark engenders a connotation that its foundational product is of high quality or grade. The marks also differ visually and aurally in light of the differing prefixes of the marks. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps.*, 73 USPQ2d at 1692; *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

While we have not overlooked the common “–CORE” suffix in each of the parties’ marks, we nonetheless conclude that this shared word is not a sufficient basis for finding that the marks, particularly in light of the suggestive nature of the term in relation to the parties’ goods. Rather, we find that the overall visual and aural dissimilarity between the marks, arising from the presence of the differing prefixes conveying different connotations, makes the marks more dissimilar than similar in terms of their overall commercial impression. Accordingly, the marks, when viewed

in their entirety, are sufficiently dissimilar that confusion is not likely to result from their use on or in connection with the parties' goods. To find otherwise would accord inordinate significance to the suggestive "–CORE" suffix in each mark.

Thus, the first *du Pont* factor does not support a conclusion that confusion is likely.

D. Applicant's Intent in Adopting its SuperCore Mark

Opposer asserts that Applicant sought registration of the SuperCore mark in bad faith. Specifically, Opposer contends that Applicant was well aware of Opposer's U-CORE mark prior to choosing the applied-for SuperCore mark and had knowledge of Opposer's mark at least two years prior to filing the involved application.³⁶ Opposer further contends that Applicant could not name any other competitors in the industry using the term "core" and purportedly struggled to identify any other companies as competitors in the polyurethane window foam market.³⁷ Under the circumstances surrounding Applicant's creation, selection and adoption of a mark allegedly confusingly similar to its competitor's known mark, Opposer argues that it is not a stretch to conclude Applicant's intent in choosing its SuperCore mark was in bad faith.³⁸

Applicant argues that it chose and adopted its SuperCore mark in good faith by conducting a survey among Applicant's employees and one of Applicant's third party

³⁶ Opposer's ACR Brief, p. 28, 32 TTABVUE 36.

³⁷ *Id.* at p. 29, 32 TTABVUE 37.

³⁸ *Id.* at p. 31, 32 TTABVUE 39.

representatives, namely, Prysm Marketing.³⁹ Applicant further maintains that its mark was chosen because it received the majority vote. Applicant also contends that the adoption of its mark had nothing to do with Applicant's prior knowledge of Opposer or its pleaded mark.⁴⁰

Bad faith, or intent to confuse, falls under the thirteenth *du Pont* factor regarding "any other established fact probative of the effect of use." *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008) ("[A] party which knowingly adopts a mark similar to one used by another for related goods should not be surprised to find scrutiny of the filer's motive."); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1442 (TTAB 2012). "[W]hen there is evidence of an applicant's intent to adopt a mark that suggests to purchasers a successful mark already in use by another, the Board may, and ought to, take into account that intent when resolving the issue of likelihood of confusion when that issue is not free from doubt." *First Int'l Servs. Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1633 (TTAB 1988). However, "an inference of 'bad faith' requires something more than mere knowledge of a prior similar mark." *Sweat Fashions, Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another's mark or even an intent to copy. *See, e.g., Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009) ("[T]he 'only relevant intent is intent to confuse. There is a

³⁹ Applicant's ACR Brief, p. 10, 39 TTABVUE 15.

⁴⁰ *Id.*

considerable difference between an intent to copy and an intent to deceive.” (quoting 4 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:113)).

Inasmuch as the only evidence here merely pertains to Applicant’s prior knowledge and not to Applicant’s intent, we do not find this record supports, by a preponderance of the evidence, a conclusion of bad faith adoption. We therefore find the *du Pont* factor regarding bad faith adoption to be neutral.

E. Actual Confusion (and the Opportunity for Actual Confusion)

We next turn to the seventh *du Pont* factor (nature and extent of any actual confusion) and the related eighth *du Pont* factor (extent of the opportunity for actual confusion). *du Pont*, 177 USPQ at 567.

Applicant argues that, despite the fact the parties have attended some of the same trade shows and that the parties have used their respective marks concurrently for approximately three and one-half years, there is no evidence of a single instance of actual confusion.⁴¹

Proof of actual confusion is not necessary to show a likelihood of confusion. *See e.g., In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017); *Herbko Int’l Inc.*, 64 USPQ2d at 1380; *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983). Moreover, “the absence of evidence of actual confusion, under the seventh *du Pont* factor, by itself is entitled to little weight in our likelihood of confusion analysis unless there also is evidence,

⁴¹ *Id.* at p. 9, 39 TTABVUE 14.

under the eighth *du Pont* factor, that there has been a significant opportunity for actual confusion to have occurred.” *In re Ass’n of the U.S. Army*, 85 USPQ2d 1264, 1273 (TTAB 2007) (citing *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992)).

While there is no evidence of any instances of actual confusion, a fact which could weigh in Applicant’s favor under the seventh *du Pont* factor, we find that it is entitled to little weight due to the minimal evidence of record pertaining to the eighth *du Pont* factor, i.e., “the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” Specifically, while (1) the parties may have attended some of the same trade shows, (2) their respective marks have co-existed for approximately three and one-half years, and (3) their goods have been sold in overlapping markets,⁴² the record demonstrates that each parties’ advertising expenditures have not been substantial in the years since they each began using their respective marks.⁴³ Accordingly, the evidence of record fails to demonstrate the nature and extent in which consumers have been exposed to each of the parties’ respective marks in the overlapping geographic markets. In light of the lack of this evidence as well as the limited time in which the parties have used their marks concurrently, we cannot conclude, on this record, that that the absence of

⁴² Opposer contends there is no evidence of record regarding the overlap of the geographic market of the parties’ respective goods. Opposer is mistaken. Both Opposer and Applicant submitted, under seal, their respective customer lists. *See* Statement of Facts (Confidential version), Exhs. G and W, 31 TTABVUE 123-26 and 322-24. The lists clearly demonstrate an overlap of the geographic markets where both parties sell their goods.

⁴³ Statement of Facts (Confidential Version) ¶¶ 22 and 56, 31 TTABVUE 7 and 13.

instances of actual confusion between Applicant's SuperCore mark and Opposer's U-CORE mark is legally significant. *See Gillette Can.*, 23 USPQ2d at 1774. Accordingly, the seventh and eighth *du Pont* factors, relating to actual confusion, are neutral in this case or, at best, weigh only minimally in Applicant's favor.

F. Balancing of Factors

In a particular case, any of the *du Pont* factors may play a dominant role. *du Pont*, 177 USPQ at 567. In fact, in some cases, a single factor may be dispositive. *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991). In the present case, based on all evidence and arguments bearing on the *du Pont* factors that the Board may consider, including the evidence and arguments that we have not specifically discussed herein, we conclude that although the parties' goods are identical in part and therefore presumably move in the same trade channels and offered to the same classes of purchasers, and while Opposer has established that its pleaded U-CORE mark has achieved some nominal commercial success, when considered in their entirety, Opposer's U-CORE mark and Applicant's SuperCore mark are more dissimilar than similar in appearance, sound, meaning and commercial impression, particularly in light of the suggestive nature of the shared "– CORE" component of the parties' marks as well as the suggestive nature of the "U–" prefix in Opposer's mark. The remaining *du Pont* factors discussed are neutral or slightly favor Applicant.

Accordingly, since the record demonstrates that Opposer's pleaded U-CORE mark is not similar to Applicant's SuperCore mark for likelihood of confusion purposes, we find that, on balance of all of the *du Pont* factors, Opposer has failed to prove its

Section 2(d) claim by a preponderance of the evidence.

V. Misuse of the Registration Symbol

Section 29 of the Trademark Act, 15 U.S.C. § 1111, provides that “a registrant of a mark registered in the Patent and Trademark Office, may give notice that his mark is registered by displaying ... the letter R enclosed within a circle, thus ®.” The Office has clarified that “the registration symbol should be used only on or in connection with the goods/services/collective membership organization listed in the registration” and that the “symbol may not be used with marks that are not actually registered in the USPTO.” TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 906 (October 2017).

In *Copeland’s Enters. Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991), the Federal Circuit held “improper use of a registration notice in connection with an unregistered mark, if done with intent to deceive the purchasing public or others in the trade into believing that the mark is registered, is a ground for denying the registration of an otherwise registrable mark.” The Court further noted that “continuing to use [the registration symbol] after being specifically notified of the impropriety of such use” is a factor that “raises serious questions as to the [user’s] purpose and intent.” *Id.* at 1299. The Board has maintained the availability of this ground in Board proceedings. *See, e.g., NSM Res. Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1034 n.8 (TTAB 2014); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 309.03(c)(1) (June 2018) (Grounds, in General “(16) That defendant has misused the federal registration symbol with intent to deceive the purchasing public or others in the trade into believing that the mark is

registered”) and cases cited therein at Note 31.

Opposer maintains that less than one month after Applicant filed the involved application but prior to the mark being registered, Applicant began to use improperly the registration symbol with its SuperCore mark on proposed advertising materials, proposed product fact sheets and in emails with its advertising agency even before it applied to register its mark.⁴⁴ Opposer further maintains that Applicant started using the registration symbol even though two weeks before filing its application it received an email from its advertising agency outlining the procedures for registering a trademark which stated, in part, “the trademark symbol cannot be used during the pending period before passing the registration application, and it can be used once the evaluation is finished and you have received a complete registration decision.”⁴⁵

Opposer also contends that after the notice of opposition was filed (which provided notice to Applicant that it was allegedly misusing the trademark registration symbol), and notwithstanding Applicant’s answer to the pleading stating that it removed the registration symbol and no longer used the symbol, Applicant continued to use improperly the trademark registration symbol. As example, Opposer points to an industry report where Applicant updated its listing of its product and employed the registration symbol but did not request to remove the symbol after being put on

⁴⁴ Opposer’s ACR Brief, p. 36, 32 TTABVUE 44; *see also* Statement of Facts ¶¶ 52 and accompanying Exhs. U, X, and Y; 30 TTABVUE 11, 12, 313-19, 325-71.

⁴⁵ Opposer’s ACR Brief, p. 36, 32 TTABVUE 44; *see also* Statement of Facts, Exh. Q, 30 TTABVUE 288-94.

notice of improper use.⁴⁶ Additionally, Opposer maintains that at least one of Applicant's third-party sales representatives, i.e., Aribell Products Limited ("Aribell"), continued to use advertising materials that displayed the registration symbol after the filing of Applicant's answer to the notice of opposition. Opposer further contends that Applicant did not send new advertising materials to its third-party representative that did not include the registration symbol after receiving notice of improper use.⁴⁷ In fact, Opposer maintains that, in November of 2016, six months after being notified of the misuse of the registration symbol, Applicant finally emailed new brochures that replaced the registration symbol with the "TM" symbol to its third-party representative, Aribell.⁴⁸ Opposer concludes that these facts are sufficient to prove Applicant's deceptive intent, and justifies a refusal to register Applicant's involved mark.⁴⁹

Applicant argues that once Applicant was informed that Applicant should not use the registration symbol prior to registration of its mark, Applicant responded by taking remedial actions. For example, on May 25, 2016, prior to the filing of its answer to Opposer's notice of opposition, email communications were exchanged between Jin Park, Applicant's president, and Applicant's employees regarding removal of the registration symbol from shipping labels, flyers, and Applicant's

⁴⁶ Opposer's ACR Brief, p. 37-38, 32 TTABVUE 45-46; *see also* Statement of Facts ¶ 65 and accompanying Exhs. L, Z, and AA, 30 TTABVUE 15, 172-215, and 372-77.

⁴⁷ Opposer's ACR Brief, p. 39, 32 TTABVUE 47.

⁴⁸ *Id.*

⁴⁹ *Id.* at pp. 39-40, 32 TTABVUE 47-48.

website.⁵⁰ Moreover, at the time of Applicant's use of the registration symbol, Applicant contends that it was unfamiliar with U.S. trademark procedures and the use of appropriate symbols.⁵¹ Based upon such unfamiliarity, Applicant claims that it was not able to distinguish the legal difference between a trademark application and a trademark registration, and assumed that it could use the registration symbol once a trademark application has been filed.⁵² Applicant states that it was confused as to when it was able to use the registration symbol and whether it was Applicant or its advertising company who was actually responsible for inserting the registration symbol on Applicant's advertising materials.⁵³ Confusion was further caused because the communication between Applicant and its advertising company was at all times conducted in Korean.⁵⁴ Applicant concludes by stating that while it accepts that all its attempted measures to remove the registration symbol from its advertising and marketing material may not have been foolproof and although a single sales representative may have continued to use the registration symbol, Applicant never intended to deceive the public or any other person or entity in the trade into believing that its mark was registered.⁵⁵

In this case, we find that Opposer has not proven that Applicant had the requisite

⁵⁰ Applicant's ACR Brief, p. 11 and accompanying Exh. A, 39 TTABVUE 16, 40 TTABVUE 2-5.

⁵¹ *Id.* at p. 12, 39 TTABVUE 17.

⁵² *Id.* and accompanying Exh. B (Park Dep. at 52:17-20), 39 TTABVUE 17, 40 TTABVUE 8.

⁵³ *Id.* and accompanying Exh. B (Park Dep. at 53:3-54:3), 39 TTABVUE 17, 40 TTABVUE 9-10.

⁵⁴ *Id.*, 39 TTABVUE 17.

⁵⁵ *Id.* at pp. 12-13, 39 TTABVUE 17-18.

intent to deceive the purchasing public, or anyone else, and thus cannot find in Opposer's favor on the ground of misuse of the registration symbol. There is no dispute that Applicant used the registration symbol "®" after the term SuperCore on various emails, as well as advertising and marketing materials, both before and after it filed the involved application, as well as after the notice of opposition was filed. Notwithstanding, the record demonstrates that Applicant's confusion regarding the proper use of the registration symbol falls within the ambit of the types of misunderstandings that the Office lists in the TMEP as "common reasons for improper use ... that do not indicate fraud," specifically, mistake as to the requirements for giving proper notice. *See* TMEP § 906.02. Given Applicant's admitted unfamiliarity with the U.S. trademark registration procedure, misunderstandings that may have arisen from a language barrier, and its clear attempts to prevent improper future use of the symbol, albeit over an approximate six-month period and after being put on notice of the improper use of the registration symbol by way of the notice of opposition, we do not find Applicant's actions rise to the level of intending to deceive prospective purchasers or anyone else. Accordingly, we find that Opposer has failed to demonstrate, by a preponderance of the evidence, its claim based on Applicant's improper use of the registration symbol.

Decision: The opposition, based on the grounds of likelihood of confusion and misuse of the registration symbol, is dismissed.