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Paper No. 12  
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Raven Lining Systems, Inc.

Serial No. 75/472,685

Mark G. Kachigian of Head Johnson and Kachigian for Raven Lining Systems, Inc.

Tracy L. Fletcher, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Simms, Cissel and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Raven Lining Systems, Inc. seeks to register the mark AQUATAPOXY on the Principal Register for "epoxy-based coating for the protection and rehabilitation of water and wastewater structures," in International Class 2.<sup>1</sup>

The Trademark Examining Attorney refused registration under Section 2(d) of the Lanham Act on the ground that applicant's mark, when used on the goods identified in the

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<sup>1</sup> Application Serial No. 75/472,685 was filed on April 23, 1998, based upon applicant's allegation of use by its predecessors in interest in interstate commerce since at least as early as September 1983.

application, so resembles two registered trademarks that confusion is likely. These cited registrations are owned by two separate entities. The first is for the mark AQUA POXY for "waterproofing coating for basements and interior masonry," in International Class 19.<sup>2</sup> The second cited registration is for the mark AQUA EPOXY for "paints, varnishes, lacquers and assorted colors used as protective coatings on various types of metals to protect against weather elements for use on exterior metal surfaces," in International Class 2.<sup>3</sup>

Responsive to the refusal to register, applicant argued that the marks are dissimilar and that the goods are unrelated. In addition to the obvious differences between its mark and the two cited marks, applicant focused in detail on the fact that applicant markets specialty, technical products to certified professionals for application to large-scale water and wastewater structures maintained by municipal, industrial and other commercial applications.

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<sup>2</sup> Registration No. 1,037,478 issued on April 6, 1976; Section 8 affidavit accepted and Section 15 affidavit acknowledged; renewed. The expression "poxy" is disclaimed apart from the mark as shown.

<sup>3</sup> Registration No. 2,165,038 issued on June 16, 1998. The word "epoxy" is disclaimed apart from the mark as shown.

On the other hand, the Trademark Examining Attorney argues that applicant's mark is highly similar to each of the cited marks in overall commercial impression. As to the relatedness of the goods, the Trademark Examining Attorney argues that "applicant's protective coatings as identified in the application could encompass each of the registrant's protective coatings as identified in the registrations." (Trademark Examining Attorney's appeal brief, p. 8).

Both applicant and the Trademark Examining Attorney filed briefs on appeal, but applicant did not request an oral hearing before the Board.

We reverse the refusal to register.

In the course of rendering this decision, we have followed the guidance of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). This case sets forth the factors that should be considered, if relevant, in determining likelihood of confusion.

Turning first to the similarities/dissimilarities in the marks, we note the argument in favor of similarity made by the Trademark Examining Attorney, as follows:

The applicant has essentially appropriated the first registrant's mark [AQUA POXY] and merely added the letters "TA" to create a

single word mark. The applicant has similarly appropriated the second registrant's mark [AQUA EPOXY] after deleting the "E" in "EPOXY." The marks create the same commercial impression of water and epoxy and purchasers are consequently likely to believe that related goods offered in connection with these marks emanate from a common source.

By contrast, applicant argues that while its AQUATAPOXY mark may create a somewhat similar connotation to each of the cited marks, the differences in sound and appearance are legally significant:

[T]he addition of the "TA" segment to the AQUA prefix creates a distinct root which differs from the other cited "AQUA" marks... It is not fair [for the Trademark Examining Attorney] to say that by the addition of this extra syllable - i.e., adding the letters "TA" - the Applicant has failed to distinguish its mark from the other "AQUA"-type marks that populate the Principal Register. This key addition causes a distinctly different pronunciation, while changing the appearance of the term as well.

A second factor supports the finding that the Applicant's mark differs in appearance from the others cited. That is, the Applicant has made a conscious choice not to include a space (or even a hyphen) between the AQUATA and POXY segments, which stands in contrast to either of the cited marks...

The Trademark Examining Attorney is correct that the common AQUA prefix with the same POXY suffix in all three of these marks combine to create terms that could each

connote both "water" and "epoxy." On the other hand, in the cited marks, AQUA could suggest water or a color, while applicant's AQUATA suggests water (aquatic) but not a color designation. However, the key factual determination before us when considering this critical du Pont factor is whether applicant's insertion of its "TA" syllable into the middle of this long, compound term results in perceptible visual and aural differences sufficient to conclude that the marks are basically dissimilar as to overall sound and appearance.

As to appearance, we agree with applicant that AQUATAPOXY, a single word, has a decidedly different appearance from both AQUA POXY and AQUA EPOXY because of the additional "TA" syllable and the absence of any space within the term. Additionally, as to pronunciation, the cited marks are fairly straightforward - four syllables of ak'w? p k-e or five syllables of ak'w? ? -p k-e . However, given that "there is no correct pronunciation of a trademark," In re Belgrade Shoe, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969), and Yamaha International Corp. v. Stevenson, 196 USPQ 701 (TTAB 1977), and cases cited therein, applicant's mark may be pronounced ak'w? ta-p k-e or ? kwat' a-p k-e . In either case, it is a much more challenging term to

pronounce. This is true because the internal "TA" sound will likely be an uncomfortable insertion in this coined term, receiving a studied emphasis and/or its presence in that exact location may well change the perceived cadence and structure in the pronunciation of the overall term.

In any case, we have to agree with applicant that on any of the elements of the sight-sound-meaning trilogy, the two cited marks are much more like each other than applicant's mark is similar to either of the cited marks. Accordingly, we find that this first du Pont factor favors applicant's position of no likelihood of confusion.

We turn next to the du Pont factor dealing with the relatedness of the respective goods. The AQUA POXY product is a waterproofing sealant applied to interior concrete and masonry surfaces in the basements of houses. The AQUA EPOXY product is used to protect exterior metal surfaces (such as railroad cars) from weather and the elements. Applicant's high performance, ambient cured, thermosetting epoxies are specifically designed for difficult environments that are by definition wet - municipal water and sewer systems. According to the declaration of applicant's chairman, applicant's goods are applied by special certified contractors. Hence, it is clear on this record that these are all specialty coatings

formulated and marketed for disparate and specific technical applications.

In light of the preceding discussion of the goods of applicant and the two registrants, we conclude that the established, likely-to-continue channels of trade for these three types of epoxy coatings will be quite dissimilar. The goods in the first cited registration are targeted to the domestic market - consumers who want to prevent moisture from getting through the concrete and masonry of their basement walls and floors, or the contractors such homeowners may hire. The goods in the second cited registration are targeted to manufacturers and reconditioning firms who want to protect exterior metal surfaces from the elements. By contrast, applicant markets its products to certified professionals for municipal, industrial and other commercial applications involving large-scale water and wastewater structures. Accordingly, we conclude that the du Pont factor dealing with different trade channels also favors a finding of no likelihood of confusion.

As to the conditions under which and buyers to whom sales are made, these are specialty products, and at a minimum, the goods of the second cited registration and of applicant are directed toward quite sophisticated

purchasers. The record makes it clear that all three of these products have specific applications, must be mixed and applied under the most exacting of conditions (e.g., cure rates, levels of temperature, moisture and other ambient conditions), and that the products covered by the cited registrations are potentially hazardous materials, laden with materials safety data sheets having pages of precautions, health hazards, procedures for dealing with leaks or spills, and extensive information on safe handling.

As to the number and nature of similar marks in use on similar goods, the Trademark Examining Attorney has argued as follows:

As evidence of the strength of the registrant's marks, the Examining Attorney previously attached the results of a search of the Office's computerized database as part of the application record, herein. The Examining Attorney notes that the search results which were unlimited by International or Coordinated Classes, reflect the existence of only three registrations comprising the root term "AQUA" with the root term "POXY." Two of the registrations retrieved are the cited registrations, the third registration for a dissimilar mark is not at issue. (Trademark Examining Attorney's appeal brief, p. 4).

Applicant, on the other hand, argues that in International Class 2 alone, there are 178 subsisting

registrations on the Register having an "AQUA" prefix and 36 having a "POXY" suffix. However, the Trademark Examining Attorney has correctly objected to the timing and summary presentation of this listing, so we have not considered this listing in reaching our decision.<sup>4</sup>

Nevertheless, based solely upon the dictionary entries for "aqua" and "epoxy," we conclude that each of these words alone is suggestive ("aqua" and "poxy") or generic ("epoxy") for two component, water-containing epoxy coatings. Hence, the combination of these terms as seen in the two cited, registered marks should not be given the same scope of protection as would be the case with a coined or arbitrary term applied to the same array of epoxy products as we are considering herein.

As to the du Pont factor dealing with the length of time during and conditions under which there has been concurrent use without evidence of actual confusion, the

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<sup>4</sup> These alleged third-party registrations (applicant's "Exhibit D") were not properly made of record. In order to make third-party registrations of record, soft copies of the registrations or printouts from the U.S. Patent and Trademark Office electronic database must be submitted. See Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992). This was not done. Furthermore, the printouts of the search results were an exhibit attached to applicant's brief, and hence were untimely. The record must be complete prior to the time of the appeal. See, 37 CFR 2.142(d); In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994).

Trademark Examining Attorney is correct that the test under Section 2(d) of the Act is likelihood of confusion, not actual confusion. Nonetheless, applicant points to sixteen years of coexistence with the AQUA POXY mark (as of the year 2000) without any actual confusion and seven years of coexistence with the AQUA EPOXY mark (again, as of the year 2000, when the declaration was taken) without any actual confusion. While we have no evidence that these respective marks have been used contemporaneously in the same geographical area, the file does contain evidence that all of these epoxy products can at the very least be researched worldwide via Internet sites, and contacts can be made in this manner for the purchase of each product from the respective vendor. Moreover, as to whether there has been sufficient opportunity for confusion to occur, the record does contain a declaration of Morton A. Cohen, chairman of the board of applicant corporation, that applicant has spent more than \$1 million in advertising this product over the past seven years. Hence, the record does indicate that in addition to the fact that applicant and its predecessors have used this mark continuously since 1983, applicant's sales and advertising activities have been appreciable for a significant period of time. Yet in spite of this appreciable and continuous usage, not

a single instance of actual confusion has come to the attention of applicant.

Without a more complete picture of the degree of usage of registrants' respective marks, this asserted lack of actual confusion, taken by itself, has limited probative value regarding applicant's arguments as to a likelihood of confusion. Nonetheless, to the extent it serves to corroborate our findings on the other relevant du Pont factors herein, this factor does not support the Trademark Examining Attorney's refusal to register.<sup>5</sup>

Finally, in assessing the extent of potential confusion, given the totality of the evidence in this record, including the dissimilarities between applicant's mark and the cited marks, the suggestiveness of the cited marks, and disparate uses for the respective goods, the potential for confusion is *de minimis*.

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<sup>5</sup> We accord no weight to the fact that applicant's predecessors in interest owned a federal registration of this matter on the Principal Register from 1987 to 1993 (cancelled due to that earlier registrant's failure to file a §8 affidavit). Even if this earlier registered mark had characteristics quite similar to the present application, the Office's allowance of such prior registrations (despite the existence on the registry in 1986 of the AQUA POXY registration cited herein) does not bind the Board or our reviewing Court. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); and In re Owens-Corning Fiberglas Corp., 774 F.2d 1116, 1127, 227 USPQ 417, 424 (Fed. Cir. 1985).

In conclusion, we find that the cited marks are entitled to limited scopes of protection, that the marks are different as to appearance and sound, that the respective goods are specialized and move in different channels of trade to sophisticated purchasers, that there has been a long period of concurrent use without applicant becoming aware of a single instance of actual confusion, and that overall, the potential for confusion is *de minimis*.

Decision: The refusal to register is reversed.