

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
November 26, 2002

Paper No. 18
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Unimin Corporation

Serial No. 76/086,771

Robert V. Vickers of Fay Sharpe Fagan Minnich & McKee, LLP
for Unimin Corporation.

Christina M. Garner, Trademark Examining Attorney, Law
Office 105 (Thomas G. Howell, Managing Attorney).

Before Walters, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Unimin Corporation seeks to register the mark VANTAGE
on the Principal Register for "industrial minerals, namely
refractory clay used to manufacture refractory objects," in
International Class 1.¹

Registration has been refused under Section 2(d) of
the Trademark Act, 15 U.S.C. §1052(d), on the ground that
applicant's mark, when applied to its goods, so resembles

¹ Application Serial No. 76/086,771, filed on July 12, 2000,
is based upon applicant's allegation of a *bona fide* intention to
use the mark in commerce.

the mark ADVANTAGE which is registered for "building materials, namely clay bricks,"² in International Class 19, as to be likely to cause confusion, to cause mistake or to deceive.

When the Trademark Examining Attorney made the refusal final, applicant appealed. Applicant and the Trademark Examining Attorney have filed briefs, 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). The du Pont case sets forth the factors that should be considered, if relevant, in determining likelihood of confusion.

The Examining Attorney maintains that the marks are confusingly similar in overall commercial impression and that applicant's goods are highly related to registrant's identified goods, that both types of goods are frequently sold under a single trademark and that they often move in the same channels of trade.

² Registration No. 2,109,113, issued on October 28, 1997.

Applicant, in urging reversal of the refusal to register, contends that the marks are dissimilar; that the goods move in distinctly different channels of trade; that registrant's ADVANTAGE mark should be given a relatively narrow scope of protection; and finally, that any common users of registrant's and of applicant's goods are all careful, sophisticated purchasers.

We turn first to a consideration of the respective marks. The Trademark Examining Attorney points to a dictionary entry showing that the word "advantage" is used repeatedly in the several definitions of "vantage." In addition to a common meaning, she argues that these two words also look alike and sound alike, hence creating the same overall commercial impression. Applicant counters that these two words are different as to sight, sound and meaning:

"[The words VANTAGE and ADVANTAGE are] different words which have different common English meanings and usages ... VANTAGE is a two syllable word beginning with a hard consonant sound. Conversely, the '113 registration is for the word "advantage" which includes three syllables and begins with a soft vowel sound. As a result, the '113 registration is a softer word than the mark of this application.

Turning to the differences in meaning, both the '113 registration and subject mark involve commonly understood words which have dictionary definitions. However, ... the word

'advantage' is a highly used word with the commonly understood meaning of 'a benefit associated with some action' and the word VANTAGE is more rarely used with the commonly understood meaning of 'a relatively favorable position or point.'

We agree with applicant that these are both common English language words, and while the word "advantage" has the connotation of "benefit," the word "vantage" has the connotation of "position." And while two syllables are identical in the marks, the sound and appearance of the two words are changed in obvious ways with the deletion of the leading syllable, "ad-," from registrant's mark.

As to a related du Pont factor, we also agree with applicant that based simply on the laudatory meaning of words like "advantage," the cited mark cannot be considered to be an especially strong mark.³ On the other hand, we do not agree with applicant that the federal trademark register shows this term to be particularly weak based upon listed third-party registrations in the fields of raw clay or finished bricks. Rather, the third party registrations demonstrate only that multiple parties have registered

³ Applicant notes that Professor McCarthy lists the word ADVANTAGE among commonly used marks. See 2 J. McCarthy, McCarthy on Trademarks & Unfair Competition, § 11.86 (4th ed. 2001), citing to Washington National Insurance Co. v. Blue Cross and Blue Shield United of Wisconsin, 727 F.Supp. 472, 14 USPQ2d 1307 (N.D. Ill. 1990) [ADVANTAGE is weak as applied to health care programs based on extensive third party use in the health care field].

marks containing variations on the word ADVANTAGE for a variety of construction materials and building supplies such as wooden building materials, doors, windows, etc. However, none appears to be closely related to the goods of applicant or of registrant.

Hence, we find that the marks do have different overall commercial impressions and that registrant's mark cannot be accorded an especially wide scope of protection. These two factors favor the position of applicant.

We turn next to the respective goods. At first blush, it may appear that raw clay, an industrial mineral, is closely related to clay building bricks. However, upon consideration of the entire record, we agree with applicant that applicant's specialized raw materials for industrial refractories are quite different from registrant's finished building materials. As argued by applicant:

While both products of applicant and registrant involve clay, that is where the similarities end. In fact, the goods of applicant are very different than the goods of registrant. This application recites industrial minerals, namely, refractory clays that are used to manufacture high temperature furnace bricks. This is a specialized product that is purchased in bulk by a purchasing department of a manufacturing organization. The product is used by the manufacturing organization to produce a different retail or wholesale item. Conversely, the '113 registration recites building materials, namely, clay

bricks. The recited clay bricks of the '113 registration are the type of product that are used on a job site by a contractor. The building materials of the '113 registration are either purchased by the contractor or by his/her purchasing department. Applicant respectfully submits that the manufacturing materials recited in this application are different than the building materials of the '113 registration.

(Applicant's appeal brief, pp. 6 - 7). As pointed out by applicant, and confirmed by information from the Internet placed into the record by the Trademark Examining Attorney, applicant (a mining company) and its competitors mine raw fireclays from the earth. Although applicant excavates fireclays to be utilized in industry, it cannot be presumed from the identification of goods that applicant itself intends to manufacture any finished materials. Rather, it sells refractory clay to others to be processed into refractory objects such as firebricks, designed to withstand incredibly hot temperatures. These firebricks are used, for example, in incinerators, industrial furnace linings, and containers for molten steel, aluminum, copper, iron and glass, or by utility company boilers in electricity-generating power plants.

By contrast, registrant's bricks are identified as "building materials," marketed to the residential and commercial building construction industry. The types of

clay brick⁴ registrant markets are not enumerated, but in light of the "building materials" preamble must be presumed to be derived from surface clays and are designed for use in walls, foundations and exterior paving. The registrant's goods could not be presumed, under this identification of goods, to include finished refractory materials such as firebricks.

In the second Office action herein, the earlier-assigned Trademark Examining Attorney placed six third-party registrations into the record purporting to show the relationship between these respective goods. However, these registrations fail to show that these respective goods "normally sold and/or distributed by the same building materials distributing and wholesale companies... ." (Trademark Examining Attorney appeal brief, p. 5). Several of these third party registrations do not even name bricks among the International Class 19 building construction items listed. Whenever raw clay and bricks were listed in the same registrations, the bricks were uniformly characterized as refractory materials, not construction bricks for the building industry. Accordingly, based on

⁴ **Clay brick** A solid masonry unit made of clay, usually formed into a rectangular unit while in the plastic state and treated in a kiln at an elevated temperature to harden it. Dictionary of Architecture & Construction, (3rd Ed. 2000).

this record, we cannot conclude that the goods of applicant are related to the goods of registrant.

We turn next to a related du Pont factor dealing with the similarity or dissimilarity of established, likely-to-continue trade channels of registrant's and of applicant's goods. Applicant argues as follows:

The nature of the goods of this application and the goods of the '113 registration results in the goods of each traveling in very different trade channels. In this respect, the goods of this application are purchased and used in bulk for the manufacture of other products. The purchaser normally buys tons of the product at a time and the product is delivered by an open railroad car or an open truck trailer. Delivery often consists of the product being dumped in a receiving area so that front-end loaders can move the product to the manufacturing process. In contrast, the goods recited in the '113 registration are finished products used on a job site by a contractor to build a structure. They are packaged in bundled units to prevent damage. These trade channels are very different. In fact, it is unlikely that the mark of this application and the mark of the '113 registration would ever cross paths let alone cross paths during the same or even similar purchasing transactions.

In order to show the same channels of trade, the first Trademark Examining Attorney, in responding to applicant's request for reconsideration, submitted Internet hits reflecting seven companies that are the source of raw materials such as fireclay as well as finished refractory

materials such as firebrick. However, six of the seven companies are located overseas (in the United Kingdom, India, Vietnam and China), so these Internet hits appear to have little probative value when determining channels of trade for these respective goods within the United States. The seventh set of company webpages of a firm known as Christy Refractories Company, of St. Louis, MO,⁵ demonstrate that Christy, like applicant, produces raw clays for refractories and ceramics markets. Christy Refractories' webpages, variously nominated as "Other refractory products" or "Products we sell and companies we represent," contain entries for BNZ Materials and Louisville Fire Brick. Both companies appear to manufacture firebrick (not construction materials), but all indications are that they each sell their respective finished firebricks to manufacturers (for use in industrial furnaces, etc.) under their own house marks.⁶ Hence, these documents do not demonstrate that these respective products "are frequently sold under the same trademarks" (Trademark Examining Attorney appeal brief, p. 5).

⁵ "... refractory brick, which is made of fire clay, the highest quality of which comes from Missouri..." *The New York Times*, April 13, 1995 (from LEXIS/NEXIS database, attached to initial Office action).

⁶ <<http://www.christyco.com/other.html>>

Finally, as to the conditions under which and buyers to whom sales are made, applicant argues as follows:

The goods of this application and the goods of the '113 registration are the type of goods which are purchased with care and reflection. These products are not purchase on impulse. First, the goods of this application and the goods of the '113 registration are purchased by a professional consumer as a part of their job. Second, raw materials sold in bulk and building materials involve costly business transactions which are not done without reflection or consideration as to the source. Third, these are the repeat type of business transactions that create relationships between purchaser and supplier, and fourth, these types of products are used in connection with costly projects such as building a home. Under these circumstances, confusion is not likely.

Again, we agree that in the case of registrant's goods, and certainly in the case of applicant's goods, both entities are dealing exclusively with careful, sophisticated purchasers. When this factor is combined with the differences in the overall commercial impressions of the marks and the clear differences in the nature and distribution of the respective goods, we find the likelihood of confusion herein to be *de minimus*.

In summary, we find that ADVANTAGE and VANTAGE have different overall commercial impressions, that registrant's mark ADVANTAGE is a laudatory term that is not entitled to

Serial No. 76/086,771

a broad scope of protection, that the respective goods are different and that they move in distinctly different channels of trade to careful, sophisticated purchasers.

Decision: The refusal to register is reversed.