

**THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Paper No. 12
TJQ
Mailed:3/26/04

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SI Corporation

Serial No. 76256918

Rodney L. Skoglund of Renner, Kenner, Grieve, Bobak, Taylor & Weber for SI Corporation.

Eugenia K. Martin, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Quinn, Bucher and Rogers, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by SI Corporation to register the mark INFORCE for "fibers made of synthetic polymers and of metal for reinforcing Portland cement and concrete."¹

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, if applied to applicant's

¹ Application Serial No. 76256918, filed May 14, 2001, based on an allegation of a bona fide intention to use the mark in commerce.

goods, would so resemble the previously registered mark ENFORCE for "reinforcing materials to structurally strengthen building components and structures, namely steel, wood and concrete,"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

Applicant argues, in urging that the refusal be reversed, that the marks have very little in common, differing in appearance and commercial impression.³ More specifically, applicant contends that "[t]he major connotation of the registered mark is that it uses 'force' to adhere or otherwise hold building components and structures together" whereas "[t]he overall commercial impression left by Applicant's mark INFORCE is that it is used to 'reinforce concrete.'" (brief, p. 4). As to the goods, applicant asserts that the cited registration improperly issued with an overbroad identification of goods, after the goods were amended by way of an Examiner's

² Registration No. 2,526,968, issued January 8, 2002. The registration includes additional goods in a different class (Int. Cl. 1) as follows: "adhesives to glue reinforcing materials to building components." Throughout the prosecution, the Examining Attorney does not reference these goods in the refusal.

³ Applicant's argument that the registrant's mark, as actually used in commerce, appears with the letter epsilon in place of the initial letter "E" is, of course, irrelevant. The mark, as shown in the cited registration, is in typed form.

Amendment. Applicant insists that there is no likelihood of confusion when the analysis includes a comparison of applicant's goods with registrant's goods, as more narrowly identified in the amended identification. In short, the amendment changed "reinforcing materials" to "reinforcing laminates;" this change, however, is not reflected in the registration as issued. Applicant goes on to argue that, in any event, the goods are different and move through different channels of trade.

The Examining Attorney maintains that the marks are phonetic equivalents, and that the only differences in the marks are a hyphen between syllables and one slight vowel sound. The Examining Attorney points out that each mark has seven letters, the last six of which are identical, and that the final syllable of each mark consists of the same word, FORCE. The Examining Attorney also asserts that the goods are commercially related, with both being used to strengthen or reinforce concrete. The Examining Attorney further asserts that applicant, in stating that there is an error in the registration, has launched a collateral attack on the cited registration which cannot be heard in an ex parte appeal.

Before turning to the merits of the appeal, we need to address the issue concerning registrant's identification of

Ser No. 76256918

goods as set forth in the cited registration. As noted above, the International Class 19 identification of goods in the registration reads as follows: "Reinforcing materials to structurally strengthen building components and structures, namely steel, wood and concrete." As shown by applicant's submission, however, the Examining Attorney (different from the Examining Attorney handling the present application), in examining the underlying application for the cited registration, entered an Examiner's Amendment on October 25, 2000. The amendment indicated that the International Class 1 identification of goods was acceptable, but went on to amend the International Class 19 goods as follows: "Reinforcing laminates to structurally strengthen building components and structures, namely steel, wood and concrete." Registrant (then applicant) was instructed to "[p]lease advise the [Examining Attorney] if there is an objection to the amendment." A check of the registration file shows that no objection was filed.

In view of the above, the likelihood of confusion issue will be analyzed based on registrant's amended identification of goods. As a review of the registration file shows, the failure to enter the amendment to the identification of goods was the result of Office error. The October 25, 2000 amendment makes it clear that the

Ser No. 76256918

identification was narrowed to "laminates." Not only was the term "materials" apparently viewed by the Examining Attorney as being overly broad and, thus, unacceptable, but the amended identification in International Class 19 is consistent with the International Class 1 identification which covers "adhesives." Lest there be any doubt, the amendment to "reinforcing laminates" is consistent with the extrinsic evidence submitted by applicant (and not specifically objected to by the Examining Attorney) which it retrieved from the registration file. See: In re Trackmobile Inc., 15 USPQ2d 1152 (TTAB 1990).

In sum, applicant's request to consider, in our determination of likelihood of confusion, registrant's identification as amended is well taken. Rather than constituting an impermissible collateral attack on the cited registration, as the Examining Attorney contends, applicant's request is to correct an obvious Office error. The registration file has been forwarded to the Post Registration branch of the Office for correction of the identification of goods.

We now turn our attention to the merits. Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in In

Ser No. 76256918

re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first turn to compare the marks in their entirety in terms of appearance, sound and connotation, and determine whether they are similar or dissimilar in their overall commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result.

Applicant's mark INFORCE and registrant's mark ENFORCE sound alike in that they essentially are phonetic equivalents. Any very slight difference in the sounds of the first syllable of the terms undoubtedly would be missed when the marks are spoken.

As to appearance, although applicant has pointed out the differences between the marks, we find that they are outweighed by the similarities. Both marks are formed with two syllables, the marks' beginning with vowels, followed by the letter "N" and ending with the identical term "force."

As to meaning, we are not persuaded by applicant's contention that registrant's mark conveys the idea that registrant's goods use force to adhere or otherwise hold building components and structures together whereas applicant's mark suggests that applicant's goods are used to reinforce concrete. Rather, we find that the marks, when applied to their respective goods, have the same connotation, that is, that the purpose of the goods is to reinforce, among other things, concrete. Although registrant's mark is suggestive, we note that the record is devoid of any evidence of third-party uses or registrations of the same or similar marks in the construction field.

The minor differences between the marks INFORCE and EN-FORCE do not sufficiently distinguish the marks so as to create separate and distinct commercial impressions. We find that these marks, considered in their entirety, are similar in sound, appearance, connotation and commercial impression so that, if they were applied to similar or

related goods, confusion would be likely to occur among purchasers.

With respect to the goods, it is well established that the goods of the parties need not be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

In comparing the goods, applicant asserts the following:

The respective goods are used in different ways, at different times in the construction process so as to be nearly impossible to confuse them in actual use....In order to use the polymeric or steel fibers of Appellant, they must be mixed with the wet cement

or concrete prior to pouring. Appellant's polymeric or steel fibers could not be used in reinforcing wood or steel....Appellant's polymeric or steel fibers are used only to reinforce cement or concrete, and only when a cement or concrete structure is initially poured, molded or cast, i.e., before the creation therewith of any building component or structural element.

The registered mark's "reinforcing materials" are used in a very different manner as compared to the Appellant's polymeric or steel fibers. The registered mark's "reinforcing materials" are used to repair existing structures, meaning the building component or structure already exists. Inasmuch as they are laminates, there must be something existing which can be laminated.

Appellant's goods are used at the beginning of construction of a Portland cement or concrete structure while the registrant's goods are used to repair or strengthen an existing building component or structure. That is, Appellant's products are marketed to construction contractors, civil engineers, architects, and concrete ready mixers who are well aware of the industry, and sold to and through the concrete mixing companies and other concrete ready mix channels of trade. The goods are poured into ready mix concrete trucks and the like for mixing with concrete prior to pouring the concrete. The goods used in connection with the registered mark are sold directly to construction and restoration workers and the like to employ the "reinforcing materials" (i.e., reinforcing laminates) in a post-construction step after completion

of the construction of a building component or other structural element.

Although the goods may be specifically different, we find that they are commercially related in terms of purpose, trade channels and classes of purchasers. Applicant's goods are identified as "fibers made of synthetic polymers and of metal for reinforcing Portland cement and concrete" and registrant's goods are identified as "reinforcing laminates to structurally strengthen building components and structures, namely steel, wood and concrete." Both products serve the same purpose, albeit differently, that is, to strengthen or reinforce concrete.⁴ As identified, the goods may be used in the same construction project, although perhaps at different stages of a project. Further, just as registrant's goods are used to reinforce an existing structure, applicant's goods may be similarly used in a certain respect. Applicant's goods, as identified, may be used in concrete that is utilized in a patching/shoring-up job to reinforce an existing structure, just as in the case of registrant's goods.

⁴ The term "reinforce" is defined, in relevant part, as "to give more force or effectiveness to; strengthen; to strengthen by adding extra support or material." The American Heritage Dictionary of the English Language (3rd ed. 1992).

The goods would move in similar trade channels in the construction industry and would be purchased by the same classes of purchasers, such as construction contractors.

We agree with applicant that the purchase of the involved goods will, in most cases, be made by relatively sophisticated purchasers. The sophistication of the purchasers, however, does not require a finding of no likelihood of confusion. Even assuming that the purchasers of these goods are sophisticated, this does not mean that such consumers are immune from confusion as to the origin of the respective goods, especially when sold under similar marks. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999); and *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

We conclude that purchasers familiar with registrant's reinforcing materials to structurally strengthen building components and structures, namely, steel, wood and concrete sold under registrant's mark EN-FORCE would be likely to believe, if they encountered applicant's mark INFORCE for fibers made of synthetic polymers and of metal for reinforcing Portland cement and concrete, that the goods originated with or are somehow associated with or sponsored by the same entity.

Ser No. 76256918

To the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.