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Mailed: September 24, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Rovanco Piping Systems, Inc.

Serial Nos. 76401721 and 76408554

John R. Crossan of Chapman and Cutler for Rovanco Piping
Systems, Inc.

Verna Beth Ririe, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Quinn, Walters and Drost, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Rovanco Piping Systems, Inc. has filed two applications
to register on the Principal Register the marks RHINOCOAT
for "corrosion inhibitants in the nature of a coating for
insulated pipe," in International Class 2,¹ and RHINOFLEX

¹ Serial Nos. 76401721, filed April 30, 2002, based on use in commerce,
alleging first use and use in commerce as of 1998.

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for "flexible insulated pipe, not of metal," in International Class 17.²

The Trademark Examining Attorney has issued a final refusal to register in each application under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the previously registered marks shown below, all owned by the same registrant, that, if used on or in connection with applicant's respective goods, it would be likely to cause confusion or mistake or to deceive.

Mark:



Goods: "metal pipes, posts and tubing."³

Disclaimer: NORTH AMERICAN STEEL WORKS

Mark:



² Serial No. 76408554, filed May 15, 2002, based on use in commerce, alleging first use and use in commerce as of May 13, 2002.

³ Registration No. 2282640, issued October 5, 1999, to Rhinotube North American Steelworks LLC.

Goods: "protective coatings in the nature of rust inhibitors for use on metal pipes, posts, and tubing."⁴

Statement: The stippling is a feature of the mark and is not intended to indicate color.

Mark: **RHINOTUBE**

Goods: "metal pipes; metal posts; metal tubing; metal pipes and protective coatings sold as a unit; metal posts and protective coatings sold as a unit; metal tubing and protective coatings sold as a unit," in International Class 6.⁵

With respect to Application Serial No. 76401721, the Examining Attorney has also issued a final refusal on the ground that the specimens do not show use of the mark for the stated goods, citing Trademark Rule 2.56(b)(1), 37 CFR §2.56(b)(1). The Examining Attorney contends that the specimens of record show use of the mark on a label attached to what appears to be a pipe, whereas the goods are identified as "corrosion inhibitors in the nature of a coating for insulated pipe."

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. Applicant requested that these two applications be considered together on appeal, contending that the facts pertaining to the likelihood of confusion refusals in each application are very similar. The Board, in an order dated March 2, 2004, granted applicant's request

⁴ Registration No. 2292032 issued November 16, 1999, to Rhinotube North American Steelworks LLC.

⁵ Registration No. 2413641 issued December 19, 2000, to Rhinotube North American Steelworks LLC.

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and, therefore, we decide the appeals of these two applications in this single opinion.⁶

Specimens in Application Serial No. 76401721

The Examining Attorney contends that “[t]he specimens of use submitted by the applicant show use of the mark in connection with a pipe[;] there is no evidence that the mark is used in conjunction with goods that are sold to consumers as a corrosion-inhibitant coating.” (Brief, p. 8.)

Applicant did not address this issue in its brief and mentioned the issue only in its response of May 8, 2003, wherein applicant stated that “[t]he substitute specimen request is misplaced for this case and should be withdrawn.”⁷

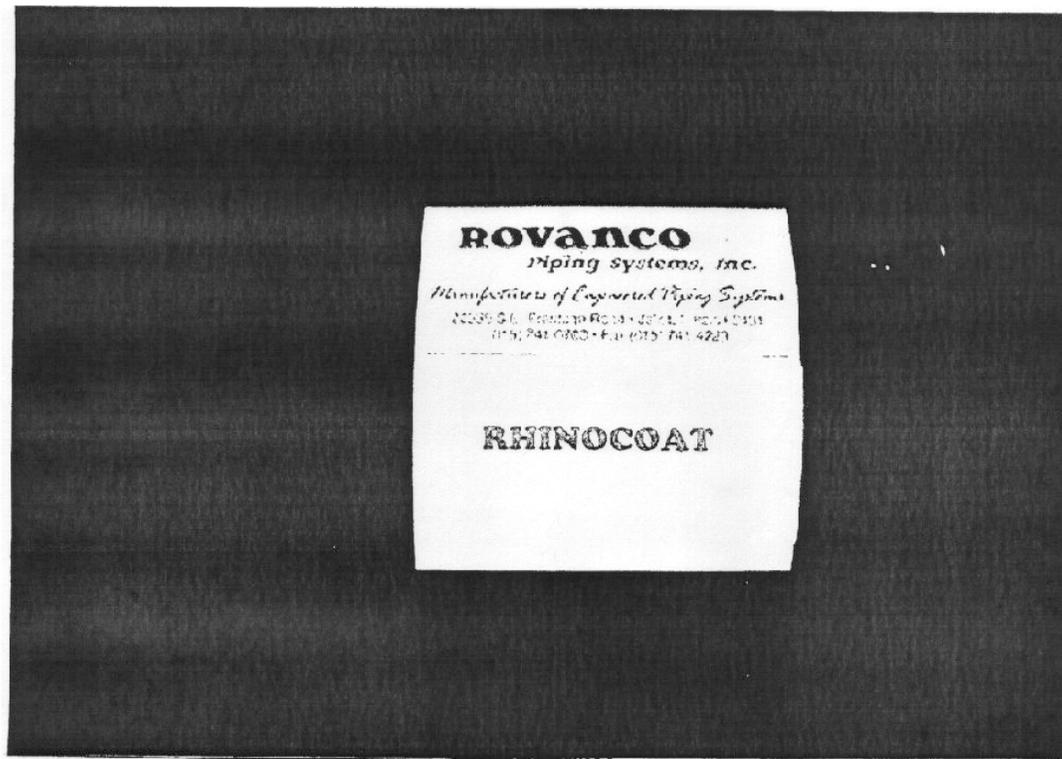
We have decided not to consider applicant’s failure to address this issue as a concession that the specimens are unacceptable but, rather, to consider the merits of the requirement for substitute specimens. The specimens submitted in this application are shown below:

⁶ The Examining Attorney, in her brief, objected to considering these two appeals in a single opinion, arguing that the appeal of Application Serial No. 76401721 should be addressed separately because it also includes a specimen requirement. However, we find that the similarity of facts involved in the likelihood of confusion issues supports our decision and that it is not burdensome to also address herein the specimen requirement.

⁷ Applicant had submitted a substitute specimen in the related application, Serial No. 76408554, and seemed to believe that the specimen requirement in Application Serial No. 76401721 was made in error, despite the Examining Attorney’s clearly stated reason for the requirement.

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The first and second specimens appear to be different photos of the same label, with the second photo from a different distance to show the label on what appears to be a pipe. It would have been helpful to our determination herein if applicant had provided some explanation as to both the nature of the specimens and the manner in which the coatings are sold. However, based on the record before us, we must agree with the Examining Attorney that, while these specimens may be appropriate for showing use of the mark in connection with piping, the specimens do not show use of the mark in connection with a coating therefor.

The Examining Attorney's requirement for a substitute specimen in this application is affirmed.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In 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 considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein. The factors deemed pertinent in this proceeding are discussed below.

The Examining Attorney contends that applicant’s marks RHINOCOAT and RHINOFLEX share the word RHINO with the registered marks; that RHINO is the dominant portion of each of the involved marks because the additional wording in each mark is merely descriptive and the wording predominates over the design elements in two of the cited registrations; and that third-party registrations for marks including the word

RHINO are inapposite because the goods, purchasers and channels of trade are quite different from those involved herein, which are either identical or closely related.

In support of her position, the Examining Attorney submitted definitions from *The American Heritage Dictionary of the English Language*, 3rd ed. 1992, of "flex" as "to bend (something pliant or elastic)," of "pipe" as "a hollow cylinder or tube used to conduct a liquid, gas, or finely divided solid," and of "shield" as "a protective device or structure." The Examining Attorney also submitted copies of third-party registrations in support of her position that applicant's and registrant's goods are related. The majority of the registrations list in the identifications of goods either non-metal pipes or metal pipes, or parts related thereto, but not both. There were, however, four registrations that included among the goods listed, both metal and non-metal pipes or pipe-related goods.⁸

Finally, the Examining Attorney submitted several pages from applicant's website under the section entitled

⁸ These registrations are listed herein: Registration No. 2299808 includes "plumbing supplies, namely, plastic pipes, metal and plastic pipe fittings and connectors..."; Registration No. 1826082 includes "metal pipe fittings, and metal tubing ... [and] non-metal pipe fittings and non-metal tubing ..."; Registration No. 2186154 includes "metal pipes and metal fittings ... [and] plastic plumbing pipes; plastic conduits for conveying gas; non-metal pipe couplings and junctions"; and Registration No. 2612155 includes "irrigation systems comprising ... plastic and metal pipes ..."

references, and the following are several excerpts therefrom⁹:

In 1974 while the Alyeska Pipeline was being built, Rovanco was asked to quote the camp piping which was to supply all the heating hot water, domestic hot water, potable water, fuel oil lines and sewage lines for the camps north of the Yukon, along the Alyeska Pipeline. We received an order from Bechtel ... for 45 miles of pre-insulated pipe with polyurethane foam, with spiral metal jacket.

. . .

Rovanco was awarded a contract by Getty Western Crude in 1980 to insulate 120 miles of 20" and 16" steel pipe with two inches of urethane foam in a polyethylene jacket.

. . .

In 1985, Rovanco was awarded a contract for \$950,000 for 3 miles of 36" Ductile Iron Pipe.

. . .

In 1977, Rovanco accepted an order for 740 miles of pre-insulated copper, fiberglass, steel and PVC 1/2" through 16" pipe to be installed at a new military city in Saudi Arabia.

. . .

In early 1989, Rovanco was awarded a contract to provide a 14" carbon steel jet fuel containment piping system for John Wayne Airport (Orange County).

. . .

In 1992, Rovanco was awarded a contract to supply over a mile of schedule 40 stainless steel pipes for a chemical waste sewer line.

Applicant contends that its goods are different from those identified in the cited registrations. Applicant stated that "[I]nsulated pipe is a very different product

⁹ We note that even the most recent of these references is at least twelve years old.

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from regular metal pipe or flexible pipe[;] insulated pipe is used for thermal systems, piping hot or cold fluids or gases while avoiding heat loss or gain and condensation over the lengths of the piping system [whereas, registrant's goods] were last used principally for supporting flexible covers for garages and other storage structures..." (Brief, p. 3.) Applicant argues that RHINO is a weak term, citing nine third-party registrations in the record containing the term RHINO "for various goods and services related to pipes, piping, corrosion prevention, and flexible piping."¹⁰ (Brief, p. 4.)

We turn, first, to a determination of whether applicant's mark and the registered marks, when viewed in their entirety, are similar in terms of appearance, sound, connotation and 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 impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. Although the marks at issue must be considered in

¹⁰ The following are some of the registrations submitted by applicant: Registration No. 1008090 for RHINO HYDE for "polyurethane elastomeric sheeting for industrial use in high impact areas or abrasive environments"; Registration No. 1904994 for RHINOHIDE for "battery separators for use in the manufacture of batteries; and Registration No. 2021135 for RHINO-TUFF and rhinoceros design for "plastic stretch wrapping film for commercial and industrial use."

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their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Each of the five marks involved herein contains a compound word beginning with RHINO and ending with a descriptive, if not generic, term, *i.e.*, applicant's COAT for its pipe-coating product and FLEX for its flexible pipe; and registrant's TUBE for its tubing and SHIELD for its protective coating.

In considering the commercial impressions of applicant's marks RHINOCOAT and RHINOFLEX, the RHINO portion of each of these marks is clearly dominant both because it is the first of the two words forming these compound word marks and because the second term in each mark is merely descriptive. We reach the same conclusion, for the same reasons, with respect to the commercial impression of registrant's word mark RHINOTUBE and, as will be discussed later, for the other cited registrations.

We do not agree with applicant that the record establishes that RHINO is a weak term with respect to applicant's and registrant's goods. First, we find that these registrations indicate that, at most, the term RHINO

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may be somewhat suggestive of strength or toughness.

Second, the goods recited in the third-party registrations appear unrelated to piping, and it is well settled that each case must be decided on its own facts. *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991); and *In re Inter-State Oil Co., Inc.*, 219 USPQ 1229, 1231 (TTAB 1983).

In considering the commercial impressions of each of registrant's two design marks, the fonts used for the wording portions of registrant's two design marks have minimal impact on the commercial impression of these two marks. Further, registrant's RHINOTUBE design mark includes registrant's name, which is merely descriptive and disclaimed, and a drawing of a stack of tubes, which reinforces the descriptive significance of the TUBE portion of RHINOTUBE. Registrant's RHINOSHIELD design mark includes a drawing of a rhinoceros, which reinforces the RHINO portion of this mark. Thus, we find that the term RHINO in each of these two design marks is the dominant portion of each mark.

Finally, we conclude that the commercial impression of each of applicant's marks is sufficiently similar to each of the cited registered marks that, if used in connection with similar or related goods, confusion as to source is likely.

Turning to consider the goods involved in this case, we note that the question of likelihood of confusion must be

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determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

Applicant's RHINOCOAT mark identifies a coating for insulated pipe and its RHINOFLEX mark identifies non-metal flexible insulated pipe. The registered marks identify, *inter alia*, metal pipes (RHINOTUBE and design), coatings for

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metal pipes (RHINOSHIELD and design), and metal pipes and coatings sold as a unit (RHINOTUBE). While applicant contends that these goods are entirely different due to their composition, the Examining Attorney has submitted several third-party registrations for marks that identify both types of pipes and coatings. These registrations are not determinative, but such registrations nevertheless have some probative value to the extent that they may serve to suggest that such goods are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

However, applicant's own website indicates that, at least in the past, it was the source of both metal and non-metal piping as well as coatings therefor. We find this persuasive, in combination with the other evidence of record, of the conclusion that such goods may come from the same source. Applicant presents no argument to the contrary with respect to this evidence. Thus, we conclude that the goods identified in each of the applications and the goods identified in the cited registrations are sufficiently similar that if identified by similar marks, confusion as to source is likely.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's

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marks, RHINOCOAT and RHINOFLEX, and registrant's marks, RHINOTUBE, RHINOTUBE and design, and RHINOSHIELD and design, their contemporaneous use on the related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Decision: The refusal based on the requirement for a substitute specimen in this application is affirmed. The refusal under Section 2(d) of the Act is affirmed with respect to the mark in each of the two applications herein with respect to each of the three cited registrations.