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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	91280901
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

Foundation Building Materials, LLC

Opposer,

v.

CBM Holdings Corporation

Applicant.

Opposition No. 91280901

Application No: 90554490



Mark:

Application Date: March 2, 2021

**OPPOSER'S OPENING TRIAL BRIEF**

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## **I. INTRODUCTION**

Pursuant to 15 U.S.C. §1052(d) and §1063, Opposer Foundation Building Materials, LLC (“FBM” or “Opposer”) opposes the registration of US Application Serial No. 90554490 (“CBM Application”) for the logo mark CBM Construction Building Materials (“CBM Mark”). On December 21, 2023, Applicant filed a motion for judgment. On May 5, 2024, the Board found that Opposer made at least a prima facie showing of a likelihood of confusion with regard to its pleaded registered FBM trademark, US Registration No. 5,141,074 (“FBM Registration.”). The Board further concluded that the burden of producing contrary evidence has now shifted to Applicant. This is the only issue remaining in this proceeding.

Opposer owns US Registration No. 5,141,074 (“FBM Registration.”) for the word mark FBM (“FBM Mark”) in International Class 035 in connection with the following:

Retail and wholesale building supply stores featuring general building materials, namely, drywall, steel, insulation, acoustical ceiling materials, metal laths, plaster and stucco, exterior insulation finishing products, fasteners, screws, clips, connectors, hand tools, gas and electric powered tools, power tool accessories, composite panels, mud, textures, adhesives, beads, trims, drywall products, framing materials.

The FBM Registration has a date of first use anywhere and in commerce of March 01, 2011.

The CBM Mark is as set forth below:



The CBM Mark was filled in International Class 035 in connection with following services:

Retail building and construction supply store services featuring cabinets, countertops, sinks and faucets for kitchens and bathrooms, porches, porch flooring and ceilings, porch railing, screens, lumber and building materials, windows, moulding, molding trim,

columns, shutters, window trim, stairs, stair railing, hardware, hand tools, power tools, decking, deck railing, doors, paint, fasteners.

The CBM Application claims a date of first use anywhere and in commerce of December 9, 2019. A disclaimer of “CONSTRUCTION BUILDING MATERIALS” is of record. The mark description, “The mark consists of the letters ‘CBM’ above a design of a stylized hammer above the words ‘CONSTRUCTION BUILDING MATERIALS,’” is of record.

FBM opposes the registration of the CBM Mark based upon likelihood of confusion with its FBM Registration.

## II. DESCRIPTION OF THE RECORD

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant’s Mark.

### A. Opposer’s Evidence

Opposer has introduced the following evidence at 17 TTABVue:

Testimonial Declaration of Bryan Vigue on Behalf of Foundation Building Materials, LLC executed on August 15, 2024 (“Vigue Dec.”), and the following Exhibits:

<b>Exhibit</b>	<b>Relevance</b>	<b>Content</b>	<b>Date Accessed</b>
A	Offered to show FBM’s store locations	A true and correct copy of a FBM’s location page found at <a href="https://www.fbmsales.com/locations/">https://www.fbmsales.com/locations/</a>	August 15, 2024
B	Offered to show types of products sold by FBM	a true and correct copy of a general listing of the type of products offered by FBM found at <a href="https://www.fbmsales.com/products">https://www.fbmsales.com/products</a>	August 15, 2024
C	Offered to show types of products sold by FBM	a true and correct copy of a general listing of types of drywall tools and accessories sold by FBM found at <a href="https://www.fbmsales.com/products/drywall-tools-and-accessories/">https://www.fbmsales.com/products/drywall-tools-and-accessories/</a>	August 15, 2024

D	Offered to show types of products sold by FBM	a true and correct copy of a general listing of types of power tools sold by FBM found at <a href="https://www.fbmsales.com/products/tools/">https://www.fbmsales.com/products/tools/</a>	August 15, 2024
E	Offered to show types of products sold by FBM	a true and correct copy of a general listing of types of fasteners sold by FBM found at <a href="https://www.fbmsales.com/products/fasteners/">https://www.fbmsales.com/products/fasteners/</a>	August 15, 2024
F	Offered to show types of products sold by FBM	a true and correct copy of a general listing of doors and fasteners sold by FBM found at <a href="https://www.fbmsales.com/products/commercial-doors-frames-and-hardware/">https://www.fbmsales.com/products/commercial-doors-frames-and-hardware/</a>	August 15, 2024
G	Offered to show FBM's vendors to show type of products sold through its services	a true and correct copy of a listing of FBM's vendors found at <a href="https://www.fbmsales.com/vendors/">https://www.fbmsales.com/vendors/</a>	August 15, 2024
H	Offered to show recent acquisitions of FBM or its expansion of use	a true and correct copy of the most recent page of news articles found at <a href="https://www.fbmsales.com/news/">https://www.fbmsales.com/news/</a>	August 15, 2024
I	Offered to show the products sold by Applicant	a true and correct copy of CBM's product page found at <a href="https://cbm1946.com/products/">https://cbm1946.com/products/</a>	August 15, 2024
J	Offered to show Applicant's retail locations	a true and correct copy of CBM's location page found at <a href="https://cbm1946.com/contact">https://cbm1946.com/contact</a>	August 15, 2024

**B. Applicant Evidence**

Applicant introduced at 15 TTABVUE:

Testimonial Declaration of Angelo Quattocchi on Behalf of CBM Holdings Corporation (“Quattocchi Dec.”) and the following Exhibits (description of relevance copied from Applicant’s Notice of Reliance):

<b>Exhibits</b>	<b>Description and Relevance</b>
1-1	Publicly disseminated calendars which depict the opposed mark. This exhibit is relevant to the use and priority of the opposed mark. This exhibit qualifies for admission under a notice of reliance as

	a printed publication.
1-2	Advertisement which depicts the opposed mark in connection with a timeline history of Applicant and its predecessor companies. This exhibit is relevant to the use and priority of the opposed mark. This exhibit qualifies for admission under a notice of reliance as a printed publication.
1-3	Advertisement issued in or around 1997 indicating that Quality Lumber (a store located in Oakford, PA) would be doing business under the opposed mark. This exhibit is relevant to the use and priority of the opposed mark. This exhibit qualifies for admission under a notice of reliance as a printed publication.
1-4	Trifold announcement indicating that Bristol Fuel and Quality Lumber would be operating as CBM and doing business under the opposed mark. This exhibit is relevant to the use and priority of the opposed mark. This exhibit qualifies for admission under a notice of reliance as a printed publication.
2-1 and 2-2	Website print outs for various -BM formative entities operating in the field of construction and materials. These exhibits are relevant to the strength of the asserted mark. These exhibits qualify for admission under a notice of reliance as an Internet document, Internet material, and/or printed publication.
3-1, 3-2 and 3-3	Registrations incorporating BM for similar goods and services as CBM. These exhibits are relevant to the strength of the asserted mark. These exhibits qualify for admission under a notice of reliance as an official record and as a printed publication.

### III. STATEMENT OF ISSUES

Pursuant to the Board’s order of May 5, 2024, the only issue remaining in these proceedings is whether the CBM Mark as set forth in the CBM Application is confusingly similar to the FBM Registration.

Registrant’s dates of first use anywhere and in commerce in the FBM Registration of March 1, 2011, predates that of Applicant’s dates of the first use anywhere and in commerce in the CBM Application of December 9, 2019. While on the face of the FBM Registrations and

CBM Application FBM has priority, it appears that Applicant is attempting to claim a date of first use that predates its December 9, 2019. Besides this priority issue, all that is left is the analysis of the *du Pont* factors.

As shown below, there is nothing in the record to suggest that CBM has had use in commerce since before 2010, giving FBM priority. All the relevant *du Pont* factors either weigh in FBM's favor or are neutral.

#### **IV. STATEMENT OF FACTS**

FBM owns an uncontestable trademark registration for the word mark FBM in connection with, "Retail and wholesale building supply stores featuring general building materials ...". Since at least as early as March 2011, FBM has been operating retail and wholesale stores featuring general building materials, namely, drywall, steel, insulation, acoustical ceiling materials, metal laths, plaster and stucco, exterior insulation finishing products, fasteners, screws, clips, connectors, hand tools, gas and electric powered tools, power tool accessories, composite panels, mud, textures, adhesives, beads, trims, drywall products, framing materials, among other products. 17 TTABVue 3; *Vigue Dec.* at ¶4. Since 2011, FBM has continuously used the mark FBM without interruption in connection with its retail and wholesale building and construction supply store services selling general building materials. *Id.* at ¶5.

FBM has nationwide use of its mark, operating over 300+ locations in North America serving the construction trades. *Id.* at ¶6; Exhibit A to *Vigue Dec.* FBM sells third party branded building materials. *Id.* at ¶7; Exhibit B to *Vigue Dec.* FBM primarily advertises its services and the sale of third-party goods through the following: (i) online website and online advertising; (ii) social media platforms, such as Facebook, Instagram, LinkedIn and X; (iii) newsletters, (iv) local sponsorships, including its sponsorship and partnership with the Anaheim Angels, the display of FBM

trademark on the Angels jerseys and in the stadium; (v) sponsorship of philanthropic events; (vi) publicly promoted company safety programs and employee safety awards; (vii) truck and tool sweepstakes and giveaways; (viii) attendance at trade shows; and (ix) hosting of publicized vendor events. *Id.* at ¶8.

FBM sells building materials to licensed contractors, homeowner contractors and commercial account holders for the sale of materials used in connection with residential and commercial construction projects. *Id.* at ¶9. FBM's customer base is made up of licensed contractors. *Id.* FBM's average sales to its customer base range from small sales of several hundred dollars to larger sales of several thousands of dollars. 17 TTABVUE 4; Vigue Dec. at ¶10.

FBM does **not** sell lumber. *Id.* at ¶11. FBM sell fasteners, tools, and accessories, including brand name tools and accessories, such as DeWalt, Makita, Milwaukee and Stanley Black & Decker, to name a few. *Id.* at ¶12; Exhibit C-E to Vigue Dec. FBM also sells doors, frames and hardware. *Id.* at ¶12; Exhibit F to Vigue Dec.

CBM has applied for registration of the stylized/logo CBM Mark. In the CBM Application, CBM has alleged a date of first of use anywhere and in commerce of December 9, 2019; however, it has declared that it has used the mark continuously and without interruptions since 1996 in connection with its retail building and construction supply store services. 15 TTABVUE 7; Quattocchi Dec. ¶8.

CBM is a family-owned lumberyard and hardware store and provides "retail building and construction supply store services." *Id.* at ¶ 5-6. While Applicant claims to have used the mark since 1996 (*Id.* at ¶8), it also claims that Applicant (CBM) was not formed until 1997. 15 TTABVUE 8; Quattocchi Dec. at ¶ 11. Applicant's material shows the mark being used in connection with three

retails stores in 2007 and 2009; however, by 2010 Applicant's materials only show the use of the mark in connection with two retail stores in Bristol, Pennsylvania and in Oakford Pennsylvania. *Id.* at ¶¶ 10-11; Exhibits 1-1 & 1-2 to Quattocchi Dec. Currently, CBM still only operates out of those two locations in Pennsylvania. 17 TTABVUE 5; Vigue Dec. at ¶¶17 & Exhibit J.

## V. ARGUMENT

In Applicant's motion for judgment, the Board considered the marks in their entireties and could not find that the marks themselves are so dissimilar as to appearance, sound, connotation and commercial impression such that there is no likelihood that contemporaneous use of the marks will result in confusion. On that record, the Board found that "Opposer has made at least a prima facie showing of a likelihood of confusion with regard to its pleaded registered FBM mark such that dismissal of the opposition is not warranted as to Registration No. 5141074. *See Skincode AG*, 2013 WL 6979640, at \*4." 15 TTABVUE 11.

The Board went on to state, "Applicant may introduce countervailing evidence during its testimony period to rebut Opposer's prima facie case of likelihood of confusion established by its FBM Registration No. 5141074 of record, as the burden of producing contrary evidence has now shifted to Applicant." *Id.* In response, Applicant is attempting to establish an earlier date of first use than listed in its CBM Application, allege the FBM Mark is weak, that Applicant's services are different from CBM services and that the parties' consumers are sophisticated.

As set for below, Applicant has failed to demonstrate the necessary "use in commerce" prior to December 9, 2019, to support its registration. Applicant has also failed to negate any likelihood of confusion between the marks FBM and CBM as: (i) the marks are similar (as already found by the Board); (ii) the services, customers and channels of trade are identical; (iii)

Applicant's customers are not sophisticated; and (iv) the FBM Mark is not weak in connection with retail building and construction store services.

**A. Opposer has Priority in the mark FBM**

Priority in a federal trademark or service mark is established by first "use in commerce." As set forth further below, FBM argues that CBM does not present any evidence of continued "use in commerce" from 2010 forward. As such, FBM has priority of use with its March 1, 2011 date of first.

Under Section 1(a) of the Trademark Act, a mark may not be registered unless it is "used in commerce." 15 U.S.C. § 1051(a)(1). "The term 'use in commerce' means the bona fide use of a mark in the ordinary course of trade ... on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services." 15 U.S.C. § 1127. "The word 'commerce' means all commerce which may lawfully be regulated by Congress." 15 U.S.C. § 1125. Mere use in intrastate commerce does not constitute use in commerce regulated by Congress (that is, the type of use essential to obtaining a federal registration of a mark). *In re Mother Tucker's Food Experience (Canada) Inc.*, 925 F.2d 1402, 17 USPQ2d 1795 (Fed. Cir. 1991).

In accordance with Section 45 of the Statute, a mark is deemed to be used in commerce on services "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one state and the person rendering the services is engaged in commerce in connection therewith."

Commencing in 2010, CBM's evidence shows that it only operated two retail stores

located in Pennsylvania. While the mark may have been used in commerce prior to that date by having stores in both PA and NJ, there is no evidence in the record that from 2010 onward that CBM has offered services in commerce of the type regulated by Congress as necessary to establish an earlier priority date. 15 TTABVUE 9; Quattocchi Dec. at ¶¶ 10-11 and Exhibits 1-1 & 1-2. Currently, CBM still only operates retail stores out of those same two locations in Pennsylvania. 17 TTABVUE 5; Vigue Dec. at ¶17 & Exhibit J. While CBM may have established interstate commerce by its alleged date of first use of December 9, 2019, there is no evidence in the record to support such use in commerce even by that date. And, even if CBM could establish use in commerce by December 9, 2019, such use is insufficient to establish priority over FBM's use.

#### **B. Likelihood of Confusion**

A determination under Section 2(d) is based 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) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). Here, Opposer and Applicant's services nearly identical, considering the strength of Applicant's mark in the letters CBM given the disclaimer on record. Further, Opposer and Applicant's Marks are nearly identical as to appearance, sound, connotation and commercial impression, which are key to a finding of likelihood of confusion. Below is an analysis of these key factors, as well as other relevant factors – all of which weigh in Opposer's favor.

**1. Opposer's Marks and Applicant's Marks are Similar in Appearance, Sound, Connotation and Commercial Impression**

Courts have found marks to be confusing where they share similar appearance, sound, connotation and commercial impression. *See, e.g., Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Assn*, 811 F.2d 1490 (Fed. Cir. 1987); *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). The degree of similarity between two marks is often the single most important factor in determining whether a likelihood of confusion exists. *See, e.g., Fisons Horticulture, Inc. v. Vigoro Indus., Inc.*, 30 F.3d 466, 476 (3d Cir. 1994). The marks do not have to be identical, merely confusingly similar. *See Fisons Horticulture*, 30 F.3d at 477. Here, the Board has already considered the marks in their entireties and could not find that the marks themselves are so dissimilar as to appearance, sound, connotation and commercial impression such that there is no likelihood that contemporaneous use of the marks will result in confusion. Applicant has not presented any evidence to the contrary. This factor weighs in favor of Opposer.

The marks are also used in connection with the same services – retail building and constructor store services. The law has long protected the legitimate interests of trademark owners and consumers from confusion among noncompetitive, but related, products bearing confusingly similar marks. *Safaty-Kleen Corp. v. Dresser Industries, Inc.*, 518 F.2d 1399, 1403 (C.C.P.A. 1975). Here the services under which Opposer and Applicant use the marks are the same and competitive.

**2. Opposer and Applicant's Services, Channels of Trade and Class of Consumers are Identical**

Opposer uses the FBM Mark in connection with “retail and wholesale building supply stores featuring general building materials, ....” Applicant uses the CBM Mark in connection with

“retail building and construction supply store services featuring ....” Opposer and Applicant’s services are the same. Further, both parties sell through the same channels of trade, catering to remodelers, commercial and industrial accounts, professional builders and contractors, and homeowners. 15 TTABVUE 9; Quattocchi Dec. at ¶ 21-22; 17 TTABVUE 3; Vigue Dec. at ¶9. The sales volumes of both parties are similar. 15 TTABVUE 9; Quattocchi Dec. at ¶ 22; 17 TTABVUE 4; Vigue Dec. at ¶10.

Claims by Opposer that FBM sells large volumes of lumber as a means to differentiate the parties services is simply false as FBM does not sell lumber. 15 TTABVUE 10; Quattocchi Dec. at ¶ 23-24; 17 TTABVUE 4; Vigue Dec. at ¶11; see also Exhibits C-F (product listings). Opposer is not a building material yard as Applicant would like the Board to believe, but rather is more akin to a hardware store, selling tools, fasteners, power tools, insulation, drywall, drywall tools, knives, blades, etc., to contractors. Similarity of services, channels of trade and class of consumers all factors in favor of FBM.

### **3. Consumers of Opposer and Applicant are Not Sophisticated**

Applicant has alleged that the parties’ consumers are sophisticated. Sophisticated purchasers are those that exercise considerable care in making purchasing decisions, especially as it relates to expensive goods. 15 TTABVUE 9; Quattocchi Dec. at ¶ 21. However, Applicant has testified that its average purchase price is around \$200 (Id. at ¶ 22); whereas, Opposer’s average purchase price is several hundred to several thousand of dollars. 17 TTABVUE 4; Vigue Dec. at ¶10.

Applicant’s evidence does not, however, established consumer sophistication. As such, it cannot be said that the conditions of sale mitigate a likelihood of confusion. Further, it is well-established that even a sophisticated consumer is not immune from source confusion. Even

assuming the purchasers are knowledgeable, the fact that purchasers are knowledgeable in a particular field does not necessarily mean that they are immune to source confusion. TMEP §1207.01(d)(vii); *see also In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (“even sophisticated purchasers can be confused by very similar marks”); *Weiss Assocs. v. HRL Assocs.*, 902 F.2d 1546, 1548, 14 USPQ2d 1840, 1841-42 (Fed. Cir. 1990) (similarities of goods and marks outweighed sophisticated purchasers, careful purchasing decision, and expensive goods); *In re Info. Builders Inc.*, 2020 USPQ2d 10444, at \*4 (TTAB 2020)(“That the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods [[or services]. ‘Human memories even of discriminating purchasers ... are not infallible.’”).

Given the high similarity between the marks and the services and the relatively low average transaction price of the goods purchased through Applicant and Opposer’s services, the type of purchaser does not negate a finding of likelihood of confusion. Even a careful sophisticated consumer is not likely to note minor differences, if any, in the content or target audience. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 948-949 (Fed. Cir. 2000). This factor weights in favor of FBM.

#### **4. Opposer’s FBM Mark is a Strong Mark**

Applicant submitted evidence of third-party use in an attempt to establish that the FBM Mark was weak. Applicant’s evidence contains screen shots of third party websites which were not properly introduced into evidence. The screen shots are not dated, the location from which they were retrieved is not made readily available and the date they were accessed was also not provided. Nevertheless, the evidence does not establish that the FBM Mark is a weak mark as used in connection with retail construction and building supply services.

Generally, the existence of third-party registrations cannot justify the registration of another mark that is so similar to a previously registered mark as to create a likelihood of confusion, or to cause mistake, or to deceive. *E.g.*, *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009). It is recognized, however, that a large number of active third-party registrations including the same or similar term or mark or the same or similar goods or services may be given some weight to show that a mark or a portion of a mark has a normally understood descriptive or suggestive connotation, leading to the conclusion that the term or mark component is relatively weak. *See, e.g.*, *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1363, 2023 USPQ2d 737, at \*4-5 (Fed. Cir. 2023).

To rely on third-party marks, the third-party marks must generally be as similar to the registered mark as the applied-for mark. *See, e.g.*, *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 675, 223 USPQ 1281, 1284-85 (Fed. Cir. 1984); *see also In re Mighty Leaf Tea*, 601 F.3d 1342, 1347, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). Potential relevance also depends on whether the third-party registered marks and uses are for goods or services as similar to those in the cited registration as those identified in the application. *See, e.g.*, *Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1580, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991).

As both FBM and CBM are retail stores selling building materials, it is most relevant in considering the strength of the marks to determine other third parties using similar marks in connection with retail stores. Opposer does not cite one registered mark or common law use of the mark FBM with the exception of Opposer's own mark. And, besides Applicant's own logo in U.S. Trademark Reg. No. 7,111,279 ("the '279 Registration"), only one other party has a

common law use of the mark CBM in connection with retail building and construction services (i.e., CBM Cherokee Building Materials). No other registrations, except for Applicant's '279 Registration, use the mark CBM as part of a registered trademark in connection with retail building and construction services. In summary, NOo registered marks, except those of Opposer and Applicant, use CBM or FBM as part of a mark used for retail building and construction services.

While Applicant does cite other common law uses and registrations using "BM" as part of the mark, only a small number of those uses are in connection with retail store services related to the sale of building and construction material. As for the common law marks cited (again besides Opposer's own mark), only two of the citations have retail stores uses in the United States, which is by CBM Cherokee Building Materials and UBM Universal Building Materials, the latter of which is lumber company. As for the registrations using "BM", beside Applicant's own registration, there exists two registrations for BMC Building Materials and Construction Services (two logo marks) for retails store services feature building materials. There also exist three registrations for distributorships for the marks: TBM Hardwoods, Inc, and BMG Metals (word mark and logo).

The potential relevance of third-party registrations and uses offered to support registrability over the cited registration depends on the relationship they bear to the application and registration at issue. Since none of the third party uses use the term FBM, and only one uses the mark CBM in connection with retail services (CBM Cherokee Building Materials), Opposer maintains that such evidence holds little value.

Opposer further contends that, given the lack similar third party uses in connection with retail stores selling building and construction materials, the FBM Mark is not a weak mark.

However, considering a mark's relative strength or weakness is only part of the process of determining whether there is a likelihood of confusion. Even registered marks deemed “weak” are entitled to the presumptions of validity under §7(b) and are entitled to protection under §2(d) against the registration of confusingly similar marks. *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 1304, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018)(affirming the Board's conclusion that confusion was likely between DETROIT ATHLETIC CO. and DETROIT ATHLETIC CLUB, marks comprised of the “conceptually weak” wording DETROIT ATHLETIC combined with the non-source identifying business identifiers ““Co.” and “Club”); *see also King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974); *Food Specialty Co. v. Standard Prods. Co.*, 406 F.2d 1397, 1398, 161 USPQ 46, 47 (C.C.P.A. 1969)(in speaking of marks as being weak or strong, “we should not lose sight of the ultimate question that must be answered, namely, whether there is a likelihood of confusion, mistake, or deception.”).

Further, even if the letters BM are used frequently on ancillary goods. Courts have found that when letters are used, it is more difficult to remember a series of arbitrarily arranged letters than it is to remember figures. *Dere v. Institute for Scientific Information, Inc.*, 420 F.2d 1068, 1069, 164 USPQ 347, 348 (CCPA 1970). *See also Crystal Corp. v. Manhattan Chemical Manufacturing Co.*, 75 F.2d 506 (CCPA 1935); *Edison Brothers Stores v. Brutting E.B. Sport—International*, 230 USPQ 530, 533 (TTAB 1986). The Court in *Weiss Assocs. v. HRL Assocs.* found that it was especially hard to distinguish between TMS and TMM when the marks only differ by the last letter, and because it is hard to distinguish between these letters, the mark TMM is confusing with TMS. 902 F.2d 1546, 1548, 14 USPQ2d 1840, 1841-42 (Fed. Cir. 1990)

Here, given the strength CBM Mark is in letters CBM, it becomes hard to distinguish between FBM and CBM, regardless of the strength of the marks.

## **VI. SUMMARY**

Opposer has established priority of use. All of the likelihood of confusion factors about which there is evidence weigh in Opposer's favor. Applicant's CBM Mark is substantially similar to Opposer's FBM Mark and certainly creates the same commercial impression or one of clear affiliation. As the services are identical, Opposer contends that, confusion is not only likely, but inevitable.

Respectfully submitted,

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