

This Opinion Is Not a
Precedent of the TTAB

Mailed: June 6, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Foundation Building Materials, LLC
v.
CBM Holdings Corporation
—

Opposition No. 91280901
—

Jennifer H. Hamilton and Jan A. Sundberg of Avyno Law P.C. for Foundation Building Materials, LLC.

John W. McGlynn and Christopher H. Blaszkowski of Buchanan Ingersoll & Rooney, P.C. for CBM Holdings Corporation.
—

Before Dunn, Thurmon, and O'Connor, Administrative Trademark Judges.

Opinion by Dunn, Administrative Trademark Judge:

CBM Holdings Corporation (Applicant) seeks registration on the Principal Register of the mark shown below¹



¹ Application Serial No. 90554490 filed March 2, 2021 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant's claim of first use anywhere and use in commerce since at least as early as December 9, 2019.

for:

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, in International Class 35.

The application states “The mark consists of the letters ‘CBM’ above a design of a stylized hammer above the words ‘CONSTRUCTION BUILDING MATERIALS.’”


The application disclaims the term CONSTRUCTION BUILDING MATERIALS.

Foundation Building Materials, LLC (Opposer) filed a notice of opposition to registration of Applicant’s mark, which alleges priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with Opposer’s mark FBM in standard characters for:

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, in International Class 35.

Opposer’s mark is the subject of pleaded Registration No. 5141074,² a current TESS copy of which accompanied the notice of opposition.³

² Registration No. 5141074 issued February 1, 2017, Sec. 8 accepted.

³ Opposer also pleaded common law rights, the marks in Registration Nos. 5420976 (FOUNDATION BUILDING MATERIALS) and 5141075 () , and a dilution

Applicant's answer denies the salient allegations of the notice of opposition.

The case is fully briefed.

For the reasons set forth below, we dismiss the notice of opposition.

I. BACKGROUND

Because the pleaded issues were narrowed during the course of proceedings, we briefly outline the chronology of the case. Once the pleadings closed, the Board suspended proceedings at the parties' request to enable settlement discussions, with proceedings scheduled to resume July 21, 2023 and Opposer's trial period scheduled to close December 10, 2023.⁴ Opposer filed no evidence, Applicant moved for dismissal, and Opposer moved to reopen its trial period.⁵

In a May 4, 2024 order, the Board denied Opposer's motion to reopen, and granted in part Applicant's motion for involuntary dismissal under Trademark Rule 2.132(b), 37 C.F.R. 2.132(b).⁶ Because Opposer made no showing with respect to its common law likelihood of confusion claims or the asserted fame of its mark for dilution purposes, those claims were dismissed.⁷

With respect to Opposer's likelihood of confusion claims based on its three registered marks, the Board noted that Opposer had submitted status and title copies

claim but, as will be explained, the Board previously granted dismissal of the dilution claim and the likelihood of confusion claim with respect to those registered marks and common law rights.

⁴ 6 TTABVUE.

⁵ 7 TTABVUE (motion to dismiss) and 9 TTABVUE (motion to reopen).

⁶ 14 TTABVUE.

⁷ 14 TTABVUE 10.

of the registrations with the notice of opposition, and so addressed whether Opposer's registrations were sufficient evidence to establish a prima facie case of likelihood of confusion.⁸ With respect to two marks, the Board found the dissimilarity in marks dispositive, and dismissed the opposition as to Opposer's Registration Nos. 5141075 and 5420976.⁹ With respect to Registration No. 5141074, the Board found Opposer made a prima facie showing of a likelihood of confusion with regard to its pleaded registered FBM mark, and so denied dismissal, and reset dates, beginning with Applicant's trial period.¹⁰

II. EVIDENCE AND OBJECTIONS

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the opposed application. In addition, the record includes:

Testimonial declaration of Angelo Quattrocchi, Applicant's General Manager and Secretary,¹¹

⁸ 14 TTABVUE 6.

⁹ 14 TTABVUE 9.

¹⁰ 14 TTABVUE 11.

¹¹ 15 TTABVUE 6-10. Mr. Quattrocchi's declaration is not dated. Trademark Rule 2.121(a), 37 C.F.R. § 2.121(a), provides that "[n]o testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board." However, because Opposer did not object that the declaration does not show that it was taken during Applicant's trial period, we will consider it. See *Int'l Dairy Foods Ass'n v. Interprofession du Gruyère*, 2020 TTAB LEXIS 268, *11-12 n.12 (declarations signed prior to testimony period considered where other party did not object to them as untimely and treated them as part of the record by raising substantive objections against them), *aff'd*, *Interprofession du Gruyère v. U.S. Dairy Exp. Council*, 575 F. Supp. 3d 627 (E.D. Va. 2021), *aff'd*, *Interprofession du Gruyère v. U.S. Dairy Exp. Council*, 61 F.4th 407, 2023 USPQ2d 266 (4th Cir. 2023).

Similarly, as Opposer points out (22 TTABVUE 17) the website screen shots accompanying the declaration are not dated. However, this is a curable defect that should have been raised promptly, and not for the first time in Opposer's trial brief. See *Moke Am. LLC v. Moke USA*,

Applicant's notice of reliance;¹²

Opposer's rebuttal testimonial declaration of Brian Vigue, Opposer's Director of Marketing, and exhibits;¹³ and

Opposer's rebuttal notice of reliance.¹⁴

Neither party cross-examined the other's witness.

Mr. Quattrocchi's declaration and the notice of reliance refer to the same exhibits. More specifically, Trademark Rule 2.122(e)(1) allows submission by notice of reliance of "Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant in a particular proceeding ... [and t]he notice of reliance shall specify the printed publication (including information sufficient to identify the source and the date of the publication)." 37 C.F.R. 2.122(e)(1).

Applicant's description in its notice of reliance of its own calendars and advertisements bearing the mark (Exhibit 1) does not describe how those materials are publications in "general circulation" rather than promotional materials distributed to potential or actual customers. Such promotional materials have been found inappropriate for submission by notice of reliance:

Petitioners submitted advertisements for sports team clothing and accessories, alleged to be from National Football League (NFL) catalogs, one advertisement

LLC, 2020 TTAB LEXIS 18, *13-14 ("As a general rule, [procedural] objections that are curable must be seasonably raised, or they will be deemed waived.") (citation omitted). We have considered the screenshots for whatever probative value they possess.

¹² 15 TTABVUE 2-5, 11-193.

¹³ 17 TTABVUE.

¹⁴ 16 TTABVUE.

is dated 1985, and the remaining ads are undated. We have no information in the record regarding whether this evidence would so qualify for submission [as printed publications available to the general public in libraries or in general circulation] in this case.

Harjo v. Pro Football, Inc., 1999 TTAB LEXIS 181, *57 n.56. Accordingly, we consider the calendars and advertisements only insofar as they are described by Mr. Quattrocchi's declaration. *Compare Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1363 (Fed. Cir. 2012) ("the Board properly struck the documents [submitted by notice of reliance] from the record because they were not submitted in accordance with the Board's rules and were not otherwise authenticated").

Applicant moves to strike Opposer's rebuttal testimony and exhibits because Opposer did not serve initial disclosures identifying Mr. Vigue and because the testimony and exhibits exceed the scope of proper rebuttal.¹⁵ With respect to the first point, "while parties need not identify prospective trial witnesses in their initial disclosures, they must identify each individual likely to have discoverable information that the disclosing party may use to support its claims or defenses." *Byer Cal. v. Clothing for Modern Times Ltd.*, 2010 TTAB LEXIS 131, *9 (internal citation omitted). In other words, initial disclosures are intended to avoid surprise during the parties' presentation of evidence for their claims and defenses.¹⁶ Rebuttal disclosures,

¹⁵ 23 TTABVUE.

¹⁶ Applicant's legal support is limited to cases finding that the parties' ability to prepare for their main trial periods, not rebuttal, may be hampered by the failure to list a witness in initial disclosures. *See Spier Wines (PTY) Ltd. v. Shepherd*, 2012 TTAB LEXIS 218; *Great Seats Inc. v. Great Seats Ltd.*, 2011 TTAB LEXIS 365. Further, the remedy for failing, as Opposer did, to serve any initial disclosures is for Applicant to file a timely motion to compel. *Kairos Institute of Sound Healing, LLC v. Doolittle Gardens, LLC*, 2008 TTAB LEXIS 61, *6-7 ("A motion to compel is the available remedy when an adversary has failed to make, or has made

which Opposer served, “are intended only to serve as notice to the party in the position of defendant as to what evidence the plaintiff will or may subsequently introduce during its rebuttal period.” *Turdin v. Trilobite, Ltd.*, 2014 TTAB LEXIS 17, *8. We find the rebuttal disclosures served their purpose here, and that “until Applicant presented its case, Opposer could not anticipate the need for [the witness] rebuttal.” *Illyrian Imp., Inc. v. ADOL Sh.p.k.*, 2022 TTAB LEXIS 91, *10. Opposer’s disclosures were sufficient.

With respect to the second point, Applicant’s witness Mr. Quattrocchi testified as to how Opposer’s services differ from Applicant’s (Par. 23-25), the relevant consumers for the services of the parties and their level of sophistication (Par. 21), the differences between the channels of trade and consumers (Par. 22), and the physical proximity of the parties (Par. 16).¹⁷ Mr. Vigue’s testimony addressed these points with information on the nature of Opposer’s services and how they are similar to Applicant’s services (Par. 4-7, 10-13, 16), its customers and channels of trade (Par. 8-9, 14-15), and that Applicant has multiple locations (Par. 17).¹⁸

Only with respect to the point as to the proximity of the parties do we find that Mr. Vigue’s evidence served as proper rebuttal “to explain, repel, counteract, or

inadequate, initial disclosures or disclosures of expert testimony.” (citation omitted). Accord *Luster Prods. Inc. v. Van Zandt*, 2012 TTAB LEXIS 449, *5.

We look with disfavor on Applicant’s citation to nonprecedential cases. *In re tapio GmbH*, 2020 TTAB LEXIS 483, *28 n.30. We look with even greater disfavor on Applicant’s failure to indicate that cited cases are not precedential.

¹⁷ 15 TTABVUE.

¹⁸ 17 TTABVUE.

disprove the evidence of the adverse party.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1082 (Fed. Cir. 2015). Opposer’s evidence as to the similarity of the services, channels of trade and consumers, and their sophistication should have been submitted during its case in chief, and has not been considered.¹⁹ *Illyrian Imp.*, 2022 USPQ2d 292, at *9 (“Evidence is improper rebuttal ... where it relates to a witness and facts that might appropriately have been introduced during the plaintiff’s case-in-chief.”).

Applicant’s motion to strike is denied, except as to Opposer’s testimony regarding the similarity of the services, channels of trade and consumers, and their sophistication.

III. ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

To establish statutory entitlement to oppose under Section 13 of the Act, 15 U.S.C. § 1063, Opposer must demonstrate a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1372 (Fed. Cir. 2020). Opposer’s ownership of pleaded Registration No. 5141074, and submission of a copy showing its current status and title, support its plausible likelihood of confusion claim against the involved application, and show its real interest in this proceeding and a reasonable basis for its belief of damage. *Coach Servs.*, 668 F.3d at 1377.

¹⁹ As will be discussed, our findings with respect to these likelihood of confusion factors largely rest on the services as recited in the application and pleaded registration, and so the evidence would not have affected the outcome of this proceeding.

Opposer has established its statutory entitlement to bring this opposition proceeding.

IV. LIKELIHOOD OF CONFUSION CLAIM

Under Section 2(d) of the Trademark Act, a mark may not be registered if it “consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion” 15 U.S.C. § 1052(d). “In opposition proceedings, the opposer has the burden of proving a likelihood of confusion by a preponderance of the evidence.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 998 (Fed. Cir. 2020). As discussed, the likelihood of confusion analysis is limited to Opposer’s registered FBM mark.

A. Priority

Because Opposer’s pleaded registration is of record, and Applicant has not brought a counterclaim to cancel it, priority is not at issue with respect to the mark and services covered by the registration. *See Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1403 n.6 (CCPA 1974) (“prior use need not be shown by a plaintiff relying on a registered mark unless the defendant counterclaims for cancellation”).²⁰

²⁰ In the case cited by Applicant (24 TTABVUE 14), the opposer did not plead a prior registration but common law priority and a pending application. *See Araujo v. Framboise Holdings Inc.*, 99 F4th 1377, 1379 (Fed. Cir. 2024).

B. Likelihood Of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1319 (Fed. Cir. 2018). “Not all of the *DuPont* factors are relevant to every case.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372 (Fed. Cir. 2018). We consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019).

1. Similarity or Dissimilarity of the Services and Channels of Trade, and Conditions of Sale

We address the second, third, and fourth *DuPont* factors, assessing the similarity or dissimilarity of the parties’ services, trade channels, and purchasers and conditions of purchase. *DuPont*, 476 F.2d at 1361. With each of these factors, our determination must be based not on evidence of current use, but on the recitation of services in Opposer’s registration and the subject application, which defines the scope of any registration that ultimately issues. *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1323-24 (Fed. Cir. 2014).

We begin with the second *DuPont* factor, assessing the similarity or dissimilarity of the involved services. As set forth above, the services of the subject application include “retail building and construction supply store services featuring ... building

materials” and the services of Opposer’s registration include “retail and wholesale building supply stores featuring general building materials, namely, drywall, steel,” and other listed items, making the services in-part identical. We find that *DuPont* factor two weighs heavily in favor of finding a likelihood of confusion.

The third and fourth *DuPont* factors assess “the similarity or dissimilarity of established, likely-to-continue trade channels” and “the conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” Where, as here, the services are identical in-part, we presume the channels of trade and classes of purchasers are the same. *Stone Lion*, 746 F3d at 1323.

Where no common law rights are involved, extrinsic evidence of different channels of trade does not rebut the presumption that the same services have the same channels of trade and classes of purchasers. That is, to the extent that Applicant submits testimony that “Opposer and Applicant target different consumers and operate in different channels of trade,”²¹ Applicant mistakes the relevant inquiry. Like our analysis of the similarity or dissimilarity of the services, we assess similarities in the channels of trade and conditions of sale based on the recitation of services in the application and registration. *See Stone Lion*, 746 F3d at 1323. As a result, we may not consider evidence of how Applicant and Opposer are actually offering their services in the marketplace when evaluating these factors. *Id.*; *In re Detroit Ath. Co.*, 903 F.3d 1297, 1308 (Fed. Cir. 2018).

²¹ 15 TTABVUE 9.

As to the conditions of purchase, “[p]urchaser sophistication may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1376 (Fed. Cir. 2005). In this case, we note Applicant’s testimony that “only consumers familiar with retail building and construction supply goods are likely to utilize such services, making consumers less likely to engage in casual and compulsive purchasing.”²² We weigh this evidence against the unrestricted services listed in the application and registration, that may serve the general homeowner as well as the professional in the building materials field. We also note that both parties use their marks with supplies such as paint and screws that may be both affordable and used by the general consumer. See *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 1325 (Fed. Cir. 2014) (“[T]he Board properly considered all potential investors for the recited services, including ordinary consumers seeking to invest in services with no minimum investment requirement. Although the services recited in the application also encompass sophisticated investors, Board precedent requires the decision to be based ‘on the least sophisticated potential purchasers.’”).

We find that the identity of the respective services, channels of trade, and classes of purchasers weigh heavily in favor of finding a likelihood of confusion, and the conditions of sale are neutral.

²² 15 TTABVUE 9.

2. Strength of Opposer's Mark

“There are two prongs of analysis for a mark's strength under the sixth factor: conceptual strength and commercial strength.” *Spireon, Inc. v. Flex LTD*, 71 F.4th 1355, 1362 (Fed. Cir. 2023). “Conceptual strength is a measure of a mark's distinctiveness, and distinctiveness is ‘often classified in categories of generally increasing distinctiveness[:] ... (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.’” *Id.* (internal citation omitted).

Because the cited registration issued on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), we must presume that Opposer's mark FBM is inherently distinctive for the registered services. Trademark Act Section 7(b), 15 U.S.C. § 1057(b); *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 17 F.4th 129, 147 n.7 (Fed. Cir. 2021) (noting the presumption that a registered mark is distinctive). Because it may affect the scope of protection to which the FBM mark is entitled, we turn to the “[t]he number and nature of similar marks in use on similar [services].” *DuPont*, 476 F.2d at 1361.

Here, Applicant's General Manager Quattrocchi testifies “it is common in the construction industry to use BM as part of a company name or company mark;” “[u]sing this common nomenclature, B stands for Builder or Building and M stands for Materials;” and “I am aware of the following examples in this respect:

- a. CBM Construction Building Materials;
- b. CBM Commercial Building Maintenance;
- c. FBM Foundation Building Materials;
- d. LBM Advantage Lumber and Building Material Coop; and

e. US LBM.”²³

General Manager Quattrocchi’s declaration also describes four third-party websites “incorporating BM for similar goods and services as [Applicant],” which are excerpted below:²⁴



OUR BUSINESS
ESSENTIAL MATERIALS THAT BUILD COMMUNITIES



We supply the materials used to build new homes and businesses, ultimately building neighborhoods and communities across the country.

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²³ 15 TTABVUE 8-9.

²⁴ 15 TTABVUE 9.

²⁵ 15 TTABVUE 24.



Welcome to Reality Building Materials Trading LLC, your partner in fulfilling construction material needs. Our offerings encompass a broad spectrum, ranging from Power Tools and Paints to Hardware, Welding Equipment, Industrial Tools and Equipment, Plumbing and Sanitary solutions, Woods & Timbers, Plywood, and Gypsum Products. As a reliable retailer, we prioritize simplifying your material sourcing, ensuring you have access to renowned brand products all in one place. Our focus on quality and efficiency is aimed at supporting your projects, regardless of scale. With a commitment to professionalism, we are here to contribute to your construction journey.

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Cherokee Building Materials is committed to offering a large selection of commercial and residential building products, from steel and drywall to acoustical tile and accessories. We source our products from only the most reputable brands in the industry, including manufacturers like USG, National Gypsum, Marino/Ware, Clark Dietrich, Telling, Armstrong, Knauf, CertainTeed, Johns Manville, Rockwool, DeWalt and 3M.

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UBM is a family owned business established in April 2012 who provides building materials such as long framing lumber, hardware, plywood, roofing, drywall, siding and trim, moulding, insulation, doors and many more building products for all types of construction projects at a competitive price.


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²⁶ 15 TTABVUE 27.

²⁷ 15 TTABVUE 28.



²⁸ 15 TTABVUE 29.

Applicant also submitted six third-party registrations for BM marks for similar building supply services:²⁹

<p>Reg. No. 2572169 Issued 5/21/02, renewed</p>	<p>TBM HARDWOODS, INC. (HARDWOODS, INC. disclaimed)</p>	<p>Wholesale distributorships featuring lumber and millwork, in Int. Cl. 35</p>
<p>Reg. No. 4427835 Issued 11/5/13, renewed</p>	<p>LBM EXPO (EXPO disclaimed)</p>	<p>Promoting and conducting trade shows in the field of lumber and building materials, in Int. Cl. 35</p>
<p>Reg. No. 4109852 Issued 3/6/12, renewed</p>	 <p>(BUILDING MATERIALS AND CONSTRUCTION</p>	<p>Services in the building construction field, namely, providing retail store services featuring building materials including engineered lumber products, dimensional framing lumber, construction hardware, windows, doors, millwork, roof and floor trusses, and manufactured wall panels to high- volume and custom homebuilders, in Int. Cl. 37.</p>

²⁹ 15 TTABVUE 30-193. On their face, individual building materials are not similar to building supply store services, and because Applicant provided no evidence that they are similar, we do not list third-party Reg. No. 2549137 for ceramic tiles, Reg. No. 2798599 for faucets and bathroom accessories, Reg. No. 4206468 for plumbing fittings, Reg. No. 6275618 for metal gates, doors, fences, windows, stairs, and ladders, Reg. No. 6275619 for furniture and closet accessories, or Reg. No. 6129447 for power tools. *See Omaha Steaks Int'l*, 908 F.3d at 1325 (“There is simply no meaningful evidence to back up GOP’s view that these two distinct types of food are related. The same evidentiary gap exists for explaining why goods and services for oriental foods, alcoholic beverages, café food, or grocery delivery services are ‘similar’ to meat.”).

Because it does not belong to a third-party but to Applicant, we also do not list Reg. No. 7111279, and because they are variations of the same mark owned by the same party, we also do not list Reg. Nos. 4457606, 4608992, 4945936, 5888356, 5527631, and 5816423. Because it is not based on use in commerce but an international registration, we do not list Reg. No. 7226877. *See Calypso Tech. Inc. v. Calypso Capital Mgmt., LP*, 2011 TTAB LEXIS 259, *28. Because they have been cancelled, we do not list Reg. Nos. 5527630 and 5517106. *See Action Temp. Servs Inc. v. Labor Force Inc.*, 870 F.2d 1563, 1566 (Fed. Cir. 1989).

	SERVICES disclaimed)	
Reg. No. 5573466 Issued 10/2/18 Sec. 8 accepted	LBM LIFTOFF (LBM disclaimed)	Cloud software as a service (SAAS) featuring software for management information system integration for use in planning, purchasing, inventory, sales, marketing, finance and human resources in the field of lumber and building materials, in Int. Cl. 42
Reg. No. 6855944 Issued 09/27/22	 (AMERICAN BUILDING MATERIALS ALLIANCE disclaimed)	Lobbying services, namely, promoting the interests of lumber and building materials dealers in the fields of legislation and regulation, in Int. Cl. 35
Reg. No. 5694343 Issued 3/12/19	 Sec. 2(f) (UNIVERSITY disclaimed)	Business education and training services, namely, developing customized leadership and executive development programs, providing executive coaching services, and providing business education programs to employees and executives of businesses in the field of building and lumber supply, in Int. Cl. 41

“Third-party use is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Omaha Steaks Int’l*, 908 F.3d at 1324. “[T]hird-party registrations containing an element that is common to both the opposer’s and the applicant’s marks can show that that element has ‘a normally understood and well-recognized descriptive or suggestive meaning.’” *Spireon, Inc. v. Flex LTD*, 71 F.4th at 1363 (citation omitted). While the third-party use and registration evidence

for BM is not large, the uses often occur in close association with “building materials,” and so reinforce General Manager Quattrocchi’s testimony that “BM’ is recognized in the construction industry nomenclature as representing ‘building materials.’”

While the term FBM as a whole is inherently distinctive, the shared BM parts of the mark suggest “building materials.” *Spireon*, 71 F.4th at 1364 (“The [fifteen] composite third-party registrations are relevant to the question of whether the shared segment—in this case, ‘flex’—has a commonly understood descriptive or suggestive meaning in the field and whether there is a crowded field of marks in use.”). We therefore find the sixth *DuPont* factor weighs slightly against a likelihood of confusion.

3. Similarity or Dissimilarity of the Marks

The first *DuPont* factor requires consideration of “[t]he similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *DuPont*, 476 F.2d at 1361. The proper test regarding similarity “is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012) (internal quotation marks and citation omitted). When, as in this case, the marks appear on identical services, the degree of similarity necessary to support a conclusion of likely confusion declines. *In re Dixie Rests.*, 105 F.3d 1405, 1408 (Fed. Cir. 1997).

Opposer's registered mark is FBM and Applicant seeks to register the composite




mark . The only common elements of the two marks are the letters BM, which the record shows are at least suggestive of building materials, and the stylization. Because Opposer's mark is registered in standard characters, its FBM mark could appear in the same stylization employed by Applicant in its presentation of the letters CBM. *See DeVivo*, 2020 TTAB LEXIS 15, at *36 (“Applicant seeks registration of a standard character mark; as such, its display is not limited to any particular font style, size or color [and we] therefore must consider that the parties' marks may be displayed in the same or similar font style, size or color.”) (internal citation omitted).

However, the differences between the marks are significant. Applicant's mark includes the different prefatory letter, the additional words CONSTRUCTION BUILDING MATERIALS, and the hammer design. The presence of the term CONSTRUCTION BUILDING MATERIALS and the hammer, a construction tool, reinforce the commercial impression that the letters CBM in Applicant's mark are the initialism for CONSTRUCTION BUILDING MATERIALS. *UMG Recordings, Inc. v. Mattel, Inc.*, 2011 TTAB LEXIS 286, *53 (“The ‘M’ in the first design mark above merely reinforces the first letter in MOTOWN...”). *See also Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F3d 1156, 1165 (Fed. Cir. 2002) (“[T]he puzzle design does not convey any distinct or separate impression apart from the word portion of the mark. Rather,

it serves only to strengthen the impact of the [CROSSWORD COMPANION] word portion in creating an association with crossword puzzles.”).

As discussed above, Opposer’s mark FBM is inherently distinctive albeit suggestive of “building materials” with respect to the last two letters. In contrast,



Applicant’s mark , considered as a whole, creates a different commercial impression, where the initialism CBM plainly is short for CONSTRUCTION BUILDING MATERIALS, and the hammer design connects the letters to the words and reinforces their meaning.

Accordingly, the marks, considered in their entireties, are dissimilar, and *DuPont* factor one weighs against a likelihood of confusion.

4. Concurrent Use Without Actual Confusion.

The eighth *DuPont* factor addresses “the length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 476 F.2d at 1361. “The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by applicant of its mark for a significant period of time in the same markets as those served by opposer under its marks.” *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 2010 TTAB LEXIS 40, *50. Here, Applicant submitted General Manager Quattrocchi’s testimony:

14. Since I began my employment with Applicant in 1996, I have not been made aware of any instances of actual confusion between Applicant and Opposer.

15. That is, I have never received or encountered any beliefs, inquiries, or statements that a consumer was mistaking or confusing materials sold by Applicant with those sold by Opposer, or vice versa.

16. The utter lack of actual confusion is notable, especially given that Opposer and Applicant have been in business simultaneously since 2011 (i.e., for at least the past 13 years), and given that Opposer's and Applicant's physical business locations are approximately 5 miles apart.³⁰

This testimony averring concurrent use within close geographic proximity without evidence of actual confusion for 13 years essentially is unrebutted. Opposer offers the testimony of marketing Director Vigue that "Applicant appears to have two locations," and a webpage showing those locations.³¹ Opposer does not dispute either the geographic proximity of at least one location, or the absence of any actual confusion since 2011. Also relevant is the evidence that the services overlap in part, as do the trade channels. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 1381 (Fed. Cir. 2019) ("Further, the Board has found that Guild's and Registrant's services are similar and move in the same channels of trade, which is relevant when assessing whether the absence of actual confusion is indicative of the likelihood of confusion.").

Where, as here, the record shows "ample time and opportunity for actual confusion to occur but there have been no reported instances," this factor favors Applicant. *G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 1295 (Fed. Cir. 1990) ("Further, we note that despite over a decade of the marketing by Desnoes of Red Stripe beer in certain of these United States, Mumm was unable to offer any evidence of actual confusion."); *TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 2018 TTAB LEXIS 121, *55 ("Up to trial, approximately seven years have passed with

³⁰ 15 TTABVUE 8.

³¹ 17 TTABVUE 5, 86.


Respondent's TRAILERTRADERS.COM mark coexisting in use with Petitioner's various -- TRADER formative marks.”).

We therefore find the eighth *DuPont* factor weighs against a likelihood of confusion.


5. Balancing the Factors

In conclusion, we have considered all of the evidence and arguments, and all relevant *DuPont* factors. Because the involved services, channels of trade, and classes of consumers are identical, the second and third *DuPont* factors weigh in favor of a finding of a likelihood of confusion. Because the services may be used by the general consumer, the fourth factor is neutral. With respect to *DuPont* factors six and one, while the FBM mark is inherently distinctive, the concluding letters BM are less distinctive when applied to building supply store services, and are the only shared



elements in the marks. The marks FBM and , considered in their entirety, are sufficiently different for confusion to be unlikely, even when used with identical services. Finally, because the marks have been in concurrent use for the same services in the same area for thirteen years, there has been a significant opportunity for confusion to arise, and there is no evidence that it ever has. We find



that it is unlikely that a consumer encountering Applicant's mark  for building supply store services who separately encounters Opposer's FBM mark for

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the identical services will believe mistakenly that those services originate from the same source.

DECISION

The opposition is dismissed.