

## US: TRADE MARKS



**Katten Muchin Rosenman  
LLP**  
New York

*Karen Artz Ash*



*and  
Bret J Danow*

## Federal Circuit rules on trade mark pronunciation

The Federal Circuit issued a precedential decision this summer in the case *StonCor Group, Inc v Specialty Coatings, Inc* regarding the proper pronunciation of a trade mark that is not a recognised word. This decision is instructional for trade mark disputes involving marks that are uniquely coined terms.

StonCor owns a federal trade mark registration for the mark Stonshield. It filed a notice of opposition before the USPTO's Trademark Trial and Appeal Board (TTAB) against a trade mark application for the mark Armorstone filed by its competitor, Specialty Coatings, claiming, among other things, that there was a likelihood of confusion between the Stonshield and Armorstone marks.

The TTAB dismissed the opposition, finding that there was no likelihood of confusion between the marks. Of particular note, when applying the sight, sound and meaning test, the TTAB found that there was no similarity between the sound of the "Ston" and "Stone" components of the respective marks.

In its analysis, the TTAB essentially assigned its own pronunciation to the Stonshield mark based on the spelling of the mark. The TTAB took the position that "according to the spelling of [the] mark, the letter 'o' is pronounced as a short vowel sound as opposed to the long vowel sound". It gave little weight to StonCor's testimony on the pronunciation of the mark, holding that although StonCor's counsel pronounced the prefix in Stonshield as "stone", the mark is not spelled in a manner consistent with this pronunciation. In doing so, the TTAB ruled that the prefix of StonCor's mark was pronounced "ston" rather than "stone" and, as such, determined that there was a substantially different sound between the Stonshield and Armorstone marks.

StonCor subsequently appealed the TTAB's decision to the Federal Circuit. The Federal Circuit ruled that the TTAB erred in the part of its analysis comparing the sound of the two marks at issue, as the TTAB should have given more credit to the evidence proffered by StonCor that consumers pronounce the prefix "Ston" as "stone". Specifically, the TTAB held that "there is no correct pronunciation of a trademark that is not a recognized word"; and in a case where a term is not an English word, it is error for the TTAB to supply its own pronunciation of the term and ignore evidence that potential customers would pronounce the term in a different way. However, notwithstanding the Federal Circuit's ruling that the TTAB erred in its analysis, the Court found that the error was harmless, affirming the ruling that there was no likelihood of confusion between the marks.

While companies are often encouraged to create uniquely coined terms to serve as their trade marks, the decision in *StonCor* indicates that they cannot simply assume that their marks will be pronounced a certain way. Instead, brand owners should be ready to provide evidence of how customers will pronounce the mark in the event of an opposition.