

TTAB
EV 182662350

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

01-03-2003

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #10

In Re: Application of United)
Coatings Manufacturing Company)
Serial No. 76/233,386)
Filing date: March 30, 2001)
Trademark: ROOF MATE)
Law Office 115)
TM Attorney: Jeffrey S. DeFord)

BRIEF OF APPLICANT

INTRODUCTION

Applicant, United Coatings, hereby appeals from the examiner's final refusal dated May 3, 2002 to register the above-identified mark and respectfully requests the Trademark Trial and Appeal Board to reverse the examiner's decision.

APPLICANT'S TRADEMARK

Applicant seeks registration on the Principal Register of its mark:

ROOF MATE

for:

ACRYLIC ELASTOMER COATING FLUID APPLIED ROOFING
MEMBRANE; EXTERIOR PAINT; PAINT PRIMER.

PRIOR REGISTRATION CITED BY THE EXAMINER

The grounds for the final refusal was a claim of a likelihood of confusion with prior U.S. Registration No. 0728153 for the mark ROOFMATE (one word) for the following goods (owned by Dow Chemical):

ROOF INSULATION.

THE REJECTION

In the initial and final rejections, the examiner contends the two marks are nearly identical and the goods are so closely related that there would be a likelihood of confusion. Applicant respectfully disagrees and requests the Board to reverse the final refusal.

ARGUMENT

The Applicant submits that there are multiple reasons and factors why there is not a likelihood of confusion in this case, including the differences in the goods themselves as well as the respective sources of the goods, the relative market channels for the goods, the level of sophistication of the purchasers, and the scope of protection given similar marks in the class, all of which is confirmed by eighteen-plus years of concurrent use with no likelihood of confusion.

The Applicant's application declares that the mark has been used on the goods since at least as early as 1983. The owner of the reference, Dow Chemical, is a large international company, and if there was a likelihood of confusion or actual confusion,

Dow Chemical would have certainly learned of it and complained of it in eighteen years' time. There has been no actual confusion and there is no likelihood of confusion, and this mark should therefore proceed to publication and allowance.

In many trademark applications and trademark litigation, the court or trier of fact is left with the speculative decision of whether there is likely to be confusion based on numerous factors that may be considered. In cases such as this however, where there are ***eighteen years of concurrent use***, that speculation is removed and the mere fact of eighteen years of concurrent use without any known instances of actual confusion and without any protest or issues raised by the prior registrant, removes the speculation and conclusively shows there is no likelihood of confusion or actual confusion.

There are numerous case law citations in which years of concurrent use have been deemed to be very significant and carry the day, weighing heavily against a finding of likelihood of confusion. The years of concurrent use have removed the speculation, and in these prior cases, the years have been far fewer than the eighteen years in this case.

In *Brookfield Communications, Inc. V. West Coast Entertainment Corp.*, 174 F.3d 1036, 1050, 50 U.S.P.Q. 2d 1545 (9th Cir 1999) for example, the Ninth Circuit stated: "We cannot think of more persuasive evidence that there is no likelihood of confusion between these two marks than the fact that they have been simultaneously used for five years without causing any consumers to be confused as to who makes what".

In the case of *Planet Hollywood v. Hollywood Casino*, a case in which the parties coexisted in the Chicago area for more than six years without a reported instance of confusion, the court held there was no likelihood of confusion, as proven by history, stating, "The court deems it very significant that over this extended period, Planet Hollywood has been unable to muster any evidence of actual confusion."

In *Greentree Laboratories, Inc. v. G. G. Bean, Inc.*, concurrent use for five years without confusion where plaintiff's mark is weak created a "presumption" that confusion is unlikely, and judgment was entered for no infringement.

Again, in *Hubbard Feeds, Inc. v. Animal Feeds Supplement, Inc.*, 182 F.3d 598 (8th Cir. 1999), a long period of concurrent use with no evidence of actual confusion is "telling" evidence that confusion is not likely.

In another case, *Barre-National, Inc. v. Barr Laboratories*, 773 F.Supp. 735 (District of N.J. 1991), an absence of actual confusion for seventeen years between Barr and Barre "weighs heavily against a finding of likelihood of confusion". To quote the Third Circuit, the longer the challenged product has been in use, the stronger this inference will be that continued marketing will not lead to consumer confusion.

The Second Circuit Court of Appeals stated as follows: "If consumers have been exposed to two allegedly similar trademarks in the marketplace for an adequate period of time and no actual confusion is detected either by survey or in actual reported instances of confusion, that can be powerful indication that the junior trademark does not cause a meaningful likelihood of confusion." In this case, eighteen years is certainly adequate.

CONCLUSION

For the individual and combined reasons set forth above, Applicant submits there is no likelihood of confusion, mistake or deception between Appellant's mark and the prior cited registration. Accordingly, Appellant's mark is entitled to registration and the Board is therefore respectfully requested to reverse the examiner's final decision refusing registration of the Appellant's mark.

Respectfully submitted,

11/3/03
Date



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Applicant United Coatings
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Trademark Attorney Jeffrey S. DeFord
Attorney's Docket No. UN1-123
Mark: ROOF MATE

TRANSMITTAL LETTER

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Enclosed are:

- 1. Return Postcard Receipt
- 2. Transmittal Letter
- 3. Brief of Applicant

01-03-2003

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Deposit Account Authorization - The Commissioner is hereby authorized to charge payment of any applicable fees to Deposit Account No. 23-0925.

Date: 1/3/03

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LR