

**THIS OPINION IS NOT A  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Pavestone Company, LP

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Serial No. 77827139

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Christopher J. Rourk of Jackson Walker LLP for Pavestone Company LP.

Ameen Imam, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

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Before Zervas, Bergsman and Kuczma,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

The Pavestone Company, LP ("applicant") filed a use-based application to register the mark VENETIAN STONE, in standard character form, for "concrete building materials, namely, interlocking concrete pavers," in Class 19.

Applicant disclaimed the exclusive right to use the word "stone."

The Trademark Examining Attorney refused to register applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that applicant's mark is likely to cause confusion with the previously

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registered mark VENEZIAN (stylized), shown below, for the following goods:

Building stone; granite; mantels for fireplaces of marble and stone; marble; nonstructural building materials, namely, granite used in decorative surface applications for countertops and vanity tops; paving stone; paving stones; pool surrounds made of stone; sealer coatings sold as an integral component of non-metal tiles, natural stone, and molded resins for construction purposes; stone for building and construction; stones; tombstones of stone, concrete or marble.<sup>1</sup>



The registration includes the following translation statement: "The English translation of the word 'Venezian' in the mark is Venetian." The registration was issued under the provisions of Section 2(f) of the Trademark Act.

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the

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<sup>1</sup> Registration No. 3741613, issued January 26, 2010.

factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 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 goods. 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").

- A. The similarity or dissimilarity and nature of the goods described in the application and in the cited registration, likely-to-continue trade channels and classes of consumers.

Applicant is seeking to register its mark for "interlocking concrete pavers" and the cited registration is for, *inter alia*, paving stones. Because a refusal under Section 2(d) is proper if there is a likelihood of confusion involving any of the goods set forth in the application and cited registration, we focus the analysis of the relatedness of the goods on paving stones which the evidence, discussed below, demonstrates are legally identical to "interlocking concrete pavers." See, e.g.,

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*Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); and *Shunk Mfg. Co. v. Tarrant Mfg. Co.*, 318 F.2d 328, 137 USPQ 881, 883 (CCPA 1963).

A "paver" is defined as "a brick, tile, stone, or block used for paving."<sup>2</sup> Thus, an "interlocking concrete paver" and "paving stones" are by definition very similar.

The Concrete Pavers Guide website, "The site for everything concrete pavers" ([concretepaversguide.com](http://concretepaversguide.com)), states that concrete pavers are paving stones.<sup>3</sup>

Welcome to Concrete pavers Guide!

Here we seek to give you the information you need to install concrete pavers (also known as paving stones, concrete paving stones, or simply pavers) at your home, whether by yourself or by a professional.

In fact, on its website ([pavestone.com](http://pavestone.com)), applicant advertises its VENETIAN STONE product under the heading "Pave Stones."<sup>4</sup> Applicant's specimen submitted with its application advertises its VENETIAN STONE as "Concrete Pave Stones," and applicant sells interlocking concrete pavers

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<sup>2</sup> The Random House Dictionary of the English Language (Unabridged), p. 1423 (2<sup>nd</sup> ed. 1983). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

<sup>3</sup> February 11, 2011 Office action.

<sup>4</sup> February 11, 2011 Office action.

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as well as "driveway pavers, brick pavers, stone pavers and patio stones."<sup>5</sup>

The website for Belgard Hardscapes, Inc. website (belgard.biz), a company that sells pavers and paving stones also uses the term "paving stones" and "interlocking pavers interchangeably."<sup>6</sup> In its webpage for "Interlocking Pavers," the webpage of Belgard Hardscapes states that "Paving stones should last over 30 years, which is much longer than alternative pavements, under normal residential use." See also the Sims Stone website (simsstone.com) ("Concrete paving stones or pavers as they are commonly referred to ..." and "The days for using concrete paving stones or pavers as simple stepping stones are long gone.");<sup>7</sup> the Brown's Concrete website (brownsconcrete.com) (the "Interlocking Paving Stones" webpage advertises concrete paving stones, including "interlocking paving stones").<sup>8</sup>

Pacific Pavingstone, "Southern California's Professional Paving Stone Installers," provided the following historical insight (emphasis added):<sup>9</sup>

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<sup>5</sup> February 11, 2011 Office action.

<sup>6</sup> February 11, 2011 Office action.

<sup>7</sup> *Id.*

<sup>8</sup> December 21, 2009 Office action.

<sup>9</sup> July 21, 2010 Office action.

Paving Stone Driveways

Driveway paving installers know the incredible strength and long-lasting qualities of paving stones. In Europe, cobblestone streets, walkways and town squares are everywhere, many of them several hundred years old and still in perfect shape. When expensive natural stone became out of reach, Europeans weren't willing to give up the charm and elegance that only stone paving can give, so they invented a new type of paving stone (known in the industry as "interlocking pavers") that duplicated the beauty and strength of stone at a fraction of the price. Since that time, concrete pavers have become the pavement of choice.

The record is replete with numerous examples demonstrating that interlocking concrete pavers are an alternative paving stone, if not a type of paving stone (e.g., Belgard Hardscapes, Gulfstream Hardscape, The Rock Yard, Inc., and Integrity Concrete).<sup>10</sup> In view of the foregoing, we find that the goods are in part identical.

Because the goods are in part identical, we must presume that the channels of trade and classes of purchasers are the same. See *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the

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<sup>10</sup> *Id.*

same channels of trade, and be sold to the same class of purchasers." ). See also *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

Applicant argues, without any supporting evidence, that "the goods are different and are marketed to different consumers in different channels of trade."<sup>11</sup> The problem with applicant's argument is that this proceeding concerns applicant's right to register a trademark, not applicant's actual trademark use. Because the scope of the registration applicant seeks is defined by its application (and not by its actual use) it is the application (and not actual use) that we must look to in determining applicant's right to register:

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

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<sup>11</sup> Applicant's Brief, p. 7.

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*Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Likewise, in considering the scope of the cited registration, we look to the registration itself, and not to extrinsic evidence about the registrant's actual goods, customers, or channels of trade. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958).

Because there are no limitations as to channels of trade or classes of purchasers in the description of goods in either the application or the cited registration, we must presume that applicant's interlocking concrete pavers and registrant's paving stones are available to all classes of purchasers for those goods. See *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

As indicated above, the record contains numerous examples of companies advertising interlocking concrete pavers as an alternative paving stone. Furthermore the Concrete Pavers Guide referenced above, is a guide for do-it-yourselfers or professionals, thus, indicating that the installation of interlocking concrete pavers or paving stones is not restricted to professionals. See also the Mold Store website ([themoldstore.us](http://themoldstore.us)) that provides instructions about making your own stone pavers that are



"so simple ... virtually anyone can do it."<sup>12</sup> Therefore, the record shows that interlocking concrete pavers and paving stones move in the same channels of trade and are sold to the same classes of consumers.

B. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that where, as here, applicant's goods and registrant's goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100*

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<sup>12</sup> February 11, 2011 Office action.

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*Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI Division of E-Systems, Inc. v. Environmental Communications Incorporated*, 207 USPQ 443, 449 (TTAB 1980).

Moreover, 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 overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1835, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. V. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 23, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion"). On the

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other hand, different features may be analyzed to determine whether the marks are similar. *Price Candy Company v. Gold Medal Candy Corporation*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). In fact, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 224 USPQ at 751.

Applicant's mark is VENETIAN STONE for "interlocking concrete pavers." As indicated above, a "paver" is defined as "a brick, tile, stone, or block used for paving." Therefore, the word "stone" is descriptive when applied to "interlocking concrete pavers" and applicant properly disclaimed the exclusive right to use the word "stone." In view thereof, we find that the word "Venetian" is the dominant element of applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1983) ("Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion"); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB

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2001) (disclaimed matter is often "less significant in creating the mark's commercial impression").

The significance of the word "Venetian" as the dominant element of applicant's mark, VENETIAN STONE is reinforced by its location as the first part of the mark. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"). *See also Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

Applicant's mark VENETIAN STONE and the mark in the cited registration VENEZIAN (stylized) are similar in appearance. The words "Venetian" and "Venezian" differ only by applicant's use of the letter "T" instead of the letter "Z."

The stylized script of the registered mark is not so distinctive that it creates a commercial impression

separate and apart from the word "Venezian." In addition, applicant's mark is presented in standard character form meaning that the rights associated with applicant's mark reside in the wording and not in any particular display. *In re RSI Systems, LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). Thus, applicant could present its mark in a script form similar to the registered mark.

Although there is no correct pronunciation of a mark, the words "Venetian" and "Venezian" are likely to have similar pronunciations.

The word "Venezian" is translated into English as "Venetian." Thus, the marks have similar, if not identical meanings (*i.e.*, of or from Venice). In this regard, the commercial impression of the marks is identical because they create the image of stone from Venice.

In view of the foregoing, we find that marks are similar in terms of appearance, sound, meaning and commercial impression.

E. Balancing the factors.

In view of the similarity of the marks, the finding of fact that "interlocking concrete pavers" and "paving stones" are identical, and the presumption that the goods move in the same channels of trade and are sold to the same classes of consumers, we find that applicant's mark VENETIAN STONE for "concrete building materials, namely,

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interlocking concrete pavers" is likely to cause confusion with the mark VENEZIAN (stylized) for the goods listed in the cited registration, specifically paving stones.

**Decision:** The refusal to register is affirmed.