



TTAB

**TRADEMARK TRIAL & APPEAL BOARD
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	:		
Masonite International Corp.	:	Law Office:	112
Serial No. 78/389,392	:	Examining Attorney:	Josette M. Beverly
Filed: March 23, 2004	:	Atty Dkt:	26240.325
Mark: CAVALIER	:		

**APPLICANT'S REPLY TO EXAMINING ATTORNEY'S BRIEF
AND REQUEST FOR ORAL HEARING**

Trademark Trial and Appeal Board
Trademark Assistance Center
Madison East, Concourse Level Room C 55
600 Dulany Street
Alexandria, VA 22314

Dear Sir:

In further support of Applicant's appeal from the Final Refusal, and in reply to the Examining Attorney's Appeal Brief, Applicant submits the following remarks. In addition, Applicant requests an oral hearing on this appeal.

The Examining Attorney's primary arguments are that 1) the marks are identical; and 2) the goods are related and marketed through similar channels of trade. Applicant respectfully disagrees, and submits that the goods are neither related nor marketed through similar channels.

With respect to the similarity of the marks, Applicant submits that a determination of likelihood of confusion does not rest on this factor alone. As set forth in Applicant's



Appeal Brief, none of the other factors support the Examining Attorney's refusal. As such, reversal of the refusal is respectfully requested.

Applicant's goods and the goods listed in the '882 registration are quite different. In contrast to the '882 registration, the goods of the present application do not include any type of railings, guardrails, or banisters. Railings, guardrails, handrails and banisters are used in entirely different applications compared to non-metal doors.

The Examining Attorney argues that "if the cited registration describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods and/or services of the type described." See Examining Attorney's Appeal Brief, p. 3. This legal proposition is misapplied given the registration does not describe the goods so broadly as to encompass the goods listed in the present application. Even if broadly construed, the description in the '882 registration (non-metallic railings, guardrails, handrails and banisters for use in and/or on buildings) simply does not encompass doors.

The '882 registration is relatively narrow in scope, and is not directed to all types of nonmetal building products, as implied by the Examining Attorney. The extent to which the registrant has the right to exclude others from using its mark is limited only to use on the specific goods listed therein. "Our precedent requires the Board to look to the registration to determine the scope of the goods/services covered by the contested mark." *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 948 (Fed. Cir. 2000); see also *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 1 U.S.P.Q.2D (BNA) 1813, 1815 (Fed. Cir. 1987); *Commerce Drug Co. v. Kirkman Labs., Inc.*, 174 U.S.P.Q. (BNA) 265, 267 (CCPA 1972). "The description of the goods in an application for

registration is critical because any registration that issues will carry that description.”

CBS, Inc. v. Morrow, 708 F.2d 1579, 1581 (Fed. Cir. 1983). The goods listed in the ‘882 registration only include “non-metallic railings, guardrails, handrails and banisters for use in and/or on buildings.” Registrant’s identification of goods does not include non-metal doors made from wood composite and solid wood components.

There is no basis for expanding the scope of the cited registration. To the contrary, Applicant has submitted extensive evidence establishing that the scope of the registration should be very narrowly construed. The Examining Attorney objects to the submission of Appendix pages 12-27 and 33-71, which are copies from the TARR web server and internet web pages. Applicant respectfully requests that the Board consider these submissions.

Prior to filing a request for reconsideration, counsel for Applicant and the Examining Attorney discussed proposed amendments to the identification of goods during a telephone interview on December 23, 2005. See 12/23/2005 Response at Appendix pgs. 72-73 attached hereto. Applicant proposed amending the identification of goods to specifically provide for ‘non-metal doors made from wood composite and solid wood components, and not including railings, guardrails and handrails.’ The Examining Attorney suggested submitting the proposed amendments in the remarks for consideration. While Applicant may have misunderstood the Examining Attorney’s intent during the telephone interview, Applicant believed that the proposed amendment would overcome the refusal. As such, Applicant did not develop the evidence provided at Appendix pages 12-27 and 33-71 at that time. Instead, Applicant requested that the refusal be withdrawn and the application be amended by Examiner’s Amendment in light

of the Examining Attorney's suggestion. In addition, Applicant specifically stated that if the amendment did not overcome the refusal, "Alternatively, Applicant can submit a supplemental response." Additional evidence would then have been submitted. In response to Applicant's proposal, the Examining Attorney denied Applicant's request for reconsideration. Applicant submits that the objection to the submissions is disingenuous in light of the prosecution history.

In any event, the Examining Attorney has already considered the TARR and website submissions and maintained her refusal. The Examining Attorney states: "Even if applicant has shown that the cited mark is 'weak', such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services." See Examining Attorney's Appeal Brief, p. 6. The Examining Attorney therefore maintains her refusal after considering the submissions. As such, remanding this application back to the Examining Attorney for further consideration would be counter-productive. Given the Examining Attorney has already considered all evidence provided in Applicant's Appendix, the Board may also properly consider all of Applicant's submissions.

Even if the Board excludes some of the TARR and website submissions, Applicant submits that evidence related to the mark CAPE COD at Appendix pages 67-71 could not have been presented earlier in the prosecution. As noted in Applicant's Appeal Brief, registrant of the '882 mark is also the owner of the mark CAPE COD, Registration No. 2,651,884 for "non-metallic railings, guardrails, handrails and banisters for use in and/or on buildings," which was registered November 19, 2002. See Appendix p. 67. Applicant of the present application is also the applicant for the mark CAPE COD,

Serial No. 78/553,761 for “metal doors, and non-metal doors; door lites, side lites, transom lites in the nature of glass and plastic panels for doors and door areas; decorative glass for building.” *Id.* at Appendix pgs. 69-71. Applicant’s ‘761 application was not approved for publication until March 8, 2006, after Applicant had already filed its Notice of Appeal. As such, this evidence could not have been submitted earlier given approval of the ‘761 application did not occur until after prosecution with the Examining Attorney had been closed. Therefore, Applicant respectfully requests that the Board at least consider evidence relating to the CAPE COD mark, Appendix pgs. 67-71, if not all of the evidence submitted at Appendix pgs. 12-27 and 33-71.

In the ‘761 application, ‘non-metal doors’ were not considered to be within the scope of protection of the Avcon’s ‘884 registration, which lists the same goods as listed in the ‘882 registration. Thus, non-metal doors have already been deemed not to be included in Avcon’s normal field of expansion. Applicant respectfully requests that the Board maintain consistency and reverse the refusal in the present application.

After submitting its Appeal Brief in the present application on April 13, 2006, Applicant’s ‘761 application for the CAPE COD mark was published for opposition on May 9, 2006. Neither Avcon nor any other third party filed an opposition or extension to file an opposition in the ‘761 application. See Appendix pgs. 74-76. Avcon has registered the mark CAPE COD for “non-metallic railings, guardrails, handrails and banisters for use in and/or on buildings”, and did not object to Applicant’s use of the mark CAPE COD for, *inter alia*, non-metal doors. As such, Avcon apparently agrees that there is no likelihood of confusion between its goods and Applicant’s goods. Applicant requests that the Board take notice of this evidence as well, given this information also

could not have been presented earlier. Indeed, the opposition period had not even begun at the time Applicant filed its Appeal Brief.

The Examining Attorney also argues that the goods are marketed through similar channels of trade. The Examining Attorney rejects evidence from Avcon's and Applicant's websites which establishes how the marks are actually used. Instead, the Examining Attorney submits excerpts from third party websites to show that the subject goods can be produced by the same party. Applicant submits that this evidence does not support the Examining Attorney's refusal. The question is whether one seeking to purchase Applicant's doors under its CAVALIER mark would confront Avcon's railings. The answer is no. The actual trade channels through which Applicant and Avcon market their goods are quite dissimilar, as explained in detail in Applicant's Appeal Brief.

Specifically, Applicant's goods are sold at various building and home centers, such as Home Depot. Avcon does not sell its products through such stores. According to Avcon's website, consumers buy its products directly from the manufacturer. See Appendix p. 7. In order to purchase Avcon's Cavalier Railing system, a consumer first requests information from Avcon or asks to be contacted by an Avcon salesman. Avcon's website indicates that in order to get a quote for a particular application, a consumer must provide Avcon with the desired style, color, method of mounting and dimensions. The dimensions are determined from blueprints or drawings supplied by the customer. See Appendix p. 7.

By contrast, Applicant's nonmetal doors marketed under its CAVALIER mark are stocked 'on the shelves' at building and home centers. One seeking to purchase Applicant's doors under its CAVALIER mark would not confront Avcon's railings. As

such, the Examining Attorney's argument that "purchasers encountering the marks are likely to assume that the applicant's and registrant's goods emanate from a common source" is without merit, and unsupported by the evidence. Consumers seeking to purchase Applicant's doors simply would not confront Avcon's railings. Nor would consumers seeking to purchase Avcon's railings confront Applicant's doors. The Examining Attorney's legal argument is contrary to the evidence.

As noted in the Examining Attorney's Appeal Brief, p. 6, it is unnecessary to show actual confusion in establishing likelihood of confusion. However, evidence of concurrent use without evidence of actual confusion is highly probative in determining that there is no likelihood of confusion. Applicant is unaware of any actual confusion. The Examining Attorney has submitted no evidence of actual confusion. Applicant has been using its CAVALIER mark in commerce since at least as early as December 1, 2004. Exhibit D, Appendix p. 28A, Mayfield Dec., ¶ 2; see also Appendix p. 72, Applicant's December 23, 2005 response. Thus, Applicant and Avcon have now been using their respective marks concurrently for more than 19 months without any actual confusion. The Examining Attorney fails to comment on this evidence.

Evidence of current use without actual confusion may not be disregarded. Indeed, the Examining Attorney's citation to *In re Kangaroos USA*, 223 USPQ 1025 (TTAB 1984), specifically states that "applicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value ... where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to)". *Id.*

at 1026-27 (emphasis added). In the present application, Applicant *has* submitted evidence pertaining to the nature and extent of concurrent use of the subject marks.

The ongoing concurrent use of the two subject marks, which has resulted in no confusion known to Applicant, suggests that confusion is unlikely. The Examining Attorney neither comments on nor disputes this evidence. Despite concurrent use of the marks for more 19 months, which is ample opportunity for confusion to arise, Applicant is unaware of any actual or potential confusion. Applicant submits that the ongoing concurrent use of the two marks is strong evidence that confusion is unlikely. The Examining Attorney fails to address this evidence. As such, *In re Kangaroos* is either inapplicable, or supports Applicant's position.

Indeed, the Examining Attorney fails to comment on or address several of Applicant's arguments with respect to analysis of several of the *DuPont* factors. Specifically, the Examining Attorney does not dispute that the mark shown in the '882 registration is not a famous mark. Nor does the Examining Attorney dispute that the mark of the '882 registration is not used as a house mark encompassing a wide variety of goods. Applicant also argued that it is currently using its mark CAVALIER for non-metal doors made from wood composite and solid wood components, and has common law rights in the mark. The Examining Attorney does not dispute and therefore acknowledges that these *DuPont* factors support registration.

Applicant submits that, when all of the *DuPont* factors are analyzed, there is no likelihood of confusion. In light of the arguments set forth herein, as well as those presented in Applicant's Appeal Brief, reversal of the Examining Attorney's refusal is respectfully requested. It is believed that no fees are due with this submission. Should

that determination be incorrect, then please debit account 50-0548 and notify the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'W. Schrot', written in a cursive style.

William C. Schrot
Attorney for Applicant

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Bethesda, Maryland 20817
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PTO Form 1957 (Rev 8/2005)

OMB Control #0651-0050 (Exp. 04/30/2006)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. 78389392 has been amended as follows:

Argument(s)

In response to the substantive refusal(s), please note the following:

The Examining Attorney is thanked for the courtesy of discussing the instant application by telephone interview on December 23, 2005. Applicant respectfully requests reconsideration of the Final Refusal in light of the following remarks.

As discussed during the telephone interview, Applicant proposes to further amend the identification of goods to provide for "non-metal doors made from wood composite and solid wood components, **and not including railings, guardrails and handrails** in Class 19." (It does not appear that Applicant's previous amendment to the identification of goods by response June 27, 2005 was entered into the PTO website. Therefore, the PTO website indicates a current identification of goods of "non-metal doors").

The Examining Attorney maintains the refusal of the present application as being likely to cause confusion with the '882 registration for non-metallic railings, guardrails, handrails and banisters for use in and/or on buildings. Applicant's proposed amendment of the identification of goods specifically excludes such railings and guardrails. The owner of the '882 registration, American Vinyl Concepts d/b/a Avcon Corporation, does not sell solid wood doors, and there is no evidence that would suggest Avcon intends to manufacture or sell doors. Furthermore, the '882 registration does not cover doors.

Therefore, Applicant submits that its proposed amendment overcomes the refusal. There is no evidence suggesting that a non-metal door marketed under the mark "Cavalier" would create confusion in the marketplace as to its source. Applicant is currently using the mark, as noted in its website (www.masonite.com), and as set forth in pages from a catalog advertisement attached hereto. Note that the catalog has a copyright date of December 2004. Thus, Applicant has been using this mark for *at least* a year (if not longer), and is aware of no confusion being caused by such use. Reconsideration of the application in amended form is respectfully requested.

As suggested by the Examining Attorney, Applicant has not formally amended the identification of goods, but submits the proposed amendment in the remarks above for consideration by the Examining

APPENDIX 72

Attorney. Should the Examining Attorney withdraw the refusal, Applicant requests that the identification of goods be amended as noted above by Examiner's Amendment. Alternatively, Applicant can submit a supplemental response.

Evidence

Evidence in the nature of Catalog pages has been attached.

Evidence-1 [evi_681638898-110912027_._Catalog_page_10000000.jpg]

Evidence-2 [evi_681638898-110912027_._Catalog_page_10000001.jpg]

Evidence-3 [evi_681638898-110912027_._Catalog_page_10000002.jpg]

Evidence-4 [evi_681638898-110912027_._Catalog_page_10000003.jpg]

Response Signature

Signature: /William C. Schrot/ Date: 12/23/2005

Signatory's Name: William C. Schrot

Signatory's Position: Attorney

Back

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2006-07-05 15:26:10 ET

Serial Number: 78553761 Assignment Information

Registration Number: (NOT AVAILABLE)

Mark

CAPE COD

(words only): CAPE COD

Standard Character claim: Yes

Current Status: Application has been published for opposition.

Date of Status: 2006-05-09

Filing Date: 2005-01-25

The Information will be/was published in the Official Gazette on 2006-05-09

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
CLARKE IDI A Employee Location

Current Location: 650 -Publication And Issue Section

Date In Location: 2006-03-30

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Masonite International Corporation

Address:

APPENDIX 74

Masonite International Corporation
1600 Britannia Road East
Mississauga, Ontario L4W 1J2
Canada

Legal Entity Type: Corporation
State or Country of Incorporation: Canada
Phone Number: (905) 670-6550
Fax Number: (905) 670-6520

GOODS AND/OR SERVICES

International Class: 006
Class Status: Active
Metal doors
Basis: 1(b)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 019
Class Status: Active
Non-metal doors; door lites, side lites, transom lites in the nature of glass and plastic panels for doors and door areas; decorative glass for building
Basis: 1(b)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2006-05-09 - Published for opposition
2006-04-19 - Notice of publication
2006-03-23 - Law Office Publication Review Completed
2006-03-17 - Assigned To LIE
2006-03-08 - Approved for Pub - Principal Register (Initial exam)
2006-03-02 - Teas/Email Correspondence Entered

APPENDIX 75

2006-02-23 - Communication received from applicant
2006-02-23 - TEAS Response to Office Action Received
2005-08-25 - Non-final action e-mailed
2005-08-25 - Non-Final Action Written
2005-08-23 - Assigned To Examiner
2005-02-03 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

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