

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85144490
LAW OFFICE ASSIGNED	LAW OFFICE 109
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The Examining Attorney has maintained and made final the refusal to register the applied-for mark, PRESTIGE CONCRETE PRODUCTS (the “Mark”), which is owned by VCNA Prestige Material Holdings, Inc. (“Applicant”). This final refusal is under section 2(d) of the Trademark Act, and is based on likelihood of confusion with the mark, PRESTIGE SERIES, which is the subject of U.S. Registration No. 3,044,687 and owned by County Materials Corporation (“Registrant”).</p> <p>Applicant requests that the Examining Attorney reconsider his final refusal to register the Mark since Applicant’s proposed revision of the identification of goods makes clear the differences in Applicant’s and Registrant’s goods, and since the circumstances surrounding the trade, sale, and marketing of Applicant’s goods provide little opportunity for customer confusion.</p> <p style="text-align: center;"><u>Likelihood of Confusion</u></p> <p>In any likelihood of confusion analysis under Section 2(d), two key factors to be considered are the similarity of the marks and the similarity of the goods and services. <i>Federated Foods, Inc. v. Fort Howard Paper Co.</i>, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In this request for reconsideration, Applicant focuses its arguments on the dissimilarities in the parties’ goods, and the circumstances surrounding Applicant’s established, likely to continue channels of trade, and the conditions under which, and buyers to whom, sales are made.</p> <p style="text-align: center;"><u>Dissimilarity of Applicant’s and Registrant’s Goods</u></p> <p>As pointed out by the Examining Attorney in the Office action dated January 20, 2011, the comparison of the parties’ goods and/or services in a likelihood of confusion analysis is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein.</p> <p>In this case, Applicant has now amended its description of goods for the Mark to “concrete, not including architectural masonry units, namely, glazed concrete blocks used for interior walls,” and the description of goods for the cited mark is “architectural masonry units, namely, glazed concrete blocks used for interior walls.”</p> <p>By making this revision, Applicant narrowed its description to specifically exclude the goods identified</p>	

by the cited mark. Although the parties' respective goods are both made from concrete, Applicant intends this narrowed description to make clear the differences in the identified goods in that Applicant's Mark is used in connection with high-quality ready mix concrete, concrete blocks, and shotcrete/gunite (concrete shot through a hose) while the cited mark identifies a specialized glazed concrete product used for interior walls.

In light of this revised description, Applicant repeats the argument it made in its July 20, 2011 response to the Office action where it stated:

"When businesses provide different goods or services, they service distinct sectors of the marketplace. As the differences between the services or goods increases, so does the competitive distance between them. The likelihood of confusion between two marks diminishes in proportion to the competitive distance between the services or goods with which they are used. *See generally Arrow Fastener Co., Inc. v. The Stanley Works*, 59 F.3d 384, 396 (2d Cir. 1995). Typically, two marks will not be found to be likely to cause confusion unless their respective goods or services serve the same purpose, fall within the same general class, or are used together. *Lang v. Retirement Living Publishing Co., Inc.*, 949 F.2d 576, 582 (2d Cir. 1991)."

Applicant asserts that the parties service distinct sectors of the marketplace. Furthermore, in Applicant's experience, glazed concrete blocks are a specialty item offered by only a few companies.

It is Applicant's belief that the competitive distance between the parties' concrete goods is substantial in that the purpose of Applicant's goods is to construct a building while the purpose of Registrant's goods is architectural and the goods are only used on interior walls. In fact, Applicant does not bid on jobs requiring glazed concrete blocks.

The differences in the parties' goods show that they are not directly competitive, and weigh in favor of a finding of no likelihood of confusion.

Trade Channels and Marketing Practices

A likelihood of confusion analysis also evaluates the trade channels, with the general rule being there is less opportunity for consumer confusion where the parties' channels of trade and advertising methods are different. *See generally Heartsprings, Inc. v. Heartspring, Inc.*, 143 F.3d 550, 556; 46 U.S.P.Q.2d 1481 (10th Cir. 1998) ("the greater the degree of overlap in the marketing approaches of the two entities, the greater the likelihood of confusion"); *Leelanau Wine Cellars, Ltd. v. Black & Red, Inc.*, 502 F.3d 504, 519 (6th Cir. 2007) (a lesser likelihood of purchaser confusion existed when, despite the parties' operation within a common geographical area, the parties sold their products "for the most part, in entirely distinct environments," where defendant winery sold approximately 85 percent of its wine through its tasting rooms and did not sell to major retail operations while, in contrast, plaintiff winery sold 25-30 percent of its wines through its tasting rooms and the remaining 70-75 percent through retail stores).

In this case, Applicant's products are marketed and sold primarily through its sales force and through direct customer contact. Applicant identifies its customers mainly through repeat business, industry associations, online lead bulletins, or field research.

And, as previously stated, Applicant does not pursue, nor would it bid on a job requiring glazed concrete products. After identifying a potential customer, Applicant's sales force develops contact with that customer, obtains the information necessary to prepare a bid, develops and submits the bid and, if

necessary, negotiates price and other specific terms. If Applicant wins the bid, the sale is closed. Applicant primarily markets itself through its sales force's direct interactions with contractors, builders, and owners. These sales and marketing practices show that Applicant's business is built primarily on relationships with customers who are familiar with Applicant and Applicant's products.

In sum, the relationship-centric nature of the channels in which Applicant's goods are traded, and the personalized nature of Applicant's marketing practices, provide little opportunity for customer confusion, and weigh in favor of no likelihood of confusion.

This argument is strengthened by the fact that the marks have co-existed for almost three years with no instances of actual confusion. *See Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1331-1332; 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999) ("the absence of actual confusion despite several years of simultaneous use in an identical market," along with other factors, meant that the defendant did not infringe the plaintiff's mark).

In this case, Applicant first started using its Mark in commerce on July 1, 2009, while the date of first use of the cited mark is April 1, 2004. Therefore, the marks have been in concurrent use without evidence of actual confusion for almost three years.

CONCLUSION

Based on the foregoing arguments, namely, the differences in the parties' goods, and the personalized nature of Applicant's trade channels and marketing practices, Applicant disagrees that a likelihood of confusion exists and requests that the Examining Attorney withdraw his final refusal to register the Mark.

GOODS AND/OR SERVICES SECTION (current)

INTERNATIONAL CLASS	019
DESCRIPTION	Concrete
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 07/01/2009
FIRST USE IN COMMERCE DATE	At least as early as 07/01/2009

GOODS AND/OR SERVICES SECTION (proposed)

INTERNATIONAL CLASS	019
TRACKED TEXT DESCRIPTION	
Concrete ; concrete, not including architectural masonry units, namely, glazed concrete blocks used for interior walls	
FINAL DESCRIPTION	
concrete, not including architectural masonry units, namely, glazed concrete blocks used for interior walls	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 07/01/2009

FIRST USE IN COMMERCE DATE	At least as early as 07/01/2009
SIGNATURE SECTION	
RESPONSE SIGNATURE	/angela alvarez subjek/
SIGNATORY'S NAME	Angela Alvarez Sujek
SIGNATORY'S POSITION	Attorney of record, Michigan bar member
SIGNATORY'S PHONE NUMBER	734-761-3780
DATE SIGNED	03/23/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Mar 23 17:29:34 EDT 2012
TEAS STAMP	USPTO/RFR-65.240.49.18-20 120323172934776461-851444 90-490712f468bb09472b8365 fe384d76cf7-N/A-N/A-20120 323171141942208

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85144490** has been amended as follows:

ARGUMENT(S)

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

The Examining Attorney has maintained and made final the refusal to register the applied-for mark, PRESTIGE CONCRETE PRODUCTS (the "Mark"), which is owned by VCNA Prestige Material Holdings, Inc. ("Applicant"). This final refusal is under section 2(d) of the Trademark Act, and is based on likelihood of confusion with the mark, PRESTIGE SERIES, which is the subject of U.S. Registration No. 3,044,687 and owned by County Materials Corporation ("Registrant").

Applicant requests that the Examining Attorney reconsider his final refusal to register the Mark since Applicant's proposed revision of the identification of goods makes clear the differences in Applicant's and Registrant's goods, and since the circumstances surrounding the trade, sale, and marketing of Applicant's goods provide little opportunity for customer confusion.

Likelihood of Confusion

In any likelihood of confusion analysis under Section 2(d), two key factors to be considered are the similarity of the marks and the similarity of the goods and services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In this request for reconsideration, Applicant focuses its arguments on the dissimilarities in the parties' goods, and the circumstances surrounding Applicant's established, likely to continue channels of trade, and the conditions under which, and buyers to whom, sales are made.

Dissimilarity of Applicant's and Registrant's Goods

As pointed out by the Examining Attorney in the Office action dated January 20, 2011, the comparison of the parties' goods and/or services in a likelihood of confusion analysis is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein.

In this case, Applicant has now amended its description of goods for the Mark to "concrete, not including architectural masonry units, namely, glazed concrete blocks used for interior walls," and the description of goods for the cited mark is "architectural masonry units, namely, glazed concrete blocks used for interior walls."

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In light of this revised description, Applicant repeats the argument it made in its July 20, 2011 response to the Office action where it stated:

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Applicant asserts that the parties service distinct sectors of the marketplace. Furthermore, in Applicant's experience, glazed concrete blocks are a specialty item offered by only a few companies.

It is Applicant's belief that the competitive distance between the parties' concrete goods is substantial in that the purpose of Applicant's goods is to construct a building while the purpose of Registrant's goods is architectural and the goods are only used on interior walls. In fact, Applicant does not bid on jobs requiring glazed concrete blocks.

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This argument is strengthened by the fact that the marks have co-existed for almost three years with no instances of actual confusion. *See Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1331-1332; 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999) ("the absence of actual confusion despite several years of simultaneous use in an identical market," along with other factors, meant that the defendant did not infringe the plaintiff's mark).

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CONCLUSION

Based on the foregoing arguments, namely, the differences in the parties' goods, and the personalized nature of Applicant's trade channels and marketing practices, Applicant disagrees that a likelihood of confusion exists and requests that the Examining Attorney withdraw his final refusal to register the Mark.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 019 for Concrete

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 07/01/2009 and first used in commerce at least as early as 07/01/2009, and is now in use in such commerce.

Proposed:

Tracked Text Description: ~~Concrete~~; [concrete, not including architectural masonry units, namely, glazed concrete blocks used for interior walls](#)

Class 019 for concrete, not including architectural masonry units, namely, glazed concrete blocks used for interior walls

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 07/01/2009 and first used in commerce at least as early as 07/01/2009, and is now in use in such commerce.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /angela alvarez sujek/ Date: 03/23/2012

Signatory's Name: Angela Alvarez Sujek

Signatory's Position: Attorney of record, Michigan bar member

Signatory's Phone Number: 734-761-3780

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85144490

Internet Transmission Date: Fri Mar 23 17:29:34 EDT 2012

TEAS Stamp: USPTO/RFR-65.240.49.18-20120323172934776

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