

From: Rossman, William

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Subject: U.S. TRADEMARK APPLICATION NO. 85144490 - PRESTIGE
CONCRETE PRODUCTS - N/A - Request for Reconsideration Denied - Return to
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Count: 4

Files: concrete1-1.jpg, concrete1-2.jpg, bloc&concr.jpg, 85144490.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85144490

MARK: PRESTIGE CONCRETE PRODUCTS



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: VCNA Prestige Material Holdings, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 4/18/2012

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated September 23, 2011 are maintained and continue to be final. *See* TMEP §§715.03(a), 715.04(a).

The 2(d) refusal is maintained as FINAL:

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

1. Applicant has merely revised their description of goods to exclude the cited registrant's goods. Cited registrant's goods are "glazed concrete blocks used for interior walls" and applicant's identification now reads; "concrete, not including architectural masonry units, namely, glazed concrete blocks used for interior

walls.” The examining attorney argues that the goods, namely, concrete and glazed concrete blocks are highly related and are offered by the same manufactures as indicated in the following cites from the previous office actions.

See evidence provided in the Final office action and attached and referenced herein that WATKINS offers glazed concrete block, concrete mix and numerous other concrete products at <http://www.watkinsconcreteblock.com> showing the actual concrete block packages and glazed block offered by the same manufacturer.

The examining attorney has also provided evidence in the first action referenced herein from third party vendors submitted by the examining attorney show manufactures offering both concrete and concrete block with registration numbers: 2566725 listing both concrete and concrete blocks, 2993920 listing in the identification concrete, concrete blocks and concrete walls and 3571310 listing concrete and concrete blocks.

2. The applicant asserts that the parties services are distinct sectors of the marketplace but have provided no actual evidence of this claim or and explanation describing why concrete and concrete blocks are not related since glazed concrete blocks would be made initially of concrete. Applicant argues that their goods are used for architecture while the registrant’s goods are used for building. The applicant has provided no real evidence of this assertion and the fact that they do not bid on jobs requiring glazed concrete blocks does not weigh heavily on the issue of confusion.

It appears that the materials here have a complimentary use in the building trade. Where evidence shows that the goods at issue have complementary uses, and are often used together or otherwise purchased by the same purchasers for the same or related purposes, such goods have generally been found to be sufficiently related such that confusion would be likely if they are marketed under the same or similar marks. *See In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009) (finding medical MRI diagnostic apparatus and medical ultrasound devices to be related, based in part on the fact that such goods have complementary purposes because they may be used by the same medical personnel on the same patients to treat the same disease);

3. Applicant further argues that it primarily markets itself through its sales force’s direct interactions with contractors, builders, and owners and that 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. Once again, no sales figures or marketing practices are provided as evidence.

The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or

services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); see TMEP §1207.01(a)(iii).

4. Finally, applicant has submitted third party registrations alleging the wording in the mark PRESTIGE is weak for non-metal building materials to support the argument that this wording is, diluted, or so widely used that it should not be afforded a broad scope of protection.

However, only one of the registrations, namely, 3222626 for grave stone markers in the submitted third party registrations by the applicant contains concrete in the identification. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with similar goods and/or services. See *Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). Furthermore, the goods and/or services listed in the third-party registrations submitted by applicant are different from those at issue and thus do not show that the relevant wording is commonly used in connection with the goods and/or services at issue.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. See 37 C.F.R. §2.64(b); TMEP §§715.03, 715.03(a), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. See TMEP §715.04(a).

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- Block
- Brick
- Stone
- Segmental Retaining Walls/Anchor
- Landscape Products
- Packaged Concrete Products
- Rebar
- Other Building Materials

Products > Block > Glazed



Astra-Glaze glazed block offers color and durability to projects. Glazed blocks are lightweight concrete blocks that have a thermosetting glazing compound permanently molded to the face. The compound is heat-treated and becomes an integral part of the block. Many shapes and sizes are available to meet the designers needs.

ASTRA-GLAZE-SW@+ glazed units are concrete masonry blocks which have a thermosetting glazing compound permanently molded to one or more faces. This glazing compound is cured and heat treated in gas-fired tunnel kilns thus becoming an integral part of the unit.



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