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

Proceeding	85144490
Applicant	VCNA Prestige Material Holdings, Inc.
Applied for Mark	PRESTIGE CONCRETE PRODUCTS
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**SERIAL NO.:** 85/144490  
**FILING DATE:** October 4, 2010  
**MARK:** PRESTIGE CONCRETE PRODUCTS  
**APPLICANT:** VCNA Prestige Material Holdings, Inc.  
**LAW OFFICE:** 109  
**EXAMINING ATTORNEY:** William M. Rossman

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## TABLE OF AUTHORITIES

Page

### Cases

<i>Accuride International, Inc. v. Accuride Corp.</i> , 871 F.2d 1531 (9th Cir. 1989) .....	3
<i>Arrow Fastener Co., Inc. v. The Stanley Works</i> , 59 F.3d 384 (2d Cir. 1995) .....	5
<i>General Electric Co. v. Graham Magnetics Inc.</i> , 197 USPQ 690 (TTAB 1977) .....	4
<i>Harvey Hubbell Inc. v. Tokyo Seimitsu Co., Ltd.</i> , 188 USPQ 517 (TTAB 1975) .....	4
<i>In re Bed and Breakfast Registry</i> , 791 F.2d 157; 229 USPQ 818 (Fed. Cir. 1986) .....	10
<i>In re Dixie Restaurants, Inc.</i> , 105 F.3d 1405; 41 USPQ2d 1531 (Fed. Cir. 1997) .....	8
<i>In re E.I. du Pont de Nemours &amp; Co.</i> , 476 F.2d 1357; 177 USPQ 563 (CCPA 1973) .....	3
<i>In re Majestic Distilling Co.</i> , 315 F.3d 1311; 65 USPQ2d 1201 (Fed. Cir. 2003) .....	3
<i>In re Mars, Inc.</i> , 741 F.2d 395; 222 USPQ 938 (Fed. Cir. 1984) .....	3
<i>In re Nat'l Data Corp.</i> , 753 F.2d 1056; 224 USPQ 749 (Fed. Cir. 1985) .....	8
<i>In re The W.W. Henry Company, L.P.</i> , 82 USPQ2d 1213 (TTAB 2007) .....	4
<i>Interstate Brands Corporation v. Celestial Seasonings, Inc.</i> , 576 F.2d. 926; 198 USPQ 151 (CCPA 1978) .....	3
<i>King Candy Co. v. Eunice King's Kitchen, Inc.</i> , 496 F.2d 1400; 182 USPQ 108 (CCPA 1974) .....	11
<i>Lang v. Retirement Living Publishing Co., Inc.</i> , 949 F.2d 576 (2d Cir. 1991) .....	6
<i>Mushroom Makers, Inc. v. R.G. Barry Corp.</i> , 580 F.2d 44 (2nd Cir. 1978), <i>cert denied</i> , 439 U.S. 116, 99 S.Ct. 1022 (1979) .....	2
<i>Standard Brands, Inc. v. Smidler</i> , 151 F.2d 34 (2d Cir 1945) .....	11
<i>Sure-Fit Products Co. v. Saltzson Drapery Co.</i> , 254 F.2d 158; 117 USPQ 295 (CCPA 1958) .....	10-11
<i>Weiss Associates Inc. v. HRL Associates Inc.</i> , 902 F.2d 1546; 14 USPQ2d 1840 (Fed. Cir. 1990) .....	12

## **APPLICANT'S APPEAL BRIEF**

### I. Introduction

Applicant VCNA Prestige Material Holdings, Inc. ("Applicant") has appealed to the Trademark Trial and Appeal Board from the final decision of the United States Patent and Trademark Office refusing registration of the above-referenced mark.

The Applicant filed its application to register the mark, PRESTIGE CONCRETE PRODUCTS, on October 4, 2010. The Examining Attorney issued his Final Refusal on September 23, 2012. The Applicant noticed its appeal from that final rejection on March 23, 2012, the same date that Applicant filed a Request for Reconsideration after Final Action. In view of the filing of the Request for Reconsideration, the appeal was instituted but action on the appeal was suspended. After the Examining Attorney denied the Request for Reconsideration on April 18, 2012, the appeal resumed on that same day.

The Examining Attorney has refused registration, contending that there is a likelihood of confusion with the mark in U.S. Registration No. 3,044,687.

As set forth in the following sections of this appeal brief, Applicant believes the Examining Attorney's contention to be in error and asks that the Board reverse the refusal and pass this mark to publication.

### II. Relevant Facts

Applicant applied for U.S. registration of the mark, PRESTIGE CONCRETE PRODUCTS, Application Serial No. 85/144490, for "Concrete," in International Class 19. The application's filing basis is actual use, with the date of first use and the date of first use in commerce of July 1, 2009, and disclaiming exclusive rights to the words "CONCRETE

PRODUCTS” apart from the mark. In a Request for Reconsideration after Final Action filed on March 23, 2012, Applicant amended the description of goods to “concrete, not including architectural masonry units, namely, glazed concrete blocks used for interior walls” in International Class 19.

The mark cited by the Examining Attorney is PRESTIGE SERIES, for use on “architectural masonry units, namely, glazed concrete blocks used for interior walls” in International Class 19 (U.S. Registration No. 3,044,687). The cited mark is owned by County Materials Corporation (“Registrant”). The registration cites the date of first use as April 1, 2004, the date of first use in commerce as May 15, 2004, and contains a disclaimer of the word “SERIES”. The cited mark was registered on January 17, 2006. On January 18, 2012, the Declaration of Use was accepted and the Declaration of Incontestability was acknowledged.

### III. Argument

Applicant requests that this Board reverse the Examining Attorney’s refusal since there is no likelihood of confusion due to: the differences in the parties’ goods and the fact that they are not competitive; the fact that buyers are making careful, sophisticated purchasing decisions resulting from a relationship-centric sales process; the differences in the parties’ respective marks as a whole; the weakness of the word “Prestige” as a trademark; and the parties’ concurrent use of their marks for nearly three years with no known instances of actual confusion.

In determining the likelihood of confusion between two marks, the critical inquiry is “whether there is any likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question.”

*Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 47 (2nd Cir. 1978), *cert denied*, 439 U.S. 116; 99 S.Ct. 1022 (1979). Likelihood of confusion must be evaluated on a case-by-case

basis and “the fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Interstate Brands Corporation v. Celestial Seasonings, Inc.*, 576 F.2d 926; 198 USPQ 151, 153 (CCPA 1978), quoting *Interstate Brands Corporation v. Celestial Seasonings, Inc.*, 196 USPQ 321, 324-325 (TTAB 1977). There are many factors to be considered in determining whether or not marks are confusingly similar, including but not limited to, the following:

(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing; (5) the fame of the prior mark (sales, advertising, length of use); (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion;. . . . *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361; 177 USPQ 563 (CCPA 1973).

Not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315; 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62; 177 USPQ at 567. The totality of the factors provides the critical inquiry: even when marks are identical, other factors may indicate that there is no likelihood of confusion. *See e.g. Accuride International, Inc. v. Accuride Corp.*, 871 F.2d 1531 (9th Cir. 1989) (no likelihood of confusion between ACCURIDE for drawer slides and ACCURIDE for wheels and rims) and *In re Mars, Inc.*, 741 F.2d 395; 222 USPQ 938 (Fed. Cir. 1984) (no likelihood of confusion between CANYON for candy bars and CANYON for fresh citrus fruits).

As analyzed below, a consideration of the most relevant factors leads to the conclusion that there is no likelihood of confusion between the two marks.

**The Parties' Goods are Different and Are Not Competitive**

Applicant argues in this appeal that the goods are different, do not typically emanate from a single source, and are not competitive.

First, the fact that the goods are both made from concrete is not controlling. To demonstrate that goods are related, it is not sufficient that a particular term may be found which may broadly describe the goods. *See General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690 (TTAB 1977) (when evaluating the relationship between opposer's goods and applicant's goods, it is not enough to find one term that may generically describe the goods); *Harvey Hubbell Inc. v. Tokyo Seimitsu Co., Ltd.*, 188 USPQ 517 (TTAB 1975) (“[i]n determining whether products are identical or similar, the inquiry should be whether they appeal to the same market, not whether they resemble each other physically or whether a word can be found to describe the goods of the parties”). Rather, the specific items in the identifications should be examined to see if they are related in a manner that would be likely to cause confusion. *In re The W.W. Henry Company, L.P.*, 82 USPQ2d 1213 (TTAB 2007).

Applicant contends that an examination of the specific items in the identifications shows that the purpose of the goods identified by the cited mark is architectural while the purpose of the goods identified by Applicant's mark is structural. In support of this contention, Applicant points to the evidence it provided in its July 20, 2011 response that, according to Registrant's website, the Premier Prestige Series® units are “often used for brightly colored accents or banding, and for full walls in gymnasiums, restrooms and indoor swimming pools where the stain and moisture resistant finish reduces maintenance” and that “[k]itchens and laboratories also benefit from the chemical and bacteria-resistant surface.” Consistent with this information on its

website, Registrant's registration describes the goods as "architectural masonry units, namely, glazed concrete blocks used for interior walls." In contrast, Applicant's focus is on standard concrete products such as ready mix, concrete block, and shotcrete/gunite (concrete shot through a hose) that are used in construction projects. To support this description of Applicant's goods, Applicant refers to the specimen of use attached to its Application, which is a data sheet about ready mix concrete used in the construction of various structures.

Second, it is not common for the goods to be sold by the same source. The sole evidence proffered by the Examining Attorney that the goods emanate from the same company is that the goods are offered on the websites belonging to Registrant and the Watkins Concrete Block Co., Inc. (i.e., as discussed below, the other websites and registrations cited by the Examining Attorney do not mention glazed concrete blocks and are not relevant). The small number of companies that sell the goods is consistent with Applicant's contention made in the Request for Reconsideration that, in Applicant's experience, glazed concrete blocks are a specialty item offered by only a few companies.

Third, the goods are not competitive since the parties service distinct sectors of the marketplace and the competitive distance between the parties' goods is substantial. 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, 396-397 (2d Cir. 1995) (although the parties' goods were both staplers and sold in some of the same stores, the Court held the goods were functionally different and, therefore, not directly competitive). 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). In this case, the parties' goods serve different purposes (structural versus architectural), and are, therefore, not competitive.

The Examining Attorney found that the goods were similar or related, and could cause a mistaken belief among potential purchasers that the goods came from a common source. However, the Examining Attorney seems to mistakenly conflate regular concrete blocks with the specialty type of goods described in the cited registration as "architectural masonry units, namely, glazed concrete blocks used for interior walls." For example, when the Examining Attorney attached to his January 20, 2011 Office Action copies of printouts from the USPTO X-Search database, he attached printouts of sixteen registrations for marks used in connection with concrete and concrete blocks and described those printouts as "third-party registrations of marks used in connection with the same or similar goods and/or services as those of applicant and registrant in this case." None of these registrations, however, included glazed concrete blocks for interior walls in their descriptions of goods.

In the response to the Office Action, Applicant attempted to explain the difference in the parties' goods by pointing out Applicant uses its mark in connection with concrete products such as ready mix, concrete block, and shotcrete/gunite and, with respect to concrete blocks specifically, Applicant's mark is used in connection with standard concrete blocks used in the construction of exterior walls. In contrast, the cited mark is used in connection with glazed concrete masonry units used exclusively on interior walls for decoration and ease of maintenance.

The Examining Attorney stated in the Office Action dated September 23, 2011 that Applicant had “been very selective with the evidence submitted from applicant’s website” and that the parties’ goods were almost identical. The Examining Attorney continued by listing five websites belonging to companies that allegedly manufactured both concrete and glazed concrete blocks. However, a review of those five websites show that three do not mention glazed concrete blocks and, of the remaining two, one website belongs to Registrant and the other belongs to a company named Watkins Concrete Block Co., Inc.

In its Request for Reconsideration after Final Action, Applicant amended its description to “concrete, not including architectural masonry units, namely, glazed concrete blocks used for interior walls.” This amendment, however, did not dissuade the Examining Attorney who, in his denial of the Request for Reconsideration, continued his finding that “the goods, namely, concrete and glazed concrete blocks are highly related and are offered by the same manufactures (sic) as indicated in the following cites from the previous office actions.” The Examining Attorney then specifically referenced the Watkins Concrete Block Co., Inc. and three of the registrations proffered before, and also stated that Applicant provided no “explanation describing why concrete and concrete blocks are not related since glazed concrete blocks would be made initially of concrete.”

Applicant believes the Examining Attorney erred in his evaluation and that, as demonstrated above, the parties’ goods are different, not typically sold by the same source, and not competitive. These findings weigh in favor of a determination of no likelihood of confusion.

**Customers Exercise Careful, Sophisticated Purchasing Decisions**

Applicant averred in its Request for Reconsideration that its business is built primarily on relationships with customers who are familiar with Applicant and Applicant’s products in that its

products are marketed and sold primarily through its sales force and through direct customer contact, and its customers are identified mainly through repeat business, industry associations, online lead bulletins, or field research.

Furthermore, construction projects are not inexpensive, and thus, customers exercise care in making purchasing decisions. Such decisions are made on the basis of personal relationships and reputation. A customer knows with whom he is dealing prior to making such purchasing decisions.

Applicant argues that the relationship-centric nature of Applicant's marketing and sales practices provides little to no opportunity for customer confusion, and weighs in favor of no likelihood of confusion.

#### **The Parties' Marks are Different**

The Examining Attorney stated in his January 20, 2011 and September 23, 2011 Office Actions that the word, PRESTIGE, appears dominant in the two marks. The Examining Attorney based this observation on the finding that the wording CONCRETE PRODUCTS in Applicant's mark, and the wording SERIES in the cited mark, both appear descriptive for the goods and are both disclaimed. Applicant agrees that disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1407; 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) and *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060; 224 USPQ 749, 752 (Fed. Cir. 1985). Applicant believes, however, that the Examining Attorney placed too much emphasis on the single word, PRESTIGE, and failed to look at other features of the marks when determining the likelihood of confusion. It is well established that marks must be compared in their entireties. *In re Nat'l Data Corp.*, 753 F.2d at 1058 (likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark).

In this case, despite the fact that the literal components of both marks begin with the word, PRESTIGE, the two marks are different in terms of sound, connotation, and commercial impression. The sound of the marks is different due to the different cadences resulting from the cited mark being comprised of two words while Applicant's mark has three words. Next, the marks are different in terms of connotation because the cited mark contains the word SERIES, which is not synonymous with the words CONCRETE PRODUCTS, and which implies products of a similar kind or related nature, e.g., a line of glazed blocks for use in interior walls. This cited mark does not indicate the type of products, but the combination of the words PRESTIGE and SERIES implies a series of "top of the line" products. In contrast, Applicant's mark consists of the words PRESTIGE CONCRETE PRODUCTS, which implies a company that provides high quality concrete products. Lastly, the marks are different in terms of commercial impression since the cited mark imparts the idea of a line of specialty products, while Applicant's mark imparts the notion of a concrete company.

In light of the nature or the strength of the marks (as discussed more fully below), and in view of these differences in the marks' sound, connotation, and commercial impression, the Examining Attorney erred when he concluded the marks of the respective parties were identical or highly similar.

#### **The word "Prestige" is Not a Strong Mark**

Although the word PRESTIGE may be the dominant part of the two marks given the fact that the words "CONCRETE PRODUCTS" and "SERIES" are all disclaimed, Applicant argues that the word PRESTIGE is not a strong mark.

In its response to the Office Action dated January 20, 2011, Applicant noted that the records of the U.S. PTO revealed 265 marks comprised in part of the word "Prestige" for a wide

variety of goods/services, and 13 live pending applications/registrations of marks incorporating the word “Prestige” for use on nonmetallic building materials classified in International Class 19. In its response to the Office Action dated August 11, 2011, Applicant provided complete printouts of the 13 live marks that incorporate the word "Prestige" and that are used in connection with goods classified in International Class 19 (see exhibits attached to August 11 2011 response). Those printouts include the two applications belonging to Applicant, the registration belonging to Registrant, and a registration for a mark used by a third party on concrete products (see U.S. Registration No. 3,222,626, PRESTIGE MEMORIALS, for use on “grave markers of stone, concrete or marble”).

Because “Prestige” is used in so many marks, it is a weak mark. The PTO may allow the registration of numerous marks containing the word “Prestige” as a part of the mark as long as there does not appear to be a likelihood of confusion in light of the factors provided above. See *In re Bed and Breakfast Registry*, 791 F.2d 157, 159; 229 USPQ 818 (Fed. Cir. 1986) (the fact that a large number of marks embodying the words "bed and breakfast" were used for similar reservation services was a factor that weighed in favor of the conclusion that the marks, BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL, were not rendered confusingly similar merely because they share the words "bed and breakfast").

In addition to being a “weak” mark, the word “Prestige” is also laudatory. Unlike situations involving arbitrary or fanciful marks, the addition of other matter to laudatory or suggestive words may be enough to distinguish them from other marks. See *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 160; 117 USPQ 295 (CCPA 1958) (“[i]t seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks” and

“[w]here a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights”). The laudatory nature of the word “Prestige” means that consumers are likely to distinguish even small differences in the marks that incorporate this word, and the addition of the words CONCRETE PRODUCTS to Applicant’s mark will distinguish it from the cited mark.

Applicant understands that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods. *See King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401; 182 USPQ 108, 109 (CCPA 1974) (the likelihood of confusion is to be avoided as much between “weak” marks as between “strong” marks). However, confusion is unlikely in this case because the goods are different, not commonly provided by the same source, and are not competitive. Applicant does not feel that Registrant is entitled to the broad protection which would be granted if Applicant’s mark is not allowed to register. The Examining Attorney’s refusal to register Applicant’s mark in effect preempts use of the word “Prestige” as far as the field of concrete products is concerned. It has often been stated that a trademark is not a “right in gross.” In *Standard Brands, Inc. v. Smidler*, 151 F.2d 34, 36 (2d Cir 1945), the court stated:

“A trade-mark is not one in gross like a patent right but is a right of user in connection with a trade or business to designate the product to which the mark is applied in that trade or business. It is the use of the mark in a going trade or business to distinguish the product of the user from that of others and not the choice of it which creates what becomes the subject of property in the mark.”

Thus, disallowing registration of Applicant’s mark under circumstances in which there is no likelihood of confusion would improperly grant Registrant protection much broader than intended by the trademark laws.

The weakness and laudatory nature of the word “Prestige” further supports a finding that there is no likelihood of confusion between the marks.

**Concurrent Use for Almost Three Years Without Evidence of Actual Confusion**

Applicant first started using its Mark anywhere and in commerce on July 1, 2009, while the date of first use of the cited mark anywhere is April 1, 2004, and the date of first use of the cited mark in commerce is May 15, 2004. Therefore, the marks have been in concurrent use without evidence of actual confusion for nearly three years.

The Examining Attorney rejected this argument in his September 23, 2011 Office Action when he stated: “[A]lthough the applicant argues that there has been no evidence of actual confusion over two years, it is well settled that the relevant test is *likelihood of confusion*, not actual confusion. It is unnecessary to show actual confusion to establish likelihood of confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and cases cited therein.” Applicant does not dispute that the relevant test is likelihood of confusion, but notes that the length of time during and conditions under which there has been concurrent use without evidence of actual confusion is one of the factors evaluated in a likelihood of confusion determination.

IV. Conclusion

For all the foregoing reasons, Applicant submits that the Examining Attorney's refusal should be reversed and the Application to register this mark should be passed to publication.

Respectfully submitted,

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