

THIS OPINION  
IS NOT A PRECEDENT OF  
THE TTAB

Hearing: 9/21/10

Mailed: 1/19/11

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

StonCor Group, Inc.  
v.  
Stonel Inc.

Opposition No. 91177161  
to application Serial No. 78879396  
filed on May 9, 2006

Charles N. Quinn and Edward L. Brant of Fox Rothschild for  
StonCor Group, Inc.

Philip B. Whitaker of Stegall, Katz & Whitaker for Stonel,  
Inc.<sup>1</sup>

Before Quinn, Grendel and Mermelstein, Administrative  
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Stonel Inc. filed an intent-to-use application to  
register the mark shown below



<sup>1</sup> Gordon P. Raisanen of Raisanen & Associates Law Firm, Ltd. represented applicant during this proceeding, including filing the brief. Before the oral hearing, applicant appointed new counsel, as noted above, who appeared at the hearing.

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for "bricks; concrete building materials namely, thin face brick on prefabricated panels" (in Class 19). The application includes the following statements: "The applicant claims color as a feature of the mark, namely, black and red. The mark consists of the word STONEL in black with the "O" in red symbolizing a brick pattern."

StonCor Group, Inc. opposed registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to applicant's goods, so resembles opposer's various previously used and registered marks ("individually and collectively"), all of which begin with the four-letter string "STON-," for a variety of flooring, coating, sealing and bonding products for use in connection with the construction of masonry and concrete buildings and other structures made of such materials, including brick, as to be likely to cause confusion.

Applicant, in its answer, denied the salient allegations of opposer's claim of likelihood of confusion.

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by both parties; and status and title copies of opposer's pleaded registrations, introduced with the notice of opposition, and as exhibits to testimony. Both parties filed briefs, and both were represented by counsel at an oral hearing.

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Opposer's pleaded registrations, all valid and subsisting (and showing the marks in typed or standard character form), are of record:

**STONCLAD-PT** for "epoxy based chemical composition for coating industrial floors" (in Class 2).<sup>2</sup>

**STONHARD** for "chemicals, namely two component epoxies; multicomponent mixtures of epoxies, curing agents and aggregates; multicomponent mixtures of urethanes, resins and hardeners; all for general industrial use" (in Class 1).<sup>3</sup>

**STONCRETE** for "cementitious grouts; non-shrink, non-metallic grouts; rapid setting grouts; expanding grouts; water-impervious grouts; water plugging grouts; self-leveling flooring underlayerments; cementitious flooring underlayerments; high strength grouts; cementitious anchoring and casting materials for use with masonry and concrete" (in Class 19).<sup>4</sup>

**STONLOK** for "liquid applied adhesives and admixtures for concrete or masonry surfaces which become integral with and impart superior stain, water and abrasion resistance to the

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<sup>2</sup> Reg. No. 1306662, issued November 27, 1984; renewed.

<sup>3</sup> Reg. No. 1487280, May 10, 1988; renewed.

<sup>4</sup> Reg. No. 1645258, issued May 21, 1991; renewed.

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surface; latex based bonding agents; epoxy bonding agents and embedding adhesives, all for use principally in industrial and commercial building applications on masonry, concrete and tile and in highway construction" (in Class 1).<sup>5</sup>

**STONLUX** for "epoxy hardeners, chemical epoxy additives, epoxy curing agents, epoxies for use as components in mixtures, chemical solvents all solely for use in industrial and institutional applications" (in Class 1); and "floors and flooring systems comprised of epoxy resins, hardeners/curing agents for use with epoxy resins, quartz aggregates, and, optionally, pigments for use in industrial and institutional applications; mortars; namely, epoxy resin based mortars for use in industrial and institutional applications" (in Class 19).<sup>6</sup>

**STONLINER** for "epoxy hardeners, chemical epoxy additives, epoxy curing agents, epoxies for use as components in mixtures, chemical solvents all solely for use in industrial and institutional applications" (in Class 1); and "mortars, including multi-component mortars for use in industrial and institutional applications" (in Class 19).<sup>7</sup>

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<sup>5</sup> Reg. No. 1655954, issued September 10, 1991; renewed.

<sup>6</sup> Reg. No. 1687420, issued May 19, 1992; renewed.

<sup>7</sup> Reg. No. 1688593, issued May 26, 1992; renewed.

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**STONSHIELD** for "epoxy hardeners, chemical epoxy additives, epoxy curing agents, epoxies for use as components in mixtures, chemical solvents all solely for use in industrial and institutional applications" (in Class 1); and "floors and flooring systems comprised of epoxy resins, hardeners/curing agents for use with epoxy resins and quartz aggregates for use in industrial and institutional applications" (in class 19).<sup>8</sup>

**STONSET** for "epoxy hardeners, chemical epoxy additives, epoxy curing agents, epoxies for use as components in mixtures, chemical solvents all solely for use in industrial and institutional applications" (in Class 1); and "grout; namely, three-component epoxy-based grouts for industrial and institutional applications" (in Class 19).<sup>9</sup>

**STONKOTE** for "epoxy resins used as components in mixtures, hardeners and curing agents for use for epoxy resins, all for use in new building construction and in repair and renovation of existing buildings" (in Class 1); and "two component epoxy-resin based coatings for use as protective floor coatings and in protecting other horizontal surfaces, used in new building construction and in repair and

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<sup>8</sup> Reg. No. 1689713, issued June 2, 1992; renewed.

<sup>9</sup> Reg. No. 1691045, issued June 9, 1992; renewed.

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renovation of existing buildings; epoxy-resin flooring coating materials for use in new building construction and in repair and renovation of exiting buildings, particularly for use over concrete" (in Class 2).<sup>10</sup>

**STONPROOF** for "epoxy hardeners, chemical epoxy additives, epoxy curing agents, epoxies for use as components in mixtures, chemical solvents all solely for use in industrial and institutional applications" (in Class 1); and "multi-purpose epoxy-based sealants and polyurethane membranes for use in industrial and institutional applications" (in Class 17).<sup>11</sup>

**STONSEAL** for "polyurethane and aliphatic polyurethane chemical solvents all solely for use in industrial and institutional applications" (in Class 1); and "protective coatings; namely, two-component polyurethane coatings and aliphatic polyurethane coatings for use in industrial and institutional applications" (in Class 2).<sup>12</sup>

**STONFIL** for "mortars; polymer modified mortars; mortars for filling voids in horizontal surfaces; grouts; waterproof and

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<sup>10</sup> Reg. No. 1697228, issued June 30, 1992; renewed.

<sup>11</sup> Reg. No. 1697229, issued June 30, 1992; renewed.

<sup>12</sup> Reg. No. 1697230, issued June 30, 1992; renewed.

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cementitious block fillers and coatings; gel mortars; trowelable and flowable mortars" (in Class 19).<sup>13</sup>

**STONCLAD** for "epoxy hardeners, chemical epoxy additives, epoxy curing agents, epoxies for use as components in mixtures, chemical solvents all solely for use in industrial and institutional applications" (in Class 1); and "floors and flooring systems composed of resins, curing agents, quartz aggregate for use in industrial and institutional applications" (in Class 19).<sup>14</sup>

**STONBLEND** for "epoxy hardeners, chemical epoxy additives, epoxy curing agents, epoxies for use as components in mixtures, chemical solvents all solely for use in industrial and institutional applications" (in Class 1); and "floors and flooring systems composed of epoxy resin, hardeners/curing agents for use with epoxy resins, and aggregates for use in industrial and institutional applications; mortars, including multi-component mortars for use in industrial and institutional applications" (in Class 19).<sup>15</sup>

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<sup>13</sup> Reg. No. 1703299, issued July 28, 1992; renewed.

<sup>14</sup> Reg. No. 1706070, issued August 11, 1992; renewed.

<sup>15</sup> Reg. No. 1712857, issued September 8, 1992; renewed.

**STONCREST** for “epoxy hardeners, chemical epoxy additives, epoxy curing agents, epoxies for use as components in mixtures, chemical solvents all solely for use in industrial and institutional applications” (in Class 1); and “protective epoxy coatings; namely, epoxy-polyamide coatings, two-component epoxy-based coatings and colorable protective coatings for use in industrial and institutional applications” (in Class 2).<sup>16</sup>

#### THE PARTIES

Opposer is engaged in the manufacture, sale and installation of a variety of self-leveling flooring, coating (including for interior walls), sealing and bonding products. Michael Jewell, opposer’s vice president of marketing, testified that the mark STONHARD is opposer’s “umbrella” mark for these products. (Jewell in-chief dep., p. 35). The products are used in a range of applications, including commercial, industrial, institutional and academic buildings. The floor and wall products may be installed over a masonry or brick base. The goods are promoted to architects, contractors and others in the construction field. Opposer attends trade shows and advertises in trade publications, such as Food Processing directed to food processing plants. Since 2002, opposer has completed between 30,000-40,000 projects in the United States.

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<sup>16</sup> Reg. No. 1740723, issued December 22, 1992; renewed.

Applicant manufactures, sells and installs thin face brick prefabricated panels and a fastening system therefor for use on the exterior walls of buildings. To date, applicant has sold its products for use in two construction projects.

**STANDING**

Opposer has established its standing to oppose registration of the involved application. In particular, opposer has properly made its pleaded registrations of record and, further, has shown that it is not a mere intermeddler. Opposer's use and registrations of its marks establish that opposer has standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

**PRIORITY**

Priority is not in issue in view of opposer's ownership of valid and subsisting registrations. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

**LIKELIHOOD OF CONFUSION**

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

*In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors, and the other relevant *du Pont* factors in the proceeding now before us are discussed below.

**FAME**

We begin with the factor of fame. Opposer claims that its marks "have achieved fame, renown and recognition in the construction industry as a result of [opposer's] advertising, trade show participation and, most importantly, nearly 12,000 sales calls made annually by [opposer's] sales representatives." (Brief, p. 26). Opposer also points to reader surveys conducted by the magazine Food Processing showing that opposer's flooring ranked first as the flooring of choice among readers.

Fame of the prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker*

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*Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Because of the extreme deference accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting fame to clearly prove it. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); and *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

The record establishes that opposer has enjoyed a degree of success with its goods sold under the STON- marks, and that there has been appreciable promotion under the marks. However, opposer has not provided specific dollar figures for its sales or advertising expenses, nor has opposer placed its degree of success in any context. See *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309. We find, therefore, that the record falls short of proving the fame of any of opposer's marks as contemplated by case law. Thus, while we find that opposer's various STON- marks may be well known in the construction field, we decline to confer on any of them, based on the record before us, the exalted status of "famous."

**FAMILY OF MARKS**

We next direct our attention to the ninth *du Pont* regarding a "family" of marks. Mr. Jewell testified that he

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believes that the letters STON- have significance in the minds of opposer's customers because "as a matter of policy for us, all products are named with S-t-o-n at the beginning," and the marks "are known to be synonymous with [opposer's] brand." (Jewell in-chief dep., p. 49). We obviously recognize that opposer owns registrations of no less than fifteen different STON- marks in connection with its various goods. Fifteen STON- marks are, of course, sufficient to comprise a family. This fact, however, is not the end of the story. That is, the mere fact of adoption, use and/or registration of fifteen STON- marks does not in itself prove that a family of marks exists. *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Polaroid Corp. v. Richard Mfg. Co.*, 341 F.2d 150, 144 USPQ 419 (CCPA 1965); *Trek Bicycle Corp. v. Fier*, 56 USPQ2d 1527 (TTAB 2000); and *Consolidated Foods Corp. v. Sherwood Medical Industries, Inc.*, 177 USPQ 279 (TTAB 1973). Although the record reveals some conjoint use of various combinations of opposer's marks (see e.g., ex. nos. O-3 and O-4), the evidence falls short of showing that a family of STON- marks has been consistently promoted together.

Accordingly, we find, based on the record before us, that opposer has not established a family of STON- marks.

The likelihood of confusion determination therefore rests on a comparison of each of opposer's registered marks, and the goods listed in each of the registrations, with applicant's mark and the goods set forth in the application.

**THE GOODS**

In discussing this *duPont* factor as it relates to likelihood of confusion, the parties have concentrated their efforts on a comparison of opposer's flooring systems with applicant's prefabricated brick panels. We understand the rationale for doing this, given Mr. Jewell's testimony that opposer is an industry leader in high performance polymer floor systems; and that flooring comprises seventy percent of opposer's business. (Jewell in-chief dep., p. 133). And, as for applicant's goods, although it has only sold two jobs thus far, prefabricated brick panels comprise the foundation of applicant's business plans for the future; according to Jukka Jumppanen, applicant's board director and major shareholder, applicant has never used the mark in connection with individual bricks. (Jumppanen dep., p. 74).

In view of the parties' focus, we are compelled to note, at the outset of our consideration of this factor, the well established principle that the issue of likelihood of confusion herein must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods identified in opposer's pleaded registrations.

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*Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846; and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). Thus, we can consider any of the goods listed in the identifications in opposer's registrations and in the involved application, regardless of the specific items that comprise the parties' principal products. Moreover, likelihood of confusion may be found based on *any* item that comes within the identification of goods in the involved registrations and application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Opposer's Registration No. 1703299 of the mark STONFIL specifically lists, in part, "mortars" and "grouts" *per se*. Five other registrations also list "mortars" and/or "grouts." Further, applicant's identification of goods includes "bricks" *per se*. We will focus our likelihood of confusion analysis on these particular portions of the parties' identifications inasmuch as we find that they represent the closest relationship between the respective goods of the parties.

In analyzing this particular factor in the present case, it is of significant importance that the issue of likelihood of confusion must be determined on the basis of opposer's goods as they are set forth in the involved registrations, and applicant's goods as they are identified

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in the involved application, *rather than in light of what the goods actually are as shown by any extrinsic evidence. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 1 USPQ2d at 1815-16; *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1109-10 (TTAB 2007). Thus, where the goods in an involved registration and/or application are broadly identified as to their nature and type (as in the case of opposer's "mortars" and "grouts," and applicant's "bricks"), such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses all the goods of the nature and type described therein, that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Any real world distinctions, as for example, that opposer's mortars and/or

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grouts are used in connection with flooring (Jewell in-chief dep., p. 158), or that opposer's mortars have not been used in connection with bricks (Jewell rebuttal dep., p. 32), or that opposer's grouts are generally used in horizontal applications, not vertical ones (Jewell in-chief dep., p. 51), are irrelevant in considering this *du Pont* factor.

Given the broad terminology "mortars" and "grouts" in opposer's identification of goods, it must be presumed that these goods would include mortar and grout for use in all normal applications, including in connection with the laying of "bricks," a product listed in applicant's identification of goods.

It is well settled that the goods of the parties need not be identical or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue,

of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

To state the obvious, "mortars" and/or "grouts," on the one hand, and "bricks" on the other, are complementary building materials. These goods are used in laying bricks, and the mortar holds the bricks together. Mortar and grout are also used in connection with applicant's prefabricated brick panels. Mr. Jumppanen testified about a statement in applicant's product brochure (Ex. No. A-4), confirming that "grout or expansion joint sealant materials are placed in the joints between the Stonel brick panels." (Jumppanen dep., p. 93). When asked to describe the grout, Mr. Jumppanen stated, "It's a cement-base mortar, brick mortar, some people just call it grout." On cross-examination, Mr. Jumppanen further testified:

Are there any particular specifications for the grout that must be used [in connection with applicant's goods]?

Well, there is specification of the formula, how they make it but I'm, I'm not aware of that, you know. We, we buy that, you know, from mortar or grout manufacturers.

Is there any reason that you could not buy it from our client?

No, there's absolutely no reason why we couldn't buy it.

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(Jumppanen dep., pp. 93-94).

Bricks, mortar and grout could be purchased at the same time in the same store by the same individual for use in the same construction project. As identified, "mortars," "grouts" and "bricks" are likely to travel in the same or similar channels of trade that would include outlets for building supplies, such as Home Depot and Lowe's.

Given the broad terms "mortars," "grouts" and "bricks" in the identifications of goods, we must assume that they could be purchased by ordinary consumers for use in do-it-yourself projects around the home. These do-it-yourselfers are likely to exercise nothing more than ordinary care in making their purchasing decisions.

The record also shows that opposer's customers include general contractors who are constructing new buildings or renovating existing buildings, as well as "architects and specifiers who would write the product into the specification." (Jewell in-chief dep., p. 51-2).

Applicant's products are also offered to architects and specifiers. (Jumppanen dep., p. 32). Applicant, in its brief, concedes that "both parties may call on architects/designers of buildings." (Brief, p. 20).

To the extent that the common customers of the parties' mortars, grouts and bricks may be sophisticated, even careful purchasers are likely to be confused when

encountering similar products offered under similar marks. As stated by our primary reviewing court, "[t]hat the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods. 'Human memories even of discriminating purchasers ... are not infallible.'" *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) quoting *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970). The similarity between the marks and the goods in this proceeding outweigh any sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods).

In sum, the factors relating to the similarity between the goods (mortars, grouts and bricks), and the trade channels and classes of purchasers therefor, weigh in favor of a finding of likelihood of confusion.

#### **THE MARKS**

With respect to the marks, as we noted earlier in dismissing opposer's claim of a family of marks, we must compare each of opposer's marks to applicant's mark in their

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entireties as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). Contrary to the gist of one of applicant's arguments (Brief, p. 12), the test, under the first *du Pont* factor, 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 their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result.

As indicated above in our discussion of the goods, we are focusing our analysis of likelihood of confusion on those marks of opposer that cover mortar and grouts. Those marks include STONFIL, STONCRETE, STONLUX, STONLINER, STONSET and STONBLEND. Of these, we find the mark STONFIL, for goods including "mortars" and "grouts" *per se*, to present opposer's strongest case. Accordingly, we will focus our analysis, as we did in considering the similarity between the goods, on opposer's registered mark STONFIL as shown in Registration No. 1703299 and its similarity with applicant's mark STONEL and design.

In considering applicant's mark, it is well settled that one feature of a mark may be more significant than

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another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("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 consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.").

Where both a word and a design comprise the mark (as in applicant's mark), then the word is normally accorded greater weight because the word is likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). See also *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). We have taken into account the design feature of applicant's mark, namely the brick design, and the colors red and black. We find, however, that the dominant portion of applicant's mark is the word STONEL, namely the literal portion of the mark. Parties ordering the goods would ask for them as "STONEL," and, in all likelihood, some purchasers of applicant's goods, such as architects and contractors, would

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encounter the mark in a word form with no design, as in project specifications and contracts. (Jewell rebuttal dep., p. pp. 7-8).

The literal STONEL portion is similar to opposer's mark STONFIL. As to appearance, the marks both include the initial letters STON-. The second portions of the marks are different, however, and the design feature of applicant's mark obviously adds a distinguishing element to the mark.

With respect to sound, applicant concedes that "[t]here is a similarity in sound with the first syllable of the respective marks: however, the second syllable of each of Opposer's marks makes the phonetics readily distinguishable." (Brief, p. 13). Both STONFIL and STONEL are comprised of two syllables; the first syllable, STON-, is identical in sound. The second syllable of each respective mark, -FIL and -EL, although specifically different, sound similar. Phonetic similarity between marks can cause a likelihood of confusion, particularly where, as here, the marks may be referred to verbally. See *TBC Corp. v. Holsa, Inc.*, 126 F.3d 1470, 44 USPQ2d 1315, 1318 (Fed. Cir. 1997) (GRAND SLAM and GRAND AM); *Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd.*, 774 F.2d 1144, 227 USPQ 541, 543 (Fed. Cir. 1985) (HUGGIES and DOUGIES); *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) (THINKER TOYS and TINKERTOY); *Crown Radio Corp. v.*

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*Soundscriber Corp.*, 506 F.2d 1392, 184 USPQ 221, 222-23 (CCPA 1974) (SOUNDSCRIBER and CROWNSCRIBER); and *Vornado, Inc. v. Breuer Electric Mfg. Co.*, 390 F.2d 724, 156 USPQ 340, 342-43 (CCPA 1968) (VORNADO and TORNADO).

Each mark has no defined meaning in the context of the respective goods, although both may suggest a connection with stones. Given the nature of the goods, however, such suggestion does not render the marks anything less than inherently distinctive.

We find that the similarities between the marks STONFIL and STONEL and design outweigh the differences such that, when used in connection with related building materials, the marks engender sufficiently similar overall commercial impressions that confusion is likely to occur among purchasers in the marketplace.

The similarity between the marks STONFIL and STONEL and design weighs in favor of a finding of likelihood of confusion.

**THIRD-PARTY USES/REGISTRATIONS**

The sixth *du Pont* factor focuses on the number and nature of similar marks in use *on similar goods*. The Board has in the past given weight to evidence of widespread and significant use by third parties of marks containing elements in common with the mark being opposed on grounds of likelihood of confusion to show that confusion is not, in

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reality, likely to occur. The justification is that the presence in marks of common elements extensively used by others unrelated as to source may cause purchasers not to rely upon these elements as source indicators, but to look to other elements as a means of distinguishing the source of the goods/services. See, e.g., *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125, 1131 (TTAB 1995).

In the present case, applicant took testimony and introduced related exhibits (excerpts of third-party websites) regarding third-party uses of marks that begin with either STON- or STONE- for a wide variety of goods and services. On cross-examination, Mr. Jumppanen made several admissions: he was not familiar with the various entities; he had never personally visited the websites; he had never done business with any of the third parties; he knew nothing about the various businesses, whether they were active businesses or even if they were currently in business; and he did not know whether any of the third parties sold, among other things, mortar or grout.

The third-party uses include the following: Stonemor for cemetery and funeral services; Stonel for process networking and valve communications; Ston-O-Max for body sculpting and physical fitness; Stonco for commercial and industrial lighting; Stone Pro for abrasives and polishing

powders for masonry finishing; Stonemark for countertops; Ston Pro for rigging for entertainment stages; Stonemark for investment banking; StoneMill for log homes; StonePocket for landscaping; Stonepoints for masonry repair; Stoner for automobile polish; and Stoneco for highway gravel.

The uses relied upon by applicant are of little probative value in deciding the issue of likelihood of confusion. The problem with applicant's evidence on this factor is that none of the uses covers the types of goods involved in our analysis of likelihood of confusion. Third-party use on goods that are unrelated to those involved in this case is of little, if any, probative value. *See, e.g., Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("The relevant *du Pont* inquiry is '[t]he number and nature of similar marks in use on similar goods.'" (emphasis in original)).

Applicant's failure to demonstrate probative third-party uses of similar marks on similar goods renders this factor neutral in our analysis of likelihood of confusion.

#### **ACTUAL CONFUSION**

The absence of evidence of actual confusion is not dispositive in this case. A showing of actual confusion would of course be highly probative, if not conclusive, of a likelihood of confusion. The opposite is not true, however.

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The lack of evidence of actual confusion carries little weight. *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965). In any event, the record shows that applicant has made only two sales, both in the northwestern United States, of its brick panels (and no sales of bricks). Thus, it would appear that the opportunity for instances of actual confusion to have occurred in the marketplace has been minimal, if not nonexistent. See *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1847; and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Moreover, as often stated, proof of actual confusion is not necessary to establish likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 218 USPQ at 396.

Accordingly, the eighth *du Pont* factor of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion is considered neutral.

**CONCLUSION**

We find that the *du Pont* factors, on balance, weigh in favor of a finding of likelihood of confusion. We conclude that consumers familiar with opposer's "mortars" and "grouts" sold under the mark STONFIL would be likely to mistakenly believe, upon encountering applicant's mark STONEL and design for "bricks," that the goods originated

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with or are somehow associated with or sponsored by the same entity.

Lastly, to the extent that any of the points argued by applicant raises a doubt about our finding of a likelihood of confusion, we resolve that doubt, as we must, in favor of opposer as the prior user. See *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 218 USPQ at 395.

**Decision:** The opposition is sustained, and registration to applicant is refused.