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

Proceeding	91181621
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## **Corrective Description of the Record and Rebuttal of Les Pierres' Evidentiary Objection**

The undisputed evidence of record in this case is (i) StonCor's Notice of Opposition<sup>1</sup>; (ii) StonCor's fourteen<sup>2</sup> incontestable United States trademark registrations<sup>3</sup> for marks all commencing with the formative "STON..."; and (iii) Les Pierres application 76/650,832 for the mark STONEDGE.

The disputed evidence of record includes StonCor's testimony given during StonCor's rebuttal testimony period by StonCor's Vice President of Marketing and StonCor's Exhibits 1 through 28 as offered in evidence without objection<sup>4</sup> in the course of the StonCor testimony, together with a Les Pierres document identified as StonCor's Exhibit 43, all accompanying StonCor's testimony when filed. Les Pierres' counsel objected to StonCor's testimony during the course thereof as constituting improper rebuttal, but made no similar objection, nor any objection at all, at the close of StonCor's testimony.

The disputed evidence of record further includes printed and Internet dictionary excerpts attached to Les Pierres' brief. These materials were not made of record during Les Pierres' testimony period, when they could have been introduced via testimony or by a timely notice of reliance. The impropriety of admitting those those materials into evidence is the subject of a

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<sup>1</sup> The Notice of Opposition was offered in evidence without objection.

<sup>2</sup> As correctly noted by Les Pierres in footnote 2 of its Brief, StonCor inadvertently included StonCor's incontestable U.S. registration 1,306,662 for StonCor's mark STONCLAD-PT in StonCor's list of its registered incontestable marks being asserted against Les Pierres in StonCor's principal Brief. StonCor regrets the error and any inconvenience caused thereby. StonCor's incontestable U.S. registration 1,306,662 is not of record and has not been asserted against Les Pierres in this proceeding.

<sup>3</sup> MR. QUINN: Okay. We also stipulate that the StonCor registrations that were attached to the Notice of Opposition are of record and are in evidence as the –

MR. MENKER: I think the Board already said as much.

MR. QUINN: I believe that – I believe that's correct, but I just wanted to see, make sure that we're in agreement between the two of us to that effect. Okay?

MR. MENKER: Yup, I agree that the registrations are made of record

Pg. 7, ln. 1-13; transcript of StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>4</sup> Pg. 98 of StonCor's witness Mr. Jewell's rebuttal testimony.

pending motion by StonCor motion to strike Les Pierres' brief, or in the alternative the materials attached thereto, and is also addressed below in this reply brief.

Les Pierres did not make or file any motion to strike StonCor's testimony. In its Brief, Les Pierres restates its objection to StonCor's testimony as constituting improper rebuttal, but cites as the basis for its objection a rule relating to admissibility of notice of reliance evidence, not to admissibility of deposition testimony.<sup>5</sup> StonCor asserts that all of the testimony and documentary evidence submitted during StonCor's rebuttal testimony period was properly made of record and is relevant to the registrability issue. Accordingly, while the parties dispute the propriety of StonCor's testimony, in the absence of any motion to strike, StonCor's testimony and associated exhibits as filed are part of the evidentiary record.

StonCor hereby rebuts Les Pierres' objection and requests that all of the evidence, both testimonial and documentary, that StonCor submitted during StonCor's rebuttal testimony period be admitted, be given appropriate weight, and be fully considered in the course of this Board's deliberations in this matter.

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<sup>5</sup> Les Pierres' Brief does not include any motion to strike StonCor's testimony. The basis Les Pierres cites for its objection is TBMP 707.02(c), which relates to notice of reliance evidence; presumably this is a typographical error in Les Pierres Brief since the applicable provision is 707.03. In any event StonCor does not acquiesce to and objects to any exclusion of the evidence StonCor submitted during StonCor's rebuttal testimony period, as well explicated in StonCor's principal brief.

## Statement of the Issues

IS THERE LIKELIHOOD OF CONFUSION WHEN LES PIERRES' MARK CANNOT BE READILY DISTINGUISHED FROM STONCOR'S FAMILY OF "STON.." MARKS AND SEEKS REGISTRATION FOR HIGHLY RELATED GOODS -?-

IS IT PERMISSIBLE FOR LES PIERRES TO FOLLOW THE PROCEDURAL RULES WHEN THEY ARE TO LES PIERRES' ADVANTAGE, AND TO IGNORE THE PROCEDURAL RULES WHEN THEY ARE NOT -?-

## Summary of the Argument

LES PIERRES' MARK CANNOT BE READILY DISTINGUISHED FROM, AND THEREFORE IS LIKELY TO BE CONFUSED WITH, STONCOR'S FAMILY OF "STON ..." MARKS.

LES PIERRES INEQUITABLY FOLLOWS THE PROCEDURAL RULES WHEN THE RULES ARE TO LES PIERRES' ADVANTAGE, AND IGNORES THE PROCEDURAL RULES WHEN THEY ARE NOT.

## Argument

1. BECAUSE LES PIERRES' MARK SEEKS REGISTRATION IN CONNECTION WITH HIGHLY RELATED GOODS AND CANNOT BE READILY DISTINGUISHED FROM STONCOR'S FAMILY OF "STON..." MARKS, THERE IS NECESSARILY LIKELIHOOD OF CONFUSION WITH STONCOR'S FAMILY OF "STON..." MARKS, AS WELL AS WITH INDIVIDUAL MEMBERS OF THE STONCOR "STON..." FAMILY.

Considering only the undisputed evidence, the only reasonable conclusion is that StonCor's "STON..." marks constitute a legally cognizable family of marks that is entitled to protection<sup>6</sup>. Respecting StonCor's incontestably registered marks that StonCor has asserted against Les Pierres, for which the title and status copies of the registration certificates were attached to the Notice of Opposition and hence are unquestionably of record,

--All commence with the formative "STON".

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<sup>6</sup> *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460 (Fed. Cir. 1991)

--All are registered for closely related construction products.

--All have suggestive/descriptive suffixes.

--All are incontestable.

--All have been renewed.

--All have been in use since 1991 or earlier.

--All have between six and ten letters.

--All share the first part of registrant's corporate name StonCor.

Businesspersons invest in marks to build their brand, to assist customers and potential customers in identifying the business entity's products, and to distinguish the entity's products from those of others. American businesspersons are not spendthrifts. To the contrary, slashing costs, reducing payrolls and getting more work out of fewer persons has become the mantra of corporate America. Every responsible news outlet has reported that more than seven million jobs have been lost in this country in the current recession, mostly as a result of corporate "downsizing", which is no longer a new word in our lexicon. Everyday we read of another corporate merger that will purportedly reduce costs and thereby increase profits. Only in the small print, far down in the story or, more likely in a second story the following day, is it revealed that the cost reductions will come through layoffs. In this day and age and in this difficult economy, clearly businesspersons spend their money only when it will bring a reasonable, justifiable, and desirable return.

Unless this Board presumes that StonCor's managers are spendthrifts, which they are not, and for which there is no evidence, the only reasonable conclusion the Board can draw is that the marks in which StonCor has invested, has registered, and has chosen to assert against Les

Pierres<sup>7</sup>, constitute a legally recognizable family of marks with which there is a likelihood of confusion as respecting Les Pierres' mark such that registration must be refused. There is no other reasonable conclusion when a company spends tens, if not hundreds, of thousands of dollars over more than two decades to create, register, maintain, and police a group of marks all commencing with the formative "S T O N..", all being registered for construction products, and all sharing that formative with the first word of their owner's corporate name, StonCor.

Les Pierres errs by arguing that its mark is not confusingly similar to any of StonCor's individually registered marks and errs again in failing to address StonCor's family of marks. If Les Pierres' mark was not likely to be confused with StonCor's family of marks, Les Pierres' mark would be clearly distinguishable from StonCor's mark family. However, Les Pierres' mark is not. Les Pierres' mark fits into StonCor's family of marks like a hand fits in a glove. Lest there be any doubt in this, this Board must ask itself whether one of the following marks does not fit with the others:

**STONBLEND, STONCLAD, STONCREST,  
STONCRETE, STONEDGE, STONFIL,  
STONHARD, STONKOTE, STONLINER,  
STONLOK, STONLUX, STONPROOF,  
STONSEAL, STONSET, STONSHIELD**

It obviously takes considerable time and study to pick Les Pierres' mark out of the grouping. Requiring time and study to choose the allegedly registrable mark is conclusive evidence of likelihood of confusion and hence lack of registrability.

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<sup>7</sup> The asserted marks are not all of the "S T O N..." marks owned by StonCor. StonCor additionally owns U.S. registration 2,978,818 for the mark STONCHEM; U.S. registrations 3,694,310 and 3,700,433 for the mark STONTEC; U.S. registration 3,707,544 for the mark STONHARD; application 77/518,576 for the mark STONGLAZE; application 77/698,756 for the mark STONKLEEN; application 77/891,386 for the mark STONFLEX; and application 77/891,523 for the mark STONRES. StonCor further owns the presently unregistered mark STONCOR, and the trade names "Stonhard", "StonCor" and "StonCor Group".

The issue is not whether Les Pierres’ mark is distinguishable in sound or in appearance or in connotation from one or all of the StonCor marks taken individually. The issue is what would be the perception of a consumer when confronted with these marks<sup>8</sup>? The grouping above sets forth StonCor’s fourteen incontestably registered marks and Les Pierres’ mark, with the marks presented in alphabetical order. Upon looking at, or listening to, that grouping, a consumer certainly could not identify Les Pierres’ mark as being distinguishable from the fourteen StonCor marks.

As further evidence of this, below is a schematic presentation of the packaging and labels a consumer or prospective customer might encounter in seeking to purchase one or more products sold under any one of StonCor’s family of “S T O N...” marks, or Les Pierres’ product, when taking the product from a store shelf:

<b>STONKOTE</b>	<b>STONEDGE</b>	<b>STONFIL</b>	<b>STONLINER</b>	<b>STONSET</b>
Epoxy	Artificial stone	Mortar	Mortar	Grout
<b>STONKOTE</b>	<b>STONEDGE</b>	<b>STONFIL</b>	<b>STONLINER</b>	<b>STONSET</b>
Epoxy	Artificial stone	Mortar	Mortar	Grout
<b>STONKOTE</b>	<b>STONEDGE</b>	<b>STONFIL</b>	<b>STONLINER</b>	<b>STONSET</b>
Epoxy	Artificial stone	Mortar	Mortar	Grout
<b>STONKOTE</b>	<b>STONEDGE</b>	<b>STONFIL</b>	<b>STONLINER</b>	<b>STONSET</b>
Epoxy	Artificial stone	Mortar	Mortar	Grout

Anyone looking to purchase any of these products and confronted with the product packages lined up side-by-side, as schematically depicted above and as they typically would reside on a shelf in a Lowe’s or Home Depot or similar outlet, would certainly not distinguish Les Pierres’ mark and the product sold under that mark, as to its source of origin, from the StonCor marks and the products sold under those marks. Indeed, the marks blur together. The

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<sup>8</sup> *In re E.I. duPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A 1973)

only viable conclusion is that Les Pierres' mark is not distinguishable from the StonCor mark family in the minds of reasonable consumers<sup>9</sup>.

The following table summarizes those ones of StonCor's family of "S T O N..." marks that have been asserted against Les Pierres in the instant proceeding:

<b>MARK</b>	<b>FILING/FIRST USE DATE</b>	<b>RELEVANT GOODS</b>
STONHARD	10 April 1987	Multi-component mixtures of epoxies, curing agents and aggregates
STONCLAD	6 December 1989	Floors composed of resins, curing agents and quartz aggregates
STONKOTE	2 October 1989	Epoxy-resin for use in repair and renovation of existing buildings
STONBLEND	6 December 1989	Mortars
STONCREST	6 December 1989	Protective epoxy coatings
STONCRETE	16 January 1990	Cementitious anchoring and casting materials for use with masonry and concrete
STONFIL	2 January 1991	Trowelable and flowable mortars
STONLINER	6 December 1990	Mortars
STONLOK	17 January 1990	Liquid applied adhesives and admixtures for concrete or masonry surfaces
STONLUX	6 December 1989	Mortars
STONPROOF	21 December 1989	Multi-purpose epoxy-based sealants and polyurethane membranes
STONSET	6 December 1989	Three component epoxy-based grouts
STONSEAL	21 December 1989	Two-component polyurethane coatings
STONSHIELD	6 December 1989	Epoxy hardening

Initially, note the "mortars" for which several of the StonCor marks are registered. Les Pierres has asserted the none of StonCor's goods are related to Les Pierres' "precast decorative

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<sup>9</sup> The schematic presentation obviously principally concerns appearance and sound of the competing marks, but connotation of marks is also important and has been ignored in Les Pierres' brief. The connotation of Les Pierres' mark is unquestionably that of an edge or boundary. The same is true of StonCor's mark STONLINER, and to a lesser extent STONFIL. An "edge" inherently defines a boundary and any such "edge" is almost always defined by a "line". As a result, the boundary connotation of STONEDGE is highly similar to the line connotation of STONLINER.

stone” product. Anyone knows that stone is installed using mortar. The assertion that the parties’ products are unrelated is ridiculous.

The first part of a mark is normally the dominant portion of the mark. It is the first part of the mark one sees. The principal of primacy holds that first in sight is the first impression and is the most likely to be the most lasting impression. These marks commence with the two consonants “S” and “T” , which are surely the two most used, most powerful consonants in the English language. When these two consonants are paired together in sequence, as they are in all of StonCor’s asserted marks and in Les Pierres’ mark, and when they appear at the beginning of a mark, as they do in all of StonCor’s asserted marks and in Les Pierres’ mark, there is a synergistic effect, both visually and aurally, as respecting recognition and distinctiveness of StonCor’s marks vis-à-vis those of others. For Les Pierres to assert that “S T O N” is less distinct than the other portions of StonCor’s marks is flat out wrong.

Les Pierres assertion that there is a descriptive characteristic of the formative “S T O N...” and that this descriptive characteristic somehow militates against the finding of likelihood of confusion as respecting Les Pierres’ mark flies in the face of the incontestable status of all of StonCor’s marks. With all of the StonCor marks being registered and incontestable, those marks have conclusively acquired trademark status and cannot be denigrated as allegedly being descriptive, as Les Pierres has done. At most, many of the suffixes of the StonCor marks are suggestive of some of the excellent results that can be achieved using the products sold under those marks. A great example of this is the mark STONLUX, suggesting a luxurious result when the mortar and other products sold under the mark STONLUX is used. Similarly suggestive the is mark STONSET indicating that when grout sold under that mark is used to secure decorative precast stone or tile, that there will be a suggestion of having been set into stone. The same is

true of STONSHIELD, where the suggestion is that the epoxy sold under that mark, when hardened, will be a shield like a stone. For Les Pierres to aver that the suggestive nature of StonCor's trademark suffixes somehow militates against the marks being an enforceable family lacks basis and is contrary to common sense.

While Les Pierres might view that "S T O N" is not a recognizable trademark, the assertion has no basis in law. It is well established that the formative defining a family of marks need not be a trademark itself in order to sustain a family of marks<sup>10</sup>.

**2. IT IS FUNDAMENTALLY UNFAIR AND INEQUITABLE TO PERMIT LES PIERRES TO FOLLOW THE PROCEDURAL RULES WHEN THOSE RULES WORK TO LES PIERRES' ADVANTAGE, BUT TO PERMIT LES PIERRES TO IGNORE THE PROCEDURAL RULES WHEN THEY DO NOT WORK TO LES PIERRES ADVANTAGE.**

Les Pierres, taking advantage of the asserted procedural posture of this case, makes repeated assertions of absence of evidence that are overly self-serving, largely incorrect, ignores the undisputed evidence of record, and misstates StonCor's position. While contending that StonCor has no admissible evidence, as discussed below, Les Pierres ignores the procedural rules and applicable case law in attempting to sneak favorable evidence into the record via the back door. Les Pierres attempts this by requesting untimely exercise of judicial notice, after declining to place anything in the record during Les Pierres' period for permissible submission of evidence. This is improper, as set forth in more detail below.

By StonCor's count, Les Pierres asserts that "opposer has presented no admissible evidence" or substantially the equivalent of that assertion ten times in Les Pierres' brief.<sup>11</sup> What Les Pierres should have said is that because Les Pierres is eschewed professional courtesy when

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<sup>10</sup> *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984)

<sup>11</sup> Les Pierres' brief, pg. 9, lns. 16 and 19; pg 10, ln. 8; pg. 15, lns. 16, 18 and 21; pg. 15, lns. 8, 14 and 17; pg. 16, ln. 6.

StonCor's counsel was ill and was unable to take StonCor's testimonial evidence in support of StonCor's case-in-chief during the envelope for doing so, and since Les Pierres eschewed consenting to StonCor taking testimony once StonCor's counsel had recovered, and because Les Pierre argued vigorously twice against StonCor's motion to reopen the envelope for such testimony once StonCor's counsel had recovered, Les Pierres contends that it has precluded Stemcor from presenting any evidence. It was Les Pierres, not StonCor, that objected to reopening the testimonial period when StonCor's counsel had recovered. It was Les Pierres, not StonCor, that presented no testimony of its own in support of its case. It is Les Pierres, not StonCor, that has only its trademark application as evidence in this case. It is Les Pierres, not StonCor, that has ignored the statutory presumptions accorded to StonCor's incontestably registered and long-used trademarks STONBLEND, STONCLAD, STONCREST, STONCRETE, STONFIL, STONHARD, STONKOTE, STONLINER, STONLOK, STONLUX, STONPROOF, STONSEAL, STONSET, STONSHIELD. It is Les Pierres which, as the newcomer, should have all evidentiary inferences drawn against it<sup>12</sup>. It is Les Pierres, as the newcomer, that had the obligation to select a mark distinguishable from marks already on the register<sup>13</sup>, especially marks that have long been on the register and long ago became incontestable.

Les Pierres has misrepresented the undisputed evidence of record and StonCor's position in conveniently ignoring the statutory presumptions to which StonCor's incontestably registered marks are entitled.

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<sup>12</sup> *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984)

<sup>13</sup> *Planters Nuts & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 134 USPQ 504 (CCPA 1962)

As but one example, Les Pierre asserts that StonCor has not proffered any evidence “showing that its registered marks were used”<sup>14</sup> This ignores the provisions of 15 USC 1058 and 1059, pursuant to which all of StonCor’s marks had to be in use with the recited goods in order to be maintained and renewed.

Les Pierres contends that StonCor has failed to present any evidence that any of StonCor’s marks have connotations similar to STONEDGE. As noted above and as set forth on pages 16 through 19 of StonCor’s principal brief, the connotation of STONEDGE and the connotations of STONLINER, both denoting a boundary line or edge, are highly similar if not identical.

Les Pierres further asserts that the formative “S T O N...” as “the claimed family feature is a descriptive term”. This is not correct assessment of StonCor’s position. StonCor’s position is that the formative “S T O N...” is suggestive as respecting characteristics of the products sold under the various ones of StonCor’s “S T O N...” marks.

Les Pierres further mischaracterizes StonCor’s position by asserting that StonCor did not specifically compare any of its registered marks to the mark STONEDGE. This is incorrect. StonCor’s principal brief is full of comparisons as between STONEDGE and StonCor’s STONFIL, STONLOK, STONSET, STONLINER, and STONCRETE marks.<sup>15</sup>

Les Pierres argues at length as respecting absence of evidence that “precast decorative stone” is related to any of the goods sold under any of StonCor’s “S T O N...” marks. This is illogical and lacks credence. Any reasonable person knows that stone, whether precast or natural, decorative or functional, is installed and fastened in place using mortar. StonCor uses StonCor’s marks STONBLEND, STONLINER, STONFIL, and STONLUX for mortar, for

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<sup>14</sup> Pg. 9, ln. 17, Les Pierres’ brief

<sup>15</sup> Pp. 12-42, StonCor’s principal brief.

which those marks are registered, as set forth above and from such registration and use it is clear that StonCor sells mortar under StonCor's marks STONBLEND, STONLINER, STONFIL, and STONLUX. When one goes to buy precast stone, one must buy the mortar with which to install the precast stone. For Les Pierres to suggest that these two products are not closely related is wrong.

## **Les Pierres' Brief Fails to Comply With the Trademark Trial and Appeal Board Manual of Procedure (TBMP)**

### **1. Les Pierres' Request That the Board Take Judicial Notice is Improper.**

In their Brief, Les Pierres requests that the Board take judicial notice of four different dictionary definitions.<sup>16</sup> Judicial notice in this instance is improper because Les Pierres failed to submit its request, by notice of reliance during its testimony period, as required by the Trademark Rules of Practice ("Trademark Rules") §2.122 and the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") Section 704.12(b).<sup>17</sup>

The rules governing practice before the Trademark Trial and Appeal Board clearly state the need for a party to introduce all evidence to be entered by judicial notice during their testimony period. Specifically, Trademark Rule 2.122 provides, in relevant part that:

Printed publications, such as books and periodicals available to the general public in libraries or of general circulation, and official records, if competent evidence and pertinent to the issue, may be introduced in evidence by filing in the Patent and Trademark office a notice to that effect during the period for taking of the testimony of the party...<sup>18</sup>

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<sup>16</sup> See Les Pierres' Brief at pp. 10 n.3, 11 n.5, 15 n. 6.

<sup>17</sup> 27 CFR § 2.122(e); TBMP § 704.12(b).

<sup>18</sup> See sources cited *supra* note 2.

TBMP Section 704.12(b) also addresses the introduction of evidence through judicial notice:

The Board will take judicial notice of a relevant fact not subject to reasonable dispute, as defined in Fed. R. Evid. 201(b), if a party (1) requests that the Board do so, and (2) supplies the necessary information. *The request should be made during the requesting party's testimony period, by notice of reliance and accompanied by the necessary information.*<sup>19</sup>

In their Brief, Les Pierres requests that the Board take judicial notice of four different dictionary entries, attaching the proffered definitions as exhibits to their Brief.<sup>20</sup> Les Pierres' requests for the Board to take judicial notice of these definitions are clearly improper, as Les Pierres did not make a request during their testimony period to have the Board take judicial notice of these materials, nor did they submit a notice of reliance at any point in this litigation. It is clear that Les Pierres is trying to manipulate the rules by improperly waiting to introduce these materials until after their testimony period has closed, and insisting that StonCor is only entitled to a rebuttal period if Les Pierres presents evidence during their testimony period.

First, Les Pierres attempts to proffer portions of two of the nine definitions for the term "stone" found in the *Webster's II New Riverside University Dictionary (Webster's)* in support of their allegation that the prefix found in StonCor's family of marks, "S T O N...", is merely a descriptive term.<sup>21</sup> Not only would judicial notice be improper in this instance because of Les Pierres' aforementioned failure to submit a notice of reliance relating to these materials during its period for testimony, but Les Pierres has unilaterally chosen portions of two of the nine definitions provided in *Webster's*, and has requested that the Board take judicial notice only of

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<sup>19</sup> TBMP § 704.12(b), emphasis added.

<sup>20</sup> See *supra* note 1, pp. 10 n.3, 11 n.5, 15 n. 6, Exhibits A-C.

<sup>21</sup> See *supra* note 1, p. 10 n.3, Exhibit A.

the two proffered definitions Les Pierres selected.<sup>22</sup> By attempting to make the two proffered definitions a part of the record at this point in the litigation, after StonCor's period for rebuttal has passed, Les Pierres has inequitably deprived StonCor of the opportunity to fully respond to the function of the prefix "S T O N..." in its family of marks. Again, Les Pierres is improperly manipulating the rules of procedure to their advantage, and to the detriment of StonCor.

Les Pierres also requests that the Board take judicial notice of the definition of the term "floor", as found in the *Oxford English Dictionary, Second Edition, Volume V* ("*Oxford Dictionary*").<sup>23</sup> Again, Les Pierres failed to submit a notice of reliance relating to these materials during their period for testimony and again, they have chosen to proffer only one of the fifteen definitions provided in the *Oxford Dictionary*.<sup>24</sup> Les Pierres alleges that their proffered definition further supports their argument that the prefix found in StonCor's family of marks is merely descriptive.<sup>25</sup> It would, therefore, be similarly inequitable for the Board to take Judicial Notice of this definition at this late stage in litigation.

The Trademark Trial and Appeals Board specifically addressed the issue of attempting to use judicial notice to enter the proffered materials after the period for testimony and rebuttal has ended in *Litton Business Systems, Inc. v. J.G. Furniture Co.*, 190 USPQ 431 (TTAB 1976).<sup>26</sup> In *Litton*, the Board upheld a decision which dismissed a petition for cancellation of a trademark because the petitioner failed to present any evidence or testimony during its testimony period in support of its pleading that the respondent's mark was merely descriptive of the respondent's product. *Id.* at 432. In that case, the petitioner argued that it was appropriate for the Board to take judicial notice of a dictionary definition of a term used in the respondent's mark, in

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<sup>22</sup> See *supra* note 1, p. 10 n.3, Exhibit A.

<sup>23</sup> See *supra* note 1, p. 11 n.5, Exhibit "B".

<sup>24</sup> See *supra* note 1, p. 11 n.5, Exhibit "B".

<sup>25</sup> See *supra* note 1, p. 11.

furtherance of the petitioner's argument that the term was merely descriptive.<sup>27</sup> The Board agreed with the decision below, finding that "petitioner's request for judicial notice of critical facts is a belated attempt to stave off a judgment occasioned by its neglect in taking testimony."<sup>28</sup>

In *Litton*, the Board based its decision on the policy underlying Trademark Rule 2.132 relating to the failure of the plaintiff to take testimony. *Litton*, 190 USPQ at 433-34. The Board reasoned that the taking of judicial notice is mandatory only if requested by a party, and the party supplies the necessary information, namely, a proper notice of reliance under Trademark Rule 2.122(c)<sup>29</sup>; therefore, unless a party provides this notice during their testimony period as required, their opponent cannot properly refute the judicially noticed fact during their period for rebuttal. In *Litton*, the Board pointed out that a proper notice of reliance under Rule 2.122(c) allows the parties to "avoid the great loss of time that would be incurred if a party adverted to a fact to be judicially noticed for the first time in its brief at final hearing and the adverse party exercised its right to heard under Rule 201(e)."<sup>30</sup>

The same policy is applicable to the instant proceedings. Had Les Pierres served a proper notice of reliance during their testimony period, as they are required to do under the Rule 2.122(c), StonCor could have utilized its opportunity for rebuttal to argue against the Board taking judicial notice of the definitions. While Les Pierres is adamant about strictly adhering to the rules requiring that StonCor not be allowed to present evidence in rebuttal if Les Pierres presented no evidence during their period for testimony, they blatantly disregard the rules requiring that they introduce all evidence during their testimony period. Although it is true that

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<sup>26</sup> *Litton Business Systems, Inc. v. J.G. Furniture Co.*, 190 USPQ 431 (TTAB 1976).

<sup>27</sup> See *supra* note 11.

<sup>28</sup> See *supra* note 11.

<sup>29</sup> Noting that Trademark Rule 2.122(c) fulfills both requirements of Federal Rule of Civil Procedure 201(d) regarding judicial notice, which requires a party to serve notice of the request for judicial notice and to supply the necessary information.

StonCor, in the position of plaintiff in this matter, bears the burden of proof, the concepts of judicial economy and general fairness apply here just as they do in any case. In *Litton*, the Board asserted that the respondent, having to guess at whether the petitioner would attempt to support its *prima facie* case with judicially noticed facts after its testimony period had ended, would have been forced to put on potentially unnecessary testimony during respondent's testimony period – anticipating petitioner's next move, or else be deprived of their opportunity to respond.<sup>31</sup>

Although StonCor's period for testimony was closed before Les Pierres would have had to provide a proper notice of reliance, the fact that they did not do so deprived StonCor of their opportunity to respond to the judicially noticed materials within the testimony period. For all of the foregoing reasons it would be clearly inequitable for the Board to take judicial notice of the definitions proffered by Les Pierres for "stone" or "floor", while at the same time not allowing StonCor an opportunity to present evidence in rebuttal, which they would have been afforded the opportunity to do had Les Pierres proffered these materials when it was appropriate to do so.

Finally, Les Pierres requests that the Board take judicial notice of two definitions of the term "decorative stone", as found in an online dictionary.<sup>32</sup> These final two requests for judicial notice suffer from the same procedural deficiencies found in the first two requests for judicial notice, namely, Les Pierres again failed to submit a notice of reliance relating to the proffered materials during their period for testimony, making all of the foregoing argument against judicial notice equally applicable to these proffered definitions.<sup>33</sup> In addition, here, Les Pierres proffers the definitions of "decorative stone" in hopes of persuading the Board that their product has no

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<sup>30</sup> See *supra* note 11.

<sup>31</sup> See *supra* note 11, pp. 433-34.

<sup>32</sup> See *supra* note 1, p. 15 n.6.

<sup>33</sup> See *supra* note 1, p. 15 n.6.

overlap with StonCor's products.<sup>34</sup> Ironically, the implication of their argument is that the meaning of the term "S T O N..." or "S T O N E", as used in their proposed mark, does not fall within the definition of the term they seek the Board to take judicial notice of with respect to StonCor's family of marks. They argue that the use of "S T O N..." or "S T O N E..." in their proposed mark refers to products which are, "not a type of functional stone that could be used as floors or flooring systems," while at the same time arguing that the prefix "S T O N..." found in StonCor's family of marks, is merely a way of describing the "like a stone in hardness" quality of StonCor's flooring.<sup>35</sup> This not only underscores the likelihood of confusion between LesPierres proposed mark and StonCor's existing family of marks, but additionally emphasizes why it would be inequitable for the Board to take judicial notice of any of the definitions proffered by Les Pierres at this stage in the litigation.

Furthermore, while Les Pierres correctly notes that a Court may take judicial notice of a dictionary definition, they may only do so when the definition is found in a recognized authority.<sup>36</sup> Certainly, the Board cannot accept that "Answers.com" is a "recognized authority". Moreover, while Les Pierres cites *Syngenta Crop Prot., Inc. v. Bio-Chek, LLC*, for the proposition that online definitions taken from print publications may be judicially noticed by a court, the decision in *Syngenta Crop Prot.* makes it clear that the definitions must still "of the type that are not subject to reasonable dispute in that they are capable of accurate and ready determination by resort to sources whose accuracy cannot be reasonably questioned."<sup>37</sup> In

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<sup>34</sup> See *supra* note 1, p. 15.

<sup>35</sup> See *supra* note 1, p. 15.

<sup>36</sup> *Hancock v. American Steel & Wire Co.*, 40 C.C.P.A. 931, 934 (C.C.P.A. 1953) (finding that the court may always refer to "standard dictionaries or other recognized authorities").

<sup>37</sup> *Syngenta Crop Prot., Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112 (TTAB 2009).

*Syngenta* the Board chose to take judicial notice of the proffered online definitions which were “consistent with those in a more traditional reference source.”<sup>38</sup>

Les Pierres has attached print-outs from Amazon.com for the *Dictionary of Architecture and Construction* and the *Sci-Tech Dictionary*, urging that the definitions supplied by the “Answers.com” website can be found in those materials.<sup>39</sup> The “information about these publications,” Les Pierres attached to their Brief does not even provide the names of the entities that published the “dictionaries”.<sup>40</sup> Without presenting the names of the publishers, Les Pierres cannot argue that this information is “capable of accurate and ready determination.”<sup>41</sup>

## **2. Les Pierres’ Brief Fails to Comply with the Trademark Rules Requiring an Index of Cases.**

Les Pierres fails to include an index of cases in their Reply Brief, as required by the Trademark Rules and the TBMP. Trademark Rules 2.126 and 2.128(b) govern the requirements for the form and content of briefs filed with the Board.<sup>42</sup> Trademark Rule 2.128(b) states, in relevant part, that “each brief shall contain an alphabetical index of cases cited.”<sup>43</sup>

## **Summary of the Evidence and Prayer for Relief**

StonCor’s undisputed evidence includes 14 incontestable United States trademark registrations for marks commencing with the formative “STON”, from which Les Pierres’ mark cannot be readily distinguished.

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<sup>38</sup> See *supra* note 22. (noting that they were not taking judicial notice of an additional definition that they did not deem to fit this requirement).

<sup>39</sup> See *supra* note 1, p. 15, Exhibit “C”.

<sup>40</sup> See *supra* note 1, p. 15, Exhibit “C”.

<sup>41</sup> See *supra* note 1, p. 15, Exhibit “C”.

<sup>42</sup> See 37 CFR §§ 2.126-2.128(b); see also, TBMP § 801.03 (citing and reproducing same).

<sup>43</sup> 37 CFR § 2.128; TBMP § 801.03 (referring to the Trademark Rules and stating that “the brief must contain an alphabetic index of all cited cases”).

StonCor's disputed evidence includes the testimony of Mr. Michael Jewell, StonCor's Vice President for Marketing and Sales, and documentary exhibits, including third party surveys evidencing the high visibility and trade recognition of StonCor's "STON" marks, including STONFIL, STONLOK, STONSET and STONCRETE, and StonCor's house mark STONHARD.

Contrasting, Les Pierres presented no evidence in support of its position during its testimony period; the only evidence properly of record for Les Pierres' is the STONEDGE application as filed.

Because Les Pierres' mark cannot be readily distinguished from StonCor's family of "STON..." marks, there is necessarily likelihood of confusion with StonCor's family of "STON..." marks, as well as with individual members of the StonCor "STON..." family. For this reason and because it is impermissible for Les Pierres to follow the procedural rules only when they are to Les Pierres' advantage, registration for STONEDGE should be denied.

The law requires viewing the evidence most favorably for StonCor as the senior user/registrant/opposer. Les Pierres, having properly presented no evidence in the proceeding, and having only the application as filed in support of its position, should be denied registration for its mark that is indistinguishable from StonCor's family of "STON..." marks.

To the extent there is any fee required in connection with the receipt, acceptance and/or consideration of this brief and/or any accompanying papers, please charge all such fees to Deposit Account 50-1943.

Respectfully submitted,

Date: 19 February 2010

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**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

StonCor Group, Inc.	:	
	:	
Opposer	:	
v.	:	Opposition 91181621
	:	
	:	Application 76/650,832
	:	
Les Pierres Stonedge, Inc.	:	
	:	
Applicant	:	

**CERTIFICATE OF SERVICE**

I, Charles N. Quinn, of full age, by way of certification, state that a copy of StonCor's Principal Brief in Support of StonCor's Case-In-Chief with Appendices was served on applicant's counsel on the date set forth below via first class mail, postage prepaid, addressed as follows:

James R. Menker, Esquire  
Holley & Menker, P.A.  
P. O. Box 331937  
Atlantic Beach, FL 32202

Date: 19 February 2010

/Charles N. Quinn/  
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