

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: July 2, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Delaware Quarries, Inc.
v.
PlayCore IP Sub, Inc.

Opposition No. 91190282 to
Application Serial No. 77562077

Eric J Von Vorys of Shulman, Rogers, Gandal, Pordy & Ecker,
P.A. for Delaware Quarries, Inc.

Douglas T Johnson of Miller & Martin PLLC, for PlayCore IP
Sub, Inc.

Before Cataldo, Ritchie, and Hightower, Administrative
Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

PlayCore IP Sub, Inc. ("applicant") has filed an
application to register ROCKSCAPE in standard characters on
the Principal Register for "playground equipment, namely,
climbing units," in International Class 28.¹ On May 19,
2009, opposer Delaware Quarries, Inc. ("opposer") filed

¹ Serial No. 77562077, filed on September 4, 2008, under Section
1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona
fide intent to use the mark in commerce.

this opposition on the ground of priority and likelihood of confusion, pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) as to opposer's prior registered mark ROCKSCAPE, also in standard character format, for "stone, gravel or similar products, namely boulders, stone veneer, and crushed stone for use in landscaping, building construction, and paving," in International Class 19.² Applicant denied the salient allegations of the notice, and asserted several affirmative defenses, including that opposer's ROCKSCAPE mark, is "invalid as descriptive and was procured by fraud," (Answer at para. 16), as well as that it is "generic or descriptive and it lacks secondary meaning." *Id.* at para. 17.

Applicant further counterclaimed to cancel opposer's pleaded registration on the grounds that it was procured by fraud, that it is generic, and that, in the alternative, it is at least merely descriptive and has not acquired distinctiveness. Opposer denied the salient allegations of the counterclaim, adding, with regard to third parties identified as including the term "rockscape" in their name:

Opposer has corresponded with each of the companies identified in Exhibits 7 through 37 inclusive that are using the term ROCKSCAPE

² Registration No. 3166094, Registered October 31, 2006. Section 8 affidavit accepted.

improperly and is discussing appropriate ways in which said companies can rectify such use.

Of the 30 companies, over half have agreed that Opposer has rights in the ROCKSCAPE name and have ceased using the term in connection with their goods/services.

(Amended Answer to Counterclaim at "Affirmative Pleading" para. 2-3)

Both opposer and applicant have filed briefs on opposer's case-in-chief, and both have filed briefs on applicant's counterclaim.

The Record and Evidentiary Issues

The record consists of the pleadings; the files of the applications both for applicant and for opposer's pleaded registration in the counterclaim; and the following³:

1. The testimonial deposition of George R. Cannell, opposer's Director of National Sales, dated May 3, 2012.
2. The testimonial deposition of Thomas Robert Nordquist, applicant's Senior Vice President of Marketing, Product Development & Sales, dated February 15, 2011.
3. Applicant's several notices of reliance on
 - a. News, articles and websites, submitted to show that the term "rockscape" is generic or descriptive for applicant's identified goods.

- b. Definitions of various renditions of "rock," "scape," "rockscape" and related and similar words, for the same purpose.
- c. Opposer's responses to discovery, submitted to rebut opposer's allegations in opposer's case in chief, and to support applicant's allegations in applicant's counterclaim.
- d. Copies of registrations and some application files for registrations (and some applications not matured to registration) owned by applicant, by opposer, and by some third parties.

In its brief, applicant moves to strike Exhibit 2 of the Cannell deposition as well as testimony given therewith, on the grounds that Mr. Cannell has no personal knowledge of the document and therefore cannot testify thereto. The referred-to exhibit is a chart describing the status of cease and desist letters sent out by opposer, and the responses received. (Cannell depo. at 8, and Ex. 2) ("It is a summary of the responses to the letters that we sent to companies that were infringing on our trademark, Rockscape."). Mr. Cannell testified that he did not personally create the chart. *Id.* at 14 ("This document, I

³ As noted in applicant's brief, opposer's notices of reliance submitted on June 8, 2012 were stricken from the record by Board

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believe, was prepared by our attorney, who handles our trademark matters.”). He also testified that he did “not recall” personally being involved with any of the dialogue with any of the alleged infringers, having looked at any of the allegedly infringing websites, or having checked whether in fact they had been rectified. *Id.* at 13-15. Accordingly, while we overrule the objection and find that Mr. Cannell has attested to what the document says on its face, we will accord it such limited probative value as it may have, taking into account that he did not personally attest to any of the facts therein.

Priority and Standing

As a result of opposer’s submission of a copy of its pleaded ROCKSCAPE registration with its notice of opposition (which registration also appears elsewhere in the record), opposer has established its priority as well as its standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) and *King Candy Co. v. Eunice King’s Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Applicant, conversely, has standing in the counterclaim by virtue of being the defendant in this

Order dated September 14, 2012 as being untimely.

opposition. See Trademark Act Section 14, 15 U.S.C. § 1064; see also *See Cunningham v. Laser Golf Corp., supra.*

I. Opposer's Case-in-Chief

LIKELIHOOD OF CONFUSION

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the relevant, probative evidence in the record. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks"). We consider all of the *du Pont* factors for which there was evidence and argument. The others, we consider to be neutral.

We first consider the similarity or dissimilarity of the marks, which look and sound identical. There is little dispute that the commercial impression and connotation of the term "rockscape" would be highly similar when applied to playground climbing walls as when applied to actual stones, boulders, and similar products used in landscaping, building, and paving, *i.e.*, giving the impression of a landscape of rock. Accordingly, we find that this *du Pont* factor favors a finding a likelihood of confusion.

We turn then to an analysis of the similarity or dissimilarity of the goods and the channels of trade. We note that for this, opposer relies entirely for its argument of relatedness on the testimony of applicant's witness, Mr. Nordquist.⁴ The Nordquist deposition does indicate in a few places that applicant's playgrounds are intended to emulate the look of real rock. ("[T]he general colors that - that those products are available in tend to be a granite or a - we call it stone, or an earth color, as well as a metal color.") *Id.* at 46 and Ex 3. He also refers to the "natural slate texture" of the product, *id.* at 47, saying "it's sort of a cross between a real rock and a piece of playground equipment." *Id.* at 48; it's "a

⁴ We note again that opposer submitted notices of reliance, which have been excluded from the record for untimeliness.

climbing component that is themed to look more natural.”
Id. at 49. In addition to admitting that applicant’s ROCKSCAPE products are themed to look more or less like natural rocks, Mr. Nordquist admitted that they may be placed in such a way that they could be integrated with landscaping, including landscaping with stones, paving, and gravel. Nevertheless, Mr. Nordquist testified that neither he, nor his competitors sell stone, gravel, or boulders.
Id. at 22.

We find from this testimony that while there may be some tangential relationship between the playground climbing units identified by applicant and the stone and related products used in landscaping, building, and paving, as identified by opposer, the nature of that relationship, if any, is not sufficiently clear to us. As our primary reviewing court has noted, we must not base a finding on a mere possibility of likelihood of confusion. *See Bongrain Int’s (Amer.) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987). Rather, the evidence must show at least a viable relationship between the goods, which opposer has not done. Similarly, there is no evidence that the goods will travel in the same or similar channels of trade in a manner that consumers will be likely to confuse their source. Accordingly, we find

that these *du Pont* factors weigh against finding a likelihood of confusion.

We next consider the conditions of sale and classes of consumers. Applicant asserts, in this regard, that applicant rarely sells to individuals:

Typical buyers would include municipalities, counties, federal government, national parks, et cetera, as well as some small communities; it could be, you know, mayors or park and recreation directors that would be representing that city or county; public and private schools.
(Nordquist depo. at 12)

Mr. Nordquist also testified that applicant's ROCKSCAPE climbing components cost between \$1500 and \$5000, just for the one component, not including the rest of the playground equipment, which could run in the "50 to \$75,000 range." *Id.* at 22, 39, and Ex. 4. We find that these are not the types of goods that consumers will buy on impulse, and that the classes of consumers who purchase these are likely to do so after some amount of forethought. Accordingly, we find this *du Pont* factor to weigh against finding a likelihood of confusion as well.

Finally, applicant has asked us to consider the relative weakness of opposer's pleaded mark and the number and nature of third party uses.⁵ In particular, as alleged

⁵ We note that the parties did discuss that there is no actual confusion. Without further ado, as both parties agree there has

in the counterclaim with its grounds of genericness and descriptiveness discussed *infra*, applicant alleges that the term "rockscape" is very weak for opposer's identified goods. Applicant further alleges that multiple parties are using the term in their own marks, and set forth both in the counterclaim and with its notices of reliance a number of third party uses of the term "rockscape" for landscaping of stones and rocks. Opposer acknowledges in its brief that there are "23" identified other users and says that, per Exhibit 2 of Mr. Cannell's deposition, 16 of these (or "70%" according to opposer) have been identified as having agreed to stop use of the mark. (see opposer's brief at 12).

First, as discussed above regarding the evidentiary objection to Exhibit 2, although we have not struck the exhibit, neither do we accord it much probative value. Mr. Cannell did not attest to having created the exhibit, nor to having any personal knowledge of its content. (Cannell depo. at 13-15). He did "not recall" whether he had ever looked at any of the third party websites or had checked to see whether in fact they had ceased use of the "rockscape" term. *Id.* Accordingly, we have no actual testimony on

been no actual confusion, we find that *du Pont* factor, and the other *du Pont* factors not specifically discussed herein, to be

this point. Second, even if we were to accept Exhibit 2 on its face and accept opposer's argument, a "70%" policing success rate nonetheless leaves 7 unauthorized uses of its mark, which is notable. We find that the number and nature of uses of the term "rockscape" as a mark weighs against finding a likelihood of confusion.

Conclusion on Opposer's Likelihood of Confusion Claim

In conclusion, we find that although the marks are identical and would be likely to give the same commercial impression, opposer has not carried its burden of showing a viable relationship between the goods or that they would travel in the same or similar channels of trade. With sophisticated, institutional consumers buying applicant's more expensive product, the likelihood of confusion further diminishes. Finally, we have found that with a large number of third parties using the term "rockscape" for similar products, opposer's mark is weak. On the balance, we find no likelihood of confusion, and the opposition is dismissed.

II. The Counterclaims

We next consider the counterclaims raised by applicant.

neutral.

GENERICNESS

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods and/or services. *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986) ("Ginn"); *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Generic terms are by definition incapable of indicating a particular source of the goods and/or services, and cannot be registered as trademarks and/or service marks; doing so "would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are." See *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987).

In an inter partes proceeding, a party must prove genericness by a preponderance of the evidence. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1554 (Fed. Cir. 1991). *Tea Board of India v. Republic of India, Inc.*, 80 USPQ2d 1881, 1887 (TTAB 2006). The critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question. *Ginn*, 228 USPQ at 530. Making this determination "involves a two-step inquiry: First,

what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" *Id.* Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. *Merrill Lynch*, 4 USPQ2d at 1143, and *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

Turning to the first inquiry, although the parties did not specifically set out the genus of goods, they both generally treat opposer's identification of goods as the genus in their discussion: "stone, gravel or similar products, namely boulders, stone veneer, and crushed stone for use in landscaping, building construction, and paving." We agree that this is an appropriate designation of genus. *See Magic Wand Inc. v. RDB Inc.*, 19 USPQ2d at 1552. *See also In re Country Music Association Inc.*, 100 USPQ2d 1828 (TTAB 2011).

Next we must determine how the relevant public understands this genus. Applicant submitted dozens of websites showing third party uses of the term "rockscape" in the context of garden landscaping with rocks, stones, and related products. Some examples include the following:

Construction Dir: Rockscape Company: Marenakos
Rock Center: Offers new materials as well as
design and construction.
www.constructiondir.com. TTABVUE #38 p52/225

Rockscapes International: Providing unparalleled
craftsmanship and expertise in the rockscape
industry. Rockscapes International has worked
with landscape architects and developers to turn
their design ideas into practical, functional
water features using natural rock and/or rock
cast from molds, cast-in-place, and tooled rock
formations. www.rockscapesinternational.com.
TTABVUE #38 p58/225.

Pacific Rockscape: Rockscapes: Replicating nature
with hand carved rockwork. Over the years, our
team has installed artistic landscapes,
rockscapes, artificial waterfalls and water
features for architects and home owners alike.
www.pacificrockscape.com. TTABVUE #38 p62/225.

Reed: Concrete Pumps & Guniting Machines:
Rockscapes are made with either wet or dry
shotcrete. Reedmfg.com. TTABVUE #38 p64/225.

Creative Land Design: Rockscaping: Welcome to the
Creative Land Design Rockscaping photo gallery.
The pictures you see above are all photos of rock
gardens that we have created in the Maryland area
over the last 25 years. . . . Please browse our
pictures of Maryland Rockscapes below, and end E-
mail us with any comments that you have.
creativelanddesignmd.com. TTABVUE #38 p70/225.

Green Lizard Landscapes LLC unique rockscapes,
which make our client's properties the envy of
the neighborhood. [sic] We meet with our
clients, get a feel of their likes, dislikes and
landscape tastes and transpose their dreams into
realities. [url cut off] TTABVUE #38 p72/225

Backyard Jungle: Tampa Bay, FL Rockscape
Installation: Backyard Jungle Tropical Landscape
LLC provides the latest in rockscape installation
options to the Tampa Bay, FL area. We install
rock gardens, drought-resistant landscaping and

more. Palmharborlandscaping.com. TTABVUE #38 p79/225.

Landscape Productions: Mulch and Rockscape: Mulch and decorative rocks complete the look of all landscape projects. We offer a wide variety of landscape rock including river rocks, buff limestone, red limestone, granite, and purple quartz. www.landscapeproductionsllc.com. TTABVUE #38 p83/225.

Authentic Rockscape Designers: Artificial Rock Waterfalls For Landscape & Swimming Pools www.authenticrockscs.com. TTABVUE #38 p89/225.

Rock Walls & Landscaping: Wise Rockscapes Landscape Solutions: Why not explore the possibility of a rockscape or timber retaining wall to add that new spectacular feature for your backyard. www.wiselandscapeolutions.com. TTABVUE #38 p93/225.

Natural Rock: Residential Projects: Throughout the past 23 years, Natural Rock Formations has gained a unique reputation among homeowners. We are not your typical rockyard. If you want to plan a rock garden, or other custom designed rockscape, we can point you in the right direction. www.natrok.com. TTABVUE #38 p96/225.

Chris' Yard Detail & Hauling: There is NOTHING like a beautiful waterscape or rockscape to compliment your yard or garden. Constructed mostly of natural materials, waterscapes and rockscapes greatly add to the aesthetics and value of your property. www.chrisyarddetail.com. TTABVUE #38 p104/225.

Star Nursery: Achieving a Beautiful Rockscape: Are you considering adding a rockscape in your yard? If so, there are several important issues and detail to consider during your planning phase. Probably the first is to DO ADEQUATE PLANNING. Determine the minimum amount of rock that you will need. www.starnursery.com. TTABVUE #38 p112/225.

AZ Rock Scape & Lawn Care: Welcome . . . We have over 15 years of Yard Maintenance and Rockscape experience. We understand the enjoyment that comes from a nicely manicured and beautifully kept yard. [url cut off] TTABVUE #38 p115/225.

Sierrascape Landscaping: Rockscapes: Rockscape Design and Construction: Perhaps nothing is more beautiful in a landscapngn [sic] environment than the use of stone. From stonewalls, dry river beds, paved paths, flagstones and boulders the use of stone in a landscape design and installation can be truly magnificent. Sierrascape Landscaping are experts in the use of the best type of stone from pebbles to boulders to paving for your budget and to create a truly stunning landscape installation using rockscape. [url cut off] TTABVUE #38 p118/225.

Artistic Waterways & Paving Stone:
Landscapes/Rockscapes/Waterways/Paving
Stone/Commercial & Industrial Paving
Applications: Artistic Waterways & Paving by
Gonzalez Rockscapes create artificial, yet,
natural looking rockscapes that become the focal
point of YOUR landscape!
www.artisticwaterways.com. TTABVUE #38 p131/225.

Breese Landscaping Landscape Design Phoenix: Full backyard landscape redesign from grass to Granite and Rockscape in Mesa. This was a Mesa, Az Landscape grass conversion to the granite and rockscape you see. *Breeselandscaping.com*. TTABVUE #38 p141/225.

Concrete Ideas: Usually working with a design element similar to that of the natural surroundings a properly crafted rockscape should blend in and flow seamlessly with its surroundings. *http://concreteideas.com*. TTABVUE #38 p201/225.

Take Advantage of Native Stones to Rockscape Yard: When the summer sun sends the average gardener to the shady confines of the gazebo (or worse - indoors), it allows a moment to see the

total landscape picture, rather than the demands of the individual plantings. It was during one of those sultry moments that my wife decided we needed to do something with all of nature's "misplaced" rocks to make them fit into the balance of the rest of the gardens and lawn. We needed to do some rockscaping. *The Morning Call*; July 22, 1990 (Articles.mcall.com). TTABVUE #38 p213/225.

Cerritos: Rockscape Planned at Freeway Entrance: Work is under way on an \$866,000 landscaping project for the entrance to the Artesia Freeway (91) at Cerritos Towne Center. . . . The work, by Valley Crest Landscape Inc. of Santa Ana, includes a 15-foot decorative rockscape, three tiers of ponds and 15-foot waterfalls and geysers. *Los Angeles Times Community Digest* November 19, 1992 (articles.latimes.com). TTABVUE #38 p217/225

We find that these uses clearly establish that the term "rockscape" would be understood by the relevant public as a generic term to mean "stone, gravel or similar products, namely boulders, stone veneer, and crushed stone for use in landscaping, building construction, and paving."

Applicant also submitted dictionary definitions of the following terms to support its claim of genericness.

-scape: view; pictorial representation of a (specified) type of view. Merriam-Webster Unabridged *Unabridged.merriam.webster.com*.

Rock: 2a: extremely hard dense stone; a large fixed stone; 3a: something that resembles a rock in firmness *Unabridged.merriam.webster.com*.

Rockscape: a landscape dominated by rocks *www.definition.of.net* (2012).

Opposer objected to the definition of "rockscape" as not being from an established dictionary. While we accept the definition, we accord it more limited probative value, taking into account the limitations noted by opposer of evidence from unestablished dictionary sources. As such, while we find that the definitions buttress applicant's case, we would reach the same conclusion without them. Opposer's mark is generic for the goods for which it is registered.

Conclusion on Counterclaims

Based on a preponderance of the evidence, we find the term "rockscape" to be generic for "stone, gravel or similar products, namely boulders, stone veneer, and crushed stone for use in landscaping, building construction, and paving." Inherent in our finding of genericness is that opposer's mark is merely descriptive, and is, indeed, highly descriptive. "The generic name of a thing is in fact the ultimate in descriptiveness." *H. Marvin Ginn Corp., supra*, at 530. Opposer has not claimed acquired distinctiveness and has not introduced any evidence or argument in that regard.

Therefore, to the extent our finding of genericness is appealed, we also find opposer's mark to be highly descriptive without a showing of secondary meaning.⁶

Decision: Opposer's likelihood of confusion claim is denied, and the opposition is dismissed. Applicant's counterclaim is granted on the ground of genericness and alternatively on the ground that opposer's mark is highly descriptive without a showing of secondary meaning.

Applicant's application will proceed to publication in due course.

Opposer's registration will be cancelled in due course.

⁶ With these findings, we see no need to address applicant's fraud claim.