

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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Mailed: February 28, 2012

Opposition No. 91190420

Ston Cor Group, Inc.

v.

Cupa Materiales, S.A.

**Before Zervas, Wellington and Shaw,
Administrative Trademark Judges**

This matter comes up for consideration of applicant's motion (filed November 2, 2010) for judgment under Trademark Rule 2.132(b). The motion is fully briefed.

On May 27, 2009, opposer filed a notice of opposition against application Serial No. 77298626 for the mark STONEPANEL CUPA (in stylized form) alleging priority and likelihood of confusion. The opposed mark is reproduced below:



stonepanel
cupa

STONEPANEL is disclaimed and the colors orange and gray are claimed as a feature of the mark. The following goods and services are opposed:¹

"Non-metallic building materials, namely, plastic pipe supports; rigid pipes, not of metal; asphalt, pitch and bitumen-based roofing sealants, portable non-metal buildings; monuments of stone, monuments of marble" in International Class 19;

"Building construction services, construction and repair of buildings, installation services of building scaffolds and working and building platforms" in International Class 37.

Underlying its claim of priority and likely confusion, opposer has pleaded and attached to its notice of opposition status and title copies of fifteen of its registrations for marks in typed form and which all begin with STON for, what opposer characterizes as "a variety of grouts, cementitious anchoring and casting materials for use with masonry and concrete; mortars, namely epoxy resin-based mortars for use in industrial and institutional applications; mortars, including mutli [sic]-component mortars for use in industrial and institutional applications; polymer modified mortars; mortars for filling voids in horizontal services; waterproof and cementitious block fillers and coatings; gel

¹ The services in International Class 42 are unopposed.

mortars; trowelable and flowable mortars." *Opposer's Response filed August 8, 2011 ("Opposer's Response")*, p. 4:

- 1) Registration No. 1306662: STONCLAD-PT;
- 2) Registration No. 1487280: STONHARD;
- 3) Registration No. 1645258: STONCRETE;
- 4) Registration No. 1655954: STONLOK;
- 5) Registration No. 1687420: STONLUX;
- 6) Registration No. 1688593: STONLINER;
- 7) Registration No. 1689713: STONSHIELD;
- 8) Registration No. 1691045: STONSET;
- 9) Registration No. 1697228: STONKOTE;
- 10) Registration No. 1697229: STONPROOF;
- 11) Registration No. 1697230: STONSEAL;
- 12) Registration No. 1703299: STONFIL;
- 13) Registration No. 1706070: STONCLAD;
- 14) Registration No. 1712857: STONBLEND;
- 15) Registration No. 1740723: STONCREST.

Opposer's testimony period, as reset, closed on September 30, 2010. Opposer did not submit any evidence or testimony. Thus, the only evidence introduced by opposer are the status and title copies of its fifteen pleaded registrations submitted with the notice of opposition. See Trademark Rule 2.122(d)(1).

Applicant seeks judgment under Trademark Rule 2.132(b) which states:

(b) If no evidence other than a copy or copies of Patent and Trademark Office records is offered by any party in the position of plaintiff, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground that upon the law and the facts the party in the position of plaintiff has shown no right to relief.

Applicant argues that "both the marks and goods [of the parties] are different enough that [opposer] had a burden of submitting evidence of a reasonable likelihood of confusion during its testimony period, which it failed to meet." *Applicant's Motion filed November 2, 2010* ("Applicant's Motion"), p. 3.

Opposer responded to the motion asserting that the parties' marks and the goods under those marks are sufficiently similar to allow this proceeding to move forward.²

In considering the nature of the marks and the goods and services at issue, we find that the pleaded registrations of record, without more, do not make out a *prima facie* case of likely confusion vis-à-vis the applied-for mark.

With respect to the marks, opposer argues that based on the disclaimed portion of applicant's mark, i.e., STONEPANEL, applicant's mark, as a whole, is confusingly similar to "the individual marks and the family of marks

pleaded by the [o]pposer." *Notice of Opposition*. To the extent that opposer relies on "a family of ... 'STON' marks" as a basis for its claim of likely confusion, *Opposer's Response*, p. 1, we note that opposer cannot simply rely on its pleaded registrations to establish that it has a family of marks. Testimony and/or evidence beyond registration evidence is required to establish such a family of "STON" marks and that is lacking here. See *J&J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462-63, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) (to establish a family of marks, it is "necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin"). Inasmuch as we cannot find that opposer owns a "Ston-" family of marks, there is no point in considering any similarity between such a family and applicant's proposed mark.

In considering whether there is any similarity between opposer's registered marks, on an individual basis, with applicant's proposed mark, we note that in its opposition to applicant's motion, opposer points to six of its marks which it believes are most similar to applicant's mark in connotation: "'STONEPANEL' has the same connotation as [opposer's] 'STONSHIELD'". Both connote walls, or panels, or

² Opposer did not move to reopen its testimony period so that it

shields, made of stone. Moreover, one can find the connotation of 'STONEPANEL' to also be that of a hard panel, similar to the connotation of [opposer's] house mark 'STONHARD'. Similar arguments hold for [opposer's] marks 'STONPROOF', 'STONCLAD', 'STONCLAD-PT', and even [opposer's] mark 'STONLINER'." *Opposer's Response*, pp. 3-5.

The only arguable similarity between applicant's mark and any of opposer's marks is the STONE and STON- elements of the marks which may or may not be perceived by consumers as describing or suggesting a "stone" feature or purpose of the goods themselves. Even if the STON and STONE elements suggest a stone feature, opposer has not established that the appearance, sound, connotation and commercial impressions of the marks are similar based on the marks alone in view of the additional elements of each mark; the dissimilar elements of the respective marks serve to distinguish the parties' marks in terms of appearance, sound, connotation or commercial impression. Accordingly, based on the registrations alone, we do not find any of opposer's marks similar to applicant's mark.

Opposer's goods are clearly not identical, or even similar on their face, to applicant's goods and services and opposer does not argue otherwise. Rather, opposer contends that its goods are related to applicant's goods because they

could file additional evidence.

are "well suited for use in installing and repairing [applicant's] products." *Opposer's Response*, p. 4.

However, opposer's assertion that its goods are somehow complementary or may be used in conjunction with applicant's goods is not supported by any evidence. Indeed, it is not apparent to us that opposer's goods are particularly well suited for installing and repairing the types of goods encompassed by applicant's application and we do not find an otherwise obvious relationship between the goods so as to obviate the need for evidence or testimony. Where, as here, the goods are different and their relatedness is not readily apparent, it is incumbent upon opposer to demonstrate, through testimony and evidence, that its goods are so related to applicant's goods and services as to cause a likelihood of confusion. The Board will not, from the face of the asserted registrations and applicant's application, presume that the goods "are intended for the same or similar uses or are conjointly used, ... or that other facts exist which would show that they are commercially related in character." *Dura Corporation v. Mead Specialties Company, Inc.*, 152 USPQ 513, 515 (TTAB 1966). Where "the goods recited in the subject application and in opposer's registration are obviously different, the registration, *per se*, is manifestly insufficient to establish a *prima facie* case and to shift the burden of going forward to applicant."

Id. The same holds true in regards to opposer's goods and applicant's services and it is telling that opposer does not even address applicant's services in its opposing brief which we view as a concession by opposer that there is no likelihood of confusion between opposer's goods and applicant's services based on the evidence of record, i.e., the pleaded registrations.

In sum, the parties' marks are dissimilar and the relationship, if any, between opposer's goods and applicant's goods and services is not apparent from the pleaded registrations. Accordingly, judgment is hereby entered against opposer under Rule 2.132(b) and the opposition is **DISMISSED with prejudice**. See *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990).

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