

ESTTA Tracking number: **ESTTA409155**

Filing date: **05/13/2011**

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

Proceeding	91194599
Party	Plaintiff StonCor Group, Inc.
Correspondence Address	CHARLES N QUINN FOX ROTHSCHILD LLP 747 CONSTITUTION DRIVE, SUITE 100 EXTON, PA 19341-0673 UNITED STATES cquinn@foxrothschild.com
Submission	Other Motions/Papers
Filer's Name	CHARLES N. QUINN
Filer's e-mail	cquinn@frof.com, ipdocket@frof.com, dmcgregor@frof.com
Signature	/CHARLES N. QUINN/
Date	05/13/2011
Attachments	13 MAY 2011 STONCOR_REPLY_TO_METROFLOR_S_ANSWER_TO_STONCOR_S_SUMMARY_JUDGMENT_MOTION.pdf (9 pages)(63871 bytes)

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

StonCor Group, Inc.	:	
	:	
Opposer	:	Opposition No.: 91194599
	:	
v.	:	Application No.: 77/795,684
	:	
Metroflor Corporation	:	Mark: TEKSTONE
	:	
Applicant	:	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

**STONCOR’S REPLY TO METROFLOR’S RESPONSE TO STONCOR’S MOTION
FOR SUMMARY JUDGMENT AND STONCOR’S ANSWER AND OBJECTION TO
METROFLOR’S MOTION FOR SUMMARY JUDGMENT**

StonCor Group, Inc. (“StonCor”) hereby (i) replies to Metroflor’s Response to StonCor’s Motion for Summary Judgment, and (ii) answers and objects to Metroflor’s FRCP 56(f)(1) Motion for Summary Judgment.

Background

StonCor moved for summary judgment on 22 April 2011. In support of its motion, StonCor submitted a declaration of Mr. Michael Jewell, Vice President for Product Development for StonCor, a copy of Metroflor’s responses to StonCor’s first set of interrogatories, and a page from Webster’s New Collegiate Dictionary.

Metroflor responded to StonCor’s Motion on 3 May 2011, submitting a short argument signed by Metroflor’s counsel. Metroflor’s response was unaccompanied by any evidentiary materials such as a declaration or a response to discovery requests.

The Record

The declaration accompanying StonCor's summary judgment motion averred likely confusion as between StonCor's registered mark STONTEC and TEKSTONE. StonCor's Mr. Jewell asserted that Metroflor's mark TEKSTONE is similar in appearance¹ to StonCor's mark STONTEC, that the marks TEKSTONE and STONTEC are highly similar in sound², and that TEKSTONE and STONTEC are identical in connotation³.

The StonCor declaration confirmed that Metroflor seeks registration of TEKSTONE for "vinyl floor tile" and that StonCor's STONTEC, U.S. registration 3,700,433, is for "... vinyl flake decorated and colored floors ..."⁴. The declaration further confirmed that Metroflor's application for registration of TEKSTONE does not limit the trade channels in which Metroflor's "vinyl floor tile" is sold⁵.

In responding to StonCor's motion, Metroflor argued that StonCor "has not provided a sound basis for likelihood of confusion and has not shown one single instance⁶ of actual confusion"⁷. Metroflor argued, but presented no supporting evidence, that "[R]eversing the formatives of the mark STONTEC and then adding an 'E' after the 'N' to obtain TEKSTONE

¹ ¶ 5, StonCor's Jewell Declaration. Similarity in appearance alone is sufficient to find likelihood of confusion. *Weiss Associates Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A., v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Ava Enterprises, Inc. v. Audio Boss USA, Inc.*, 77 USPQ2d 1783 (TTAB 2006); *In re Lamson Oil Co.*, 6 USPQ2d 1041 (TTAB 1987).

² ¶ 6, StonCor's Jewell Declaration. Similarity in sound alone is sufficient to find likelihood of confusion. *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960 (TTAB 1980); see also *Molenaar, Inc. v. Happy Toys, Inc.*, 188 USPQ 469 (TTAB 1975) and *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963).

³ ¶ 7, StonCor's Jewell Declaration. Similarity in connotation alone is sufficient to find likelihood of confusion. *United Rum Merchants Ltd.*, 216 USPQ 217 (TTAB 1982); *H. Sichel Sohne, GmbH v. John Gross & Co.*, 204 USPQ 257 (TTAB 1979); *Procter & Gamble Co. v. Conway*, 164 USPQ 301, 304 (CCPA 1970); *Hancock v. The American Steel & Wire Co. of New Jersey*, 97 USPQ 330 (CCPA 1953).

⁴ ¶ 8, StonCor's Jewell Declaration.

⁵ ¶ 9, StonCor's Jewell Declaration. In the absence of any stated limitation on trade channels, Metroflor's vinyl floor tile is presumed to move in all channels of trade that would be normal therefor and to be purchased by all potential customers thereof. *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

⁶ The issue is not actual confusion, as erroneously contended by Metroflor; the issue is likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

⁷ Pg. 1, ln. 13-14, Metroflor's Response to StonCor's Summary Judgment Motion.

shows likelihood of confusion with the resulting conversion⁸” and that “[M]erely reversing the order of the formatives in the mark STONTEC and adding an ‘E’ after the ‘N’ to obtain TEKSTONE does not demonstrate likelihood of confusion with the resulting conversion”⁹.

StonCor’s Compliance with FRCP 56 and Metroflor’s Non-Compliance

StonCor has the burden of demonstrating absence of any genuine issue of material fact such that StonCor is entitled to judgment as a matter of law. StonCor met its burden by submitting evidence, and there is no contrary evidence to support Metroflor’s position.

StonCor supported its motion with a declaration and other evidence establishing similarity in appearance, sound and connotation of STONTEC and TEKSTONE. The STONTEC and TEKSTONE goods speak for themselves as to their related, likely competitive, character. StonCor’s unrefuted evidence establishes StonCor’s right to judgment.

Metroflor’s conclusory assertions by counsel do not meet the requirement of FRCP 56. Metroflor was required but failed to proffer countering evidence by affidavit or otherwise, under FRCP 56, to establish a genuine factual dispute for trial.¹⁰

Here is the applicable language from Rule 56:

Rule 56. Summary Judgment

- ...
- (c) Procedures.
 - (1) Supporting Factual Positions. A party **asserting that a fact cannot be or is genuinely disputed must support the assertion by:**
 - (A) **citing to particular parts of materials in the record**, including depositions, documents, electronically stored information, affidavits or declarations, stipulations (including those made for

⁸ Pg. 2, ln. 2-3, Metroflor’s Response to StonCor’s Summary Judgment Motion. The admission of likelihood of confusion at this place in Metroflor’s Response is presumably a typographical error.

⁹ Pg. 2, ln. 22-24, Metroflor’s Response to StonCor’s Summary Judgment Motion.

¹⁰ *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986).

- purposes of the motion only), admissions, interrogatory answers, or other materials; **or**
- (B) **showing that the materials cited do not establish** the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact.¹¹

Metroflor neither cited to any “particular parts of materials in the record¹²” nor did Metroflor show “that the materials cited do not establish presence of a genuine dispute”, as required by FRCP 56. Simply stated, Metroflor failed totally to address StonCor’s evidence. By failing to comply with FRCP 56 and by failing to present countervailing evidence, Metroflor effectively conceded that StonCor’s evidence-supported recitation of facts is correct and hence that there is no disputed issue of material fact.

The record shows that Metroflor did not comply FRCP 56. Metroflor proffered no evidence supporting a position that there is a genuinely disputed fact. There was no affidavit or other evidence accompanying Metroflor’s response. Metroflor only argued that StonCor had allegedly “failed to demonstrate the absence of any genuine issue of material fact”¹³ and that StonCor had allegedly “not provided a sound basis for likelihood confusion and has not shown one single instance of actual confusion”¹⁴. Metroflor did not address any of the facts set forth in StonCor’s evidence. Such argument does not comport with the requirements of FRCP 56.

StonCor submitted declaration evidence of similarity in appearance of STONTEC and TEKSTONE¹⁵, in compliance with FRCP 56. Metroflor neither presented nor cited any contrary evidence.

¹¹ FRCP 56(c)(1)

¹² Metroflor did characterize StonCor’s evidentiary declaration as “concocted” and “self-serving” at pg. 1, ln. 8 of Metroflor’s Response to StonCor’s Summary Judgment Motion, but did not otherwise address StonCor’s evidence.

¹³ Pg. 1, ln. 2-3, Metroflor’s Response to StonCor’s Summary Judgment Motion.

¹⁴ Pg. 1, ln. 13-14, Metroflor’s Response to StonCor’s Summary Judgment Motion.

¹⁵ ¶ 5, StonCor’s Jewell Declaration.

StonCor submitted declaration evidence of similarity in sound of STONTEC and TEKSTONE¹⁶, in compliance with FRCP 56. Metroflor neither presented nor cited any contrary evidence.

StonCor submitted declaration evidence of similarity in connotation of STONTEC and TEKSTONE¹⁷, in compliance with FRCP 56. Metroflor neither presented nor cited any contrary evidence.

With StonCor having presented evidence of similarity of STONTEC and TEKSTONE in appearance, sound and commercial connotation, with the law conclusively presuming that the TEKSTONE vinyl floor tile would be sold in all reasonable trade channels to all reasonable customers (including the trade channels and customers for STONTEC flooring), StonCor has presented unrefuted evidence of likelihood of confusion. Metroflor presented *no evidence* to the contrary.

Cavalierly ignoring StonCor's declaration evidence Metroflor argues that StonCor has not demonstrated similarity in appearance, sound and overall commercial impression, but presents no countervailing evidence. Metroflor does not identify a single material fact, supported by an affidavit or other evidence, as to which there is a genuine disputed issue. The TTAB Manual states that a non-moving party should specify, in its brief opposing summary judgment, the material facts in dispute¹⁸. Metroflor did not identify a single material fact that is in dispute. Proper application of FRCP 56 to the evidence of record can only result in summary judgment for StonCor.

¹⁶ ¶ 6, StonCor's Jewell Declaration.

¹⁷ ¶ 7, StonCor's Jewell Declaration.

¹⁸ TMEP 528.01, pg. 362, ¶ 3.

Metroflor’s Non-Likelihood of Confusion Arguments Lack Evidentiary Support

Metroflor argues that there is no likelihood of confusion. Likelihood of confusion, or lack thereof, is a conclusion of law. Conclusions of law must be supported by evidence. Metroflor has presented none.

Metroflor’s argument respecting reversal of the formatives of STONTEC to arrive at TEKSTONE, with the accompanying list of flip-flopped, allegedly confusingly similar “names”, is irrelevant. Each case, such as this one, must be decided on its own merits¹⁹. Metroflor’s coinage of “names” commencing with the formative “S T O N” is a meager attempt to divert attention from the issue at hand: Whether Metroflor has presented admissible evidence establishing a genuine issue of material fact sufficient to thwart StonCor’s motion? The answer must be “No”. Metroflor *has not presented any evidence of any type*, let alone *evidence of dissimilarity of the marks in appearance, sound and commercial connotation*.

Metroflor further argues that “the formatives ‘S T O N’ and ‘S T O N E’ do not look alike nor do they sound alike”²⁰. That assertion is preposterous. “S T O N” and “S T O N E” differ by only a single letter. Anyone having reasonably decent vision would perceive “S T O N” and “S T O N E” to “look alike”, contrary to Metroflor’s assertion. Similarly “S T O N” and “S T O N E” sound alike; they are pronounced identically. Anyone having a sense of hearing would perceive “S T O N” and “S T O N E” as sounding alike.

Metroflor asserts that “S T O N E” is a formative “that has a meaning, e.g., concreted earthy or mineral matter, rock”, but that “‘S T O N’ has no meaning”²¹. This, like the remainder

¹⁹ *In re Nett Designs, Inc.*, 236 F. 3d 1339, 51 USPQ2d 1564 (Fed. Cir. 2001); *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001); *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001).

²⁰ Pg. 3, ln. 1, Metroflor’s Response to StonCor’s Summary Judgment Motion.

²¹ Pg. 3, ln. 2-3, Metroflor’s Response to StonCor’s Summary Judgment Motion.

of Metroflor's response, has no evidentiary support. Moreover, the issue is not the connotation of formatives such as "S T O N E" and "S T O N"; the issue is similarity of the connotations of the **marks** STONTEC and TEKSTONE. Metroflor has not presented any evidence that the connotations of the two marks, when each of the marks is taken as a whole, are different. Contrasting, StonCor has presented evidence that the connotations of STONTEC and TEKSTONE are identical²².

Metroflor further argues that StonCor allegedly "has not demonstrated similarity in appearance, sound and overall commercial impression"²³. That assertion ignores the evidentiary declaration accompanying StonCor's motion.

Metroflor still further argues that Metroflor's TEKSTONE mark "designating vinyl floor tile is used for commercial and residential applications whereas opposer's mark designating non-metal floors is used for protective coatings in industrial and institutional applications"²⁴. From this, Metroflor argues that there is no commercial intersection²⁵ between TEKSTONE and STONTEC. Metroflor conveniently ignores the established legal principle that when an application, such as Metroflor's, does not include any trade channel restriction, the product involved, namely Metroflor's vinyl floor tile, is presumed to move in all relevant trade channels and to be sold to, and purchased by, all kinds of purchasers. For Metroflor to argue that there is "no commercial intersection" between TEKSTONE and STONTEC is not only erroneous as a matter of law, it is irrelevant with respect to the issue of whether Metroflor has identified any genuinely disputed issue of material fact.

²² ¶ 7, StonCor's Jewell Declaration.

²³ Pg. 3, ln. 7, 8, Metroflor's Response to StonCor's Summary Judgment Motion.

²⁴ Pg. 3, ln. 9-11, Metroflor's Response to StonCor's Summary Judgment Motion.

²⁵ Pg. 3, ln. 12, Metroflor's Response to StonCor's Summary Judgment Motion.

Summary and Prayer for Relief

Because Metroflor failed to identify any single material fact in issue, and because Metroflor failed to present any evidence in support of its response to StonCor's motion, relying instead solely on a two and one-half page argument of counsel, Metroflor failed to meet its burden of establishing a genuine issue of material fact. With Metroflor failing to meet its burden, summary judgment should be entered in favor of StonCor.

There is no basis in the record supporting Metroflor's FRCP 56(f) motion, which should be denied.

StonCor respectfully submits that when all of the foregoing is considered, this Board will find there is no genuine issue of material fact presented by the evidence of record and hence that summary judgment is in order. StonCor respectfully solicits entry of judgment in favor of StonCor and issuance of an order sustaining this opposition and denying registration of TEKSTONE.

Respectfully submitted,

Date: 13 May 2011

/Charles N. Quinn/
CHARLES N. QUINN
Attorney for Opposer StonCor Group, Inc.
Fox Rothschild LLP
747 Constitution Drive, Suite 100
Exton, PA 19341
Tel: 610-458-4984
Fax: 610-458-7337
email: cquinn@foxrothschild.com

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

StonCor Group, Inc.	:	
	:	
Opposer	:	Opposition No.: 91194599
	:	
v.	:	Application No.: 77/795,684
	:	
Metroflor Corporation	:	Mark: TEKSTONE
	:	
Applicant	:	

CERTIFICATE OF SERVICE

I, Charles N. Quinn, of full age, by way of certification, state that a copy of the foregoing
**STONCOR’S REPLY TO METROFLOR’S RESPONSE TO STONCOR’S MOTION FOR
SUMMARY JUDGMENT AND STONCOR’S ANSWER AND OBJECTION TO
METROFLOR’S MOTION FOR SUMMARY JUDGMENT**
is being sent to applicant’s counsel via email on the date and to the electronic address indicated
below. This is in accordance with a 17 May 2010 agreement between the parties for electronic
service.

rodrod@rodman-rodman.com

Date: 13 May 2011

/Charles N. Quinn/
CHARLES N. QUINN
Attorney for Opposer StonCor Group, Inc.
Fox Rothschild LLP
747 Constitution Drive, Suite 100
Exton, PA 19341
Tel: 610-458-4984
Fax: 610-458-7337
email: cquinn@foxrothschild.com