

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Mailed: June 24, 2011

Opposition No. **91194599**

StonCor Group, Inc.

v.

Metroflor Corporation

Before Bucher, Zervas, and Bergsman,  
Administrative Trademark Judges.

By the Board:

Metroflor Corporation ("applicant") seeks to register the mark TEKSTONE<sup>1</sup> for "vinyl floor tile" in International Class 19.

StonCor Group, Inc. ("opposer") has opposed registration of applicant's mark on the ground of dilution under Section 43(c) of the Lanham Act and on the ground that applicant's applied-for mark so resembles opposer's previously used and registered marks that they are likely to cause confusion, mistake, or deceive prospective consumers under Section 2(d) of the Trademark Act of 1946, 15 U.S.C.

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<sup>1</sup> Application Serial No. 77795684, filed August 3, 2009, alleging first use and first use in commerce on December 31, 2004.

§ 1052(d).<sup>2</sup> In its notice of opposition, opposer pleaded ownership of the registered mark STONTEC<sup>3</sup> for "non-metal floors, namely, vinyl flake decorated and colored floors, aspartic urethane-based floors" in International Class 19.

Applicant, in its answer, denied the salient allegations in the notice of opposition.

This case now comes up for consideration of opposer's motion (filed April 22, 2011) for summary judgment on its likelihood of confusion claim. Applicant filed a response that includes a cross-motion for summary judgment (filed May 3, 2011) on the ground of likelihood of confusion. Both motions are fully briefed.

Summary judgment is only appropriate when there is no genuine dispute as to any material fact and the moving party is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(a). The Board may not resolve issues of material fact; it may only ascertain whether a genuine dispute regarding a material fact exists. See *Lloyd's Food*

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<sup>2</sup> We observe that the notice of opposition as written is less than artful, but based on the pleading, the ESSTA cover sheet, and the pleaded registrations attached from the USPTO database, we construe the pleading as one of likelihood of confusion. Moreover, we note that applicant had no problem answering the notice of opposition, defending against opposer's motion for summary judgment, and filing its own cross-motion on the claim.

<sup>3</sup> U.S. Registration No. 3700433, issued October 20, 2009, based on an application filed July 24, 2006 and reciting December 31, 2002 as the date of first use and date of first use in commerce. Opposer also pleads ownership of several other marks containing the prefix STON for various goods involving flooring and flooring related products.

*Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods*, 22 USPQ2d at 1542. The mere fact that cross-motions for summary judgment have been filed does not necessarily mean that there are no genuine disputes of material fact, and that a trial is unnecessary. See *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389-90 (TTAB 1994).

We turn first to opposer's motion for summary judgment.

Because opposer has properly made its pleaded registrations of record, opposer has established its standing.<sup>4</sup> *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

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<sup>4</sup> As noted above, opposer attached copies of its pleaded registrations showing current status of and title to the registrations from the USPTO databases. The copies of the registrations attached to the notice of opposition are properly made of record pursuant to Trademark Rule 2.122(d)(1).

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and the goods covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

In support of its motion, opposer argues that applicant's mark is confusingly similar to opposer's registered mark in terms of sound, connotation, and overall commercial impression; that the respective goods are "functional equivalents"; that the respective goods move in the same channels of trade; and that it is "legally presumed" that applicant's products, like opposer's, will be sold to all available and reasonable customers, which would include sophisticated and unsophisticated customers, both commercial and residential.

As evidentiary support for its motion, opposer has submitted: (1) the declaration of Michael Jewell, opposer's Vice President of Product Development for the Stonhard Division; (2) applicant's responses to opposer's first set of interrogatories; and (3) an excerpt from Webster's New Collegiate Dictionary for the word "tech".

In response to the motion, applicant asserts that opposer has not provided "a sound basis for likelihood of confusion"; that opposer has not shown a single instance of actual confusion; that merely reversing the order of the

"formatives" in the mark STONTEC and adding an "E" after the "N" to obtain TEKSTONE does not demonstrate a likelihood of confusion; and that there is no "commercial intersection" between applicant's mark and opposer's mark.<sup>5</sup>

In its reply brief, opposer asserts that applicant's arguments are unsupported by any evidence; that opposer has met its burden in this instance; and that there is no disputed issue of material fact.

In determining the issue of likelihood of confusion, we are guided by the factors set forth in the case of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. Our primary reviewing Court has held that only those *du Pont* factors shown to be material or relevant in the particular case and which have evidence submitted thereon are to be considered. *See Olde Tyme Foods*, 22 USPQ2d at 1542.

In this particular case, the two key factors are the degree of similarity of the parties' marks and the degree of similarity of their respective goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24

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<sup>5</sup> Applicant did not submit any evidentiary support for its position.

(CCPA 1976). For purposes of this proceeding, the goods of the parties must be considered to be closely related, if not identical. Both the application and opposer's pleaded registration are flooring products. Neither the application nor the registration is limited or restricted as to the channels of trade through which these flooring products move or as to the ultimate purchasers of them, so we have no basis upon which to distinguish applicant's goods from those of opposer. Hence, because of the close relationship of the goods and the absence of any limitations in the subject application and registration we presume that the purchasers and channels of trade for such goods overlap. See *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003). Applicant argues that the goods flow through different trade channels because of their particular applications, and that confusion is therefore unlikely to occur, but there is no limitation in either the identification of the application or the pleaded registration to this effect, and applicant provided the Board with no other evidence which supports making such a distinction. If similar marks are used on these products, confusion will be likely.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont*

*De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that where, as here, the goods are closely related, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI Division of E-Systems, Inc. v. Environmental Communications Incorporated*, 207 USPQ 443, 449 (TTAB 1980).

The marks are similar because the dominant elements in opposer's mark "STON[E]" and "TEC" are similar in a number of respects to applicant's mark "TEKSTONE"; specifically, applicant's mark TEKSTONE is a mere transposition of opposer's mark. As we have held before, the transposition of terms is not always sufficient to distinguish the resulting marks. See *In re Wine Society of America Inc.*, 12 USPQ 2d 1139, 1142 (TTAB 1989); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882 (TTAB 1988) ("the reversal in one mark of the essential elements of another mark may serve as a

basis for a finding of no likelihood of confusion only if the transposed marks create distinctly different commercial impressions" (citations omitted)). The transposition of the marks does not, in our opinion, add anything which would change the commercial impression fostered by these marks. The marks, when considered in their entireties are similar in sound and appearance, and "STONTEC" and TEKSTONE" engender the same suggestive connotations inasmuch as they both reference stone technology. See *In re Atlantic Gulf Service*, 184 USPQ 828 (TTAB 1974) (ATLANTIC GULF SERVICE and GULF ATLANTIC are confusingly similar). The paired elements "ston" and "stone" and "tec" and "tek" are similar in appearance, sound and connotation. Hence, adding the letter "E" to the "ston" in opposer's mark, and changing the letter "C" to a "K" does not distinguish the marks. *In re Sybron Corporation*, 165 USPQ 410 (TTAB 1970) (VACUUM AIRE is confusingly similar to AIRVAC).

In the absence of facts which could lead us to a different conclusion, we see no reason not to follow the general rule that confusion may not be avoided by merely reversing the elements of the mark of another especially in this case where the goods are closely related. See *Carlisle Chemical Works v. Hardman & Holden Limited*, 168 USPQ 110 (CCPA 1970); *Royal Crown Cola Co. v. Bakers Franchise Corp.*, 150 USPQ 698 (TTAB 1966).



Applicant argues that there is no evidence that actual confusion has taken place, but of course actual confusion need not exist in order to find that confusion is likely. Because applicant did not submit any evidence in support of its opposition to opposer's motion or in support of its cross-motion, we have no basis on which to determine whether there has been a meaningful opportunity for confusion to have occurred. The absence of actual confusion is not a meaningful factor in resolving the issue of likelihood of confusion where there has been no opportunity for such confusion to have occurred. *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992).

In summary, confusion is likely because the mark applicant seeks to register is similar to opposer's mark, the products on which applicant intends to use it are similar and the purchasers and the trade channels are overlapping.

In view of the foregoing, opposer's motion for summary judgment on the likelihood of confusion claim is hereby granted. The opposition is sustained on the likelihood of confusion claim and registration to applicant is refused. Having sustained the opposition on the basis of likelihood of confusion, we need not reach the issue of dilution. Applicant's cross-motion for summary judgment is denied.