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Docket No.: 001647.00022  
Serial No.: 76/238,084



**IN THE UNITED STATES PATENT AND TRADEMARK  
BEFORE THE TRADEMARK TRIAL AND APPEAL B**

07-25-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #26

In re Application of:

Associated Materials, Incorporated dba Alside

Mark: ECLIPSE FLATSEAM VINYL SIDING

Serial No.: 76/238,084

Filed: April 10, 2001

)  
)  
) Trademark Attorney  
) Christine Cooper

) Law Office 104  
)  
)  
)

**NOTICE OF APPEAL**

TRADEMARK TRIAL AND  
APPEAL BOARD

APR 28 3 33  
02 JUL 3 33  
Applicant hereby appeals to the Trademark Trial and Appeal Board the decision of the Trademark Examining Attorney refusing registration of the above-captioned mark under Section 2(e) of the Trademark Act, pursuant to 37 C.F.R. § 2.141. 2.142.

Please charge the fee of \$100.00 to the Deposit Account of Banner & Witcoff, Ltd., Deposit Account No. 19-0733.

Respectfully submitted,

**Associated Materials, Incorporated  
dba Alside**

Date:

July 25, 2002

By:

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

In re Application of:	)	
	)	
Associated Materials, Incorporated dba Alside	)	Trademark Attorney
	)	Christine Cooper
Mark: ECLIPSE FLATSEAM VINYL SIDING	)	
	)	Law Office 104
Serial No.: 76/238,084	)	
	)	
Filed: April 10, 2001	)	

**MOTION FOR SUSPENSION OF APPEAL**  
**AND MEMORANDUM IN SUPPORT THEREOF**

Applicant respectfully moves that the Trademark Trial and Appeal Board suspend the Appeal pending the Examiner's consideration of the Request for Reconsideration. A copy of the Request for Reconsideration is attached hereto as Exhibit A.

Applicant submits that good cause exists for granting this Motion for Suspension of Appeal because if the Examiner accepts the Applicant's Request for Reconsideration, the Appeal will be moot.

Wherefore, Applicant respectfully requests that the Trademark Trial and Appeal Board issue an order suspending the Appeal pending the outcome of the Examiner's decision on the Request for Reconsideration. In the event the Examiner rejects the Request for Reconsideration,

Applicant requests that the Trademark Trial and Appeal Board issue an order providing Applicant with sixty (60) days from the mailing date of the order to file its Appeal Brief.

Respectfully submitted,

**Associated Materials, Incorporated  
dba Alside**

Date:

7/25/02

By:

Holly M. Ford

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# **ATTACHMENT A**

**BOX RESPONSES - NO FEE****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
Associated Materials Incorporated dba Alside Inc.	)	Examiner: Christine Cooper
	)	
Mark: ECLIPSE FLATSEAM VINYL SIDING	)	Law Office: 104
	)	
Serial No. 76/238,084	)	
	)	
Filed: April 10, 2001	)	

**REQUEST FOR RECONSIDERATION**

This responds to an Office Action mailed on February 19, 2002.

**AMENDMENTS AND SUBMISSIONS**

Applicant requests that the mark as shown in the drawing that was originally filed with the application was not made a part of the application. The mark is not a word mark but a word in stylized format mark. The mark should be displayed as follows:

**E C L I P S E**

FlatSeam Vinyl Siding

Please be advised that the stylized format was not made of record, and the mark was considered to be only a word mark. Applicant's statement regarding the stippling of the drawing (see Applicant's Response dated November 6, 2001) has also not yet been made of record.

### **ARGUMENTS**


The Examiner has issued a final refusal to register the marks ECLIPSE (Serial No. 76/205,933) and ECLIPSE FLATSEAM VINYL SIDING (Serial No. 76/238,084) based on a prior registration for ECLIPSE covering "roofing shingles" (Reg. No. 1,923,662). Although the Applicant feels that the goods "siding" and "roofing shingles" are sufficiently different that the use of the mark ECLIPSE on both marks is not likely to cause confusion, the applicant has decided to abandon its application for the word mark ECLIPSE. However, it believes strongly that the mark ECLIPSE FLATSEAM VINYL SIDING & Design is very different from the existing registration for the following reasons.

### **THE MARKS SHOULD BE VIEWED IN THEIR ENTIRETIES AND WHEN SO VIEWED ARE NOT CONFUSINGLY SIMILAR**

ECLIPSE and ECLIPSE FLATSEAM VINYL SIDING present substantially different commercial impressions not only because of the additional wording, but also because of the stylized design element as well, as is evident by the juxtaposition of the marks below. In addition, because the term ECLIPSE is commonly used and registered by many, the scope of protection for assessing likelihood of confusion is necessarily more limited. In Opryland USA, Inc. v. The Great American Music Show, Inc., 970 F.2d 847, 23 U.S.P.Q. 1471 (1992), a case involving likelihood of confusion, the Court found that it was incorrect to compare the mark CAROLINA OPRY with Opryland's marks such as GRAND OLE OPRY or OZARK OPRY after excluding the word "OPRY". The incorrectness of this analytical approach is apparent, for marks must be considered in the way they are perceived by the relevant public, in determining likelihood of confusion.

The Court noted that although it is often helpful to the decision maker to analyze marks by separating them into their component words or design elements in order to ascertain which aspects are more or less dominant, such analysis must not contravene law and reason. When it is the entirety of the marks that is perceived by the public, it is the entirety of the marks that must be compared. See, Estate of P.D. Beckwith, Inc. v. Comm'r of Patents, 252 U.S. 538, 545-6, 40 S.Ct. 414, 417, 64 L.Ed. 705 (1920) ("The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety ...") See also, Specialty Brands, 748 F.2d at 672-73, 223 USPQ at 1282-83 (comparing SPICE VALLEY and SPICE ISLANDS, viewed as a whole); Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed.Cir.1983) (comparing GIANT FOOD and design and GIANT HAMBURGERS and design, viewed in their entireties); and Coca-Cola Co. v. Clay, 324 F.2d 198, 199-200, 139 USPQ 308, 309 (CCPA 1963) (comparing COCA-COLA and CUP-O'-COLA, viewed as a whole). See, generally, 1 J. Thomas McCarthy, Trademarks and Unfair Competition, §§ 11:10, 12:12(C) (2d ed. 1984 & 1990 Supp.) Thus, it is not dispositive whether generic or descriptive words are included as part of the mark; that is simply a factor to be considered when viewing the mark as a whole.

ECLIPSE

E C L  P S E

FlatSeam Vinyl Siding

**THE GOODS ARE NOT EXPECTED TO BE  
MANUFACTURED BY THE SAME SOURCE**

In the present case the goods offered under the two marks are not expected to be manufactured by the same source. Although the goods are both used in the building materials industry, purchasers do not expect, when encountering the marks, that the goods would come from the same source. Generally speaking, there are very few manufacturers of vinyl siding and it is not usual that manufactures of siding are in the business of manufacturing roofing shingles. The manufacturers of siding are few and well known in the industry. Thus, its customers, who are sophisticated purchasers, will generally know exactly what siding they are purchasing and would not expect a manufacturer of siding to manufacture roofing shingles. The process of creating vinyl siding is unique and complicated. There is, as a result, a Vinyl Siding Institute through which manufacturers come together to share information (see Attachment A). Given such a limited and specialized field, it is clear that consumers would be well aware of who is the source of their vinyl siding.

**CHARACTERISTICS OF PURCHASERS  
AND DEGREE OF CARE EXERCISED**

In determining trademark infringement, everything hinges on whether there is a likelihood of confusion in the mind of an appreciable number of reasonably prudent buyers. Standard Brands, Inc. v. Smiler, 151 F.d. 34 (d. Cir.1945).

A reasonably prudent purchaser is expected to exercise the degree of care and caution appropriate to the choice the purchaser faces in the marketplace. Volkswagen Aktiengesellschaft v. Church, 411 F.d. 350 (9th Cir.1969). Thus, the reasonably prudent buyer is not indifferent, foolish or negligent.



Moreover, the availability and price of the goods is a factor in determining the level of care exercised by the buyer. Obviously, the price level of the goods is an important factor in determining the amount of care the reasonably prudent buyer will use. If the goods are relatively expensive, more care is taken and buyers are less likely to be confused as to source or affiliation. MacGregor-Donigen, Inc. V. Drizzle, Inc., 599 F.d. 1126(d. Cir. 1979) In addition to being almost specialty goods purchased by very deliberate and careful customers, Applicant's goods are not inexpensive. This will go a long way toward negating a likelihood of confusion between the vinyl siding product offered by Applicant and the roofing shingles product offered by Registrant.

### CONCLUSION

Based on the above arguments, we do not believe that a likelihood of confusion exists between the marks ECLIPSE FLATSEAM VINYL SIDING and ECLIPSE.

Accordingly, it is hereby requested that the Examiner reconsider his refusal and allow the subject mark to proceed to registration on the Principal Register.

Respectfully submitted,

**Associated Materials Incorporated  
dba Alside Inc.**

Date: July 25, 2002

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# **ATTACHMENT A**



# Vinyl Siding Institute

A Business Unit of The Society of The Plastics Industry, Inc.

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## Membership List

VSI membership is composed of manufacturers of vinyl siding and suppliers of raw materials, equipment or services to the vinyl siding industry.

To contact manufacturers directly about specific product information, see our [manufacturers contact list](#).

A B C D E F G H I J K L M N O P Q R S T U V W X Y Z

### *Manufacturer Members in Italics*

#### A

- *[Alcoa Building Products](#)*
- *[Alside, Inc.](#)*
- *[American Maplan Corporation](#)*
- *[American Theysohn Extruder Corporation](#)*
- *[Americhem, Inc.](#)*
- *[Architectural Testing Inc.](#)*
- *[Atlas Electric Devices Company](#)*
- *[ATOFINA Chemicals, Inc.](#)*
- *[Avery Dennison-Performance Films](#)*

#### B

#### C

- *[CertainTeed Corporation](#)*
- *[Charvat, Robert A.](#)*
- *[Cognis Corporation \(formerly Henkel Corp.\)](#)*
- *[Colormatrix Corporation](#)*
- *[Crane Performance Siding](#)*
- *[Crompton Corp. \(formerly Witco\)](#)*

#### D

- *[Dupont Dow Elastomers LLC](#)*

#### E

- *[E.I. du Pont de Nemours & Co.](#)*

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## F

- Ferro Corporation
- Formosa Plastics Corp., USA

## G

- Gentek Building Products, Inc.
- Georgia Gulf Corporation

## H

- Heartland Building Products
- Heucotech, Ltd.
- Holland Colors Americas, Inc.
- Honeywell (formerly Rheochem Technologies of AlliedSignal)

## I

- IMERYS Pigments & Additives Group

## J

- J.I. Gray & Associates

## K

- Kaneka Texas Corporation
- Kaycan, Ltd.
- Krauss-Maffei Corporation

## L

- LP Specialty Products
- Lucite International Inc.

## M

- Milacron, Inc.
- Mitten Vinyl Inc.

## N

## O

- Omya, Inc.
- Owens Corning
- Oxy Vinyls LP

## P

- Penn Color, Inc.
- PolyOne (formerly M.A. Hanna Color)
- Progressive Foam Technologies, Inc.

## Q

- Q-Lab Weathering Research Services

## R

- RADCO
- Resource Materials Corporation
- Rohm and Haas Company
- Rollex Corporation
- Royal Building Products

## S

- Shintech Inc.
- Specialty Minerals, Inc.

## T

## U

## V

- Variform, Inc.

## W

## X

## Y

## Z

last updated 7/9/02



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## Welcome to the VSI Web Site!

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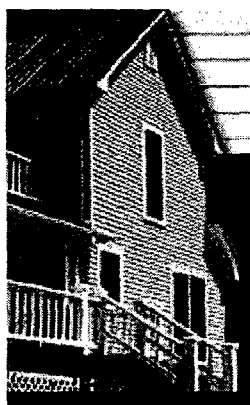
The Vinyl Siding Institute (VSI) is the trade association for manufacturers of vinyl siding and suppliers of raw materials, equipment or services to the vinyl siding industry. Please explore our Web site to learn more about VSI, vinyl siding, and our industry activities . . .

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# Vinyl Siding Institute

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## VS Vinyl Siding Certification Program

VS developed the *Vinyl Siding Certification Program* to assure consumers--from homeowners and remodelers to architects and contractors--of the quality of the vinyl siding they select and use.

Certified vinyl siding is siding that is verified by an independent process to meet or exceed ASTM D3679, the long-standing, accepted industry standard for quality vinyl siding.

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[New! \*Certified Vinyl Siding: Quality You Can Count On\\*\*](#)

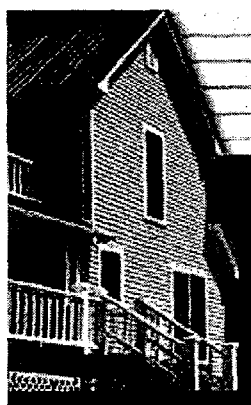
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## What is VSI?

The Vinyl Siding Institute (VSI) is the trade association for manufacturers of vinyl siding and suppliers of raw materials, equipment and services to the vinyl siding industry.

The purpose of VSI is to further the development and growth of the vinyl siding industry by:

- Opening new and maintaining current markets for vinyl siding through monitoring of building codes and the education of building code developers and regulators
- Developing material, product and performance standards
- Promoting acceptance and adoption of standards developed by VSI
- Addressing regulatory issues as they pertain to vinyl siding
- Sponsoring the VSI *Vinyl Siding Certification Program*
- Providing a forum for issues of interest to the vinyl siding industry

## What Does VSI Do for Its Members?

- Sponsors the VSI *Vinyl Siding Certification Program*
- Employs technical director, focusing on technical, code and regulatory issues
- Responds quickly and effectively to building code and regulatory issues
- Works with ASTM to set standards and testing for products
- Provides forum for sharing technical data among VSI members and related organizations
- Publishes technical brochures on a variety of topics of interest to consumers and installers of vinyl siding
- Spearheads participation in Habitat for Humanity projects
- Provides accurate market statistics reporting and benchmarking of operations
- Demonstrates leadership on issues relating to the use of vinyl siding
- Fosters promotion of vinyl siding
- Sponsors the Awards of Distinction that recognizes outstanding construction projects that use vinyl siding
- Provides instruments of communication for members and consumers such as a Web site, publications, newsletters, press releases and a toll-free information hotline.

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- Provides timely and useful information to members on activities, successes and pertinent issues of interest
- Provides vinyl siding manufacturers and suppliers to the industry with access to each other
- Meets twice a year as the full Institute; committees meet more often on an as-needed basis
- Recognizes individual leaders in the vinyl siding industry
- Participates in the development of SPI policy on issues impacting VSI matters
- Is the only organization dealing with the major issues of the vinyl siding industry

### **How is VSI Structured?**

The elected officers of VSI consist of a Chair, a Vice Chair and a SPI Board Representative. Each are elected to three-year terms by a majority of those present and eligible to vote at the Annual Meeting of VSI held in election years. Each can serve no more than two successive terms. The elected Chair may choose to act as the SPI Board Representative.

The VSI Steering Committee consists of the highest level executive of each manufacturer member company and the VSI Executive Director. The Steering Committee Chair is the VSI Vice Chair. The Steering Committee is responsible for VSI making policy.

The VSI Executive Committee consists of the VSI Chair, Vice Chair, SPI Board Representative, Past Chairs, the VSI Executive Director and other VSI members as appointed by the Chair, usually the heads of other committees, subcommittees or task groups. The executive committee is responsible for implementing VSI policy as made by the steering committee.

Other committees are established to further the VSI mission. Subcommittees, task forces and working groups are appointed by the Committee Chairs as needed to address specific issues. Membership in VSI includes participation in its committees and subgroups. Current committees in addition to the Steering and Executive committees include: Technical Committee, Code and Regulatory Committee, Certification Oversight Committee, and the Producers Planning Council.



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