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Subject: U.S. TRADEMARK APPLICATION NO. 86425022 - FASCRETE - T12910 - Request for
Reconsideration Denied - Return to TTAB

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86425022

MARK: FASCRETE



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

APPLICANT: Giles, Richard

CORRESPONDENT'S REFERENCE/DOCKET NO:

T12910

CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action dated August 26, 2015 are maintained and continue to be final: SECTION 2(D) REFUSAL DUE TO LIKELIHOOD OF CONFUSION and CLASSIFICATION AND IDENTIFICATION OF GOODS/MULTIPLE-CLASS APPLICATION REQUIREMENTS. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); see 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); see TMEP §§715.03, 715.03(a)(ii)(B), (c).

SECTION 2(D) REFUSAL DUE TO LIKELIHOOD OF CONFUSION

The following refusal made final in the Office action dated August 26, 2015 is maintained and continue to be final: SECTION 2(D) REFUSAL DUE TO LIKELIHOOD OF CONFUSION. In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3900522. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record.

Citigroup Inc. v. Capital City Bank Grp., Inc., 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

COMPARISON OF THE MARKS

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

Applicant's standard character mark is FASCRETE. The standard character mark in U.S. Registration No. FASTCRETE. Applicant's mark and registrant's mark are similar in appearance, sound, connotation and commercial impression because both marks use the same first three letters, namely, FAS, in connection with the last five letters suggestive of concrete, namely, CRETE. Applicant's mark merely omits the letter t in registrant's mark. Nevertheless, the FAS portion of applicant's mark is also suggestive of the word fast which is the first portion of registrant's mark. Thus, particularly in connection with the concrete related goods at issue, the marks both create a common commercial impression related to a fast concrete product.

Moreover, given that the letter t is often silent or softly pronounced at the end of words like fast, the marks could be pronounced the same given that applicant's mark merely deletes the letter t from registrant's mark. Thus, the marks are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv). Furthermore, even slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983); see *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012). This is particularly true even if the t in registrant's mark were heavily pronounced.

Overall, as previously noted, there is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. *See Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *In re The Belgrade Shoe Co.*, 411 F.2d 1352, 1353, 162 USPQ 227, 227 (C.C.P.A. 1969)); TMEP §1207.01(b)(iv). The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Therefore, the marks are confusingly similar.

COMPARISON OF THE GOODS

If the goods and/or services of the respective parties are “similar in kind and/or closely related,” the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

Applicant’s goods as amended are: Consumables for use in asphalt and concrete repair, namely, unprocessed epoxy resin, unprocessed artificial resins, unprocessed synthetic resins and unprocessed polymers, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals [International Class 1]; Consumables for use in asphalt and concrete repair, namely, pigments and raw natural resins, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair, namely, unprocessed natural resins primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals [International Class 2]; Consumables for use in asphalt and concrete repair, namely, crude oil and petroleum, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals [International Class 4]; Consumables for use in asphalt and concrete repair, namely, carbon fiber primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair in the nature of aggregate material composed of carbon fiber, primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair, namely, semi-processed resins, polymer based patching and compounds and carbon fibers, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals [International Class 17]; Consumables for use in asphalt and concrete repair, namely, sand and cement aggregates, all primarily distributed in connection with asphalt and concrete repair supplies and services and

marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair in the nature of aggregate material composed of sand for use in concrete and asphalt repair, primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair in the nature of aggregate material composed of gravel, primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair, namely, cement aggregates, concrete aggregates and asphalt aggregates, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals [International Class 019].

The goods in U.S. Registration No. 3900522 are: Mortar; cement mixes; Portland cement-based resurfacing and patching material for use on concrete slabs; and patching compound made of a cement base.

Applicant's goods are similar in kind and/or closely related to registrant's goods because both goods are for use in connection with concrete. In addition, although applicant's goods may ultimately be classified in various classes, the goods have the same function related to use with concrete, particular concrete repair. Applicant's goods explicitly indicate that applicant's goods are consumables for use in concrete repair and registrant's goods, particularly cement mixes, resurfacing and patching materials and patching compounds made of cement base are also for repair of concrete. Although the goods are not identical as identified, the goods have a similar purpose and nature related as identified in the identification of record to cement such that the goods are related. Accordingly, the goods are considered related for purpose of the likelihood of confusion analysis.

The examining attorney also notes that the applicant has limited the channel of trade for the goods, namely, that the goods are primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals. However, this amendment is insufficient to obviate the likelihood of confusion in this case. The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); see TMEP §1207.01(a)(iii). Thus, registrant's goods presume to operate in all channels of trade and reach all classes of purchasers including those particularly limited by applicant's identification.

APPLICANT'S ARGUMENTS

1. Applicant's Mark Is Distinguishable from Registrant's Mark and Is Therefore Registrable on the Principal Register.

Applicant contends that applicant's mark is distinguishable from registrant's mark. In support of registration, applicant provides Exhibit A with applicant's request for reconsideration. According to the applicant, Exhibit A is the only evidence of actual use of registrant's mark found by the

applicant and is from registrant's website. In particular, applicant notes that based on registrant's actual use which is probative on the issue of the similarity of the marks, applicant's mark differs from the use of the registrant's mark in both appearance, sound and commercial impression. Applicant maintains that the one letter difference, namely, the missing letter T, between applicant's mark and registrant's mark, is significant in both terms of appearance and sound between the marks. With respect to the sound in particular, the applicant notes that unlike the minimal difference in sound that would result from the removal of an insignificant letter in a mark, the lack of the letter T of registrant's mark makes a strong commercial impression, while the lack of the hard consonant T sound of applicant's mark makes a completely different strong commercial impression. This difference between the marks related to the letter T causes distinctions in sound and appearance of the marks such that there is very little likelihood that a buyer would confuse the marks because of an ultimate difference in commercial impression.

The examining attorney unpersuaded by applicant's line of reasoning. In particular, while applicant's Exhibit A is probative on the issue of the presentation of the mark, the registrant's use does not obviate the similarity between the marks which as noted above are similarly spelled causing a similarity in appearance, meaning and connotation related to fast concrete. While the marks are not identical due to the lack of the letter T in applicant's mark, the marks are sufficiently similar in sound, appearance and suggestive meaning of fast concrete that the marks are similar in commercial impression. This is also true considering that both marks as applied are standard character marks and despite the actual evidence of registrant's use which applicant has provided. Furthermore, applicant statement that consumers who view applicant's FASCRETE mark immediately recognize the missing "T", such that the commercial impression is distinguishable from that of registrant's mark seemingly contradicts applicant's arguments in that applicant's mark is a play on words of fastcrete which is registrant's actual mark.

In support of applicant's position that applicant's mark and registrant's mark would not be likely to cause consumer confusion, applicant indicates that the actual market penetration for registrant's mark should be taken into consideration. According to the applicant, since the listed actual use date in 1991 of registrant's mark, registrant's mark appears to have little market penetration. As mentioned above by the applicant, registrant's website is the only instances of "fastcrete" that applicant can find in connection with registrant's goods after roughly 25 years of actual use. At the rate of expansion and penetration of the use of registrant's mark, consumer recognition of registrant's mark would not reach the level of causing confusion even if another 25 years of use follow. Thus, the limited recognition of the mark of registrant's mark indicates the weakness of registrant's mark in the marketplace and the limited scope of protection it should be granted for purposes of this likelihood of confusion analysis.

Applicant's arguments on this point are unpersuasive. A trademark or service mark registration on the Principal Register is prima facie evidence of the validity of the registration and the registrant's exclusive right to use the mark in commerce in connection with the specified goods and/or services. See 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv). For this reason, applicant's arguments related to the alleged limited recognition of the registrant's mark despite 25 years of use are unpersuasive. Moreover, even if applicant's characterization of registrant's mark as weak is correct, this does not obviate the need to protect such marks. The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal

Board have recognized that marks deemed “weak” are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. TMEP §1207.01(b)(ix); *see King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974) (likelihood of confusion is “to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and ‘strong mark’”); *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982) (“even weak marks are entitled to protection against registration of similar marks”). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975). Thus, despite applicant’s contention, registrant’s mark is still entitled to protection against the applicant of a similar mark for closely related goods, and in the present case this is exactly the case given the marks and the identification of goods of record.

2. Applicant’s Goods Are Distinguishable from Registrant’s Goods and Both Goods Move Through Different Channels of Trade Such That There is Not a Likelihood of Confusion.

Applicant contends that applicant’s goods are distinguishable from registrant’s goods. In addition, applicant contends that both goods move through different channels of trade such that there is no likelihood of confusion in this case. In particular, applicant notes that applicant’s consumables for use in asphalt and concrete repair differ from registrant’s mortar and cement-based patching material due to the natural differences between applicant’s consumables and registrant’s mortar. This is the case because applicant’s consumables range from epoxies to carbon fibers and from aggregates to gravel and sand while registrant’s identification of goods is limited to mortar and cement based materials. According to the applicant, to any relevant consumer, the differences between registrant’s mortar and cement based goods would be clearly distinguishable from applicant’s consumables, and such a consumer would not likely be confused as to source or affiliation because of these differences.

The examining attorney finds applicant’s line of reasoning unpersuasive because the issue is whether consumers would perceive the various goods as emanating from the same source. While applicant’s and registrant’s goods are not identical as to material composition, the goods are similar in kind and/or closely related as to purpose and functions related to concrete repair given the identification of goods of record. Thus, consumers encountering similar marks for concrete repair goods may assume that the goods are derived from a common commercial source.

Applicant notes that the most drastic distinction between the goods of applicant and registrant is found in the actual use of registrant’s mark as shown by applicant’s Exhibit A. In particular, applicant notes that registrant’s mark is not used on all types of mortar and cement-based products, but rather is limited to use in the very specialized floorcovering industry. Thus, applicant contends that the only products sold by registrant, or in any way related to the products sold by registrant, clearly fall within the floorcovering industry. In contrast, applicant’s points out that applicant’s mark is used in connection with goods “for use in asphalt and concrete repair” and “primarily distributed in connection with asphalt and concrete repair supplies and services marketed primarily to infrastructure maintenance professional,” as indicated by the identification of goods, as amended. Thus, applicant’s concrete and asphalt repair goods in the infrastructure maintenance profession are

clearly distinguishable from registrant's mortar and cement-based goods in the floorcovering industry.

Additionally, applicant notes that registrant's goods and applicant's goods travel in very distinct channels of trade. In particular, applicant notes that the normal channels of trade for registrant's goods are that provided in applicant's Exhibit A related to registrant's goods. Specifically, registrant's goods only appear to be available through a specialized network of distributors, as indicated on the "SILPRO - Distributors" page of registrant's website. Applicant notes that the same page indicates that the network is affiliated with the "International Standards & Training Alliance" of "Floorcovering Professionals." Therefore, applicant concludes that registrant's goods only appear to be distributed through floorcovering professionals, such as those specializing in tile for the construction industry. By contrast, applicant notes that applicant's goods are "primarily distributed in connection with asphalt and concrete repair supplies and services marketed primarily to infrastructure maintenance professional" as indicated by the identification of goods as amended. Applicant maintains that applicant's asphalt and concrete repair supplies and services will not appear in the same channels of trade as registrant's floorcovering goods, meaning no relevant consumer would ever encounter the marks in any situation that would cause confusion. According to the applicant, these vastly distinct channels of trade prevent a finding of likelihood of confusion. For these reasons, applicant respectfully submits that the goods and the channels of trade for each of the goods are so different that there is no likelihood of confusion in the present case, and a finding by the Office of the same is respectfully requested.

Unfortunately, although the examining attorney understands applicant's line of reasoning with respect to the differences between applicant's goods and registrant's goods, with respect to applicant's and registrant's goods, **the question of likelihood of confusion is determined based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use.** See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). Absent restrictions in an application and/or registration, the identified goods and/or services are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). Unfortunately, as set forth in the identification of record, registrant's goods do not have any restrictions as to the channels of trade or end consumers which would obviate the similarity in the nature of the goods at issue despite applicant's amendments to the identification of goods to include such restrictions. The Trademark Trial and Appeal Board has upheld this determinative principle of likelihood of confusion time and time again with respect to constructions of identification which appear in registrations and applications.

3. Applicant's Goods Are Purchased Under Different Conditions and by Different Classes of Consumers than Registrant's Goods, Adding Further Weight to the

Conclusion that There Is No Likelihood of Confusion Between the '522 Registration and Applicant's Mark.

Applicant indicates for the record that the purchasers of applicant's goods are industry professionals, including those working for municipalities tasked with infrastructure maintenance, who seek high quality consumables for use in asphalt and concrete repair. According to the applicant, professionals seeking such products are not likely to purchase any product without first being educated on the efficacy and quality of the product being purchased. Thus, applicant notes that such professionals will seek out detailed information on the product and the supplier before making their purchase, making these individuals careful and sophisticated consumers. Therefore, applicant concludes that such careful and sophisticated consumers are not likely to confuse applicant's goods with registrant's goods.

Likewise, applicant further explains, the purchasers of registrant's mortar products are sophisticated with respect to registrant's goods. As supported by registrant's website which applicant has submitted as Exhibit A, registrant's goods are marketed to construction professionals seeking quality thin-set for leveling structure and flooring, such as for installing tile. The construction professionals seeking out and purchasing registrant's mortar products are well educated with respect to the different construction products and suppliers, and thus are not at all likely to confuse applicant's goods with those of the registrant.

Thus, overall, applicant contends that the sophisticated class of purchasers involved in both applicant's and registrant's goods is a strong indication that there is no likelihood of confusion between applicant's and registrant's goods.

Nevertheless, as previously noted, the sophisticated consumers of registrant's goods are not limited in the registrant's identification as applicant contends despite applicant's Exhibit A evidence to the contrary. Moreover, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). For these reasons, the applicant's arguments related to the sophistication of the purchasers of applicant's and registrant's goods are unpersuasive, particularly in light of registrant's identification of record.

CONCLUSION

Couple the similarity in commercial impression along with the related nature of the goods and a consumer encountering both marks may wrongly assume that the goods are derived from a common commercial source.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the

registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Accordingly, the request is denied.

CLASSIFICATION AND IDENTIFICATION OF GOODS/MULTIPLE-CLASS APPLICATION REQUIREMENTS

The following requirements made final in the Office action dated August 26, 2015 are maintained and continue to be final: CLASSIFICATION AND IDENTIFICATION OF GOODS/MULTIPLE-CLASS APPLICATION REQUIREMENTS. In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

In particular, in applicant's request for reconsideration, applicant amended the identification as follows for International Class 19:

Consumables for use in asphalt and concrete repair, namely, unprocessed epoxy resin, unprocessed artificial resins, unprocessed synthetic resins and unprocessed polymers, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals [International Class 1]; Consumables for use in asphalt and concrete repair, namely, pigments and raw natural resins, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair, namely, unprocessed natural resins primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals [International Class 2]; Consumables for use in asphalt and concrete repair, namely, crude oil and petroleum, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals [International Class 4]; Consumables for use in asphalt and concrete repair, namely, carbon fiber primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair in the nature of aggregate material composed of carbon fiber, primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals ; Consumables for use in asphalt and concrete repair, namely, semi-processed resins, polymer based patching and compounds and carbon fibers, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals [International Class 17]; Consumables for use in asphalt and concrete repair, namely, sand and cement aggregates, all primarily distributed in connection with

asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair in the nature of aggregate material composed of sand for use in concrete and asphalt repair, primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair in the nature of aggregate material composed of gravel, primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair, namely, cement aggregates, concrete aggregates and asphalt aggregates, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals [International Class 019].

The wording in the amended identification of goods is not acceptable because it includes bracketed information related to the classes for the goods which should be removed when eventually properly classified, but also the identification includes goods classified in multiple classes in one identification. See TMEP §1402.01. The examining attorney notes that when the applicant's amended identification of goods from the request for reconsideration was entered into the Office's database, the brackets with the international class information were stripped automatically such that the brackets do not currently appear in the identification. Nevertheless, applicant should not include the international class information within the identification. In addition, the examining attorney notes that the applicant has only paid for one class of goods.

While the applicant has amended the identification to specify the common commercial name of the goods, applicant has not properly classified the goods. In particular, applicant has classified the following goods and/or services in International Class 19:

Consumables for use in asphalt and concrete repair, namely, unprocessed epoxy resin, unprocessed artificial resins, unprocessed synthetic resins and unprocessed polymers, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals [International Class 1]; Consumables for use in asphalt and concrete repair, namely, pigments and raw natural resins, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair, namely, unprocessed natural resins primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals [International Class 2]; Consumables for use in asphalt and concrete repair, namely, crude oil and petroleum, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals [International Class 4]; Consumables for use in asphalt and concrete repair, namely, carbon fiber primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair in the nature of aggregate material composed of carbon fiber, primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily

to infrastructure maintenance professionals ; Consumables for use in asphalt and concrete repair, namely, semi-processed resins, polymer based patching and compounds and carbon fibers, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals [International Class 17].

However, the proper classification for each item is as follows:

Consumables for use in asphalt and concrete repair, namely, unprocessed epoxy resin, unprocessed artificial resins, unprocessed synthetic resins and unprocessed polymers, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals, International Class 1; and

Consumables for use in asphalt and concrete repair, namely, pigments and raw natural resins, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair, namely, unprocessed natural resins primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals, International Class 2; and

Consumables for use in asphalt and concrete repair, namely, crude oil and petroleum, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals, International Class 4; and

Consumables for use in asphalt and concrete repair, namely, carbon fiber primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair in the nature of aggregate material composed of carbon fiber, primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair, namely, semi-processed resins, polymer based patching and compounds and carbon fibers, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals, International Class 17.

Therefore, applicant may respond by (1) adding one or more of the above international class(es) to the application, and reclassifying the above goods and/or services accordingly; or (2) deleting the goods and/or services in International Class(es) 1, 2, 4 and 17 (identified above) from the application. See 37 C.F.R. §§2.86(a), 6.1; TMEP §§1403.02 *et seq.* If applicant adds one or more international classes to the application, applicant must comply with the multiple-class requirements specified in this Office action.

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netahtml/tidm.html>. See TMEP §1402.04.

Applicant may adopt the following identification of goods, if accurate:

Consumables for use in asphalt and concrete repair, namely, unprocessed epoxy resin, unprocessed artificial resins, unprocessed synthetic resins and unprocessed polymers, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals, International Class 1; and/or

Consumables for use in asphalt and concrete repair, namely, pigments and raw natural resins, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair, namely, unprocessed natural resins primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals, International Class 2; and/or

Consumables for use in asphalt and concrete repair, namely, crude oil and petroleum, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals, International Class 4; and/or

Consumables for use in asphalt and concrete repair, namely, carbon fiber primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair in the nature of aggregate material composed of carbon fiber, primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals ; Consumables for use in asphalt and concrete repair, namely, semi-processed resins, polymer based patching and compounds and carbon fibers, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals, International Class 17; and/or

Consumables for use in asphalt and concrete repair, namely, sand and cement aggregates, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair in the nature of aggregate material composed of sand for use in concrete and asphalt repair, primarily

distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair in the nature of aggregate material composed of gravel, primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals; Consumables for use in asphalt and concrete repair, namely, cement aggregates, concrete aggregates and asphalt aggregates, all primarily distributed in connection with asphalt and concrete repair supplies and services and marketed primarily to infrastructure maintenance professionals, International Class 19.

An applicant may only amend an identification to clarify or limit the goods, but not to add to or broaden the scope of the goods. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07.

MULTIPLE-CLASS APPLICATION REQUIREMENTS

The application identifies goods and/or services in more than one international class; therefore, applicant must satisfy all the requirements below for each international class based on Trademark Act Section 1(b):

- (1) [List the goods and/or services by their international class number](#) in consecutive numerical order, starting with the lowest numbered class.

- (2) [Submit a filing fee for each international class](#) not covered by the fee(s) already paid (view the USPTO's current fee schedule at http://www.uspto.gov/trademarks/tm_fee_info.jsp). The application identifies goods and/or services that are classified in at least five classes; however, applicant submitted a fee(s) sufficient for only one class(es). Applicant must either submit the filing fees for the classes not covered by the submitted fees or restrict the application to the number of classes covered by the fees already paid.

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.32(a)(6)-(7), 2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c). The fees for adding classes to a regular TEAS application are \$325 per class when the fee is paid using the Trademark Electronic Application System (TEAS) and \$375 per class when the fee is paid in a paper submission. See 37 C.F.R. §2.6(a)(1)(i)-(ii); TMEP §§810, 1403.02(c).

For an overview of the requirements for a Section 1(b) multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/multiclass.jsp>.

Accordingly, the request is denied

/Brendan McCauley/

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