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Subject: U.S. TRADEMARK APPLICATION NO. 86693803 - VERANDA - TMB-7855 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86693803

MARK: VERANDA



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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: MARBLE SYSTEMS, INC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

TMB-7855

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

Applicant Marble Systems, Inc., ("Applicant"), has appealed the Examining Attorney's final refusal to register the proposed mark, VERANDA, in standard characters, under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). Registration was refused on the grounds that Applicant's mark is likely to be confused with the standard character mark, VERANDA, in U.S. Registration No. 3178672.

FACTS

On July, 15, 2015, applicant filed the application at issue under Section 1(b) of the Trademark Act, to register the mark VERANDA for “ceramic tiles; ceramic tiles for flooring, facing, lining and coverings; glazed ceramic tiles; mosaic art tiles made of marble; natural stone tiles” in Class 19.

On October 27, 2015, the examining attorney issued an Office action refusing the mark under Trademark Act Section 2(d) for a likelihood of confusion with the mark VERANDA, in U.S. Registration No. 3178672.

On February 12, 2016, applicant filed a Response to Office action and presented arguments against the Trademark Act Section 2(d) refusal.

A Final Office action was issued on March 25, 2016¹, wherein the examining attorney maintained and continued the refusal regarding the mark in U.S. Registration No. 3178672.

Applicant subsequently filed a Request for Reconsideration and Notice of Appeal on September 26, 2016. The application was remanded to the examining attorney on October 5, 2016, and the Request for Reconsideration was denied on October 26, 2016. Applicant filed its appeal brief on December 23, 2016.

ISSUE

The sole issue on appeal is whether the applicant’s proposed mark, VERANDA for “ceramic tiles; ceramic tiles for flooring, facing, lining and coverings; glazed ceramic tiles; mosaic art tiles made of marble; natural stone tiles” so resembles the mark, VERANDA, in U.S. Registration No. 3178672 for

¹ The examining attorney issued a subsequent superseding Final Office action on March 25, 2016 to correct an error found in the initial Final Office action issued on March 25, 2016.

“Non-metal building materials for use in building decks; non-metal fencing; non-metal lattices” as to cause confusion, mistake, or to deceive as to the source of the goods under Section 2(d) of the Trademark Act.

ARGUMENT

Trademark Act Section 2(d) bars registration of a 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 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)). In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); TMEP §§1207.01 *et seq.*

Since the applicant’s mark is identical in sound, appearance, and commercial impression to the registered mark and the goods offered by the applicant and registrant are related, registration of the applied-for mark is likely to create consumer confusion.

A. THE MARKS ARE IDENTICAL IN APPEARANCE, SOUND, CONNOTATION AND OVERALL COMMERCIAL IMPRESSION.

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)); TMEP §1207.01(b).

In the present case, the applicant’s mark, VERANDA, in standard characters, is identical in appearance, sound, and meaning, to registrant’s mark, VERANDA, also in standard characters, “and have the potential to be used . . . in exactly the same manner.” *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015). Because they are identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant and registrant’s respective goods. *In re i.am.symbolic, llc*, 116 USPQ2d at 1411. Therefore, the marks are confusingly similar.

In its brief, applicant acknowledged that the applied-for mark is identical to the registered mark. Applicant’s Brief at p.6.

B. APPLICANT AND REGISTRANT’S GOODS ARE RELATED

Applicant has stated an intent to use the applied-for mark in connection with “ceramic tiles; ceramic tiles for flooring, facing, lining and coverings; glazed ceramic tiles; mosaic art tiles made of marble; natural stone tiles” in International Class 19. The registration currently uses its mark to identify

“Non-metal building materials for use in building decks; non-metal fencing; non-metal lattices” also within International Class 19.

The goods of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000). TMEP §1207.01(a)(i). Moreover, where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the goods needed to support a finding of likelihood of confusion declines. See *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)); TMEP §1207.01(a).

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 registration, the identified goods 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 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).

In the present case, the identification of goods in the registration contains no limitations. Thus, it is presumed that the registrant’s “Non-metal building materials for use in building decks” encompasses all varieties of non-metal building materials that are used in the building and construction

of decks including the applicant's tiles. To illustrate that tiles are a type of non-metal building material commonly used in the construction of decks, the examining attorney attached the following Internet² evidence to the March 25, 2016 Final Office action and October 26, 2016 Denial of Request for Reconsideration:

- Handy Deck, showing an entity offering ceramic tiles for use on decks and outdoor spaces. Final Office action at pp. 2-4.
- Daltile, showing an entity offering ceramic porcelain tiles for pool decking. Final Office action at pp. 5-8.
- Swift Tile, showing an entity offering slate, sandstone, granite, and porcelain tiles for use on decks. Final Office action at pp. 16-20.
- Master Tile, showing an entity offering natural stone tiles for use on decks. Final Office action at pp. 26-28.
- Build Direct, showing an entity offering natural stone tiles for building decks. Request for Reconsideration Denial at pp. 28-29.
- Floor & Décor, showing an entity offering ceramic and natural stone tiles as material for outdoor decks. Request for Reconsideration Denial at pp. 30-39.
- Pavers and Decks, showing an entity offering natural stone tiles, namely, travertine, for use in building decks. Request for Reconsideration Denial pp. 40-41.

In its brief, applicant argues the parties' goods are not related because "one does not or would not construct decks, fencing and lattices of ceramic or mosaic tiles." Applicant's Brief at p.6. Applicant

² Evidence obtained from the Internet may be used to support a determination under Section 2(d) that goods and/or services are related. See, e.g., *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

claims the examining attorney applied an overly broad interpretation of the wording “building materials for use in building decks” and stretched the meaning to include the applied-for tiles rather than the actual lumber and composite board materials used by the registrant. Applicant’s Brief at p. 5-6. In support of this assertion, applicant submitted registrant’s specimen of record to illustrate that the registrant actually uses its mark in connection with composite decking board that “looks, installs, and works like wood but resists warping, rotting, and damage from weather. . .” rather than a type of tile. Id.

Applicant’s argument is premised on a narrow reading of the registrant’s identification of goods and limits the scope of applicant’s “Non-metal building materials for use in building decks” to exclusively lumber or composite board materials. When analyzing goods for similarity and relatedness, that determination is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). In the present case, the registrant’s goods are for non-metal building materials for use in building decks. The term deck is refers to a flat floored roofless area adjoining a house or a concrete or tile area surrounding a swimming pool. See Request for Reconsideration Denial at pp. 1-4. Thus, 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 identified in the registration including tiles intended for installation on decks or any roofless area adjoining a house. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald’s Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); see TMEP §1207.01(a)(iii).

Next, applicant argues that confusion is unlikely because it caters to sophisticated consumers. Although no evidence is provided to support this assertion, applicant claims deck materials and tiles are

not impulse purchases but expensive endeavors sold to discriminating customers. Applicant's Brief at pp.7-8.

As demonstrated by the evidence of record, the relevant consumer ranges from the experienced professional to amateur homeowners. See Request for Reconsideration Denial at pp. 42-62. When the relevant consumer includes both professionals and the general public, the standard of care for purchasing the goods is that of the least sophisticated potential purchaser. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014). Further, even if consumers of the compared goods could be considered sophisticated and discriminating, it is settled that "even sophisticated purchasers are not immune from source confusion, especially in cases such as the present one involving identical marks and related goods." *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1413 (TTAB 2015) (citing *In re Research & Trading Corp.*, 793 F.2d 1276, 1279, 230 USPQ 49, 50 (Fed. Cir. 1986)). The identity of the marks and the relatedness of the goods "outweigh any presumed sophisticated purchasing decision." *In re i.am.symbolic, llc*, 116 USPQ2d at 1413 (citing *HRL Assocs., Inc. v. Weiss Assocs., Inc.*, 12 USPQ2d 1819, 1823 (TTAB 1989), *aff'd*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990)).

Finally, applicant has submitted electronic copies of third-party registrations for marks containing the word VERANDA to support the argument the word is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. Applicant's Brief at pp.6-7. However, evidence comprising third-party registrations for similar marks with different or unrelated goods, as in the present case, is of limited probative value in determining the strength of a mark. See *Kay Chems., Inc. v. Kelite Chems. Corp.*, 464 F.2d 1040, 1042, 175 USPQ 99, 101 (C.C.P.A. 1972); *In re Thor Tech, Inc.*,

90 USPQ2d 1634, 1639 (TTAB 2009). Thus, these third-party registrations submitted by applicant are insufficient to establish that the wording VERANDA is weak or diluted.

In sum, the goods of the applicant and registrant are related and this factor weighs in favor of finding a likelihood of confusion. Therefore, because confusion as to the source of the goods is likely and any doubt must be resolved in favor of the registrants, the applied-for mark must be refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). 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).

CONCLUSION

The applied-for mark and the registrant's mark, both VERANDA, are likely to be confused by consumers. The evidence of record shows the marks are identical and the goods of applicant and registrant are so closely related that purchasers are likely to be confused, mistaken or deceived as to the source of the goods. For the foregoing reasons, the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) should be affirmed.

Respectfully submitted,

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