

ESTTA Tracking number: **ESTTA805654**

Filing date: **03/07/2017**

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

Proceeding	86693803
Applicant	Marble Systems, Inc.
Applied for Mark	VERANDA
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Submission	Reply Brief
Attachments	TMB7855ReplyBrief.pdf(63784 bytes)
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Date	03/07/2017

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

In re Trademark Application of	:	
	:	
MARBLE SYSTEMS, INC.	:	
	:	Examining Attorney JACKSON
Serial Number: 86/693,803	:	
	:	Law Office 120
Filed: July 15, 2015	:	
	:	
For: VERANDA	:	
	:	

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

Sir:

EX PARTE APPEAL
REPLY BRIEF FOR APPELLANT

This is a reply to the Examining Attorney’s Brief of February 15, 2017 in the above-identified application to register the mark VERANDA.

1. ARGUMENT

The Examining Attorney argues there may be a likelihood of confusion under Trademark Act Section 2(d) between U.S. Trademark Registration Number 3,178,672 for the mark VERANDA for the goods “NON-METAL BUILDING MATERIALS FOR USE IN BUILDING DECKS; NON-METAL FENCING; NON-METAL LATTICES” and Applicant’s mark

VERANDA Serial Number 86/693,803 for the goods “CERAMIC TILES; CERAMIC TILES FOR FLOORING, FACING, LINING AND COVERINGS; GLAZED CERAMIC TILES; MOSAIC ART TILES MADE OF MARBLE; NATURAL STONE TILES.”

The Trademark Examining Attorney has interpreted “decks” to cover patios or pool areas when the word’s common meaning is “b. a roofless floored area that adjoins a house”, *The American Heritage College Dictionary 3rd Edition*, pgs. 359-360 (see Exhibit B in Appeal Brief).

The goods on which both marks are used significantly differ as there is no relationship between the goods and no similarity between the goods which would support a finding of likelihood of confusion of the general public. The degree of relatedness must be viewed in the context of all factors, in determining whether the goods are sufficiently related that an ordinary consumer would be confused as the source or sponsorship.

Contrary to the argument of the Trademark Examining Attorney, Applicant’s goods are used in totally difference areas of construction, use different professional skills and are unrelated to Registrant’s goods. Decks are built primarily by carpenters in the decking industry. They are made of lumber and/or composite board. Tile is the subject of another building specialty using stone masons and tile cutters/setters which requires a totally different skill set, different adhesives, different cutting tools and different installation tools. Furthermore, Applicant provides relatively expensive goods to knowledgeable discriminating purchasers who pick the color and design of the tiles, the color of the grout and then pay thousands of dollars for a tile setter to cut and lay the tile in the predetermined design. There is little to no impulse buying of Applicant’s goods because of the complexity including the necessity for color coordination, size and pattern limitations. Generally speaking, wood and composite decks and tile projects costs tens of thousands of dollars with construction drawings and/or color layouts and require specialists in the field which do not

cross over to do deck construction or conversely, tile laying, cutting and setting.

The cited '672 registration noted above is for non-metal building materials for use in building decks, non-metal fencing and non-metal lattices. The term "decks" must be read together with fencing and lattice. The meaning and scope of the goods identified in an identification of goods must be given their ordinary meaning and not stretched to cover every possible interpretation. One does not or would not construct decks, fencing and lattices of stone tiles, ceramic and/or mosaic tiles. Decks are commonly used by the general public to describe wood or composite wood appearing structures extending from the side or back of a house or residential building. As can be seen by Exhibit A (specimen from the VERANDA '672 registration previously submitted), the '672 application as taken from the TSRD files of the United States Patent and Trademark Office), clearly show that the mark is used on composite decking board. The product overview in the specimen notes that it looks, installs and works like wood but resists warping, rotting and damage from weather or insect attack and is made from premium recycled wood and polymer. Indeed, the ordinary consumer chooses between composite board and wood boards when selecting for a building contractor to build a deck.

There is a clear distinction between the ceramic and natural stone tiles and mosaic tiles of Applicant and the specific decking board composite of the '672 registration. Applicant's goods are specifically different in composition and are noncompetitive. Furthermore, Applicant's goods are sold in completely different consumer settings.

The Trademark Examining Attorney has also cited a number of stone and ceramic tile articles to show use of the same in pool decks and has thus given a broader interpretation to the goods than would ordinarily be given by the normal purchaser.

Using the Trademark Examiner's argument that decks, encompass anything referred to as a

deck since boats have decks, the goods of the '672 registration would fall under an earlier VERANDA Registration 3,118,416 for boats. The internet citations of the Examining Attorney do not show a wide range of consumers nor the sophistication of the consumers. The goods of the present application and the '672 registration are totally different, have to meet different code specifications and have specifically different material composition and uses, as well as being installed by different building professionals in different channels of trade.


The essential inquiry is whether there is sufficient overlap of the perspective purchasers of the parties' goods to confuse actual and potential purchasers. Because the goods are used on construction projects that are "quite different" and sold to discriminating customers, there is no likelihood of confusion even though both parties use the identical mark. *Dynamics Research Corp. V. Langenau Mfg. Co.*, 217 USPQ 649 (Fed Cir. 1983).

In light of the actual narrow scope, use and installation of Applicant's goods, it is highly unlikely that the consuming public or the marketplaces for the goods of Applicant and those of the '672 Registrant overlap.

It is respectfully requested that the Examining Attorney refusal be withdrawn and the appeal be determined in favor of Applicant and the present Application passed to publication. If any costs are incurred, please charge Deposit Account Number 07-1340.

Respectfully submitted,

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