

This Opinion is not a
Precedent of the TTAB

Mailed: April 28, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Marble Systems, Inc.

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Serial No. 86693803

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John S. Hale of Gipple & Hale,
for Marble Systems, Inc.

Kara E. Jackson, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

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Before Bergsman, Greenbaum, and Hightower,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Applicant Marble Systems, Inc. seeks registration on the Principal Register of the mark VERANDA, in standard characters, for “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 19.¹

¹ Application Serial No. 86693803 was filed on July 15, 2015, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a *bona fide* intention to use the mark in commerce.

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as applied to the goods identified in the application, so resembles the mark VERANDA, in standard characters, previously registered on the Principal Register for "non-metal building materials for use in building decks; non-metal fencing; non-metal lattices" in International Class 19,² as to be likely to cause confusion, to cause mistake, or to deceive.

After the Examining Attorney made the refusal final, Applicant requested reconsideration and appealed to this Board. After reconsideration was denied, the appeal resumed and is now fully briefed.

We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

² Registration No. 3178672, issued November 28, 2006; renewed.

We first address the *du Pont* likelihood of confusion factor focusing on “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567).

Applicant’s mark and the cited mark consist entirely of the identical term VERANDA, in standard characters, as Applicant acknowledges.³ The first *du Pont* factor thus weighs strongly in favor of a finding that confusion is likely.

We next consider the second *du Pont* factor, the similarity of the goods. The test is not whether consumers would be likely to confuse the goods, but rather whether they would be likely to be confused as to their source. *In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012). Therefore, to support a finding of likelihood of confusion, it is not necessary that the goods be identical or even competitive. It is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such that they would be encountered by the same persons in situations that would give rise, because of the marks, to a mistaken belief that they originate from the same source or that there is an association or connection between the sources of the goods. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009).

Where, as here, the involved marks are identical, the degree of similarity between the goods required to support a finding that confusion is likely declines. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). It is necessary only that there be a

³ Appeal Brief at 6, 11 TTABVUE 10.

viable relationship between the two to support a finding of likelihood of confusion. *In re i.am.symbolic*, 116 USPQ2d 1406, 1411 (TTAB 2015).

Also where as here there are no limitations in the identification of goods in either the application or the cited registration, we must presume that the identified goods encompass all goods of the nature and type described therein. *See, e.g., Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1471 (TTAB 2016); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). A likelihood of confusion may be found with respect to a particular class based on any item within the identification of goods for that class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

We must make our determination regarding the similarities between the goods based on the goods as they are identified in the involved application and cited registration, respectively, not on any extrinsic evidence of actual use. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). In other words, an applicant may not restrict the scope of the goods covered in the cited registration by argument or extrinsic evidence. *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013); *see also Thor Tech*, 90 USPQ2d at 1638 (“We have no authority to read any restrictions or limitations into the registrant’s description of goods.”); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764-65 (TTAB 1986).

For these reasons, Applicant's arguments and evidence concerning the *actual* goods offered by Applicant and Registrant are not probative.

Here, Applicant's identified goods are "ceramic tiles; ceramic tiles for flooring, facing, lining and coverings; glazed ceramic tiles; mosaic art tiles made of marble; natural stone tiles." The goods identified in the cited registration are "non-metal building materials for use in building decks; non-metal fencing; non-metal lattices."

The Examining Attorney introduced evidence that third parties offer under the same mark both tile flooring on the one hand and non-metal building materials or non-metal fencing on the other, and also that some ceramic and natural stone tiles are marketed specifically for use in building decks. These third-party uses include:

- Build Direct: tile flooring, non-metal building materials, and deck tiles⁴
- Menards: tile and stone flooring and non-metal fencing⁵
- Handy Deck: ceramic deck tiles⁶
- Daltile: natural stone tiles for pool decking⁷
- Master Tile: natural stone deck tile⁸
- Tile Lines: natural stone tiles for decks⁹
- Tiling Treasures: exterior ceramic and natural stone deck floor tile¹⁰

⁴ October 27, 2015 Office Action at TSDR 4-5 and Reconsideration Letter at TSDR 27-29 (from builddirect.com).

⁵ October 27, 2015 Office Action at TSDR 8-13 (from menards.com).

⁶ March 25, 2016 Superseding Final Office Action at TSDR 2-4 (from handydeck.com).

⁷ *Id.* at 5-9 and Reconsideration Letter at TSDR 48-51 (from daltile.com).

⁸ March 25, 2016 Superseding Final Office Action at 26-27 (from mastertile.net).

⁹ Reconsideration Letter at 42-47 (from tilelines.com).

¹⁰ *Id.* at 59-62 (from tiling-treasures.com).

This evidence shows that the kinds of goods identified in the application and cited registration may emanate from a single source under the same mark. It also shows that the ceramic and natural stone tiles identified in the application can constitute “non-metal building materials for use in building decks.”

Based on the record evidence discussed *supra*, we find that the goods identified in the application and cited registration are related and overlapping in part. In our likelihood of confusion analysis, this finding under the second *du Pont* factor also strongly supports a finding that confusion is likely.

Finally, we address Applicant’s contention that its customers are sophisticated.¹¹ This argument concerns the fourth *du Pont* factor, the “conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” *Id.*, 177 USPQ at 567. Applicant introduced no evidence concerning what the cost of its goods will be, but did submit evidence that a composite decking board is offered under the cited mark for \$34.37.¹²

We do not find the record evidence sufficient to establish that the goods identified in the subject application and cited registration are expensive or sold only to discriminating customers. Precedent requires that we base our decision on the least sophisticated potential purchasers. *Stone Lion*, 110 USPQ2d at 1163. Even assuming that some consumers of the identified goods are sophisticated, moreover, it is well-

¹¹ See, e.g., Appeal Brief at 7, 11 TTABVUE 11; Reply Brief at 2, 14 TTABVUE 3.

¹² Request for Reconsideration, 4 TTABVUE 19, which Applicant states is from the specimen submitted with Registrant’s combined filing under Trademark Act Sections 8 & 9. *Id.* at 2.

settled that careful or sophisticated purchasers are not immune from source confusion, especially in cases involving identical marks:

That the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods. “Human memories even of discriminating purchasers . . . are not infallible.” Sophistication of buyers and purchaser care are relevant considerations, but are not controlling on this factual record.

In re Research & Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986). (citation omitted). For these reasons, we find the fourth *du Pont* factor to be neutral.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, as they pertain to the relevant *du Pont* likelihood of confusion factors. To the extent that any other *du Pont* factors for which no evidence was presented by Applicant or the Examining Attorney may nonetheless be applicable, we treat them as neutral. We have found that Applicant’s mark is identical to the cited mark; the goods identified in the subject application and cited registration are related and overlapping; and the remaining *du Pont* factors are neutral.

We find that Applicant’s mark is likely to cause confusion with the mark in cited Registration No. 3178672 when used in association with the goods identified in the application.

Decision: The refusal to register Applicant’s mark is affirmed.