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

Proceeding	92051645
Party	Plaintiff Masonite International Corporation and Masonite Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Cancellation No. 92051645  
of Registration No. 3,284,513 For **GLENVIEW DOORS**

<b>Masonite International Corporation and Masonite Corporation,</b>	:	
	:	
	:	
<b>Petitioners,</b>	:	
	:	<b>Cancellation No. 92051645</b>
<b>v.</b>	:	
	:	
<b>Doors for Builders, Inc.,</b>	:	<b>Registration No. 3,284,513</b>
	:	
<b>Registrant.</b>	:	

**POST-TESTIMONY TRIAL BRIEF OF PETITIONERS MASONITE  
INTERNATIONAL CORPORATION AND MASONITE CORPORATION**

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Petitioners, Masonite International Corporation (“MIC”) and Masonite Corporation (“MC”) (collectively “Petitioners”) respectfully submit this post-testimony trial brief in support of their petition to cancel pursuant to 15 U.S.C. § 1064 Registration No. 3,284,513 for GLENVIEW DOORS & Design as applied to wooden and glass doors (“the Registration”) owned by Doors for Builders, Inc. (“Registrant”). Oral hearing is requested.

**I. PRELIMINARY STATEMENT**

This cancellation proceeding boils down to the issue of priority rights for the mark GLENVIEW. Registrant claims an earliest date of use in commerce of March 30, 2006 on its registration, and has made no attempt to establish an earlier date. Petitioners, on the other hand, first used their GLENVIEW mark as early as January 14, 2006 at the largest annual light construction builders’ show in the world, a trade show attended by Petitioners and their actual and prospective customers, namely product manufacturers, builders, and remodelers. At the trade show, Petitioners presented existing and new products, including the soon to be released GLENVIEW door with a clearly visible GLENVIEW placard mounted thereon, in an elaborate and highly visible display booth that include a second floor, two meeting rooms for private discussions with customers, and interactive counters. Forty (40) of Petitioners’ sales representatives each met with an estimated 40 to 70 customers over the course of the multi-day trade show. These sales representatives were trained as to pricing, size and architectural features of the GLENVIEW door, and were instructed to inform each customer that the intended release date for the GLENVIEW door was scheduled for 2006. In short, Petitioners’ marketing and pre-sales conduct at the January 2006 Show were calculated to attract the attention of their existing and prospective customers and to create an association between the GLENVIEW mark and Petitioners. Petitioners were very successful in creating a substantial impact with their customers

at the trade show. As such, when the GLENVIEW door went on sale in December 2006, Petitioners sold hundreds of thousands of doors in the first full year of introduction.

Market-constraint problems beyond Petitioners' control, in particular the short supply of dies necessary for manufacture of the door, caused the sale of the GLENVIEW door to be delayed until December 2006. Trial testimony clearly indicates that Petitioners never intended to abandon their launch of the GLENVIEW door announced at the 2006 Show, and as intended, Petitioners carried out the launch as soon as the market-constraint problems were resolved. Registrant's counsel cross-examined each of Petitioners' witnesses and did not elicit any evidence to the contrary. Further, over this period of "delay," Petitioners wrote more than 1200 customers in a letter dated July 26, 2006 to inform them of the effect of market capacity constraints on production of the GLENVIEW door, and to assure the customers that they would be informed when the GLENVIEW door would be available for purchase. Further, in November and December 2006, Petitioners sent advertising brochures and displays to their customers in anticipation of the launch. In short, Petitioners acted in a commercially reasonable manner to overcome market-constraint problems beyond their control while keeping their customers informed as to Petitioners' continued intent to make the GLENVIEW door commercially available in 2006, a goal that Petitioners achieved.

For these reasons, Petitioners respectfully request that the Trademark Trial and Appeal Board (the "Board") grant Petitioners' Notice of Cancellation, cancel U.S. Registration No. 3,284,513, and approve Petitioners' trademark application Serial No. 77/133,127 for registration.

## II. STATEMENT OF THE FACTS

### A. Procedural History

Petitioner MIC filed an intent-to-use (“ITU”) trademark application, application Serial No. 77/133,127 (the “‘127 trademark application”), on March 16, 2007 for the mark GLENVIEW as applied to non-metal entry doors. (Ps’ Notice of Reliance (“NOR”) Ex. A [MC00113-19].) On June 26, 2007, the U.S. Patent & Trademark Office (“PTO”) issued a Notice of Suspension, suspending the application pending disposition of Registrant’s trademark application 77/031,888 for GLENVIEW DOORS and Design as applied to wooden and glass doors in Class 19. (Ps’ NOR A [MC00106-10].) The Registrant’s ‘888 application subsequently registered as U.S. Registration No. 3,284,513 on August 28, 2007 (the “Registration”). (Ps’ NOR A [MC00102-03].) On December 26, 2007, the PTO refused the ‘127 trademark application under 15 U.S.C. § 1052(d) (“Section 2(d)”) as being likely to be confused with the Registration. (Ps’ NOR A [MC00099-103].) The Registration claims a date of first use of March 30, 2006 and a filing date of October 30, 2006. (Ps’ NOR A [MC00102-03].)

On June 25, 2008, MIC amended the description of goods in its ‘127 trademark application to read “non-metal entry doors formed primarily from composite materials” in International Class 19, and requested reconsideration of the Section 2(d) refusal. (Ps’ NOR A [MC00082-96].) On July 15, 2008, the PTO issued a Final Office Action maintaining the Section 2(d) refusal. (Ps’ NOR A [MC00025-77].) MIC renewed its request for reconsideration of the refusal on January 12, 2009. (Ps’ NOR A [MC00019-24].) The PTO denied the renewed request on February 13, 2009. (Ps’ NOR A [MC00011-13].)

Petitioners filed a Petition for Cancellation of the Registration on October 23, 2009, asserting, *inter alia*, priority to the GLENVIEW mark by virtue their use of the mark prior to the



claimed date of first use of the Registration. (D.E. 1.) Registrant filed a first motion for summary judgment on January 6, 2011. (D.E. 9.) The next day, January 7, 2011, the Board denied the summary judgment motion as untimely. (D.E. 10.) The Board seemingly cautioned Registrant that the undisputed facts included in the Registrant's summary judgment motion seemed to make out a case for prior analogous use by Petitioners, a legal doctrine that Registrant failed to recognize or cite in its summary judgment motion:

In its motion, respondent seeks entry of summary judgment on the ground that petitioner cannot establish prior use in commerce of its pleaded GLENVIEW mark on the identified goods. In addition to establishing priority through use of a mark in interstate commerce, priority may be established on the basis of intrastate use of a mark or use of a term as a trade name. See *Panda Travel Inc. v. Resort Option Enterprises Inc.*, 94 USPQ2d 1789 (TTAB 2009). Further, priority can be established through use of a mark between the United States and a foreign country. See Trademark Act Section 45, 15 U.S.C. Section 1127. In addition, priority can also be established through use analogous to trademark use. See *Westrex Corp. v. New Sensor Corp.*, 83 USPQ2d 1215 (TTAB 2007). To establish prior analogous use sufficient to create proprietary rights, petitioner must show prior activities sufficient to create an association in the minds of the purchasing public between the mark and the petitioner's goods. See *Malcolm Nicol & Co. v. Witco Corp.*, 881 F.2d 1063, 1065, 11 USPQ2d 1638, 1639 (Fed. Cir. 1989). A showing of analogous use does not require direct proof of an association in the public mind. See *T.A.B. Systems v. Pactel Teletrac*, 77 F.3d 1372, 1375, 37 USPQ2d 1879, 1882 (Fed. Cir. 1996). Nevertheless, the activities claimed to create such an association must reasonably be expected to have a substantial impact on the purchasing public before a later user acquires proprietary rights in a mark. See *id.*

(D.E. 10, p. 2.)

Registrant filed a request for reconsideration on January 14, 2011, in which Registrant asserted that its summary judgment motion was timely. (D.E. 11.) The Board denied the Registrant's request for reconsideration on January 21, 2011. (D.E. 14.) Subsequently, proceedings were suspended while the parties engaged in settlement negotiations, which ultimately proved unsuccessful. (D.E. 25-30.)

The parties took testimony from a total of 5 witnesses (4 called by Petitioners and 1 called by Registrant), each of which is listed below:

<u>Witness</u>	<u>Title/Description</u>
Dale Mayfield (for Petitioners)	MIC Vice President of Marketing (Mayfield Dep. 6:2-7:6.)
Keith Kometer (for Petitioners)	MC Vice President of Product Management & Marketing Services (Kometer Dep. 4:17-6:22.)
Lawrence P. Repar (for Petitioners)	MC Executive Vice President & Chief Operating Officer (Repar. Dep. 4:9-6:5.)
Jason W. Caulk (for Petitioners)	MC Director of Product Management for Interior Doors (Caulk Dep. 5:15-6:19.)
Slava A. Tenenbaum (for Registrant)	Doors for Builders, Inc. President (Tenenbaum Dep. 5:14-8:10.)

Petitioners and Registrant filed their Notices of Reliance on December 17, 2010 and March 10, 2011, respectively. (D.E. 7, 20-21.)

**B. The Parties**

**1. Petitioners**

Petitioners are part of a global organization in the business of the manufacture, sale and distribution of light construction building products, including doors and door accessories, since at least as early as 1928. (Ps' NOR Ex. C, Ex. LL.) MIC is the Canadian-based parent of its wholly-owned subsidiary MC, which is the United States-based operation that sells Petitioners' products, including non-metal entry doors, to homebuilders, remodelers, third-party distributors and retailers, and other such housing professionals. Petitioners' customers include wholesale distribution customers, such as Home Depot and Lowes, who each buy Petitioners' doors and then resell them to consumers. (Kometer Dep. 13:14-14:15, 26:4-27:28:7, 29:10-21, Ps' Ex. 21;

Ps' NOR Ex. XX.) Throughout their extensive history, Petitioners have become well-known to consumers and in the trade as suppliers of doors, door components and door accessories, among other products.

**2. Registrant**

According to its twice-denied summary judgment motion, Registrant is an Illinois corporation that distributes and sells glass and wood doors under a GLENVIEW DOORS and Design trademark. (D.E. 9, pp. 1-2.) Registrant purports to use the mark in connection with wooden and glass doors. (D.E. 9, p. 2.)

**C. Petitioners' Prior Analogous Use of GLENVIEW Dates to January 2006, Which Is More Than Two Months Before Registrant's Priority Date**

The International Builders' Show (the "Show") is an annual multi-day trade show that is the largest of its kind in the world. (Mayfield Dep. 7:10-12, 11:18-24, Mayfield Ex. 1; Repar Dep. 6:9-19, 11:4-22, Repar Exs. 1 and 2; Ps' NOR Exs. B and Z-CC.) In January 2006, the Show set a record attendance (at least at the time) of approximately 105,000 housing professionals. (*Id.*) As was the case in 2006, the Show is routinely attended by product manufacturers, builders, and remodelers, and is also open on one day for public attendance. (Mayfield Dep. 7:24-8:7; Repar Dep. 8:9-23.) Petitioners have been regularly attending and setting up sales booths at the Show for approximately the last 60 years, with the January 2006 Show in Orlando, Florida being no different. (Repar Dep. 6:20-7:12, 8:9-9:15; Ps' NOR Ex. Z.) The annual Show, including the 2006 Show, provides Petitioners with the opportunity to exhibit new technology, reinforce marketing of existing door and glass products, launch new products (such as GLENVIEW), and build and maintain business relationships. (Mayfield Dep. 7:13-23, 8:8-10:12; Repar Dep. 7:13-8:11, 8:24-9:15.) The attendees at the Show, especially distributors

and retailers, represent Petitioners' target customer market. (Mayfield Dep. 9:5-10; Repar Dep. 11:23-12:1.) Registrant admitted to Petitioners' display of interior doors (non-metal entry doors) at the January 2006 Home Builders Show in Orlando, Florida as an undisputed fact in its summary judgment motion. (D.E. 9, p. 2, lns. 16-17, p. 6, lns. 21-22.)

Petitioners' GLENVIEW door was among their products on display at the January 2006 Show as part of their "Anniversary Collection." (Mayfield Dep. 11:25-13:8, Mayfield Ex. 2; Repar Dep. 9:16-11:1, 12:4-24, 30:6-32:20, Repar Exs. 2 and 13; Ps' NOR Ex. EE, Ex. GG-II, Ex. WW, Ex. YY.) Petitioners' booth at the January 2006 Show covered a large area, displaying six (6) door pods and including a second floor and two (2) meeting rooms for private discussions with customers. (Repar Dep. 9:9-10:6.) Petitioners' products were viewable by anyone walking through or around the booth. (Mayfield 21:8-18.) Counters at either end of the sales booth allowed customers to swipe an identification card in order to request that marketing literature be sent to them. (Repar Dep. 10:7-15.)

Petitioners had approximately forty (40) sales representatives attend the January 2006 Show. (Repar Dep. 15:13-21; Mayfield Dep. 10:23-11:1.) The sales representatives were tasked with personally greeting existing and prospective customers and taking them on a tour of Petitioners' booth to show and discuss with them new and existing products. (Mayfield Dep. 10:23-11:9; Repar Dep. 10:16-18, 15:13-21.) The morning before the January 2006 Show, Petitioners' sales representatives were trained by Dale Mayfield, Vice President of marketing for Petitioner MIC, who gave an internal presentation to educate the sales representatives with respect to new product information, including the size, pricing, architectural features and intended release date for the GLENVIEW door. (Mayfield Dep. 18:13-19:19:8, 20:10-21, 33:22-34:16, Mayfield Ex. 13.) Mr. Mayfield emphasized to the sales representatives that this

information was to be passed along to customers, and that customers were to be informed that all new products, including the GLENVIEW door, would be available in 2006. (*Id.*) Armed with this information and instructed to disseminate it to the Show's attendees, each of the approximately forty (40) sales representatives took approximately 40 to 70 customers through Petitioners' booth and apprised them of Petitioners' products, including the GLENVIEW door, as instructed by Mr. Mayfield. (Mayfield Dep. 10:15-18; Repar Dep. 15:13-21.)

In line with Petitioners' customary practice, Petitioners mounted a placard with the GLENVIEW mark on the GLENVIEW door at the January 2006 Show. (Mayfield Dep. 13:9-14:21, 15:6-18:12, Mayfield Exs. 2-3; Repar Dep. 12:25-14:6, 16:2-17:1, 28:8-29:9, Repar Exs. 2-3.) Petitioners individually labeled each of their doors with their respective product marks, including GLENVIEW, so that their products were easily identifiable by their customers. (Repar Dep. 16:19-17:1.) The placard was observable by customers at the booth, and Masonite employees were prepped prior to the Show to discuss the GLENVIEW door with customers as part of the Anniversary Collection. (Mayfield Dep. 14:22-15:5, 18:17-21:3, Mayfield Ex. 13; Repar 14:7-15:21, 16:2-17:1, Repar Ex. 3.)

After the January 2006 Show, Petitioners sent a letter dated July 26, 2006 to their approximately 1200 customers (at the time) referencing the display of the GLENVIEW door and other Anniversary-Series doors that were displayed at the January 2006 Show, and stating, *inter alia*, that market capacity constraints, and in particular difficulties throughout the industry in obtaining dies, had caused a delay in the launch of the GLENVIEW door, and that customers would be kept updated as to Petitioners' progress in making the GLENVIEW door available for purchase. (Mayfield Dep. 24:1-26:21, Mayfield Ex. 5; Repar Dep. 18:7-19:18; 20:7-22:20, Repar Ex. 5.) These market-capacity constraints applied throughout the molded door industry,

not just to Petitioners. (Repar Dep. 18:7-23.) Registrant admitted to Petitioners having sent the July 2006 letter as an undisputed fact in its summary judgment motion. (D.E. 9, pp. 2-3.) At no time did Petitioners ever not intend to launch the GLENVIEW door. (Repar Dep. 21:22-24.) In fact, Petitioners were ready to start production, but for the market capacity constraints that caused the delay. (Repar Dep. 22:1-19.)

In November 2006, Petitioners printed and distributed an advertising brochure containing a photograph of the GLENVIEW door, characterizing it as part of the Anniversary Collection. (Kometer Dep. 7:14-9:1, Kometer Ex. 6.) In addition, in November 2006 Petitioners updated their Molded Door Facing Dimensions Specifications guide to include the GLENVIEW door. (Kometer Dep. 12:21-14:1-15, Kometer Ex. 6.) It was and continues to be Petitioners' standard practice to distribute such materials to their customers. (Kometer Dep. 9:2-16, Kometer Ex. 6.)

On December 8, 2006, Petitioners sent another letter to their customers announcing the availability of and providing pricing for the GLENVIEW door, and indicating that Petitioners would "begin accepting orders for Glenview on December 18, 2006." (Mayfield Dep. 27:1-28:5, Mayfield Ex. 11; Kometer Dep. 20:12-23:14, Kometer Ex. 11; Caulk Dep. 13:8-19, 14:11-14, Caulk Ex. 11.) Petitioners sent the letter to "multiple thousands" of customers. (Kometer Dep. 21:16-24; Caulk Dep. 13:20-14:10.) Also in December 2006, Petitioners sent out 30"x80" GLENVIEW-labeled "display doors" and "hand samples" to their customers for the purpose of placing them in the customers' showrooms or forwarding them to downstream retailers to increase product awareness. (Mayfield Dep. 28:6-31:13, Mayfield Ex. 11; Kometer Dep. 17:13-20:9, Kometer Ex. 10; Caulk Dep. 14:15-18.) As of the date of Mr. Kometer's deposition, the door displays and hand samples were on display at such distributor locations as Home Depot.

(Kometer Dep. 26:6-27:17, Kometer Ex. 21.) Registrant admitted to Petitioners having sent the December 2006 letter as an undisputed fact in its summary judgment motion. (D.E. 9, p. 3.)

Despite the delays in the GLENVIEW launch caused by problems beyond Petitioners' control, in particular the industry-wide market constraints with regard to the procurement of dies, Petitioners at no time abandoned their plan to launch the GLENVIEW door as soon as those problems were resolved. (Mayfield Dep. 25:4-9; Repar Dep. 21:19-22:20.) Petitioners started selling GLENVIEW doors to customers in December 2006 and sold 291 GLENVIEW doors in the first days after introduction, and over 22,000 GLENVIEW doors in the following first quarter of 2007. (Caulk Dep. 6:24-13:7, Caulk Ex. 4; Ps' NOR Exs. ZZ-BBB.)<sup>1</sup> Since its introduction in January 2006 and first sales in December 2006, GLENVIEW has been one of Petitioners' most popular doors and has been advertised continuously using, for example, brochures, website postings, specification guides, hand samples, articles, *etc.* To be sure, Petitioners have sold hundreds of thousands of units to their customers. (Repar Dep. 4-18:6, Repar Ex. 4; Kometer Dep. 6:25-20:9, 23:17-31:19, 33:4-9, Kometer Ex. 6-10, 12, and 20-21; Caulk 6:24-13:7, Caulk Ex. 4; Ps' NOR Ex. D-P, R-U, W, DD-KK, UU-WW, and YY.)

**D. Registrant's Alleged First Use of GLENVIEW**

The Registration recites a date of first use of the GLENVIEW DOORS & Design mark as March 30, 2006. (D.E. 9, p. 2.) Registrant has neither asserted nor established an earlier date of first use during these proceedings. Registrant has claimed that it did not attend or show its

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<sup>1</sup>Any documents designated by Petitioners as confidential, including but not limited to pages 6-13 of the Caulk Deposition, Petitioners' Exhibits 4 and 13, and NOR Exhibits ZZ, AAA, and BBB, should continue to be treated as confidential, except to the extent that specific information (such as December 2006 sales data) has been expressly disclosed in this Trial Brief.

GLENVIEW DOORS & Design product(s) at the January 2006 International Builders' Show.  
(Tenenbaum Dep. 36:4-10.)

### **III. ARGUMENT**

In order to cancel a registration on the Principal Register, “the petitioning party must show both standing and valid grounds for cancellation.” *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1161, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002). That is, the petitioner must show that it will be damaged by the registration and that the mark falls within “any of the specifically enumerated grounds under which a registration may be canceled at any time.” See Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 20:52 (4<sup>th</sup> ed. 2010). One basis for cancellation is Section 2(d) of the Lanham Act. To prevail under Section 2(d), the petitioner must prove that it has prior rights in the mark vis-à-vis the registrant, and that a likelihood of confusion exists as between the marks. See *Herbko Int'l*, 308 F.3d at 1161-62, 64 USPQ2d at 1378.

#### **A. Petitioners Have Standing**

A petitioner for cancellation of a registration has standing if it “pleads and proves that it has a real interest in the outcome of the proceeding, beyond that of the general public.” *A.V. Brands, Inc. v. Spirits Int'l, B.V.*, Cancel. No. 92043340, 2009 WL 1068777, \*4 (TTAB Mar. 31, 2009). Indeed, pursuant to Section 14 of the Lanham Act, 15 U.S.C. § 1064, a petition for cancellation of a registration may be filed by “any person who believes he is or will be damaged by the registration of a mark.” By virtue of an application for registration of a mark, which has been rejected by the PTO based on a prior registration, a petitioner can establish standing. See *American Vitamin Prods. Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992); *Hartwell Co. v. Shane*, 17 USPQ2d 1569, 1570 (TTAB 1990). Here, Petitioners' '127 trademark



application for GLENVIEW has been refused based upon Registrant's '513 Registration for GLENVIEW DOORS and Design. Registrant has never disputed or raised standing as an affirmative defense. Thus, by virtue of Petitioners' pleading of the PTO's Section 2(d) refusal of Petitioners' '127 trademark application as causing likely confusion with Registrant's Registration, Petitioners have standing.

**B. The Parties Have Each Conceded Likelihood of Confusion**

In their Petition for Cancellation, Petitioners asserted that "Registrant's mark GLENVIEW DOORS & Design is substantially similar to [Petitioners'] mark GLENVIEW." (D.E. 1, p. 3.) In its Answer, "Registrant admit[ted] that there is a likelihood of confusion between Registrant's mark GLENVIEW DOORS and Design and [Petitioners'] mark GLENVIEW." (D.E. 4, p. 3.) The PTO likewise found likelihood of confusion, refusing Petitioners' '127 trademark application in light of the Registration. (Ps' NOR A [MC00011-13, MC00025-77, MC00099-103].) Hence, likelihood of confusion, and thus a basis for cancellation, is not contested and has been established.

**C. Petitioners Have Established Priority Through Analogous Use**

What Registrant has failed to recognize, despite the Board's words of caution in its Decision denying Registrant's summary judgment motion, is that Petitioners' display and promotion of its GLENVIEW door at the January 2006 multi-day trade show gives Petitioners priority under the doctrine of analogous use. (D.E. 10, p. 2 (citing *Westrex Corp. v. New Sensor Corp.*, 83 USPQ2d 1215 (TTAB 2007).) As explained by the Board in its Decision denying summary judgment,

[t]o establish prior analogous use sufficient to create proprietary rights, petitioner must show prior activities sufficient to create an association in the minds of the purchasing public between the mark and the petitioner's goods. See *Malcolm*

*Nicol & Co. v. Witco Corp.*, 881 F.2d 1063, 1065, 11 USPQ2d 1638, 1639 (Fed. Cir. 1989). A showing of analogous use does not require direct proof of an association in the public mind. See *T.A.B. Systems v. Pactel Teletrac*, 77 F.3d 1372, 1375, 37 USPQ2d 1879, 1882 (Fed. Cir. 1996). Nevertheless, the activities claimed to create such an association must reasonably be expected to have a substantial impact on the purchasing public before a later user acquires proprietary rights in a mark. See *id.*

(D.E. 10, p. 2.)

Analogous use is such as to “create the required association in the minds of potential purchasers between the mark as an indicator of a particular source and the service to become available later.” *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 1376, 37 USPQ2d 1879, 1882 (Fed. Cir. 1996) (citation omitted). “[U]nder any and all of the articulations of the test, it is actual public perception that is required.” *T.A.B. Sys.*, 77 F.3d at 1376, 37 USPQ2d at 1883. Use analogous to trademark use includes evidence such as advertising brochures, advertising in catalogues and newspapers, and in press releases and trade publications. *T.A.B. Sys.*, 77 F.3d at 1375, 37 USPQ2d at 1881; *Malcolm Nicol & Co. v. Witco Corp.*, 881 F.2d 1063, 1065, 11 USPQ2d 1638, 1639 (Fed. Cir. 1989) (citing J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 20:4 at 1023-26 (1984)). Furthermore, the Board has found that displays at industry trade shows constitutes use analogous to trademark use. See *Jimlar Corp. v. Army & Airforce Exch. Serv.*, 24 USPQ2d 1216 (TTAB 1992) (finding that a trade show display of opposer’s product, with the mark conspicuously appearing on the product, would be expected to have a significant impact on opposer’s prospective customers and therefore constituted use analogous to trademark use). Indeed, the Board has elaborated that

[w]hether a particular piece of evidence by itself established prior use is not necessarily dispositive as to whether a party has established prior use by preponderance. Rather, one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use.

*Weatherford/Lamb, Inc. v. C&J Energy Servs., Inc.*, 96 USPQ2d 1834, 1838 (TTAB 2010)  
(citation omitted).

1. **Petitioners' 2006 Show Booth and Sales Representatives Had a Substantial Impact By Promoting the GLENVIEW Door to a Substantial Number of Customers**

The January 2006 International Builders' Show provided Petitioners with an opportunity to reach a substantial segment of their pertinent purchasing public. At the time in question, January 11-14, 2006, the Show was the world's most prominent and largest annual trade show for the building products industry, which necessarily included the door industry. The January 2006 Show had 105,000 housing professionals in attendance, making the 2006 Show the most successful ever at that time. Attendees of the January 2006 multi-day Show included product manufacturers, builders, retailers and remodelers, which collectively formed and continue to form the crux of Petitioners' customer base and target market. Having attended and displayed their products at the Show for approximately 60 years, Petitioners were well known by, and had established relationships with, actual and prospective customers among the Show's attendees.

Petitioners' activities at the January 2006 Show were of such a nature and extent that they created public identification of the target term, *i.e.*, GLENVIEW, between Petitioners and their GLENVIEW door. Petitioners' elaborate display booth prominently displayed the new line of "Anniversary-Collection" doors, which included the GLENVIEW door that was conspicuously identified with a visibly mounted GLENVIEW placard. Petitioners provided personalized attention to existing and prospective customers by manning the booth with approximately forty (40) trained sales representatives who greeted customers and personally escorted them through the booth while highlighting existing and new products, including the GLENVIEW door, which were displayed in the booth. Petitioners' sales representatives not only displayed the door, but

presented customers with information concerning the size, pricing, and architectural features of the GLENVIEW door. Even those Show attendees who did not receive personalized attention were able to view Petitioners' products, including the GLENVIEW door clearly and conspicuously identified by the visibly mounted placard with the GLENVIEW mark, by walking through or around the booth. Thus, Petitioners were able to advertise and build public perception of the GLENVIEW door to a substantial audience filled with their target actual and prospective customers, thereby creating a substantial impact as to public identification between Petitioners' doors and the GLENVIEW mark.

Finally, Petitioners' sales representatives at the January 2006 Show "inform[ed] and apprise[d] prospective purchasers of the present or future availability of" Petitioners' GLENVIEW door. *T.A.B. Sys.*, 77 F.3d at 1376, 37 USPQ2d at 1882. Petitioners' trained representatives informed customers the GLENVIEW door was to be released for sale in 2006, and provided pricing and size information for the GLENVIEW door. Moreover, as pointed out above, Petitioners were known leaders in the door manufacturing market, and regularly used the Show to commercially launch their products.

In *Jimlar Corp. v. Army & Airforce Exch. Serv.*, 24 USPQ2d 1216, 1221 (TTAB 1992), this Board found that the display of a sample product with a prominently featured patch showing the mark at a quarterly industry trade fair constituted use analogous to trademark use, even though no pre-orders were taken at the trade fair.

The trade show display of the Highland-style boot, with the patch illustrating the "A CLUB" mark conspicuously appearing on the product, would be expected to have a significant impact on prospective customers for opposer's boots. Notably, it was of a sufficient nature and extent as to create, in the mind of the potential purchasers of opposer's goods who attended the several-day affair, an association of the "A CLUB" designation with opposer's goods, especially in light of the fact that orders for the goods followed relatively shortly thereafter.

*Id.* See also *Marvel Comics Ltd. v. Defiant*, 837 F. Supp. 546, 549, 28 USPQ2d 1794, 1796 (S.D.N.Y. 1993) (finding use established based on “promotion of ‘Plasmer’ [mark] at ‘the most significant annual convention in the comic book business,’ attended by thousands of industry participants and readers ..., might establish sufficient publicity”).

As in *Jimlar* and *Marvel*, Petitioners showed their conspicuously marked goods at a multi-day trade show, which happened to be the most well-attended trade show for the door industry, to thousands of actual and prospective customers. Indeed, a more compelling case for finding analogous use by Petitioners can be made than there was in *Jimlar* and *Marvel*. In *Jimlar*, the opposer had “several of its salespeople” at the trade show to exhibit its goods, whereas Petitioners had 40 trained sales representatives, each meeting with a substantial number of actual and prospective customers. *Jimlar*, 24 USPQ2d at 1218. In *Marvel*, approximately 1500 copies of a promotional brochure were distributed at a comic book convention, 28 USPQ2d at 1795, whereas Petitioners’ 40 sales representatives each personally met with an estimated 40 to 70 customers, eclipsing the 1500 contacts of *Marvel*. Also significant, Petitioners conducted one-on-one personalized meetings with customers, which included private discussions in the booth’s two meeting rooms. These contacts were far more meaningful and had a much more substantial impact than the contacts in *Marvel*, where customers were handed brochures.

2. **Advertising Was Sufficiently Clear and Repetitious to Maintain the Source Identification Between GLENVIEW and Petitioners**

Following the January 2006 Show, Petitioners continued to commercially promote their GLENVIEW mark as applied to non-metal entry doors. Petitioners kept their customers informed of the status of the GLENVIEW door by sending letters to their more than 1200 customers in July 2006 and December 2006. The July 2006 letter in particular explained that

“overall market constraints,” which were beyond Petitioners’ control, delayed the launch of the GLENVIEW product “until further notice to ensure that we [Petitioners] are prepared to service your business on these new products.” (Mayfield Ex. 5.) The July 2006 letter also provided pricing information concerning the GLENVIEW product. Clearly, the July 2006 letter is the type of promotional activity intended to inform a significant segment of Petitioners’ customers that the GLENVIEW product would soon be available for purchase.

Additionally, even before the first GLENVIEW door sales in December 2006, Petitioners rolled out their advertising and promotional campaign. For example, in November 2006, Petitioners disseminated an advertising brochure containing a photograph of the GLENVIEW door, characterizing it as part of the Anniversary Collection. In addition, Petitioners updated their Molded Door Facing Dimensions Specification guide in November 2006 to include the GLENVIEW door. Then, in December 2006, Petitioners sent their customers 30”x80” GLENVIEW-labeled “display doors” and “hand samples” for the purpose of placing them in their showrooms or sending them to downstream customers to increase product awareness.

Although market-constraint problems that were beyond Petitioners’ control caused a slight delay in the launch of the GLENVIEW door, trial testimony clearly indicates that Petitioners never intended to abandon their launch of the GLENVIEW door as soon as the market-constraint problems were resolved. Indeed, Registrant’s counsel cross-examined each of Petitioners’ witnesses, and did not elicit any evidence to the contrary. Further, “[w]ith use analogous to trademark use, the proper inquiry is whether any delay between such use and actual, technical trademark use is commercially reasonable.... [W]hen use analogous to trademark use is involved, the user need not necessarily have a capacity to produce goods for sale under the involved mark at the time of the analogous use.” *Dyneer Corp. v. Automotive*

*Prods., PLC*, 37 USPQ2d 1251, 1255-56 (TTAB 1995) (citations omitted). Petitioners “delay” of less than a year between its first analogous use in January 2006 and technical trademark use was attributable to market-constraint conditions beyond Petitioners’ control, thus making the “delay” commercially reasonable.

3. **Petitioners Demonstrated Continuous and Substantial Sales After Product Launch**

The substantial impact made by the January 2006 Show is manifested by the Petitioners’ significant sales of their GLENVIEW door. Indeed, Petitioners sold 291 GLENVIEW doors in the first few days after launch, and hundreds of thousands of units over the first year after launch. Petitioners’ sales dwarf the level of sales discussed in *Jimlar*, where the Board stated that substantial revenue enjoyed based on analogous use is evidence of use of such a nature and extent as to have created an association in the mind of the consuming public between the mark and the goods. See *Weatherford/Lamb, Inc.*, 96 USPQ2d at 1840, *Jimlar*, 24 USPQ2d at 1221 (citations omitted).

4. **Petitioners Have Established Priority Over Registrant**

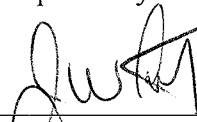
For reasons set forth above, Petitioners’ priority date is no later than January 14, 2006, *i.e.*, the last day of the 2006 Show at which Petitioners used the GLENVIEW mark in a manner analogous to trademark use. The earliest priority date asserted by Registrant (and set forth in the Registration) is more than two months later, specifically March 30, 2006. Petitioners have established prior proprietary rights in the GLENVIEW mark, warranting cancellation of the Registration and approval of Petitioners’ ‘127 trademark application.

**IV. CONCLUSION**

Petitioners Masonite International Corporation and Masonite Corporation respectfully request that the Board cancel Registrant's U.S. Registration No. 3,284,513 and approve Petitioners' trademark application 77/133,127 for registration.

It is believed that no fees are due with this submission. Should that determination be incorrect, then please debit account 50-0548 and notify the undersigned.

Respectfully submitted,



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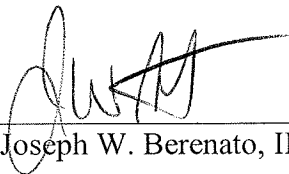


**CERTIFICATE OF SERVICE**

I, Joseph W. Berenato, III, hereby certify that on this 11<sup>th</sup> day of May, 2012, I caused a true and correct copy of POST-TESTIMONY TRIAL BRIEF OF PETITIONERS MASONITE INTERNATIONAL CORPORATION AND MASONITE CORPORATION to be served by e-mail and United States Mail, first-class postage prepaid, addressed as follows::

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