

ESTTA Tracking number: **ESTTA1157093**

Filing date: **09/01/2021**

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

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Damon H Hawkins		
Entity	Individual	Citizenship	UNITED STATES
Address	2301 TRURO DRIVE MCKINNEY, TX 75071 UNITED STATES		

Correspondence information	JOHN GREGORY BAKER BAKER LAW FIRM 3717 NASH LN PLANO, TX 75025 UNITED STATES Primary Email: drassoff1776@yahoo.com Secondary Email(s): j baker@PlanoPatentLaw.com, j baker@PlanoTrademarkLaw.com, j baker@AlohaPatentLaw.com 9724673445		
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Registration Subject to Cancellation

Registration No.	6472739	Registration date	08/31/2021
Registrant	Kain, William 14026 BETHANY CHURCH ROAD MONTPELIER, VA 23192 UNITED STATES		

Goods/Services Subject to Cancellation


Class 009. First Use: 2021/05/28 First Use In Commerce: 2021/05/28 All goods and services in the class are subject to cancellation, namely: Safety protection platform system for supporting workers and materials on a sloped roof, comprised of ridge hooks, roofjacks, and supporting cables there between
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Dilution by blurring	Trademark Act Sections 14(1) and 43(c)
Deceptiveness	Trademark Act Sections 14(3) and 2(a)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration	4731108	Application Date	09/04/2014
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No.			
Registration Date	05/05/2015	Foreign Priority Date	NONE
Word Mark	STEEPGEAR ROOF SAFETY WEAR		
Design Mark			
Description of Mark	The mark consists of the wording "STEEPGEAR" above the wording "ROOF SAFETY WEAR" with "STEEP" in orange, "GEAR" in gray, and "ROOF SAFETY WEAR" in black and a design that consists of wording "STEEPGEAR" outlined in black, four chevrons above the wording outlined in black, and the left half of the four chevrons in gray and right half of the four chevrons in orange.		
Goods/Services	Class 009. First use: First Use: 2014/06/07 First Use In Commerce: 2014/06/07 Clothing for protection against accidents		

Attachments	86385662#TMSN.png(bytes) Petition_for_cancellation_of_STEEPSEAT_09_01_2021.pdf(695188 bytes)
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Signature	/John Gregory Baker/
Name	John Gregory Baker, Esq.
Date	09/01/2021

Petition for Cancellation of Trademark

STEEPSEAT

US Serial Number: 90157844 & US Registration Number: 6472739

Petition filing date 9/01/2021

STEEPGEAR ROOF SAFETY GEAR [Plaintiff] 4731108 5/5/2015

VS.

STEEPSEAT [Defendant] 90157844 registered on 8/31/2021

1) Short and Plain Statement:

The owner [Plaintiff] of STEEPGEAR ROOF SAFETY WEAR (“STEEPGEAR”) US Serial Number 86385662 which was filed in 09/04/2021 and was registered on 5/5/2015 under US Registration Number 4731108 is being damaged by the filing of the new mark STEEPSEAT. STEEPGEAR is being robbed of the goodwill and marketing and fame of the STEEPGEAR mark which has a strong association with roofing gear and roofing safety. The new mark STEEPSEAT is leveraging for free and without consent the notoriety and strength of the STEEPGEAR name tied to the roofing industry, roofing products, and roofing safety apparatus. The junior mark STEEPSEAT is confusingly similar to the senior mark STEEPGEAR and is diluting the Plaintiff’s mark by blurring. STEEPSEAT misrepresented to the USPTO the true mark logo they are using in commerce and did not file the true colored mark containing the look and feel and commercial impression of the STEEPGEAR mark they are actually using in commerce. The goods for sale cited in the specimen of the STEEPSEAT trademark application does not match the category chosen in the application. In applying the

court's 8 factor test as to whether marks are confusingly similar, 7 of the 8 tests are in Plaintiff's favor and one is neutral.

2) **Standing:**

Plaintiff is Damon Howard Hawkins and owns the USPTO Trademark US Serial Number 86385662 filed on 09/04/2014; STEEPGEAR ROOF SAFETY GEAR (STEEPGEAR). US Registration Number is 4731108 and was Registered on 05/05/2015; STEEPGEAR. Plaintiff has a personal stake in the cancelation of the newly registered trademark as the newly registered trademark STEEPSEAT will in the future pouching STEEPGEAR customers to STEEPSEAT. PLAINTIFF has a bona fide intent to manufacture more Roofing Gear products. Actual confusion has already occurred as Plaintiff as received requests for STEEPSEAT products.

3) **The 30-day opposition period has passed**

The mark was not noticed by Plaintiff with in the 30-day publication opposition period.

4) **The ultimate issue is consumer confusion**

The trademark reader will find this is not a simple case of a side-by-side comparison of the marks themselves and the comparison of the sales categories. Contained in this case are latent subtleties and some potential sneakiness coming into play. At the outset, and before drilling down into the standard 8 factor likelihood of confusion test, it needs to be pointed out the bottom-line test is whether or not the new mark entering the stage creates a likelihood of confusion as to the source of the goods. This is not an accumulation of score card of points being added up on the likelihood of

confusion test factors, but rather whether the overall impression of consumers in the marketplace leads them to believe that the products being offered under the the new and similar mark is providing products to the exact same source of goods as the first.

5) Strength and Recognition of Plaintiff's Mark in Roofing Gear

In remembering the basics, the trademark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it which represents the trademark's owners' source of goods. Here, the Plaintiff's mark which has been used going on for 10 years.



The Plaintiff's mark and roof safety quality products are well known by roofers, insurance adjusters, pest control companies, painters, tree trimmers, homeowners, Christmas light installers, and anyone with a need to be on a roof. Further, **STEEPEGEAR ROOFING SAFETY WEAR** has been in roof safety community and tradeshow for going on 10 years. The Plaintiff being an insurance roofing adjuster as been spending now much of his life wanting to protect others from roofing accidents after seeing his colleagues die of roofing falls. May they rest in peace.

Even though the sales category selected under the original mark was clothing for protection against accidents Plaintiff's **STEEPEGEAR ROOFING SAFETY WEAR** is thought of as roof safety in the minds of the consuming public. This is because of

Plaintiff's product marking, desire for roof safety, marketing and ROOF SAFETY in is also in the literal name of Plaintiff's logo. Plaintiff is well known in the roofing and roof safety community as is his brand containing roof safety, colors orange and grey, and at least one chevron design.

It is unfair competition to pass off your goods as those of another producer by using a trademark confusingly similar to that of the other producer. Remedies in Trademark infringement are designed to ensure where the owner of a trademark has spent energy, time and money in presenting to the public the product, he is protected in his investment from the appropriation by pirates and cheats. Trademark Law Targets Dishonest Trade Diversion. Here, product diversion is going from Plaintiff and flowing to Defendant.

Here, the defendant is marketing his products in commerce under:



STEEPSEAT in the exact shades of the color orange and gray and with a chevron at Plaintiff's STEEPGEAR ROOF SAFETY. Defendant's chosen sales category is a system for supporting workers and materials on a sloped roof. No matter what it was called, Defendant's product at tradeshow and on their website is a roof safety device designed to protect against roofing accidents.



So, we are not misled by the differences in sales category it is shown that in commerce both Plaintiff and Defendant are selling roof safety products designed to protect against roofing accidents.

6) Misrepresentation of the true in commerce logo

Defendant's Intellectual Property Law Firm filing the trademark application and or the Defendant chose to select the plain jane literal STEEPSEAT as the image mark not the heavily used STEEPSEAT mark used in Defendant's advertising. Defendant's



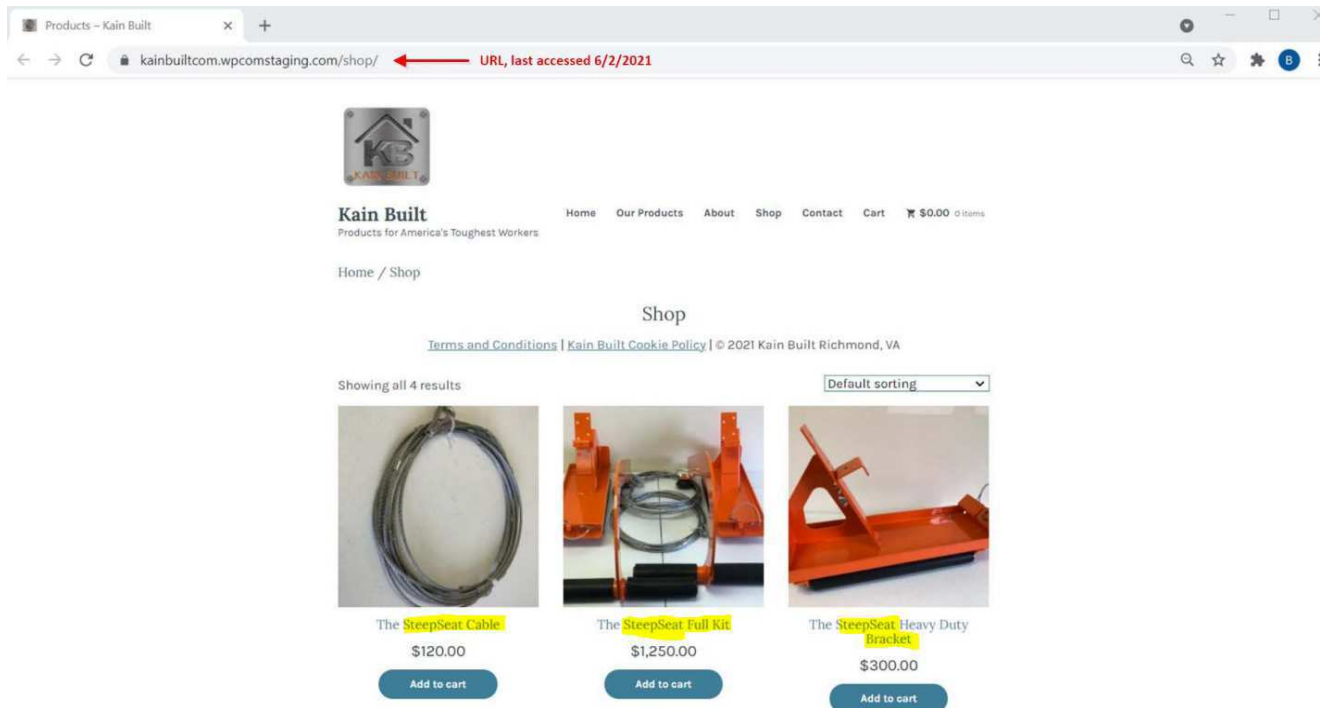
image is misappropriating the Plaintiff's look

and feel and overall commercial impression of Plaintiff's mark creating actual user confusion.

This avoidance of Defendant uploading the true mark in the trademark application hides the similarities with Plaintiff's registered mark. SteepGear.



The Defendant's application specimen is show below for convenience:



Showing all 4 results

Default sorting ▼



The SteepSeat Cable

\$120.00

Add to cart



The SteepSeat Full Kit

\$1,250.00

Add to cart



The SteepSeat Heavy Duty Bracket

\$300.00

Add to cart

rather than the logo used heavily in the advertising and brochure material of the Defendant's true SteepSeat product.

7) Specimen products do not match sales category – sales category insufficiency

What is shown in the specimen is some collateral accessories pieces of the main SteepSeat product shown below. Further, the sales category is abstract not truly letting others know what the Defendant is selling. "System for supporting workers and materials on a sloped roof." Safety protection platform system for supporting workers and materials on a sloped roof, comprised of ridge hooks, roof jacks, and supporting cables there between.

8) Insufficiency of Sales Category

The word System is a bit abstract for a trademark sales category to put others on notice to what sales goods would be infringed and what would not as far as the “System”. Here the specimen filed in the patent application shows only a cable, and a Full Kit and a Heavy-Duty Bracket for sale, these are component parts of a system not a complete system. Defendant’s “system” for sale is shown below. The mark specimen does not match the “system” sales category. The specimen does not really match the “System for....” Since a system would comprise, multiple components as one complete system package and not separate components. For this reason, the mark should be cancelled since specimen is not showing the “System” for sale but a few separate components. The specimen and the sales category do not match. Thus, the sales category does not match the specimen. Component parts are not a system.

9) Avoidance of filing true mark-logo in the Trademark Application.

It is interesting to note that Defendant filed for protection of the mark STEEPSEAT as a literal with claiming no stylization, colors or combined design logo. However, from tradeshow to tradeshow, website-to-website, and many STEEPSEAT brochures, and the true mark selling Defendant’s product in commerce is not the plain jane STEEPSEAT literal but rather the same look and feel and commercial impression of Plaintiff’s mark which was avoided to be uploaded as the image the application. The plain jane logo uploaded in the trademark application is not so honest as the true mark that the defendant is truly using in commerce.



does not = STEEPSEAT

Again, the mark as filed in Defendant's Trademark Office application is not the mark truly used and heavily advertised and used in commerce selling the complete **SteepSeat** product. On this reason alone, the Trademark Registration should be cancelled. It seems the not so honest concealment of the true mark being used in commerce to sell Defendant's product that mirrors the colors, chevron, and overall look and feel of **STEEPGEAR ROOFING SAFETY** could be cancelled on lack of full honesty.

If the mark that has been really used in commerce on the websites, and at the tradeshows in marketing the product with Plaintiff's same colors and chevron as the top of the triangle was filed in the application, this may have caused the trademark examining attorney to another look. In the trademark examining attorney taking another look, it is likely the trademark examiner would have found a "borrowing" putting it nicely, of Plaintiff's look and feel of the mark, and the ultimate issue, that the roof safety equipment consumers in the market place would believe the products were from the same source. Affidavits of some of these consumers believing the products are from the same source will be provided. We can see a parallel of trade dress here and why there was a need for trade dress law.

If after this petition for cancellation is filed, and then Defendant's website, marketing brochures, and tradeshow mockup changes to have just the literal STEEPSEAT instead of the real mark being used should not be given any weight and

allowed as evidence in response to this petition. What should matter is what the circumstances were at the time of the filing of the trademark application.



It is what the Defendant was really using in the market place at the time the application was filed that counts in addressing any honesty of mark used in commerce issues. The evidence will show the mark used in commerce is as above and does not match the plain jane literal mark likely used to get around the similarity of the look and feel and overall commercial impression of the Plaintiff's mark used in commerce both selling roofing safety equipment.

10) Marks are confusingly similar

Going back to the real test of consumer confusion rather than the technicality of of scorecard points on the 8-factor test, consider the well know Reese's case below.



If we look at the literals, the wording and trade channels, we could find the marks are distinctive enough and even the sales category. However, common sense prevailed and the look and feel of the marks and overall commercial impression were just too similar. Someone buying Toffee Crisp would likely think this candy was from the same source of goods as Reese's. Someone in a rush would even think it is a small Reese's peanut butter cup.

This is what is happening here,



The marks are so confusingly similar actual confusion has already taken place as Plaintiff's **STEEPGEAR** company has received requests for the **SteepSeat** roof safety seat believing **SteepSeat** belongs to the same company and source of goods as **STEEPGEAR**.

11) Lack of good faith in filing the STEEPSEAT mark

Further, for all the same confusingly similar reasons, Plaintiff's mark is being diluted by blurring his look, feel, and commercial impression of his mark into an new marks in roofing gear, roofing safety apparatus that contain the similar look and feel.

12) Lack of good faith in filing the STEEPSEAT mark

Defendant has used much of Plaintiff's advertising verbiage. This is going to the point it was not a coincidence Defendant is hiding their main logo using the same colors, chevron, and look and feel of Plaintiff's mark. We can say, Defendant borrowed the tradedress of Plaintiff's mark. Defendant tried to be on the down low when filing their plain jane mark.

The usurpation of Plaintiff's look and feel was not an accident. The Plaintiff and Defendant for years and before defendant filed for the mark, have attend the same tradeshows and **STEEPGEAR** can almost 7 years before **SteepSeat**

A recent list of exhibitors for these types of International Roofing Expos are shown below.

Listing of International Roofing Expo 2021 exhibitors

From: Damon Hawkins (damon@steepgear.com)
To: drassoff1776@yahoo.com
Date: Wednesday, August 25, 2021, 04:41 PM CDT

4:40



rof221.mapyourshow.com

SRS Distribution Inc. consists of a family of industry-leading, independent roofing distributors with a common goal and purpose: to focus all of our efforts on serving th...

Starwrap Inc

3423



Starwrap Inc is an innovative, customer-oriented, and global manufacturer of high-quality synthetic roofing underlayment materials. Our high-quality woven products have b...

STC Safety Training & Compliance

3529



Steep Seat

1/2

8/25/2021

Yahoo Mail - Listing of International Roofing Expo 2021 exhibitors

Steep Seat

2349

SteepSeat

SteepGear, LLC

3425

Steinel America, Inc.

1506

↑ Back to Top

STEINEL is a global organization dedicated to the

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13) The Eight Point Factor Test

a) Strength of the Mark

Plaintiff's is well known in all the roofing, safety, and tradeshow throughout the country. For 10 years Plaintiff has worked on developed his product, gave presentations, seminars at roofing and safety tradeshow. STEEPGEAR is well known in the roofing and safety community and has great strength in the market place. Just googling STEEPGEAR will show how well known it is. Contrarily, STEEPSEAT is only known because it piggybacks off of STEEPGEAR's more than 7 years of advertising and successful product launch and wide range of sales in each of the categories from roofers, to insurance adjusters, to painters, pest control workers, Christmas light installers, tree trimmers, homeowners, and anyone needing to be on a roof. This factor weighs in Plaintiff's favor.

b) Similarity of the mark

STEEPSEAT VS. STEEPGEAR - seven letters are the same out of 9. Only two letters are different. The trademark office knows well the first words in the mark are given the most weight and remembrance in consumers mind. Here STEEP relating to roofing calls to mind STEEPGEAR. Further, because of Plaintiff's successful sales, hard work, time spent, labor, and money in advertising just saying the word steep anything in conjunction with roofing brings to mind Plaintiff's product in roofing safety.



This has many parallels to this case below:



In both instances, we can see the look and feel of the image was appropriated.

The real mark used in commerce and prominent mark at the same tradeshow
STEPPGEAR attends uses the very similar look, feel, and commercial impression.

This factor weighs in Plaintiff's favor.

- c) Proximity of the products – both products are selling roofing safety products in commerce. No matter what class of good is chosen in the sales category. STEPPGEAR is selling roofing safety gear, currently anti-slip slip-on slip-over roof safety shorts and other roof safety products. STEEPSEAT is just starting to sell ROOF Safety Seats, both help prevent the roofer from sliding to an unfortunate end like Plaintiff's own father.

Looking at the STEPPGEAR mark it also contains the literal ROOF SAFETY WEAR.

There is no doubt to the consumers the product channels are the same. It is the

consumers confusion that is at test here, not some technicality difference in the chosen sales category. The consumers buying these products believe both are from the same company.

This factor weighs in Plaintiff's favor.

d) *Bridging the gap* – Defined as: whether the senior user of the mark is likely to enter the market in which the junior user is operating. Here, the Plaintiff is the senior user of going towards 10 years lead time and he is selling roof safety gear even though his category chosen was “clothing for protection against accidents”. It would be obvious from Plaintiff's mark this is safety gear for roofs. Looking at the literal of the mark STEEPGEAR ROOF SAFETY WEAR it is likely STEEPGEAR would and is selling other roofing gear and would sell platforms on roofs.

The gap should be bridged in Plaintiff's favor.

e) *Actual confusion*

Actual confusion has already occurred by Donald Graham, Kevin Kramer, and Michael Lance, and many other consumers requesting the platform seat products under the mark STEEPSEAT. Plaintiff has three affidavits of the above consumers names and is currently acquiring more.

This factor definitely weighs in Plaintiff's favor.

f) Defendant's Good Faith

There is absolutely no evidence of good faith on the part of the Defendant in this action. To the contrary, verbiage of Plaintiff's advertising and outlining structure has made it from Plaintiff's advertising to Defendant's advertising. The Defendant has had many years looking and Plaintiff's logo and design colors as evidence shows they attend the same roofing tradeshow for many past years. Looking at the true mark Defendant is really using to sell his product it has exactly same look and feel of Plaintiff's. How come Defendant did not upload the true mark logo that Defendant is promoting at the tradeshow, and its real online advertising and brochures? This is some kind of sneakiness. Moreover, it cannot be said Defendant just did not know how to upload a design image, he used an IP law firm to file his trademark. Defendant did not even use a regular Attorney, but it seems an IP law firm for this case would be needed and one was sought out.

Filing the plain jane literal mark rather than the one used in commerce, this was likely to avoid this certain trigger of consumer confusion in the purchasing of roofing gear.

This factor weighs in Plaintiff's favor.



g) Quality of Defendants' products

Plaintiff has spent years trying to develop the right safety gear to make sure it is the safest possible and is designed to save lives. Plaintiff has used the very best materials he could find even though the product price is a little higher as a result. To Defendant's credit, it looks as though he is using better materials than he has to. So, unlike the usual knock-off watch cases, this factor does not directly pertain to this case. However, if Defendant later proceeded to manufacture inferior infringing goods this would debase Plaintiff's mark.

h) Sophistication of the Buyers

Purchasers of the roofing safety products are more worker types in a rush and they are just grabbing a product and going to their work site to get the job at hand completed. They don't have time for trademark trickery in analyzing the differences to understand these products are not from the same company or the family of companies are not related. They are not sophisticated enough to understand the orange and grey and chevron design of STEEPGEAR and STEEPSEAT are not of the same company and not from the same source of goods.

This factor weighs in Plaintiff's favor.

14) Importance of quality if roof safety products

In past times guilds required members to display their marks for the purpose of developing and maintaining the collective goodwill of the guild; marks. This was so consumers would expect a certain level of quality from the guilds. This protected the consumers in quickness of product selection saving time. Today, when it comes to safety products, if a new company's product was not as safe as the old this would hurt

the consumer. It would seem to give the consumers standing to sue when the consumers are confused by one company's use of a mark similar to other companies and they chose a defected product. When it comes to purchasers of roofing safety products, the difference between a good product and a bad product is, well serious bodily injury or death. Then comes negligence actions, product liability actions, and wrongful death actions. This is not to say Defendant's product is unsafe. In looking at the pictures of Defendants product they look to be well built with good quality parts. The attorney's issue in advocating for Plaintiff is that the mark actually being used in commerce is too close and confusingly similar, and consumers are calling up Plaintiff to purchase Defendant's products. This is labeled as actual confusion. Defendant's actual stylized and colorized version of the mark used in commerce to sell the product has appropriate Plaintiff's look and feel and overall commercial impression of Plaintiffs mark. Even if we now go back and compare to the Plain Jane Literal mark of STEEPSEAT, to SteepGear because of the previous marketing of **SteepSeat** with the look and feel and commercial impression of **STEEPGEAR ROOFING WEAR** that has taken place consumers will still associate STEEPSEAT with STEEPGEAR. Maybe the companies should merge. But this petition for now requests the STEEPSEAT mark to be cancelled. Plaintiff has spent tens of thousands of dollars on branding for the last 7 years and Plaintiff's goodwill in the mark needs to be protected.

Respectfully filed,

/John G Baker/

Attorney & Counselor at Law

972 467-3445

Bar Admissions

Admitted in the United States Patent and Trademark Office

Admitted in all four United States District Courts of California

Admitted in all four United States District Courts of Texas

Admitted in the State of California

Admitted in the United States Bankruptcy Court for the Eastern District of Texas

Admitted in the United States Tax Court

Admitted before the United States Supreme Court