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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re VCNA Prestige Material Holdings, Inc.

Serial Nos. 85144490 and 85144501

Angela Alvarez Sujek, Susan M. Kornfield, and Karen H. Anderson
of Bodman PLC for VCNA Prestige Material Holdings, Inc.

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Before Quinn, Cataldo and Taylor,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

VCNA Prestige Material Holdings, Inc. filed, on October 4,
2010, applications to register the mark PRESTIGE CONCRETE
PRODUCTS (in standard characters), and the mark shown below



both for "concrete, not including architectural masonry units,
namely, glazed concrete blocks used for interior walls" in
International Class 19 (application Serial Nos. 85144490 and

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85144501, respectively). Applicant disclaimed the words "CONCRETE PRODUCTS" in each application. Each application is based on allegations of first use anywhere and first use in commerce on July 1, 2009.

The trademark examining attorney refused registration in each application under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, when used in connection with applicant's goods, so resembles the previously registered mark PRESTIGE SERIES (in standard characters) ("SERIES" disclaimed) for "architectural masonry units, namely, glazed concrete blocks used for interior walls" in International Class 19¹ as to be likely to cause confusion.

When the refusal was made final in each application, applicant appealed. Applicant and the examining attorney filed briefs.

The two appeals involve common issues of law and fact, and the evidentiary records and arguments are essentially identical. Accordingly, the Board will decide the appeals in this single opinion.

Applicant concedes that "the word PRESTIGE may be the dominant part of the [marks] given the fact that the words "CONCRETE PRODUCTS" and "SERIES" are all disclaimed"; applicant

¹ Registration No. 3044687, issued January 17, 2006; combined Sections 8 and 15 affidavit accepted and acknowledged.

goes on to argue, however, that registrant's marks are not strong due to third-party adoptions of "PRESTIGE" marks for goods in Class 19. (Brief, p. 9). Applicant also asserts that while even weak marks are worthy of protection, confusion is unlikely to occur because the goods are different and not competitive, and are not commonly provided by the same source. Applicant also points to the sophistication of purchasers, and to the contemporaneous use of the marks for three years without any known instances of actual confusion. In support of its arguments, applicant submitted ten third-party registrations of "PRESTIGE" marks for goods in Class 19, and an excerpt retrieved from registrant's website.²

The examining attorney maintains that the word "PRESTIGE" is the dominant portion in all of the marks, due to the disclaimed and more subordinate nature of the words "CONCRETE PRODUCTS" in applicant's marks and "SERIES" in registrant's mark. The examining attorney also asserts that the goods, trade channels and purchasers are similar. In support of the refusal, the examining submitted an excerpt from registrant's website,

²Applicant, in its response dated July 20, 2011, provided only a link to registrant's website. This was insufficient to make the evidence of record, and it has not been considered. See *Calypto Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1216-19 (TTAB 2011). However, in view of the examining attorney's failure to object thereto until his appeal brief, as pointed out in applicant's reply brief, we have considered the updated website excerpt presented as Attachment 1 to the reply brief.

excerpts from third-party websites, and copies of third-party registrations.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first direct our attention to the *du Pont* factor of the similarity/dissimilarity between the marks. We must compare the marks in their entirety as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1690 (Fed. Cir. 2005), quoting *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is

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likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

It is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable."). Where both words and a design comprise the mark (as in applicant's logo mark), then the words are normally accorded greater weight because the words are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods and/or services. *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed"); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*,

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228 USPQ 461, 462 (TTAB 1985). See also *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). In applicant's logo mark, the literal portion of the mark, namely the words "PRESTIGE CONCRETE PRODUCTS," is the dominant portion; and, in turn, due to the generic nature of the words "CONCRETE PRODUCTS," the literal portion is dominated by the only source-identifying word, namely "PRESTIGE," which appears in much larger font. Thus, the word "PRESTIGE" in applicant's marks is the dominant feature.

Likewise, registrant's mark is dominated by the word "PRESTIGE" for the same reasons due to the disclaimer of "SERIES." See, e.g., *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming Board's finding that "DELTA," not the disclaimed generic term "CAFÉ," is the dominant portion of the mark THE DELTA CAFÉ); and *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (finding that "BINION'S," not the disclaimed descriptive wording "ROADHOUSE," is the dominant portion of the mark BINION'S ROADHOUSE).

Thus, the dominant portions of the marks are identical, a point not lost on applicant when it stated, as already noted, "the word PRESTIGE may be the dominant part of the [marks] given the fact that the words "CONCRETE PRODUCTS" and "SERIES" are all disclaimed." In discussing the dominant portion of the marks, we recognize, of course, that the marks ultimately must be

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compared in their entireties, including any disclaimed words, design feature and minimally stylized lettering. When this comparison is made, we find that each of applicant's marks is similar to registrant's mark in sound, appearance and meaning. Because of these similarities, applicant's and registrant's marks engender similar overall commercial impressions, namely, that the products have a high standing among other competing products.

The similarity between each of applicant's marks and registrant's mark weighs in favor of a finding of likelihood of confusion.

We next turn to consider the second *du Pont* factor regarding the similarity/dissimilarity between the goods. It is well settled that the goods of applicant and registrant need not be identical or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of applicant and registrant are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB

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1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

We make our determination regarding the similarities between the goods, channels of trade and classes of purchasers based on the goods as they are identified in the applications and cited registration, respectively. See *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Further, because the involved identifications include no restrictions as to trade channels or classes of purchasers, the recited goods must be presumed to travel through all normal trade channels and be marketed to all possible classes of relevant purchasers. See *Interstate Brand Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1913 (TTAB 2000).

Accordingly, we compare registrant's "architectural masonry units, namely, glazed concrete blocks used for interior walls" to applicant's "concrete, not including architectural masonry units, namely, glazed concrete blocks used for interior walls." A main argument of applicant is, of course, the presence of the exclusionary language in its identification of goods, that is, a specific exclusion of the goods identified in the cited registration.

In short, we discount applicant's addition of the exclusionary phrase to the identification of goods in each application as an ineffective attempt to avoid a finding that the involved goods are similar. As indicated above, the goods need not be identical to support a finding of likelihood of confusion. In this case, both types of goods fall under the general category of concrete products; and it would appear that concrete and glazed concrete blocks used for interior walls are complementary products. If goods are complementary in nature, or used together, this relatedness can support a finding of likelihood of confusion. *See, e.g., In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); and *In re Toshiba Medical Systems Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009) (medical MRI diagnostic apparatus and medical ultrasound devices are related, in part because they have complementary purposes and may be used by the same medical personnel on the same patient to address the same medical issue).

Furthermore, the examining attorney submitted, in an attempt to show that the goods are related, several use-based third-party registrations showing that the same entity has registered the same mark for the types of goods involved in this appeal, namely concrete and concrete blocks. We recognize that none of the third-party registrations lists both "concrete" and

"architectural masonry units, namely, glazed concrete blocks used for interior walls." However, each of the registrations lists both "concrete" and "concrete blocks." The term "concrete blocks" is broadly worded, and as such, encompasses all types of concrete blocks, including both structural and architectural. Thus, these "concrete blocks," as broadly identified, are presumed to include glazed concrete blocks used for interior walls. "Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source." *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988). See also *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The examining attorney also introduced six excerpts of third-party websites showing that both types of goods, namely concrete and concrete blocks, may emanate from the same source.

Given the relatedness of concrete and glazed concrete blocks, the goods are likely to move in similar trade channels (e.g., Home Depot, Lowes, building materials outlets and the

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like), and are marketed to similar classes of purchasers (e.g., contractors and do-it-yourself homeowners).

Thus, the factors of the similarity between the goods, and the overlap in trade channels and classes of purchasers weigh in favor of a finding of likelihood of confusion.

One of applicant's main arguments is that registrant's mark is a weak mark entitled to only a narrow scope of protection. Applicant's argument is based on the alleged "common use" of the word "PRESTIGE" in trademarks for building materials in Class 19 and, in this connection, applicant introduced ten third-party registrations. This registration evidence does not prove that "PRESTIGE" is a weak mark in the building materials industry. Absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); and *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011). See also *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) ("As to strength of a mark, however, registration evidence may not be given any weight"). We also have considered this evidence, however, as

similar to that of a dictionary showing how language is generally used. See *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987). Clearly, the word "PRESTIGE" appearing in a trademark is, at the very least, laudatorily suggestive; the word conveys an idea that the product is superior or worthy of a high standing. But, in this case, the marks all convey the identical, indistinguishable suggestion. Lastly, and in any event, as often stated, even a weak mark is entitled to protection against the registration of a similar mark for related goods. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974). This factor is neutral or, at best, weighs slightly in applicant's favor.

Applicant argues that the purchase of applicant's and registrant's goods involves some degree of sophistication. First, applicant has failed to support this argument with any evidence. Second, the identifications of goods, as noted above, are broad enough to cover concrete and glazed concrete blocks that would be purchased by do-it-yourself homeowners. Even presuming that these individuals are somewhat discriminating when it comes to home improvement goods, it is settled that even sophisticated purchasers are not immune from source confusion, especially in cases such as the instant one involving very similar marks and similar goods. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), *citing*

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Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd., 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers...are not infallible."). See also *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). We find that the similarities between the marks and the goods sold thereunder outweigh any presumed sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods). Thus, this factor is neutral.

Applicant's assertion, in this ex parte proceeding, of the contemporaneous use of applicant's and registrant's marks for a period of three years without actual confusion is entitled to little weight. See *In re Majestic Distilling Co., Inc.*, 65 USPQ2d at 1205 ("uncorroborated statements of no known instances of actual confusion are of little evidentiary value"). See also *In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of applicant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). *In re Binion*, 93 USPQ2d at 1536; *In re 1st USA Realty Professionals Inc.*, 84

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USPQ2d 1581, 1588 (TTAB 2007); and *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984). In any event, the record is devoid of probative evidence relating to the extent of use of applicant's and registrant's marks and, thus, whether there have been meaningful opportunities for instances of actual confusion to have occurred in the marketplace. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); and *In re Wilson*, 57 USPQ2d 1863, 1869 (TTAB 2001) ("[I]nasmuch as we have heard from neither registrant nor the Highland Orange Association in this appeal, we cannot conclude that, in fact, no instances of actual confusion ever occurred."). Accordingly, the *du Pont* factor of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion is considered neutral.

Based on the record before us, we find that the *du Pont* factors, on balance, weigh in favor of a finding of likelihood of confusion.

To the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

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Decision: The refusal to register in each application is affirmed.