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Mailed:
March 15, 2007
Bucher

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re The Innovative Companies LLC

Serial No. 76640746

Myron Amer of Myron Amer, P.C. for The Innovative Companies LLC.

Paul C. Crowley, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Bucher, Zervas and Walsh, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant, The Innovative Companies LLC. seeks registration on the Principal Register of the mark **STONE DEPOT** *(in standard character format)* for services originally recited in the application as "wholesale and retail store services for natural stone, man-made stone, and tiles, and advising on the end uses thereof."[1] When this recitation

[1] Application Serial No. 76640746 was filed on June 13, 2005 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. No claim is made to the word "Stone" apart from the mark as shown.

was found to be indefinite, applicant proposed an amendment of the recitation to "services featuring end uses of quarry stones as kitchen countertops and bathroom vanities," a description placed by applicant, once again, in International Class 19.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon two different grounds.

*(1)* The Trademark Examining Attorney contends that applicant's proposed amendment to the recitation of services is unacceptable. Absent applicant's compliance with the requirement for an acceptable recitation of services, registration has been refused. 15 U.S.C. § 1062(b); 37 C.F.R. § 2.64(a).

*(2)* The Trademark Examining Attorney has also refused registration of applicant's mark based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney asserts that applicant's mark, when used in connection with the recited services, so resembles the trademark **STONE TILE DEPOT.COM** *(in standard character format)* registered in connection with "wholesale and retail store services

for natural stone, man made stone and tile" in International Class 35,[2] as to be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney submitted briefs. We affirm both refusals to register.

## ***Unacceptable recitation of services***

Applicant's original recitation of services, as filed, was "wholesale and retail store services for natural stone, man-made stone, and tiles, and advising on the end uses thereof" in class 19. Clearly, services are not classified in International Class 19. We also agree with the Trademark Examining Attorney that the "advising" language needed some clarification. Nonetheless, with minor tweaking, it appears likely that this original description of applicant's goods/services could well have been changed to an acceptable recitation of services in International Class 35, for example.

However, in response to the initial Office action, applicant asked that the description of services be

[2] Registration No. 3005046 issued to Marble Systems Inc. of Fairfax, VA on October 4, 2005, based upon an application filed on January 23, 2004 having claims of first use anywhere and first use in commerce at least as early as March 12, 2003. No claim is made to the words "Stone Tile" apart from the mark as shown.

amended to "*services featuring end uses of* quarry stones as kitchen countertops and bathroom vanities" (*emphasis* supplied). The Trademark Examining Attorney takes the position that this terminology is indefinite and vague,

> " … particularly with respect to applicant's use of the wording, "*services featuring end uses of* …," because the applicant fails to state the nature of the "services." As proposed, the applicant's services may refer to any number of services in any number of classes, for example: "retail or wholesale store," "advertising," or "consumer information," services in class 35, "installation" or "maintenance" services in class 37, or "design" services in class 42.
>
> Because applicant's proposed services are sufficiently ambiguous as to encompass these numerous diverse services, the applicant's proposed services are 1) indefinite, 2) do not use common terminology so as to be readily understandable and (3) do not accurately describe the services. TMEP § 1402.11. Therefore, the applicant's proposed amendment to its identification of services remains unacceptable as indefinite.

Trademark Examining Attorney's appeal brief, unnumbered pp. 13 – 14.

Applicant points to an earlier issued registration owned by applicant – a registration covering goods in International Class 20 for a composite mark that appears to include applicant's INNOVATIVE house mark:

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|---|---|
| **INNOVATIVE STONE SURFACES** | for "kitchen and vanity bathroom countertops featuring natural stones and agglomerates of volcanic stone" in International Class 20.[3] |

In his final refusal, the Trademark Examining Attorney suggested that applicant adopt the recitation of services, if accurate, of "providing consumer information in the field of the end uses of quarry stones as kitchen countertops and bathroom vanities" in International Class 35. However, rather than working out an acceptable recitation of services with the Trademark Examining Attorney, applicant appealed the final action as to both bases for refusal.

As seen in applicant's **INNOVATIVE STONE SURFACES** registration – or as one would discover by perusing the United States Patent and Trademark Office's "Acceptable Identification of Goods and Services Manual" – a range of detailed descriptions for stone countertops (e.g., "kitchen countertops of stone," "bathroom vanity

[3] Registration No. 2586480 issued to Innovative Marble and Tile, Inc. on June 25, 2002 based on an application filed on October 23, 2000, ultimately claiming first use anywhere and first use in commerce at least as early as February 5, 2002. The words "Stone Surfaces" are disclaimed apart from the mark as shown. According to the assignment records of the United States Patent and Trademark Office, this registration was one of twenty applications and registrations that Innovative Marble and Tile, Inc. n/k/a Innovative Stone International, Inc., assigned to The Innovative Companies LLC, as of January 9, 2004, recorded at Reel 3041, Frame 0563.

countertops made of natural quarry stones," etc.) comprise definite identifications of goods for parts of furniture in International Class 20 – the "furniture class." Figurines, tiles, prefabricated stone and stones for building and construction are generally identified by their common commercial names and/or end uses, and are placed in International Class 19.

However, despite the fact that applicant repeatedly placed its described goods/services in International Class 19 – a *goods* class, the words themselves have consistently pointed to *services*. Furthermore, the Trademark Examining Attorney takes issue with applicant's proposed, lead-off wording of "*services featuring end uses of* quarry stones as kitchen countertops and bathroom vanities." Inasmuch as applicant has failed to clarify the nature of the "services," the Trademark Examining Attorney takes the position that this terminology is indefinite and vague. We agree.

For example, applicant initially applied for "wholesale and retail store services …" – a description that would correctly be placed in International Class 35. While "advertising" and "consumer information" services would also be placed in International Class *35*, "installation" or "maintenance" services would be placed

in International Class *37*, "custom manufacture of stones in the form of countertops" would be placed in International Class *40*, "educational services, namely, providing training to individuals in the use of stones" would be placed in International Class *41*, while "design" services would be placed in International Class *42*. Therefore, we agree with the Trademark Examining Attorney that applicant's proposed services are sufficiently ambiguous as to encompass potentially this whole range of diverse services. Hence, the Trademark Examining Attorney is correct in taking the position that judging by the standards set out in TMEP § 1402.11, the applicant's proposed wording for its services is indefinite, not readily understandable and inaccurate.

Inasmuch as applicant has failed to comply with the requirement of the Trademark Examining Attorney for an acceptable recitation of services, we affirm this refusal to register. 15 U.S.C. § 1062(b); 37 C.F.R. § 2.64(a).

## ***Likelihood of Confusion***

We turn, then, to the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on

the issue of likelihood of confusion. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, 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). *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

**The Services**

Registrant's services are recited as "wholesale and retail store services for natural stone, man made stone and tile" in International Class 35. Applicant's original description of goods/services was written as "wholesale and retail store services for natural stone, man-made stone, and tiles, and *advising on the end uses thereof*," in International Class 19. Apart from the final clause that the Trademark Examining Attorney found objectionable (and applicant's incorrect classification), applicant's and registrant's services would be identical. While the indefinite nature of applicant's proposed amendment makes

any definitive comparisons inherently difficult,[4] "services featuring end uses of quarry stones as kitchen countertops and bathroom vanities" could certainly include "retail store services for natural stone." Accordingly, we find that the services are, at the very lease, closely related, and may well be identical.

**The Marks**

We turn next to the *du Pont* factor that focuses on the similarities or dissimilarities in the appearance, sound, connotation and commercial impression of the respective marks. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

We also note that if the respective services (or goods) of the parties are essentially identical, as is the case herein, it has been held that "the degree of similarity [of the marks] necessary to support a

[4] In addition to ensuring proper classification, a primary reason for examination practice and procedures in the area of identifications of goods/recitation of services, and an underlying reason for the precision of the entries of the USPTO's "Acceptable Identification of Goods and Services Manual," is the proper determination of likelihood of confusion.

This is necessarily a critical issue at the time the involved application is being examined. Secondly, should a resulting registration eventually issue, problems might well arise during the unlimited life of that registration in determining whether this registration should act as a bar to later-filed applications under Section 2(d) of the Lanham Act.

conclusion of likely of confusion declines." *Century 21 Real Estate v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992) [finding CENTURY LIFE OF AMERICA for insurance underwriting services confusingly similar to opposer's CENTURY 21 mark for insurance brokerage services]; *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1700 (TTAB 2006) [finding iShine and ICE SHINE confusingly similar for floor-refinishing preparations]; *In re J. M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987) [J M COLLECTABLES and JM ORIGINALS confusingly similar for identical and related items of clothing]; and TMEP § 1207.01(b).

Furthermore, under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The question is whether the marks create the same overall impression. *Recot, Inc. v. M. C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); and *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby*

*Skate Corporation*, 206 USPQ 255 (TTAB 1980); *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); and TMEP § 1207.01(b).

Applicant's mark is **STONE DEPOT** and registrant's mark is **STONE TILE DEPOT.COM**. There are obvious similarities in the appearance and pronunciation of the two marks in that both begin with the identical term "Stone" and end with the identical, stand-alone word, "Depot." Although registrant's mark does follow the word "Depot" with the Top-level Domain name (TLD), ".COM," such a designation operates as a locator for Internet website addresses, and hence, in this case, does not serve to distinguish the source of the services. In particular, the joinder of the words "stone," "tile" and "depot" with the TLD ".com" does not create a formulation that, in context, would be perceived by the relevant public as suggesting a non-descriptive connotation like SUGAR & SPICE for bakery products,[5] THE SOFT PUNCH for noncarbonated soft drink,[6] and NO BONES ABOUT IT for fresh pre-cooked ham[7]. *Cf. In re DNI Holdings Ltd.*, 77 USPQ2d 1435 (TTAB 2005). At best, in

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[5] *In re Colonial Stores Incorporated*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968).

[6] *In re Delaware Punch Co.*, 186 USPQ 63 (TTAB 1975).

[7] *In re National Tea Co.*, 144 USPQ 286 (TTAB 1965).

the context of registrant's mark, the TLD suffix serves merely to suggest that potential customers can transact business with registrant via the Internet.

The mark of the applicant and registrant are also different in that the applicant has deleted the highly descriptive, if not generic, term, "Tile," from the mark of the registrant, in order to arrive at its mark. In the event this small difference in the middle of the marks would even be noticed or remembered – we find that this difference is not sufficient to distinguish the marks as to appearance. Certainly, marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See* *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd* 1 USPQ2d 1813 (Fed. Cir. 1987) [COMMCASH and COMMUNICASH]; and *In re Optical Int'l*, 196 USPQ 775 (TTAB 1977) [OPTIQUE versus OPTIQUE BOUTIQUE used in connection with competing optical wear]. Hence, notwithstanding these differences, we find that the marks are similar in appearance.

Similarly, as to sound, applicant's deletions of the term, "Tile," from the middle of the mark and the TLD, ".COM" from the ending of registrant's mark, do not

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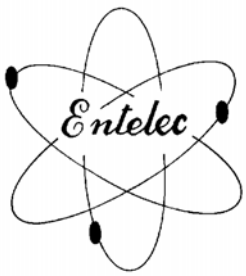


distinguish the marks. As noted by the Trademark Examining Attorney, slight differences in the sound of similar marks will not avoid a likelihood of confusion. *See In re Energy Telecomm. & Electrical Ass'n*, 222 USPQ 350 (TTAB 1983). Hence, we find that the marks involved herein are pronounced similarly.

As to connotation, the terms "Stone" and "Depot" have the same meaning in both marks – namely, a place for storing stones. The major difference, with respect to the commercial impressions created by the marks, is the term, "Tile," which is present in the mark of the registrant. However, the record shows that in registrant's and applicant's field of business, tile products move through the same channels of trade as do stones, and registrant has correctly disclaimed exclusive rights to use this term. Hence, for rational reasons, we give less emphasis to this term.[8]

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[8] When considering marks for purposes of a likelihood of confusion determination under Section 2(d) of the Trademark Act, disclaimed matter is typically less significant or less dominant when comparing marks. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. *Dixie Restaurants Inc., supra*; *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002)

Therefore, although there are some differences in the marks, we find that applicant's mark and registrant's mark are very similar in their entireties as to appearance, sound, connotation and commercial impression.

Finally, given the close relationship of the services, applying the standard of *Century 21 Real Estate, supra*, we find that the degree of difference between the proposed mark, **STONE DEPOT** and the registered mark, **STONE TILE DEPOT.COM**, is certainly not enough to avoid a likelihood of confusion as to source with regard to the marks.

*Decision*: Inasmuch as applicant's proposed amendment to the recitation of services is unacceptable, we affirm the refusal of registration on this ground. Also, we affirm the refusal to register based upon Section 2(d) of the Lanham Act.

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[HEWLETT PACKARD confusingly similar to PACKARD TECHNOLOGIES]; *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976) [TEKTRONIX not confusingly similar to mark having prominent letter "D" above DAKTRONICS INC.]; *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) [MACHO COMBOS for food items and MACHO for sandwich is likely to cause confusion]; and *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) [RESPONSE CARD confusingly similar to RESPONSE].