

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: July 26, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Roycon, Inc.

Serial No. 78690119

Stuart D. Hirsch of The Kennedy Law Firm, APC for Roycon, Inc.

Kaelie Kung,¹ Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Rogers, Drost and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Roycon, Inc. to register on the Principal Register the mark shown below for the following services: "construction of concrete surfaces, including buildings, driveways, pool decks, walkways, slabs, floors, roadways and other constructed items" in International Class 37.²

¹ The above application was reassigned to the examining attorney whose name is shown to prepare the appeal brief.

² Application Serial No. 78690119 was filed August 10, 2005, based on applicant's assertion of September 30, 2006 as the date



The examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as used in connection with its services, so resembles the mark shown below, previously registered on the Principal Register for the following goods: "concrete building walls and concrete modules, namely, multiple intersecting walls defining part of a building" in International Class 19,³ as to be likely to cause confusion.



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

of first use of the mark in commerce. Applicant disclaimed the exclusive right to use "CONCRETE" apart from the mark as shown. In addition, applicant describes the mark as follows: "The mark consists of a crown above the name."

³ Registration No. 3047513, issued January 24, 2006 with a disclaimer of "CONCRETE" and "INC." apart from the mark as shown. The color blue is claimed as a feature of the mark.

issue under appeal. In addition, applicant filed a reply brief.

Preliminary Matters

Before turning to the substantive ground for refusal, some preliminary matters require our attention.

Materials Submitted with Applicant's Brief

We note that applicant has submitted a declaration with several exhibits with its main brief. The declaration is from an officer of applicant who attests to the length and nature of applicant's use of its mark, and further introduces a copy of applicant's Fictitious Business Name Statement indicating that applicant has been in business since 1986 (Exhibit A); two invoices displaying applicant's mark, dated February 11, 1988 and April 17, 2006 (Exhibits B and C); a printout from registrant's Internet web site (Exhibit D); printed copies of applicant's application and the cited registration, taken from the United States Patent and Trademark Office's (USPTO's) Trademark Electronic Search System (TESS) (Exhibits E and F); a printout from the Internet web site of a third party (Exhibit G); and a copy of the June 13, 2006 Office action issued by the prior examining attorney for this application (Exhibit H).

We note that the Fictitious Business Name Statement and invoices comprising Exhibits A - C previously were

submitted with applicant's response to the prior examining attorney's first Office action. As such, they are properly of record in this proceeding. Moreover, by its very nature the June 13, 2006 Office action comprising Exhibit H is of record herein.

As to Exhibits D - G, we agree with the examining attorney that these submissions are untimely, and they have not been considered. See Trademark Rule 2.142(d) (the evidentiary record in an application should be complete prior to the filing of an ex parte appeal). Similarly, we find the declaration of applicant's officer, submitted with its brief, to be untimely. *Id.* We note applicant's assertion in its reply brief that exclusion of these exhibits would both "VIOLATE THE SPIRIT AND ESSENCE OF THE RULES OF EVIDENCE AND THE LANHAM ACT" (reply brief, heading p. 1) and further be prejudicial to its ability to defend its application on appeal. However, it is settled that evidence submitted after the filing of an appeal normally will be given no consideration. *Id.* See also TBMP §1207.01 (2d ed. rev. 2004) and the authorities cited therein. While, as applicant argues, the Board takes a more permissive stance regarding the admissibility and probative value afforded certain types of evidence submitted in ex parte appeals (See TBMP §1208 and the

authorities cited therein), applicant provides no support for its argument that such latitude extends to the requirement that the evidence in question be timely filed. Applicant was afforded ample opportunity to timely submit evidence to support its position during the prosecution of its application, and will not now be heard to argue that its late-filed evidence must be given consideration. As to applicant's assertion of prejudice, we note for the reasons outlined below that had we considered such evidence in our determination of the issue on appeal, the result would be the same.

Applicant's Request For Remand

Further, with its reply brief, applicant requests remand of the application for consideration of its Exhibits D - G. As grounds therefor, applicant states that the information contained in those exhibits

was not included in the examining attorney's initial review of the application and thus, was not known to the APPLICANT at the time of its application, or at any time prior to appeal. The APPLICANT had no reason to suspect or to know that its application would be denied due to minute similarities between some company which creates and sells pre-cast cement walls and modules to be put into place at [a] construction site in Florida and the APPLICANT'S service of pouring concrete on location in Southern California.

(Reply brief, p. 4). However, applicant has been aware of the examining attorney's refusal to register that is the subject of this appeal since issuance of the first Office action on March 5, 2006. Indeed, applicant addressed that refusal to register in its May 10, 2006 response to the first Office action. Furthermore, applicant neither asserts, nor does the record support a finding, that the materials comprising Exhibits D - G were unavailable prior to the filing of its appeal. In short, applicant's mere assertion that such materials previously were "not known" to it falls short of establishing the requisite good cause for its remand request at this late stage of the proceeding, and the request accordingly is denied. See TBMP §1209.04 and the authorities cited therein.

Likelihood of Confusion

Turning now to the matter under appeal, 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 outlined in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the

marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 27 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

Similarity of the Marks

We first consider the similarity of the marks. In this case, applicant's mark, ROYAL CONCRETE and design, is similar to registrant's mark, RC ROYAL CONCRETE CONCEPTS INC. and design, in that both share the words ROYAL CONCRETE. There is no evidence of record to support a finding that ROYAL has a recognized meaning in the concrete field. Thus, the term ROYAL is at least laudatory and suggestive as used with both registrant's goods and applicant's services. Further, the word ROYAL is the first word appearing in applicant's mark and is displayed beneath the design of a crown. Thus, ROYAL is the portion of applicant's mark to which the viewer is drawn, as well as the portion that the viewer is most likely to remember. The crown design in applicant's mark, though visually prominent, is less significant than the wording therein. This is because when a mark comprises both wording and a design, the wording would be used by customers to request the identified goods or services. See *In re Appetito*

Provisions Co., 3 USPQ2d 1553 (TTAB 1987). Further, the crown design suggests royalty and thus lends further emphasis to the word ROYAL. For these reasons, we consider ROYAL to be the dominant feature of the registered mark.

As for the presence of CONCRETE in applicant's mark, this term, which has been disclaimed, is obviously descriptive, if not generic, of the recited services. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, 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 a consideration of the marks in their entireties. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In view of the descriptive nature of the word CONCRETE, it has little, if any, source-indicating significance, and is entitled to less weight in the likelihood of confusion analysis.

With regard to the mark in the cited registration, the letters RC on a blue rectangular design are visually prominent and appear to be distinctive as applied to registrant's goods. As for the wording in registrant's mark, the words ROYAL CONCRETE appear in boldface type that is larger than that in which the words CONCEPTS, INC. is

displayed. As noted above, the word ROYAL appears to be laudatory and suggestive as applied to registrant's goods. The disclaimed words CONCRETE and INC. clearly are descriptive or generic as applied to applicant and its goods, and thus, have little or no source-indicating significance.

The most distinctive portion of applicant's mark, namely, the word ROYAL, is identical in part to the most distinctive portion of registrant's mark, namely, RC ROYAL. Further, the words ROYAL CONCRETE appear together in both marks. Thus, we find that when viewing the marks as a whole, these similarities outweigh their differences. Consumers who are familiar with the mark, RC ROYAL CONCRETE CONCEPTS INC. and design, used in connection with registrant's concrete building walls and modules, who then see the mark ROYAL CONCRETE and design used in connection with applicant's services of constructing concrete surfaces, are likely to assume that the owner of registrant's mark simply has utilized a similar mark to identify its concrete related services. In other words, consumers are likely to view both marks as variations of each other, and therefore as indicators of a single source. Thus, despite the fact that the applicant's mark includes a crown design, and registrant's mark contains the additional

wording RC and CONCEPTS, INC., the marks are highly similar in appearance, sound, connotation and commercial impression. Accordingly, this *du Pont* factor favors a finding of likelihood of confusion.

Similarity of the Goods and Services

Turning now to our consideration of the recited goods and services, we must determine whether consumers are likely to mistakenly believe that they emanate from a common source. It is not necessary that the goods and services at issue be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective goods and services are related in some manner, and/or that the conditions and activities surrounding the marketing thereof 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 producer. *See In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, applicant's "construction of concrete surfaces, including buildings, driveways, pool decks, walkways, slabs, floors, roadways and other constructed items" is highly similar to registrant's "concrete building

walls and concrete modules, namely, multiple intersecting walls defining part of a building," in that both may be utilized for identical or otherwise related purposes. Specifically, registrant's concrete building walls and modules consisting of walls are used for the identical purpose as applicant's construction of concrete buildings. We note that neither registrant's goods or applicant's services recite any limitations as to the nature or type of buildings that may be constructed thereby. Thus, it may be presumed that applicant's services may be utilized to construct buildings that are identical to those created using registrant's goods. In addition, concrete walls and modules are closely related to construction of concrete driveways, decks, walkways, slabs and floors in that the same buildings may feature registrant's walls and floors, as well as walkways, driveways, etc. constructed by applicant.

Thus, we find that as recited, applicant's services may be used for purposes that are identical in part and otherwise related to registrant's goods. As a result, the goods and services are related on their face, and this *du Pont* factor also favors a finding of likelihood of confusion.

Channels of Trade

Furthermore, we are not persuaded by applicant's arguments that its customers differ from those of registrant or that registrant's goods travel in channels of trade that are separate and distinct from those in which applicant's services may be encountered. It is settled that in making our determination regarding the relatedness of the parties' goods and services, we must look to the goods and services as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.") In this case, there are no restrictions in either applicant's recitation of

services or registrant's identification of goods as to the channels of trade in which the goods or services may be encountered, or type or class of customer to which the goods and services are marketed. Thus, while applicant has argued that its services are distinct from registrant's goods, and presented a declaration and evidence to support its argument, neither recitation of goods or services contains any limiting language to support such distinction. Accordingly, both applicant's services and registrant's goods are presumed to move in all normal channels of trade and be available to all classes of potential consumers, including consumers of each others' goods and services. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). As a result, this *du Pont* factor also favors a finding of likelihood of confusion.

Sophisticated Purchasers

Another *du Pont* factor discussed by applicant is that of the conditions of sale. Applicant asserts that its services and registrant's goods simply are not impulse purchases and thus would be purchased by careful and sophisticated users. However, there is no evidence that either applicant's services or registrant's goods are limited to use only by highly sophisticated persons. Even individual homeowners may need concrete walls or concrete

poured on site. Moreover, the marks ROYAL CONCRETE and design and RC ROYAL CONCRETE CONCEPTS INC. and design are so similar that even careful purchasers are likely to assume that the marks identify goods or services emanating from a single source. Even sophisticated purchasers are not necessarily knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812, 1814-1815 (TTAB 1988). As a result, this *du Pont* factor further favors a finding of likelihood of confusion.

Actual Confusion

A further *du Pont* factor discussed by applicant is that of the lack of instances of actual confusion. Applicant asserts that the absence of actual confusion suggests no likelihood of confusion. However, it is not necessary to show actual confusion in order to establish likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). Particularly in an *ex parte* proceeding, applicant's assertion of the absence of actual confusion is of little probative value in our determination on the issue of likelihood of confusion because the Board cannot readily determine whether there has been a significant opportunity for actual confusion to have occurred, such that the absence of confusion is meaningful. See *In re Opus One*

Inc., 60 USPQ2d 1812, 1817 (TTAB 2001); *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984); and *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984). In those situations where the Board has recognized the absence of actual confusion as probative in an ex parte setting, there existed a "confluence of facts" which together strongly suggested that the absence of confusion was meaningful and should be given probative weight. See *In re Opus One Inc.*, *supra*; and *In re Jeep Corp.*, *supra*. The "confluence of facts" is not present in this record. As a result, this *du Pont* factor appears to be neutral.

Fame and Applicant's Prior Use of Its Mark

Applicant argues in addition that because it has been using its mark for 16 years prior to registrant's use of the mark in the cited registration, "any fame of either mark would have to weigh in favor of the **APPLICANT**" (brief, p. 14 emphasis in original). However, and as noted by the examining attorney, any claim of prior use by applicant is not relevant in an ex parte proceeding. Section 7(b) of the Trademark Act provides as follows:

A certificate of registration on the principal register provided by this Act shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the mark in commerce on or in connection with the goods or

services specified in the certificate, subject to any limitations stated in the certificate.

15 U.S.C. §1057(b). Because the mark in the cited registration is presumed to be valid, and the owner thereof is presumed to have an exclusive right to use such mark in commerce, the fact that applicant may have made earlier use of its mark has no bearing on our determination of likelihood of confusion in this ex parte proceeding. Thus, to the extent that applicant is asserting a claim of priority, such a claim is of no moment herein.

Furthermore, there is no evidence of record regarding the fame of either applicant's or registrant's mark. As such, this *du Pont* factor would also appear to be neutral.

Geographic Scope of Application and Registration

Finally, applicant argues that because applicant and registrant operate in two geographically separate markets, applicant should be allowed to register its mark. However, the involved application and the cited registration do not contain any geographic or other limitations as to the mode or place of use of the marks or the goods and services on or in connection with which the marks are used. See Trademark Act Section 2(d), 15 U.S.C. §1052(d). The Board will only consider and determine geographic limitations in the context of a concurrent use proceeding. See Trademark

Rule 2.133(c). See also generally TBMP §1100 et. seq. (2d ed. rev. 2004) and the authorities cited therein. Absent geographical limitations in the application and registration, our likelihood of confusion analysis must presume a nationwide right to use the mark. See Trademark Act §7(b), 15 U.S.C. §1057. Further, and as noted above, inasmuch as the identification of goods in the cited registration is not limited to any specific channels of trade, we presume an overlap and that the goods would be offered in all ordinary trade channels for these goods and to all normal classes of purchasers. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

Summary

In summary, weighing all of the relevant *du Pont* factors, we find that a likelihood of confusion exists. Moreover, 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. See *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 165, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal of registration is affirmed.