

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Oral Hearing:
May 3, 2007

Mailed:
October 31, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Decra Roofing Systems, Inc.
v.
John M. Sisson

Cancellation No. 92043095

Richard M. Johnson of The Johnson IP Group for Decra Roofing
Systems, Inc.

W. Patton Hahn of Baker Donelson Bearman Caldwell &
Berkowitz, P.C. for John M. Sisson

Before Rogers, Kuhlke and Wellington, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Decra Roofing Systems, Inc. (petitioner) has petitioned
to cancel the following registration owned by John M. Sisson
(respondent) for the mark **DecraStone** for "concrete masonry
units used for construction of walls" in International Class
19.¹

¹ Registration No. 2817005, issued February 24, 2004.

As grounds for cancellation petitioner asserts the claim of priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). More specifically, petitioner alleges that respondent's mark DECRASTONE, as applied to his goods, so resembles petitioner's previously used and registered mark DECRA for "roofing tiles and tile accessories, namely, ridge hip caps, barge hips caps, box barge covers and lead edge flashings"² and "metal roofing construction materials, namely, metal tiles and treated corrugated iron sheets, roofing shakes, roofing tiles, roofing panels and roofing construction accessories, namely, ridge caps, hip caps and barge caps,"³ as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d).

Respondent, in his answer, denies the salient allegations in the petition for cancellation.⁴

The evidence of record includes: the pleadings; the file of the registration sought to be cancelled; trial testimony, with related exhibits, taken by each party (Mr.

² Registration No. 1495119 issued July 5, 1988 based on a New Zealand registration. Section 8 and 15 affidavits have been, respectively, accepted and acknowledged.

³ Registration No. 2282690 issued October 5, 1999, based on use and use of the mark in commerce, as well as on two New Zealand registrations.

⁴ We consider respondent's pleaded affirmative defense of acquiescence to have been waived, inasmuch as respondent has not presented argument as to this defense.

John Hernan Miller (Miller), petitioner's vice president of operations, and Mr. John M. Sisson (Sisson), respondent); and various excerpts from printed publications submitted by petitioner under a notice of reliance.

STANDING/PRIORITY

We begin by noting that another entity, AHI Roofing Ltd., which is not a party to this proceeding, is the owner of the pleaded registrations for the mark DECRA. However, petitioner has demonstrated its standing by virtue of the fact that it is the exclusive licensee of AHI Roofing Ltd. for use of the mark DECRA in the United States. Miller Test. p. 15. A petitioner whose use of a pleaded mark is as a licensee of the trademark owner may have standing in a case brought under Section 2(d) of the Trademark Act notwithstanding that it does not claim ownership of the allegedly similar mark, or the right to control its use. See J.L. Prescott Co. v. Blue Cross Laboratories (Inc.), 216 USPQ 1127 (TTAB 1982) (opposer that had assigned mark and obtained exclusive license from assignee held to have standing). See also Universal Oil Products Co. v. Rexall Drug and Chemical Co., 43 F.2d 1122, 174 USPQ 458 (CCPA 1972); and BRT Holdings Inc. v. Homeway Inc., 4 USPQ2d 1952 (TTAB 1987).

With respect to priority, when both parties in a cancellation case can rely on their ownership of

registrations, priority remains an issue but each party can, if it chooses, rely on the filing date of the application that resulted in issuance of its involved registration. However, in this case, petitioner, as the licensee, may not rely on the registrations inasmuch as they are owned by petitioner's licensor, AHI Roofing Ltd. It is well settled that "the Section 7(b) presumptions accorded to a registration on the Principal Register accrue only to the benefit of the owner of the registration, and hence come into play only when the registration is made of record by its owner." TBMP §704.03(b)(1)(B) (2d ed. rev. 2004). See also *Joseph S. Finch & Co. v. E. Martinoni Co.*, 157 USPQ 394, 395 (TTAB 1968) (An opposer cannot rely on registrations owned by a parent or one of its parent's subsidiaries: "Opposer is not the registrant of any of the registrations filed with its notice under Trademark Rule 2.123(c) [current Rule 2.122(e)] and said registrations stand in the same category as if they were owned by independent and unaffiliated companies."). Thus, in order to establish its priority, petitioner must prove actual use of the DECRA mark prior to the earliest date upon which respondent may rely, which is February 2, 2002. *Sisson Test*. p. 59.

We find that petitioner's evidence clearly establishes use by petitioner (or petitioner's predecessor-in-interest)

of the mark DECRA for stone-coated steel roofing since 1978. Miller Test. pp. 17, 21. Therefore, petitioner has proven its priority in this proceeding. Petitioner has also shown prior use of the mark DECRA in connection with other products, including ridge covers (1978), side flashing (1986), and roof to wall flashing (2000). Id.; Sisson Test. Ex. No. 8 pp. 3-4.

LIKELIHOOD OF CONFUSION

Our likelihood of confusion determination under Section 2(d) 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 and 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 arguing that no likelihood of confusion would result by the concurrent use of these marks respondent contends that petitioner's DECRA mark is weak and should be accorded very narrow protection. Under the du Pont factors, existence of widespread third-party use may serve to indicate the weakness of a term in the context of its source identifying significance. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). However, in support of this argument respondent has offered very little evidence. The references in the brief to third-party registrations and

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third-party uses do not make them of record for our consideration. While third-party registrations may, in some circumstances, be used to indicate that a term has been commonly adopted in a particular field or may be used in the manner of dictionary definitions to indicate the descriptive or suggestive significance of a term, they are not probative of third-party use. Compare *In re Hamilton Bank*, 222 USPQ 174, 177 (TTAB 1984) ("Such registrations are ... competent to show that others in a particular area of commerce have adopted and registered marks incorporating a particular term. We can also note from such registrations that the term or feature common to the marks has a normally understood meaning or suggestiveness in the trade") with *AMF Inc. v. American League Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (CCPA 1973) ("We have frequently said that little weight is to be given such registrations in evaluating whether there is likelihood of confusion. The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them")

The only evidence in the record to support respondent's position is testimony regarding petitioner's and respondent's knowledge of other "DECRA" marks. See Miller Test. pp. 79-89; Sisson Test. pp. 27-30; and Petitioner's Response to Interrogatory No. 20 introduced as Ex. No. 4 in

the Miller Test. and Ex. No. 8 in the Sisson Test. For example, Mr. Miller, in answer to the question if he was "aware of a company known as Decra-Scape" testified "I have heard of that company name, yes" but when asked if "Decra-Scape is a concrete surface company that designs and installs brick and concrete pathways and walls" he testified "I'm not sure. They - you're obviously reading from something, so - and I have seen a Web site for the company Decra-Scape." Miller Test. p. 81. This type of testimony is hardly sufficient to establish that there is a multitude of "Decra" marks used in the same field such that only minor differences may suffice to distinguish the marks.

In addition, respondent argues that "DECRA" has the connotation of "decorative" and thus is descriptive or at least suggestive of petitioner's stone-covered roof tiles. Respondent points to his testimony whereby he testifies that Decra may be "a descriptive word, perhaps being a shortening of the word 'decorative.'" See Sisson Test. pp. 14-15. This is not objective or impartial evidence showing that DECRA is descriptive or even suggestive. Thus, the record does not support a finding that petitioner's mark is not inherently distinctive or is a weak mark.

Petitioner argues that its mark is famous in the construction field and in support testified to substantial sales and advertising expenses over the past five years.

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With regard to advertising it appears from the record to be primarily through trade press and trade shows. The record reveals only a very limited exposure through television. In addition, petitioner submitted examples of articles featuring DECRA in various trade publications, e.g., Metal Home Digest, Metal Home Roofing Architecture, Design/Build Business. Petitioner also submitted a report titled "2002 Metal Roofing Industry Profile and Analysis" prepared by a third-party that includes a graph indicating that twenty-five percent of residential metal roofing installed in 2001 was petitioner's product. In another report from a publication titled "Home Improvement Executive" a chart shows that seventy-nine percent of those polled listed petitioner as the brand driving the business in 2006.

As stated by the Board in *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005), "In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, we think that it is the duty of a plaintiff asserting that its mark is famous to clearly prove it." On this record, we cannot say that petitioner has provided sufficient evidence about the extent of its use of the mark, or its sales under the mark such that we can conclude that petitioner's DECRA mark can be considered a famous mark.

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See *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). However, although we have found that the record is insufficient to support a finding of fame, in view of the evidence we do have of industry exposure to the DECRA mark, we find that DECRA is a strong mark in the construction industry, which accords it a commensurate higher level of protection.

With the above in mind, we turn to our analysis of whether respondent's mark **DecraStone** and petitioner's mark DECRA are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under this 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 impressions that confusion as to the source of the goods offered under the respective marks is 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).

We find the marks to be very similar.⁵ Respondent's mark begins with the entirety of petitioner's mark and DECRA, being the first portion of respondent's mark, is more likely to strike an impression in the consumer's mind. The second portion of respondent's mark is clearly distinguished as a separate word by use of capitalization of the first letters of the respective portions, Decra and Stone. Moreover, while we are mindful that the respective marks must be considered in their entireties and that any descriptive or other disclaimed matter therein cannot be ignored, our principal reviewing court has indicated 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 [that] the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). According to the court, "[t]hat a particular feature is descriptive [or otherwise lacking in distinctiveness]...with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark..." *Id.* Here, the word "STONE" in respondent's mark in relation

⁵ We have not considered petitioner's "family of marks" argument inasmuch as it was not pleaded or proven.

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to respondent's goods is, at least, somewhat suggestive inasmuch as the "concrete masonry" is constructed to resemble stone (Sisson Test. p. 15) and, as such, is less significant than the dominant and distinguishing term DECRA when the mark is considered as a whole. Thus, in view of the identity of the term DECRA, the parties' marks are very similar in sound and appearance. To the extent DECRA connotes anything it would be the same for both parties' marks. Finally, we find the overall commercial impression of the marks to be similar. The addition of the word STONE to respondent's mark, rather than distinguishing the marks, may serve to enhance confusion inasmuch as a primary feature of petitioner's roof tiles is ground stone and petitioner frequently uses its mark in close proximity to the name of the goods, i.e., stone-coated roofing. See, e.g., Miller Test. Ex. No. 5.

Thus, we find that the similarities in the sound, appearance, connotation and overall commercial impressions of the parties' marks outweigh their differences.

We turn next to a consideration of the similarities between petitioner's and respondent's goods, and the similarities between petitioner's and respondent's trade channels and classes of purchasers of these goods. With regard to respondent's goods, we must make our determinations under these factors based on the goods as

they are recited in the registration. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

The goods need not be identical or directly competitive in order for there to be a likelihood of confusion. Rather, the respective goods need only be related in some manner or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. In *re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Petitioner uses the mark DECRA on, inter alia, stone-covered metal roofing tiles in both commercial and residential applications. Respondent's goods are identified as "concrete masonry units used for construction of walls." The parties' goods are obviously different in that one is used for a roof in a structure and the other is used for a wall. However, both parties goods are used in the construction of the outer surface of buildings and, as such, are complementary. Moreover, the goods serve a similar aesthetic function in that they both have the appearance of stone.⁶

⁶ While petitioner argued that its roof tiles may also be used (and have been used) as wall tiles, there is very little in the record to show that its roof tiles have been used in this manner and we have restricted our analysis to a consideration of petitioner's goods used as roof tiles only.

With regard to the channels of trade and potential purchasers, because the registration is not limited we presume respondent's goods travel in all ordinary channels of trade, which would include both the commercial and residential construction industry. Further, the record establishes that both parties goods are sold, inter alia, to architects, engineers and general contractors.

In view of the above, we find that the channels of trade and class of purchasers are the same and the goods are related.

As to the conditions of sale, we agree that purchases of these goods do not fall in the category of impulse purchases. Moreover, the consumer of the parties' goods would approach the purchase with a higher level of knowledge about the product than the average consumer and would exercise a higher degree of care. However, under the circumstances of this case, we find that this factor does not outweigh the other factors, namely, the relatedness of the goods, the strength of the DECRA mark and the similarities of the marks.

Finally, respondent argues that there has been no actual confusion, however, the evidence does not show whether the goods here have been sold under the marks in issue in the parties' overlapping territories. Thus, we find this factor neutral.

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After a careful analysis of the relevant du Pont factors we conclude that, in view of the strength of petitioner's mark, the overall similarity of the marks, and the relatedness of the goods and channels of trade, confusion among consumers is likely.

Decision: The petition for cancellation is granted.