

The Examining Attorney has issued a final refusal for registration of the mark **EVERLAST** for “Athletic flooring; flooring comprised of artificial turf, foam, hardwood, soft PVC vinyl, vinyl and wood, adapted for physical fitness activities; non-metal flooring; hardwood flooring; parquet flooring; rubber flooring; rubber gym flooring rolls; wood flooring; wood tile flooring; synthetic flooring materials or wall-claddings; tile flooring, not of metal; rubber floor tiles; rubber gym floor tiles” in Class 19, on the basis that Applicant’s mark, so resembles **RN 1854672 EVERLAST** for “rubber floor tile for use in commercial settings except for sports, gymnastics or physical fitness facilities” in Class 19 owned by Dodge Delaware Inc., and **RN 4887838 EVERLAST** for “Flooring comprised of epoxy resins and an aggregate material, namely, sand, glass, porcelain, vinyl, rubber, or rock materials, namely, marble and quartz for industrial, commercial, indoor, outdoor, and recreational use and activities; Floor construction system comprising epoxy resins and rock materials for floors, namely, abrasion resistant floors, slip resistant floors, corrosion resistant floors, sound reducing floors, impact resistant floors, chemically resistant floors, and floors controlling static electricity; Flooring kit for do-it-yourself use and use by contractors comprised of epoxy resins, an aggregate material composed primarily of a rock, sand, vinyl, rubber, porcelain, or glass material, and a curing agent; Rock materials used in building flooring; Floor construction system comprising polyurethane and rubber materials for floors, namely, abrasion resistant floors, slip resistant floors, corrosion resistant floors, sound reducing floors, impact resistant floors, chemically resistant floors, and floors controlling static electricity; Flooring kit for do-it-yourself use and use by contractors comprised of polyurethane, an aggregate material composed primarily of rubber, and a curing agent” in Class 19 owned by DLTM OPERATIONS, LLC, as to be likely to cause confusion under Trademark Act Section 2(d).

Applicant respectfully requests reconsideration of this matter and presents arguments herein in support of registration and incorporates by reference arguments presented in the

August 29, 2021, Office Action response. In addition, Applicant intends to file an appeal to the Trademark Trial and Appeal Board.

### **SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION**

It is well established that the likelihood of confusion determination under Section 2(d) is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F. 2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). The Court of Customs and Patent Appeals set forth several factors to be considered in reviewing an application for likelihood of confusion under §2(d) of the Lanham Act, the most relevant of which in this case includes the number and nature of similar marks in use on similar goods. The *DuPont* factors are generally applied on a case-by-case basis, the fundamental inquiry being “the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F. 2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976); see also *Toro Co. v. GrassMasters.*, 66 USPQ 2d. 1032, 1035-36 (T.T.A.B. 2003).

After considering the relevant factors and focusing on the ultimate question of whether consumers are likely to be confused between the marks at issue, Applicant submits that this refusal was incorrectly issued.

### **THE NUMBER AND NATURE OF SIMILAR MARKS IN USE FOR SIMILAR GOODS**

The sixth *Du Pont* factor requires us to consider evidence of "the number and nature of similar marks in use on similar goods." *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). The Examining Attorney argues that “evidence comprising only a small number of third-party registrations for similar marks with similar goods

and/or services, as in the present case, is generally entitled to little weight in determining the strength of a mark” and “that the few similar third-party registrations submitted by applicant are insufficient to establish that the wording “EVERLAST” is weak or diluted.” Applicant respectfully disagrees and contends that the very fact that the cited marks already co-exist with *each other* in the flooring materials industry *and* with other "EVERLAST" marks registered in association with non-metal building materials in Class 19, is substantial evidence that weighs in Applicant's favor.

The probative value of third-party trademarks depends entirely on their usage. *Scarves by Vera, Inc. v. Todo Imports, Lid*, 544 F.2d 1167, 1173 (2d Cir. 1976). Thus, Applicant provides evidence of registered third-party usage of the term "EVERLAST" in Class 19 in the table below. The court has noted, "[t]he purpose of a defendant introducing third party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers 'have been educated to distinguish between different [such] marks on the bases of minute distinctions.'" *Palm Bay Imports, Inc. v. Veuve Cliquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1374. (CAFC 2005). (internal quotation from *McCarthy on Trademarks* §11:88 (4<sup>th</sup> ed. 2001)). "Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to other elements of the marks as a means of distinguishing the source of goods or services in the field." *In re Bed and Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986).

Furthermore, Applicant points out that the cited marks have co-existed on the Register for over five (5) years. On January 19, 2016, **RN 4887838 EVERLAST** registered for “rubber for use in the manufacture of flooring” in Class 17, and for flooring and flooring do-it-yourself kits “comprised of epoxy resins and an aggregate material, namely...rubber” in Class 19, for goods

that are *highly related* to **RN 1854672 EVERLAST**, registered for “rubber floor tile...” See Office Action dated May 8, 2020, Attachment No. 3). While the Examining Attorney argues that “the issue here is whether there is a likelihood of confusion between the application and the cited registrations, not whether there is a likelihood of confusion between the registered marks”, Applicant contends that their very presence on the USPTO register in Class 19 for flooring related non-metal building materials reveals that consumers “have been educated to distinguish between different marks on the basis of minute distinctions.” *McCarthy on Trademarks*, at §11:88.

There are currently three other registered marks in Class 19, owned by different entities, that consist of the single word “EVERLAST” and one recently published mark for **EVERLAST WALL SYSTEMS**, with “WALL SYSTEMS” disclaimed, also in Class 19:

Mark	Details	Goods/Services	Owner
<b>EVERLAST</b> Jurisdiction: US Reg: 2207037 Serial: <u>75360564</u>	Registered Renewal: 12/06/2008 Affidavits: 8 Reg: 12/01/1998 Pub: 09/08/1998 Filed: 09/22/1997 First Use: 01/01/1990 Current Basis: 1a	<b>019</b> natural stone for landscaping and building purposes	Ayers Supply Inc.  2036 Newton Ranson Boulevard Clarks Summit PENNSYLVANIA 18411 US
<b>EVERLAST</b> Jurisdiction: US Reg: 3124862 Serial: <u>78574940</u>	Registered Renewal: 09/29/2016 Affidavits: 8; 15 Reg: 08/01/2006 Pub: 11/22/2005 Filed: 02/25/2005 First Use: 08/08/2005 Current Basis: 1a	<b>019</b> non-metal door thresholds	Van Avery, Randy  9580 E. ML Avenue Galesburg MICHIGAN 49053 US

<b>EVERLAST</b> Jurisdiction: US Reg: 3719939 Serial: <u>77671988</u>	Registered Renewal: 06/11/2019 Affidavits: 8; 15 Reg: 12/01/2009 Pub: 06/09/2009 Filed: 02/17/2009 First Use: 09/01/2009 Current Basis: 1a	<b>019</b> non-metal building materials, namely, composite polymer siding	CHELSEA BUILDING PRODUCTS, INC.  565 CEDAR WAY OAKMONT PENNSYLVANIA 15139 US
<b>EVERLAST WALL SYSTEMS</b> Disclaims: "WALL SYSTEMS" Jurisdiction: US Serial: <u>90768865</u>	Published Pub: 04/19/2022 Filed: 06/11/2021 Current Basis: 1b	<b>019</b> prefabricated non-metal walls; wall panels not of metal;	DBA Everlast Interiors Everlast Interior Construction, Inc.  52 N Main Street Marlboro NEW JERSEY 07746 US

**(TSDR records of all of the above are attached in Exhibit A)**

This evidence of third-party registrations demonstrates that consumers have encountered and have become accustomed to usage of the term "EVERLAST" related to non-metal building materials to such an extent that they are capable of distinguishing between similar marks. Applicant also notes that **RN 2207037** is registered for "natural stone for...building purposes" which arguably encompasses natural stone for use in the construction of flooring. Moreover, and more importantly, presence on the Register of all these "EVERLAST" marks establishes that the existence of cited marks cannot prevent the registration of another "EVERLAST" related mark for non-metal building materials.

Applicant submits that the state of the Register for "EVERLAST" related marks and the fact that the cited marks have been co-existing with one another for a considerable period of time is powerful evidence that Applicant's mark can coexist with these marks without confusion. Indeed, they already do.

Therefore, the sixth *DuPont* factor weighs in favor of the Applicant.

### **CONDITIONS UNDER WHICH THE SALES ARE MADE**

When determining whether a likelihood of confusion exists between two marks, the tribunal should examine the conditions under which the sales are made and the buyers to whom the sales are made. *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A., 1973). The Restatement (Third) of Unfair Competition indicates that:

“The care expected of purchasers against which the likelihood of confusion is measured is determined by the marketing environment in which the goods or services are ordinarily bought or sold. Some factors to be considered are the manner in which the goods are purchased...the manner in which the goods are marketed...and the class of prospective purchasers.” *Restatement (Third) of Unfair Competition § 20* (1995).

The question of care is one of degree. *Maxim’s Limited v. Badonsky*, 227 U.S.P.Q. 316, 320, n. 4 (7th Cir. 1985). Generally, the higher degree of ordinary care, the less the likelihood of confusion. *Fison Horticulture, Inc. v. Vigoro Indus., Inc.*, 31 U.S.P.Q. 2d 1592, 1599-1600, n. 12 (3rd Cir. 1994). The issue of care entails the degree to which consumers consider (a) the marks themselves as well as (b) information about the product sources other than what the marks convey. *Waldman Lighting Co. v. Halogen Lighting Sys., Inc.* 28 U.S.P.Q. 2d 1682, 1685 (N.D.Ill. 1993).

An increased degree of care and reduced likelihood of confusion is typically associated with the purchase of products that are used for a specific purpose. *Haydon Switch & Inst. v. Rexnord, Inc.* 4 U.S.P.Q. 2d 1510, 1517 (D. Conn. 1987). In this case, that specific purpose is flooring, the purchase of which would result in a more careful perusal of the nature and cost of the goods than that involved in a typical purchase by an ordinary consumer. (“The knowledge of

the purchasers in their particular field is highly relevant to their ability to distinguish between the two marks and directly aids in obviating confusion.”) See *In re Degussa-Huls AG1*, SN 75411277 (TTAB 2001).

There are many factors to consider when choosing flooring materials. “Each type of floor has its own merits and demerits. There is no single flooring material which can be suitable for all circumstances and for different purposes in different buildings such as residential, institutional, industrial, and go-downs. However, the selection of flooring should be made by considering the following factors” ...initial cost, appearance, cleanliness, durability, damp-resistance, sound insulation, thermal insulation, smoothness, hardness, comfort, fire-resistance, maintenance, light reflection, floor design, slipperiness, and location (See **Exhibits B and C**), as well as the square footage to be covered, the surface upon which the flooring will be installed, and whether the flooring is pet or eco-friendly.

Another important factor is the actual availability of flooring materials due to unpredictable disruptions to the supply chain such as the COVID-19 outbreak and its recurrent variants. “While the supply chain struggles that have plagued virtually every business around the world are easing in some areas, prolonged backlogs in ports, a shortage of truck drivers and other labor issues are continuing to wreak havoc on many segments of the flooring business...And while demand for flooring and other home products is strong, supply and labor are more strained than ever...” (See **Exhibit D**). Given these real-world challenges, consumers are more likely to settle for suitable goods that are actually “in-stock” rather than waiting for an indefinite period of time for the sake of brand loyalty.

Applicant submits that the high degree of deliberation and care involved in determining the suitability of the goods weighs heavily against finding the refusal issued.

The Examining Attorney must prove not just that there is a mere *possibility* of confusion, but that there is an *actual likelihood* of confusion (Emphasis Added). *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), citing *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g* 153 USPQ 412 (TTAB 1967) (We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations, but with the practicalities of the commercial world, with which the trademark laws deal).

Here, the Examiner posits only a remote "theoretical possibility" that a consumer of the goods offered under the cited marks and the goods offered under Applicant's mark, might mistakenly believe that they are offered by the same source.

### **CONCLUSION**

Applicant submits that given all the above arguments and evidence, consumers encountering goods in the marketplace under the marks at issue herein would be unlikely to mistakenly believe that there is a connection between the source of the respective goods. Accordingly, Applicant respectfully requests that the Section 2(d) refusal be withdrawn, and its application be approved for prompt passage to publication.