

The Examining Attorney has refused registration of the instant application under Section 2(d), 15 U.S.C § 1052(d) on the basis that Applicant's 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, 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 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 as to be likely to cause confusion, to cause mistake, or to deceive.

Applicant notes the refusal and presents arguments herein in support of registration by addressing the possible conflicts between the marks.

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 raised.

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). Applicant respectfully argues that the very fact that the cited marks already co-exist with each other in the flooring construction 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 "TALON" in Class 9 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 Fondee en 1772*, 396 F.3d 1369, 1374. (CAFC 2005). (internal quotation from *McCarthy on Trademarks §11:88 (4th 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).

The Examining Attorney argues that the "overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer." Applicant argues, however, that the cited marks have co-existed for over five (5) years. On January 19, 2016, **RN 48847838 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). Applicant contends that their 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.

Furthermore, there are currently three other registered marks in Class 19, owned by different entities, that consist of the single word “EVERLAST.”:

Mark	Details	Goods	Owner
EVERLAST Jurisdiction: US Reg: 2207037 Serial: 75360564	Registered Reg: 12/01/1998 Pub: 12/08/1998 Filed: 12/22/1997 First Use: 00/00/1990 Current Basis: 1a	019 natural stone for landscaping and building purposes	Ayers Supply Inc. 2036 Newton Ranson Boulevard Clarks Summit PENNSYLVANIA 18411 US
EVERLAST Jurisdiction: US Reg: 3719939 Serial: 77671988	Registered Reg: 12/01/2009 Pub: 06/09/2009 Filed: 02/17/2009 First Use: 09/01/2009 Current Basis: 1a	019 Non-metal building materials, namely, composite polymer siding	CHELSEA BUILDING PRODUCTS, INC. 565 CEDAR WAY OAKMONT PENNSYLVANIA 15139 US
EVERLAST Jurisdiction: US Reg: 3124862 Serial: 78574940	Registered Reg: 08/01/2006 Pub: 11/22/2005 Filed: 02/25/2005 First Use: 08/08/2005 Current Basis: 1a	019 non-metal door thresholds	Van Avery, Randy 9580 E. ML Avenue Galesburg MICHIGAN 49053 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 cited marks cannot prevent the registration of another "EVERLAST" related mark.

Applicant submits that the state of the Register for "EVERLAST" related marks is powerful evidence that Applicant's mark can coexist with the cited marks without confusion. Indeed, they already do.

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

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.