

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB FEB. 3, 00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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The Prudential Insurance Company of America  
v.  
Development & Construction Corporation of America

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Opposition No. 99,548 to application Serial No. 74/494,744  
filed on February 28, 1994

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David W. Maher, Samuel Fifer, Carol Anne Been and Gregory R.  
Naron of Sonnenschein Nath & Rosenthal for The Prudential  
Insurance Company of America.

William M. Hobby, III of Hobby & Beusse for Development &  
Construction Corporation of America.

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Before Hohein, Bottorff and Rogers, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Development & Construction Corporation of America,  
doing business as DECCA, has filed an application to register the  
mark "ROCSOLID" for the "custom construction of homes".<sup>1</sup>

The Prudential Insurance Company of America has opposed  
registration on the ground that it provides "a wide variety of

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<sup>1</sup> Ser. No. 74/494,744, filed on February 28, 1994, which alleges dates  
of first use of December 31, 1993.

**Opposition No. 99,548**

insurance and financial services, including those related to the financing, sale and development of real estate"; that since at least as early as July 1985, opposer has continuously and extensively used the mark "ROCK SOLID" to identify its services and, since at least as early as October 1986, it has used such mark in connection with its real estate development and construction services; that opposer consequently has "priority rights over Applicant's asserted subsequent first use of the term ROCSOLID in December, 1993"; that opposer is the owner of a federal registration for the mark "ROCK SOLID" for, inter alia, "real estate development services, namely planning, laying out and construction of real estate for others";<sup>2</sup> that opposer is also the owner of federal registrations for the mark "THE ROCK" for, among other things, "real estate development services, namely planning, laying out and construction of real estate for others"<sup>3</sup> and the mark "ROCK SOLID. MARKET WISE." for, inter alia, "financing services, namely providing and arranging for funds for others for the purchase of real and personal property"<sup>4</sup>; and that "use by Applicant of the term ROCSOLID for custom construction of homes is likely to cause confusion, mistake or deception."

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<sup>2</sup> Reg. No. 1,443,527, issued on June 16, 1987, which in relevant part sets forth dates of first use of October 14, 1986; combined affidavit §§8 and 15.

<sup>3</sup> Reg. No. 1,443,528, issued on June 16, 1987, which in pertinent portion sets forth dates of first use of October 14, 1986; combined affidavit §§8 and 15.

<sup>4</sup> Reg. No. 1,452,524, issued on August 11, 1987, which sets forth dates of first use of July 3, 1986; combined affidavit §§8 and 15.

**Opposition No. 99,548**

Applicant, in its answer, has admitted that opposer is the owner of the registrations which have been pleaded, but has otherwise denied the salient allegations of the notice of opposition.

The record includes the pleadings; the file of the opposed application; and, as part of opposer's case-in-chief, the affidavit, with exhibits, of its vice president and corporate secretary, Susan L. Blount, which was submitted pursuant to a stipulation by the parties. Opposer, as the rest of its case-in-chief, has submitted notices of reliance upon (i) applicant's responses to various requests for admission and its answers to certain interrogatories; and (ii) certified copies of opposer's previously mentioned registrations, together with certified copies of several other registrations owned by opposer, including registrations for the following:<sup>5</sup> (a) the mark "PEACE OF MIND. IT COMES WITH EVERY PIECE OF THE ROCK." for, among other things, "real estate development services; namely, planning, laying out and construction of residential, commercial and industrial properties for others";<sup>6</sup> (b) the mark "THE PRUDENTIAL" and design, as shown below,

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<sup>5</sup> Opposer indicates that it has submitted such registrations to show that its "ROCK SOLID" mark, which is the sole mark for which it claims that applicant's use of the mark "ROCSOLID" is likely to cause confusion, is "an extension" of its "Rock of Gibraltar" logo and its corresponding "The Rock" nickname.

<sup>6</sup> Reg. No. 1,868,561, issued on December 20, 1994, which in relevant part sets forth dates of first use of March 28, 1993.

**Opposition No. 99,548**

for, inter alia, "real estate development services, namely  
planning, laying out and construction of residential, commercial

**Opposition No. 99,548**

and industrial properties for others";<sup>7</sup> (c) the design mark, as depicted below,

for, among other things, "real estate development services, namely planning, laying out and construction of real estate for others";<sup>8</sup> and (d) the design mark, as illustrated below,

for, inter alia, "real estate development services, namely planning, laying out and construction of residential, commercial and industrial properties for others".<sup>9</sup> Such copies show, except in one instance,<sup>10</sup> that the registrations are subsisting and owned by opposer.

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<sup>7</sup> Reg. No. 1,580,456, issued on January 30, 1990, which in pertinent portion sets forth dates of first use of February 6, 1989; combined affidavit §§8 and 15.

<sup>8</sup> Reg. No. 1,471,603, issued on January 5, 1988, which in relevant portion sets forth dates of first use of May 16, 1994; combined affidavit §§8 and 15.

<sup>9</sup> Reg. No. 1,616,000, issued on October 2, 1990, which in pertinent portion sets forth dates of first use of February 6, 1989; combined affidavit §§8 and 15.

<sup>10</sup> Specifically, while opposer has also relied upon its ownership of Reg. No. 1,1735,276, issued on November 24, 1992 for the mark "MOVE UP TO THE ROCK" for "planning, laying out, and construction of

Applicant, as part of its case-in-chief, has filed the affidavit, with exhibits, of its president, Kulbir Ghumman, which was submitted pursuant to a stipulation by the parties.<sup>11</sup>

Opposer, as its rebuttal, has submitted in accordance with the parties' stipulation the affidavit, with exhibits, of its vice president of advertising, Mary Lou Sack. Briefs have been filed,<sup>12</sup> but an oral hearing was not requested.

Opposer's priority of its "ROCK SOLID" mark, which it argues in its briefs to be the sole mark with which applicant's use of the "ROCSOLID" mark is likely to cause confusion, is not in issue inasmuch as the certified copy of its registration

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residential and commercial properties," a check of the records of the Patent and Trademark Office reveals that such registration has subsequently been canceled pursuant to Section 8 of the Trademark Act. See TBMP §703.02(a). Accordingly, no further consideration will be given thereto.

<sup>11</sup> While opposer, in its main brief, has reiterated the objections which, as permitted by the parties' stipulation, it submitted in response to the Ghumman affidavit, suffice it to say that, regardless of whether any of opposer's objections is sustained and the specific testimony is excluded, the outcome in this case would be the same since much of the substance of such testimony is contained in the discovery responses by applicant which opposer has made of record.

<sup>12</sup> Opposer, with its main brief, has attached a copy of a wire service article dated March 19, 1999 and requests that "the Board take judicial notice of the article." In addition, with its reply brief, opposer submitted a copy of a May 14, 1999 news release which it assertedly issued and a copy of a June 1, 1999 newspaper article. Such matters, however, are not properly the subjects of judicial notice. See TBMP §712.01. Moreover, evidentiary materials attached to a party's briefs on the case can be given no consideration unless they otherwise properly form part of the record, such as being introduced during the party's time for taking testimony. See TBMP §705.02. According, since briefs may not be used as vehicles for the introduction of evidence, no consideration will be given to the materials attached to opposer's briefs. See TBMP §801.01. Furthermore, and in any event, even if such materials, in light of the lack of any objection thereto by applicant, were to be considered, it is pointed out that the news release lacks proper foundation and that the wire service and newspaper articles constitute inadmissible hearsay since opposer is offering the articles for the truth of the matters set forth therein.

therefor shows, as noted previously, that the registration is subsisting and owned by opposer. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). The only real issue to be determined, therefore, is whether applicant's "ROCSOLID" mark, when used in connection with the services of the custom construction of homes, so resembles opposer's "ROCK SOLID" mark for, inter alia, real estate development services consisting of the planning, laying out and construction of various properties for others, that confusion is likely as to the source or sponsorship of the parties' services.

According to the record, opposer provides a wide variety of insurance and financial services, including those related to the financing, sale and development of real estate. In particular, opposer provides nationwide real estate brokerage and referral services through The Prudential Real Estate Affiliates, Inc., a subsidiary network composed of over 1400 independently owned and operated franchisees. A significant part of opposer's real estate business involves the purchase and sale of retirement homes, and opposer also provides, to its senior citizen and retiree clientele, various related insurance and financial services, including retirement planning services.

Opposer commenced use of the mark "ROCK SOLID" in connection with "real estate financing, leasing and sales services at least as early as July 1985". (Blount aff. ¶10.) It "began using the ROCK SOLID mark in connection with real estate development and construction at least as early as October 1986

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and has used the mark in connection with real estate and real estate related services up to the present time." (Id.) Such mark, according to Ms. Blount, "is among Prudential's most well-known and prominently featured marks" and "is an extension of Prudential's many trademarks which play off the famous Prudential 'Rock of Gibraltar' logo and slogan ('THE PRUDENTIAL HAS THE STRENGTH OF GIBRALTAR'), use of which dates back to 1896." (Id. ¶11.)

Since 1985, opposer has expended over \$40 million "in advertising and promoting the services it offers under the ROCK SOLID mark in the United States alone." (Id. ¶14.) Opposer "advertises extensively in virtually every medium, including television, radio, newspapers, national magazines, telephone directories, the [I]nternet, and outdoor advertising." (Id. ¶15.) Opposer "has also advertised its services offered under the ROCK SOLID mark through direct mail marketing methods," including "direct mail advertising pieces for insurance and financial services featuring the ROCK SOLID mark ... directed specifically to senior citizens." (Id. ¶16.) In addition, through its previously mentioned subsidiary, opposer "has advertised its services offered under the ROCK SOLID mark in local editions of national real estate publications[, ] such as *Harmon Homes*, throughout the United States." (Id. ¶17.)

In light of its longtime use of its "ROCK SOLID" mark "in connection with, *inter alia*, the financing, sale, development and construction of real estate," opposer insists that it "has achieved widespread recognition of the mark ... for such services

**Opposition No. 99,548**

... and has developed substantial valuable goodwill therein." (Id. ¶19.) Such recognition for its mark, opposer maintains, "is confirmed by its 1995 net investment income of more than \$2 Billion attributable to real estate activities in the United States alone." (Id. ¶20.)

Applicant, the record shows, is in the business of developing and constructing retirement communities in the State of Florida. Applicant, in connection therewith, builds and sells retirement homes under the mark "ROCSOLID" solely in the State of Florida and, according to its president, had no actual knowledge of opposer's use of the mark "ROCK SOLID," in connection with the financing, sale and development of real estate, prior to the commencement of this proceeding. Moreover, applicant has never experienced any incidents of actual confusion due to the contemporaneous use of mark "ROCK SOLID" by opposer for its various services and applicant's use of its mark "ROCSOLID" for its custom home construction services.

Unlike opposer, applicant is not in the insurance business nor is it in the retirement planning business. Applicant, while contending that, to Mr. Ghumman's knowledge, opposer is not a licensed contractor in Florida or anywhere else in the United States, nevertheless admits that its services of the custom construction of homes are among the services included in the recitation of services set forth in opposer's registration for the mark "ROCK SOLID," which specifically lists "real estate development services, namely planning, laying out and construction of real estate for others". Applicant further

**Opposition No. 99,548**

admits that there are no third-party registrations for the mark "ROCK SOLID," or its phonetic equivalent, for construction services. Moreover, as to the meaning of the term "rock solid," applicant's president testified that his understanding thereof is "something [which] is solid as a rock or very solid" and that such term "is used in trademarks to give the same connotation." (Ghumman aff. ¶8.)

Applicant advertises its custom home construction services to senior citizens and retirees, a clientele which, it concedes, are potential customers and users of opposer's insurance services. In particular, applicant advertises the services which it offers under its "ROCSOLID" mark in national publications, such as Modern Maturity and Senior Golfer, and it promotes those services through the use of brochures, other printed materials, slide presentations and a scale model at its sales center. Advertising and promotional expenditures by applicant totaled \$414,000 in 1994 and \$359,000 in 1995, the only two years for which such information was provided. In addition, applicant's "ROCSOLID" custom home construction services have received publicity in various magazines and trade journals, including Florida Builder and Ocala Today. Sales presentations mentioning the mark have been made by applicant at seminars held in the Florida cities of Ft. Myers, Miami, Brooksville, Ft. Lauderdale, and Clearwater/St. Petersburg, and at trade shows conducted in Chicago, Illinois; Long Island, New York; and Greenbelt, Maryland.

Turning to the issue of likelihood of confusion, we find upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), that confusion as to source or affiliation is likely to occur. As a starting point, it is plain that applicant's "custom construction of homes" are services which are encompassed by, and hence are identical in part to, the "real estate development services, namely planning, laying out and construction of real estate for others," which are specified in opposer's subsisting registration for the mark "ROCK SOLID". Applicant, in fact, has admitted such, but contends that, in reality, the parties' services and their respective channels of trade are specifically different. In particular, applicant insists that opposer "has failed to produce any evidence in this proceeding that indicates that they are licensed general contractors or have ever constructed a single home under the mark ROCK SOLID."

However, as opposer correctly points out, it is settled that the registrability of an applicant's mark must be evaluated on the basis of the identifications of goods and/or services set forth in the involved application and any pleaded registrations of record, regardless of what the record may reveal as to the particular nature of the respective goods and/or services, their actual channels of trade, or the class of purchasers to which they are in fact directed and sold. *See, e.g.,* *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and *Canadian Imperial Bank of*

**Opposition No. 99,548**

Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). In particular, it is well established that, absent any specific limitations or restrictions in the identifications of goods and/or services as listed in the applicant's application and the opposer's registration(s), the issue of likelihood of confusion must be determined in light of consideration of all normal and usual channels of trade and methods of distribution for the respective goods. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Here, as applicant has conceded in its response to one of opposer's requests to admit, its services of the "custom construction of homes" are among the services included in the "real estate development services, namely planning, laying out and construction of real estate for others," recited in opposer's registration for the mark "ROCK SOLID". Applicant's services, therefore, must in legal contemplation be regarded as identical in part to opposer's particular services and, in consequence thereof, must be deemed to share the same channels of trade and class of purchasers. Clearly, if the same custom home construction services were to be rendered under identical or similar marks, confusion as to the origin or affiliation thereof would be likely to occur.

Applicant contends, however, that confusion is not likely because opposer's "ROCK SOLID" mark "presents an entirely

different commercial impression in that it is spelled different, looks different, has a different meaning, and provides an entirely different connotation to ... [applicant's] one-word mark ... ROCSOLID." Applicant also maintains that confusion is not likely because opposer's mark is weak due to its "descriptive and laudatory nature".<sup>13</sup> We concur with opposer, however, that the respective marks are phonetically identical and visually are virtually the same. Moreover, connotatively, both opposer's "ROCK SOLID" mark and applicant's "ROCSOLID" mark are identical in meaning, since each suggests, as used in connection with home or other real estate construction services, the durability of the dwellings or buildings constructed. Thus, even though the respective marks may be regarded as highly suggestive or laudatory in connotation, they nevertheless convey the same significance, are identical in sound, and are virtually identical in appearance. Considered in their entireties, as they must be, the marks "ROCK SOLID" and "ROCSOLID" engender essentially the same commercial impression. Consequently, when such marks are used in connection with legally identical services, confusion as to the origin or affiliation of the services is likely to occur. Furthermore, even if consumers were to notice the minor differences in the respective marks, they would not be likely to view such differences as indicative of separate sources for the

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<sup>13</sup> In the absence of a proper counterclaim for cancellation, opposer is correct in its reply brief that applicant's assertions that the mark "ROCK SOLID" is descriptive of, or is even generic for, opposer's real estate development services constitute an impermissible collateral attack on the validity of opposer's registration for such mark. No further consideration, therefore, will be given thereto.

**Opposition No. 99,548**

services, given opposer's history of utilizing marks which play upon its nickname of "The Rock" and the image of the Rock of Gibraltar in its logo.

Our conclusion that confusion is likely is strengthened by the fact that, on this record, there are no third parties utilizing marks which are either identical or substantially similar to the marks at issue herein in connection with services involving or relating to real estate construction. In addition, while we disagree with opposer's contention that the evidence establishes that its "ROCK SOLID" mark is indeed famous for real estate development services, the record nevertheless reflects that such mark, particularly given the recognition and strength developed therein through opposer's appreciable advertising and promotional expenditures since 1985 in excess of \$40 million, has become relatively well known as a source indicator for opposer's services and thus merits protection against imitation by applicant's "ROCSOLID" mark for the custom construction of homes.

Finally, the fact stressed by applicant that it has not experienced any instances of actual confusion does not undermine our conclusion that confusion is likely to occur. The record, in this regard, not only fails to reveal the extent of opposer's sales and advertising of its "ROCK SOLID" real estate development services in Florida, where applicant has exclusively rendered its "ROCSOLID" custom home construction services, or in any locations outside thereof, where applicant has exhibited at trade shows, but there is simply no indication that applicant has enjoyed such substantial sales volume for its services over an extended period

**Opposition No. 99,548**

of time that, if confusion were likely, it would be expected to have taken place. The lack of any incidents of actual confusion is also not dispositive herein inasmuch as evidence thereof is notoriously difficult to come by and, in any event, the test under Section 2(d) of the Trademark Act is likelihood of confusion rather than actual confusion. See, e.g., Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992) and cases cited therein.

**Decision:** The opposition is sustained and registration to applicant is refused.

G. D. Hohein

C. M. Bottorff

G. F. Rogers  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board