

THIS DISPOSITION
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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

Lykos

Mailed: April 13, 2006

Opposition No. 91159554

Florida Engineered
Construction Products
Corporation¹

v.

Cast-Crete Inc.

Before Bucher, Holtzman and Kuhlke, Administrative Trademark
Judges.

By the Board:

This case now comes up for consideration of (1)
opposer's motion to amend the notice of opposition pursuant
to Fed. R. Civ. P. 15(a); (2) applicant's cross-motion to
dismiss the case; and (3) opposer's motion for summary
judgment.

By way of background, applicant applied to register the
mark displayed below

¹ By this order, the caption of this proceeding has been amended
to reflect opposer's correct name. The parties should therefore
caption all further submissions in the above manner.



for "pre-cast concrete products for building, namely, window sills, lintels, cornices, fireplace mantels, stepping stones, well rings and covers, countertops, planters, postal bases, panels, meter boxes, vaults, houses, curbstone, pier caps, piers, parking lot bumpers, light bases, custom architectural designs, coping banding, balustrades, balusters, rails, stairs, landings, arches, keystones, grave markers, monuments, sculpture, fountains, coins" in International Class 19.² The mark was published for opposition on December 2, 2003.

On December 29, 2003, a party identified as "Florida Engineered Construction Products Corporation" filed a request to extend the time to oppose the involved application. The Board granted the extension request. On January 27, 2004, a party identified as "Cast-Crete, formerly known as Florida Engineered Construction Products

² Application Serial No. 78030642, filed October 14, 2000, alleging October 2, 1997 as the date of first use anywhere and in commerce.

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Corporation" filed the notice of opposition. The notice of opposition contains the following salient allegations:

1. Cast-Crete Corporation of Florida . . . had adopted and had used the trademark CAST CRETE for a wide variety of concrete products, including lintels, sills, manholes, catch basin, slabs, beams, and blocks.
2. Cast Crete Corporation of Florida . . . first used the trademark CAST CRETE in interstate commerce on August 30, 1962.
4. On or about January 31, 1987, Florida Engineered Construction Products Corporation . . . purchased Crete-Corporation of Florida including all goodwill and all marks associated therewith . . .
5. On or about January 1, 2004, Florida Engineered Construction Products Corporation changed its name to Cast-Crete Corporation.
6. Cast-Crete Corporation assumed all goodwill and all marks associated with Florida Engineered Construction Products Corporation, including the trademark CAST CRETE.
17. The term CAST CRETE, alleged to be used by Applicant in association with concrete products, is confusingly similar in appearance, sound, connotation and commercial impression to CAST CRETE, the trademark of Opposer, used in association with concrete products.

In its answer to the notice of opposition, applicant denied the salient allegations and asserted various affirmative defenses.

We now turn to the motions pending before us.

- I. *Opposer's Motion to Amend the Notice of Opposition and Applicant's Cross-Motion to Dismiss the Case*

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Opposer now seeks to amend the notice of opposition to name Florida Engineered Construction Products Corporation as the proper party plaintiff and to correct the Cast Crete Corporation and Florida Engineered Construction Products Corporation merger date from January 31, 1987 to December 1, 1995. Opposer argues that on August 23, 1962, Cast-Crete Corporation ("Cast-Crete") began using its trademark in interstate commerce; that on December 1, 1995, Florida Engineered Construction Products Corporation merged with Cast-Crete, with Florida Engineered Construction Products Corporation acquiring the rights in the CAST-CRETE trademark; that at the time opposer filed its notice of opposition (January 27, 2004), it mistakenly believed that Florida Engineered Construction Products Corporation had changed its name to Cast-Crete; that subsequent to the filing of notice of opposition, Florida Engineered Construction Products Corporation learned that it had not changed its name to Cast-Crete but that rather a wholly owned subsidiary company of Florida Engineered Construction Products Corporation, American Enterprise Solutions, had changed its name to Cast-Crete on February 26, 2004; that the identification of Cast-Crete was a mistake; that the proper party in interest is Florida Engineered Construction Products Corporation; that the proposed amendment should be allowed because it does not involve the substitution of a

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different party; and that applicant will not be prejudiced because during the course of the proceeding, applicant has been aware of the existence of Florida Engineered Construction Products Corporation. In support of its motion, applicant has submitted the declaration of Mr. Craig M. Parrino, Vice President of Engineering of Florida Engineered Construction Products Corporation with various exhibits attached thereto attesting to the above facts; an amended notice of opposition, and the declaration of Mr. Ralph W. Hughes, Chairman of Florida Engineered Construction Products Corporation.

In response, applicant argues that opposer has submitted no evidence that Florida Engineered Construction Products Corporation, and American Enterprise Solutions are related entities, and that because opposer failed to use diligence in its filing of the notice of opposition, the case should be dismissed.

Opposer's motion to amend its pleading and applicant's motion to dismiss present the same issue, that is whether the misidentification of Cast-Crete in the notice of opposition is a type of mistake contemplated by Fed. R. Civ. P. 15(a) such that the Board may now allow opposer to amend the notice of opposition to name Florida Engineered Construction Products Corporation as party plaintiff. Based on the

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record before us, we find that opposer's misidentification of the opposer in the notice of opposition is the type of mistake which may be corrected.

Under Fed. R. Civ. P. 15(a), leave to amend pleadings shall be freely given when justice so requires. The Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse parties or parties. Section 512.04 of the TBMP (2d ed. rev. 2004) states in relevant part:

When it is shown to the satisfaction of the Board that a party in whose name a Board proceeding complaint was filed was misidentified therein by mistake, the Board may allow amendment of the complaint, or pursuant to Fed. R. Civ. P. 15(a), to correct the misidentification and/or to substitute the proper party in interest.

For example, in *Davidson v. Instantype, Inc.*, 165 USPQ 269 (TTAB 1970), the Board applied Rule 15(a) and permitted opposer to amend its notice of opposition to substitute the real party in interest where it was shown that the incorrect party was named due to a mistake. In that case, the opposition was filed in the name of an individual. While taking the testimony of opposer, it became clear that the proper plaintiff

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was not the individual named in the notice of opposition, but rather a corporation where the individual worked. It also became evident that the named individual and his wife owned the stock in the corporation. The Board, after determining that the corporation controlled the use of the trademark at issue in the case, allowed opposer time to substitute the party plaintiff. As the Board remarked:

In the instant case, it is apparent that the filing of the notice of opposition in the name of the individual rather than in the name of the corporation which he represents occurred because of an innocent misconception made either by Mr. Davidson or his attorney. Since Rule 15 of the Federal Rules of Civil Procedure provides that leave to amend "shall be freely given when justice so requires" it is our opinion that opposer should be granted leave to amend its opposition to substitute the proper party-in-interest and that applicant will not be unduly prejudiced thereby.

Id. at 271.

In addition, Trademark Rule 2.102(b), which pertains to misidentifications in extensions of time to oppose, provides a useful analogy. The rule states in relevant part:

Any opposition filed during an extension of time should be in the name of the person to whom the extension was granted, but an opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

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To illustrate an application of this rule, in *Custom Computer Services Inc. v. Paychex Properties Inc.*, 67 USPQ2d 1638 (Fed. Cir. 2003) a party identified as "Custom Computer Services, Inc., formerly known as The Payroll People" filed two requests to extend the time to oppose the involved application. The Board granted each extension request. Thereafter, a party identified as "The Payroll People, Inc." filed the notice of opposition. The Board, failing to note the difference in the identification of the parties who filed the extension requests and notice of opposition, instituted the proceeding without requesting an explanation, and named Custom Computer Services, Inc. as opposer. Opposer sought to amend the notice of opposition to name The Payroll People, Inc. as party plaintiff. The Board granted applicant's motion to dismiss, and denied opposer's motion for leave to amend the notice of opposition to correct the party plaintiff on the ground that The Payroll People, Inc. failed to demonstrate the requisite privity with Custom Computer Services, Inc.

On appeal, the Federal Circuit reversed the Board finding that while substantial evidence supported a finding of a lack of privity, a mistake

was made within the parameters of the rule. The court's reasoning was as follows:

It is not the case that the entity named in the extensions is a "different *existing* legal entity." *Cass Logistics*, 27 USPQ2d at 1077 (emphasis added). The PTO's reliance on *Cass Logistics* is thus unsound, as there were two independent existing legal entities involved in that case. Here, there never has been an entity named "Custom Computer Services, Inc., formerly known as The Payroll People." There is an entity presently named "Custom Computer Services, Inc.," but it was never formerly known as "The Payroll People." Instead, we have here a mistake in the *form* of one entity's name, *i.e.*, Payroll People, a mistake consistent with the PTO's definition of a mistake. To be sure, the mistake that occurred here was an incorrect belief that a corporate name had changed. However, that was a mistake as to the *form* of the correct entity, not an attempt to substitute one entity in the place of a different existing legal entity. Accordingly, all evidence unambiguously supports the finding that the mistake in this case was one within the meaning of §2.102(b), and the decision of the Board was therefore lacking in substantial evidence.

The circumstances presented here are similar to both cases discussed above. The declaration of Mr. Craig Parrino, vice president of Engineering of Florida Engineered Construction Products Corporation, clearly states that the identification of Cast-Crete in the notice of opposition was an innocent mistake, and was a mistake in the form of the entity, not an attempt to substitute an entirely different company. According to Mr. Parrino, while searching

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corporate records in order to respond to applicant's discovery requests, he learned that his good-faith belief regarding the date of the corporate merger as well as the name change was erroneous, and was due to "a mistake and/or an innocent misconception" on his part. Moreover, based on the record before us, the mistake in the identification of opposer and merger date has not unduly prejudiced applicant in terms of taking discovery or otherwise defending itself against the opposition. Thus, by applying Rule 15(a) to the present case and the same principles embodied 2.102(b), justice would require allowing opposer to correct its mistake.

In view thereof, opposer's motion to amend the notice of opposition to name Florida Engineered Construction Products Corporation as the proper party in interest is hereby granted and applicant's motion to dismiss is denied. Opposer's amended notice of opposition is now the operative pleading in this case.³

II. Opposer's Motion for Summary Judgment

Next, we consider opposer's motion for summary judgment on the grounds of likelihood of confusion and priority. On

³ With regard to opposer's request that the exhibits attached to the original notice of opposition "remain of record," opposer is advised that exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced in evidence as exhibits. See Trademark Rule 2.122(c).

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the issue of likelihood of confusion, opposer maintains that insofar as opposer's first set of admission requests have been deemed admitted by applicant, applicant has admitted to a likelihood of confusion between the parties' respective marks.⁴ As to the issue of priority, opposer contends that it has conclusively established that through its predecessor in interest and the evidence submitted with its motion that opposer first used its mark CAST-CRETE in interstate commerce on August 30, 1962, and that such use has been continuous.⁵ In support of its motion for summary judgment, opposer has attached the declarations of Mr. Craig Parrino, vice president of opposer and Mr. Ralph W. Hughes, chairman of opposer, with various exhibits attached thereto; as well as excerpts from the discovery deposition transcripts of Mr. Gail Brewer, president of applicant and Glen S. Petrosso, a corporate representative of applicant; opposer's first set of requests for admissions; and opposer's first set of interrogatories and applicant's responses thereto.

Applicant, in response to opposer's motion for summary judgment, argued the issue of likelihood of confusion on its merits, and does not address opposer's assertions regarding

⁴ On December 15, 2004, the Board granted as conceded opposer's motion to deem admitted its first set of admission requests. See Fed. R. Civ. P. 36(a) and Trademark Rule 2.127(a).

⁵ Opposer states that it inadvertently allowed its federal Registration No. 0836555 to expire.

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the effect of applicant's admissions. On the issue of priority, applicant maintains that the "key test" is whether "the first user's market penetration at the time of the second user's entry is significant enough to pose a real likelihood of confusion"; that opposer has failed to demonstrate prior use under this standard; that in addition, opposer's interstate use of its mark has been sporadic and not continuous; and that opposer's documentation is insufficient for establishing prior use. Applicant submitted with its responsive brief the declaration of Mr. Brewer.

In its reply brief, opposer contends that applicant has applied the wrong test for priority. Opposer submitted therewith a second declaration from Mr. Parrino regarding opposer's inadvertent expiration of its federal registration.

Before further discussing the merits of opposer's summary judgment motion, we will consider applicant's objections to the declarations of Mr. Craig Parrino and Mr. Ralph W. Hughes, and the exhibits attached thereto. Applicant has objected to the declarations and a number of the exhibits on the grounds that they contain inadmissible hearsay statements and are irrelevant.

Applicant's objections are overruled. With respect to applicant's hearsay objections, the statements of both

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declarants were made with personal knowledge and not based on out-of-court statements of persons other than the declarants. See Fed. R. Evid. 802. Moreover, the declarations and exhibits attached thereto are being submitted for the purpose of showing prior use, the extent of opposer's use of its mark throughout the United States, and public recognition of opposer's mark. See Fed. R. Evid. 802. As to applicant's objections on relevancy, the declarations and exhibits submitted therewith are clearly relevant to the issues likelihood of confusion and priority presented in this case. See Fed. R. Evid. 402.

We will now discuss whether summary judgment is warranted in this case. Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable

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to the nonmoving party. See *Opryland USA, Inc., v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.

A plaintiff moving for summary judgment in its favor on a Section 2(d) claim must establish that there is no genuine dispute that (1) it has standing to maintain the proceeding; (2) contemporaneous use of the parties' respective marks on their respective goods would be likely to cause confusion, mistake or to deceive consumers; and (3) it is the prior user of its pleaded mark. See *Hornblower & Weeks, Inc., v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733 (TTAB 2001).

We first turn to the facts alleged in opposer's requests for admission, which stand admitted pursuant to the Board's December 15, 2004 order. The facts established by applicant's admissions include the

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following: that applicant did not use its mark in interstate commerce until October 2, 1997 (admission no. 2); that applicant uses its mark in connection with sills, window sills, thresholds, parking bumpers, slabs, beams, and scuppers (admission nos. 3-10); that the parties' goods are sold through the same trade channels and to the same types of purchasers (admission nos. 11 and 12); and that the parties' marks are identical in sound, pronunciation, meaning and commercial impression (admission nos. 13, 14 and 15). These admissions demonstrate that no genuine issue of material fact exists as to opposer's pleaded claim of likelihood of confusion under Section 2(d) of the Trademark Act.

The admission requests, however, by themselves do not establish opposer's priority. As to that issue, we find that opposer has satisfied its burden on summary judgment of demonstrating prior use by virtue of the evidence it has submitted in conjunction with its motion for summary judgment.

Before turning to a discussion of this evidence, we note that opposer is correct that applicant has argued its case under the wrong standard for assessing priority in Board proceedings. To establish priority on a likelihood of confusion claim brought under Trademark Act Section 2(d), a

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plaintiff must prove that it owns "a mark or trade name previously used in the United States ... and not abandoned...." Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). The geographic extent of such use is irrelevant except in the context of a concurrent use proceeding. See *Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227 (TTAB 1989). A plaintiff may establish its own prior proprietary rights in a mark through actual trademark use or through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspaper advertisements and Internet websites which creates a public awareness of the designation as a trademark identifying the party as a source. See Trademark Act Sections 2(d) and 45, 15 U.S.C. Section 1052(d) and 1127; *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), *vacating PacTel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994). Thus, applicant's arguments regarding market penetration are irrelevant here.

Furthermore, applicant's assertion that opposer must demonstrate continuous use of its pleaded mark in order to prevail on the issue of priority is misplaced. In *West Florida Seafood Inc. v. Jet Restaurant, Inc.*, 31 USPQ2d 1660 (Fed. Cir. 1994), the Federal Circuit, in reversing the Board, held that a plaintiff in a Board proceeding need not show continuous use unless the defendant is asserting the

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affirmative defense of abandonment. The Court, in reaching its conclusion, highlighted the following language from the Trademark Act:

The governing statute does not speak of "continuous use," but rather of whether the mark or trade name has been "*previously used* in the United States by another *and not abandoned*." 15 U.S.C. Section 1052(d)(emphasis in original).

In this particular case, applicant has not asserted the affirmative defense of abandonment. Furthermore, we find that opposer has demonstrated use of its mark at least as early as 1996 which is sufficient to show use prior to the October 14, 2000 filing date of the involved application which, in the absence of any proof of earlier use, is the earliest date on which applicant is entitled to rely. According to the declarations of Mr. Parrino and Mr. Hughes, opposer first used the mark CAST-CRETE in interstate commerce on August 30, 1962, and such use has been continuous. Documentary evidence of such use includes a photograph from a publication showing the mark CAST-CRETE imprinted on a box containing opposer's goods dated April 1977, submitted as Exhibits 21 and 22 to the declaration of Mr. Hughes; photographs from a publication showing the mark CAST-CRETE imprinted on a box containing opposer's goods dated 1974-1981, submitted as Exhibits 24 and 25 to the declaration of Mr. Hughes; a photograph of a truck imprinted with the mark CAST-CRETE transporting opposer's goods from a

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publication dated "Fourth Quarter 1990", submitted as Exhibit 34 to the declaration of Mr. Hughes and accompanied by the statement in the declaration that the trucks are used to transport opposer's goods in interstate commerce; and a photograph of a truck imprinted with the mark CAST-CRETE transporting opposer's goods from a publication dated July 1, 1996, submitted as Exhibit 38 to the declaration of Mr. Hughes and accompanied by the statement in the declaration that the trucks are used to transport opposer's goods. Based on this evidence, opposer has established its claim of priority.

Further, we find that the evidence of opposer's prior use of the CAST-CRETE mark shows, and there is no dispute, that opposer has standing to bring this case. As such, no genuine issue of material fact exists on the issue of standing.

Based on the foregoing, we find that there is no genuine issue of material fact and that confusion is likely to result as a matter of law. See Fed. R. Civ. P. 56(e).⁶

Accordingly, in view of the foregoing, the opposition is sustained, and registration of applicant's mark is

⁶ Applicant's request to "modify its application to limit the goods . . . so as to avoid a likelihood of confusion" in the event that the Board determines that opposer has met its burden of proof on summary judgment is denied. Applicant has made no formal motion to amend its application but has merely attempted to reserve the right to modify its application in an attempt to avoid judgment.

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refused.