

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re INNOVATIVE MARBLE & TILE, INC.

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Serial No. 75/119,724

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Myron Amer for INNOVATIVE MARBLE & TILE, INC.

Won T. Oh, Trademark Examining Attorney, Law Office 104.

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Before Cissel, Hanak and Chapman, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

INNOVATIVE MARBLE & TILE, INC. (applicant) seeks to register in typed drawing form SIGNATURE STONE for "flat pieces of marble and granite to cover floors." The intent-to-use application was filed on June 12, 1996. In the first Office Action, the Examining Attorney explained that the word STONE in applicant's mark was descriptive of applicant's goods, and hence must be disclaimed. In response, applicant disclaimed exclusive rights to the use of the word STONE.

Citing Section 2(d) of the Trademark Act, the Examining Attorney has refused registration on the basis that applicant's mark SIGNATURE STONE, as applied to applicant's goods, is likely to cause confusion with the mark SIGNATURE TILE, previously registered in typed drawing form for "ceramic tile." Registration No. 757,145.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed opening briefs. Applicant also filed a reply brief, which this Board has considered. Applicant did not request a hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Considering first the marks, they both begin with the arbitrary word SIGNATURE. Indeed, the word SIGNATURE is the only arbitrary portion of applicant's mark and registrant's mark. We have already explained that applicant has disclaimed exclusive rights to the

descriptive word STONE. In similar fashion, registrant disclaimed the exclusive rights to the descriptive word TILE.

We are fully aware that "the basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with a particular goods or services for which they are used." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985). However, the foregoing principle is set forth with the caveat that "in articulating reasons for reaching a conclusion on the issue 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." National Data, 224 USPQ at 751. It is well known that "one commonly accepted rationale for giving less weight to a portion of a mark" is if that portion "is descriptive or generic with respect to the involved goods." National Data, 224 USPQ at 751.

In view of the foregoing, it is our determination that the word SIGNATURE is the dominant portion of both marks. Not only is it the only arbitrary portion of both marks, but in addition, it is the first word of both marks and the longest word of both marks. Moreover, both the application and the cited registration depict the marks in typed

drawing form. Because both marks are depicted in typed drawing form, "this means that [the] application [and registration are] not limited to the mark[s] depicted in any special form[s]." Phillips Petroleum Co. v. C.J. Webb, Inc. 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971).

Accordingly, in deciding the issue of likelihood of confusion, we are obligated "to visualize what other forms the mark[s] might appear in." Phillips Petroleum, 170 USPQ at 36.

One reasonable manner of presenting applicant's mark would be to have the arbitrary word SIGNATURE appear on one line in larger lettering, and the descriptive word STONE appear on a second line in smaller lettering. Likewise, one reasonable manner of presenting the registered mark would be to depict the arbitrary word SIGNATURE on one line in larger lettering, and the descriptive word TILE in smaller lettering on a second line. When so depicted, the marks would be extremely similar.

Considering next the goods, applicant's goods are flat pieces of marble and granite to cover floors. Obviously, registrant's goods (ceramic tile) could likewise cover floors. In other words, both applicant's product and registrant's product serve the same purpose. An ordinary homeowner, in need of covering his bathroom or kitchen

floor, could easily go to a building supply house and be confronted with various floor covering options including marble, granite and ceramic tile. If said ordinary homeowner were to see the mark SIGNATURE STONE on marble and granite and see the mark SIGNATURE TILE on ceramic tile, we are of the very firm belief that said ordinary homeowner would believe that all three products emanated from a common source. This ordinary homeowner would, in our judgment, view the descriptive words STONE and TILE not as source indicators, but rather as words which simply named the different type of floor coverings. Indeed, we believe that the marks are so similar that even a professional builder would assume that both marks indicated that the products emanated from a common source, and that the words STONE and TILE merely indicated the particular type of product.

Finally, we take note of the fact that the Examining Attorney has properly made of record five third-party registrations which cover ceramic tile, on the one hand, and marble and/or granite on the other hand. While it is true that such third-party registrations do not prove that the marks registered are in actual use, they nevertheless "have some probative value to the extent that they may serve to suggest that such goods or services are of the

type which may emanate from a single source." In re Mucky Duck Restaurant Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), aff'd as not citable precedent 88-1444 (Fed. Cir. November 14, 1988). In any event, we would have reached the same result that there exists a likelihood of confusion regardless of the presence or absence of these third-party registrations in the record.

Decision: The refusal to register is affirmed.