

1/24/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 13
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Norcom Incorporated**

Serial No. 75/543,910

Christopher P. Bussert and Sara K. Stadler of **Kilpatrick Stockton LLP** for **Norcom Incorporated**.

Amy Gearin, Trademark Examining Attorney, Law Office 107
(**Thomas Lamone**, Managing Attorney).

Before **Seeherman, Hohein** and **Hairston**, Administrative Trademark Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Norcom Incorporated has filed an application to register the mark "DOCUWORKS" for "office supplies, namely, typing paper, multi-purpose paper, inkjet paper, laser paper, copier paper; business and scratch pads; index cards, sheet protectors, binders, pad holders, project planners, daily planners, report covers, envelopes, indexes, clip boards, file folders, hanging files, notebooks, steno books, memo books, writing tablets, pocket dividers, tabbed dividers, and index guides."¹

¹ Ser. No. 75/543,910, filed on August 27, 1998, which alleges a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "DOCUWORKS," which is registered for "photocopying and document reproduction services,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed and an oral hearing was held. We affirm the refusal to register.

The determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), "in any likelihood of confusion analysis[,] two key considerations are the similarity of the goods and the similarity of the marks."³ Here, inasmuch as the respective marks are identical in all respects and engender the same commercial impression,⁴ the focus of our inquiry is on whether any of applicant's goods are so related to registrant's services that, when such goods and services are offered under the

² Reg. No. 2,200,051, issued on October 27, 1998, which sets forth dates of first use of January 10, 1998.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

⁴ Applicant, we observe, not only does not seriously appear to contend otherwise, but acknowledges, in its initial brief, "[t]he fact that the 'DOCUWORKS' marks at issue happen to be identical."

mark "DOCUWORKS," confusion as to the source or sponsorship thereof is likely to occur. We note in this regard that, as a general proposition, where the respective marks are identical (as in this case) or essentially the same, there need be only a viable relationship between the goods and/or services in order to support a holding of likelihood of confusion. See, e.g., In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1983) and In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983).

Applicant, as summarized in its initial brief, argues essentially that there is no real likelihood of confusion because the respective goods and services are "distinctly different," with applicant selling "'garden variety' office supplies" while registrant offers photocopying and document reproduction services. In particular, applicant insists that (**emphasis in original**):

[T]here is no evidence that consumers could **find**, much less purchase, the goods and services at issue in the same "retail stores." Indeed, in the reality of the marketplace, the types of third[-]party branded goods and services at issue do not share **any** channels of trade. For one thing, there is no record evidence that a consumer could find branded office supplies and photocopying services offered by unrelated third parties in the same "retail stores." And even if some of the business[es] cited by the Examining Attorney do offer both office supplies and photocopying services, this circumstance does nothing to support a finding of likely confusion because the cited businesses are offering the goods and services at issue, if at all, **either under**

their own "house mark" or as an unbranded convenience to customers.

Applicant also contends that "confusion between the marks at issue is extremely unlikely" because, according to the record, "the marks at issue have coexisted for more than a year with absolutely no evidence of actual confusion"; there exists "a multitude of 'DOCU' [prefixed] marks . . . , which necessarily narrows the scope of protection to which the cited registration is entitled"; and there is a "lack of any predatory intent" on the part of applicant to trade upon the goodwill in registrant's mark.

Several declarations have been submitted by applicant in support of its position, including two from its chief financial officer in which he states, inter alia, that applicant provides "new, prepackaged office supplies for use by the general consumer"; that applicant intends to market its goods under its "DOCUWORKS" mark through such retail channels as grocery stores, drug stores and mass merchandisers, but it does not intend to offer any services under such mark; that even if some of the goods applicant provides under its "DOCUWORKS" mark "were to be used for photocopying purposes, the consumers themselves would have to perform the photocopying function using their own equipment, which would not involve professional 'document reproduction services' in the least"; that in adopting its mark, applicant "had **no** intention of trading upon the reputation of any other person or firm" (**emphasis in original**); and that, since applicant began marketing its goods in March 1999, he is "unaware

of a single instance in which anyone believed that the DOCUWORKS mark or the office supplies ... sold under that mark were associated or connected with the Cited Registrant or had the sponsorship, endorsement, or approval of the Cited Registrant."

The Examining Attorney, on the other hand, contends that confusion is likely because, among other things:

Some of the applicant's products, namely, "typing paper, multi-purpose paper, inkjet paper, laser paper, and copier paper[,"] are sold as supplies for copying or duplicating devices. In addition, as the evidence of record shows, office supplies and document reproduction services are commonly offered by a single source under a single mark. It would, therefore, be reasonable to assume that office supplies, namely, "typing paper, multi-purpose paper, inkjet paper, laser paper, copier paper, business and scratch pads, index cards, sheet protectors, binders, pad holders, project planners, daily planners, report covers, envelopes, indexes, clip boards, file folders, hanging files, notebooks, steno books, memo books, writing tablets, pocket dividers, tabbed dividers and index guides," are goods that are in registrant's normal field of expansion.

Furthermore, according to the Examining Attorney, because "[t]he evidence of record establishes that office supplies and photocopying and document reproduction services are sold together in retail stores and that there are [registrations of] marks on the principal register in which office supplies and photocopying or document reproduction services originate from the same source," the Examining Attorney asserts that:

In this case, the average consumer, who uses registrant's photocopying services, under the mark DOCUWORKS, would recollect the mark, DOCUWORKS, when purchasing applicant's office supplies, such as copier paper and laser paper, at a retail store. They would

mistakenly assume some sponsorship, affiliation or connection between the goods and services because they are used together and are commercially related.

As to applicant's remaining contentions, the Examining Attorney urges that the absence of any known incidents of actual confusion over the course of a year's time is not controlling on the issue of likelihood of confusion, particularly since, in an ex parte proceeding, "the registrant has not had an opportunity to be heard on the issue"; that "[w]hile there are other 'DOCU' [formative] marks on the principal register, there is only one DOCUWORKS mark on the principal register and that is the cited mark in this case"; and that, even though applicant adopted its mark in good faith, such "does not change the fact that office supplies, such as copier paper and laser paper, and photocopying and document reproduction services are used together, and will likely be associated with one another in the minds of consumers." Any doubt, therefore, as to whether there is a likelihood of confusion must, the Examining Attorney maintains, be resolved in favor of the registrant.

As support for her position, the Examining Attorney notes that the record contains copies of various excerpts from the "NEXIS" database, use-based third-party registrations and an advertisement which, according to the Examining Attorney, constitute "evidence that office supplies and photocopying or document reproduction services are sold together in retail stores." Representative of the 14 "NEXIS" excerpts are the following (**emphasis added**):

"Staples Inc. said it will open an office superstore ... in Russellville.

The ... store will carry general **office supplies**, office furniture, computers, business machines and assorted software. Faxing, **photocopying** and binding services will also be available." -- Arkansas Democrat-Gazette, April 21, 1999;

"Many small businesses and student customers want to shop for **office supplies** and use **photocopy** machines 'whenever it's most convenient, even if it's 3 in the morning,' Staples President Jim Peters said. Westboro-based Staples is believed to be the first among office supply stores to open all night." -- Patriot Ledger (Quincy, MA), April 8, 1999;

"Farther north, construction is scheduled to begin ... on a new Kinko's. The **photocopying** shop and **office supply** store is leaving its location ... for a larger store" -- Broward Daily Business Review, December 9, 1998;

"The coalition has been lobbying for four years to block the Postal Service from offering **photocopying**, packaging services and money transfer services, as well as the sale of **office supplies** and novelty items." -- Washington Post, October 23, 1998;

"Banc One spokesman John Russell said the bank is seeking retailers like Mail Boxes Etc. to draw customers to the bank. He said the retailer, which provides postal services, packing and shipping, **photocopying**, faxing, and **office supplies** in 2,700 stores in the United States, attracts small business customers" -- American Banker, March 7, 1997; and

"The Thatches opened the **photocopying** and **office supply** shop" -- Kansas City Star, August 31, 1995.

Of the use-based third-party registrations, there are seven which list marks which are registered for photocopying services and/or document reproduction services, on the one hand,

and retail store services featuring office supplies, on the other. Four of these, however, are owned by the same registrant. In addition, there is one third-party registration for a mark which is registered both for document reproduction services and such office supplies as "paper, namely, copy, bond and colored." While, admittedly, the third-party registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, it nevertheless is settled that such registrations have probative value to the extent that they serve to suggest that the services and goods listed therein are of the kinds which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6.

Furthermore, as pointed out by the Examining Attorney, the record also contains a Yellow Pages advertisement by "Office Depot" which touts the retail availability of both "Office Supplies" and an "In-Store Copy & Print Center." Applicant, we additionally observe, likewise submitted a copy of essentially the same ad (see exhibit D) with its request for reconsideration.

As correctly noted by the Examining Attorney in her brief, it is well settled that goods and services need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods and services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under

situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same entity or provider. See, e.g., *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978) and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). It is also well established that a refusal under Section 2(d) of the statute is proper if use of the respective marks in connection with any of the goods and services respectively set forth in the application and cited registration would be likely to cause confusion. See, e.g., *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) [likelihood of confusion must be found if use of a mark for any item in an applicant's application is likely to cause confusion with a mark for any of registrant's goods] and *Shunk Manufacturing Co. v. Tarrant Manufacturing Co.*, 318 F.2d 328, 137 USPQ 881, 883 (CCPA 1963) [where there is a likelihood of confusion as to any of the goods listed in an application, it is unnecessary to rule on other goods listed therein].

While, in the present case, the issue of whether any of applicant's goods would be viewed by purchasers as sufficiently related to the cited registrant's services is concededly a close question, we cannot agree with applicant's contentions, as reiterated in its reply brief, that the evidence of record establishes that the respective goods and services are unrelated because, for instance, "consumers **never** could find office supplies under Brand A and photocopying services under Brand B in

the same stores" and that "**office supplies and document reproduction services never are offered by a single source under a single mark**" (emphasis in original). Instead, we are constrained to concur with the Examining Attorney that the record demonstrates that there are retailers which offer to consumers, typically under the same house mark (although in one instance under the identical product and service mark), office supplies such as inkjet paper, laser paper and copier paper, on the one hand, and photocopying and/or document reproduction services, on the other. In view thereof, and given the obvious inextricable nexus between various inkjet, laser and copier papers and the photocopying and document reproduction services which utilize such products, we believe that consumers, whether ordinary purchasers or business professionals, would find such goods and services to be related as to their source or sponsorship, particularly when offered under the identical mark.

In particular, although applicant's inkjet, laser and copier papers, as well as its other "garden variety" office supplies, may not necessarily--in light of applicant's stated intent--be sold by applicant or registrant in the same retail outlets where registrant's photocopying and document reproduction services are performed, it is still the case that consumers commonly purchase both office supplies and copying services and that they cross-shop the retail establishments offering such goods and services. It is therefore reasonable to conclude, in light of the evidence of record before us, that consumers familiar with the photocopying and document reproduction services

provided by registrant under its "DOCUWORKS" mark in copy centers or office supply stores would assume, upon seeing applicant's inkjet paper, laser paper, copier paper and other office supplies for sale under the identical mark "DOCUWORKS" in such retail channels as grocery stores, drug stores and mass merchandisers, that the respective services and goods share a common origin or affiliation. Specifically, those acquainted with registrant's "DOCUWORKS" photocopying and document reproduction services are likely to assume, for example, that registrant has expanded its business to offer, under the identical mark "DOCUWORKS," a line of closely related office supplies such as inkjet, laser and copier paper.

Our conclusion in this regard is not diminished or otherwise altered by applicant's statement that its chief financial officer is unaware of the occurrence of any incidents of actual confusion during the year since applicant commenced marketing its office supplies in March 1999. While the absence of any instances of actual confusion over a significant period of time is a factor indicative of no likelihood of confusion, it is a meaningful factor only where the record demonstrates appreciable and continuous use by the applicant of its mark in the same markets as those served by registrant under its mark. See, e.g., Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). It is not a mitigating factor where, as here, the record is devoid of information concerning details of the nature and extent of the sales and marketing activities of applicant and registrant under their respective marks; the

asserted period of contemporaneous use thereof has been exceedingly short; and the goods and services involved do not appear to be very expensive, such that any instances of actual confusion would be expected to be reported by consumers and thus would have come to the attention of applicant and/or registrant. Compare In re General Motors Corp., 23 USPQ2d 1465, 1470-71 (TTAB 1992). Moreover, while the prefix "DOCU-" may indeed be suggestive of a wide variety of goods and services involving documents, including office supplies used in their creation as well as document photocopying and other reproduction services, there is nothing in the record which indicates that the mark "DOCUWORKS" similarly has been so commonly adopted and/or used in connection with numerous goods and services that it is entitled to only a narrow scope of protection.

Finally, to the extent that we may nevertheless have any doubt concerning whether the contemporaneous use of the mark "DOCUWORKS" by applicant for office supplies, including inkjet paper, laser paper and copier paper, and by registrant for photocopying and document reproduction services is likely to cause confusion, we resolve such doubt, as we must, in favor of the registrant. See, e.g., In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) and In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

Decision: The refusal under Section 2(d) is affirmed.