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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Canadian Atlas Furniture Corporation

Serial No. 75/892,492

D. Peter Hochberg of D. Peter Hochberg Co., L.P.A. for
Canadian Atlas Furniture Corporation.

Tracy L. Fletcher, Trademark Examining Attorney, Law Office
115 (Tomas Vlcek, Managing Attorney).

Before Simms, Walters and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On January 7, 2000, Canadian Atlas Furniture
Corporation (applicant) filed an application to register
the mark EDEN (in typed form) on the Principal Register for
goods identified as "Office furniture, namely chairs and
stools, restaurant furniture, namely chairs, stools and
sofas, hospital furniture, namely chairs and stools,
furniture for use in public institutions and public places

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and waiting rooms, namely chairs and stools" in International Class 20.¹

The examining attorney² has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark EDEN in typed form³ for:

Cushions, bed linens, mattress pads, mattress covers, pillowcases for medical purposes in International Class 10

Pillows, cushions, mattresses, and complete beds, namely, bunkbeds in International Class 20

Bed linens, linen coverings for featherbeds, pillowcases, blankets, slip-in blankets, comforters, down comforters, mattress covers, mattress cloth, mattress pads, and mattress ticking for use in making mattress cases in International Class 24

The examining attorney also cited a second registration owned by the same party for the mark shown below for "mattresses and pillows" in International Class 20 and "bed linen, mattress pads, mattress covers, pillow cases, and cotton fabric used as ticking for covering pillows and mattresses" in International Class 24⁴:

¹ Serial No. 75/892,492. The application sets out a date of first use and a date of first use in commerce of May 1998.

² The current examining attorney was not the original examining attorney in this case.

³ Registration No. 2,315,743, issued February 8, 2000.

⁴ Registration No. 2,124,972, issued December 30, 1997.

Eden
VARIOPROTECT

The goods in the second cited registration ('972) are, essentially, identical to goods in the first cited registration ('743), although the '743 registration includes additional goods. The mark in the '972 registration includes the term EDEN, which is the entire mark in the '743 registration, and adds additional non-disclaimed wording to the mark. Because applicant's mark is identical to the cited mark in the '743 registration, we consider the issue of likelihood of confusion with respect to the '743 registration only; the '972 registration will not be considered separately. However, we note that, if applicant's mark is registrable over the EDEN registration, it is also registrable over the less similar EDEN VARIOPROTECT mark.

When the refusal was made final, applicant filed this appeal.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65

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USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that “[t]he 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.” Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor we consider is the similarities and dissimilarities of the marks in the application and registration. Here, both applicant’s mark and registrant’s mark are for the same word EDEN in typed form. There is no indication in the record that EDEN is weak or even a suggestive term when applied to the goods in this case. Therefore, this factor “weighs heavily against the applicant.” In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). See also Majestic Distilling, 65 USPQ2d at 1203.

Next, we consider the relationship between the goods of the applicant and registrant. Here, we look at whether prospective customers would believe that there is some relationship between applicant’s office, restaurant,

hospital and public institution furniture and registrant's goods that include mattresses, mattress pads, bed linens, bunkbeds, and similar items.

In this case, we agree with the examining attorney that the goods are related. First, while applicant has limited its identification of goods to office, restaurant, and hospital furniture and furniture for use in public institutions and public places, registrant's goods are not limited to goods for any particular type of institution. We must consider the goods as they are identified in the application and registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). In this case because registrant's goods are not limited to any particular institution they must be considered to be sold in all normal channels of trade. Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989) ("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages"). We cannot agree with applicant's attempt to limit the

registrant's goods to "household accessories." Brief at 8. Most of registrant's goods contain no restrictions so we agree with the examining attorney that these goods may be purchased by hotels, motels, hospitals, retirement homes, and dormitories. Brief at 8. Purchasers of furniture for public institutions and public places and hospitals would likely also purchase pillows, mattresses, bed linens, and similar products. Interestingly, while some of registrant's goods contain a restriction, this restriction emphasizes the relationship of registrant's and applicant's goods. Registrant's goods in International Class 10 include such items as "pillowcases for medical purposes." These goods could clearly be purchased by hospitals and even by the same purchasers who procure the hospital's furniture such as chairs and stools. Because hospitals purchase thousands of products including very specialized products recommended by doctors, we recognize that not everything purchased by hospitals is necessarily related. However, in this case, chairs, stools, mattresses, and pillowcases fall within the same general category of products that are likely to be recommended and purchased by the same class of purchasers.

Applicant also argues that its products are purchased by "office managers, office administrators, interior

designers and architects." Brief at 8. Even if, for the sake of argument, we accept this limitation and the limitation that registrant's goods are for household use, the purchasers would still overlap to the extent that these purchasers would also purchase mattresses, bunkbeds, bed linens, pillows, and similar items for their homes. When these purchasers encounter the same mark on registrant's and applicant's goods, even in these circumstances, they are likely to believe that there is some association or relationship between the sources of the respective goods. See In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) (Court held that distributorship services in the field of automotive parts were related to oil and lubrication services because "virtually all of registrant's customers are prospective consumers" of applicant's services). Similarly here, even if applicant's customers were limited as applicant asserts, they would all be potential customers of registrant's goods. We add that, when identical marks are used on the goods identified in the application and registration, even sophisticated purchasers are likely to be confused. In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999) ("We recognize applicant's attorney's point that its software is expensive and that purchasers of it are likely to be sophisticated.

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Suffice it to say that no evidence in support of these assertions was submitted. In any event, even careful purchasers are not immune from source confusion").

Further support for the examining attorney's position can be found in the third-party, use-based registrations⁵ that the examining attorney has made of record. These registrations show that the same party has registered a mark for goods including furniture and also for mattresses, pillows, bed linens and/or similar products. See, e.g., Registration No. 2,434,674 ("Furniture, namely, stools, ... mattresses ... chairs"); No. 2,373,631 ("mattresses, upholstered and non-upholstered furniture"); No. 2,371,665 ("Furniture, namely, ... chairs ... and mattresses"); No. 2,337,779 (Furniture and bed linen, pillow cases and mattress covers); No. 2,277,993 ("chairs, sofas, beds, and mattresses"); and No. 2,307,092 ("home office furniture ... mattresses"). This evidence suggests that the same source may provide both applicant's and registrant's goods. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may

⁵ We have not considered the registrations that are not based on use in commerce.

have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

"In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001). Here, the record supports the examining attorney's position that the applicant's furniture and registrant's mattresses, bunk beds, and other products are related.

Finally, when we consider that the marks are identical, the goods of the parties are related, and they are likely to be encountered by the same class of purchasers, we hold that there is a likelihood of confusion.

Decision: The examining attorney's refusal to register applicant's mark for the identified goods on the

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ground that it is likely to cause confusion with the identical mark EDEN used in connection with the identified goods in Registration No. 2,315,743 under Section 2(d) of the Trademark Act is affirmed.