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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sitonit Office Seating, Inc.

Serial No. 76433340

Richard P. Sybert of Gordon & Rees, LLP for Sitonit Office Seating, Inc.

Leslie LaMothe, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Cissel, Seeherman and Walters, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Sitonit Office Seating, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register LEADER as a trademark for "office furniture, namely, an office chair."¹ Registration has been refused

¹ Application Serial No. 76433340, filed July 23, 2002, and asserting first use and first use in commerce as of May 2002.

pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark LEADER'S CASUAL FURNITURE (with the words CASUAL FURNITURE disclaimed), previously registered for "retail store services featuring furniture and home accessories,"² that, as used on applicant's identified services, it is likely to cause confusion or mistake or to deceive.

The appeal has been fully briefed.³ Applicant did not request an oral hearing.

There are some procedural matters that we must discuss first. At the conclusion of its reply brief, applicant has requested remand "in the alternative" in order to "introduce additional evidence in the form of survey evidence to show that consumers recognize LEADER'S as primarily a surname." Applicant explains that this evidence was not filed prior to appeal because "there was (and frankly is) no reason to put Applicant to the considerable expense of a survey when Applicant contends the subject proposition is self-evident and a matter of common sense and judgment." Applicant also explains that

² Registration No. 2,544,574, issued March 5, 2002, and claiming first use and use in commerce on January 1, 1986.

³ With its appeal brief applicant has submitted as exhibits copies of the various Office actions and responses. Applicant is advised that such duplication is unnecessary. Applicant is also advised that only a single copy of a brief or reply brief need be submitted in an ex parte appeal.

such a survey has not been conducted, so the request for remand cannot be accompanied by the evidence sought to be introduced.

Applicant's alternative request is denied. Applicant was aware that it had the option to conduct and submit evidence of a survey throughout the prosecution of the application. In its response filed on April 25, 2003 applicant even stated that it could, if necessary, commission a consumer survey. However, applicant chose not to do so, and it cannot, at this late stage of the appeal, have the application undergo further examination (of evidence which is not even in existence!). (The value of applicant's arguments on the surname point is discussed infra.)

It is also noted that, in applicant's appeal brief, it comments, with respect to the factor of the sophistication of purchasers, that it "is willing to present substantial sales and marketing evidence to support this point if the Board so directs." Brief, p. 11. Applicant appears to have confused the appeal stage of this proceeding with the examination phase. The Board's role is not to review the evidence of record and then tell applicant what additional evidence it should submit in support of its position. Trademark Rule 2.142(d) makes clear that the record in the

application should be complete prior to the filing of an appeal.

The Examining Attorney has objected to Exhibit I to applicant's brief, which appears to be an excerpt from applicant's website, and which was not previously made of record. The objection is well taken, and this exhibit has not been considered. See Trademark Rule 2.142(d).

This brings us to the issue of likelihood of confusion. Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to the goods and services, applicant's identified "office chair" is one of the items that can be sold through "retail store services featuring furniture" identified in the cited registration. As such, the goods and services must be considered complementary. A company that makes furniture may also have a showroom or retail

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store in which that furniture is sold, such that, if the same or similar marks were used in connection with both, consumers would be likely to assume a connection or sponsorship.

The Examining Attorney has listed in her brief numerous cases in which a likelihood of confusion has been found when the same or similar marks are used for goods, on the one hand, and for services involving those goods, on the other. Moreover, the Examining Attorney has submitted several third-party registrations which show that entities have registered single marks for both chairs and retail furniture store services. See, e.g., Registration No. 2,136,125 for, inter alia, furniture, namely chairs and retail furniture store services; Registration No. 1,849,963 for, inter alia, non-upholstered chairs and retail furniture store services; Registration No. 2,315,476 for, inter alia, furniture, namely chairs and retail furniture and fabric store services. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Applicant has argued that the furniture sold by the registrant is "'casual' furniture for relaxed home use, namely rattan and wicker." Brief, p. 9. Applicant bases this contention on information obtained from the registrant's website. Applicant also asserts that its office chairs are sold to businesses and are intended to facilitate working, not relaxing, such that the goods and services do not compete in any meaningful way.

Applicant's argument is not persuasive. It is well established that the question of likelihood of confusion must be determined on the basis of the identification of goods set forth in the subject application and cited registration. *In re William Hodges & Co., Inc.*, 190 USPQ 47 (TTAB 1976). See also, *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (determination of likelihood of confusion based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be).

Thus, applicant's argument that "there is no reason that the Board cannot look at the actual underlying facts in precisely the same way that a court would do in

evaluating likelihood of confusion," brief, p. 8, is answered by the case law that specifically states that the Board may not do so, but must look only to the goods and services as they are identified in the respective application and registration, without restrictions or limitations not reflected therein. The reason underlying this principle is that Section 7(b) of the Trademark Act provides, inter alia, that a certificate of registration is evidence of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate. Thus, because registrant has the exclusive right to use its mark in connection with "retail store services featuring furniture and home accessories," we must determine whether applicant's use of its mark on office chairs is likely to cause confusion with the registrant's use of LEADER'S CASUAL FURNITURE for retail store services featuring all types of furniture, including office furniture, and not just in connection with the rattan and wicker casual furniture asserted by applicant. The fact that the registrant's mark includes the words CASUAL FURNITURE does not limit the registration to retail store services featuring only casual furniture.

Similarly, because the registration is geographically unrestricted, and because applicant also seeks a geographically unrestricted registration, applicant's argument that "no one is going to confuse an office chair manufacturer in California with a chain of retail furniture stores selling wicker and rattan in Florida," brief, p. 8, has no persuasive value. Even applicant's own comments belie the validity of this argument; applicant acknowledges that it sells its goods "nationally and even internationally," brief, p. 8. As a result, even if the registrant were, in fact, to use its mark in connection with services rendered only in Florida, applicant's goods must be deemed to be sold in the same geographic area.

Applicant also argues that the target markets for applicant and registrant are distinct. Applicant asserts that its office chairs are marketed to the professional office market, with the buyers for such goods being professional agents and employees buying on behalf of a business, while registrant's furniture is marketed to the non-professional home user through its own retail stores, with the buyers being private individuals furnishing their own homes.

The problem with this argument is that office chairs may be purchased by individuals as well as businesses. It

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is common knowledge that many people have offices in their homes, and they may buy office chairs to furnish their home offices. Thus, the same class of customers--home or apartment owners or renters--may both purchase office chairs and shop in retail furniture stores, and may encounter both office chairs sold under applicant's mark and retail furniture store services rendered under the registrant's mark.

This brings us to a consideration of the marks. Applicant has argued at great length that the word LEADER'S in the cited registration is a surname and is therefore descriptive. It is not entirely clear to us what applicant's purpose is in making this argument. Applicant has cited a number of decisions in which marks were found to be primarily merely surnames and therefore not registrable. However, the cited mark is in fact registered, and applicant may not attack the validity of a registration in the absence of a cancellation proceeding.

To the extent that applicant is asserting that the protection to be accorded the cited registration should be limited because LEADER'S is, according to applicant, a surname, we point out that the mark LEADER'S CASUAL FURNITURE was considered by the Examining Attorney who examined that application to be inherently distinctive, as

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the registration issued without recourse to the provisions of Section 2(f) of the Act. Moreover, we note that the cited registration claims use in commerce since 1986, so that, even if the application therefor had encountered a surname refusal, the mark would have been registrable under Section 2(f).

Applicant argues that the words CASUAL FURNITURE are the key to the registrability of the cited mark. Because of the incorrect premise on which it is based, namely, that the word LEADER'S in the registered mark is a descriptive term, we do not consider the words CASUAL FURNITURE in the cited mark to be the dominant element, nor do we view these words as distinguishing the two marks. The words CASUAL FURNITURE, which have been disclaimed, would clearly be perceived by the public as having virtually no source-indicating value, as they indicate the nature of some of the goods sold which are the subject of the registrant's retail store services featuring furniture and home accessories. It is well established that in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been give to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks

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in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). For the reasons we have given, we have no doubt that the term LEADER'S in the cited mark is the dominant element, and must be given greater weight in the likelihood of confusion analysis.

Thus, the additional words CASUAL FURNITURE in the cited mark, although adding elements in terms of appearance and pronunciation, do not serve to distinguish the marks, since applicant's mark LEADER is virtually identical to the source-identifying element of the cited mark, LEADER'S. In this connection, we acknowledge that the cited mark uses the possessive form of LEADER'S, having an "'S." However, we do not think that consumers are likely to note or remember that one mark uses the possessive form and the other does not. Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980).

To the extent that applicant is arguing that the marks are distinguishable in terms of connotation because of the surname significance of LEADER'S in the cited mark, we are not persuaded by this argument. Even if we assume that consumers perceive the mark LEADER'S CASUAL FURNITURE used

in connection with retail furniture store services as suggesting that the store or the furniture sold therein is connected with a person or family named LEADER, consumers familiar with the mark used in connection with the store, and seeing the name LEADER on an office chair, are likely to believe that this is a furniture item emanating from the same LEADER individual or family. Conversely, consumers who are familiar with LEADER office chairs may, upon encountering a retail furniture store services rendered under the mark LEADER'S CASUAL FURNITURE, assume an association or sponsorship between the source of the LEADER office chair and the source of the services.

Applicant also argues that its goods are purchased with a high degree of care, and that its "customers are sophisticated buyers whose livelihoods depend on these purchases." Brief, p. 11. As noted previously, the problem with this argument is that office chairs may be purchased by non-professionals, members of the public that want office chairs for home offices. In addition, even in a business setting, not all office chairs are purchased by large companies which have a professional buyer whose sole job is to purchase office furniture. A small business may also, on occasion, have the need to purchase an office chair, and the purchasing decision may be made by someone

without great sophistication about such purchases. Such a buyer may well assume an association as to source between an office chair sold under the mark LEADER and retail furniture store services rendered under the mark LEADER'S CASUAL FURNITURE. Even assuming that careful purchasers would notice the differences in the marks, they are likely to ascribe the differences to the different nature of the goods and services, rather than to a difference in the sources of the goods and services (e.g., a single source uses LEADER'S CASUAL FURNITURE for a retail store specializing in casual furniture, and LEADER, without the additional words, for an item of office furniture). For similar reasons, the fact that furniture may be expensive does not avoid the likelihood of confusion.⁴

Decision: The refusal of registration is affirmed.

⁴ In this connection, although we note applicant's statement that a single item of furniture "can cost several hundreds of dollars or more," brief, p. 11, we also note that applicant has simply commented on the cost of furniture in general, such that we cannot take this statement as an indication of the price of all office chairs.