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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Royalty Carpet Mills, Inc.

Serial No. 78384757

Richard J. Ward, Jr. of Christie, Parker & Hale, LLP for Royalty Carpet Mills, Inc.

Leigh A. Lowry, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Hohein, Zervas and Cataldo, Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Royalty Carpet Mills, Inc. to register the mark shown below on the Principal Register for "residential tufted carpet and rugs."[1]

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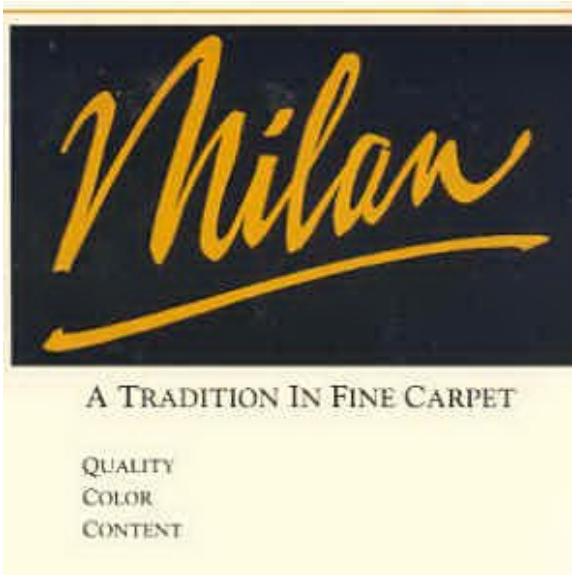
[1] Application Serial No. 78384757 was filed March 15, 2004, asserting March 1, 1999 as the date of first use of the mark anywhere and in commerce.



The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as used on applicant's goods, so resembles the following marks, previously registered on the Principal Register in standard character form, as to be likely to cause confusion: THE MILAN STYLE for "ceramic wall and floor tiles;"[2] and A TRADITION IN CARPET for "rug and carpet delivery services."[3] In addition, the trademark examining attorney required applicant to disclaim the wording "QUALITY COLOR CONTENT" apart from the mark as

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[2] Registration No. 1519831 was issued to Cedit S.P.A. on January 10, 1989. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

[3] Registration No. 1554121 was issued to Shaw Industries, Inc. on August 29, 1989. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

shown and submit a color claim as well as a description of where the claimed colors appear in its mark.

When the refusal and requirements were made final, applicant appealed. Applicant and the examining attorney have filed briefs. An oral hearing was not requested.

Applicant contends that its applied-for mark is MILAN and design inside a black border; that it mistakenly submitted a copy of its specimen in place of the mark in its original application; and that the words "A TRADITION IN FINE CARPET" and "QUALITY COLOR CONTENT" are not part of its mark, but rather are intended to provide information as they appear on its specimen. Applicant argues that, as a result, the examining attorney's requirement for a disclaimer of the wording "QUALITY COLOR CONTENT" is moot. With regard, in particular, to the refusal to register under Section 2(d) as to Registration No. 1519831, applicant requests that the Board take judicial notice "of the fact that there are approximately 150 applications and registrations involving the word MILAN as part of the mark" (brief p. 3); that the term MILAN thus should be afforded a narrow scope of protection; that its mark differs from the cited THE MILAN STYLE mark in sight, sound and meaning; and that the stylization of its mark further distinguishes it from the mark in the cited registration. Applicant

presents no argument, however, with regard to the refusal to register under Section 2(d) as to Registration No. 1554121 for the mark A TRADITION IN CARPET.[4]

Applicant submits with its brief a proposed amended drawing, as well as a statement that "color is not claimed as a feature of the mark" (brief p. 4).

The examining attorney maintains that the drawing page of the application at issue displays the mark as MILAN A TRADITION IN FINE CARPET QUALITY COLOR CONTENT and design; that while the body of the application indicates that the mark is MILAN and design, the drawing page controls for purposes of determining which is the applied-for mark in an application; that, in addition, applicant's specimen agrees with the mark as it appears on the application's drawing page; and that applicant's proposed amendment of its mark to MILAN and design is an unacceptable material alteration of the mark as it appears in the original drawing. With regard to the refusals to register under Section 2(d), the examining attorney argues that applicant's mark is similar to the marks in the cited registrations; that applicant's goods are related to the goods and services in the cited

[4] We presume that applicant's position is that in the event the Board accepts a proposed amendment to its mark, the refusal to register as to the mark A TRADITION IN CARPET is moot.

registrations; and that, as a result, confusion is likely among consumers as to the source of those goods and services. The examining attorney further argues that the wording "QUALITY COLOR CONTENT" is highly descriptive of the goods and must be disclaimed apart from the mark as shown. Finally, the examining attorney argues that the mark appears in color; and that applicant must submit a claim of color as well as a description of where the claimed color appears in its mark.

The examining attorney, in support of her position, submits with her brief dictionary definitions of the terms "QUALITY," "COLOR," and "CONTENT" and requests that the Board take judicial notice thereof.[5]

Judicial Notice

As a preliminary matter we will address the above-noted requests made by applicant and the examining attorney that the Board take judicial notice of certain matters.

Applicant requests that we take judicial notice of third-party applications and registrations containing the term "MILAN." However, the Board does not take judicial notice of third party registrations. *See In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998); and *In re*

[5] The proffered dictionary definitions are taken from the Internet dictionary Bartleby.com (www.bartleby.com).

Wada, 48 USPQ2d 1689, 1689 n.2 (TTAB 1998), *aff'd* 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999). Further, the Board does not take judicial notice of application files that are not the subject of the proceeding and where no copies thereof are filed. *See Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986).

Accordingly, applicant's request for judicial notice is denied.

The examining attorney requests that we take judicial notice of entries from the Internet dictionary Bartleby.com. It is settled that the Board will take judicial notice of Internet dictionary definitions where the resources from which the definitions are obtained are available in printed form. *See In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002); and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). That is the case here. Further, applicant has not objected to the examining attorney's proffered definitions.

Accordingly, the examining attorney's request for judicial notice is granted.

The Mark At Issue

Turning now to the matters on appeal, we note initially that a discrepancy exists between the marks as they appear on the drawing page and in the body of the application. Specifically, the drawing page displays the mark as shown above, while the body of the application indicates that the involved mark is "Milan with line design." As noted above, applicant argues that it "inadvertently" submitted a copy of its specimen in place of its drawing, and that it "intended" to apply for the mark "Milan with line design." However, and applicant's intentions notwithstanding, the mark appearing on applicant's drawing page displays the mark as MILAN A TRADITION IN FINE CARPET QUALITY COLOR CONTENT and design. It is settled that when an applicant submits a separate drawing page (or a digitized image of a separate drawing page in a TEAS application) displaying a mark, and a different mark appears in the written application, the mark on drawing page controls for purposes of determining which is the applied-for mark. In such cases, the mark appearing in the written application is disregarded. *See In re L.G. Lavorazioni Grafite S.r.l.*, 61 USPQ2d 1063 (Comm'r. 2001). *See also Humanoids Group v. Rogan*, 375 F.3d 301, 71 USPQ2d 1745 (4th Cir. 2004); and TMEP §807.01 and the authorities

cited therein. As such, applicant's mark is MILAN A TRADITION IN FINE CARPET QUALITY COLOR CONTENT and design as reproduced earlier in this decision. Moreover, as to applicant's proposed amendment of its drawing to MILAN and design, which it submitted with its brief on the case, the examining attorney is correct that such amendment is not permissible inasmuch as it is a material alteration of its applied-for mark as shown on the originally submitted drawing. *See* Trademark Rule 2.72(a) and *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983).

Likelihood of Confusion

Our determination of the issue of likelihood of confusion 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 Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d

1531 (Fed. Cir. 1997). We will consider the refusal with regard to each of the cited registrations separately.

Registration No. 1519831 - THE MILAN STYLE

We first consider the similarity of the marks. In this case, applicant's mark, MILAN A TRADITION IN FINE CARPET QUALITY COLOR CONTENT and design, is highly similar to the cited mark, THE MILAN STYLE in that both contain as a prominent element the term "MILAN." In applicant's mark, the term "MILAN" is presented inside a large black border in considerably larger size than the remaining wording and relatively minor design element. As such, the term "MILAN" is the most visually prominent element of applicant's mark, and is most likely to be impressed upon the memory of a consumer. In registrant's mark, the article "THE" has essentially no source identifying function and does nothing to differentiate the mark from that of applicant. In addition, the term "STYLE" appears to modify "MILAN." Thus, the term "MILAN" may be viewed as the dominant feature of the mark in the cited registration. It is a well-established principle 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 given to a

particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In view of the prominent display of the term MILAN in applicant's mark, it is accorded greater weight in the likelihood of confusion analysis. Consumers who are familiar with the mark, THE MILAN STYLE, used on registrant's ceramic wall and floor tiles, who then see the mark MILAN A TRADITION IN FINE CARPET QUALITY COLOR CONTENT and design used on residential tufted carpet and rugs, are likely to assume that the owner of the mark, THE MILAN STYLE, has adopted a similar mark to identify its line of carpets and rugs. In other words, consumers are likely to view both marks as variations of each other, but both as indicating a single source. We further note that 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. *See Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). Thus, despite the fact that the marks include additional wording and applicant's mark includes a minor design element, the marks overall are highly similar in appearance, pronunciation, connotation and commercial impression.

Accordingly, this d*u Pont* factor favors a finding of likelihood of confusion.

Turning now to our consideration of the recited goods, it is clear that applicant's goods differ from those of registrant. However, it is not necessary that the goods at issue be identical or even directly competitive to support a finding of likelihood of confusion. It is sufficient instead that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. *See In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, the examining attorney has made of record a number of use-based third-party registrations which show that various entities have adopted a single mark for goods that are identified in both applicant's application and the cited registration. That is to say, entities have adopted the same marks to identify carpets and rugs on the one hand, and other floor coverings, including ceramic tile, on the other. *See, for example*:

> Registration No. 2197097 for "flooring tiles made of linoleum, ceramic, vinyl and hardwood" in Class 19, and "carpets and rugs" in Class 27;
>
> Registration No. 2750703 for "ceramic tile" in Class 19, and "carpets, rugs" in Class 27;
>
> Registration No. 2512777 for "flooring, namely, wood and ceramic tiles" in Class 19, and "carpets" in Class 27;
>
> Registration No. 2692764 for "flooring, namely, laminate flooring, hardwood flooring, and ceramic tile flooring" in Class 19, and "carpeting and rugs" in Class 27;
>
> Registration No. 2898672 for "building materials, namely, ceramic tile coverings and wood flooring" in Class 19, and "floor coverings, namely, solid vinyl floor coverings, composition vinyl floor coverings, linoleum floor coverings and carpets," in Class 27;
>
> Registration No. 2721429 for "ceramic tile, wooden flooring" in Class 19, and "carpet, linoleum for use on floors" in Class 27; and
>
> Registration No. 2930984 for, *inter alia*, "ceramic tile" in Class 19, and "floor coverings, namely, carpets, carpet tiles, rugs, hard surface coverings for floors, namely linoleum, and hard surface laminate coverings for floors.

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, 1786 (TTAB 1993).

In addition, the Examining Attorney submitted articles and advertisements from Internet web pages suggesting that the same entities provide rugs and carpets as well as ceramic tiles. Excerpts from these articles and web pages include the following:

> We've been in the business for 34 years, specializing in residential and commercial floor covering. We carry Ceramic and Porcelain Tile from around the world as well as Travertine Marble. Our Carpets are of the quality for any budget….
> (www.eflooringworld.com/about%20us.);
>
> Carpet Connection
> We Specialize In:
> Wood
> Laminates
> Ceramic
> Carpet
> Vinyl
> Area Rugs
> (www.carpetconnectionfl.com)
>
> 5. Does Carpeteria sell only Carpets?
> No, Carpeteria carries all kinds of floor coverings including carpet, vinyl, hardwood, laminate, ceramic tile and area rugs.
> (www.carpeteria.com); and
>
> Find flooring that fits your lifestyle and warranty needs with our exclusive online Select-A-Floor system.
> Carpet
> Vinyl
> Laminate
> Ceramic
> Hardwood
> Area rugs
> (http://carpetone.com)

The foregoing evidence demonstrates the related nature of the goods at issue, and this *du Pont* factor also favors a finding of likelihood of confusion.

Registration No. 1554121 – A TRADITION IN CARPET

Here, too, in comparing the marks we must consider the appearance, sound, connotation and commercial impression of both marks. Again, the test under the first *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Here, applicant's involved mark consists of the term "MILAN" inside a black border, the slogan "A TRADITION IN FINE CARPET," and the descriptive terms "QUALITY COLOR CONTENT" as well as a minor line design. The wording "A TRADITION IN FINE CARPET" in applicant's mark is nearly identical to the cited mark A TRADITION IN CARPET. Thus, applicant's mark is highly similar to that of registrant in

that it incorporates in its entirety the cited mark as a distinctive portion thereof. The stylization of the lettering in applicant's mark is not dispositive, given the fact that the cited registered mark is registered in standard character form and thus could be displayed in lettering similar or even identical to applicant's. *See, e.g., In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). In coming to our determination that the mark in the involved application is similar to that in the cited registration, we do not ignore the other elements of applicant's mark, including the prominently displayed term MILAN. Nonetheless, applicant in this case cannot adopt registrant's mark as a portion of its own and avoid a finding that the marks are similar by the addition of other material thereto. Purchasers familiar with registrant's mark A TRADITION IN CARPET, upon encountering related goods marketed under applicant's mark which features the wording "A TRADITION IN FINE CARPET," are likely to assume that there is a common source, affiliation or other connection between the respective goods and services. The presence in applicant's mark of other wording and of the design element would not relieve them of that misconception. That is, purchasers are more likely to assume, based on the presence in both marks of the wording "A TRADITION IN CARPET," that

a source connection exists, than they are likely to assume, based on the presence in applicant's mark of the additional wording and the design element, that no such source connection exists. Accordingly, this d*u Pont* factor favors a finding of likelihood of confusion.

Once again, to find goods or services related for the purposes of Trademark Act Section 2(d), the goods or services need not be identical. The goods or services need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the services originate from the same source. *See On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (fed. Cir. 2000). In this case the examining attorney has argued that goods like applicant's "residential tufted carpet and rugs" may be delivered by registrant. While we doubt that registrant would in fact deliver applicant's goods if such would indeed be likely to cause confusion, it nonetheless is the case that sellers of carpet and rugs often provide delivery services for such goods and thus the services are complementary, i.e., related. In addition, the Examining Attorney submitted articles and advertisements from Internet web pages suggesting that the same entities provide both rugs and carpets and delivery services

therefor. Excerpts from these articles and web pages include the following:

> …J & W Carpet, Inc. is the one-stop carpet company for all of your residential and commercial needs. We offer a large selection of quality products at competitive prices. Our experienced company provides designer brands and expert installations at warehouse prices. We have thousands of rolls, and remnants on display. Delivery is available….
> (www.jandwcarpet.com);
>
> …In addition to our expertise with carpets, we provide other quality services, such as widow treatments, custom made widow drapery, area rugs, flooring, and custom binding…Through superior workmanship and prompt delivery, you will be satisfied with our services….
> (www.carpetking1.com);
>
> Tuftex Carpet
> Delivery Time
> After you place an order, you can usually expect to receive it within three to ten business days, assuming the material you ordered is in stock….
> (www.americancarpetfloors.com)
>
> …Your choices will represent the complete realm of products from the world's largest flooring maker whether you're shopping for carpet, ceramic, laminate, hardwood, or rugs…Your Shaw Flooring Center dealer will ensure that your entire decision instills confidence, from delivering the flooring on time to making sure it's properly installed.
> (www.rayscarpets.com);
>
> 5. Does Carpetieria sell only Carpets?
> No, Carpeteria carries all kinds of floor coverings including carpet, vinyl, hardwood, laminate, ceramic tile and area rugs.
> 11. Does Carpeteria provide a delivery service?
> If you have your own installer, or are the DIY type, we offer delivery of your website purchases….

(www.carpeteria.com); and

> Some of the styles of carpet we have to choose from are shag carpet, frieze carpet, textured carpet, Berber carpet, plush carpet, seagrass carpet, pattern carpet, commercial carpet…Use the site outline below to find the flooring you want and begin shopping. Once you've made a selection and purchased, the freight carrier will deliver directly to your home….
> (www.carpetcapitol.com).

The foregoing evidence demonstrates the related nature of the goods and services at issue, and this *du Pont* factor also favors a finding of likelihood of confusion.

Neither applicant nor the Examining Attorney has discussed any of the remaining *du Pont* factors. We will say, briefly, that none seems to be applicable, as we have no evidence with respect to them.

In sum, after considering all evidence of record bearing on the pertinent *du Pont* factors, we conclude that there is a likelihood of confusion in this case with regard to the subject matter of both cited registrations. We conclude so principally due to the similarity between applicant's mark and the marks in both cited registrations and the close relationship between applicant's goods and the goods and services identified in both cited registrations.

Finally, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion,

that doubt is required to be resolved in favor of the prior registrant. *See In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

Disclaimer and Color Statements

We now consider the examining attorney's requirement that applicant disclaim the wording "QUALITY COLOR CONTENT" apart from the mark as shown. An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. *See* Trademark Act Section 6(a), 15 U.S.C. §1056(a). Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1), and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. *See, for example, In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of a significant ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed.

Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

The burden is initially on the United States Patent and Trademark Office to make a prima facie showing that the mark or word in question is descriptive from the vantage point of purchasers of applicant's goods and, where doubt exists as to whether a term is descriptive, such doubt should be resolved in favor of the applicant. *See In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987). In support of the disclaimer requirement, the examining attorney has made of record dictionary definitions that indicate the terms "QUALITY COLOR CONTENT" are merely descriptive of a feature, quality, or characteristic of applicant's goods. Furthermore, we note that applicant has presented no argument in opposition to the requirement, aside from its assertion that such requirement is moot because the wording in question is not part of the applied-for mark. Applicant's argument to that end was rejected above.

Accordingly, we find that applicant must disclaim the merely descriptive wording "QUALITY COLOR CONTENT" apart from the mark as shown.

Similarly, we observe that, notwithstanding applicant's assertions to the contrary, the applied-for

mark includes the colors black, orange and tan as a feature thereof. When a mark includes color, the drawing must depict the mark in color, and the applicant must name the colors, describe where the colors appear on the mark, and submit a claim that the colors are a feature of the mark. *See* Trademark Rule 2.52(b)(1). *See also* TMEP §807.07(a) and the authorities cited therein. The examining attorney made final the requirement that applicant provide the necessary color statements in accordance with Trademark Rule 2.52(b)(1). However, applicant neither complied with the requirement nor set forth arguments in opposition thereto.

Accordingly, we find that applicant must submit a claim that colors are a feature of the mark, name the colors appearing in its mark, and describe where the colors appear in its mark.

Decision: The refusal to register applicant's mark under Section 2(d) of the Act is affirmed with regard to both Reg. Nos. 1519831 and 1554121. The disclaimer requirement under Section 6(a) of the Act and color statement requirements pursuant to Trademark Rule 2.52(b)(1) are also affirmed.