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Mailed: 4/20/07

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nevers Industries, Inc.

Serial No. 78412722

Kyle T. Peterson and Irene Eckert of Patterson, Thuente,
Skaar & Christensen for Nevers Industries, Inc.

Steven W. Jackson, Trademark Examining Attorney, Law Office
107 (J. Leslie Bishop, Managing Attorney).

Before Quinn, Hairston and Walsh, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Nevers Industries, Inc. filed an application to
register the mark SIMPLE for "office furniture" in
International Class 20.¹

The trademark examining attorney refused registration
under Section 2(d) of the Trademark Act on the ground that
applicant's mark, when applied to applicant's goods, so

¹ Application Serial No. 78412722, filed May 4, 2004, alleging a
bona fide intention to use the mark in commerce.

resembles the previously registered mark SIMPLE OFFICE SOLUTIONS ("OFFICE SOLUTIONS" disclaimed) for

on-line ordering services featuring furniture in office environments; retail services in the field of office furniture; telephone and on-line information services featuring information on furniture sales, installation, repair and warranty (in International Class 35);

office furniture installation and assembly (in International Class 37); and

providing planning services and consultation regarding space, floor treatment, light arrangement, power distribution and wire management, and disability and safety standards with respect to office environments (in International Class 42)²

as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

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,

² Registration No. 2742501, issued July 29, 2003.

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 first turn to compare the marks SIMPLE and SIMPLE OFFICE SOLUTIONS. In determining the similarity or dissimilarity of the marks, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Nevertheless, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ["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 consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable."] For example, "that a particular feature is descriptive or

generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark..." Id. at 751.

When considering registrant's mark, the descriptive words "OFFICE SOLUTIONS" have been disclaimed. Although we have not ignored "OFFICE SOLUTIONS," these words are clearly subordinate to the remainder of registrant's mark, namely the word "SIMPLE." This dominant portion of registrant's mark is identical to the entirety of applicant's mark. Applicant has merely appropriated the dominant portion of registrant's mark, and deleted the descriptive and obviously subordinate portion. See *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988); and *In re Computer Systems Center Inc.*, 5 USPQ2d 1378 (TTAB 1987). Contrary to applicant's arguments, "SIMPLE" in registrant's mark would be the word used to call for registrant's services, and, as the first word and most distinctive portion of the mark, would be the portion of the mark most likely to be remembered by prospective purchasers. *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895 (TTAB 1988).

In terms of sound and appearance, the marks look and sound similar; registrant's mark begins with "SIMPLE," and

this is the entirety of applicant's mark. The marks also convey similar meanings, both suggesting simplicity in office furniture and services involving such furniture. In view of the similarities between the marks, we find that they engender similar overall commercial impressions.

The similarity between the marks SIMPLE and SIMPLE OFFICE SOLUTIONS is a factor that weighs in favor of a finding of likelihood of confusion.

Although applicant states that the term "SIMPLE" is "both widely used and commonly registered as a trademark for various goods or services," no evidence in support of this statement was submitted. Thus, notwithstanding the suggestive meaning of the word "SIMPLE" as applied to office furniture, the record is devoid of any evidence of third-party uses or registrations of the same or similar marks in the furniture field. This sixth du Pont factor weighs in favor of finding a likelihood of confusion.

We next turn to a consideration of the goods and services. It is not necessary that the respective goods and services be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods and services are related in some manner, and/or that the conditions and activities surrounding the marketing of the

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goods and services 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 originated from the same producer. In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991).

It is well recognized that confusion is likely to occur from the use of the same or similar mark for goods, on the one hand, and for services involving those goods, on the other. In the present case, we find that applicant's office furniture is sufficiently related to registrant's services involving office furniture that, when offered under similar marks, confusion is likely to occur in the marketplace. See In re Hyper Shoppes (Ohio) Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) [BIGG'S (stylized) for retail grocery and general merchandise store services held likely to be confused with BIGGS and design for furniture]; In re United Service Distributors, Inc., 229 USPQ 237 (TTAB 1986) [design for distributorship services in the field of health and beauty aids held likely to be confused with design for skin cream]; and Steelcase Inc. v. Steelcare Inc., 219 USPQ 433 (TTAB 1983) [STEELCARE INC. for refinishing of furniture, office furniture, and machinery

held likely to be confused with STEELCASE for office furniture and accessories].

In support of his contention that the goods and services are related, the examining attorney submitted several third-party use-based registrations with each covering both furniture and services involving furniture. Third-party registrations which individually cover a number of different items (and/or services) and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type that may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ 1783 (TTAB 1993). Each of the registrations lists furniture and a variety of services involving furniture (including the types rendered by registrant), suggesting that these goods and services may emanate from a single source under the same mark.

Applicant's goods and registrant's services would be offered to the same classes of purchasers. Applicant contends, however, that these purchasers are sophisticated and that, due to the high price of office furniture and the cost of office remodeling and relocation, they would exercise a high degree of care in making their purchases.

As shown by the excerpts retrieved from applicant's website, applicant's office furniture can be quite

expensive. We also note, however, that neither of the involved identifications includes any limit on the classes of purchasers or the conditions of sale. Even assuming arguendo that purchases of applicant's goods and registrant's services would involve a deliberate decision, this does not mean that the purchasers are immune from confusion as to the origin of the respective goods and services, especially when, as we view the present case, the substantial similarity of the marks and the similarity between the goods and services clearly outweigh any sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) [similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods]. See also *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ["Human memories even of discriminating purchasers...are not infallible."].

We conclude that purchasers familiar with registrant's services in the field of office furniture rendered under the mark SIMPLE OFFICE SOLUTIONS would be likely to

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believe, upon encountering applicant's mark SIMPLE for office furniture, that the goods and services originate from or are associated with or sponsored by the same source.

Lastly, 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. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.