

Mailed:

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB**

November 21, 2006
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Liberty Hardware Manufacturing Corp.

Serial No. 78495253

Edgar A. Zarins, Esq. of Masco Corp. PC for Liberty Hardware Manufacturing Corp.

David S. Miller, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Quinn, Hohein and Walters, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Liberty Hardware Manufacturing Corp., by merger with Bath Unlimited, Inc., is the owner of an application to register on the Principal Register in standard character form the mark "MESA" for "bathroom accessories, namely towel bars, towel rings, tissue holders and tumbler-toothbrush holders" in International Class 21.¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

¹ Ser. No. 78495253, filed on October 6, 2004, which is based on an allegation of a bona fide intention to use such mark in commerce.

applicant's mark, when applied to its goods, so resembles the mark "MESA INTERNATIONAL" and design, which is registered on the Principal Register in the form shown below



for "retail and outlet store services featuring decorative tabletop items and decorative accessories for the home and mail order catalog services featuring decorative tabletop items and decorative accessories for the home" in International Class 35,² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed and briefs have been filed. We affirm the refusal to register.

Our 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 or dissimilarity in the goods and/or services at issue and the

² Reg. No. 2,218,666, issued on January 19, 1999, which sets forth a date of first use of the mark anywhere and in commerce of May 1997; affidavit §8 accepted. The word "INTERNATIONAL" is disclaimed.

similarity or dissimilarity of the respective marks in their entireties.³ Inasmuch as applicant, in its brief, essentially concedes by the absence of any argument pertaining thereto that the respective marks are so similar that, if used in connection with commercially related goods and services, confusion as to the source of sponsorship thereof would be likely to occur, the focus of our inquiry is accordingly on whether the goods and services at issue are so related.

Applicant, in its brief, argues that the respective goods and services "have no similarity." According to applicant, registrant's mark is "used in connection with retail services featuring decorative knick-knacks and accessories." In particular, applicant contends that:

A quick Google search reveals that the goods sold by the Registrant are decorative bakeware and dining sets used in the kitchen, wire racks and similar decorative items. These are goods consumers use to decorate around the kitchen, items that are purchased on a whim according to certain tastes.

By contrast, applicant maintains that its goods are "hardware products which are utilitarian devices used in the bath area."

Specifically, applicant insists that:

Applicant's bath accessories are purchased at do-it-yourself home centers for installation in the bath area. Unlike the Registrant's goods which are purchased on a whim, consumers will carefully consider Applicant's bath accessories since they will become semi-permanent fixtures mounted to the wall in the bathroom. They are not interchangeable

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/or services] and differences in the marks." 192 USPQ at 29.

without some patching of the walls. Moreover, consumers would not base their purchase of bath accessories upon a perceived association with a regional outlet store.

With respect to the evidence of record which is relied upon by the Examining Attorney (as discussed more fully later in this opinion), applicant urges that "none of the examples provided showed retail establishments that sold wall-mounted bath accessories side by side with decorative plates and the like." While nonetheless admitting that "[c]ertainly a large enough big box retailer may sell both," applicant asserts that sales thereof would occur "in entirely different departments." Applicant consequently concludes that "[t]here is no likelihood that consumers would be confused between both hardware and a regional outlet store specializing in decorative plates."

The Examining Attorney, on the other hand, argues in his brief that (*italics in original*):

Applicant offers "bathroom accessories, namely towel bars, towel rings, tissue holders and tumbler-toothbrush holders." Registrant provides "retail and outlet store services featuring decorative tabletop items and decorative accessories for the home and mail order catalog services featuring decorative tabletop items and decorative accessories for the home." For the purposes of this appeal, the most significant portion of registrant's identification of services is the usage of the phrase "decorative accessories for the home." Towel bars, towel rings, tissue holders, and toothbrush holders are *home accessories*. Because there are no limitations on registrant's scope of its services, it is presumed to encompass the decorative type of bathroom accessories applicant offers.

Consumers are likely to be confused by the use of similar marks on or in connection with goods and with services featuring or

related to those goods. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (BIGG'S for retail grocery and general merchandise store services held confusingly similar to BIGGS for furniture); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for retail women's clothing store services and clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *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); *Mack Trucks, Inc. v. Huskie Freightways, Inc.*, 177 USPQ 32 (TTAB 1972) (use of similar marks for trucking services and on motor trucks and busses is likely to cause confusion).

In concluding that "applicant's identified goods, namely, towel bars, towel rings, tissue holders, and toothbrush holders are substantially related to registrant's identified retail store services featuring decorative accessories for the home" because "[a]pplicant's goods are merely a subset of the broader category of goods for which registrant provides its services," the Examining Attorney asserts that "the same manufacturer normally offers some form of 'bathroom accessories' as part of its larger 'home accessories' merchandise." As support for such assertion, the Examining Attorney refers to the following "sample of excerpted product manufacturer Internet web sites included with the May 16, 2005 Office Action and November 7, 2005 Final Refusal." According to the Examining Attorney:

From the web site "Elvis Home and Bathroom Accessories" (<http://www.marketstreetmercantile.com/pages/elvis9.html>):

1. Elvis Presley Beaded Curtain with "Jailhouse Rock" decoration;

2. Elvis Presley 3-Pc. Bathroom Set, includes soap dish and tumbler, with "Jailhouse Rock" decoration;
3. Elvis Presley Soap/Lotion Dispenser with "Jailhouse Rock" decoration;
4. Elvis Presley Cotton Ball Holder with "Jailhouse Rock" decoration;
5. Elvis Presley Trashcan with "Jailhouse Rock" decoration; and
6. Elvis Presley Shower Curtain with "Jailhouse Rock" decoration.

From the web site "Renovator's Supply -- Wrought Iron & Decorative Towel Bars" (<http://www.rensup.com>):

1. A total of nine (9) different towel bars all found under the listing "Decorative Towel Bars," and located within the larger sets of "Accessories > Bath Accessories."
2. Excerpt from manufacturer: "Whether you're looking for a handcrafted, wrought iron towel bar, a decorative steel or nickel bar, or a designer brass bar, you'll find what you're looking for in our collection of decorative towel bars." [emphasis added]

From the web site "Eagle Emporium's Neat Stuff" (<http://www.eagle-emporium.com/bars.htm>):

1. Multiple listings for home décor items, such as wrought iron towel bars, paper towel holders, toilet paper holders, and other "home décor items."

From the web site "The Home Improvement Site" (<http://www.the-home-improvement-site.com/kitchens/23/decorative-kitchen-towel.html>):

1. "Decorative towel rings." From the manufacturer: "Homestead Interiors specializes in lodge and cabin style home decorating items to

enhance the mountain and wilderness feeling in your home." [emphasis added]

2. Several other listings for "decorative towel bars" and "decorative kitchen towels."

From the web site "La La Ling" (<http://www.lalaling.com>):

1. Fun Toothbrush Holders by Crocodile Creek. "Fun, colorful and decorative toothbrush holders" available in four different styles.

As "further support of the relatedness of the goods," the Examining Attorney notes that the record contains four use-based third-party registrations which "have probative value to the extent that they serve to suggest that the goods listed therein, namely, towel bars, towel rings, tissue holders, and toothbrush holders are considered to be home accessories and are of a kind that may emanate from a single source. *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 (TTAB 2001), citing *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 at n.6 (TTAB 1988)." According to the Examining Attorney, "[t]he relevant parts of the third[-]party registrations that demonstrate the related nature of the goods and services read as follows:"

- 1) Registration No. 1394905 for the mark SURE-LOCK, for goods including "... accessories for the home and bathroom namely, toilet tissue holders."
- 2) Registration No. 1990688 for the mark CREATIVE BATH, for goods including "bathroom and home accessories, namely [tumblers,] ... tissue boxes, wastebaskets, soap dishes, towel

holders, liquid soap dispensers,
toothbrush holders, bowl brushes, cotton
ball and swab holders, towel rings,
[and] ... toilet tissue holders"

- 3) Registration No. 2709312 for the mark
CHESTNUTS & PAPAYA, for services
including "retail store services ... in
the fields of ... decorative accessories
for the home ... toothbrush holders
...."
- 4) Registration No. 2846273 for the mark
ANIMAL WALK, for services including
"retail store services, featuring--home
accessories; ... bed and bath products,
namely, bathroom accessories, namely,
tissue holders"

With respect to applicant's arguments that applicant's goods and registrant's services nevertheless are not related because "a quick Google search reveals that the goods sold by the Registrant are decorative bakeware and dining sets used in the kitchen, wire racks and similar decorative items," the Examining Attorney accurately observes that "applicant provides no evidence of said Google® search." Moreover, the Examining Attorney properly points out that, for purposes of assessing whether there is a likelihood of confusion, it is "the identification of registrant's services [as] *listed in the registration* [which] serves as the true measure of the scope of such services, not registrant's web site." Specifically, as correctly stated in his brief:

Likelihood of confusion is determined on the basis of the goods or services as they are identified in the application and the registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ 1687, 1690 n.4 (Fed. Cir. 1993). Since the identification of the registrant's services is considerably broad,

it is presumed that the registration encompasses all goods and/or services of the typed described, including those in the applicant's more specific identification, that they move in all normal channels of trade and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re Optica International*, 196 USPQ 775 (TTAB 1977); TMEP §1207.01(a)(iii).

Furthermore, as to applicant's argument that, unlike purchasers of the goods available through registrant's services, consumers of applicant's goods "will carefully consider Applicant's bath accessories since they will become semi-permanent fixtures mounted to the wall in the bathroom," the Examining Attorney properly observes among other things that "applicant has provided no evidence of any consumer care taken when items of this type are purchased." The Examining Attorney, instead, posits that "the consumers of both applicant's goods and registrant's services will be members of the general public" and that, in any event, even if such consumers were discriminating rather than merely ordinary purchasers, "the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion," citing "*In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(viii)." In addition, as to applicant's contention that none of the evidence of record shows "retail establishments that sold wall-mounted bath accessories side by side with decorative plates and the like," the Examining Attorney maintains that such contention is "not persuasive" because, *inter alia*, the evidence of record

demonstrates that "'bath accessories' do, in fact, normally emanate from the same source as 'home accessories' or 'decorative home accessories.'"

We agree with the Examining Attorney that, inasmuch as it is the manner in which applicant's goods and registrant's services are identified which is controlling, such goods and services must be considered to be commercially related for purposes of determining whether contemporaneous use of the marks at issue would be likely to cause confusion. See, e.g., *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993); and *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990). Specifically, as the Examining Attorney has properly pointed out, it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and the cited registration rather than in light of what the goods and/or services actually are as shown by any extrinsic evidence. See, e.g., *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Here, as persuasively noted by the Examining Attorney, applicant's goods, which are identified in its application as "bathroom accessories, namely towel bars, towel rings, tissue holders and tumbler-toothbrush holders," are indeed included within the language "decorative accessories for the home" which is set forth in registrant's registration, which recites its services as "retail and outlet store services featuring decorative tabletop items and decorative accessories for the home and mail order catalog services featuring decorative tabletop items and decorative accessories for the home." Moreover, rather than improperly serving to limit or restrict the identification of applicant's goods and/or the recitation of registrant's services, the evidence of record confirms that "bathroom accessories" of the kinds offered by applicant, namely, "towel bars, towel rings, tissue holders and tumbler-toothbrush holders," are considered in the trade for such items to be items of "decorative accessories for the home," which would be marketed to consumers through, for instance, registrant's "retail and outlet store services featuring ... decorative accessories for the home" and its "mail order catalog services featuring ... decorative accessories for the home." Stated otherwise, "decorative accessories for the home" encompass more than just what applicant refers to as "decorative bakeware and dining sets used in the kitchen, wire racks and similar decorative items" which "consumers use to decorate around the kitchen" and which would be "purchased on a whim according to certain tastes." Clearly, if respectively offered under the same or similar marks,

purchasers familiar with "retail and outlet store services featuring decorative tabletop items and decorative accessories for the home and mail order catalog services featuring decorative tabletop items and decorative accessories for the home" would be likely to believe, upon encountering goods such as "bathroom accessories, namely towel bars, towel rings, tissue holders and tumbler-toothbrush holders," that the latter emanate from or are sold through the former, notwithstanding that the latter are decorative items which, in some cases, ultimately become semi-permanent fixtures mounted to a wall in a bathroom.

Turning, therefore, to consideration of the marks at issue, we concur with the Examining Attorney that, due to its visual prominence, the dominant and distinguishing portion of registrant's "MESA INTERNATIONAL" and design mark is the term "MESA," which is identical in sound, appearance, connotation and commercial impression to applicant's "MESA" mark. While the Examining Attorney is also mindful that the respective marks must be considered in their entireties and that any descriptive or other disclaimed matter therein cannot be ignored, our principal reviewing court has indicated 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 [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "[t]hat a particular

feature is descriptive [or otherwise lacking in distinctiveness] ... with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" Id. Here, as the Examining Attorney points out, the word "INTERNATIONAL" in registrant's mark has been disclaimed as descriptive and, as such, is "less significant" than the dominant and distinguishing term "MESA" when the mark is considered as a whole. Thus, while registrant's mark includes additional matter not present in applicant's mark, including the descriptive word "INTERNATIONAL," overall the marks at issue are so substantially similar in sound, appearance, connotation and commercial impression that we agree that confusion would be likely. Furthermore, as the Examining Attorney accurately notes, applicant "has not presented any argument or evidence as to the ... dissimilarity between the marks, effectively conceding that the marks are indeed highly similar."

Accordingly, we conclude that consumers and prospective purchasers who are familiar or otherwise acquainted with registrant's "MESA INTERNATIONAL" and design mark for its "retail and outlet store services featuring decorative tabletop items and decorative accessories for the home and mail order catalog services featuring decorative tabletop items and decorative accessories for the home," would be likely to believe, upon encountering applicant's substantially similar "MESA" mark for its "bathroom accessories, namely towel bars, towel rings, tissue holders and tumbler-toothbrush holders," that such commercially

Ser. No. 78495253

related services and goods emanate from, or are otherwise sponsored by or affiliated with, the same source.

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