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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mattress Discounters Corporation

Serial No. 78701477

Jennifer Donohue of Arent Fox LLP for Mattress Discounters Corporation.

John Dwyer, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

Before Quinn, Grendel and Bergsman, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Mattress Discounters Corporation, applicant herein, seeks registration on the Principal Register of the mark SLEEP COUNSELOR (in standard character form; SLEEP disclaimed) for services recited in the application as "retail store services featuring mattresses, bedding,

bedsprings, bed frames, and bedding related accessories," in Class 35.[1]

The Trademark Examining Attorney has issued a final refusal to register applicant's mark on the ground that the mark, as used in connection with applicant's recited services, so resembles the mark SLEEP CONSULTANTS, previously registered on the Principal Register (in standard character form; SLEEP disclaimed) for services recited in the registration as "retail bedding store services; telephone shop at home services in the field of bedding" in Class 35,[2] as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant has appealed the final refusal. After careful consideration of the evidence of record and the arguments of counsel, we affirm the refusal to register.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). *See*

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[1] Serial No. 78701477, filed on August 26, 2005. The application is based on applicant's asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

[2] Registration No. 2435720, issued on March 13, 2001. Affidavits under Sections 8 and 15 accepted and acknowledged.

In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.,* 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We find that applicant's services as recited in the application are in part identical to and otherwise closely related to the services recited in the cited registration. The second *du Pont* factor (similarity or dissimilarity of the services) therefore weighs in favor of a finding of likelihood of confusion.

We find that applicant's services as recited in the application and the identical and closely related services recited in the cited registration are or would be marketed in the same trade channels and to the same classes of purchasers. The third *du Pont* factor therefore weighs in favor of a finding of likelihood of confusion.

We turn next to the first *du Pont* factor, which requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra*. 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 or service marks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). In cases such as this, where the applicant's services are identical, at least in part, to the services recited in the cited registration, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the services were not identical. *Century 21 Real Estate Corp. v. Century Life of America,* 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applicant's mark is SLEEP COUNSELOR. The cited registered mark is SLEEP CONSULTANTS. In terms of appearance, we find that the marks are identical to the extent that both begin with the word SLEEP. COUNSELOR and CONSULTANTS are not identical in appearance, but they look similar to the extent that they are both rather long words

which begin with the letter "c". Viewing the marks in their entireties in terms of appearance, we find that they are similar.

In terms of sound, we again find that the marks are identical to the extent that they both start with the word SLEEP. COUNSELOR and CONSULTANTS are not identical in terms of sound, but they are similar to the extent that they both have three syllables, they both start with a hard "c", the first syllable of both words ends with an "n," and the second syllable of both words begins with a "s" and ends with an "l". Viewing the marks in their entireties in terms of sound, we find that they are similar.

In terms of connotation, we find that the marks are highly similar. SLEEP has the same meaning in both marks. The record establishes that "counselor" is defined as "one that counsels: advisor." (Webster's Third New International Dictionary Unabridged.) "Consultant" is defined as "one who gives professional advice or service regarding matters in the field of his special knowledge or training." (Id.) Thus, in essence, "counselor" and "consultant" mean essentially the same thing, each connoting a person who gives advice to others. Viewing the marks SLEEP COUNSELOR and SLEEP CONSULTANTS in their entireties in terms of meaning, we find that they are

similar because they both connote a person who gives advice about sleep.

We also find that the marks create highly similar if not essentially identical commercial impressions. As applied to the specific services identified in applicant's application and in the cited registration, both marks would be perceived as identifying a person who gives others advice in a retail context about sleep products, including advice as to which types of mattresses and other bedding would be the most appropriate for a particular purchaser and his or her sleep-related needs. We have considered applicant's arguments to the contrary, but we find them to be unpersuasive.[3]

Comparing the marks in their entireties in terms of appearance, sound, connotation and overall commercial impression, we find for the reasons discussed above that the marks are similar. This is especially so given the identical (in part) nature of applicant's and registrant's

[3] These include applicant's arguments and evidence pertaining to the term "sales consultants," and its argument and evidence pertaining to the coexistence on the Register of unrelated third-party "counselor" and "consultant" marks. Nor are we persuaded by applicant's argument that SLEEP CONSULTANTS is a weak mark entitled to a narrow scope of protection because "sleep consultant" is sometimes used descriptively in the mattress and bedding retail context. Even if the registered mark is weak, it still is entitled to protection against registration of applicant's highly similar mark used on identical services.

respective services and the resulting lesser degree of similarity between the marks which is necessary to find a likelihood of confusion. We find that the first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Considering all of the evidence of record as it applies to the *du Pont* factors, we conclude that a likelihood of confusion exists. To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts against applicant. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *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 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.