

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: May 1, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Espace Production International E.P.I.

Serial No. 78783663

John S. Egbert and Jeremy Craft of Egbert Law Offices for
Espace Production International E.P.I.

Wendy B. Goodman, Trademark Examining Attorney, Law Office
109 (Dan Vavonese, Managing Attorney).

Before Hohein, Cataldo and Ritchie de Larena,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Espace Production
International E.P.I. to register the mark UTOPIA in
standard character form on the Principal Register for the
following goods, as amended: "non-metal flooring, namely,
parquet flooring and parquet floor boards" in International
Class 19.¹

¹ Application Serial No. 78783663 was filed January 2, 2006,
based upon applicant's assertion of a bona fide intent to use the
mark 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 in connection with its goods, so resembles the mark UTOPIA, previously registered on the Principal Register in typed or standard character form for "plastic floor covering having a water resistant, smooth or embossed surface in rolls or tiles" in International Class 27,² as to be likely to cause confusion.

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

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, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (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, 27 (CCPA

² Registration No. 2655030 issued November 26, 2002.

1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

The Marks

We first consider the similarity of the marks. In this case, applicant's mark is identical to the cited mark, UTOPIA, in appearance and sound.

We are not persuaded by applicant's argument that the marks convey different commercial impressions due to differences in the identified goods. Applicant fails to explain how use of its UTOPIA mark on parquet flooring conveys "the distinct impression of a luxury brand of wood flooring from France that represent[s] the pinnacle of the home decorative flooring industry"³ whereas registrant's use of the identical mark on plastic flooring conveys "a worry-free or 'perfect' water resistant barrier for floors."⁴ As such, applicant fails to support its contention that these otherwise identical marks are somehow different in connotation or convey different commercial impressions. See, e.g., *In re Big Pig, Inc.*, 81 USPQ2d 1436 (TTAB 2006). Cf. *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312 (TTAB 1987). In view of the foregoing, we find that the marks are identical in all respects. Use of identical marks is a

³ Brief, p. 3.

⁴ Id.

fact which "weighs heavily against applicant." See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984); and *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

Neither are we persuaded by applicant's argument that as a result of "unrestrained use by third parties,"⁵ UTOPIA is a weak mark. Applicant refers to the results of a search of the USPTO's Trademark Electronic Search System (TESS) which purportedly retrieves a number of UTOPIA formative marks owned by third parties. We observe, however, that applicant has not made of record the results of any such search, and the Board will not take judicial notice of third-party registrations or marks. See *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). Accordingly, applicant's unsupported allegations regarding the asserted weakness of the mark in the cited registration are entitled to little weight. We therefore find that on the facts before us, and in the absence of any evidence to the contrary, the mark UTOPIA is a strong mark, and as such is entitled to a broad scope of protection.

⁵ Id. at 5.

The Goods

We next turn to a consideration of the goods. We note, at the outset of considering this *du Pont* factor, that the greater the degree of similarity between applicant's mark and the cited registered mark, the lesser the degree of similarity between applicant's goods and registrant's goods that is required to support a finding of likelihood of confusion. See *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). If the marks are the same, as in this case, it is only necessary that there be a viable relationship between the goods in order to support a finding of likelihood of confusion. See *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

Furthermore, it is not necessary that the goods at issue be similar or competitive, or even that they move in the same channels of trade, to support a holding 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*

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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, in each instance, adopted a single mark for goods that are identified in both applicant's application and the cited registration. See, for example:

Registration No. 2806186 for, *inter alia*, parquet flooring, floor coverings of wood, cork rubber, plastic or substitutes for these materials;

Registration No. 2261596 for, *inter alia*, parquet wood flooring, vinyl flooring, and linoleum flooring;

Registration No. 2423964 for, *inter alia*, wood tile flooring, parquet wood flooring, vinyl floor covering; and

Registration No. 2350422 for, *inter alia*, parquet wood strips, parquet wood floors, linoleum and vinyl floors, floor coverings of cork, rubber, plastics, or substitutes therefor.

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 this case, the evidence of record suggests that applicant's parquet flooring and parquet floor boards and

registrant's plastic floor covering, which by definition includes vinyl floor coverings, are related building materials that may emanate from a common source. We hereby take judicial notice of the following definition of vinyl: "any of various typically tough, flexible, shiny plastics, often used for coverings and clothing."⁶ American Heritage Dictionary, 4th ed. (2006).

Thus, we find that applicant's parquet flooring and floor boards are related to registrant's plastic floor coverings such that consumers could, because of the identical nature of the marks, mistakenly believe that they originate from the same source.

Channels of Trade

We are not persuaded by applicant's argument that while registrant's goods are "sold to various consumer flooring stores,"⁷ its goods "are imported from France and sold only in bulk to wholesale consumers"⁸ with the result that the "channels of trade are necessarily different due to the fact that the consumers of the goods are radically

⁶ The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). See also *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁷ Brief, p. 4.

⁸ *Id.*

different.”⁹ It is settled that in making our determination regarding the relatedness of the parties’ goods, we must look to the goods as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”) See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.”)

In this case, neither the goods identified in the application at issue nor those in the cited registration recite any limitations as to channels of trade. Accordingly, both applicant’s and registrant’s goods are presumed to move in all normal channels of trade therefor and be available to all classes of potential consumers,

⁹ Id.

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including consumers of each other's goods. *See In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Summary

In summary, weighing all of the evidence of record as it pertains to the relevant *du Pont* factors, we find that a likelihood of confusion exists.

Decision: The refusal of registration is affirmed.