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*Decision Mailed:
September 26, 2008
GDH/gdh*

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Steelcase Inc.

Serial No. 78968191

Aaron J. Wong of Price, Heneveld, Cooper, DeWitt & Litton, LLP
for Steelcase Inc.

Christina M. Sobral, Trademark Examining Attorney, Law Office 109
(Dan Vavonese, Managing Attorney).

Before Hohein, Zervas and Cataldo, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Steelcase Inc. has filed an application to register on
the Principal Register in standard character form the mark
"RUNNER" for "tables" in International Class 20.¹

Registration has been finally refused under Section
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that
applicant's mark, when applied to its goods, so resembles the
mark "RUNNER," which is registered on the Principal Register in

¹ Ser. No. 78968191, filed on September 6, 2006, which alleges a date
of first use of the mark anywhere and in commerce of June 1995.

standard character form for "chairs" in International Class 20,² 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). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). 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 of the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.³ See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Here, inasmuch as the respective marks are identical in all respects, the primary focus of our inquiry is accordingly on the similarities and dissimilarities in the goods at issue along with consideration of, *inter alia*, such factors as the conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful,

² Reg. No. 2,651,512, issued on November 19, 2002, which is based on Danish Reg. No. VR200101250 issued on March 14, 2001.

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 differences in the marks." 192 USPQ at 29.

sophisticated purchasing, and the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion.

Turning first to the similarities and dissimilarities in the goods at issue, applicant (although notably without any evidentiary proof other than as to the name of the owner of the cited registration) maintains in its brief that "[t]he mark [which is the subject of the registration] cited by the Examining Attorney is owned by Fritz Hanson A/S Corp., who sells the RUNNER chair" which, applicant insists, "is a stacking chair designed by Danish designer Kasper Salto." Applicant further asserts that:

The Fritz Hanson website notes that the RUNNER chair can be supplied with or without arms, with or without seat upholstery, and, when used at conferences, with or without writing tablets and linking elements. Thus, the chairs marketed under the [mark of the] registration cited by the Examining Attorney are for use at conference type settings where seating capacity is an issue and where there also exists a need to store the chairs in an efficient manner such as stacking the chairs, which is a feature provided by the runner chair of the '512 registration.

By contrast, applicant argues that (citation omitted):

The present application is for the mark RUNNER for use in connection with tables. Purchasers of Applicant's products are typically corporate purchasers whom [sic] use these products for designing office layouts and configurations. Such purchases are not impulse purchases, but rather require detailed analysis of options, costs, configuration and capacity. Thus, the purchasers of Applicant's products are highly discriminating purchasers who will only buy after careful consideration. Discriminating purchasers are, generally speaking, less likely to be confused by ... [contemporaneous] use of marks. What is more, the purchasers of the products sold

under the [mark which is the subject of the] registration cited by the Examining Attorney are likely to be buyers for conference centers and the like, such that these purchasers are also highly sophisticated and are specifically seeking chairs which provide the seating capacity needed as well as the storage capabilities of the RUNNER chair. Therefore, the goods identified in the present application and the goods of the mark cited by the Examining Attorney are not purchased without careful thought and consideration by untrained consumers, but rather, they are purchased by discriminating purchasers with specific intentions for the goods such that they are not likely to be confused.

The Examining Attorney, on the other hand, properly observes as a preliminary matter in her brief that where the marks at issue are identical, as is the case herein, the respective goods "need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks," citing *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001) and *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981). See also, *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994). In addition, the Examining Attorney correctly points out that it is well established that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the application and the cited registration, rather than on the basis of what they are asserted to be or any evidence reveals them actually to be. See, e.g., *Octocom Systems Inc. v. Houston Computer 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 the goods are directed"); 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).

Thus, as the Examining Attorney accurately notes, where an applicant's and a cited registrant's goods are broadly described as to their nature and type, it is presumed in each instance that in scope the application and cited registration encompass not only all goods of the nature and type described therein, but that the identified goods move in all channels of trade which would be normal for those goods and that they would be purchased by all potential buyers thereof. See, e.g., In re Dakin's Miniatures Inc., 59 USPQ2d 1593, 1595 (TTAB 1999); In re Linkvest S.A., 24 USPQ2d 1716 (TTAB 1992); and In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). Here, applicant's goods are broadly identified as "tables" while registrant's goods are broadly set forth as "chairs"; neither of the identifications of the respective goods contains any restriction or limitation as to the use of the goods or their typical purchasers. The Examining Attorney is accordingly correct that "applicant's argument that

the nature of the goods and the purchasers are different has no bearing" in this case.

Moreover, as the Examining Attorney also accurately observes, it is well settled that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., In re Total Quality Group Inc., 51 USPQ2d 1474, 1476 (TTAB 1999); Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

Here, the Examining Attorney contends that, as shown by the following evidence which she has made of record, applicant's tables and registrant's chairs are related goods in that they "are commonly sold and marketed together." Specifically, such evidence consists of copies of four use-based third-party registrations for marks which are registered in International Class 20 for goods which are variously identified as: "tables and chairs"; "furniture, namely, tables, chairs, ..."; "chairs, tables, ... lounge chairs, ... swivel chairs, high-backed chairs, dining tables, cocktail tables, coffee tables, conference tables"; and "furniture, namely, chairs, tables," Although

we note that such registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, it is still the case that the registrations have some probative value to the extent that they serve to suggest that the goods listed therein are the kinds of goods which may emanate from a single source. See, e.g., In re Infinity Broadcasting Corp. of Dallas, 60 USPQ2d 1214, 1217-18 (TTAB 2001); 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 n.6 (TTAB 1988), *aff'd as not citable precedent*, 864 F.2d 149 (Table, unpublished) (Fed. Cir. 1988). In addition, the Examining Attorney has furnished copies of pages from the catalogs of such furnishings retailers as "IKEA," "Crate & Barrel," "Target" and "Pottery Barn" showing, in each instance, the advertising and offering for sale of chairs in conjunction with tables. In light of such evidence, as well as applicant's original specimens of use, which demonstrate use of its tables with chairs, we fully concur with the Examining Attorney's conclusion that the goods at issue herein are commercially related in that "tables and chairs are complementary goods that are often sold together in the same channels of trade."

Furthermore, while we understand and appreciate applicant's argument that confusion is nonetheless unlikely, despite contemporaneous use by applicant and registrant of the identical mark "RUNNER," because tables and chairs are not impulse items and are instead products which are typically purchased by sophisticated purchasers only after careful

deliberation and assessment of their particular furnishing needs, we concur with the Examining Attorney that confusion is likely to occur. As the Examining Attorney persuasively notes, it is well established that while buyers may be knowledgeable and discriminating as to the kinds of goods required to meet or take care of their specific needs or requirements, and thus would be expected to exercise care and deliberation in their choice of goods, such sophistication as to product selection "does not necessarily preclude their mistaking one trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986); *In re Decombe*, 9 USPQ 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983). This would be especially so where, as here, the marks at issue are identical in all respects.

Finally, applicant asserts (although again without any evidentiary proof) that "both the applied-for mark and the mark cited by the Examining Attorney have been in use concurrently for the past six years without any indication of actual confusion." Even assuming that, by "concurrent use," applicant actually means contemporaneous use in the same marketplaces (rather than true concurrent use in separate geographical areas) as the basis for its stated "belief that these two marks can coexist in their distinct channels of trade without any likelihood of confusion,"

the Examining Attorney properly notes that as stated by the Board in *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984):

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In particular, it is pointed out that in order for an asserted lack of any incidents of actual confusion to be a meaningful factor, the record must demonstrate that there has been appreciable and continuous use by applicant of its mark in the same market(s) as those served by registrant under its mark. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Specifically, there must be evidence showing that there has been an opportunity for instances of actual confusion to occur and here the record is devoid of any such proof. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). There simply is no such evidence on this record in order for the asserted absence of any instances of actual confusion to be a meaningful factor in the determination of whether confusion is likely to occur.

Accordingly, we conclude that purchasers who are familiar or otherwise acquainted with registrant's "RUNNER" mark for "chairs," would be likely to believe, upon encountering applicant's identical "RUNNER" mark for "tables," that such

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commercially related goods emanate from, or are sponsored by or affiliated with, the same source. For instance, purchasers could reasonably believe that registrant's "RUNNER" chairs and applicant's "RUNNER" tables are a line of coordinated office or conference furniture.

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