

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

Oral Hearing:
April 28, 2005

Mailed: July 25, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

This Old House Ventures, Inc.
v.
Restoration Services, Inc.

Opposition No. 91152820
to Application No. 76319002
filed on September 28, 2001

Albert Robin of Cowan Liebowitz & Latman and Robert T.
Sherer, Esq. for This Old House Ventures, Inc.

James E. Holland of Restoration Services, Inc., Pro Se.

Before Quinn, Hohein and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

This Old House Ventures, Inc. filed its opposition to
the application of Restoration Services, Inc. to register
the mark THIS MOLD HOUSE for "educational services, namely,

conducting classes in the field of mold remediation training," in International Class 41.¹

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's services, so resembles opposer's previously used and registered mark THIS OLD HOUSE, in both standard character format and in combination with a logo, for a wide variety of educational and entertainment services offered through several different media, and various goods related thereto,² as to be likely to cause confusion, under Section 2(d) of the Trademark Act.³

This is a highly unusual case procedurally. Applicant did not file an answer to the notice of opposition in the time set by the Board. In response to the Board's order to show cause as to why judgment should not be entered against it, applicant requested, and was granted, an enlargement of time to file its answer. Applicant's default was set aside and, on April 17, 2003, applicant filed a paper entitled "Notice of Response," which was accepted as applicant's answer to the notice of opposition. Trial dates were set

¹ Application Serial No. 76319002, filed September 28, 2001, based upon use of the mark in commerce, alleging dates of first use and first use in commerce as of September 10, 1996.

² Opposer claims ownership of sixteen registrations and alleges use of its THIS OLD HOUSE mark since January 1979.

³ The notice of opposition also includes a claim of dilution. However, this claim was not pursued in opposer's brief and the Board considers the dilution claim to have been deleted from the opposition.

and the trial and opposer's briefing period passed with neither opposer nor applicant taking any testimony or submitting any evidence, and without opposer filing a brief.

On July 7, 2004, the Board issued an order requiring opposer to show cause as to why judgment should not be entered against opposer for failure to file a brief. On August 5, 2004, opposer responded to the show cause order, stating that it had not lost interest in the case and requesting that the opposition be decided on its merits. Opposer stated that "[applicant's] notice of response did not respond either to opposer's allegation of ownership of the registrations pleaded in paragraph 5 of the notice of opposition or to opposer's allegation that said registrations were validly subsisting and uncanceled, thereby admitting both of these allegations"; and contending that the notice of response acknowledged opposer's registrations in the following paragraph of the notice of response (p. 3):

Applicant is engaged in the business of indoor sampling and consulting and specializes in mold sampling and training. Applicant does not now engage in any of the goods or services that the opposer's several registrations cover.

The Board accepted opposer's response and, on October 18, 2004, discharged the show cause order and set a new briefing schedule. Opposer filed its brief in a timely manner; however, applicant filed no brief.

Therefore, the record in this case consists only of the pleadings and the file of the involved application. An oral hearing was held, but only opposer attended.

The threshold question before the Board is whether applicant's answer can be construed as admitting, with respect to the status and title of opposer's pleaded registrations, that such registrations are subsisting and owned by opposer. Paragraph 5 of the notice of opposition contains the following allegation:

5. Opposer is the owner of several registrations on the Principal Register for the mark THIS OLD HOUSE, both alone and in combination with its Window Logo, issued by the United States Patent and Trademark Office, including the following:

[list of sixteen registrations by number, date of issue and identification of goods and services]

The registrations set forth above are validly subsisting and uncanceled.

In its answer, applicant did not respond paragraph-by-paragraph to each of the numbered paragraphs in the notice of opposition; nor did it expressly admit or deny any of the statements in the notice of opposition. Applicant responded with introductory and concluding paragraphs and with, essentially, three different itemized sections. In the first section, in six numbered paragraphs, applicant recited the procedural history of the application and filing of the opposition. In the second section, in four numbered paragraphs, applicant alleged that it is entitled to

registration of its mark and described its services and stated its date of first use (paragraph nos. 1 and 2). In paragraph nos. 3 and 4, applicant alleged what services it is not engaged in and what goods it does not use in merchandising or as promotional items. In alleging what it does not do, applicant used the exact language that was used by opposer in paragraph nos. 3 and 4 of the notice of opposition describing opposer's goods and services. In the third section, applicant alleged the following:

Applicant is engaged in the business of indoor sampling and consulting and specializes in mold sampling and training. Applicant does not now engage in any of the goods or services that the opposer's several registrations cover. Applicant does not provide or sell any of the following:

[at this point, in nine lettered paragraphs, applicant repeats verbatim the identifications of goods and services in opposer's pleaded registrations listed in paragraph no. 5 of the notice of opposition].

There are a number of cases addressing the issue of what is sufficient to establish the status and title of plaintiff's pleaded registrations. Opposer relies on *Tiffany & Co. v. Columbia Industries, Inc.*, 455 F.2d 582, 173 USPQ 6, (CCPA 1972), wherein plaintiff predicated its claim on its ownership of pleaded registrations, but neither filed status and title copies thereof, nor established the same through testimony. Defendant in that case, in answering the notice of opposition, denied any likelihood of confusion, but did state that it "admits the registrations

referred to in the notice of opposition." Additionally, one of the pleaded registrations had been the basis for a refusal during examination, which was subsequently withdrawn, and a copy thereof was in the application file.

The court stated the following (at 8):

The purpose of pleadings is to apprise a party by fair notice of the case it has to meet, and the Federal Rules of Civil Procedure reject the approach that pleading is a game of skill. *American Novawood Corp. v. United States Plywood-Champion Papers, Inc.*, 426 F.2d 823, 827, 57 CCPA 1226, 1281 (1970). We think that at least with respect to Reg. No. 137,722, appellee had such notice without the attachment of copies.

... appellee did not deny appellant's ownership of the registration, but rather admitted "the registrations referred to in the notice of opposition." Reg. No. 137,722 shows on its face ownership in opposer and makes out a prima facie case of ownership under § 7(b) of the Lanham Act, 15 U.S.C. § 1057(b). Appellee cannot and does not contend lack of familiarity therewith since that is the registration which was interposed by the examiner during the ex parte examination of the opposed application. Finally, that the opposition was premised on the ground of likelihood of confusion with this mark is apparent from the notice of opposition.

Since appellee had fair notice of the case it had to meet, it would work an injustice on appellant under these circumstances to deprive it of the right to rely on the statutory presumptions flowing from registration of the mark TIFFANY for playing-cards and chips and cribbage-boards, Reg. No. 137,722

In *Crown Radio Corp. v. The Soundsciber Corp.*, 506 F.2d 1392, 184 USPQ 221 (CCPA 1974), petitioner did not submit status and title copies of its registrations with its petition to cancel, nor did it take any testimony. However, respondent, subsequent to filing its answer, submitted a

search report with copies of the reported registrations, including those pleaded by petitioner, attached thereto. The court concluded that this was an admission as to the existence of petitioner's registrations. In a concurring opinion, Judge Miller emphasized that this submission was also an admission of the present existence of these registrations.

In *Hollister v. Downey*, 565 F.2d 1208, 196 USPQ 118 (CCPA 1977), wherein plaintiff attached to his notice of opposition a copy of his order for "status" copies of his pleaded registrations, the answer by defendant was in the nature of a denial, and neither party took testimony. The court found that the Board was incorrect in holding that the registrations were not properly of record because the status copies in the record did not show title. The court found that, to the contrary, the status copies with plaintiff listed thereon as owner established a prima facie case of title in plaintiff which defendant did not rebut by his answer. The court concluded that defendant had fair notice of the case he had to meet because the notice of opposition named the registrations and included copies thereof showing ownership by plaintiff on their faces. The court stated the following (at 120):

Under the circumstances of this case, the board could have set a time for Hollister to obtain and file proof of title. A flexible, not mechanical, approach was warranted under these circumstances,

particularly in light of the intervening fee change. Expediting of appeals is laudable, but dismissing on purely mechanical grounds can, as it did here, prove wasteful of judicial resources.

In the case of *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991), plaintiff did not submit any evidence during its testimony period, but did attach photocopies of its pleaded registrations to its notice of opposition; and defendant, while admitting that the pleaded registrations issued to plaintiff, denied for lack of knowledge or information that, inter alia, plaintiff's pleaded registrations were valid and subsisting. The court concluded that the denials by defendant in its answer constituted a challenge to the current status and title of plaintiff's pleaded registrations and plaintiff failed to act. The court made the following statement (at 1713):

In sum, the circumstances of this case do not establish a prima facie case precluding application of 37 C.F.R. 2.132(a). While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines.

In the case before us, opposer's pleading included its statement of ownership of its sixteen registrations and a statement that the registrations "are validly subsisting and uncanceled." As noted above, applicant did not deny this statement and, in fact, in its answer referred to opposer's registrations and specifically listed the goods and services

identified in each and every one of the pleaded registrations. Applicant also did not respond to contest opposer's contention in its response to the show cause order that applicant had admitted the status and title of opposer's registrations.

The type of legal representation of opposer in this case is something that we neither commend nor wish to encourage. Nonetheless, in view of these facts, we conclude that, by applicant's admission, opposer's pleaded registrations are considered to be part of the record and that such registrations are subsisting and owned by opposer. As stated in *Tiffany*, applicant "cannot and does not contend lack of familiarity" with opposer's registrations or the ground of opposition, and applicant has had fair notice of the case it had to meet.

Likelihood of Confusion

Inasmuch as fourteen of opposer's sixteen pleaded registrations⁴ are considered to be of record, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the

⁴ Pledaded Registration Nos. 1990419 and 2017933 have been cancelled under Section 8 of the Trademark Act and, thus, have not been further considered herein.

probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and/or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The only evidence in this case consists of opposer's pleaded and subsisting registrations, which are listed below.

Registration No. 1514892
THIS OLD HOUSE
IC 041: entertainment services through the medium of television, namely a series on the subject of home renovation, improvement and design.
Registration date: November 29, 1988
Disclaimer: HOUSE
SECT 15. SECT 8 (6-YR)

Registration No. 1732568
THIS OLD HOUSE
IC 009: prerecorded video tapes, video cassette tapes, video cassette containers, and computer programs featuring educational information on the subject of home renovation, improvement and design.
Registration date: November 17, 1992
Disclaimer: HOUSE
SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20020824
1ST RENEWAL 20020824

Registration No. 1975904



IC 016: books on the subject of home renovation, improvement and design.

IC 021: beverage mugs. IC 025: items of clothing for men and women, namely T-shirts.

Registration date: May 28, 1996

Disclaimer: HOUSE

"The mark consists of a drawing of the side of a house, with the words THIS OLD HOUSE printed beneath two windows."

SECT 15. PARTIAL SECT 8 (6-YR).

Registration No. 1992003

THIS OLD HOUSE

IC 016: magazine on the subject of home renovation, improvement, and design.

Registration date: August 6, 1996

Disclaimer: HOUSE

SECT 15. SECT 8 (6-YR).

Registration No. 2019384

THIS OLD HOUSE

IC 016: printed goods, namely, books on the subject of home renovation, improvement, and design.

Registration date: November 26, 1996

Disclaimer: HOUSE

SECT 15. SECT 8 (6-YR).

Registration No. 2287621

THIS OLD HOUSE

IC 009: CD-ROM on the subject of home construction, renovation, improvement and design.

Registration date: October 19, 1999

Disclaimer: HOUSE

Registration No. 2287622

**This Old
House**

IC 009: CD-ROM on the subject of home construction, renovation, improvement and design.
Registration date: October 19, 1999
Disclaimer: HOUSE

Registration No. 2326050

**This Old
House**

IC 016: books on the subject of home construction, renovation, improvement and design.
Registration date: March 7, 2000
Disclaimer: HOUSE
"The mark consists of a window to the left of the words THIS OLD HOUSE printed with the words THIS OLD above the 'o' and 'u' in HOUSE."

Registration No. 2326190

**This Old
House**

IC 041: educational and entertainment services, namely, a television series on the subject of home renovation, construction, improvement and design.
Registration date: March 7, 2000
Disclaimer: HOUSE
"The mark consists of a window to the left of the words THIS OLD HOUSE printed with the words THIS OLD above the 'o' and 'u' in HOUSE."

Registration No. 2326191

**This Old
House**

IC 016: books on the subject of home construction, renovation, improvement and design.
Registration date: March 7, 2000
Disclaimer: HOUSE

"The mark consists of the words THIS OLD HOUSE printed with the words THIS OLD above the 'o' and 'u' in HOUSE."

Registration No. 2238871

**This Old
House**

IC 016: magazine on the subject of home construction, renovation, improvement and design.
Registration date: April 13, 1999
Disclaimer: HOUSE
SECT 15. SECT 8 (6-YR).

Registration No. 2241484

THIS OLD HOUSE

IC 037: repair and improvement of homes.
Registration date: April 27, 1999

Registration No. 2275796

 **This Old
House**

IC 009: magnetically encoded debit cards.
IC 016: credit cards.
Registration date: September 7, 1999
Disclaimer: HOUSE
"The mark consists of a drawing of the side of house with the words THIS OLD HOUSE printed to the right of the drawing."

Registration No. 2304349

 **This Old
House**
O N L I N E

IC 042: providing information about home construction, renovation improvement and design through a global computer network.
Registration date: December 28, 1999
Disclaimer: HOUSE and ONLINE
"The mark consists of a window to the left of the words THIS OLD HOUSE ONLINE printed with the words THIS OLD above the 'o' and 'u' in HOUSE which is

above the word ONLINE, as shown in the accompanying drawing."

Opposer characterizes its services as covering "educational services on the subjects of home renovation, improvement and design" and contends that applicant's educational services involving conducting classes in the field of mold remedial training are encompassed within opposer's educational services or are at least sufficiently related thereto that confusion is likely if both services are rendered under confusingly similar marks. Further, opposer contends that, while not identical, the marks are substantially similar in sound and appearance; and that applicant's addition of one letter to opposer's mark is insufficient to distinguish the marks. As indicated earlier, applicant did not file a brief or otherwise present an argument in this case.

Opposer's various identifications of goods and services can be summarized as educational products in the nature of videos, computer programs, CD-ROMs, books and magazines, and educational services in the nature of television programs and Internet websites, all pertaining to home renovation, improvement and design.⁵

⁵ Opposer's Registration No. 2275796 is for a THIS OLD HOUSE design mark for debit and credit cards. The record provides no evidence that these products bear any relationship to applicant's services and, thus, regardless of any similarity in the marks, we find no likelihood of confusion between the marks in this registration and applicant's mark in connection with the respective goods and services.

With respect to the goods and services of the parties, both parties provide educational services pertaining to work that is performed on a home, that is, renovation, improvement and design on the one hand, and mold remediation,⁶ on the other hand. It is very likely that an aspect of some home renovations includes mold remediation and eliminating mold is clearly an improvement to a home. Thus, we conclude that applicant's identified services are closely related to, if not encompassed by, the services identified in opposer's registrations.

Turning to the marks, we note that while we must base our determination on a comparison of the marks in their entireties, we are guided, equally, by the well established principle that, in articulating reasons for reaching a conclusion on the issue 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 the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Several of opposer's registrations are for the word mark THIS OLD HOUSE and the remaining registrations include these words, one with the addition of the word ONLINE, in

⁶ There is, of course, no evidence that describes exactly what "mold remediation" is; however, in view of applicant's mark, THIS MOLD HOUSE, we assume that mold remediation pertains to eliminating mold from houses.

stylized writing, some also with a window design. The window design is suggestive of a house and home improvement, and the word ONLINE in the THIS OLD HOUSE ONLINE mark is merely descriptive of the nature of the services identified in that registration. Thus, even in opposer's stylized and design marks, the term THIS OLD HOUSE predominates.

Applicant's mark consists also of three words, with the first and last words identical to the same in opposer's marks. While the connotation of the middle words in the parties' marks differ, MOLD and OLD, the two words rhyme and the cadence on the terms, THIS MOLD HOUSE and THIS OLD HOUSE, is the same. We conclude that the marks are sufficiently similar that, if used in connection with closely related goods or services, confusion as to source is likely.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, THIS MOLD HOUSE, and opposer's THIS OLD HOUSE marks, their contemporaneous use on the closely related goods and services involved in this case is likely to cause confusion as to the source or sponsorship of such goods and services.

Decision: The opposition is sustained.