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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

CCA Global Partners, Inc., by change of name
from Carpet Co-op of America Association

v.

Global Tile, Inc., by change of name from
Global Tile & Carpet, Inc.¹

Cancellation No. 92030214

Michael R. Annis, Gary A. Pierson II and Alan S. Nemes of
Blackwell Sanders LLP for CCA Global Partners, Inc., by
change of name from Carpet Co-op of America Association.

William M. Lee of Barnes & Thornburg, LLP for Global Tile,
Inc., f/k/a Global Tile & Carpet, Inc.

Before Seeherman, Grendel and Zervas, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On March 23, 1999, Registration No. 2234973 ("the '973
registration") for the mark TILE ONE (in typed form) issued

¹ On May 2, 2005, the Assignment Branch of the United States
Patent and Trademark Office recorded a change of name from Global
Tile & Carpet, Inc. to Global Tile, Inc. at Reel No. 3204, Frame
No. 0581. The caption for this proceeding has been amended to
reflect the change of name. See TBMP § 512.02 (2d ed. rev.
2004).

on the Principal Register for "importation and wholesale distribution of ceramic, porcelain, granite, marble and stone tile through a network of dealers" in International Class 35, based on an application filed on February 18, 1997. The '973 registration states dates of first use anywhere and first use in commerce on September 22, 1998 and includes a disclaimer of the word TILE. Global Tile, Inc. ("respondent") is the owner of record of the '973 registration.²

CCA Global Partners, Inc. ("petitioner"), formerly, Carpet Co-op of America Association, has filed a petition to cancel the '973 registration. In the petition to cancel, petitioner pleaded ownership of the following registrations:

Registration No. 1422989 issued December 30, 1986 for the mark CARPET ONE (in typed form) for "carpeting" in International Class 27 and "carpet dealership services" in International Class 42, with CARPET disclaimed;

Registration No. 1397206 issued June 10, 1986 for the mark



for "retail store services featuring carpets" in International Class 42, with CARPET disclaimed;

Registration No. 2091844 issued August 26, 1997 for the mark DISTRIBUTION ONE (in standard character form) for "wholesale distributorship featuring carpet and floor coverings" in

² A Section 8 affidavit was accepted on June 28, 2006.

International Class 42, with DISTRIBUTION disclaimed;

Registration No. 1778411³ issued June 22, 1993 for the mark YES! THE ONE WORD GUARANTEE for "floor coverings; namely, carpets, carpet pads and resilient hard surface vinyl covering for floors" in International Class 27; and

Registration No. 2223178 issued February 9, 1999 for the mark CERAMICA UNO (in typed form) for "ceramic tile" in International Class 19, with CERAMICA disclaimed.⁴

Petitioner has alleged that its marks form a family of marks; and that respondent's mark so closely resembles the marks of petitioner's pleaded registrations and petitioner's family of marks as to be likely to cause confusion, mistake or deception in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Petitioner has also alleged that respondent has abandoned its mark.

Respondent has answered the petition to cancel by denying the salient allegations thereof.

The record consists of the pleadings; the file of the involved registration; petitioner's notice of reliance by which petitioner submitted status and title copies of various registrations, including the pleaded registrations; and the April 11, 2007 testimonial deposition of Robert

³ The petition to cancel incorrectly identifies this registration as Registration No. 1778441.

⁴ Petitioner has also alleged ownership of Registration No. 1405940 for the mark CONTRACT ONE (in typed form) but has not submitted a status and title copy of the registration with its notice of reliance and has not established its ownership and

Wilson, Chief Operating Officer of CCA Global Partners, Inc., and accompanying exhibits, divided into a confidential portion and a non-confidential portion.

Petitioner has filed its main brief; respondent has not filed any evidence nor a main brief.

Findings of Fact

Petitioner is a cooperative composed of a number of members which are an affiliated group of independently owned and operated retail floor coverings stores. The members sell floor coverings such as carpet, wood, stone, ceramic tile, vinyl and rugs throughout the United States. Petitioner provides advertising for its members through television, magazines, newspapers and other forms of media including a website. It also provides them with merchandising, management and training services. Additionally, petitioner maintains a buying system that allows its members to purchase floor covering products and accessories at reduced prices. The members may and are encouraged to use the CARPET ONE mark in their trade names.

Priority

Because this is a cancellation proceeding, petitioner does not necessarily have priority simply because it owns registrations. *Brewski Beer Co. v. Brewski Brothers, Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998) (the "Board has taken the

existence through the testimony of any witness. We therefore

position, in essence, that the registrations of each party offset each other; that petitioner as a plaintiff must, in the first instance, establish prior rights in the same or similar mark Of course, petitioner or respondent may rely on its registration for the limited purpose of proving that its mark was in use as of the application filing date."). In this case, because respondent has not submitted any evidence, the earliest date upon which it can rely is the February 18, 1997 filing date of respondent's application which issued as Registration No. 2234973.

Intersat Corp. v. International Telecommunications Satellite Organization, 226 USPQ 154, 156 n. 5 (TTAB 1985) ("The earliest date of first use upon which Intelsat can rely in the absence of testimony or evidence is the filing date of its application."). Inasmuch as petitioner's underlying applications for pleaded Registration Nos. 1422989, 1397206, 2091844 and 1778411 were all filed prior to the February 18, 1997 filing date of the TILE ONE application, petitioner has priority in connection with each of the marks of such registrations.

Likelihood of Confusion

Our 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 issue of likelihood of

have not considered any claim based on Registration No. 1405940.

confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We first address petitioner's contention that it has a family of marks. The Court of Appeals for the Federal Circuit has defined a family of trademarks as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. ... Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family.

J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991).

In order to create the requisite recognition of the common element of the marks or "family surname," the common

element must be so extensively advertised that the public recognizes the "family surname" as a trademark. *Reynolds & Reynolds Co. v. I.E. Systems, Inc.*, 5 USPQ2d 149, 1751 (TTAB 1987). The Board has required:

In order to establish a "family of marks," it must be demonstrated that the marks asserted to comprise its "family" or a number of them have been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark.

American Standard Inc. v. Scott & Fetzer Co., 200 USPQ 457, 461 (TTAB 1978).

Petitioner's evidence fails to establish that petitioner has created a family of "ONE" marks. First, petitioner relies heavily on various registrations for marks containing the word ONE. See brief at p. 7 ("CCA uses the above noted marks as a family of 'ONE' marks," citing only to petitioner's registrations and Mr. Wilson's testimony regarding such registrations). The mere fact that petitioner has registered many of the purported "family" members is not sufficient to prove that a family of marks exists. *Consolidated Foods Corp. v. Sherwood Industries, Inc.*, 177 USPQ 279, 282 (1973) ("the registrations, per se, are manifestly incompetent to establish the extent of use of the registered marks, whether one or more of the registered marks have been promoted, advertised, used or displayed in

any manner likely to cause an association or 'family' of marks, or that, at the least, a good number of the registrations have become known or familiar to purchasers of frozen confections and the like"). Second, petitioner's evidence does not show that the different "ONE" marks have been promoted, advertised, used or displayed together in any manner likely to cause an association among the marks or that there is a "family" of marks. Therefore, the record in this case falls short of presenting the type of evidence necessary to support an allegation of a "family" of "ONE" trademarks. Accordingly, petitioner's claim of likelihood of confusion must be based solely on its alleged individual "ONE" trademarks and not on a family of marks.

Because petitioner has asserted that its marks are famous, we next consider the *du Pont* factor regarding the fame of these marks. This factor plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. *Id.* at p. 1456. A famous mark is one "with extensive public recognition and renown." *Id.* See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

In determining whether a mark is famous, we may consider sales, advertising expenditures, and the length of time the mark has been used. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811 (TTAB 2005). This information, however, must be placed in context (e.g., a comparison of advertising figures with competitive products, market share, reputation of the product, etc.). *Bose*, 63 USPQ2d at 1309.

Petitioner maintains that "[a]s a result of the considerable sales, promotion and publicity in connection with CCA's CARPET ONE Marks [defined at p. 6 of petitioner's brief as including pleaded Registration Nos. 1422989 and 1397206⁵], as well as the long period of continued use of the Marks, CCA and the Marks have become extremely well known to the trade and purchasing public. Petitioner and its members have offered floor coverings and related goods and services throughout the country under the CARPET ONE

⁵ Petitioner has also included Registration No. 2327090 for the mark CARPET ONE for "cleaning services for carpets ..." and Registration No. 2757785 for the mark



for "cleaning services for carpets, draperies, upholstery, fabrics and furniture, water damage restoration services, cleaning and resurfacing of hard surface flooring, and duct cleaning" in its definition of "CCA's CARPET ONE Marks." Because petitioner did not plead these two registrations in its petition

marks for more than twenty-two years." Brief at p. 23. At p. 25 of its brief, petitioner concludes that "the CARPET ONE Marks ... have in fact attained a high level of fame."

We have carefully considered petitioner's evidence and arguments in support of its contention that "the CARPET ONE Marks" are famous and find that the evidence does not support petitioner's contention. First, the annual total advertising and sales figures provided by petitioner are not just for "the CARPET ONE Marks," which number two pleaded marks, but are for "the 'ONE' Family of Marks." Mr. Wilson has defined "the 'ONE' Family of Marks" as including more than ten registered marks, some of which were not pleaded and some of which are for unrelated services.⁶ See, e.g., Wilson dep. at p. 41 regarding Registration No. 2535829 for THE POWER OF ONE for "association services, namely promoting the interests of member carpet retailers." Second, petitioner has not provided the annual advertising and sales figures for goods or services for each mark, but only annual totals for "the 'ONE' Family of Marks." Because we have found earlier in this decision that petitioner has not established that its asserted marks are part of a family of marks, the annual totals provided by petitioner are of

to cancel, we do not consider them as part of petitioner's alleged family of marks.

⁶ A plaintiff may not rely on an unpleaded claim. See TBMP § 314 (2d ed. rev. 2004) and cases cited therein.

limited probative value. Third, as to the sales figures, Mr. Wilson, has testified that petitioner's members sell "soft surface flooring" such as "traditional fuzzy carpet," and hard surface flooring such as wood, engineered wood, ceramic tile and stone flooring. He adds that they may sell counter tops and laminate flooring; and that "it's approximately a 50/50 mix of [hard and soft] product that's sold in the marketplace." Thus, the record is unclear as to what goods petitioner has included within its "product purchases of the 'ONE' Family of Marks"; sales of disparate goods such as counter tops may have been included within such figures. Because the evidence is insufficient, we find that petitioner has not established that its asserted marks are famous.

Next, we turn to the *du Pont* factor regarding the similarity or dissimilarity and nature of the goods and/or services. We limit our consideration of this factor, and the remaining *du Pont* factors, to Registration No. 1422989 for the mark CARPET ONE, which is the pleaded mark most similar to respondent's mark.

The services in the CARPET ONE registration, "carpet dealer services," are broadly identified and, based on the record, include the wholesale distribution of carpets. Respondent's services are more narrowly identified as "importation and wholesale distribution of ceramic,

porcelain, granite, marble and stone tile through a network of dealers." The question, then, is whether the wholesale distribution of carpets is similar or dissimilar to the wholesale distribution of tile.

Generally, services need not be identical or even competitive to support a finding of likelihood of confusion. Rather, it is enough that the services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which would give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and the cases cited therein.

We find that these services are related. The evidence of record shows that petitioner sells both tile and carpet to retailers. See Mr. Wilson's testimony regarding (i) the CARPET ONE and the CERAMICA UNO registrations for goods and services including carpet and tile, and (ii) petitioner's sources of flooring products from manufacturers and wholesalers and sales to its members. Wilson dep. at pp. 30, 33, 34 and 39 - 40; Wilson confid. dep. at pp. 28 and 30. See also Exhibit 47A to Mr. Wilson's deposition, a

printout of various webpages from petitioner's carpetone.com website, which offers among other things CARPET ONE carpet and CERAMICA UNO tile. Petitioner's evidence establishes that a distributor may offer both carpet and tile to retailers and a retailer of flooring products may acquire carpet and tile from a common source. As a result, retailers are likely to believe that carpet dealer services and tile wholesale distribution services would emanate from a single source if they were offered under the same or similar marks. Thus, we resolve the *du Pont* factor regarding the similarity of the services in petitioner's favor.

This brings us to the *du Pont* factors regarding the classes of consumers and the established and likely to continue trade channels. Respondent's identification of services specifies that respondent, inter alia, is a wholesaler of tile through a network of dealers. Its customers, therefore would necessarily be wholesalers or retailers of tile who are part of a network of dealers. Petitioner's "carpet dealership services" is broad enough to include wholesale sales of carpet to wholesalers or retailers. Because petitioner has established that retailers of flooring products purchase carpeting and tile, consumers of petitioner's and respondent's goods are at least in part identical. We therefore resolve the *du Pont*

factors regarding the classes of consumers and similarity of the channels of trade in petitioner's favor.

Next, we consider the *du Pont* factor regarding the similarity or dissimilarity of the CARPET ONE and the TILE ONE marks. We must determine whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports*, 73 USPQ2d at 1692.

There are several similarities between these marks. Both are two word marks with an initial term which has been disclaimed and which is a descriptive term for a flooring product, followed by the word ONE. Descriptive terms which have been disclaimed are often less significant in creating a mark's commercial impression and may be given little weight in reaching a conclusion on the issue of likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *In re Code Consultants, Inc.*, 60 USPQ2d 1699 (TTAB 2001). See also, *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006). Thus, we find that the word ONE in each mark is the dominant term in each of the marks. Put another way, the fact that the marks contain different initial descriptive words does not serve to distinguish the marks. Consumers are likely to view these differences not as indications of different sources for the services, but as information about the services themselves, i.e., that CARPET

ONE dealer services involve distribution of carpet, and TILE ONE distribution services involve distribution of tile.

When we consider the marks as a whole, they are very similar. As noted, they have a similar construction (a descriptive term for flooring, followed by ONE). They also are similar in meaning, with each mark having a suggestive laudatory significance for an item of flooring. Further, due to the similarities in meaning and construction, the commercial impressions of the marks are also similar. In short, although there are specific differences in the marks, consumers would likely view the marks as variations of each other, adopted by a single entity, with the variation indicating the specific type of floor covering that is the subject of the service. We therefore resolve the *du Pont* factor regarding the similarity of the marks against respondent.

Considering and balancing all of the evidence as it pertains to the relevant *du Pont* factors, we conclude that a likelihood of confusion exists. Respondent's mark is sufficiently similar to petitioner's CARPET ONE mark in Registration No. 1422989 that use of the respective marks on respondent's similar services is likely to lead to confusion as to source, sponsorship or affiliation. A member of petitioner's cooperative desiring to sell tile could easily

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assume that petitioner is the source of respondent's tile offered through a network of dealers.

In view of our finding that there is a likelihood of confusion between petitioner's Registration No. 1422989 and respondent's mark, we need not reach the question of whether there is a likelihood of confusion between the remaining pleaded marks and respondent's mark. Also, we need not reach petitioner's pleaded claim of abandonment.

DECISION: The petition to cancel Registration No. 2234973 is sustained.