

**THIS OPINION IS NOT A
PRECEDENT OF
THE TTAB**

Mailed: March 2, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The PaperClip Club, LLC

Serial No. 77501562

Eric H. Melzer, Esq. of Greenbaum, Rowe, Smith & Davis LLP
for The PaperClip Club, LLC.

Kathleen M. Vanston, Trademark Examining Attorney, Law
Office 107 (J. Leslie Bishop, Managing Attorney).

Before Hairston, Cataldo and Taylor, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

The PaperClip Club, LLC filed an application to
register the mark PAPERCLIP CLUB, as shown below,

The logo for Paperclip Club features the word "Paperclip" in a white, rounded, sans-serif font with a black outline, and the word "Club" in a bold, red, sans-serif font with a black outline. The two words are positioned side-by-side.

Serial No. 77501562

for services ultimately identified as "on-line wholesale and retail store services featuring office and home office supplies" in International Class 35.¹

The trademark examining attorney refused to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with applicant's services, so resembles the previously registered mark PAPERCLIP for "office and residential furniture,"² as to be likely to cause confusion.³

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs.

Before turning to the substantive merits of the appeal, an evidentiary issue requires our attention.

¹ Application Serial No. 77501562, filed on June 18, 2008, asserting first use and first use in commerce on October 31, 2006. The application contains the following description of the mark: "The mark consists of in one straight line spelled out to say PaperclipClub: the word 'Paper' in white letters with a black outline, a red letter 'c' with a black outline, a white paperclip in the place of the letter 'l' with a black background, the letters 'i', 'p' and 'C' in red with a black outline, a white paperclip in the place of the letter 'l' with a black background, and the letters 'u' and 'b' in red with a black outline." In addition, the application states: "The color(s) white, black, and red is/are claimed as a feature of the mark."

² Registration No. 2415886, issued on December 26, 2000; Sections 8 and 15 affidavits accepted and acknowledged, respectively.

³ The examining attorney also cited another registration owned by a different entity, Registration No. 2711217, as a basis for the refusal under Section 2(d). However, we note that this registration was cancelled under Section 8 of the Trademark Act on December 5, 2009. Thus, the refusal is moot as to this registration.

Serial No. 77501562

Applicant submitted evidence with its appeal brief, and the examining attorney has objected thereto on the basis of its untimely submission.

As pointed out by the examining attorney, the record in an application should be complete prior to the filing of an appeal. Trademark Rule 2.142(d). Accordingly, exhibits attached to a brief that were not made of record during examination are untimely, and will not be considered. *TBMP* §§1203.02(e) and 1207.01 (2d ed. rev. 2004). In view thereof, the examining attorney's objection is sustained and the attachments have not been considered.

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 bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). 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 re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods

and services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We turn first to a comparison of the marks, i.e., whether the respective marks are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, supra*. The test 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 and services offered under the respective marks is likely to result. The focus is on the average purchaser, who normally retains a general rather than specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Furthermore, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ["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 a consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.”]

In this case, applicant’s mark PAPERCLIP CLUB and design incorporates in its entirety registrant’s mark PAPERCLIP as its most distinctive and dominant feature. Neither the addition of the term CLUB nor the design offer sufficient distinctiveness to create a different commercial impression. The term CLUB is descriptive of applicant’s services as applicant indicates on its Internet homepage that its services are membership club services.⁴ Furthermore, the design of applicant’s mark is not so unique as to distinguish applicant’s mark from registrant’s mark. The paperclips in the place of the letter “l” in “clip” and “club” simply reinforce the term PAPERCLIP in applicant’s mark.

We find that due to the shared term PAPERCLIP, applicant’s mark PAPERCLIP CLUB and design is highly similar to registrant’s mark PAPERCLIP in sound, appearance and connotation.

⁴ A printout of applicant’s Internet homepage was submitted by the examining attorney with her office action dated September 25, 2008.

Although we have focused on the dominant portion of applicant's mark, which is identical to registrant's mark, we have considered the marks in their entireties. And, in doing so, we find that they engender similar overall commercial impressions.

We next turn to the issue of the similarity of applicant's and registrant's respective goods and services. The examining attorney argues that office and home office supplies encompass office furniture and, therefore, registrant's office furniture, on the one hand, and applicant's on-line wholesale and retail store services featuring office and home offices supplies, on the other, are related. Furthermore, the examining attorney points to applicant's Internet homepage which shows that applicant does sell office furniture.

Applicant, on the other hand, argues that the key element of its services is office and home office supplies which do not have anything to do with office furniture. In addition, applicant argues that the purchasers of its on-line wholesale and retail store services and registrant's office furniture are sophisticated.

It is not necessary that the respective goods and services be competitive, or even that they move in the same channels of trade to support a holding of likelihood of

confusion. Rather, it is sufficient that the respective goods and services are related in some manner, and/or that the conditions and activities surrounding their marketing 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 originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978). In addition, it is well recognized that confusion is likely to result from the use of the same or similar mark for goods, on the one hand, and for services involving those goods, on the other hand.

Applying these principles to the present case, we find that the examining attorney has failed to establish that applicant's services and registrant's goods are similar or related in any way which would result in source confusion, even when marketed under similar marks. Although the examining attorney contends that office furniture is encompassed within office and home office supplies, there is no evidence to support this contention. In particular, there is no evidence that purchasers understand or refer to office furniture such as desks, chairs, and bookcases as office supplies. Indeed, applicant's Internet homepage

Serial No. 77501562

suggests otherwise inasmuch as there are separate category headings for office supplies, on the one hand, and office furniture, on the other, e.g., "Binders & Binding Supplies," "Files & Filing Supplies," and "Furniture & Room Accessories." Thus, the principle that confusion is likely to result from the use of the same or similar mark for goods, on the one hand, and for services involving those goods, on the other, is not applicable in this case.

Furthermore, the mere fact that office furniture is one of the many products applicant sells is insufficient to show that applicant's identified services and registrant's goods are related. There is no evidence that applicant's services and registrant's goods are of a type which may emanate from a single source, and consumers are not likely to believe that on-line wholesalers and retailers of office and home office supplies also manufacture office and residential furniture. In short, there is no evidence from which we may conclude that applicant's services and registrant's goods are sufficiently related to give rise to a likelihood of confusion.

The examining attorney bears the burden of presenting evidence to support her refusal. Where, as in this case, the respective goods and services, on their face, do not appear to be sufficiently related, it is incumbent on the

examining attorney to present evidence establishing such relationship. Mere argument and conclusory assertions do not suffice.

In reaching our decision, we should point out that we have not relied on applicant's contention that the purchasers of its services and registrant's goods are sophisticated. It is well settled that in the absence of any limitations in the identifications of goods and services in the application and cited registration, we must presume that applicant's services and registrant's goods are purchased by all the normal classes of purchasers. Purchasers of on-line wholesale and retail store services featuring office and home office supplies and office and residential furniture comprise a broad market consisting of both discriminating and ordinary consumers who would not be expected to exercise more than ordinary care in making their purchases.

In sum, we find that there is no likelihood of confusion. On this record, applicant's services and registrant's goods do not appear to be sufficiently related for any confusion to be likely, even when marketed under similar marks. We might reach a different conclusion on a different, more complete evidentiary record, but on this record, we cannot find that confusion is likely.

Serial No. 77501562

Decision: The refusal to register is reversed.