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Subject: U.S. TRADEMARK APPLICATION NO. 77821763 - J WARREN - 34832 -  
EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 77821763

**MARK:** J WARREN



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** Parke-Bell Ltd., Inc.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

34832

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## EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed from the Trademark Examining Attorney's final refusal, pursuant to Section 2(d) of the Trademark Act, to register the mark "J WARREN" (standard characters) for "WORKS OF ART, NAMELY, SCULPTURES" (Class 6) and "HOME DÉCOR AND FURNITURE, NAMELY, BEDROOM FURNITURE, TABLES, CHAIRS AND HOME FURNISHINGS" (Class 20). Registration No. 3,556,276 (the nearly identical mark "J. WARREN", also in standard characters, for "PHOTOGRAPHS") has been cited as a bar to the registration of the applicant's mark.

## FACTS

Final refusal of registration, pursuant to Section 2(d) of the Trademark Act, was issued March 12, 2010 upon consideration of: 1.) the substantially identical overall commercial impression created by the respective marks; 2.) the close relationship of registrant's computer goods and computer-related retail services to the applicant's computer software; and 3.) the certainty that applicant's goods and registrant's goods/services will be

contemporaneously encountered within identical channels of trade. Following review of a request for reconsideration, the final refusal of registration was adhered to in an Office Action issued on May 10, 1999.

Applicant has traversed the refusal by arguing principally that the respective goods are unrelated, are offered through disparate trade channels and that consumer care and sophistication obviates likelihood of confusion.

## **ARGUMENT**

### **I.) APPLICANT'S MARK IS ESSENTIALLY IDENTICAL TO THE PREVIOUSLY-REGISTERED MARK IN OVERALL COMMERCIAL IMPRESSION.**

It is respectfully submitted that the marks involved herein, “J WARREN” AND “J. WARREN”, are legally identical. The presence of a period following the leading initial in the registered mark is the sole difference. Both will undoubtedly be perceived by potential consumers as the name of a certain individual in abbreviated format.

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980); TMEP §1207.01(b).

Accordingly, extensive discussion of this factor is respectfully deemed to be unnecessary. However, it is noted that in cases such as this, where the marks of the respective parties are identical or virtually identical, there need be only a viable relationship between the relevant goods and/or services to support a finding of likelihood of confusion. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009); *In re Wilson*, 57 USPQ2d 1863, 1867 (TTAB

2001); *see also In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

**II.) THE RESPECTIVE GOODS ARE RELATED, COMPLEMENTARY AND MOVE WITHIN THE SAME TRADE CHANNELS.**

As noted, particularly in cases where the marks are nearly identical, the goods of the parties need not be identical or even directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that they come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

In this instance, the respective goods are deemed to be closely-related, complementary products which may be employed by a single consumer in creating a particular style or theme of overall home décor. Clearly, art objects and furnishings, such as offered by the applicant, may be utilized along with photographs featuring the same or related theme, such as sports or outdoors, for example, in developing a consistent decorating scheme for a particular room or even a complete building.

Moreover, as established during prosecution, the respective goods are commonly offered under the same marks by a single source, such that prospective consumers are likely to be conditioned to expect a source connection. Attention is directed to copies of printouts from the USPTO X-Search database, as attached to the Final Office Action issued on March 12, 2010, which show third-party registrations of marks used in connection with the same or similar goods services as those of applicant and registrant in this case. These printouts have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely sculptures, art objects, photographs and furniture/furnishings, are of a kind that may emanate from a single source. *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

**III.) THE RESPECTIVE GOODS AND SERVICES MUST BE PRESUMED TO MOVE WITHIN IDENTICAL TRADE CHANNELS.**

In performing the likelihood of confusion analysis in an *ex parte* case, the comparison of the parties' goods is based solely on the goods as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); see TMEP §1207.01(a)(iii).

In this case, the identification set forth in the cited registration uses broad wording to describe registrant's goods and does not contain any limitations as to nature, type, channels of trade or classes of purchasers. Similarly, this application contains neither specific limitations nor restrictions. Therefore, it must be presumed that both the application and the cited registration encompasses all goods of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. See *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638-39 (TTAB 2009); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii).

For this reason, applicant's various implied efforts to characterize either its goods or registrant's goods in a specific manner, or to assert that the respective goods move in disparate trade channels and/or that they would appeal only to certain specific consumers, are entitled to no consideration, as these arguments lack any semblance of support within the wording of the respective identifications. For example, the respective identifications provide absolutely no support for applicant's contentions that applicant's goods are "high-end" décor items appealing only to "sophisticated" consumers or that registrant's goods are limited to sporting event photos appealing only to casual purchasers. Applicant's goods identification clearly encompasses inexpensive items suitable for impulse purchase, just as registrant's identification encompasses large art photo prints suitable for inclusion in a "high-end" décor by "sophisticated" consumers.

**IV.) APPLICANT'S ARGUMENTS IN SUPPORT OF REGISTRATION ARE UNPERSUASIVE.**

To the extent that they have not been expressly considered in the previous discussion, applicant's additional arguments in support of registration fail to indicate that confusion is unlikely.

Applicant's argument that the respective marks should be viewed as dissimilar since they are presented differently in actual use is unpersuasive. Both marks involved here are in Standard Character format. A mark in standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element itself and not in any particular display. TMEP §1207.01(c)(iii); *see* 37 C.F.R. §2.52(a). *See, e.g., In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). Accordingly, applicant's argument that the specimens of use submitted in the respective cases indicates a different manner of presentation is simply immaterial.

Applicant's effort to discredit the evidence pertaining to contemporaneous marketing of the respective goods under the same mark by a single source attempting to characterize this evidence as establishing only that large retail establishments offer a wide range unrelated goods is also unpersuasive. The submitted registrations covering all of the goods involved herein are a type of evidence recognized as having probative value to the extent that they serve to suggest that the goods listed therein may emanate from a single source. *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). In this regard, it is noted that many of the referenced registrations are not owned by "large retail establishments", but are, in fact, owned by individuals. Others appear to reflect the wares of home décor specialty retailers offering a "signature" line of related, complementary home décor items. This evidence is, respectfully, deemed quite pertinent to the instant case.

Applicant's attempt to distinguish the respective goods by noting that they fall into different International Classes is unpersuasive. The fact that the Office classifies goods in different classes does not establish that they are unrelated under Trademark Act Section 2(d). *See* TMEP §1207.01(d)(v). The determination concerning the proper classification of goods or services is a purely administrative determination unrelated to the determination of likelihood of confusion. *Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971,

975, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993); *Nat'l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990).

Finally, applicant's assertions alleging consumer sophistication are, respectfully, without any foundation. There are no stated limitations in applicant's goods identification which limit the marketing of the goods only to "skilled decorators" and/or other "sophisticated" consumers. Moreover, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see In re Cynosure, Inc.*, 90 USPQ2d 1644 (TTAB 2009); *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

### **CONCLUSION**

For the foregoing reasons, it is respectfully urged that the refusal, pursuant to Section 2(d) of the Trademark Act, to register applicant's mark on the ground that it so resembles Registration No. 3,556,276, for the respective marks "J WARREN" and "J. WARREN", as to be likely to cause confusion or mistake, is proper and should be affirmed.

Respectfully submitted,

/David H. Stine/

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