

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Mailed: March 25, 2011

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Parke-Bell Ltd., Inc.

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Serial No. 77821763

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John H. Pearson, Jr. and Daniel J. Mansur of Pearson & Pearson, LLP for Parke-Bell Ltd., Inc.

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Before Walters, Cataldo and Ritchie,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Parke-Bell Ltd., Inc., filed an application to register the mark J WARREN in standard characters on the Principal Register for the following goods: "works of art, namely, sculptures" in International Class 6; and "home décor and furniture, namely, bedroom furniture, tables, chairs and home furnishings" in International Class 20.<sup>1</sup>

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<sup>1</sup> Application Serial No. 77821763 was filed September 8, 2009, based upon applicant's assertion of July 1, 2008 as a date of first use of the mark anywhere and in commerce in connection with both classes of goods. The application contains the following statement: "The name(s), portrait(s), and/or signature(s) shown

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as used in connection with its goods, so resembles the mark J. WARREN, previously registered on the Principal Register standard characters for "photographs" in International Class 16,<sup>2</sup> as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs on the issue under appeal.<sup>3</sup>

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 set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between

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in the mark identifies Jason Warren Bartley, whose consent(s) to register is made of record."

<sup>2</sup> Registration No. 3556276 issued January 6, 2007. The registration contains the following statement: "The name(s), portrait(s), and/or signature(s) shown in the mark identifies J. Warren Emerson, whose consent(s) to register is made of record."

<sup>3</sup> In his final Office action, the examining attorney also made final certain requirements relating to the identification of goods in Classes 6 and 20 and the sufficiency of the specimen of use for the goods recited in Class 20, but did not discuss these requirements in his brief. Accordingly, they are deemed waived.

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the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 27 (CCPA 1976). *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

The Marks

We first consider the similarity of the marks. Applicant's mark J WARREN is substantially identical to the cited mark, J. WARREN, in appearance and sound. The sole difference between the marks is the presence of a period in registrant's mark. The period, used as punctuation to indicate that the letter J is an initial, has no meaningful impact visually, aurally or as to commercial impression, and fails to distinguish J WARREN from J. WARREN. *See, for example, In re Burlington Industries, Inc.* 196 USPQ 718, 719 (TTAB 1977) ("An exclamation point does not serve to identify the source of the goods"); and *Goodyear Tire & Rubber Co. v. Dayco Corp.*, 201 USPQ 485, 488 n.4 (TTAB 1978) (FAST-FINDER with hyphen is in legal contemplation substantially identical to FASTFINDER without hyphen).

Further, both applicant's mark and registrant's mark are presented in standard character form. Marks appearing in typed or standard characters may be displayed in any reasonable stylization, font, color and size. *See Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ

35 (CCPA 1971) [a mark in typed or standard character form is not limited to the depiction thereof in any special form]; *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585 (TTAB 1992) ["[a]s the *Phillips Petroleum* case makes clear, when [an] applicant seeks [or a registrant has] a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which ... [the word mark] could be depicted"]; and TMEP §807.03. Thus, we are not persuaded by applicant's argument that "the cited owner uses the mark in block letters stamped on the front of a photograph. In contrast, the Appellant's mark appears as a signature on the goods."<sup>4</sup> As discussed above, because both applicant and registrant present their marks in standard characters, registrant's mark may be displayed in a stylized manner that is identical to a stylization adopted by applicant.

We further find that on the facts before us, and in the absence of any evidence to the contrary, the mark J. WARREN is a strong mark, and as such is entitled to a broad scope of protection.

#### The Goods

We next turn to a consideration of the goods. We note, at the outset of considering this *du Pont* factor,

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<sup>4</sup> Applicant's brief, p. 10-11.

that the greater the degree of similarity between applicant's mark and the cited registered mark, the lesser the degree of similarity between applicant's goods and registrant's goods that is required to support a finding of likelihood of confusion. See *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). If the marks are substantially identical, as in this case, it is only necessary that there be a viable relationship between the goods in order to support a finding of likelihood of confusion. See *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

Furthermore, it is not necessary that the goods at issue be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods 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 originate from the same producer. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, the examining attorney has made of record a substantial number of use-based third-party registrations which show that various entities have adopted a single mark for goods of the type that are identified in both applicant's application and the cited registration.

The following examples are illustrative:

Registration No. 2878415 for, *inter alia*, photographs and furniture, namely, tables, chairs; sculptures and statues made of wood or plastic;

Registration No. 3043170 for, *inter alia*, home furnishings, namely, furniture, and photographs;

Registration No. 3713958 for, *inter alia*, photographs, home furnishings, namely, furniture, artwork, namely, sculptures of bone, ivory, plastic, plaster, wax and wood, and wrought iron decorative artwork;

Registration No. 3728416 for, *inter alia*, non-precious metal sculptures and photographic prints; and

Registration No. 3548178 for, *inter alia*, photographs, and furniture;

Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993). In this case, the evidence of record suggests that applicant's and registrant's goods are related furnishings

and decorations that may emanate from a common source. As a result, we find that the goods are related such that consumers could, because of the substantially identical nature of the marks, mistakenly believe that they originate from the same source.

Channels of Trade

We are not persuaded by applicant's argument that its "high end home furnishings,"<sup>5</sup> are "purchased by skilled decorators [and] are not related to Registrant's photographs purchased by consumers that want sports related photographs in such places as sports bars or the rooms of sports enthusiasts."<sup>6</sup> It is settled that in making our determination regarding the relatedness of the parties' goods, we must look to the goods as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers 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

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<sup>5</sup> Id. at 4.

<sup>6</sup> Id.

channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.")

Because there are no trade channel restrictions recited in either the involved application or cited registration, the goods identified therein are presumed to move in all normal channels of trade and be available to all classes of potential consumers. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Therefore, in this case, we must presume that the same consumers would purchase both applicant's and registrant's goods and that they would be sold in the same channels of trade.

Sophistication of Purchasers and Conditions of Sale

Applicant's unsupported argument that its goods would be purchased by sophisticated consumers is not persuasive. There is nothing in the identification of goods to indicate that these are purely expensive products purchased only by consumers with specialized knowledge. However, even assuming the identification inherently conveys this meaning, there is nothing in the record to support a finding that the goods and purchasing process are of such a

nature that purchasers could distinguish substantially identical marks for related goods. *Cf., e.g., Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992) (record confirms that opposer's services are expensive and are purchased only by experienced corporate officials after significant study and contractual negotiation and that the evaluation process used in selecting applicant's products requires significant knowledge and scrutiny). As is frequently stated, even if consumers are knowledgeable in a particular field that does not necessarily mean that they are immune from source confusion. *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

Third Party Use

In its brief, applicant argues that third party registration of an unrelated mark (INTELLISENSE) by a number of different entities to identify various goods that are not related to the goods at issue herein weighs against a finding of likelihood of confusion.

We begin by noting that "third-party registrations relied upon by applicant cannot justify the registration of another confusingly similar mark." *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987), quoting *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB

1983). These "registrations are not evidence of use of the marks shown therein. Thus, they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of similar marks in the marketplace, and as a result are able to distinguish between the JUMP marks based on slight differences between them." *In re Jump Designs LLC*, 80 USPQ2d 1370, 1375 (TTAB 2006).

Moreover, and as noted above, the INTELLISENSE mark in the four third-party registrations is wholly unlike the marks in the involved application or cited registration and identifies goods that are wholly unrelated to the goods at issue herein. As a result, this evidence has little, if any, probative value to our determination herein.

Summary

In summary, weighing all of the evidence of record as it pertains to the relevant *du Pont* factors, including those not specifically addressed in this decision, we find that a likelihood of confusion exists. Moreover, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025

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(Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal of registration is affirmed.