

THIS DECISION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: June 21, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Restoration Hardware, Inc.

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Serial No. 85064187

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Mark A. Steiner, Duane Morris LLP, for Restoration  
Hardware, Inc.

Giselle M. Agosto, Trademark Examining Attorney, Law Office  
102 (Karen M. Strzyz, Managing Attorney).

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Before Kuhlke, Ritchie and Wolfson, Administrative  
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Restoration Hardware, Inc., applicant, filed an  
application to register the mark MAXWELL in standard  
characters for goods ultimately identified as "leather  
furniture, namely, chairs, loveseats, couches, sofas,  
sleeper sofas, ottomans, chaise lounges" in International  
Class 20.<sup>1</sup>

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<sup>1</sup> Application Serial No. 85064187, filed on June 16, 2010,  
alleging first use and first use in commerce in 2005 under  
Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a).

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Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used on its identified goods, so resemble each of the two registered marks as to be likely to cause confusion, mistake or deception. The two registered marks are MAXWELL<sup>2</sup> in typed form for "fabric products; namely drapery fabric, upholstery fabric, quilted bedspreads, bedskirts, pillow cases, pillow shams, coverlets and duvet covers," in International Class 24, and MAXWELL HOME & GARDEN<sup>3</sup> in standard characters for "fabrics for the manufacture of indoor and outdoor furniture upholstery; fabrics for the manufacture of furniture accessories, namely, furniture and chair covers, throws, cushions and cushion covers; fabrics for the manufacture of wall coverings, namely, fabric wall tiles, wall accessories, namely, bedspreads, coverlets, duvet and futon covers, comforters, bed covers, bed skirts, pillows and pillow covers, pillow cases and pillow shams; fabrics for the manufacture of table cloths" in International Class 24. Maxwell Fabrics Ltd. is the listed owner of both of the registrations.

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<sup>2</sup> Registration No. 1829457, issued on April 5, 1994, Section 8 and 15 declaration accepted and acknowledged, renewed.

<sup>3</sup> Registration No. 3523276, issued on October 28, 2008.

When the refusals were made final, applicant appealed and briefs have been filed.

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 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We begin with the du Pont factor of the similarity of the marks, i.e., whether applicant's mark MAXWELL and registrant's marks MAXWELL and MAXWELL HOME & GARDEN are similar or dissimilar when compared in their entirety in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

Applicant's mark MAXWELL is identical to the mark MAXWELL in Registration No. 1829457. With regard to the mark MAXWELL HOME & GARDEN in Registration No. 3523276, it

is well settled that marks must be considered in their entirety, not dissected or split into component parts and each part compared with other parts. It is the impression created by the involved marks, each considered as a whole, that is important. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). However, “[t]hat a particular feature is descriptive [or otherwise lacking in distinctiveness] ... with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark...” In re *National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). We find that the dominant portion of this mark is the term MAXWELL inasmuch as it is the first word in the mark and the phrase HOME & GARDEN is suggestive of the purpose of the goods. *Palm Bay*, 73 USPQ2d at 1692. The evidence of record supports the suggestive nature of the terms HOME and GARDEN. See, e.g., website printouts showing “Home” and “Outdoor & Garden” used as category headings for certain types of furniture products attached to June 2, 2011 Office Action.<sup>4</sup> Applicant argues that “it

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<sup>4</sup> The examining attorney also attached the printout of the search results for the searches “home furniture” and “garden furniture” from the Google search engine. These excerpts do show use of the terms in connection with describing a category of furniture but they are of limited probative value. In re *Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (“Search engine results-which provide little context to

would be unreasonable to assume that consumers will believe that the phrase "HOME & GARDEN" describes a feature of Applicant-Appellant's leather furniture [because] [t]here is no evidence in the record that supports the idea that consumers would believe that leather furniture is appropriate for use in a garden." Br. p. 7. However, it is not unreasonable to believe the word "HOME" suggests the products sold under MAXWELL are for home or residential use as opposed to commercial use. While the phrase "HOME & GARDEN" embraces more expansive residential uses both in and outside of the house, it still suggests residential use. In view thereof, applicant's mark is identical to the dominant portion of registrant's mark MAXWELL HOME & GARDEN.

Viewing the marks in their entirety, applicant's mark is identical to one and very similar in sound, appearance, connotation and commercial impression to the other of the registrant's marks.

Applicant argues under the sixth du Pont factor that the term MAXWELL is weak in this field and relies on

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discern how a term is actually used on the webpage that can be accessed through the search result link - may be insufficient to determine the nature of the use of a term or the relevance of the search results to registration considerations.") See also *In re Remacle*, 66 USPQ2d 1222, n. 2 (TTAB 2002).

third-party registrations in support of this contention.<sup>5</sup> First, it is well-settled that third-party registrations are not evidence of third-party use of the registered marks in the marketplace, for purposes of the sixth du Pont factor. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198 (TTAB 2009). In addition, there are only two referenced third-party registrations, one of which has other distinguishing elements (Reg. No. 34021225 MAXWELL & WILLIAMS) and the other is for different goods (Reg. No. 2524374 MAXWELL for beds).<sup>6</sup>

Applicant also relies on third-party registrations<sup>7</sup> for other marks to suggest that it is common in this industry

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<sup>5</sup> The examining attorney's objection to applicant's reference to these registrations is denied inasmuch as she did not advise the applicant during prosecution that the reference was insufficient and addressed the third-party registrations on their merits. In *re Boyd Gaming Corp.*, 57 USPQ2d 1944, 1945 n.4 (TTAB 2000). While these references were provided in a request for reconsideration, it was filed long prior to the deadline for filing the appeal and the examining attorney denied the request for reconsideration also prior to the expiration of the appeal period, thus permitting applicant an opportunity to add to the record of the application. See *In re 1<sup>st</sup> USA Realty Professionals, Inc.*, 84 USPQ2d 1581 (TTAB 2007).

<sup>6</sup> The third-party application for the mark MAXWELL THOMAS is of no probative value. *Glamorene Products Corp. v. Earl Grissmer Co., Inc.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (evidence only of the filing of the application).

<sup>7</sup> As noted above, the examples consisting of pending applications are not probative.

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(furniture and fabrics) for similar marks to coexist, presumably to support the idea that consumers are accustomed to distinguishing source among close marks in this industry. The evidence does not support such a proposition. Applicant proffers four examples with no information as to the actual goods and the involved marks have distinguishing elements.

We turn to the du Pont factor of the relatedness of the goods, keeping in mind, at least as to the mark MAXWELL in Registration No. 1829457, that where the marks are "identical the degree of relatedness between the respective goods that is necessary to support a finding that the goods are related under the second du Pont factor is less than it would be if the marks were not identical; there need be only a viable relationship between the respective goods." Davey Products, 92 USPQ2d at 1202.

The examining attorney contends that applicant's leather furniture goods are related to registrant's fabric products arguing that "conditions in commerce illustrate that the same entity can be the source of both Class 20 furniture items, such as leather furniture, sofas, chairs, loveseats, and the source of Class 24 fabrics and fabric products, such as bedspreads, bed skirts, pillow cases, pillow shams, coverlets and duvet covers." Br. p. 13. In

support of her position, the examining attorney submitted several third-party used-based<sup>8</sup> registrations that show furniture and fabric (both as a retail product and for further manufacture into other products) under the same mark. These third-party registrations may serve to show that the goods of the parties are of a kind that may emanate from a single source under a single mark. In re Albert Trostel & Sons Co., 29 USPQ2d 183, 1785-86 (TTAB 1993). See, e.g., Reg. No. 1593063 for the mark George Smith for upholstery fabric and living room type furniture; Reg. No. 3445883 for the mark SOMERSET BAY THE COLORS OF A LIFE WELL LIVED for upholstery fabrics and furniture; Reg. No. 3425465 for the mark THOM HOME for, inter alia, furniture and upholstery fabrics, fabrics for the manufacture of furniture, pillows, cushions, and window coverings; Reg. No. 3742763 for the mark NATURALMAT for, inter alia, furniture and bed linen, bedspreads, quilted linen fabric; Reg. No. 3714921 for the mark KASHMIRA for furniture and furnishing and upholstery fabrics; Reg. No. 3820630 for the mark MARIETTE HIMES GOMEZ for, inter alia, sofas, chaise lounges and ottomans, and upholstery fabrics;

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<sup>8</sup> The non use-based registrations (i.e., based on Sections 44 or 66 of the Trademark Act), do not have probative value. In addition, Registration No. 3055992, from which furniture has been deleted from the identification of goods, is of no probative value.



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Reg. No. 3905438 for the mark LUXURY FOR LIFE for, inter alia, furniture for house, office and garden and fabrics for textile use, furnishing and upholstery fabrics, textile fabrics for home and commercial interiors; Reg. No. 2855052 for the mark A BEAUTIFUL EXPERIENCE for, inter alia, living room furniture, sofas, couches, and upholstery fabrics and drapery fabrics, drapery and bedcoverings, fabric trim for furniture and drapery; Reg. No. 3046554 for the mark OSCAR DE LA RENTA for furniture and fabrics, namely, upholstery fabrics, fabrics for the manufacture of bed sheets, bed blankets, bed spreads and table linens; Reg. No. 3598499 for the mark JEFF BURTON for, inter alia, leather furniture and bedding sets consisting of sheets, pillow cases, pillow shams, comforters, and dust ruffles; and Reg. No. 3324621 for the mark VICENTE WOLF for, inter alia, upholstered and leather furniture and bed skirts, duvet covers, pillowcases, cotton fabric, linen, and spun silk fabrics for use in the designer fabric collections, textile fabrics for the manufacture of home and commercial interiors. In addition, the examining attorney submitted printouts from websites of third-parties showing furniture and fabric or bedding (e.g., duvets) for sale under the same mark. See, e.g., June 2, 2011 Office Action, [www.boconcept.us](http://www.boconcept.us); [www.karvet.com](http://www.karvet.com); [www.michaelsmithinc.com](http://www.michaelsmithinc.com).

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The examining attorney contends that the goods are complementary and the record shows that the goods in issue are "used together or otherwise purchased by the same purchasers for the same or related purposes." Br. p. 20.

Applicant argues that it "would be incorrect to conclude that fabric, which is commonly sold in bolts, and ready-made leather furniture are complementary goods the consumer may purchase together or use together which leads to source confusion." Br. p. 14.

With regard to the goods in Registration No. 1829457 namely, "fabric products; namely drapery fabric, upholstery fabric, quilted bedspreads, bedskirts, pillow cases, pillow shams, coverlets and duvet covers," this identification encompasses both fabric and finished products made from fabric sold at the retail level. The record shows that such goods frequently emanate from the same source as applicant's furniture products, even as limited to leather furniture. See, e.g., Registration Nos. 3324621 and Registration No. 3598499. Thus, we find applicant's goods to be sufficiently related to registrant's goods.

We further find that the record demonstrates such goods travel through the same channels of trade. As to applicant's arguments regarding applicant's and registrant's actual trade channels and classes of

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purchasers for this registration, i.e., that applicant only sells its furniture at the retail level and registrant only sells fabric at the wholesale level to sophisticated purchasers, those arguments are inapposite. Applicant's application is not limited to retail sales and, therefore, includes the wholesale trade channel. In addition, the identification in this registration is not limited to the wholesale market and includes finished products such as duvet covers; therefore, we must consider both retail and wholesale channels of trade for these goods.

In addition, because of the absence of such limitations we must consider all potential purchasers for such goods and we must make our determination based on the least sophisticated purchaser, i.e., the general public.

With regard to Registration No. 3523276, as identified, each item in the identification is limited by the phrase "for the manufacture of." We recognize the record contains a handful of examples of third-party registrations that include "fabric for the manufacture of" along with other finished products; however, we do not find this a sufficient basis upon which to find that an ordinary channel of trade for fabric for further manufacture would include the retail trade channel. Thus, we find that registrant's goods in this registration are limited by

trade channel. As such, the only overlapping customers would be more sophisticated (for example, as applicant argues, accredited interior designers) than the average purchaser of furniture. However, given the close similarity of the marks and relationship between the respective goods, we do not believe this factor outweighs the other du Pont factors. This case does not present circumstances similar to those wherein sophisticated purchasing outweighs the other factors. See, e.g., Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp., 954 F.2d 713, 21 USPQ2d 1388, 1402 (Fed. Cir. 1992). Purchasers of registrant's upholstery fabric and fabrics for other furniture accessories (pillows, covers, etc.), in designing the interior of a room could reasonably believe that applicant's leather furniture belongs to that furnishings product line and emanates from or is otherwise associated with registrant.

In view of the above, the du Pont factors of the similarity of the goods, the channels of trade, and classes of purchasers favor a finding of likelihood of confusion as to the cited registrations.

Applicant also argues that its mark has been in use since 2005 and there are no known instances of actual confusion. First, the inquiry here is likelihood of

confusion, not actual confusion. HRL Associates Inc. v. Weiss Associates Inc., 12 USPQ2d 1819, 1824 (TTAB 1989) aff'd, 14 USPQ2d 1840 (Fed. Cir. 1990). The Court of Appeals for the Federal Circuit has observed, "A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, J.C. Hall Co. v. Hallmark Cards, Inc., 340 F.2d 960, 964, 144 USPQ 435, 438 (CCPA 1965), especially in an ex parte context." In re Majestic Distilling Co., Inc., 65 USPQ2d at 1205. Thus, regardless of the evidence, an ex parte proceeding is ill-equipped for a fair determination inasmuch as the registrant does not have an opportunity to defend its registration.

Further, based on applicant's statements that the registrant and applicant do not offer their goods in the same trade channels, it appears that there has not been a meaningful opportunity for confusion to occur.

In balancing the relevant du Pont factors in this case, we find that because the marks are identical and very similar, the goods are related, the channels of trade and the classes of consumers overlap, confusion is likely between applicant's mark and the marks in the cited

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registrations. To the extent there are any doubts, we resolve them, as we must, in favor of the registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

**Decision:** The refusal to register under Section 2(d) of the Trademark Act is affirmed as to both cited registrations.