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Subject: U.S. TRADEMARK APPLICATION NO. 85627379 - H HUGHES FURNITURE MOTION EAZE - N/A - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**U.S. APPLICATION SERIAL NO.** 85627379

**MARK:** H HUGHES FURNITURE MOTION EAZE



**CORRESPONDENT ADDRESS:**

ALAN B FELTS

TUGGLE DUGGINS PA

100 N GREENE ST STE 600

GREENSBORO, NC 27401-2546

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** Hughes Furniture Industries, Inc.

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

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

afelts@tuggleduggins.com

## **EXAMINING ATTORNEY'S APPEAL BRIEF**

The Applicant has appealed the Trademark Examining Attorney's Final Refusal to register the mark "H HUGHES FURNITURE MOTION EAZE RECLINERS" and design for use on "furniture" on the grounds of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. 1052(d).

## I. FACTS

The Applicant applied for registration on the Principal Register of the trademark “H HUGHES FURNITURE MOTION EAZE RECLINERS” and design for use on “furniture.”

In the first Office action, the Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act based on a likelihood of confusion with U.S. Registration No. 3916977 for the mark “BRADLEY HUGHES” in standard character form for use on “residential and commercial furniture.” The Trademark Examining Attorney also requested that the Applicant insert a disclaimer of “FURNITURE” and “MOTION” and “RECLINERS” apart from the mark as shown.

The Applicant responded by submitting arguments and evidence in support of withdrawing the likelihood of confusion refusal and a partial disclaimer. In response thereto, the Trademark Examining Attorney issued a Final Refusal on the likelihood of confusion issue and the disclaimer requirement.

After the Trademark Examining Attorney’s Final Refusal on the likelihood of confusion issue and disclaimer requirement, the Applicant submitted a Request for Reconsideration and a Notice of Appeal. The Applicant’s Request for Reconsideration was in the form of an Appeal Brief. Therein, the Applicant maintained its argument as to the absence of a likelihood of confusion and satisfactorily complied with the disclaimer requirement. This Appeal follows the Trademark Examining Attorney’s Denial of the Request for Reconsideration on the likelihood of confusion issue.

## II. ARGUMENT

**THE MARKS OF THE APPLICANT AND THE REGISTRANT ARE CONFUSINGLY SIMILAR IN APPEARANCE, SOUND, AND OVERALL COMMERCIAL IMPRESSION AND THE GOODS OF THE PARTIES ARE CLOSELY RELATED AND TRAVEL IN THE SAME CHANNELS OF TRADE SUCH THAT THERE EXISTS A LIKELIHOOD**

**OF CONFUSION, MISTAKE OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT AS TO THE SOURCE OF THE GOODS.**

The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the listed *DuPont* factors may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are most relevant: similarity of the marks, similarity of the goods, and similarity of the channels of trade. The other *DuPont* factors cannot be considered because no relevant evidence concerning those factors, beyond mere conjecture, is contained in the record. See *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984).

Any doubt as to the issue of likelihood of confusion must be resolved in favor of the Registrant and against the Applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

In this case, the Applicant makes the following principal arguments: (1) the marks create different overall commercial impressions; (2) the goods are different and travel in different channels of trade; and (3) the purchasers of the Applicant's and Registrant's goods are sophisticated. Applicant's Appeal Brief at pp. 6, 10 and 13.

For the reasons outline below, however, the Trademark Examining Attorney finds that the marks in question are sufficiently similar in sound, appearance, and overall commercial impression and that the goods of the parties are closely related and travel in the same trade channels such that confusion is likely.

i. THE MARKS ARE CONFUSINGLY SIMILAR.

The Applicant is seeking to register the mark "H HUGHES FURNITURE MOTION EAZE RECLINERS" and design. The registered mark is "BRADLEY HUGHES" in standard character form.

The marks of the parties are to be compared for similarities in sound, appearance, meaning or connotation. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §1207.01(b).

Further, when the Applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956).

Regarding the issue of likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, 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 whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

In this case, the Applicant's mark "H HUGHES FURNITURE MOTION EAZE RECLINERS" and design and the registered mark "BRADLEY HUGHES" in standard character form both contain the wording "HUGHES."

Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See Crocker Nat'l*

*Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii).

In the Applicant's mark, the wording "HUGHES" is combined with the generic wording "FURNITURE," "MOTION" and "RECLINERS," the letter "H", the suggestive wording "EAZE," two shaded rectangles, and underlining. The Applicant argues that these differences in appearance and sound demonstrate a difference in commercial impression that makes it unlikely that a consumer would be confused as to the source of the Applicant's and Registrant's goods. Applicant's Appeal Brief at pp. 6-10.

Granted, the marks are compared in their entireties under a Trademark Act Section 2(d) analysis. See TMEP §1207.01(b). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); see TMEP §1207.01(b)(viii), (c)(ii).

For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671

F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)).

In addition, disclaimed matter that is descriptive of or generic for an applicant's goods and/or services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii).

In this case, the Applicant has not demonstrated that the additional wording and design elements in the Applicant's mark are so significant to the overall commercial impression of the mark that a consumer will use them primarily, and not the wording "HUGHES," when referring to or requesting the goods. When encountering the Applicant's mark, the wording "HUGHES" appears in the largest, boldest letters across the top/middle of the rectangle carriers. Below this wording is the generic wording "FURNITURE." Generic wording names the genus of the goods and thus has no trademark significance. Applicant's goods are furniture. To the left of the wording "HUGHES FURNITURE" is the single letter "H." This initial presumably refers to "HUGHES." Along the bottom of the mark is the wording "MOTION EAZE RECLINERS."

Attached to the Office action mailed electronically on April 23, 2013 is a dictionary excerpt retrieved from [www.furniturecaretips.com](http://www.furniturecaretips.com) which indicates that "MOTION FURNITURE" is defined as "[m]echanized furniture allowing for the adjustment of seating position such as a recliner or rocker." Also attached to the Office action mailed electronically on April 23, 2013 is an excerpt retrieved from [www.hughesfurniture.com](http://www.hughesfurniture.com) which demonstrates that the wording "MOTION" and "RECLINERS" in the Applicant's mark is generic in relation to applicant's goods, which include motion recliners, and thus has no trademark significance. This evidence promotes the Applicant's goods with the following informational statement:

*"We welcome the opportunity to supply you with all your upholstery needs. Including: stationary and motion upholstery, sofas, loveseats, chairs, ottomans, sleepers and recliners."*

The wording "EAZE" in the Applicant's mark appears to be a novel spelling of "EASE," and when used within the phrase "MOTION EAZE RECLINERS" is highly suggestive of a characteristic or feature of the goods – that the Applicant's goods have an ease of motion.

Based on this evidence and the legal standards set forth above, the wording "HUGHES" in the Applicant's mark is dominant in creating the overall commercial impression of the Applicant's mark. The registered mark "BRADLEY HUGHES" fully encompasses the dominant portion of the Applicant's mark with the addition of the given name BRADLEY. Attached to the denial of the request for reconsideration mailed electronically on February 2, 2014 is a copy of a search of the Office records which shows that the wording "HUGHES" is neither weak nor diluted when used on furniture. This evidence demonstrates that the only registered or pending marks containing the wording "HUGHES" for use on furniture are the Applicant's mark and the Registrant's mark.

Also attached to the denial of the request for reconsideration mailed electronically on February 2, 2014 is evidence which indicates that it is common for furniture manufacturers to be identified by surname (e.g., Althorp, Baker, Bernhardt, Carter, Cochrane, Cox, Davis, Klaussner, McNeilly, Pearson, Selva, Sherrill etc.). For this reason, consumers encountering the marks of the Applicant and the Registrant (both containing the same surname -- Hughes) are likely to believe that the goods of the parties emanate from a common source or are otherwise related. *In re SL&E Training Stable, Inc.*, 88 USPQ2d 1216, 1219 (TTAB 2008) (holding SAM EDELMAN and EDELMAN, both for wallets and various types of bags, likely to cause confusion, noting that there are strong similarities between the marks because they share the same surname, and that consumers viewing the mark EDELMAN may perceive it

as an abbreviated form of SAM EDELMAN because it is the practice in the fashion industry to refer to surnames alone).

The Applicant argues that by virtue of ownership of prior U.S. Registration No. 4038175 for the mark "MOTION EAZE" also for use on "furniture," consumers will already be inclined to associate the Applicant's goods with the Applicant (and not the Registrant) and a concern of a likelihood of confusion is eliminated. Applicant's Appeal Brief at pp. 6 and 7. To the contrary, mere ownership of a prior registration for a mark composed, in part, of wording appearing in another mark does not in and of itself prevent a likelihood of confusion or substantiate what mental associations consumers will make with respect to either mark.

The mark in the instant application is "H HUGHES FURNITURE MOTION EAZE RECLINERS" and design. As stated above, the wording "MOTION" is generic with respect to the Applicant's goods and thus has no trademark significance, and the wording "EAZE" is highly suggestive of a characteristic/feature of the goods – that the Applicant's goods have an ease of motion. The addition of the arbitrary, non-descriptive, non-generic wording "HUGHES" cannot be ignored in a likelihood of confusion analysis simply because the Applicant has a prior registration for the mark "MOTION EAZE." Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

For the reasons set forth above, the Trademark Examining Attorney submits that the Applicant's mark "H HUGHES FURNITURE MOTION EAZE RECLINERS" and design and the registered mark "BRADLEY HUGHES" are confusingly similar when compared in their entireties and are likely to cause consumer confusion as to the source of the identified goods.

ii. THE GOODS ARE CLOSELY RELATED AND TRAVEL IN THE SAME CHANNELS OF TRADE.

In accordance with the practice established in *In re August Storck KG*, 218 USPQ 823 (TTAB 1983), after examining the similarities of the marks to determine likelihood of confusion, the next issue to be considered is the similarities between the goods or services associated with the marks.

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, 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 the goods and/or services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

The Applicant's mark is used on "furniture."

The Registrant's mark is used on "residential and commercial furniture."

The Applicant argues that the goods of the Applicant and Registrant are significantly different and are sold in completely different channels of trade such that a likelihood of confusion is minimal. Applicant's Appeal Brief at p. 10. For the reasons outlined below, however, the Trademark Examining Attorney finds that the goods are very closely related – and presumably identical – and travel in the same trade channels such that confusion is likely.

With respect to the Applicant's and Registrant's goods, the question of likelihood of confusion is determined based on the description of the goods stated in the application and registration at issue, not

on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Absent restrictions in an application and/or registration, the identified goods and/or services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identifications set forth by the Applicant and the Registrant have no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application uses broad wording to describe the goods and this wording is presumed to encompass all goods of the type described, including those in narrower Registrant’s identification. In other words, the Applicant’s “furniture” is broad enough and must be presumed to include the Registrant’s “residential and commercial furniture.”

Finally, where the goods and/or services of an applicant and registrant are identical or virtually identical (as in this case), the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); TMEP §1207.01(b).

iii. ARGUMENTS REGARDING THE SOPHISTICATION OF THE CONSUMER NEITHER PERSUASIVE NOR DETERMINATIVE.

The Applicant argues that consumers who purchase the Applicant's and Registrant's goods are generally sophisticated purchasers who know the designer products and their respective sources and are not likely to be confused. Applicant's Appeal Brief at p. 13. While the sophistication of the relevant consumer is one factor to be considered, when considered in conjunction with the other relevant factors, it is not determinative on the issue of likelihood of confusion.

The Applicant's arguments regarding the sophistication of the purchasers appear to be merely self-serving statements with no evidence in the record in support thereof. Further, 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, e.g., *Stone Lion Capital Partners, LP v. Lion Capital LLP*, \_\_\_ F.3d. \_\_\_, \_\_\_, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

III. CONCLUSION

In view of the substantially similar nature of the marks, the close relatedness of the goods, and the common channels of trade, purchasers are likely to confuse the sources of these goods. Therefore, the Examining Attorney respectfully requests that the Board affirm the refusal to register the mark on the Principal Register under Section 2(d) of the Trademark Act.

Respectfully submitted,

/Alicia Collins Edwards/

Trademark Examining Attorney

United States Patent and Trademark Office

Law Office 115

571-272-9147

[alicia.edwards@uspto.gov](mailto:alicia.edwards@uspto.gov)

John Lincoski

Managing Attorney

Law Office 115