

**This Opinion Is Not a
Precedent Of The TTAB**

Mailed: August 11, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hearst Communications, Inc.

Serial No. 85704221

Mary A. Donovan of Donovan & Yee LLP, for Hearst Communications, Inc.

Kevin A. Mittler, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop,
Managing Attorney).

Before Quinn, Ritchie, and Wolfson, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Hearst Communications, Inc. (“Applicant”) filed an application to register the mark METROPOLITAN HOME,¹ in standard character form, for goods identified as “case goods, namely, chests, night stands, cabinets, dining tables, coffee tables, end tables, desks, bed and headboards; upholstered furniture; all the foregoing not relating to furniture for use in patient rooms and waiting areas of healthcare facilities,” in International Class 20. The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C.

¹ Serial No. 85704221, filed August 15, 2012, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a *bona fide* intent to use the mark in commerce, and disclaiming the exclusive right to use the term “HOME” apart from the mark as shown.

§ 1052(d), on the ground that Applicant's mark so resembles the registered mark METROPOLITAN,² also in standard character form, for "furniture for use in patient rooms and waiting areas of healthcare facilities," in International Class 20, that when used on or in connection with Applicant's identified goods, it is likely to cause confusion or mistake or to deceive.

Upon final refusal of registration, Applicant filed a timely appeal. Both Applicant and the Examining Attorney filed briefs, and Applicant filed a reply brief. For the reasons discussed herein, the Board affirms the refusal to register.

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *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 Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). We consider the factors discussed by Applicant and the Examining Attorney. The others we deem neutral.

² Registration No. 3265682, issued July 17, 2007. Sections 8 and 15 accepted and acknowledged.

The Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In comparing the marks, we are mindful that 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 offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average consumer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Analyzing the sight and sound of the marks in their entireties, we find that Applicant's METROPOLITAN HOME mark consists of, and incorporates in full, the term METROPOLITAN, which constitutes the entirety of registrant's mark. Applicant argues that the addition of the term "HOME" changes the appearance, sound, and commercial impression of the mark significantly. However, as our precedent dictates, "it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988); *see also Palm Bay Imports*, 73 USPQ2d at 1692.

This is especially so where the added term is disclaimed and descriptive. *In re National Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985) (“[T]here 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 consideration of the marks in their entireties.”).

Applicant contends that the term “METROPOLITAN” is weak, asserting in its brief that “[t]here are almost 400 active federal trademark citations of marks that consist of or include the word ‘metropolitan.’” (Applicant’s brief at 6). However, Applicant has not submitted into the record any third-party registrations, nor any evidence of third-party use of the term “METROPOLITAN.” While we accept that the term may indeed be suggestive for urban furniture, it is not so weak that it is not entitled to protection against Applicant’s mark for related goods. Rather, we find a high degree of similarity between METROPOLITAN and METROPOLITAN HOME in sight, sound, meaning, and commercial impression such that this *du Pont* factor weighs strongly in favor of finding likelihood of confusion.

The Goods and Channels of Trade

The identification of goods covered by the cited registration includes “furniture for use in patient rooms and waiting areas of healthcare facilities,” while Applicant’s identification of goods includes “case goods, namely, chests, night stands, cabinets, dining tables, coffee tables, end tables, desks, bed and headboards; upholstered furniture; all the foregoing not relating to furniture for use in patient rooms and waiting areas of healthcare facilities.” Although Applicant specifically excluded from its identification of goods the furniture included in the cited registration, the

Examining Attorney submitted into the record websites of third-party companies that offer for sale under the same mark both furniture listed by Applicant, such as “desks” and “beds” or “upholstered furniture” and patient or waiting room furniture, as listed in the cited registration. The websites include: *naicsfurniture.com* (dining room tables and healthcare waiting room furniture); *hermanmiller.com* (desks and furniture for healthcare); *norix.com* (beds and healthcare waiting room furniture); *peoplefriendlyplaces.com* (upholstered furniture and healthcare waiting room furniture); *upholsterycustommade.com* (upholstered furniture and healthcare waiting room furniture); *kimballoffice.com* (upholstered furniture and healthcare waiting room furniture); and *championchair.com* (upholstered furniture and healthcare waiting room furniture).

An illustrative image of the similarity of the goods includes the following:

Kimball[®]Office

PRODUCTS

INDUSTRIES

DESIGN

SEARCH

LOGIN

Create a Caring Environment

Kimball Office Furnishings for Healthcare

Overview Photo



Keeping Wellbeing in Mind

Kimball Office furniture for medical and hospital facilities satisfies the needs of physicians, staff, and guests. Office Furniture for healthcare environments complements medical offices, patient rooms, visitor lounges, and nursing home reception areas.

Designed with your wellbeing in mind, Kimball Office has storage solutions to house your medical records and office supplies. Office organizational tools help keep information and equipment orderly and close at hand. Kimball Office furniture is:

Healthcare Collateral

Healthcare Brochure
Healthcare Brochure - Print Version
Healthcare Overview Sheet
CA OSHPD Approval Info

Industry Links

Case Studies

Applicant argues that these websites are inapposite because they largely reference commercial rather than home furniture whereas Applicant's mark contains the term "HOME."³ We note, however, that Applicant's identification of goods is not limited to home furnishings, and we must interpret the identification as potentially including commercial furnishings, or furnishings that may be used in a commercial environment. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d

³ Applicant refers in its reply brief to its disclaimer of "HOME" as support for this argument. However, the disclaimer of "HOME" relates to the fact that Applicant's furniture may be sold for home use. It does not exclude the possibility that it may also be sold for commercial use.

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 channels of trade or the class of purchasers to which the sales of the goods are directed.”) (citations omitted).

As for the channels of trade, the registrant’s identification is limited to “healthcare facilities,” whereas Applicant’s identification specifies “not relating to furniture for use in patient rooms and waiting areas of healthcare facilities.” That said, the web evidence makes clear that these can be related and travel via the same channels of trade to some of the same consumers. Accordingly, these factors also weigh in favor of finding a likelihood of confusion.

Consumer Sophistication/Other

Applicant urges us to consider the consumer sophistication and degree of purchaser care likely to be exercised for the goods at issue in this proceeding.

While acknowledging that the purchase of furniture for healthcare facilities is not likely to be one done on impulse, we note that the prices may vary. Indeed, while at least registrant’s goods may be sold to knowledgeable, sophisticated consumers, and potentially Applicant’s as well, it is well-established that even sophisticated consumers are not immune from source confusion, especially where, as here, the marks are highly similar. *See Cunningham*, 55 USPQ2d at 1846.

We also note that Applicant asserts that it was the publisher of a magazine under the title *Metropolitan Home*, a “well-known home interior design magazine,” that ceased publication in 2009. (Applicant’s brief at 3 and 7). With its December 4, 2013 Request for Reconsideration, Applicant submitted its Registration No. 1235238

for METROPOLITAN HOME⁴ (disclaiming “HOME”) for “magazines.” Applicant also submitted several news articles discussing the closure of its *Metropolitan Home* magazine to evidence the fame of the magazine. These include articles from *The New York Times*, dated November 9, 2009, from *LA at Home*, dated November 9, 2009, from *US Weekly*, dated November 9, 2009, and from *The Huffington Post*, dated March 18, 2010. These articles are very narrow in scope for several reasons. First, they cover a very short time period.⁵ Second, they are rather small in number. Finally, as pointed out by the Examining Attorney, to the extent that Applicant has achieved any renown for its “METROPOLITAN HOME” mark, any such goodwill is not for furniture but rather for magazines. *But see In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012) (no likelihood of confusion found where applicant had previously existing, incontestable mark for “substantially similar” mark for same goods).

We find these factors to be neutral.

Conclusion

Considering all of the arguments and evidence of record as they pertain to the relevant *du Pont* factors, in comparing Applicant’s METROPOLITAN HOME mark to the cited registration for METROPOLITAN, we conclude that the marks are highly similar and create similar commercial impressions, the goods and channels of trade are related, and Applicant cannot rely on its prior goodwill or registration for

⁴ Registered March 23, 1981. Renewed.

⁵ Applicant notes that the covers of its previously published magazines are still available online at *ElleDecor.com*, a related entity. However, this is only to say that the covers of the magazines are available for viewing, not the magazines themselves, or any searchable content thereof. *See* December 4, 2013 Request for Reconsideration, Ex. C.

METROPOLITAN HOME relating to magazines to establish proprietary rights in the present mark. Accordingly, we find a likelihood of confusion with this registration.

Decision: The refusal to register is affirmed.