

This Opinion is Not a
Precedent of the TTAB

Oral Hearing: May 18, 2017

Mailed: June 28, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Williams-Sonoma, Inc.

Serial No. 86092589

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Townsend and Stockton LLP,
for Williams-Sonoma, Inc.

Laurie Mayes, Trademark Examining Attorney, Law Office 101,
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Before Zervas, Taylor and Wellington,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Williams-Sonoma, Inc. (“Applicant”) seeks registration on the Principal Register
of the standard character mark MANHATTAN for “Upholstered furniture” in
International Class 20.¹

¹ Application Serial No. 86092589, filed on October 16, 2013 pursuant to Section 1(b) of the
Trademark Act, 15 U.S.C. § 1051(b), asserting a *bona fide* intent to use the mark in
commerce.

The Examining Attorney refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on Registration No. 2479386² for the typed mark³ MANHATTAN CABINETRY for "custom designed and crafted furniture" in International Class 20. The mark has been registered under the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), and registrant has disclaimed the term CABINETRY.

After the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration. On remand by the Board, the Examining Attorney denied the request for reconsideration. The appeal resumed and both Applicant and the Examining Attorney filed briefs. The Board conducted an oral hearing on May 18, 2017. We affirm the refusal to register.

Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the

² Registered August 21, 2001, renewed (June 16, 2011).

³ Prior to November 2, 2003, "standard character" marks were known as "typed" drawings. A typed mark is the legal equivalent of a standard character mark. *In re Vittera Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) ("until 2003, 'standard character' marks formerly were known as 'typed' marks.").

evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see also In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014).

The Goods

We first turn to the goods as they are identified in the application and cited registration. *In re Trackmobile Inc.*, 15 USPQ2d 1152 (TTAB 1990). If the goods are described broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration encompasses all goods of the type described, that they move in all channels of trade normal for these goods, and that they are available to all usual classes of purchasers. *See In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

Applicant’s goods are “upholstered furniture” and registrant’s goods are “custom designed and crafted furniture.” Because both Applicant’s and the cited registrant’s goods are broad enough to encompass custom designed and crafted upholstered furniture, we find that the goods are overlapping in scope. *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”).

We reject Applicant’s arguments that the goods differ because (i) the term CABINETRY in registrant’s mark limits registrant’s goods to cabinetry; and (ii)

“Applicant uses the MANHATTAN mark for a single and universal upholstered furniture item, whereas the MANHATTAN CABINETRY goods are custom designed products configured for an individual customer’s preferences, taking into account the location where the furniture will be installed.”⁴. Because there are no limitations regarding the types of upholstered furniture identified by Applicant or the custom designed and crafted furniture identified by registrant, we must assume they encompass all types, including custom designed and crafted upholstered furniture. Registrant’s goods are not limited to the particular custom designed and crafted furniture that it actually sells. *Paula Payne Prods. Co. v. Johnson Publ’g Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77-78 (CCPA 1973) (Board must “give full sweep” to an identification of goods regardless of registrant’s actual business).

We also reject Applicant’s argument that registrant’s identification of goods is not clear; and that we should consider extrinsic evidence of use by registrant because “where wording in an identification is unclear or undefined, the Trademark Trial and Appeal Board will consider extrinsic evidence demonstrating that the registrant’s identification has a specific meaning.”⁵ “A term in an identification of goods should be read to have its ordinary meaning.” *In re Thor Tech Inc.*, 85 USPQ2d 1474 (TTAB 2007); *see also*, TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1402.07(a) (April 2017). The meaning of registrant’s identification is clear and extrinsic evidence is not necessary to understand its specific meaning. Also, the extrinsic evidence

⁴ Applicant’s brief at 6, 7 TTABVUE 12.

⁵ Reply at 7, 10 TTABVUE 8.

Applicant would have us consider is none other than the specimen of use submitted by registrant in connection with its application.⁶ This specimen is not of record, and the Board does not take judicial notice of records residing in the Patent and Trademark Office. *See In re Pedersen*, 109 USPQ2d 1185 (TTAB 2013); *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). Furthermore, relying on the specimen (which we assume would depict the goods actually sold) which ultimately restricts the scope of the identification of goods in the cited registration would contravene the Board's instruction in *In re Trackmobile, supra*.⁷

Applicant argues too that “[a]s a creator of custom designed and crafted furniture products, Registrant necessarily works closely with each of its customers to solicit design suggestions based on that individual user’s unique needs;”⁸ and this is a material difference in the goods.⁹ We are not persuaded that the manner registrant interacts with its customers distinguishes the goods, because consumers of both Applicant’s and registrant’s goods are ultimately purchasing furniture which suits their unique needs.

The Examining Attorney placed into the record evidence of entities providing both custom designed furniture and finished upholstered furniture under the same mark.

⁶ “The Registrant’s application shows exactly the type of goods Registrant claims; the submitted specimen enumerates numerous products that can be custom-built, and all are constructed solely of wood. Upholstered furniture is notably absent.” Reply at 8, TTABVUE 9.

⁷ A proceeding under Section 18 of the Trademark Act, 15, U.S.C. § 1068, allows an aggrieved party to restrict a registration.

⁸ Applicant’s brief at 6, 7 TTABVUE 12.

⁹ Applicant’s brief at 6, 7 TTABVUE 12.

Goods may be related when the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the goods originate from or are in some way associated with the same source. *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). It is only necessary that there be a viable relationship between the goods to support a finding of likelihood of confusion. *In re Concordia Int'l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983). *See*:

- <http://www.villagepinenj.com/index.html> submitted with.¹⁰



¹⁰ June 10, 2014 Office Action, TSDR 13.

- Snow's Custom Furniture & Home Interiors¹¹

SNOW'S
**CUSTOM FURNITURE
& HOME INTERIORS**

4009 US Hwy 1
Vero Beach, FL
772-794-4430 ~ Fax: 772-794-4431

Welcome

Home

Custom Furniture I

Custom Furniture II


Home Interiors I

Home Interiors II


Home Interiors III

Contact Us

Retail



**Imported from
around the world**



The retail division is the successor to Yun's Antique Pine, which we operated for 5 years at 3854 US 1, in Vero Beach. As our lease was expiring, we relocated the showroom to 4009 US 1, essentially across the road on the west side of US 1. We expanded the existing line of furniture and accessories to add a new, more eclectic look. We feature unique pieces imported from around the world, and are still the area's only source for the 4 Seasons line of **upholstered furniture**. In addition, we showcase a number of items produced by our **custom** division.

Custom Shop

Snow's **Custom Furniture** was established in 2005, in response to a great demand for **custom** built furniture and **cabinetry**. Specializing in TV entertainment centers, libraries, book cases and dining tables of all types, Snow's has become known for its high quality and craftsmanship.

The shop is under the supervision of Dave Crockett, a Vero Beach native with over 25 years experience in the fabrication of all types of furniture. We build high quality products using the best furniture grade lumbers. We are able to **custom** design each piece to fit each client's needs and specifications. No project is too large or too small. We can build nearly any type of furniture in nearly any material.

Snow's finish shop personnel are equally qualified in the applications of most finishes, including stains, lacquers, and conversion varnish. Our shop foreman has over 25 years in finishing all types of furniture and **cabinets**.

In addition, Snow's offers a complete repair service. We can fix almost any piece of furniture, and then match the existing finish to make the repair virtually indistinguishable.

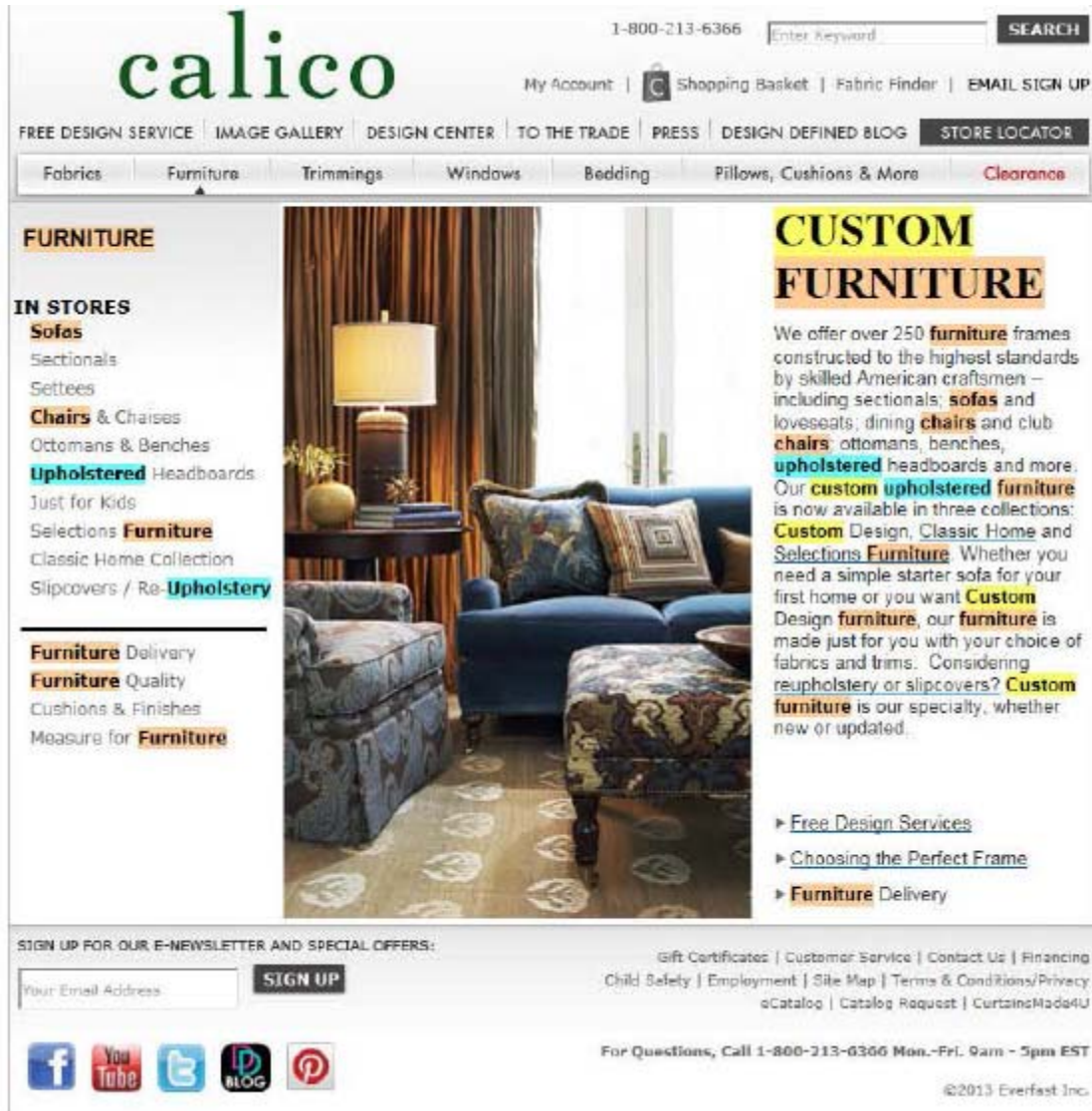


**Stop in and see our great variety
of great furniture and accessories.**

¹¹ June 10, 2014 Office Action, TSDR 24.

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- Calicocorners.com¹²



In addition, Applicant's specimen of use reflects that Applicant itself not only sells finished upholstered furniture, but also offers "made to order" and "special order" furniture (which essentially is custom designed and crafted furniture):

¹² November 20, 2013 Office Action, TS DR 18.

10/15/13

Manhattan Leather Club Chair | Pottery Barn

P O T T E R Y B A R N



MANHATTAN LEATHER CLUB CHAIR

quick ship on select fabrics

Special Order selections generally ship within 8 - 10 weeks. Made to order, these items are non-refundable.

\$1,499 - \$1,955

CHOOSE YOUR ITEMS BELOW ▾

Also, registrant's webpage indicates that registrant offers finished floor samples for sale:¹³

We have a number of exceptional floor samples available at discounted prices. All items are high quality custom made pieces available for pick up or delivery from our factory or showroom. Please call (212)750-9800 - showroom, or (718)937-4780 - factory, for more information.



¹³ May 20, 2014 Resp., TSDR 2.

In view of the foregoing, we find that the *du Pont* factor regarding the similarity of the goods favors a finding of likelihood of confusion.

Channels of Trade and Classes of Consumers

Because the goods described in the application and the cited registration overlap and there are no limitations in the identifications in the application or registration, we presume that both Applicant's and registrant's goods travel in overlapping trade and distribution channels and will be marketed to the same potential consumers, who are members of the general public. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"). *See also, In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014).

In addition, the Examining Attorney's website evidence persuades us that there is a commercial relationship among the goods because it demonstrate that the involved goods are offered on the same webpages to the same consumer.

The Marks

We now compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay Imp's.*, 73 USPQ2d at 1692. 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. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Assoc. of the United States Army*, 85 USPQ2d 1264 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Where the goods of an applicant and registrant overlap, as they do here, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as with diverse goods. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987).

Applicant argues that registrant's mark is entitled to a narrow scope of protection because "Manhattan" is a geographic term. We note that the cited registration is registered under the provisions of Section 2(f) of the Lanham Act. Having acquired distinctiveness, the mark MANHATTAN CABINETRY is entitled to the same trademark protection as any other validly registered trademark. *E. I. du Pont de Nemours & Co. v. Societe Dupont*, 161 USPQ 489, 491 (TTAB 1969). We also note that there is no evidence that MANHATTAN is commonly used by others in the relevant

field or that the mark is otherwise weak and entitled to only a narrow scope of protection.

Applicant's mark is contained in its entirety within registrant's two-term mark. "Likelihood of confusion often has been found where the entirety of one mark is incorporated within another," *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2014), (citing *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant's mark ML is similar to registrant's mark ML MARK LEES), *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (THE LILLY as a mark for women's dresses is likely to be confused with LILLI ANN for women's apparel including dresses), *In re United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (CAREER IMAGE for women's clothing stores and women's clothing likely to cause confusion with CREST CAREER IMAGES for uniforms including items of women's clothing)).

When considered in their entireties, the marks are so substantially similar as to be likely, if used in connection with the overlapping or related goods, to cause confusion or mistake or deception. While marks must be considered in their entireties, including any generic matter, it is also the case that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that

a particular feature is ... generic with respect to the involved ... [goods] is one commonly accepted rationale for giving less weight to a portion of a mark” *Id.* Here, Applicant’s mark is identical to the dominant and distinguishing element of registrant’s MANHATTAN CABINETRY, the term MANHATTAN, in view of the lack of source-indicative significance inherent in the generic term CABINETRY (which registrant has disclaimed). It is likely that consumers could reasonably believe, in light of the similarities in sound, appearance, connotation and overall commercial impression between the respective marks due to the shared term MANHATTAN, that the goods have a common source or sponsorship if such goods are the same or otherwise commercially related.

We also take into account the fallibility of purchasers’ memory over time and the fact that purchasers tend to retain a general rather than a specific impression of the many trademarks they encounter. While Applicant’s and registrant’s marks are not identical, that is not the test under the first *du Pont* factor. *See In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1468 (TTAB 1988). We find that any distinction in the marks caused by the additional term CABINETRY is outweighed by the overall similarity resulting from the shared identical term MANHATTAN. The *du Pont* factor regarding the similarity of the marks hence favors a finding of likelihood of confusion.

Conditions of Purchase and Sophistication of Purchasers

Applicant argues:

Because furniture is expensive and intended to be used for many years, a consumer will take greater care in its purchase, thus reducing the chance he will be confused.

Furniture purchases require a detailed analysis of comfort, quality and durability, among other factors. As such, consumers don't acquire products such as Applicant's upholstered sofas, sectionals, recliners, ottomans and armchairs on a whim, with no concern or awareness of their source.

Similarly, Registrant's customers are sophisticated consumers who are familiar with the furniture market and are looking for a high-end furniture customization service. "Custom designed and crafted" products—and particularly furniture—are expensive, and require a significant amount of consideration and input on the consumer's part. The custom design experience is highly interactive and requires extensive customer involvement, from providing specifications to approving the final design. A customer must deal directly with the Registrant throughout the design and manufacture of his custom furniture, so he is unquestionably well aware of the source of the product/service Registrant provides.

We agree with Applicant that "consumers don't acquire products such as ... upholstered sofas, sectionals, recliners, ottomans and armchairs on a whim, with no concern or awareness of their source." But this does not mean that purchasers acquire upholstered furniture with heightened care. Indeed, overstock.com lists an upholstered office chair for \$119.99,¹⁴ an item included with Applicant's identification of goods. We agree that custom designed and crafted furniture might involve some deliberation and care, and involvement with the merchant/designer, and a customer who goes to the trouble of having furniture designed to order would exercise care. Therefore, we accept that this factor favors Applicant with respect to purchasers of

¹⁴ See, e.g., November 20, 2013 Office Action, TSDR 11.

registrant's furniture, but find that that certain consumers would use no more than ordinary care when purchasing Applicant's goods.

Absence of Confusion

Applicant argues:

The parties' marks have been used concurrently since at least as early as August 1997, Applicant's claimed first use date, with no evidence of actual confusion despite this 17+ year coexistence. ...

Applicant's Pottery Barn family of stores is well-known throughout the U.S. The number of stores and their placement throughout the country, as well as Applicant's extensive marketing efforts and significant online presence, means the chances Registrant's customers have encountered Applicant's MANHATTAN mark are high. Despite the very public nature of Applicant's use of the mark, however, Applicant is unaware of any instances in which consumers confused the upholstered furniture bearing the MANHATTAN mark with Registrant or its "custom designed and crafted furniture."¹⁵

The Federal Circuit, however, has offered the following regarding the weight to be given to an assertion of no actual confusion by an applicant in an *ex parte* proceeding:

With regard to the seventh *DuPont* factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. *See In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). 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

¹⁵ Applicant's brief at 9, 7 TTABVUE 15.

confusion carries little weight, [citation omitted], especially in an ex parte context.

Majestic Distilling, 65 USPQ2d at 1205; see also *In re Integrated Embedded*, 120 USPQ2d 1504, 1515 (TTAB 2016).

Accordingly, while examples of actual confusion may point toward a finding of a likelihood of confusion, an absence of such evidence is not compelling in support of a finding of no likelihood of confusion. Thus, we do not conclude from the lack of instances of actual confusion that confusion is not likely to occur, even if there has been a coexistence of marks for 17 years.¹⁶

In any event, this record is devoid of any probative evidence relating to the extent of use of Applicant's and registrant's marks and, thus, whether there have been meaningful opportunities for instances of actual confusion to have occurred in the marketplace. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). That Applicant sells its goods in its Pottery Barn stores which are nationwide in and of itself is of no significance; Applicant says nothing about the extent of use of its MANHATTAN mark on upholstered furniture.

Accordingly, the *du Pont* factor of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion is neutral.

¹⁶ Applicant's brief at 10, 7 TTABVue 16.

Any Other Probative Fact

Applicant argues that its mark should be capable of coexisting with registrant's mark because registrant's mark was registered despite the registration of the mark MANHATTAN LOFT (Registration No. 2838366, registered May 4, 2004, cancelled on December 10, 2010, for "Retail store services featuring furnishings used throughout the home, including all living room, kitchen, bedroom, home office and dining furniture, artwork, case goods, cabinetry, gifts, fabrics, mattresses, futons, sofas, tables, beds, chairs, pillows and window coverings" in International Class 35).¹⁷ We consider this registration, but are not persuaded by it as the mark is not as close to the cited mark as the mark in the involved application. Moreover, the Board is not bound by the actions of an examining attorney based on records that are not before us. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [applicant's], the PTO's allowance of such prior registrations does not bind the board or this court."). Each case must stand on its own record.

Balancing the Factors

After considering all of the *du Pont* factors for which there has been evidence or argument, including evidence and arguments not specifically mentioned in this decision, we find that Applicant's mark and the registrant's mark are very similar, the goods overlap and are related in other aspects, the channels of trade overlap, the classes of consumers are the same, and Applicant's consumers would use ordinary

¹⁷ Applicant's brief at 10, 7 TTABVue 16.

care in their purchases of Applicant's upholstered furniture. The only *du Pont* factor that favors Applicant's position is the care which may be taken with respect to choosing custom designed and crafted furniture. However, even if we assume that registrant's prospective purchasers are careful, "even careful purchasers are not immune from source confusion." See *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); *In re Total Quality Grp. Inc.*, 51 USPQ2d 1474 (TTAB 1999); *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). That is, even relatively careful purchasers of the overlapping goods at issue here are likely to believe that they come from the same source, since they are offered under substantially similar marks. In other words, even if consumers pay attention to the marks, and note that Applicant's mark does not include CABINETRY, the inclusion of this generic term is not likely to convey to consumers that the mark identifies a different source from the owner of the MANHATTAN CABINETRY mark.

We therefore find that the mark MANHATTAN for upholstered furniture is likely to cause confusion with MANHATTAN CABINETRY for custom designed and crafted furniture.

Decision: The refusal to register under Section 2(d) is *affirmed*.