

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

Hearing:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Opposition No. 91152287

Kohler Co.

v.

Kohler Homes

Opposition No. 91152290

Kohler Co.

v.

Kohler Associates Architects

Raymond I. Geraldson, Jr., Bradley L. Cohn and Kristen S. Knecht of Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP for Kohler Co.

Lawrence E. Laubscher, Jr. of Laubscher & Laubscher, P.C. for Kohler Homes and for Kohler Associates Architects.

Before Grendel, Drost and Zervas, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Opposition Nos. 91152287 and 91152290

On May 8, 2001, Kohler Homes filed an application (Serial No. 76252765) for registration of the mark KOHLER HOMES (in standard character form) for "custom construction of homes" and Kohler Associates Architects filed an application (Serial No. 76252766) for registration of KOHLER ASSOCIATES ARCHITECTS (in standard character form) for "architectural design." Both applications seek registration on the Principal Register and recite February 13, 2001 as the date of first use anywhere and first use in commerce. Kohler Homes has disclaimed the term HOMES in its application and Kohler Associates Architects has disclaimed the term ASSOCIATES ARCHITECTS in its application. We refer to both applicants collectively as "applicant."

Opposer, Kohler Co., filed timely notices of opposition to registration of both of applicant's marks. In both notices of opposition, opposer pleaded that it is the owner and user of the following marks and registrations:

1. Registration No. 1137310 for the mark THE BOLD LOOK OF KOHLER in typed form for "plumbing fixtures and fittings for use with plumbing fixtures, and parts therefor" in International Class 11 (renewed January 24, 2001);
2. Registration No. 0577392 for the mark KOHLER in typed form for "plumbing fittings-namely, bath and shower fittings, bath fittings and valves, bath drains, showers, mixing valves, shower heads, combination lavatory fittings and faucets, drinking fountain fittings, supply pipes, sink, lavatory and urinal strainers, traps and continuous drains, flush pipes, closet and urinal fittings, bidet fittings, sink faucets, laundry tray faucets, lawn faucets, and bath and shower

Opposition Nos. 91152287 and 91152290

accessories consisting of soap dishes, robe hooks, towel bars, and wall grip rails" in International Class 13 (thrice renewed September 30, 2003); and

3. Registration No. 0094999 for the mark KOHLER in typed form for "bath-tubs, lavatories, sinks, water-closets, closet-tanks, urinals, slop-sinks, traps, sitz-baths, receptors for use in connection with showers, lavatory bowls, drain-boards, closet-bowls and closet-tanks" in International Class 13 (fifth renewal March 16, 2004).¹

We refer to these three registered marks as "Opposer's Marks." Additionally, opposer claims priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); and that "Opposer's name Kohler Co. has acquired distinctiveness as a trade name for

¹ Opposer has also pleaded that it is the owner and user of the following marks and now-cancelled registrations:

1. Registration No. 0592927 for the mark
 for "plumbing fixtures-namely, bath tubs, sitz baths, shower receptors, lavatories, wash sinks, drinking fountains, kitchen sinks, sink and trays, laundry trays, service sinks, service sumps, closet tanks, urinal tanks, laboratory sinks"; and
2. Registration No. 2349436 for the mark  for "plumbing fixtures being part of sanitary installations, namely, bath tubs, lavatories, bidets, sitz baths, shower receptors, wash sinks, drinking fountains, kitchen sinks, combination sink and trays, service sinks, water closets, urinals, closet tanks, urinal tanks, and laboratory sinks."

Because they have been cancelled, we do not give further consideration to Registration Nos. 0592927 and 2349436. Also, as for opposer's asserted common law rights to these marks, we need not consider them in view of our disposition of the oppositions.

Opposition Nos. 91152287 and 91152290

Opposer's goods and services and is now a famous, well-known name and mark throughout the United States." Notices of opposition at ¶ 5. Opposer has also pleaded dilution of its "name and mark" under Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c). *Id.* at ¶ 13.

Applicant has denied the salient allegations of the notices of opposition. On January 15, 2005, the Board consolidated the oppositions. The parties have fully briefed this case, and the Board conducted an oral hearing on July 15, 2008.

The Record

Of course, the record includes the pleadings and the files of the two opposed applications. Additionally, the record includes opposer's two notices of reliance on (i) certified status and title copies of Registration Nos. 0094999 (KOHLER), 0577392 (KOHLER), 0590052 (KOHLER) and 1137310 (THE BOLD LOOK OF KOHLER); (ii) applicant's responses to opposer's first set of requests for admissions; and (iii) applicant's response to opposer's Interrogatory no. 19(2). The record also includes (i) the testimony deposition of applicant's principal Mark A. Kohler with exhibits; and (ii) the declarations of several individuals submitted pursuant to an agreement between the parties to submit testimony by sworn declaration. Specifically, opposer has submitted the declarations of (i) Douglas

Opposition Nos. 91152287 and 91152290

Bocchini, opposer's director of fixtures merchandising; (ii) John Engberg, opposer's manager for global media and web development, with exhibits; (iii) Peter Fetterer, opposer's part-time corporate archivist, with exhibits; (iv) Cynthia Howley, opposer's design center, services and events manager, with exhibits; (v) Jason Keller, opposer's manager, global power group communications, with exhibits; (vi) Todd Weber, opposer's manager of kitchen and bath public relations, with an exhibit; (vii) George Mantis, opposer's expert witness, along with his expert opinion and an exhibit; and (viii) Diana Koppang, opposer's attorney's information resources coordinator, with exhibits. Applicant has submitted the declarations of (i) Karl E. Kohler, a founding member of applicant's predecessor-in-interest, with exhibits; (ii) Mark Kohler, with exhibits; (iii) Thomas Flach, vice-president of Kohler Homes and an associate of Kohler Associates Architects, with an exhibit; (iv) Linette Bernstein, applicant's director of accounting and administration, with exhibits; (v) George Stafford, CEO of Fairmont Studios which produced applicant's web site, with an exhibit; (vi) Marianne Smith, applicant's attorney's paralegal, with exhibits; and (vii) various individuals who testified to a lack of actual confusion, namely, Jay Alls, Brian Downs, Dee David and Robert Gallagher.

Evidentiary Objection

Ms. Smith, a paralegal in applicant's attorney's law firm, testified through her declaration that she searched corporation division databases for all 50 states for registered corporations with "Kohler" as all or part of a registered name, conducted Google searches for the names of the entities identified in the corporation division searches, and placed phone calls to the entities found as a result of the Google searches to verify that the businesses are still operating under the "Kohler" name and/or providing services under the "Kohler" mark." Smith dec. ¶ 2. She submitted a chart with her declaration that identifies the entity she located, its "Industry" and phone number, whether she contacted anyone at the entity's office, the name of the person she contacted, and an Internet address for a "web link" for the entity. Ms. Smith also provided webpages for the "web link" which identify the entity or which comprise pages from its website.

Opposer objects to Ms. Smith's declaration and exhibits to the extent that she relies on conversations with individuals who answered the phone at certain third-party businesses on the grounds of hearsay and lack of personal knowledge, and on the chart which allegedly includes information learned in her conversations. Additionally, opposer objects to webpages which accompany her declaration

on the ground of hearsay to the extent that applicants rely on any statements made in the webpages. Applicant responds by arguing that Ms. Smith's declaration is based on first hand knowledge of third party use as a result of her investigation and is not hearsay; and that the exhibits to her declaration were obtained directly by her as a result of her investigation and confirm the uses set forth in her chart.

We have considered opposer's objections, but also the fact that the parties have agreed that "the parties' testimony may be introduced by affidavit or sworn declaration with witnesses available for cross-examination by deposition if necessary." Opposer's notice of reliance, ex. E. The record does not indicate that opposer sought to cross-examine Ms. Smith or that opposer raised any objection to Ms. Smith's declaration in any paper filed prior to its brief. We therefore consider her declaration and exhibits, but only for the purpose of demonstrating that there are businesses in operation which have the term KOHLER in their trade names and that these businesses have active websites. See discussion *infra*.

Standing/Priority

Opposer has made status and title copies of Opposer's Marks, showing that they are in full force and effect and are owned by opposer Kohler Co. Because opposer has made

these registrations properly of record, opposer has established its standing to oppose registration of applicant's mark and priority is not in issue.² See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *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 considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Fame

The first *du Pont* factor we consider is the factor of fame. The fame of the prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d

² Applicant has not contested opposer's standing.

Opposition Nos. 91152287 and 91152290

1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public ... recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). That is, we look to the class of customers and potential customers of a product or service, and not the general public. In this case, as further discussed *infra*, the relevant public for opposer's goods and applicant's architectural design services are homeowners, commercial building owners, contractors and builders, and the relevant public for opposer's goods and applicant's custom construction of homes services are current or future homeowners.

Opposer has sold over \$18 billion worth of KOHLER kitchen and bath products in the United States and has spent over \$150 million in advertising its KOHLER kitchen and bath products in the United States through national and local magazines, trade journals, newspapers, television, radio, trade shows, billboards and the Internet. Bocchini dec. at ¶ 2, Engberg dec. at ¶ 6. Further, opposer's distributors, dealers, designers and builders operate a network of nearly

Opposition Nos. 91152287 and 91152290

six hundred showrooms throughout the United States as a way to showcase and promote opposer's products. *Id.* at ¶ 7. Opposer has been selling a number of its products for over seventy years, and has sold some of its products, including sinks and bathtubs, for over 100 years. *Id.* at ¶¶ 2 and 4, ex. 1; Fetterer dec. at ¶ 16, ex. 3.

Opposer's products have been the subject of special recognition or awards. Opposer's products have won awards from *Home Builder Executive*, *Builder News*, *Professional Builder*, *Professional Remodeler*, *Building Products*, *Architecture*, *Architectural Record*, *BusinessWeek*, the National Society of Professional Engineers, the National Association of Home Builders Senior Housing Council and the Industrial Design Society of America. Weber dec. ¶ 2 and ex. 1. In addition, a number of KOHLER-branded products have been rated a *Consumer's Reports* "Best Buy" and/or a *Consumers Digest* "Best Buy." *Id.* at ¶ 4. KOHLER bath products are featured at "the House of Innoventions" at Walt Disney's EPCOT Center. *Id.*

Also, opposer and its KOHLER products have been the subject of newspaper and magazine articles and feature pieces across the United States, including in *The New York Times*, *The Washington Post*, *The Chicago Tribune*, *The Wall Street Journal*, *Forbes*, *Advertising Age*, and *Builder*.

Opposition Nos. 91152287 and 91152290

Fetterer dec. ¶ 14, ex., 1; Koppang dec. ¶¶ 3 - 21 and exs. 1 - 19.

Applicant has recognized in its statement of facts that “[a]s a consequence of its sale and advertising of bath products, Opposer is known as the undisputed king of the America bathroom,” citing ¶ 23 of Mr. Fetterer’s declaration. Brief at p. 3. Also, applicant has conceded that KOHLER is a strong mark, “*but only as applied to plumbing fixtures and fittings ...*” Brief at p. 12 (emphasis in original). Additionally, Mr. Kohler has acknowledged that KOHLER is a well-known brand for bathroom fixtures. Kohler dep. p. 21.

On this record, we find that opposer's KOHLER mark is famous in connection with bathroom fixtures and within the home construction industry generally for purposes of our likelihood of confusion analysis, and is entitled to broad protection. *Bose*, 63 USPQ2d at 1305.

The factor of fame weighs heavily in favor of finding a likelihood of confusion.

The Marks

In considering the similarity between Opposer’s Marks and applicant's mark, we determine whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports*, 73 USPQ2d at 1692.

Opposition Nos. 91152287 and 91152290

Applicant's two marks, KOHLER HOMES and KOHLER ASSOCIATES ARCHITECTS, contain the term KOHLER and the merely descriptive terms HOMES and ASSOCIATES ARCHITECTS. HOMES identifies what applicant builds and ASSOCIATES ARCHITECTS identifies those persons providing applicant's architectural services. Additionally, applicant has disclaimed both HOMES and ASSOCIATES ARCHITECTS. Disclaimed matter is often "less significant in creating the mark's commercial impression." *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001). See also *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972).

The Federal Circuit has recognized that there is nothing improper in giving more weight, for rational reasons, to a particular portion or feature of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). The Court has also stated that "the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'" *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, *In re National Data Corp.*, 224 USPQ at 752. See also *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006) ("When comparing the similarity of marks, a

Opposition Nos. 91152287 and 91152290

disclaimed term, here 'COMMUNICATIONS,' may be given little weight, but it may not be ignored").

We therefore find that the dominant portion of both of applicant's marks is the term KOHLER, which is identical to two of opposer's pleaded registered marks.

Further, with regard to the two pleaded marks for KOHLER, the dominant component of applicant's marks is identical to opposer's marks, and the remaining wording in applicant's marks is merely descriptive. Also, when an opposer's mark is famous such as is the case here, the degree of similarity between the marks need not be as great as when the opposer's mark is obscure or weak. *Kenner Parker Toys*, 22 USPQ2d at 1456. See also *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984) ("less care may be taken in purchasing a product under a famous name"). We therefore find that we find that the marks in their entireties are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports, supra*. See also, e.g., *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997) (likelihood of confusion with addition of the words "The" and "Café" and a diamond-shaped design to registrant's DELTA mark); and *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985) (if "the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral

Opposition Nos. 91152287 and 91152290

differences.") Any differences due to the additional wording in applicant's marks are outweighed by the similarity due to the shared term KOHLER.

Turning now to opposer's THE BOLD LOOK OF KOHLER mark, we find that KOHLER figures prominently in creating the commercial impression of this mark as it identifies what has the "bold look." In other words, the mark makes a statement about KOHLER products. Indeed, as used on opposer's website, the mark emphasizes KOHLER:

**THE BOLD LOOK
OF KOHLER.**

Howley dec. ex. 2. Because applicant's marks have KOHLER as their dominant terms, we find that applicant's marks and opposer's THE BOLD LOOK OF KOHLER mark are similar in meaning and commercial impression, both focusing the consumer on KOHLER as the source indicator. To the extent that opposer's mark and applicant's marks include the term KOHLER, we find them to be more similar than dissimilar in appearance and sound, and find that any differences in appearance and sound due to the additional wording are outweighed by the similarities due to the shared term KOHLER. Thus, we find that applicant's marks are similar to opposer's THE BOLD LOOK OF KOHLER mark.

The *du Pont* factor regarding the similarity of the marks is resolved in opposer's favor.

Goods, Services, Trade Channels and Classes of Purchasers

We now consider the similarity or dissimilarity of applicant's "custom construction of homes" and "architectural design" services and the goods of Opposer's Marks which are primarily plumbing fixtures and fittings for use with plumbing fixtures. We also consider the similarity or dissimilarity of the trade channels and classes of consumers.

It is well established that the goods of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. Rather, it is sufficient that the respective goods of the parties be 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 source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Additionally, inasmuch as there are no restrictions in the registrations and the applications, we must presume that opposer's goods and applicant's services would be sold in all appropriate channels of trade. See

Opposition Nos. 91152287 and 91152290

Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987).

Certainly, both opposer and applicant have current or future homeowners as customers. See Engbert dec. ¶¶ 5 and 6; Kohler dep. p. 71. Additionally, business owners, contractors and builders may take advantage of applicant's architectural services and also purchase fixtures. See, e.g., applicant's admission of opposer's request for admissions no. 14, "[t]he construction of homes encompasses working with homeowners who select fixtures to place into dwellings". Thus, the relevant public for opposer's goods and applicant's architectural design services are homeowners, commercial building owners, contractors and builders, and the relevant public for opposer's goods and applicant's custom construction of homes services are current or future homeowners.³ The classes of consumers hence overlap.

As far as promotional efforts, both parties promote their goods or services in home design magazines and journals as well as newspapers. Kohler dep. pp. 23, 27 and

³ Others may also participate in purchasing decisions; Mr. Engberg has testified that builders, designers, and architects often guide and assist their clients in selecting new fixtures. *Id.* at ¶ 5.

Opposition Nos. 91152287 and 91152290

38 - 40; applicant's response to request for admissions no. 18; Engberg dec. ¶ 8. Both parties have advertised in *Southern Living* magazine and *The Washington Post*.

Opposer has established too that in connection with the marketing of its kitchen and bath fixtures, it provides builders, architects, designers and homeowners with support, educational programs and design tools. By doing so, opposer is closely associated with the home construction, renovation and remodeling industry and has established itself as more than merely a seller of, for example, a fixture for a home.

Specifically, opposer annually attends the International Builders' Show ("IBS") and the Kitchen/Bath Industry Show, and spends millions of dollars on the booths and marketing support for these trade shows. Enberg dec. ¶¶ 10 - 11. Opposer holds programs and events around the country to inform designers and architects about opposer's new products. For the last seven years, opposer hosted dozens of builders at the "Kohler Builders Symposium" in Wisconsin where builders are informed of trends in the home building industry. Opposer has provided nationwide assistance to builders installing KOHLER products, with over 1,000 home builders enrolled in a program wherein opposer provides builders with training and educational support as well as marketing assistance and literature on opposer's products to share with their clients. Bocchini dec. ¶¶ 3 -

Opposition Nos. 91152287 and 91152290

6. Builders also visit the Kohler Design Center, which attracts over 150,000 homeowners, builders, architects and designers each year. The Kohler Design Center is a 36,000 square-foot facility in which opposer displays its kitchen and bath products and offers educational seminars featuring speakers who inform consumers on how to make their homes more attractive, comfortable and practical, including home repairs and modeling projects. Opposer also provides home design services through personal design consultation, and online design assistance though, inter alia, articles on kitchen and bath design, floor plan options and virtual room-planning software. Howley dec. at ¶¶ 2 - 8. Indeed, printouts from opposer's website offer a "Virtual Bath Planner" which allows a homeowner to create a virtual bathroom from his or her own floor plan. Howely dec. ex. 2.

Applicant, of course, provides design services as part of its architectural services. It also assists its customers in choosing and installing fixtures for bathrooms or kitchens as part of its custom construction of homes and architectural design services. See applicant's admission of opposer's request for admissions no. 11 - "The construction of homes encompasses the selection of fixtures to be used in the rooms of a home." In fact, applicant has installed opposer's fixtures for its customers. Kohler dep. p. 21. Thus, opposer, as part of the marketing of its fixtures,

provides design services and assists with the selection of fixtures and applicant, as part of its architectural and custom home construction services, also provides design services and assistance with the selection of fixtures.

When a famous mark is part of the equation in determining the issue of likelihood of confusion, "special care is necessary to appreciate that products [and services] not closely related may nonetheless be confused as to source by the consumer because of the fame of the mark." *Bose*, 63 USPQ2d at 1310. Therefore, and in view of the similarity of the marks, we find that the conditions and activities surrounding the marketing of the goods are such that they could be encountered by the same persons under circumstances that could give rise to the mistaken belief that they originate from or are in some way associated with the same producer, because of the similarity of the marks used therewith.

The *du Pont* factors regarding the similarity of the goods and services, channels of trade and classes of consumers favor a finding of likelihood of confusion in both applications.

Actual Confusion

Opposer maintains that there is evidence of actual confusion between opposer's goods and applicant's services in the record. Opposer relies on Mr. Kohler's testimony

Opposition Nos. 91152287 and 91152290

regarding (i) an encounter at the IBS trade show when Mr. Kohler was asked by a presenter, who saw Mr. Kohler's name card, whether he was connected to opposer; and (ii) occasions when applicant's customers or potential customers asked in meeting with Mr. Kohler, if applicant is connected with opposer. Because Mr. Kohler's last name is the same as opposer's mark, we find that this testimony is not conclusive as to whether actual confusion has occurred.

Mr. Kohler has also testified that when he initially meets a prospective customer, he "always tr[ies to] make it clear that we're not associated with [opposer] so we don't have that confusion in the very beginning of sales." Kohler dep. p. 79. Opposer relies on *Conopco, Inc. v. May Dept. Stores Co.*, 784 F.Supp. 684, 24 USPQ2d 1721 (E.D. Mo. 1992), for the proposition that a voluntary disclaimer is recognized as evidence that the junior user anticipates actual confusion. However, because Mr. Kohler is involved in these meetings, and because his last name is the same as opposer's mark, we similarly discount any significance to his testimony in this regard and do not find that Mr. Kohler's practice is evidence that applicant anticipates confusion.

Opposition Nos. 91152287 and 91152290

The *du Pont* factor regarding actual confusion is neutral in the likelihood of confusion analysis.⁴

Survey

Opposer commissioned a likelihood of confusion survey, which first tested the mark KOHLER HOMES and second tested the mark KOHLER ASSOCIATES ARCHITECTS. The two surveys followed a standard, mall-intercept format. Qualified persons were persons 25 years of age or older who were planning to or recently had (i) a new home built for them designed by an architect or based on plans and specifications they provided, or (ii) renovations or additions made to their home designed by an architect or based on plans and specifications they provided. 34.1 percent of respondents mistakenly believed that custom home construction services provided under the KOHLER HOMES mark were provided by opposer or that applicant was connected, authorized by, or affiliated with opposer. 37.4 percent of respondents mistakenly believed that architectural design services provided under the KOHLER ASSOCIATES ARCHITECTS mark were provided by opposer or that Kohler Associates Architects was connected to, authorized by, or affiliated with opposer. Opposer also relies on the testimony of George Mantis, applicant's expert witness who conducted the

⁴ Actual confusion is not necessary for a finding of likelihood of confusion. *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002).

survey, for an explanation of the survey and his conclusions regarding the survey.

"A mall intercept survey, while clearly admissible and a recognized survey method, is entitled to limited probative weight because it is not based on a random sample and the results cannot be projected to the entire universe of relevant purchasers." *In re Spirits International N.V.*, 86 USPQ2d 1078, 1089 (TTAB 2008), citing *Frank Brunckhorst Co. v. G. Heileman Brewing Co.*, 875 F.Supp. 966, 35 USPQ2d 1102 (E.D.N.Y. 1994); *Calvin Klein Co. v. Farah Manufacturing Co.*, (not reported in F.Supp.), 229 USPQ 795 (S.D.N.Y. 1985); and *R. J. Reynolds Tobacco Co. v. Loew's Theatres, Inc.*, 511 F. Supp. 867, 210 USPQ 291 (S.D.N.Y. 1980). Thus, we cannot infer that the views allegedly reflected in this survey represent the views of the consumers and potential consumers at large.

In addition, the number of actual respondents to the KOHLER HOMES and KOHLER ASSOCIATES ARCHITECTS surveys is small, i.e., 164 and 163, respectively. We cannot determine, and cannot assume, from this limited number of survey participants, that opposer included persons who had constructed or planned to construct homes or additions, or renovated or planned to renovate their homes, such homes and additions spanning the full spectrum in terms of cost and size. Additionally, builders and contractors, who we have

identified as potential purchasers of applicant's architectural services, were not identified as participants in the survey. Neither were designers, which Mr. Engberg has testified assist clients in selecting new fixtures. Engberg dec. ¶ 5.

Accordingly, we give limited weight to the survey, finding only that the survey reinforces opposer's position that there is a likelihood of confusion between opposer's and applicant's marks.

Conditions of Sale

Applicant has argued that confusion is not likely because its customers are discriminating, relying on Mr. Flach's testimony regarding how purchases of applicant's services are made. Brief at pp. 15 - 16. Specifically, Mr. Flach has testified that applicant's customers

tend to interview multiple architectural firms and multiple home builders and view the prior work of these firms. Before making a final decision to work with us, a typical customer will visit our offices to become familiar with our processes and practices. They will also talk with several previous customers about our work. The typical cost for providing architectural drawings for one of our custom homes is 8% of the construction cost and the average price to construct one of our custom houses is \$1,400,000.00.

First, applicant's services are not limited to projects which have a particular cost. Thus, Mr. Flach's testimony is only probative regarding purchasing conditions for similarly priced projects and not for all architectural

Opposition Nos. 91152287 and 91152290

services or custom construction of homes services. Applicant has introduced no evidence regarding purchasing conditions for less expensive services such as the custom construction of an inexpensive home or for architectural services for the addition of a simple deck. Second, even if purchases are made as Mr. Flach has described, we find that the similarity of the marks and the goods and services outweigh any purchaser sophistication. *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). See also *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweighed sophisticated purchasers, involved purchasing decision, and expensive goods). Moreover, the fact that purchasers are sophisticated in a particular field does not necessarily mean that they are knowledgeable in the field of trademarks or immune from source confusion. *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999); and *In re Hester Industries, Inc.*, 231 USPQ 881, 883 (TTAB 1986) ("While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here,

substantially identical marks are applied to related products.”)

The *du Pont* factor regarding the conditions of sale is also neutral in the likelihood of confusion analysis.

Third Party Marks

In connection with the *du Pont* factor regarding the number and nature of similar marks in use on similar goods or services, applicant contends that there are numerous third party uses of KOHLER; and that such uses establish that “KOHLER is not a particularly strong mark and is being used by others for goods and services related to those provided by Opposer under the KOHLER mark.” Brief at p. 20. Applicant relies on Ms. Smith’s declaration and exhibits thereto, including listings from state corporation division databases, webpages and trademark registrations taken from the United States Patent and Trademark Office TARR database.

Ms. Smith’s declaration, her chart and her exhibits are of limited probative value. Many of the goods and services identified in the various trade names containing “Kohler” are goods or services that are not similar to opposer's goods. See, e.g., Kohler City Hardoos Sawmill, ex. 6; Kohler Direct Marketing, Inc., ex. 11; W. Kohler Lamp & Shade Co., ex. 20; Kohler Farm Supply, ex. 26; Kohler Machine Products, Inc., ex. 27; Kohler Mortgage Inc., ex. 28; Kohler Lawn & Outdoor, Inc., ex. 29; Kohler Sprinklers

Opposition Nos. 91152287 and 91152290

and Backflow L.L.C., ex., 38; and Kohler Print Group, LLC, ex. 39. Also, we cannot determine what businesses several entities are involved in from the information provided. See, e.g., Kohler/Dorman Enterprises, Inc. ex. 10; and Kohler of France #1, Inc., ex. 11. Similarly, for several entities with "Construction" in its name, we do not know what type of construction services they provide.

Further, with regard to the webpages Ms. Smith has submitted, there is no information on the extent to which purchasers and prospective purchasers are exposed to them or their familiarity with them. See *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782 (TTAB 2001). The trademark registrations are not helpful either because registrations are not evidence of use of the marks shown therein. They are not proof that consumers are familiar with such marks so as to be accustomed to the existence of the same or similar marks in the marketplace. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). Additionally, such registrations recite goods (musical instruments) and services (printing services) unrelated to opposer's goods.

Thus, the third-party evidence fails to establish that "Kohler" is commonly used in connection with goods similar

to those of opposer.

Conclusion

After weighing each of the relevant *du Pont* factors, and considering the marks in their entirety, we find that applicant's marks for "custom construction of homes" and architectural design" services are likely to be confused with opposer's marks for the goods recited in the registrations for such marks. Opposer has established that its KOHLER marks are famous for purposes of our likelihood of confusion analysis, the marks are sufficiently similar, that there is a sufficient relationship among the goods and services, and that the classes of consumers and trade channels overlap, so that confusion as to source is likely to occur. Accordingly, the opposition under Section 2(d) is sustained.

Dilution

Because we have found for opposer in connection with its likelihood of confusion claim, we do not reach its claim of dilution.

DECISION: The oppositions on the ground of likelihood of confusion are sustained and registration to applicant of both of its marks is refused.