

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed: August 23, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Buzz Seating Inc.
v.
Encore Seating, Inc.

Opposition No. 91210838
to application Serial No. 85473489

S. Corey Hamilton, Charles H. Melville and Theresa L. Nelson of Strauss
Troy for Buzz Seating, Inc.

Steven J. Nataupsky, Lauren Keller Katzenellenbogen and Hans. L. Mayer
for Encore Seating, Inc.

Before Seeherman, Adlin and Heasley, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Encore Seating, Inc. (“Applicant”) applied to register FLITE (in standard characters) for “Office furniture, including chairs,” in Class 20.¹ Buzz Seating Inc. (“Opposer”) opposes registration of this mark on the ground of likelihood of confusion. Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). In

¹ Application Serial No. 85473489, filed November 15, 2011, based on Section 1(b) of the Trademark Act (intent-to-use).

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particular, Opposer asserts that it adopted and has used the mark FLITE for chairs continuously since January 23, 2004; that it has filed a trademark application, Serial No. 85860663, to register the mark FLITE for a “side chair,” also in Class 20; that Applicant’s mark is identical to Opposer’s mark, the class of the goods and the nature of the goods is the same; and that there has been actual customer confusion. Applicant admits that “Opposer’s purported mark is identical to Applicant’s mark,” Answer ¶ 8, but otherwise denies the salient allegations of the notice of opposition.

The Record

By operation of the rules, the pleadings and the file of the opposed application are of record. The record also includes the testimony deposition, with exhibits, of Opposer’s president, Daniel O’Hara, and of Christopher Burgess, Applicant’s Executive Vice President and co-owner. Applicant submitted, by notice of reliance, Opposer’s responses to Applicant’s First Set of Interrogatories and Requests for the Production of Documents, and printouts from various websites.² Opposer made of record by notice of reliance, as rebuttal evidence, excerpts from certain printed publications and webpages.

² It should be noted that documents obtained in response to a document production request cannot, simply by virtue of being produced by the opposing party, be made of record by a notice of reliance. Trademark Rule 2.120(j)(3)(ii). However, two of the four documents were made of record by the testimony of Mr. O’Hara (Exhibit L) and Mr. Burgess (Exhibit 19). The two remaining exhibits appear to be brochures for Opposer’s FLITE line of chairs, and they are extremely similar to the brochures (Exhibits H and I) made of record through Mr. O’Hara’s testimony. Therefore, although we do not consider the specific brochures submitted with Applicant’s notice of reliance, this has no effect on our decision.

Preliminary Issues

In its brief, Applicant included the following footnote:

Encore has offered to limit its Federal Registration to exclude the handful of states where Buzz Seating allegedly has had more than \$40,000 in sales in the past 3 years and Buzz Seating's home state of Ohio. The Board declined this amendment. Encore herein renews its request for this geographic limitation.

39 TTABVUE 9, n.1. By way of background, on March 13, 2015, after the close of Opposer's trial period, Applicant filed a motion to amend its application to seek a concurrent use registration, naming Opposer as an exception to Applicant's claim of exclusive use, and to terminate the present opposition proceeding in favor of a concurrent use proceeding. 23 TTABVUE. Opposer opposed the motion, and on July 28, 2015, the Board denied it. 29 TTABVUE. Applicant did not file a request for reconsideration, or otherwise take any action with respect to this motion, and trial in the opposition proceeded. Even with its footnote, Applicant has not provided any reasons to believe that the Board's denial of its motion to amend was incorrect. Trial and briefing in the opposition is over, and in these circumstances we will not revisit a decision that was made over a year ago. Accordingly, we deny Applicant's renewed request that the Board allow a geographically limited application.³

Also in its trial brief Applicant has stated, citing Section 18, that "If the Board finds that a more precise description of goods in Applicant's Application

³ Our decision herein does not preclude Applicant from filing an application for a concurrent use registration. The issue of whether Applicant is entitled to a concurrent use registration was not tried, and as set forth in the Board's July 28, 2015 order, could not have been raised in this opposition proceeding.

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would alleviate any alleged confusion, Applicant consents to amendment of its Application to recite [executive office chairs with specific features], and “would also consent to limit the marketing channels for its goods....” 39 TTABVUE 11, n. 2. Although the Board has authority, under Section 18, to enter a restriction of an application if that restriction will avoid a likelihood of confusion, the opposer in the proceeding must have notice *prior* to trial that an applicant is seeking a registration with such a restriction, so that the opposer can submit evidence on the issue of likelihood of confusion in connection with the proposed restricted identification as well. *See ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351, 1353-54 (TTAB 2007) (Applicant’s request raised for first time in its trial brief that Board narrow identification of goods under Section 18 denied; opposer was never put on notice of a possible limitation either before or during trial period). Applicant’s untimely offer of a restriction is clearly prejudicial to Opposer, which presented its case based on the current identification in the application. Accordingly, we decide the opposition based on the goods as identified in Applicant’s application.

Standing

Opposer is a manufacturer and seller of commercial office seating, i.e., chairs, including side chairs, stacking chairs, executive chairs, ergonomic chairs and conference room chairs. O’Hara test, 27 TTABVUE 12, 13. It uses the name FLITE to identify a line of its companion chairs, also known as side chairs or stacking chairs. *Id.* at 89. This shows that Opposer has a real interest

in this proceeding, and a reasonable belief that Applicant's registering the identical mark FLITE for chairs will cause Opposer damage. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). Therefore, Opposer has established its standing.

Likelihood of Confusion Ground

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), provides, in part, that a trademark may be registered unless it "consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." Thus, there are two elements to the Section 2(d) ground: priority and likelihood of confusion. And, because Opposer does not own a trademark registration, it is proceeding based on its claim of having a mark previously used in the United States and not abandoned.

Opposer's Use of its Mark

Opposer chose the mark FLITE in 2003 for a line of side chairs. There are four models in this line. O'Hara test, 27 TTABVUE at 31; Opposer's 2004 price book lists a square back stacker, both with and without arms, and a radius back stacker, both with and without arms. O'Hara test Exhibit A, 27 TTABVUE 143. The chairs have a label with the word "Flite" affixed to the underside of each chair seat. *Id.* at 85-86. O'Hara test Exhibit O. Opposer has

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sold its FLITE chairs in 36 states and Puerto Rico, *id.* at 71, with sales from January 1, 2004 through June 17, 2014 totaling \$1.182 million. O'Hara test Exhibit L. The chairs are promoted through independent representatives to dealers, who then buy the product for resale to the ultimate users. 27 TTABVUE 87, 93. Opposer advertises its FLITE chairs through, *inter alia*, brochures that are specific to the FLITE line. These promotional materials are passed out to the independent reps that sell Opposer's goods and to dealers, and they ultimately may reach the end users. *Id.* at 57. Opposer also exhibits at trade shows, *id.* at 105, and promotes its goods on its website, *id.* at 21, and through emails. *Id.* at 26.

Priority

Because Opposer does not have a registration for its mark, priority is in issue. *Cf. King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Mr. O'Hara, Opposer's president, testified that as of December 2003 the FLITE chair was part of Opposer's product line. 27 TTABVUE 36, and that Opposer has sold the FLITE chair every year from 2004 to the present (the testimony deposition was taken on January 5, 2015). *Id.* at 54, 71-72. In support of this testimony Opposer offered documentary evidence, including a brochure for its FLITE line of chairs that was created in early 2004 (O'Hara test Exhibit I); a January 23, 2004 invoice for 104 FLITE STACKER SQUARE ARMLESS chairs to a company located in Charlotte, NC

(O'Hara test Exhibit J); and its pricing books for the years 2004-2006, 2009, 2011 and 2014 (O'Hara test Exhibits A through G).⁴

Applicant's first sale of its FLITE chairs was December 28, 2011, to a company in California. Burgess test, 33 TTABVUE 128. It filed its intent-to-use application on November 15, 2011, so that is the earliest date on which it can rely. *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) ("[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights").

Clearly, Opposer began using its mark FLITE on chairs long prior to the filing date of Applicant's application. However, Applicant argues that Opposer cannot show that it is the prior user because its use of FLITE "has been de minimis or non-existent in all but a handful of states," and that in the remaining states, Applicant "has prior rights through filing its intent-to-use application and through its sales of FLITE executive chairs across the country since 2011." Brief, 39 TTABVUE 2. It appears to be Applicant's position that priority is determined on a state-by-state basis, and that because Opposer cannot show prior use of its mark in each state in the United States prior to

⁴ Mr. O'Hara explained that pricing books were not created in 2008, 2010, 2012 or 2013, and that pricing books were created only when there was a new product or a price increase.

the filing of Applicant's intent-to-use application, Opposer cannot establish priority.

Applicant is incorrect. The Statute does not require that an Opposer show prior use everywhere in the United States in order to show prior rights. On the contrary, the Statute provides only that the mark be previously used *in* (rather than throughout) the United States and not abandoned. *See Panda Travel Inc. v. Resort Option Enterprises Inc.*, 94 USPQ2d 1789, 1795 (TTAB 2009) ("Section 2(d) only requires prior use; it does not require use in commerce); *Cf. Nat'l Cable Television Ass'n Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1429 n.4 (Fed. Cir. 1991) ("Section 14 requires only prior use; 'in commerce' is noticeably absent"). Applicant has provided no support for its contention that priority is determined on a state by state basis when an Applicant is seeking an unrestricted registration.⁵

Applicant also makes the claim, in connection with its contention that Opposer cannot meet its burden to show that it is the senior user, that Opposer "has abandoned any rights it may have even arguably had" in the states where Applicant has been selling its FLITE chairs. Brief, 39 TTABVUE 8-9. Again, Applicant appears to be asserting that abandonment is determined on a state

⁵ Since Opposer need only show commercial use in the United States, and not commercial use in every state in the United States, Applicant's argument that Opposer has made only *de minimis* use of its mark in some states fails. But so that there is no doubt on this point, we find that the sales made by Opposer, as reflected in Exhibit L, evidence use in the United States that constitutes bona fide use in the course of trade.

by state basis. However, the Trademark Statute defines “abandonment” of a mark, in relevant part, as

When its use has been discontinued with intent not to resume such use. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

Section 45, 15 U.S.C. § 1127. There is no mention in this definition of “abandonment” of a mark being abandoned in a particular state, nor of nonuse in a state in which the mark had previously been used. Applicant acknowledges that there has been no consecutive three year period when Opposer has not used its FLITE mark on chairs. Further, the testimony and evidence (in particular O’Hara test Exhibit L) make it clear that Opposer has made continuous use of its mark FLITE on chairs in the United States since at least 2004. Therefore, we find that Opposer has made prior use of the mark FLITE for side chairs, and has not abandoned its rights in the mark.

Opposer has proved the first element of its likelihood of confusion claim by establishing its prior rights to the mark FLITE for side chairs.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In*

re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

The first *du Pont* factor is the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. Opposer uses the mark FLITE, and Applicant has applied to register the same mark. Applicant nevertheless argues variously that Opposer uses the word FLITE as the identifier of a chair model rather than a “brand”; that Opposer did not provide evidence that consumers recognize FLITE as a trademark; and that when viewed in their entireties, the marks create different commercial impressions, presumably due to Applicant’s belief that Opposer’s house mark BUZZ SEATING and a design of a bee forms part of Opposer’s mark. We are not persuaded by any of these arguments. First, Opposer’s witness testified that it is common in the industry to identify products with a name, rather than a stock code. 27 TTABVUE 15. Applicant’s own price list bears this out. Burgess test, Exhibit 13, 33 TTABVUE. As a result, consumers recognize model names as trademarks. Second, although BUZZ SEATING and the bee design are used in the manner of a house mark, such as on the cover of Opposer’s 2011 price list (O’Hara test Exhibit F), the word FLITE appears by itself on the page of the price list featuring FLITE chairs, which is headed “**Flite** Stacking Series.” 27 TTABVUE 163. Tellingly, this is the same way Applicant advertises its own claimed trademark FLITE (“Flite™ Series”). Burgess test Exhibit 13, 33 TTABVUE at 58.

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Because the marks are identical, this *du Pont* factor weighs heavily in Opposer's favor.

The next *du Pont* factor we consider is the similarity or dissimilarity and nature of the goods as described in an application or in connection with which a prior mark is in use. As discussed, Opposer's goods are stacking chairs. They can be used in an office, on the visitor's side of the desk. 27 TTABVUE 14. They can also be used in conference rooms. *Id.* at 93. Applicant's goods, as identified in its application, are "Office furniture, including chairs." Applicant's identified "office chairs" thus encompass Opposer's chairs that are used in offices and office conference rooms; the goods are legally identical. Further, because Applicant identifies office chairs without limitation, they are deemed to travel in all channels of trade that are appropriate for such goods, including the same channels of trade as Opposer's chairs. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (absent restrictions in the application and registration, legally identical goods and services are presumed to travel in the same channels of trade to the same class of purchasers).

Applicant argues that its chairs are different from Opposer's because Applicant's are "premium executive chairs sold to corporate customers for use behind a desk or in a conference room," and that "a person purchasing a stacking chair such as [Opposer's] Flite chair would not buy an executive chair and vice-versa." Brief, 39 TTABVUE 10. Leaving aside the crucial fact that Applicant has not limited its identification of goods to executive chairs, and

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that the goods as identified in its application are legally identical to Opposer's chairs, the specific differences that Applicant points out between its executive chairs and Opposer's side chairs do not avoid a likelihood of confusion. The question is not whether consumers will confuse the chairs, but whether they will be confused as to the source of the goods. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1471 (TTAB 2016). The evidence shows that executive chairs and side chairs are closely related. They are complementary, in that they can be used in the same office. As Mr. O'Hara testified, "you may have an executive chair behind your desk and two side chairs on the other side of your desk as companion chairs." 27 TTABVUE 14. They can also be used for the same purpose, for example, as seating in a conference room. *Id.* at 93. Further, Opposer itself sells both executive chairs and side chairs, and in the case of its MELO chair, uses the same mark on both. 27 TTABVUE 92, Applicant's exhibit 1, *Id.* at 307, 314. As a result, consumers who are familiar with Opposer's FLITE side chair, upon seeing the identical mark FLITE for an executive chair, are likely to believe that Opposer has similarly expanded its line under this mark.

As for the channels of trade, as we previously said, the legally identical goods must be presumed to be sold in the same channels of trade. Even apart from that presumption, the evidence shows that both Opposer and Applicant sell their chairs through independent representatives to dealers or distributors who, in turn, sell them to the ultimate users. Competing companies' chairs,

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including executive chairs and side chairs, can be sold by the same dealers or distributors to the same customers. TTABVUE 88, 90. In this connection, Mr. O'Hara testified that Opposer's customers include "corporate America" and Mr. Burgess testified that Applicant's customers include "corporate companies." 27 TTABVUE 93-94, 33 TTABVUE 131-32.

The *du Pont* factor of similarity or dissimilarity of established, likely-to-continue trade channels favors Opposer.

As for the *du Pont* factor of the conditions under which and buyers to whom sales are made, Applicant asserts that the purchasers of its executive chairs are either very sophisticated, or they consult with dealers or interior designers or architects. Brief, 39 TTABVUE 11.

We must assess the conditions of purchase based on Opposer's common law rights, rather than on theoretical purchasers based on the identification in a registration. Thus, we have no information that Opposer's chairs are sold to individuals--for example, for use in a home office—who might be assumed to be unsophisticated purchasers or to exercise no more than ordinary care. Rather, Mr. O'Hara testified that the dealers would sell the chairs to the end user, e.g., corporations, schools and the government. 27 TTABVUE 93-94. In the absence of any testimony or other evidence that Opposer's common law rights extend to sales to individuals for personal use, we assume that the ultimate purchasers of the chairs are companies or institutions that would exercise care in their purchasing decisions. Although this *du Pont* factor favors

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Applicant, it is not sufficient to outweigh the identical marks, legally identical goods and legally identical channels of trade. *See HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods).

There are two final *du Pont* factors that have been discussed and/or for which evidence has been submitted. One would fall under the “any other fact” 13th factor, and is essentially that Applicant adopted its mark in good faith because it conducted a search in an industry group publication and had its attorneys conduct a search for conflicting registered marks. Evidence of an applicant’s bad faith adoption of its mark is relevant to the determination of likelihood of confusion. *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1891 (TTAB 2008) (bad faith is strong evidence that confusion is likely, as such an inference is drawn from the imitator’s expectation of confusion). However, it does not follow that good faith adoption shows *no* likelihood of confusion. *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1834 (TTAB 2012). This *du Pont* factor is neutral.

Opposer asserts that the factor of “the nature and extent of any actual confusion” also favors its position. Opposer points to two instances. In the first instance, Mr. O’Hara testified that Opposer’s special projects manager, Art Jacobs, contacted him to ask if he was aware of Applicant’s use of the mark FLITE. 27 TTABVUE 79. Although this showed Mr. Jacobs’ concern about the

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possibility of confusion, Mr. Jacobs himself was clearly not confused. The second instance, also reported through Mr. O'Hara's testimony, was a call Mr. O'Hara received by a new dealer who wanted a price quote for FLITE chairs. Mr. O'Hara testified that during his questioning of the caller he determined that the caller was interested in another company's chair, and Mr. O'Hara then found through a Google search that it was Applicant's chair. Mr. O'Hara could not remember who the dealer was, and could not pin down a date to anything closer than "it was around the end of 2012, maybe the beginning of 2013, something in that time period." *Id.* at 78.

We recognize that it is difficult to find evidence of actual confusion, and that when there is such evidence it can be very persuasive in showing likelihood of confusion. However, Mr. O'Hara's testimony is so vague as to details, especially the lack of information as to who the dealer was, that we treat this factor as neutral. Nevertheless, the other factors that favor Opposer's position are sufficient for us to find likelihood of confusion.

In view of the marks being identical, and the goods and channels of trade being legally identical, we find that Applicant's use of FLITE for "Office furniture, including chairs" is likely to cause confusion with Opposer's previously used and not abandoned mark FLITE for stacking or side chairs.

Decision: The opposition is sustained.