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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/197989

APPLICANT: Salton, Inc.

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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: BEYOND

CORRESPONDENT'S REFERENCE/DOCKET NO: 09741620-011

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Salton, Inc.	:	BEFORE THE
Trademark:	BEYOND	:	TRADEMARK TRIAL
Serial No:	78197789	:	AND
Attorney:	Samual Fifer	:	APPEAL BOARD
Address:	Sonnenschein Nath & Rosenthal LLP 8000 Sears Tower Chicago, IL 60606	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

FACTS

On December 26, 2002, Applicant filed an application for the trademark BEYOND for “Electric household kitchen appliances, namely, ovens, microwave ovens, convection ovens, toaster oven, toasters, grills, electric slow cookers, roasters, coffee makers and bread makers, hand held electric hair dryers, commercial and stationary hair dryers; whirlpool baths for feet’ heat and steam facial saunas, portable electric water heaters and aerators for washing and refreshing feet for domestic use; parts and replacement parts therefore.” In the First Office Action, the Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d) for likelihood of confusion with registration No. 2003965 for the mark BEYOND for “retail store services in the field of linen products, housewares and home furnishings.” The Applicant subsequently responded to the refusal.

On February 10, 2004, the Examining Attorney issued a Final refusal under Section 2(d), which addressed each of Applicant’s arguments and contained evidence in the form of web pages from Registrant’s website. Applicant then filed this appeal, requested reconsideration and amended the identification of goods by deleting the term “household”. The deletion of the term raised a new issue because “household” is a limiting term. And the deletion of the term from the identification broadened the scope of the goods beyond appliances strictly for household use, as specified in the original application. Applicant subsequently amended the wording back to the original identification and continued the request for reconsideration of the substantive refusal. The

Examining Attorney reaffirmed the refusal and the application was returned to the Trademark Trial and Appeal Board for the resumption of this appeal. In its appeal brief, Applicant has attached additional evidence and exhibits not submitted previously. The examining attorney objects to any additional evidence because the record must be complete prior to the Appeal. TMEP Section 710.01(c).

ARGUMENTS

I. The Household Goods Identified in the Application Are So Similar to the Registrant's Retail Services for Home Furnishings as to Cause a Likelihood of Confusion Between the Identical Marks.

Taking into account the relevant *Du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

Applicant has applied for the mark BEYOND in typed form. The Registrant's mark is a slightly stylized form of the same word. Registration of a mark in typed or standard character form means that the mark may be displayed in any lettering style. 37 C.F.R. §2.52(a). The rights associated with a mark in typed or standard character form reside in the wording itself. TMEP

§1207.01(c)(iii). Therefore, the Applicant's mark and the mark of the Registrant are essentially identical.

If the marks of the respective parties are identical, the relationship between the goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Amtcor, Inc. v. Amtcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981); TMEP §1207.01(a).

Additionally, consumers are likely to be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods. *See In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (BIGG'S for retail grocery and general merchandise store services held confusingly similar to BIGGS for furniture); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for retail women's clothing store services and clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (design for distributorship services in the field of health and beauty aids held likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB for various items of men's, boys', girls' and women's clothing held likely to be confused with THE "21" CLUB (stylized) for restaurant services and towels); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (STEELCARE INC. for refinishing of furniture, office furniture, and machinery held likely to be confused with STEELCASE for office furniture and accessories);

Mack Trucks, Inc. v. Huskie Freightways, Inc., 177 USPQ 32 (TTAB 1972) (use of similar marks for trucking services and on motor trucks and busses is likely to cause confusion).

“It is well recognized that confusion is likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the other.” TMEP Section 1207.01(a)(iii). However, Applicant argues that “linen products, housewares and home furnishings” does not name or cover any of the appliances named in Applicant’s identified goods. This argument is unsupported by the evidence. In the denial of Applicant’s request for reconsideration, the Examining Attorney submitted the definition of **furnishing** as: 1. A piece of equipment necessary or useful for comfort or convenience; 2. **furnishings**. The furniture, *appliances*, and other movable articles in a home or other building. (Emphasis added). (Office Action, May 16, 2005). Applicant’s identified household kitchen appliances are certainly within the definition for *furnishings*, namely, appliances in a home. Applicant must also concede that its goods are “equipment necessary or useful for comfort or convenience.” The Examining Attorney also submitted evidence that the Registrant’s retail store services include the sale of household appliances such as toasters, toaster ovens, grills, electric slow cookers, coffee makers, bread makers, electric hair dryers, and remote foot spas. (See web pages attached to Office Action, Feb. 10, 2004). This evidence was not, and cannot be used to show how registrant uses its mark, as Applicant has tried to do. The combination of the evidence and the dictionary definitions shows that the goods involved with Registrant’s retail services are clearly identical to the goods identified under Applicant’s mark.

Applicant also argues that the kitchen and personal care appliances described in Applicant’s application will be sold in conjunction with Applicant’s BEYOND home network and that the

appliances will include specially manufactured equipment. (Applicant's Brief, p. 6). However, likelihood of confusion is determined on the basis of the goods or services as they are identified in the application and the registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Since the identification of the applicant's goods has not been limited in any way to distinguish the goods from the registrant's services, it is presumed that the application encompasses all goods and/or services of the type described, including those in the registrant's identification, that they move in all normal channels of trade and that they are available to all potential customers. TMEP §1207.01(a)(iii). Although the examining attorney recommended that Applicant amend the identification to distinguish the goods, Applicant made no attempt to distinguish the goods in the identification by amendment other than to delete the wording "household", which was an impermissible expansion of the scope of the goods. Additionally, there is no guarantee that an amendment to identify Applicant's goods more specifically would distinguish the goods from Registrant's services enough to prevent a likelihood of confusion.

Applicant also argues that, "Because the owner of the cited mark is Bed Bath & Beyond ("BB&B"), a well known national chain of retail housewares stores, any use of the word BEYOND in connection with BB&B would instantly be recognized, in context, as a shortened version of the mark BED BATH & BEYOND." (Applicant's Brief, pp. 7-8). Even if this unsupported statement is true, it is inconsequential to the 2(d) analysis. The purpose of a trademark/service mark is to connect the goods/services to the source of those goods/services. If consumers were to see

Registrant's mark and mentally make the connection to Bed Bath & Beyond, there is nothing to keep them from seeing the same mark on Applicant's household appliances and connecting them to the Registrant, Bed Bath & Beyond. Section 2(d) of the Trademark Act is meant to prevent this type of confusion. Additionally, Applicant's attempt to argue that the Registrant only uses the BEYOND mark in connection with the mark BED BATH & BEYOND should be disregarded. In a likelihood of confusion analysis, the mark and goods or services specified in the application are compared only with the mark and the goods or services identified in the registration. Applicant cannot provide extrinsic arguments or evidence as to how the Registrant provides its goods or services or uses its mark. This argument is also nullified by the fact that Registrant has filed a Section 8 affidavit showing use of the mark BEYOND alone in advertising for kitchen appliances.

II. The Registration is Entitled to Protection Against Applicant's Identical Mark for Goods Directly Related to Registrant's Services.

In Applicant's brief, argument numbers 2 and 3 are essentially the same. Specifically, Applicant states that the cited Registration is weak and consequently deserves only a narrow scope of protection even though Applicant previously argued that the Registrant was well known and the word BEYOND would instantly be recognized as a shortened version of Bed Bath & Beyond. (Applicant's Brief, p. 7). First, the argument that the registered mark is weak is unsupported by evidence. Applicant has attached a list of registrations from a search of the USPTO's trademark database which contain the term BEYOND. (Exhibit M, Applicant's Brief). As stated previously, the examining attorney objects to this evidence because the record must be complete prior to the appeal. 37 C.F.R. §2.142(d); TMEP Section 710.01(c). Additionally, Applicant's evidence is in the form of a list of registrations *and* applications. The submission of a list of registrations does not make these registrations part of the record. *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974).

TMEP Section 710.03. Additionally, the registrations in the list provided by Applicant previously either: 1) do not provide the same commercial impression as the identical marks at issue because of additional wording in the mark, or 2) they do not contain the same or similar goods and services.

Second, third-party registrations, by themselves, are entitled to little weight on the question of likelihood of confusion. *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of those marks. *In re Comexa Ltda*, 60 USPQ2d 1118 (TTAB 2001); *National Aeronautics and Space Admin. v. Record Chem. Co.*, 185 USPQ 563 (TTAB 1975); TMEP §1207.01(d)(iii). Further, existence on the register of other confusingly similar marks would not assist applicant in registering yet another mark which so resembles the cited registered mark that confusion is likely. *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999).

Third, Applicant repeatedly mentions that it is the owner of a different application for the mark BEYOND for different goods that has been issued a Notice of Allowance. This is inconsequential. Prior decisions and actions of other trademark examining attorneys in registering other marks with different records are without evidentiary value and are not binding upon the Office. Each case is decided on its own facts, and each mark stands on its own merits. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); *In re Consolidated Foods Corp.*, 200 USPQ 477 (TTAB 1978); TMEP Section 1216.01.

And finally, even if applicant had shown that the cited mark is “weak,” such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services. *See Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976) and cases cited therein. Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant’s ownership of the mark and of the registrant’s exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate. TMEP Section 1207.01(d)(iv). Applicant states, “As the only term common to both Applicant’s mark and the Cited Mark is very weak, the Cited mark should only be afforded a narrow scope of protection.” (Applicant’s Brief, p. 9). This rule does not apply in this case. The only term common to both marks is the *only* term in marks. The marks are identical. And Applicant has provided no evidence that registered mark is weak.

Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

CONCLUSION

The marks of the parties are identical. Therefore, there will be a likelihood of confusion between the marks because the goods specified in Applicant’s identification of goods are the same or highly similar to the goods provided through Registrant’s retail store services. The Registrant is entitled to protection. Any extrinsic arguments or evidence should not be considered. For the foregoing

reasons, the refusal of the mark for likelihood of confusion under Section 2(d) of the Trademark Act should be affirmed.

Respectfully submitted,

/Michael Webster/

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