

This Opinion is Not a
Precedent of the TTAB

Mailed: April 8, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Joe A. Machiz
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Serial No. 88238871
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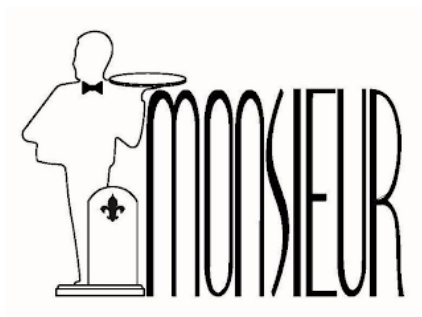
James T. Hollin, Jr. of JT Hollin, Attorney at Law, P.C.,
for Joe A. Machiz.

Tiffany Y. Chiang, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

—
Before Wellington, Shaw, and Dunn,
Administrative Trademark Judges.

Opinion by Dunn, Administrative Trademark Judge:

Joe A. Machiz (Applicant) seeks registration on the Principal Register of the mark¹



¹ Application Serial No. 88238871 filed on December 21, 2018, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's allegation of a bona fide intention to use the mark in commerce.

for “accent furniture; buffets being furniture; custom furniture; patio furniture; tables” in International Class 20. The application describes the mark as “the silhouette of a male waiter wearing a bowtie, standing on a pedestal having a fleur de lis emblem, the waiter balancing an oval-shaped tray horizontally on his left hand and immediately to the right of the silhouette, the word ‘MONSIEUR’ appears in large capital letters.”

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied to the goods identified in the application, so resembles the registered mark MONSIEUR MARBLE (standard characters) for “coasters, not of paper or textile; drinking glasses; flasks; mugs; plates; serving trays; soapstone cubes for chilling whiskey,” in International Class 21,² on the Principal Register as to be likely to cause confusion, to cause mistake, or to deceive.

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

I. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of

² Registration No. 5531224, issued July 31, 2018.

confusion factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors, and the other relevant *DuPont* factors now before us, are discussed below. We must consider each relevant *DuPont* factor for which there is evidence or argument. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

As a preliminary matter we address Applicant's contention that an earlier decision by a different examining attorney should be treated as "prima facie evidence" that there is no likelihood of confusion here.³ Applicant argues that her prior application



for the similar mark for almost the same goods, later abandoned, was pending and not cited as a potential bar to registration of the Registrant's application, and so, we should not allow Registrant's registration to bar

³ 4 TTABVUE 12-15. Citations in this opinion to the briefs refer to TTABVUE, the Board's online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear.

Applicant's second, similar application.⁴ This argument is not persuasive because the decision of an examining attorney is not a judgment, and is not binding on the Board, which must decide each case on its own merits. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). *Accord In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994); *In re BankAmerica Corp.*, 231 USPQ 873, 876 (TTAB 1986).

A. Strength of the Registered Mark

The fifth *DuPont* factor is the “fame” or strength of the prior mark, and the sixth factor is the number and nature of similar marks in use for similar goods. *DuPont*, 177 USPQ at 567. In determining the strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and, if evidence is submitted (which it was not in this case), commercial strength, based on recognition in the relevant market. *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”). “In order to determine the conceptual strength of the cited mark, we evaluate its intrinsic nature, that is, where it lies along the generic-descriptive-suggestive-arbitrary (or fanciful) continuum of words.” *In re Davia*, 110 USPQ2d 1810, 1815 (TTAB 2014).

The Examining Attorney and Applicant do not agree on the strength of the term MONSIEUR, which the Examining Attorney argues is the dominant feature of the

⁴ Application Serial No. 86643668 filed May 28, 2015 under Section 1(b) of the Trademark Act for “furniture; furniture made from wood or substitutes for wood; library furniture; patio furniture; tables” was abandoned January 21, 2019 for failure to file the statement of use.

registered mark.⁵ The Examining Attorney submitted the dictionary definition for the term MONSIEUR, which is defined as “a Frenchman of high rank or station — used as a title equivalent to Mister and prefixed to the name of a Frenchman.”⁶ An arbitrary mark is a “known word used in an unexpected or uncommon way.” *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004). *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (an arbitrary term is “conceptually strong as a trademark”). Because the record shows no connection, descriptive or otherwise, between the term MONSIEUR and the registered goods “coasters, not of paper or textile; drinking glasses; flasks; mugs; plates; serving trays; soapstone cubes for chilling whiskey,” we find that the term MONSIEUR in the mark is arbitrary, and conceptually strong as applied to the registered goods.

Under the sixth *DuPont* factor, a mark’s strength may be curtailed by extensive third party use of similar marks with similar goods or services. *Jack Wolfskin Austrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135-1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015). Although registrations are not proof of use, third party registrations may indicate that a mark carries a suggestive or descriptive connotation in the particular industry,

⁵ 6 TTABVue 6.

⁶ March 21, 2019 Office Action, TSDR 8 [pdf]. Citations to the application record are to downloaded pages from the USPTO’s Trademark Status & Document Retrieval (TSDR) database.

and is weak for that reason. *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694 (Fed. Cir. 2018) (“The purpose of introducing evidence of third-party use is “to show that customers have become so conditioned by a plethora of such similar marks that customers ‘have been educated to distinguish between different [such] marks on the bases of minute distinctions.’”) (citations omitted); *Juice Generation* at 1675, citing *Anthony’s Pizza & Pasta Int’l, Inc.*, 95 USPQ2d 1271, 1278 (TTAB 2009) (“The testimony, third-party registrations, and telephone listings are sufficient to show that the name ‘Anthony’s’ has been extensively adopted, registered and used as a trademark for restaurant services, in particular for Italian restaurants and pizzerias, and therefore that ‘Anthony’s’ has a significance in this industry. ... As a result, a mark comprising, in whole or in part, the name ‘Anthony’s’ in connection with restaurant services should be given a restricted scope of protection.”).

Here, Applicant has not submitted evidence that the term MONSIEUR has been extensively registered in the housewares industry so as to undercut its strength when applied to Registrant’s goods. Instead, Applicant confuses registrations within a specific industry with registrations within an international class, and argues that if a mark is registered more than once within an international class, this is sufficient to weaken the scope of protection for the mark.⁷ While each international

⁷ 4 TTABVue 21-23. Applicant submitted 25 third party MONSIEUR registrations which Applicant describes as five MONSIEUR registrations for International Class 3 cosmetics, perfumes, or makeup products; seven MONSIEUR registrations for International Class 35 and 43 restaurant services, or providing of food and drink; five MONSIEUR registrations for International Class 3 wines, alcoholic beverages, and/or beers; three MONSIEUR registrations for International Class 25 clothing, pants, shirts, sweaters, dresses, and other

classification has a broad heading, there is no factual or legal support for finding that all items within the class belong to the same industry for the purpose of assessing the strength of a mark. *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 128 USPQ2d at 1694 (“[T]he present analysis [of whether third party use affects the mark’s scope of protection] only involves goods like those being offered by the parties to the ‘relevant public,’ while third-party use outside of that relevant market is meaningless.”); *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (“Symbolic has neither introduced evidence, nor provided adequate explanation to support a determination that the existence of I AM marks for goods in other classes, e.g., its class 25 registration for clothing, support a finding that registrants’ marks are weak with respect to the goods identified in their registrations.”). *See also In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (“Classification is solely for the ‘convenience of Patent and Trademark Office administration,’ and ‘is wholly irrelevant to the issue of registrability under section 1052(d)’”) (citations omitted).

In assessing the strength of the registered mark MONSIEUR MARBLE, there little dispute that the term MARBLE has descriptive significance as applied to the goods. The term MARBLE is defined as “limestone that is more or less crystallized by metamorphism, that ranges from granular to compact in texture, that is capable

types of clothing; and two MONSIEUR registrations for International Class 9 household appliances goods, and argues “[b]y analysis of the examples above, it is established that the frequent use of the word, ‘MONSIEUR’ for marketing a similar, or essentially the same, product or service within the same specific International Class (IC) by multiple entities, is permitted by USPTO.”

of taking a high polish, and that is used especially in architecture and sculpture.”⁸ Because the term MARBLE may describe the material composition of the registered “coasters, not of paper or textile; drinking glasses; flasks; mugs; plates; serving trays; soapstone cubes for chilling whiskey,” it will be perceived as descriptive as applied to the goods.⁹ In fact, in its brief Applicant asserts “the standalone term ‘MONSIEUR MARBLE’ evidently attempts to create the hint that the product is beverage coasters made of marble.”¹⁰ While the term MARBLE is not disclaimed in the registration, the absence of a disclaimer does not mean that a word or phrase in a registration is distinctive in the registered mark, so that that part of the mark must be treated the same as an arbitrary feature. *See In re Detroit Athletic Co.*, 128 USPQ2d at 1050 (“[T]he record evidence shows that, regardless of whether ‘Co.’ and ‘Club’ were disclaimed, they do not serve source-identifying functions); *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) (“The registration affords prima facie rights in the mark as a whole, not in any component. Thus, a showing of

⁸ <https://www.merriam-webster.com/dictionary/marble>. Merriam-Webster, <https://www.merriam-webster.com/> (3/31/20). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

⁹ Because the identification of goods does not specify marble as the material composition of the registered goods, the Examining Attorney erred in contending that, based on the specimen in the registration file, “marble clearly is a key feature and primary composition of Registrant’s goods.” 6 TTABVUE 7. The nature and scope of a party’s goods must be determined on the basis of the goods recited in the application. *In re Detroit Athletic Co.*, 128 USPQ2d at 1052 (“The relevant inquiry in an ex parte proceeding focuses on the goods and services described in the application and registration, and not on real-world conditions.”).

¹⁰ 4 TTABVUE 20.

descriptiveness or genericness of part of a mark does not constitute an attack on the registration.”).¹¹

Based on this record, we find that the dominant feature of the mark MONSIEUR MARBLE for the registered goods is the arbitrary term MONSIEUR. While the addition of the descriptive term MARBLE creates a more narrow commercial impression for the mark MONSIEUR MARBLE than the literal term MONSIEUR standing alone, MONSIEUR MARBLE is arbitrary as applied to Registrant’s “coasters, not of paper or textile; drinking glasses; flasks; mugs; plates; serving trays; soapstone cubes for chilling whiskey.” As an arbitrary mark, MONSIEUR MARBLE is conceptually strong, and there is no record evidence of third party use on similar goods which warrants narrowing the scope of protection we give to arbitrary marks. In sum, the fifth and sixth *DuPont* factors favor a likelihood of confusion.

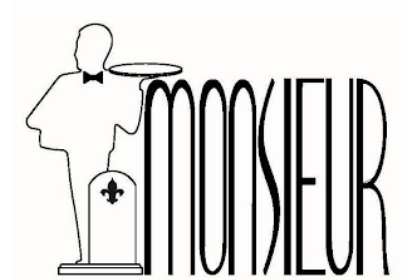
B. Similarity or Dissimilarity of the Marks

We consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression. *See Palm Bay*, 73 USPQ2d at 1689. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746

¹¹ To the extent that Applicant contends in her brief (4 TTABVUE 20-21) that the registered mark is not in use in commerce with the goods and/or is ornamental as applied to the goods, we give no consideration to the impermissible collateral attack on the cited registration. Under Trademark Act Section 7(b), a certificate of registration is prima facie evidence of the validity of the registration. 15 U.S.C. § 1057(b). If an applicant believes a cited registration is invalid, those arguments will not be heard in an ex parte proceeding; instead the applicant must petition to cancel the registration. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re Fiesta Palms*, 85 USPQ2d 1360, 1363 (TTAB 2007); Trademark Manual of Examining Procedure (TMPEP) § 716.02(a) (2019).

(TTAB 2018), *aff'd*, Slip Op. No. 18–2236 (Fed. Cir. Sept. 13, 2019) (mem) (*quoting In re Davia*, 110 USPQ2d at 1812). The proper focus is on the recollection of the average purchaser, who retains a general impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (*citing Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)).

In comparing the two marks in their entireties, we find that the identical term MONSIEUR is the dominant feature in both the registered mark MONSIEUR



MARBLE in standard characters and Applicant's mark

In the case of marks, such as Applicant's, consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (*citing CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). The verbal portion of a word and design mark "likely will appear alone when used in text and will be spoken when requested by consumers." *Id.* at 1911. In this case, the commercial impression created by the literal element of the mark is not diluted but reinforced by the design element. As defined in the record, the term MONSIEUR designates a French male title indicating high station, and the design

incorporating a waiter wearing a tie and bearing a tray on one hand near what could be a stone or marble pedestal with the fleur-de-lis, portrays household or hospitality industry service with a French connotation. *See In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007) (“[B]ecause a stars motif is often associated with the United States, the stars design tends to simply reinforce the component USA in applicant’s mark, rather than having a separate connotation or making a separate impression”); *In re Wilson*, 57 USPQ2d 1863, 1865 (TTAB 2001) (“[T]he illustration of pine cones merely reinforces the dominance of the arbitrary designation PINE CONE”); *In re N. Am. Free Trade Ass’n*, 43 USPQ2d 1282, 1288 (TTAB 1997) (“[T]he globe design featuring North America reinforces that [the literal term] NAFTA is a reference to the treaty.”).

The stylized lettering of the term MONSIEUR in Applicant’s mark does not create a strong impression on its own, and it does not alter the dominant impression created by the term MONSIEUR. Moreover, because the mark MONSIEUR MARBLE is registered in standard characters, Registrant may employ any font, size, style, or color when using the mark, including the same font and style used by Applicant. *See In re Viterra Inc.*, 101 USPQ2d at 1909; *In re Davia*, 110 USPQ2d at 1814.

The dominant part of each mark thus is identical in spelling, sound, and meaning. Notwithstanding the addition of the descriptive term MARBLE in Registrant’s mark and the stylization and design element in Applicant’s mark, the marks create highly similar commercial impressions: a French man of high station. Our ultimate conclusion rests upon a comparison of the marks in their entireties. *In re Nat’l Data*

Corp., 224 USPQ at 751 (Fed. Cir. 1985). The similarities outweigh the differences between the marks, and so we find a high degree of similarity between the marks. As such, this first *DuPont* factor weighs in favor of finding a likelihood of confusion.

C. Similarity or Dissimilarity of the Goods and Channels of Trade

We turn to the *DuPont* factors regarding the similarity or dissimilarity of the respective goods and channels of trade, including prospective purchasers. The issue is not whether the goods will be confused with each other, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”). It is sufficient that the goods of the applicant and the registrant are related in some manner or that the conditions surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 14711, 1476 (Fed. Cir. 2000) (“[A]lthough the services are different, it is reasonable to believe that the general public would likely assume that the origin of the services are the same”).

Here, the mark MONSIEUR MARBLE is registered for “coasters, not of paper or textile; drinking glasses; flasks; mugs; plates; serving trays; soapstone cubes for



chilling whiskey.” Applicant seeks to register her mark for

“accent furniture; buffets being furniture; custom furniture; patio furniture; tables.”

In determining whether the goods are related, it is not necessary that we find a likelihood of confusion between all of the registered goods and all the goods listed in the application. When we consider the similarity of the parties’ goods, it is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods in a particular class in the application. *See Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d at 1409.

“Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods and services are used together or used by the same purchasers; advertisements showing that the relevant goods and services are advertised together or sold by the same manufacturer or dealer; or copies of use-based registrations of the same mark for both the applicant’s services and the goods listed in the cited registration.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, *4-5 (TTAB 2019). Here, the Examining Attorney submitted nine registrations, based on

use in commerce, to show the same mark being used on goods listed in the application and goods listed in the registration:¹²

Registration 1883486 shows the same mark for goods identified as furniture tables and furniture for house, office and garden in International Class 20, and coasters not of paper or table linen, plates, and serving trays, in International Class 21.¹³

Registration 3690909 shows the same mark for goods identified as tables in International Class 20, and serving trays, plates, and coasters made of non-precious metal, plastic, wood, cork, and paper, in International Class 21.¹⁴

Registration 5375256 shows the same mark for goods identified as furniture in International Class 20, and coasters not of paper or textile, in International Class 21.¹⁵

Registration 5579222 shows the same mark for goods identified as furniture, tables, and custom furniture in International Class 20, and ceramic plates, copper coasters, and tea drinking glasses, in International Class 21.¹⁶

Registration 3047163 shows the same mark for goods identified as furniture chests in International Class 20, and serving trays not of precious metal and coasters not of paper or linen, in International Class 21.¹⁷

Registration 3021262 shows the same mark for goods identified as household, garden and patio furniture in International Class 20, and drinking glasses, mugs, serving trays not of precious metal, and coasters, in International Class 21.¹⁸

Registration 3712766 shows the same mark for goods identified as buffets, bedroom furniture, living room furniture, and tables, in International Class

¹² Other registrations submitted by the Examining Attorney have expired or been cancelled, and are not listed. A cancelled or expired registration is not evidence of any presently existing rights in the mark shown or that it was ever used. *Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989); *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1606 (TTAB 2018).

¹³ March 21, 2019 Office Action, TSDR 46-47.

¹⁴ *Id.* at 50-51.

¹⁵ *Id.* at 59.

¹⁶ *Id.* at 65-66.

¹⁷ July 10, 2019 Office Action, TSDR 41-42.

¹⁸ *Id.* at 43-44.

20, and plastic coasters and coasters not of paper or linen, in International Class 21.¹⁹

Registration 4171679 shows the same mark for goods identified as tables in International Class 20, and coasters not of paper or linen, dinner plates, buffet plates, and mugs, in International Class 21.²⁰

Registration 5386470 shows the same mark for goods identified as furniture in International Class 20, and coasters, not of paper or textile, plastic coasters, and trays for household purposes, in International Class 21.²¹

“Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source.” *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff’d*, 864 F.2d 149 (Fed. Cir. 1988) (unpublished table decision). *Accord In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1737 (TTAB 2018) (third party registrations support finding “optical lenses, namely, corrective lenses sold through eye care professionals” related to “spectacles, spectacle cases, spectacle lenses, spectacle settings, spectacle frames, glasses for sport, protective helmets for sports, binoculars, parts of these goods included in this class” and “ski glasses, ski goggles, goggles for sports, protective sport helmets; sunglasses, bags specifically adapted for protective helmets”); *In re Sela Prods., LLC*, 107 USPQ2d 1580, 1586 (TTAB 2013) (third party registrations support

¹⁹ *Id.* at 46-47.

²⁰ *Id.* at 49.

²¹ *Id.* at 52.

finding “surge protector” related to “audio and video cables and other audio and video accessories”); *In re G.B.I. Tile and Stone*, 92 USPQ2d 1366, 1369 (TTAB 2009) (third party registrations support finding “roofing tiles and trim” related to “stones, ceramic floor tiles, porcelain floor tiles”); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993) (third party registrations support finding “leather sold in bulk” related to “all-purpose sports bags, luggage, attache cases, portfolio briefcases, and handbags”).

Here, the evidence of the third party registrations is corroborated by the Internet evidence that registrant’s coasters, drinking glasses, flasks, mugs, plates, serving trays, and soapstone cubes, and Applicant’s furniture, are complementary goods that are available from the same source, and are identified with the same mark. *See Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1789 (Fed. Cir. 1990) (“[T]he record supports no other factual findings but that modems and computer programs are commonly used together in networking, could come from a single source, and be identified with the same mark”); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991) (“The [women’s shoes and women’s pants, blouses, shorts and jackets] sold by applicant and registrant are considered to be complementary goods. They may be found in the same stores, albeit in different departments.”). The Examining Attorney submits pages from eight different third party home furnishing websites (Crate & Barrel, Pottery Barn, West Elm, Magnolia Home, Serena & Lily, World Market, Howard Miller, and Cyan Design) offering furniture and accessories,

such as coasters.²² In addition to listing product categories of furniture and accessories, or the accessories subcategory “tabletop,” the home furnishing websites provide various means for choosing furnishings such as plates, coasters, and serving trays which will complement different styles of furniture. Crate and Barrel offers software applications to “create a mood board” of furniture and accessories.²³ Pottery Barn advertises rattan outdoor furniture with rattan-covered glassware.²⁴ West Elm and World Market allow the customer to search by room, by style, or by material, which produces results from all categories.²⁵ In this way the home furnishing website pages invite customers to connect the two distinctly different yet complementary types of products (furniture and tabletop accessories) as the customers choose a certain look in their homes. As noted above, the question is not whether purchasers can differentiate the goods themselves but rather whether purchasers are likely to confuse the source of the goods. The complementary nature of the goods, emphasized by the way the goods are marketed to consumers, is a factor that weighs in favor of a finding of likelihood of confusion.

Applicant points out (4 TTABVUE 11) that the website evidence of third-party use does not include photographs of the goods bearing the mark:

Upon clicking each individual hyperlink sequentially, one is led to color photographs displaying advertisements of a “piano” coaster, and a cayman coaster (apparently brand names); (b) night stands and side tables, with none

²² March 21, 2019 Office Action TSDR 9-45 [pdf]; July 10, 2019 Office Action, TSDR 8-40 [pdf].

²³ March 21, 2019 Office Action TSDR 15.

²⁴ *Id.* at 26.

²⁵ *Id.* at 32; July 10, 2019 TSDR 31.

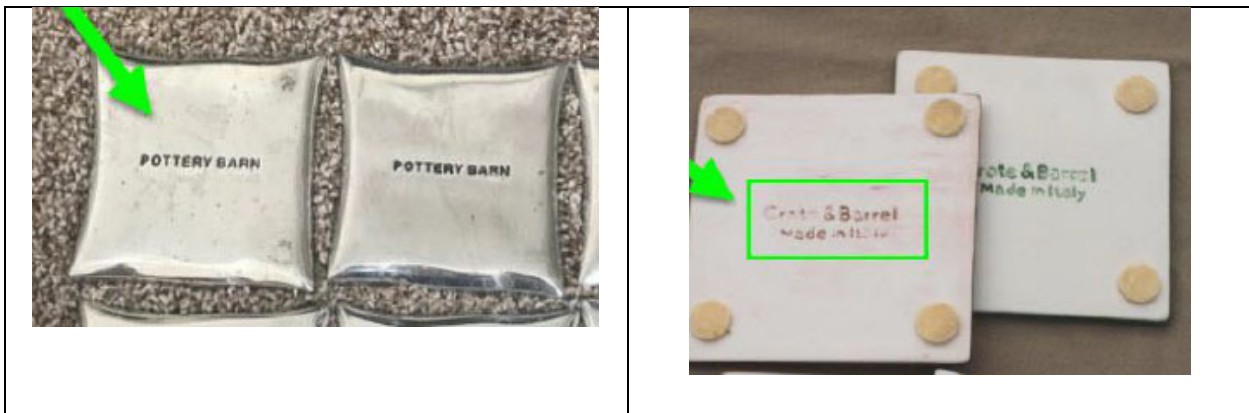
of these items bearing a trademark or brand name; (c) a bar cart, with no trademark or brand name; (d) furniture items bearing no brand name or trademark; and (e) outdoor furniture, none of these items evidencing a brand name or trademark.

Applicant contends that a website photograph of the goods with a product mark (“apparently brand names”) which does not match the mark for the home furnishings website is evidence that consumers do not associate the website mark with the goods. We disagree, because there is a recognized commercial practice of employing more than one mark in connection with goods – typically, one as a house mark, and one to indicate a particular product line. *See In re Andes Candies Inc.*, 478 F.2d 1264, 178 USPQ 156, 156 (CCPA 1973) (“Appellant's mark [CREME DE MENTHE] is shown in large, distinct type in a separate line on the boxes in which its laminated chocolate mint candies are packaged. Its trade name or house mark, ANDES, also appears prominently on its boxes”); *In re Royal Bodycare, Inc.*, 83 USPQ2d 1564, 1569 (TTAB 2007) (“[T]he evidence shows that the term RBC is used as a house mark [in the mark RBC's NANOCEUTICAL]”); *Textron Inc. v. Cardinal Eng'g Corp.*, 164 USPQ 397, 399 (TTAB 1969) (“[I]t is a common practice for manufacturers to apply both a house mark and a product mark to their various merchandise”).²⁶ Accordingly, we do not find the Examining Attorney's evidence that third party “Serena and Lily” is the source of both furniture and coasters is undermined by the photographs on the Serena and Lily

²⁶ *See also* Trademark Manual of Examining Procedure (TMEP) § 1402.03(b) (2019) (“House marks do not identify the particular goods or services – rather, they identify the provider of a wide variety of goods or services, with such goods or services often themselves identified by a separate trademark or service mark.”).

website of “Priano coasters” and “Cayman coasters”, as these terms designate different product lines carried by Serena and Lily.

Applicant also asserts that photographs of the goods which do not display the mark on the goods are evidence that consumers do not associate the home furnishings mark with the goods. There is no requirement that a trademark is used only on the goods. Trademark Act Section 45 specifies that a mark is in use in commerce with the goods when “it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale.” 15 U.S.C. § 1127. In the final Office Action, the Examining Attorney also supplied evidence that the home furnishing stores Crate and Barrel and Pottery Barn place the house mark on coasters, by locating photographs of coasters bearing the mark on a resale site.²⁷

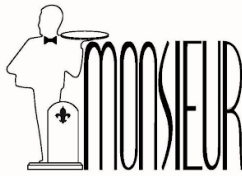


²⁷ July 10, 2019 Office Action, TSDR 67-68

In short, we are not persuaded by Applicant’s arguments that the Examining Attorney’s evidence does not prove that there is a viable relationship between “coasters, not of paper or textile; drinking glasses; flasks; mugs; plates; serving trays; soapstone cubes for chilling whiskey” and “accent furniture; buffets being furniture; custom furniture; patio furniture; tables.”

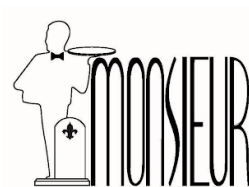
We find that the second and third *DuPont* factors also weigh in favor of finding a likelihood of confusion.

In conclusion, we have considered all of the arguments and evidence of record, and all relevant *DuPont* factors. Insofar as each of the *DuPont* factors discussed above all weigh in favor of finding a likelihood of confusion, we conclude that confusion is likely



to occur between Applicant’s mark for its goods and Registrant’s MONSIEUR MARBLE mark for its goods.

II. Decision



The refusal to register Applicant’s mark is affirmed.