

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
January 16, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re Office Furniture Concierge, LLC

—
Serial No. 85263144

—
Matthew L. Grell of Balser & Grell IP Law for Office Furniture Concierge, LLC.

Michelle E. Dubois, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

—
Before Grendel, Taylor, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Office Furniture Concierge, LLC filed an application to register on the Principal Register the mark set forth below:¹



¹ Application Serial No. 85263144, filed under Trademark Act § 1(a), 15 U.S.C. §1051(a), on March 10, 2011, with a claim of first use and first use in commerce of November 4, 2009.

Serial No. 85263144

Registration of the mark is sought for the following services:

Retail services by direct solicitation by sales agents in the field of office furniture, in International Class 35.

Applicant makes no claim to the exclusive right to use OFFICE FURNITURE and DESKS CHAIRS TABLES FILE CABINETS WORKSTATIONS ERGONOMIC TOOLS apart from the mark as shown.

The trademark examining attorney refused registration under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, as used in connection with applicant's services, so resembles the mark CONCIERGE COLLECTION, which is registered on the Principal Register in standard character form for "furniture,"² as to be likely to cause confusion, or to cause mistake, or to deceive. When the refusal was made final, applicant filed a request for reconsideration, which was denied. Applicant then appealed. Applicant and the examining attorney have filed their respective appeal briefs and applicant has filed a reply brief.

Our determination under Section 2(d) is based on an analysis of all of the probative 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, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services at issue. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In this case, the applicant and

² Reg. No. 3819625, issued on July 13, 2010.

the examining attorney have also submitted evidence and arguments regarding channels of trade, conditions under which sales are made, classes of customers, absence of actual confusion, duration of concurrent use, the right to exclude others from use, and the extent of potential confusion.

We address first the respective services and goods of applicant and registrant, to determine whether they are sufficiently related to give rise to potential confusion. Applicant seeks registration of its mark for “Retail services by direct solicitation by sales agents in the field of office furniture.” Applicant’s specimens of use are excerpts from its website, stating the following:

...call upon a local provider with over 25 years industry experience that will provide personal service for your office furniture project. Have your phone calls answered, your emails returned, and work with a project manager that appears in person until the project is completed to your satisfaction....

Office Furniture Concierge is a full-service office furniture dealership....

...

We can visit you in your office and respond with a project proposal consisting of estimates, photos & brochures or we can pick you up and bring you to one of our Atlanta area warehouses or showrooms to view new and used furniture offerings in person.

The specimens also show that customers may view applicant’s “inventories and deals” on applicant’s website; and that applicant accepts online inquiries from customers through its website. While we assume that applicant’s service, as identified in the application, involves substantial contact between customers and sales representatives of applicant, the specimens show that such direct contacts do

not constitute the exclusive commercial contexts in which applicant and its customers interact. Applicant and its customers may also interact by means of e-mails, written proposals, brochures, on the phone, and in warehouses and showrooms.

The cited mark is registered for “furniture.” We must presume that the registrant’s goods encompass all goods of the nature and type identified in the registration, including office furniture. *In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006).

It has often been recognized that likelihood of confusion may arise where confusingly similar marks are used on goods, on the one hand, and in connection with sales of such goods, on the other. *See In re Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1640 (TTAB 2006); J. Thomas McCarthy, *Trademarks and Unfair Competition* (4th ed.) § 24:25. As our principal reviewing court has noted, “trademarks for goods find their principal use in connection with selling the goods” and accordingly marks for goods and marks for the service of selling such goods will have their impact on the purchasing public in the same marketplace. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

The examining attorney has provided ample evidence to show that full-service furniture dealerships sell the furniture of others and that third-party trademarks pertaining to such furniture products appear on the dealers’ websites.³

³ This evidence shows, for example, that Peartree Office Furniture sets forth on its website a list of dozens of furniture trademarks; and that Sun Turtle Office Furniture’s website refers to a “Select Line of Manufacturers,” identifying them by the trademarks HON, Paulo, DMI, High Line, Mayline, Safco Products and HON Basyx. We note also similar web

The record lacks evidence to show that such dealerships offer furniture that is marked with the dealerships' own trademarks. However, it is clear from the record that customers who seek office furniture through a dealership service such as that of applicant will be exposed to trademarks for furniture products. As applicant's specimen of use demonstrates, such exposure could happen by means of a recommendation made by a sales representative in a face-to-face meeting, through an e-mail communication or telephone call, through a written proposal, through a brochure supplied to the customer by the sales representative, or through the customer's own browsing through inventories and deals offered on the applicant's web site. Under such circumstances, the use of similar marks in connection with the furniture and the furniture dealership could give rise to the mistaken belief that such goods and services originate from or are in some way associated with the same producer. *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010); *Schering Corporation v. Alza Corporation*, 207 USPQ 504, 507 (TTAB 1980); *Oxford Pendaflex Corporation v. Anixter Bros. Inc.*, 201 USPQ 851, 854 (TTAB 1978). Accordingly, we find that applicant's services and registrant's goods are closely related. This *du Pont* factor weighs heavily in favor of a finding of likelihood of confusion.

We turn next to the similarity or dissimilarity of the marks as to appearance, sound, connotation and commercial impression. *Du Pont*, 177 USPQ at 567.

advertisements of Argyle Office Solutions, Contract Furniture Options, Inc., Caddo Solutions, MOI, Total Office Furniture, Office Furniture Expo, Furniture Plus Design, and Mod Design, all of which make reference to numerous third-party furniture brands. *See* evidence submitted with the Office actions of July 20, 2011 and November 29, 2011.

Applicant's mark consists of a representation of "a Concierge with a bow tie holding up a platter."⁴ The wording OFFICE FURNITURE CONCIERGE appears to rest upon the platter. The concierge figure is headless; in place of the head are generic words designating various items of furniture.⁵ "[T]he head is represented by [this] stylized text...."⁶

We consider the marks at issue in their entirety in reaching our ultimate conclusion, but there is nothing improper in giving more or less weight to a particular feature of a mark, for rational reasons. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). The dominant portion of applicant's mark is the wording OFFICE FURNITURE CONCIERGE. In the case of marks consisting of words and a design, the words are normally given greater weight because they would be used by consumers to request the goods or services. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 2 USPQ2d 1553, 1554 (TTAB 1987). *See also Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). The other wording in applicant's mark is generic, with no source-indicating function; it is also too voluminous to conveniently serve as a means of calling for the goods. While the position of this additional wording is unusual (inasmuch as it appears in

⁴ Application, p. 1, description of the mark.

⁵ "DESKS CHAIRS TABLES FILE CABINETS WORKSTATIONS ERGONOMIC TOOLS."

⁶ Application, p. 1, description of the mark.

the place where one would expect to see the depicted concierge's head), this graphic feature is unlikely to be used by customers in identifying applicant or calling for applicant's services. Our perception of OFFICE FURNITURE CONCIERGE as the dominant portion of the mark is supported by the fact that applicant's corporate name is Office Furniture Concierge, LLC, and by applicant's statement that "Our filing was initiated so no other office furniture dealership or other entity starts a business with the name Office Furniture Concierge..."⁷ In addition, the wording OFFICE FURNITURE CONCIERGE would most likely be used in text in order to identify applicant's services. See *In re Viterra*, 101 USPQ2d at 1911; *In re Dakin's Miniatures, Inc.*, 59 USPQ2d at 1596; *CBS Inc. v. Morrow*, 708 F.2d 1579, 1582, 218 USPQ 198, 200 (Fed. Cir. 1983).

Applicant argues that the concierge design is the dominant portion of the mark and should be given greater weight than the remainder of the mark. The cases cited by applicant do not squarely support this contention. In *In re Computer Communications, Inc.*, 484 F.2d 1392, 179 USPQ 51 (CCPA 1973), the mark contained, besides the design, only generic wording having little or no source-indicating power. However, applicant's mark includes the distinctive term CONCIERGE. In *Columbia Steel Tank Company v. Union Tank and Supply Company*, 277 F.2d 192, 125 USPQ 406 (CCPA 1960), the court gave *equal* weight, not greater weight, to the design element. 125 USPQ at 409. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272

⁷ Applicant's response filed June 27, 2011.

(CCPA 1974) indicates only that it is improper to ignore the design element. We do not believe the design elements of applicant's mark would be the primary feature whereby customers would identify applicant and its services.

Comparing applicant's mark OFFICE FURNITURE CONCIERGE (and design) in its entirety with the registered mark CONCIERGE COLLECTION, we find that they convey substantially similar, although not identical, commercial impressions. In each case, the most distinctive element is the word CONCIERGE, which is arbitrary with respect to the relevant goods and services.⁸ OFFICE FURNITURE and COLLECTION are generic and have little, if any, source indicating function. In each case, the designation CONCIERGE is most likely to be recalled by customers, who retain a general rather than specific impression of marks seen in the marketplace. *See Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Although the marks are not identical in meaning, appearance or sound, it is likely that customers would perceive a connection between a selection of furniture called the CONCIERGE COLLECTION and a furniture dealership called OFFICE FURNITURE CONCIERGE.

Applicant compares the present case to *Kellogg Co. v. Pack'em Enterprises, Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), in which the mark FROOTEE

⁸ The word "concierge" means "a member of a hotel staff in charge of special services for guests...." THE RANDOM HOUSE DICTIONARY OF THE ENGLISH LANGUAGE (2nd ed. 1987), p. 423. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

ICE with elephant design was found dissimilar to the word mark FROOT LOOPS. However, in that case, “the marks share[d] no common words.” 21 USPQ2d at 1144. In the case before us, both marks do indeed share a common word, which is the distinctive designation CONCIERGE.

Applicant emphasizes the difference between its mark, which includes a graphic design, and the cited registered mark which “merely contains two words....”⁹ However, the standard character form of the cited registration does not limit the registrant’s right to display its mark in graphic form. The rights associated with a mark in standard characters reside in the wording and not in any particular display. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983); *In re RSI Systems, LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988).

Having considered applicant’s mark in its entirety, and all of applicant’s arguments regarding the distinctions between the marks, we find that the substantial similarities between the marks weigh in favor of a finding of likelihood of confusion.

With respect to the trade channels for the respective services and goods, the examining attorney’s evidence relating to full-service furniture dealerships, discussed above, demonstrates that services similar to those of applicant are a suitable channel of trade through which furniture is marketed, such that customers dealing with applicant are likely to be exposed to the trademarks of companies

⁹ Applicant’s brief at 9.

similar to registrant. This *du Pont* factor weighs in favor of a finding of likelihood of confusion.

As to the nature of applicant's customers, applicant argues that purchasers of office furniture "are sophisticated and knowledgeable business-people" who "are not impulse buyers because of the typically high cost of office furniture."¹⁰ However, business persons who are sophisticated in their own fields are not necessarily sophisticated in the field of office furniture. Moreover, it is settled that even sophisticated purchasers are not immune from source confusion, especially in cases involving similar marks and closely related goods and services. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970). *See also In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). In the present case, we find that the similarities between the marks and the high degree of relationship between applicant's services and registrant's goods outweigh the alleged sophistication of applicant's customers. *See 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 outweigh sophisticated purchasers, careful purchasing decision, and expensive goods). Thus, this factor is neutral.

On the basis of the dates of use set forth in the application and the registration, applicant notes that the marks at issue have both been in use since at

¹⁰ Applicant's brief at 14.

least January 15, 2010, and that applicant is not aware of any actual confusion during that time.¹¹ This statement is unsupported by probative evidence. Applicant's uncorroborated statement as to an absence of actual confusion is entitled to little weight. *See In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). *See also In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973). This is particularly true in an *ex parte* context, where we have no input from the registrant. Moreover, the record contains no evidence relating to the extent of use of applicant's and registrant's marks and, thus, whether there have been meaningful opportunities for instances of actual confusion to have occurred in the marketplace. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Accordingly, the *du Pont* factor of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion is considered neutral.

Applicant argues that there is no market interface between applicant and registrant, because applicant provides sales services while registrant provides goods. Although there may have been no actual dealings between applicant and registrant, the evidence discussed above shows that applicant's services are a type of usual trade channel for registrant's goods. This potential for market interface weighs in favor of a finding of likelihood of confusion.

¹¹ *Id.* at 15.

Applicant has submitted no evidence of its “right to exclude others from use of its mark,” other than applicant’s unsupported statement that “Applicant was the first to use the mark for furniture related serv[ices].”¹² To the extent that applicant is alleging priority, such allegation cannot be considered. During *ex parte* prosecution, including an *ex parte* appeal, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (*e.g.*, applicant’s claim of priority over the cited mark). *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); and *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992). See TMEP §1207.01(d)(iv) (8th ed. 2012). Accordingly, no consideration has been given to applicant’s arguments in this regard.

Finally, applicant argues (without support) that “any potential confusion would be *de minimis*” because applicant’s sophisticated buyers can be expected to carefully review their business-related purchases.¹³ This argument is redundant of applicant’s argument regarding the sophistication of its customers, which was dealt with above.

Having considered the evidence of record and all relevant *du Pont* factors, including those not specifically discussed herein, we find that applicant’s mark, as applied to applicant’s services, so closely resembles the registered mark CONCIERGE COLLECTION for furniture as to be likely to cause confusion, mistake or deception as to the source of applicant’s services.

Decision: The refusal to register is affirmed.

¹² *Id.* at 16.

¹³ *Id.*