

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

6/16/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Polo Ralph Lauren, L.P.

Serial No. 74/715,419

Anthony F. Lo Cicero of Amster Rothstein & Ebenstein for
Polo Ralph Lauren, L.P.

Susan Leslie DuBois, Trademark Examining Attorney, Law
Office 104 (Sidney Moskowitz, Managing Attorney)

Before Cissel, Hanak and Hairston, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Polo Ralph Lauren, L.P. (applicant) seeks registration
of SANTA FE in typed capital letters for "interior and
exterior paint." The intent-to-use application was filed on
August 14, 1995.

The Examining Attorney refused registration pursuant to
Section 2(d) of the Lanham Trademark Act on the basis that
applicant's mark, as applied to interior and exterior paint,
is likely to cause confusion with the identical mark SANTA

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FE, previously registered in typed capital letters for "wallpaper." Registration No. 1,652,482.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

In any likelihood of confusion analysis, two key considerations are the similarities of the goods and the similarities of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

In this case, the marks are identical. Turning to a consideration of the goods, it must be kept in mind that "if the marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion." In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983).

The Examining Attorney has made of record numerous third-party registrations showing that the same marks have been registered for both (1) interior and exterior paint and (2) wallpaper. Moreover, it is common knowledge that the interior walls of homes and other buildings are usually

either painted with interior paint or covered with wallpaper. Indeed, applicant even concedes "that the goods [wallpaper and paint] both can be used in a decorative manner on walls." (Applicant's brief page 2). Thus, with regard to wallpaper and interior paint, there is not merely a "viable relationship" between these two types of goods, there is instead a fairly close relationship between these two types of goods. Under such circumstances, use of the identical mark SANTA FE on closely related goods would clearly result in a likelihood of confusion.

Finally, we note that applicant, without any evidentiary support whatsoever, makes the unsubstantiated allegation that wallpaper and paint "are likely ... to travel in different channels of trade." (Applicant's brief page 2). We believe that it is most likely that home improvement centers would carry both wallpaper and paint. However, even if applicant's totally unsubstantiated allegation were true, the fact remains, as conceded by applicant, that wallpaper and interior paint can be used for the identical purpose. Thus, even assuming for the sake of argument that wallpaper and paint were sold in different channels of trade, we nevertheless would find that the use of the identical mark SANTA FE on products which can be used in place of one another (wallpaper and paint) would result in a likelihood of confusion.

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Decision: The refusal to register is affirmed.

R. F. Cissel

E. W. Hanak

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial
and Appeal Board