

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB JAN. 6, 98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

Office Express, Inc.

v.

Independent Stationers, Inc.

---

Opposition No. 96,771  
to application Serial No. 74/500,826  
filed on March 16, 1994

---

Philip K. Fitzsimmons of Shlesinger, Fitzsimmons for Office  
Express, Inc.

William S. Gardiner for Independent Stationers, Inc.

---

Before Seeherman, Hanak and Quinn, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Independent Stationers, Inc. (applicant) seeks  
registration of OFFICE PLUS EXPRESS in typed capital letters  
for "retail and mail order store services in the fields of  
office supplies, furniture and office equipment, and  
computers and computer equipment; catalog services featuring

**Opposition No. 96771**

office supplies, furniture and office equipment, and computers and computer equipment; printing and designing business cards, forms and rubber stamps for others." The intent-to-use application was filed on March 16, 1994. Applicant disclaimed the exclusive right to use OFFICE apart from the mark in its entirety.

Office Express, Inc. (opposer) filed a notice of opposition alleging that prior to March 16, 1994 opposer both used and registered OFFICE EXPRESS for "retail store services in the field of office products," and further alleging that the contemporaneous of these two marks for essentially the same services is likely to result in confusion. Opposer has properly made of record a certified status and title copy of its Registration No. 1,752,035 issued February 9, 1993. This registration is for the mark OFFICE EXPRESS depicted in typed capital letters for "retail store services in the field of office products." In that registration, opposer disclaimed the exclusive right to use OFFICE apart from the mark in its entirety.

Applicant filed an answer which denied the pertinent allegations of the notice of opposition.

Opposer and applicant filed briefs. In reviewing applicant's brief, the Board noted the following comments made by applicant at page 3: "The opposer has chosen not to

**Opposition No. 96771**

file a brief in this action... Thus the applicant is forced to make reasonable assumptions as to what exactly opposer is contending." On October 20, 1997, the Board placed a telephone call to counsel for applicant and informed him that opposer had filed a brief with a certificate of service attached thereto indicating that a copy of said brief had been filed with applicant's counsel. To cut to the quick, applicant's counsel obtained a copy of opposer's brief from opposer's counsel and filed with the Board "Applicant's Amended Brief" along with a request for permission to file said brief. In the request, applicant's counsel noted that opposer's counsel had agreed to this request. Furthermore, applicant requested that opposer be given the opportunity to file a reply brief to Applicant's Amended Brief. Opposer had not elected to file a reply brief to applicant's original brief. We are hereby granting applicant's request (consented to by opposer's counsel) to file Applicant's Amended Brief. On December 9, 1997 the Board telephoned counsel for opposer and was informed that opposer had reviewed Applicant's Amended Brief and had decided not to file a reply brief. Neither party has requested a hearing.

The record in this case is summarized at page 1 of opposer's brief and page 2 of Applicant's Amended Brief.

In considering opposer's section 2(d) claim (i.e. priority and likelihood of confusion), we note at the outset

**Opposition No. 96771**

that priority rests with opposer. Not only has opposer properly made of record its aforementioned registration of OFFICE EXPRESS, but in addition the record shows that opposer commenced use of OFFICE EXPRESS long before March 16, 1994, the filing date of applicant's intent-to-use application. Indeed, at page 2 of its Amended Brief, applicant makes the following statements: "There is no issue as to priority. Opposer is the prior user." Thus, the only issue before the Board is one of likelihood of confusion.

In any likelihood of confusion analysis, two key considerations are the similarity of the goods and/or services 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 services] and differences in the marks.")

Considering first the services, we find that the services as set forth in opposer's registration (retail store services in the field of office products) are, despite the differences in terminology, identical to some of the services set forth in applicant's application, namely, "retail ... store services in the fields of office supplies ... and office equipment."

**Opposition No. 96771**

Turning to a consideration of the marks, it must be kept in mind that "when marks would appear on virtually identical goods or services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

In this case, applicant has adopted opposer's mark in its entirety and merely inserted the word PLUS. Thus, in terms of visual appearance, pronunciation and meaning, we find that applicant's mark OFFICE PLUS EXPRESS is very similar to opposer's mark OFFICE EXPRESS. The similarities in visual appearance and pronunciation are quite obvious and merit no discussion. As for the similarity in meaning, we note that the word "plus" is defined as "added to" or "increased by." Webster's New World Dictionary (2d ed. 1970). Indeed, it has been held that "the term PLUS is an everyday word that indicates something added, and when applied to goods [or services], it merely implies additional quantity or quality." Plus Products v. Plus Discount Foods, Inc., 722 F.2d 999, 222 USPQ 373, 378 (2d Cir. 1983). We believe that consumers familiar with opposer's mark OFFICE EXPRESS for retail store services in the field of office products would, upon seeing the mark OFFICE PLUS EXPRESS, believe that the latter mark simply denotes that opposer's

**Opposition No. 96771**

services have now been expanded somewhat to include a greater selection of office products and/or products related to office products. In this regard, we note that applicant seeks to register OFFICE PLUS EXPRESS not only for services identical to opposer's services, but also for additional (expanded) services including retail store services featuring office furniture and computers, and mail order and catalog services featuring office supplies.

In short, we find that the contemporaneous use of OFFICE EXPRESS for retail store services in the field of office products and OFFICE PLUS EXPRESS for these identical services plus some additional related services is likely to result in confusion.

We note that applicant has made the argument that opposer's mark "is a weak mark and should be allowed only a very narrow scope of protection." (Applicant's Amended Brief page 8). There can be no dispute that opposer's mark is suggestive and thus is entitled to a narrower scope of protection than would be afforded an arbitrary mark. However, opposer's mark, even if deemed to be suggestive, is entitled to some degree of protection and we find that that degree of protection precludes the registration of a very similar mark for identical services. We also note that applicant has alleged that "opposer has chosen to use and register a highly descriptive mark." (Applicant's Amended

**Opposition No. 96771**

Brief page 8). We simply do not share applicant's view that opposer's mark is descriptive. Moreover, in making this argument, applicant is seeking to collaterally attack opposer's registration. If applicant desired to take this course of action, it should have filed a counterclaim to cancel opposer's registration on the basis that opposer's mark is merely descriptive. As has been stated repeatedly, "if the opposer relies upon a prior registration as grounds for opposition, the validity of that registration cannot be challenged unless the applicant counterclaims by a petition to cancel opposer's registration." 3 J. McCarthy, McCarthy On Trademarks and Unfair Competition, Section 20:22 at page 20-46 (4th ed. 1997) and cases cited therein.

We also note that applicant argues that confusion is not likely because "there is no evidence in the record that the opposer offers its services to the general public through traditional retail store type sales. Thus, it appears that [opposer's] customers have a close relationship with the opposer and a clear knowledge of its business." (Applicant's Amended Brief page 10). To begin with, we find no evidentiary support for applicant's contention that opposer's customers have "a close relationship with the opposer and a clear knowledge of its business." The fact that opposer's customer list includes businesses does not merit a finding that these businesses have a close

**Opposition No. 96771**

relationship with and a clear understanding of opposer. Moreover, even assuming for the sake of argument that in practice opposer does have a close relationship with its customers, it must be remembered that in a proceeding such as this, "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-a-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). As described in the registration and application, the services of opposer and applicant are clearly broad enough to include ordinary retail store services in the field of office products/supplies which are provided to individuals and small businesses having no prior knowledge of either opposer or applicant.

Finally, we note that applicant has argued that it has a "family of marks" which includes the words OFFICE PLUS. (Applicant's Amended Brief pp. 10-12). Applicant then argues that because of the existence of this family of marks, "the applicant believes that the buying public would clearly identify the mark, OFFICE PLUS EXPRESS, as belonging to the applicant and not confuse it with the opposer. The fact that there is no evidence of any [actual] confusion

between the opposer's mark and any of the family of OFFICE PLUS marks currently in use clearly supports this position." (Applicant's Amended Brief page 11).

Two comments are in order. First, the "family of marks" argument is simply "unavailable [as a defense] to a defendant in a Board proceeding." Baroid Drilling Fluids Inc. v. Sun Drilling Products, 24 USPQ2d 1048, 1049 (TTAB 1992). Moreover, even if the family of marks argument was available as a defense (which it is not), in this proceeding applicant has totally failed to demonstrate that it has so extensively used and advertised its various OFFICE PLUS marks together such that the relevant consuming public has come to associate the common component (OFFICE PLUS) with applicant.

Second, as for applicant's allegation that there have been no instances of actual confusion involving opposer's mark and applicant's various OFFICE PLUS marks, suffice it to say that based on this record, we have way of knowing whether the marks have ever been actually used together such that there was the chance for confusion to occur.

**Opposition No. 96771**

Decision: The opposition is sustained.

E. J. Seeherman

E. W. Hanak

T. J. Quinn  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board