

Hearing:
May 12, 1999

Paper No. 14
HRW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB DEC. 14, 99
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bernhardt Furniture Company

Serial No. 75/176,890

Howard A. MacCord Jr. of Rhodes, Coats & Bennett LLP
for Bernhardt Furniture Company.

Jeri J. Fickes, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Cissel, Wendel and Bucher, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Bernhardt Furniture Company has filed an application
to register the mark VISIONS for "furniture - namely,
modular furniture components for high-end corporate
offices, featuring a unique wire management enhancement,
and conference tables with wire handling capabilities."¹

¹ Serial No. 75/176,890, filed October 4, 1996, based on an
assertion of a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the registered mark VISION BUSINESS PRODUCTS in the format shown below for "distributorship services in the field of business office and computer products, supplies and furniture; mail order services in the field of business, office and computer product supplies and furniture."²

Both applicant and the Examining Attorney have filed briefs, and both participated in an oral hearing.

Here, as in any determination of likelihood of confusion, two key considerations in our analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods and/or services with which the marks are, or will be, used. See *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

² Registration No. 1,827,264, issued March 22, 1994, claiming first use dates of July 1, 1988. A disclaimer has been made with respect to the words BUSINESS PRODUCTS. Although the registration also covers certain office and computer supplies in Classes 9 and 16 and franchising services in Class 35, these goods and services have not been argued by the Examining Attorney.

Insofar as the marks are concerned, we agree with the Examining Attorney that the dominant feature of registrant's mark is the word VISION. Although it is true that in determining likelihood of confusion, marks must be considered in their entireties, it is well established that there is nothing improper in giving more or less weight to a particular feature of a mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). While descriptive portions of a mark cannot be ignored, the fact remains that the purchasing public is more likely to rely upon the non-descriptive portion as the indication of source. This is particularly true when the descriptive portion has been graphically relegated to subordinate status in the mark. See Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993). A design element is also of lesser import, unless highly distinctive, because it is the word portion of a mark which is more likely to be remembered and relied upon by purchasers in calling for the goods or services. See In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987).

Thus, neither the descriptive wording BUSINESS PRODUCTS, which has been disclaimed, nor the design element is the dominant feature of registrant's mark. We concur with the Examining Attorney that it is the word VISION

which is most responsible for creating the commercial impression of the mark as a whole.

As such, there is little difference between the registered mark and applicant's word mark VISIONS. While applicant's mark is the plural form of the word VISION, we do not find this to be a distinction which would be readily recalled by purchasers over a period of time, if in fact it would be recognized at first impression. Furthermore, although applicant argues that the design components of registrant's mark cannot be ignored, the Examining Attorney is correct in pointing out that applicant, being unlimited by its typed drawing to any particular style, could present its mark in a format very similar to that of the registrant. See *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); *Jockey International Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992). Accordingly, we find that the marks involved create similar overall commercial impressions.

Applicant insists, however, that it is the dissimilarities of the respective goods and services involved, of the channels of trade for the goods versus the services, and of the conditions of sale which are the controlling factors in this case. Applicant argues that its goods are high-end office furniture which is purchased

by discerning customers and is sold in such a manner that these customers may view the furniture prior to purchase. Registrant, accordingly to applicant, is simply a distributor and mail-order vendor of office furniture, along with information processing and imaging supplies. Applicant argues that there is no indication that registrant's furniture would be high-end in nature, would be manufactured by registrant, would be available for on-site appraisal, or would travel in the same channels of trade as applicant's furniture.

In the first place, although applicant has restricted its office furniture to a particular type and cost range, there are no such limitations or qualifications in the registration as to the type of office furniture being distributed and/or offered through mail-order by registrant. Thus, it must be presumed that registrant's office furniture encompasses the high-end varieties offered by applicant and travels in the normal channels of trade for office furniture of this nature. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Contrary to applicant's arguments, the fact that registrant also offers office and computer

supplies does not necessarily relegate its furniture products to low-cost items.³

Further, there is no limitation of the manner of sale of applicant's office furniture to on-site purchases. Instead, applicant's furniture could be made available to purchasers through distributors or mail-order merchants such as registrant.

The crux of the matter is whether the goods of applicant, high-end modular office furniture, and the services of registrant, distributorship and mail-order services offering business office furniture, are related in such a manner that they would be encountered by the same persons under circumstances which would cause them to believe that the goods and services emanate from the same source. See *In re Peebles, Inc.*, 23 USPQ2d 1795 (TTAB 1992); and *General Mills Fun Group, Inc. v. Tuxedo Monopoly*

³ Applicant's reliance upon the holdings of the District Court in *Frehling Enterprises Inc. v. International Select Group Inc.*, 45 USPQ2d 1750 (S.D. Fl. 1997) is misplaced. The issues in that case included infringement and unfair competition. The Court found distinctions between the specific furniture being sold by the defendant and the distributorship services of the plaintiff based on the evidence of record. Here, the issue is registrability, which must be determined on the basis of the goods and services as identified in the application and registration, and not on any extrinsic evidence of differences in the goods and services with which the marks are actually used. See *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, *supra*.

Inc., 204 USPQ 396 (TTAB 1979), *aff'd*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981). The Board has previously held that store services and goods which may be sold in that store are related goods and services for purposes of determining likelihood of confusion. In *re Peebles, supra* at 1796; In *re Best Products Co., Inc.*, 231 USPQ 988 (TTAB 1988). A relationship of this nature has been specifically held to exist between general merchandising store services and furniture. In *re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988). Moreover, the Board has found a similar relationship to exist between a distributorship and the products it offers, such that it would be reasonable for prospective purchasers to presume that a mark used to identify the distributorship services would also be used as a trademark for at least some of the products sold by the distributor. In *re Burroughs Corp.*, 2 USPQ2d 1532 (TTAB 1986).

Accordingly, we find it likely that persons encountering registrant's distributorship or mail-order services for office furniture under the mark VISION BUSINESS PRODUCTS and applicant's office furniture, if marketed as intended under the mark VISIONS, would assume a relationship between these services and goods. In view of the similar commercial impressions created by the marks, it

would be most reasonable for potential purchasers to mistakenly believe that VISIONS office furniture is a product not only emanating from, but also directly associated with, the same source providing the VISION BUSINESS PRODUCTS distributorship or mail-order services for office furniture.⁴

Decision: The refusal to register under Section 2(d) is affirmed.

R. F. Cissel

H. R. Wendel

D. E. Bucher

Trademark Administrative Judges,
Trademark Trial and Appeal Board

⁴ We note, as applicant points out, that applicant now owns Registration No. 668,677 for the mark VISION for "tables, upholstered furniture and furniture case goods," which registration was subsisting when the cited registration was allowed. We do not agree, however, that the existence of applicant's prior registration is in any way indicative of the registrability of the mark which is the subject of the present application. In the present application, the furniture is specifically restricted to office furniture, as is the furniture in the cited registration, making the relationship between furniture and distributorship services much more direct.

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