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Paper No. 9
GFR

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **MIV, Inc.**

Serial No. 75/**188,385**

Kathryn Evans Smith and Kurt A. Summe of **Wood, Herron & Evans, LLP** for **MIV, Inc.**

Josette M. Beverly, Trademark Examining Attorney¹, Law Office **112** (**Janice O'Lear**, Managing Attorney).

Before **Quinn, Hairston** and **Rogers**,
Administrative Trademark Judges.

Opinion by **Rogers**, Administrative Trademark Judge:

MIV, Inc. has filed an application to register the mark **WORK PLACE**, in stylized form, as a service mark in International Classes 35 and 42 for, respectively, "business marketing consulting services, and planning and procurement services, namely, obtaining furniture, all for wholesale and retail manufacturers and vendors" and "design

¹ All examination was completed by Martha Santomartino. Ms. Beverly briefed the appeal.

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and implementation of offices, stores, and showrooms for use by wholesale and retail furniture manufacturers and vendors."²

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 used in connection with the identified services, will be likely to cause confusion or mistake or to deceive, in view of the prior registration of WORKPLACE, in stylized form, for "modular industrial furniture, namely--benches, cabinets, shelving and tables."³ In addition, the Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, as used on or in connection with applicant's services, the mark is merely descriptive of a significant attribute thereof.

When the refusals were made final, applicant appealed.⁴ Both applicant and the Examining Attorney have filed

² Serial No. 75/188,385, filed October 28, 1996, alleging June 1, 1996 as a date of first use and first use in commerce.

³ Registration No. 868,061, issued April 8, 1969 on the Supplemental Register, listing May 1, 1967 as date of first use and first use in commerce.

⁴ The Examining Attorney also made final a requirement for further amendment of the identification of applicant's Class 35 services. In its brief, applicant adopted a suggested amendment. The identification is not an issue on appeal.

briefs, but an oral hearing was not requested. Applicant, with its brief, introduced evidence that would usually be refused consideration as untimely. See Trademark Rule 2.142(d). The Examining Attorney, however, acknowledged the submissions and considered them in her brief.

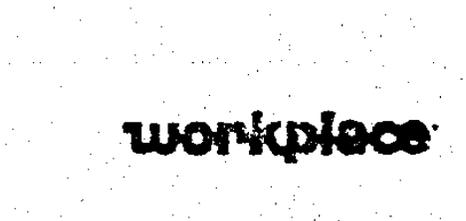
Accordingly, the exhibits are considered part of the record. We review, first, the refusal under Section 2(d).

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 likelihood of confusion issue. See In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, two key considerations are the similarities of the marks and the similarities of the services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin with the marks, which are set forth below.⁵



**WORK
PLACE**



workplace

⁵ Registrant's mark, set forth on the right, in actual use is not surrounded by slight spots and the lettering is more crisp. See materials submitted as Exhibit D to applicant's brief. The Office's search system appears to contain a poor illustration of the mark.

Applicant argues that each mark is presented in a different form of stylized lettering and that the registered mark is presented as one word, while applicant's mark is presented "in a split, two-line format." We are not persuaded that these are significant differences. Both marks are presented in sans serif type; there is no particular flourish to either. Likewise, applicant's display of its mark in a format wherein one word is a reversal set against a dark background is not particularly unusual. Moreover, we note from the specimens applicant submitted and the additional exhibits it submitted with its brief, that both applicant and registrant utilize their respective marks in more straightforward typed forms, which undercuts any argument that particular displays make a significant contribution to commercial impression created by each of the involved marks.⁶ See Steelcase Inc. v. Steelcare Inc., 219 USPQ 433, 436 (TTAB 1983), *relying on* Morton Norwich Products, Inc. v. S.C. Johnson & Son, Inc., 189 USPQ 413 (CCPA 1976) ("It is proper to look to actual usage for aid in determining the significance and meaning of marks.").

⁶ Applicant also changes the solid and reversal-lettering format when it places its entire mark against a dark background, so that WORK is in reversal and PLACE is in solid lettering.

The marks are spelled the same, pronounced the same, and have the same connotation, when considered in conjunction with the respective goods and services for which they are used, which are discussed infra. The visual differences are insignificant. Overall, then, we find the marks virtually identical.

Turning to the respective goods and services, we begin by noting that our analysis of the similarity or relatedness thereof must be based on the identifications in the involved application and registration. See Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990), and Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). Accordingly, applicant's argument that registrant's industrial furniture is always made of steel, and its argument that applicant's own furniture is only for office and not industrial use, both must be disregarded. Registrant's identified goods are not limited to those made of steel; nor is the furniture bought and sold through applicant's services limited to office furniture. In short, we must read registrant's identification as inclusive of benches, cabinets, shelving and tables made of any type of material and we must consider the activities

involved in rendering applicant's services to involve office and industrial furniture.

Moreover, we agree with the Examining Attorney's argument that we must, in our analysis, also consider goods or services in the registrant's normal fields of expansion. In this case, we need not hypothesize about what fields registrant would normally expand into, as applicant has introduced material which illustrates registrant's expansion. These goods include, for example, computer workstations made of steel and laminate, and ergonomic chairs. Such goods can also be found in applicant's catalogue.

Registrant's literature states that it manufactures "biomechanically sound work environments for virtually all types of national and international markets. ...built for a wide range of customer applications, including colleges, hospitals, the electronics industry, manufacturers, government facilities, laboratories, and many others." It promotes its goods as "[h]andsome enough for the office, yet rugged enough for the work area..." and claims to have customers throughout the country.

Applicant explains its business as one that targets the "middle market" between large "A-grade" office furniture manufacturers who deal directly with facilities

managers and "commodity products" vendors who sell "ready-to-assemble laminate office furniture." Applicant purchases furniture "through a national network of wholesale and retail manufacturers and vendors, displaying the furniture in a central showroom, and then providing design and implementation services to its customers, along with the installation of the items into its customers' offices, stores and showrooms." Finally, applicant notes that it "promotes its products to companies with 10 to 250 office employees, and also markets to those working out of home offices."

Based on the involved identifications and additional material made of record by applicant, we conclude that there exists a likelihood of confusion or mistake or deception among consumers. As the Examining Attorney has observed, applicant could very well purchase furnishings from registrant for display in its catalogue and showrooms and for marketing by its network of furniture dealers. In this regard, we note that applicant's catalogue includes various types of furniture identified by a wide variety of trademarks. Were applicant to include registrant's WORKPLACE furniture in its catalogue, readers might very well assume that applicant was marketing its own "house brand" items along with those of the other manufacturers.

Likewise, the record suggests overlap in potential customers insofar as applicant's stated target group of companies with 10 to 250 employees could equally be targets of registrant. In other words, there is nothing to suggest that registrant does not also target the "middle market" that applicant targets.

Applicant argues that any common customers will be able to distinguish applicant from registrant because customers are conditioned to distinguish many different "workplace" or "workplace"-formative marks. The only support for this argument, however, is applicant's submission of a list of 92 third party applications and registrations. We agree with the Examining Attorney that the applications and registrations have not been properly introduced, see In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983), and, in any case, are not probative on the question of likelihood of confusion. In fact, applicant's presentation of the list as one of "92 other 'WORK PLACE'-containing marks currently subsisting on the Principal Trademark Register" gravely mischaracterizes the evidence.

Even if we were to consider this evidence, we would have to discount 54 of the marks on the list, which are only the subjects of applications (one of which is applicant's). See Zappia-Paradiso, S.A. v. Cojeva Inc.,

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144 USPQ 101 (TTAB 1964). As to the 38 registrations, 8 do not involve the term "workplace" at all; 7 of these involve the phrase "place to work" and another is for the mark THAT PATCHWORK PLACE. Thus, we are left with only one-third of the marks on applicant's list. For these, however, we have no evidence regarding the status of the registrations or the goods or services for which the marks therein have been registered. For example, a check of the particulars of the first registration on the list, no. 2,305,011 for WORKPLACE ART, reveals that it is not, contrary to applicant's contention, subsisting on the Principal Register; it is on the Supplemental Register. Also, a check of the particulars for the only registration on the list for the same mark as applicant and registrant, i.e., Registration No. 1,722,567 for the single word WORKPLACE, reveals that it covers "vocational education services in the field of graphic communications," in Class 41.

To the extent applicant relies on the third-party applications and registrations to establish that the mark in the cited registration is weak and not entitled to a broad scope of protection, while we cannot accept the evidence, we do not disagree with applicant's conclusion. Moreover, in reaching our conclusion on likelihood of confusion, we have kept in mind that the cited mark is

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registered on the Supplemental Register. See In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994) ("...in most cases marks are registered on the Supplemental Register because they are descriptive, [thus] the scope of protection accorded to them has been consequently narrow, so that likelihood of confusion has normally been found only where the marks and goods are substantially similar.>"). Nonetheless, even if applicant had properly introduced evidence of weakness of the cited mark, the registration of such a mark is still entitled to protection against registration by a subsequent user of a virtually identical mark for related goods or services. See Hollister Incorporated v. Ident A Pet, Inc., 193 USPQ 439, 442 (TTAB 1976); see also, In re Copytele Inc., 31 USPQ2d 1540, 1542 (TTAB 1994).

Finally, applicant's assertion that it is not aware of any instances of actual confusion is not persuasive that there is no likelihood of confusion. Any assertion of no actual confusion, made by an applicant in an ex parte case, is of limited value and, in any event, the period of contemporaneous use of the involved marks has not been lengthy. See In re Cruising World, Inc., 219 USPQ 757, 758 (TTAB 1983) and Cooper Industries, Inc. v. Repcoparts USA, Inc., 218 USPQ 81, 85-86 (TTAB 1983).

The refusal of registration under Section 2(d) of the Trademark Act is affirmed. Next, we turn to the refusal of registration based on Section 2(e)(1) of the Trademark Act.

It is well settled that a term is considered merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-218 (CCPA 1978); see also In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

It is not necessary that a term describe all of the attributes of the goods or services in order for it to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration of the term is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Consequently, "[w]hether consumers could

guess what the product is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

The evidence of record relative to the question of descriptiveness includes dictionary definitions of "workplace" as a "place (as a shop or factory) where work is done" and a "place, such as an office or a factory, where people are employed." In addition, the Examining Attorney made of record numerous NEXIS references establishing the ubiquitous use of the phrase "workplace design," and variations thereof. The NEXIS evidence also includes numerous references to "workplace" furniture or furnishings. Finally, as noted by the Examining Attorney, applicant's catalogue of furniture products list various "work areas" for which furniture and accessories are available through applicant's furniture dealers. These include, for example, "Executive Workplaces," "Administrative Workplaces," "Training in the Workplace," and "Home Office Workplaces." Each of these phrases is clearly used to describe a particular place of work.

We have no doubt that WORK PLACE, as used by applicant, will immediately, and without need of thought or imagination, describe a significant feature of applicant's services, namely, that the furniture obtained in the

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rendering of its Class 35 services is "workplace" furniture, and that its Class 42 design services involve "workplace" design and furniture used therein. We find no merit in applicant's argument that "the words WORK PLACE, when viewed as an entirety in its [sic] stylized design format, have no obvious connotation relative to Applicant's services." (Emphasis by applicant.)

The refusal of registration under Section 2(e)(1) of the Trademark Act is affirmed.

Decision: The final refusal of registration is affirmed on both the Section 2(d) and Section 2(e)(1) bases asserted by the Examining Attorney.