

5/16/01

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Paper No. 18
JQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Standard Plywoods, Inc.**

Serial No. 75/415,276

Richard M. Manning and Timothy D. St. Clair of Dority & Manning for applicant.

Richard R. Alves, Jr., Trademark Examining Attorney, Law Office 104 (Sidney I. Moskowitz, Managing Attorney).

Before Seeherman, Quinn and Walters, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Standard Plywoods, Inc., doing business as Anderson Hardwood Floors, to register the mark JACKSON PLANK ("PLANK" disclaimed) for "wood flooring."¹

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the

¹ Application Serial No. 75/415,276, filed January 8, 1998, based on an allegation of a bona fide intent to use the mark in commerce.

ground that applicant's mark, if applied to applicant's goods, so resembles the previously registered mark JACKSON SQUARE for "wood flooring"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing originally was requested, but the request was later withdrawn.

We affirm the refusal to register.

The Examining Attorney maintains that the marks are similar, with both marks dominated by the identical "JACKSON" portion, and that even if the cited mark were viewed as weak, the scope of protection of the cited mark extends to include applicant's mark when the marks are applied to identical goods. The Examining Attorney also discounts the argument that consumers of wood flooring are sophisticated. The Examining Attorney submitted excerpts retrieved from the NEXIS database showing descriptive uses of the term "plank" in connection with wood flooring.

Applicant contends that the cited registration is weak and entitled to a narrow scope of protection. In this regard, applicant asserts that the term "Square" in

² Registration No. 1,478,721, issued March 1, 1988; combined Sections 8 and 15 affidavit filed.

registrant's mark is "either generic or highly descriptive for the registered goods or should be regarded as a suggestive term and therefore substantively distinguishing from other marks not including such terminology." (brief, p. 8) Applicant also contends that "Jackson" is a surname and adds to the weakness of the cited mark. Applicant further asserts that wood flooring is the subject of a sophisticated purchase "based upon investigation, counsel and advice of professionals, and most commonly involving professional installation." (brief, p. 10) Applicant states that wood flooring is "most typically professionally installed by 'Contractors and Installers' after being selected directly or in consultation with 'Architects, Designers, Decorators, and Other Specifiers.'" (brief, p. 10) In support of its position, applicant submitted the file wrapper of the cited registration, excerpts from a telephone directory with "Jackson" surname listings, excerpts from applicant's marketing material, and one third-party registration.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of

confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The goods in the application and the cited registration are identical, namely "wood flooring." It is presumed that the goods move in the same channels of trade and are purchased by the same classes of purchasers. In *re Elbaum*, 211 USPQ 639 (TTAB 1981). In this connection, we note that if the goods are identical, as they are here, "the degree of similarity [between 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).

Insofar as the marks are concerned, we find that the marks JACKSON PLANK and JACKSON SQUARE engender similar overall commercial impressions as applied to identical goods (wood flooring). The respective marks clearly are dominated by the identical term "JACKSON." Being the first word in each of the marks, the term "JACKSON" is the portion that is most likely to be remembered by consumers and to be used in calling for the goods. Further, although we have considered the marks in their entireties, "there is nothing improper in stating that, for rational reasons,

more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For example, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark..." Id. at 751.

In the case at hand, the term "PLANK" in applicant's mark is disclaimed and, as shown by the NEXIS evidence, is descriptive as applied to wood flooring. The term "SQUARE" in registrant's mark, while not disclaimed, is at least highly suggestive. Registrant's specimens show that its wood flooring is sold in square size. Thus, as in the case of applicant's mark, this term is subordinate to the term "JACKSON." The fact that "Jackson" may be a surname or a geographical term does not diminish the likelihood of confusion between the two marks.

In sum, the general overall commercial impression engendered by the marks is similar. Purchasers familiar with registrant's wood flooring sold under the mark JACKSON SQUARE would be likely to believe, upon encountering applicant's mark JACKSON PLANK for wood flooring, that applicant's mark identified a line extension of the JACKSON

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SQUARE brand flooring, or that it identified a different type of wood flooring (plank versus square) emanating from registrant.

Although we find it reasonable for applicant to assert that the purchase of wood flooring involves a fairly sophisticated purchasing decision, this would not ensure against confusion here given the similarity of the marks and the identity of the goods. In any event, the identifications of goods are not restricted as to class of purchasers, and we therefore must presume that the flooring is bought not only by those knowledgeable in the trade, but by do-it-yourselfers as well.

The one third-party registration of the mark JACKSON does not dictate a different result. The registration is of little probative value on the specific question of likelihood of confusion presented in this case, given that the registration covers goods (power wood working machines and tools) different from the wood flooring of applicant and registrant, not to mention the fact that there is no evidence that the registered mark is in use.

Decision: The refusal to register is affirmed.

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