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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 10  
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Global Total Office<sup>1</sup>

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Serial No. 75/600,227

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Judith L. Grubner of Laff, Whitesel & Saret, Ltd. for  
Global Total Office.

Heather D. Thompson, Trademark Examining Attorney, Law  
Office 103 (Michael A. Szoke, Managing Attorney).

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Before Chapman, Holtzman and Rogers, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Global Total Office (a Canadian limited partnership)  
has filed an application to register the mark  
ADAPTABILITIES for "office furniture" in International  
Class 20. The application is based on applicant's claimed  
first use date of June 1998. Applicant also claims  
priority under Section 44(d) of the Trademark Act, 15  
U.S.C. §1126(d) based on its Canadian application Serial

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<sup>1</sup> The records of the Assignment Branch of this Office indicate that the involved application has been assigned from Global Upholstery Company to Global Total Office. (Reel 2153, Frame 620.)

No. 881,803 (filed in Canada on June 18, 1998), and which matured into Canadian Registration No. 512,375.

Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its identified goods, so resembles the registered mark, ADAPTABLES, for "furniture," as to be likely to cause confusion, mistake or deception.<sup>2</sup>

When the refusal was made final, applicant appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register. In reaching this conclusion, we have considered all of the relevant du Pont<sup>3</sup> factors.

We turn first to a consideration of the cited registrant's goods and applicant's goods. It has been repeatedly held that when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the goods (or services) as identified in the application with the goods (or services) as identified in the registration. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Octocom Systems*

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<sup>2</sup> Registration No. 2,249,513, issued June 1, 1999. The claimed date of first use is February 4, 1977.

<sup>3</sup> See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Applicant's identification of goods clearly sets forth a specific type of furniture, namely "office furniture"; however, the cited registrant's goods, identified as "furniture," covers all types of furniture, including "office furniture."<sup>4</sup> While applicant's identification of goods is limited to "office furniture," there is no such limitation in the registrant's identification of goods. Thus, the cited registration encompasses the more specific furniture set forth in applicant's identification.

In any event, it is well settled that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods or services are related in

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<sup>4</sup> The Examining Attorney submitted a page from a third-party website referring to the cited registrant as selling "office furniture." We agree with applicant that this evidence does not establish that registrant would refer to its goods in that manner. However, the Examining Attorney's evidence does indicate that the term "office furniture" may refer to either a typical business office or an office or computer room in the home.

Another evidentiary matter is applicant's submission, with its reply brief, of pages from a portion of registrant's website. This evidence is untimely and has not been considered. See Trademark Rule 2.142(d). We hasten to add that consideration of this evidence would not alter our decision.

some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that the goods or services originate from or are in some way associated with the same producer, or that there is an association between the producers of the goods or services. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Here there is no restriction as to the channels of trade or the types of purchasers in either the application or the registration. See *Canadian Imperial Bank v. Wells Fargo Bank*, supra. Therefore, the Board must assume that applicant's goods could move through all the ordinary and normal channels of trade for such goods, and would be offered to all the usual purchasers (including the general public) for such goods. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, supra, at 1787; *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Based on the record before us, we readily conclude that applicant's goods, as identified, are closely related

to the cited registrant's broadly identified goods, and would be sold through similar channels of trade to the same class of purchasers.

Applicant argues that home and office furniture products are "relatively expensive" (brief p. 8, and reply brief p. 4) and are not impulse purchases. Even if we assume that the purchasers of the goods in question in the instant case are somewhat careful purchasers, and do not purchase furniture on impulse, this does not mean that such purchasers are immune from confusion as to the origin of the respective goods, especially when sold under similar marks. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, footnote 17 (TTAB 1992).

Turning then to a consideration of the marks, applicant's mark ADAPTABILITIES and registrant's mark ADAPTABLES, although obviously not identical, are similar in sound, connotation and commercial impression. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather must be based on the similarity of the general overall commercial impressions engendered by the involved marks.

The fact that the marks are somewhat different coined words does not serve to distinguish these marks which are particularly similar in sound and connotation. Purchasers are unlikely to remember the specific differences between the marks due to the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of the many trademarks encountered. That is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd (Fed. Cir., June 5, 1992).

Moreover, it is the first part of a mark which is most likely to be impressed upon the mind of a purchaser and be remembered by the purchaser. See *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). In this case, both marks begin with "adapt." This certainly plays a part in creating the similarity of the overall commercial impression of these marks.

The connotation created by both marks, ADAPTABILITIES and ADAPTABLES, is the same for both parties in relation to the goods. That is, both refer to the versatility or adaptability of the furniture--either that each individual

piece of furniture might adapt to various uses, or the furniture consists of components which may be utilized together in various configurations. See *The Wella Corporation v. California Concept Corporation*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977).

Applicant's argument regarding the scope of protection to be afforded the registered mark is unpersuasive.<sup>5</sup> Applicant made clear that it was not asserting the third-party registrations as involving goods similar to those at issue in this case, but rather applicant submitted the third-party listings "to bring this case within the holding in *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 205 USPQ 968, 975 (5th Cir. 1980) (Applicant's Brief at 4-5), which approves the use of registrations for unrelated goods and services to show that a particular mark should be given

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<sup>5</sup> Mere typed listings of third-party registrations are not an appropriate way to enter such material into the record. See *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974); and *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992). Applicant simply referred to some third-party registrations in its response to the first Office action; and the Examining Attorney did not mention them in her Final Office action. See TBMP §1207.01 and 1207.03. In applicant's brief on appeal, it submitted photocopies of the results of two searches conducted on the USPTO Trademark Text and Image Database--one a list of 88 registrations or applications which include the word "adapt" in the mark, and one a list of 11 registrations or applications which include the letters "adapta" in the mark. (Both lists set forth only the registration or application numbers and the marks.) The Examining Attorney noted the untimeliness of this evidence, but stated she would nonetheless address the merits thereof. Thus, the submission with applicant's brief has been considered by the Board.

a limited scope of protection." (Applicant's reply brief, p. 2.) The issues in that case are distinguishable from the question of registrability at issue in this case before the Board in many ways. First, that civil action involved a suit for trademark infringement, unfair competition, violation of the Georgia anti-dilution statute, and other such claims. Second, the marks involved were the English words "Domino" or "Domino's." Third, defendant had introduced into evidence at trial 72 third-party registrations of the mark "Domino" for a wide variety of products, and "extensive evidence of 15 third-party uses of the 'Domino' mark from 1885 until the present." *Amstar v. Domino's*, supra, 205 at 979. Suffice it to say that the *Amstar* case is inapposite here where the nature of the marks involved as well as the nature and extent of the third-party registrations and uses is vastly different from that in the Court case.

Applicant's listing of third-party registrations from the USPTO database for marks which include the letters "adapt" or "adapta" do not indicate the goods and/or services, but applicant argues in its brief that seven (including the one applicant asserts it owns - ADAPT for office furniture, namely chairs) are for related goods, namely ADAPTA-MEDIA for office furniture; ADAPTAFILE for

filing cabinets; ADAPTALAB for laboratory furniture; ADAPTOR for furniture, namely, library furniture used as computer workstations; ADAPTABAK for a self-inflating pad or cushion for back or postural support; and ADAPT'R for point of purchase displays, namely plastic sign holders.

Third-party registrations are of little weight in our determination of likelihood of confusion as they are not evidence of use of the marks shown therein and they are not proof that consumers are familiar with them so as to be accustomed to the existence of similar marks in the marketplace. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Moreover, third-party applications are of virtually no evidentiary value. While the Patent and Trademark Office strives for consistency, each case must be decided on its own facts and record. Of course, we do not have before us any information from the third-party application or registration files.

Even if applicant had shown that the cited mark is weak (which it did not), such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or related goods. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

Applicant cites the case of Plus Products v. Natural Organics, Inc., 204 USPQ 773 (TTAB 1979) regarding third-party registrations of similar marks as evidence showing a lack of likelihood of confusion. We find this case is also inapposite here. In that case involving the likelihood of confusion between applicant's mark NATURE'S PLUS for vitamins and opposer's mark PLUS for vitamins, food supplements, and the like, applicant had introduced numerous third-party registrations, essentially all for related products, i.e., vitamins or food supplements. The Board also considered that applicant's mark, NATURE'S PLUS, consisted of two words which created a "unitary" expression, and would be so perceived by purchasers. In the application now before us applicant submitted lists that do not include information as to the goods and/or services, ownership, etc. Moreover, many of the third-party marks which include either "adapt" or "adapta" create many separate and differing commercial impressions.

Applicant's assertion that it owns a registration for the mark ADAPT (for "office furniture, namely, chairs") is not relevant to the issue of likelihood of confusion between applicant's applied-for mark and the cited registered mark because applicant cannot rely upon a family of marks in seeking registration of this particular mark.

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See *In re U.S. Plywood-Champion Papers, Inc.*, 175 USPQ 445 (TTAB 1972). See also, *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992).

While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must be resolved against the newcomer, as the newcomer has the opportunity of avoiding confusion and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

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