2/20/02
Hearing:
15 NOV 2001

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

Paper No. 28
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Rooms & Gardens, Inc.
v.
Rooms & Gardens and
Jami Voulgaris[1]

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Cancellation Nos. 29,345 and 29,535

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Joseph D. Lewis and Karen McGee of Barnes & Thornburg for Rooms & Gardens, Inc.

Victoria A. Carver of Carver Law for Rooms & Gardens and Jami Voulgaris.

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Before Hohein, Rogers and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 17, 1999, Rooms and Gardens, Inc. (petitioner) filed petitions to cancel Trademark Registration Nos. 2,128,231 and 2,171,437. Registration

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[1] Jami Voulgaris is now the owner of Registration No. 2,128,231 as a result of an assignment. The change in ownership is recorded with the Office at Reel/Frame No. 1973/0807. Registration No. 2,171,437 issued to Jami Voulgaris. Therefore, Jami Voulgaris has been added as a party defendant, and the caption of this proceeding amended accordingly.

No. 2,171,437 issued on July 7, 1998, as a result of an application filed on August 15, 1997, for the mark ROOMS & GARDENS (typed form) for services identified as “retail store services featuring upholstered and slipcovered furniture, wood furniture, garden furniture and accessories, gifts, bath products, candles, oil paintings and paintings” in International Class 35. The registration alleges a date of first use and a date of first use in commerce of May 29, 1993.

The second registration (No. 2,128,231) is for the following mark for the same services:

The underlying application for this registration was filed on June 5, 1996, and the registration issued on January 13, 1998. The registration alleges a date of first use and a date of first use in commerce of May 26, 1996.

Petitioner, in its petition to cancel, claims that it has filed an application to register the mark ROOMS &

GARDENS for services similar to respondent's.[2] Petitioner alleges that its application has been refused registration because of a likelihood of confusion, in view of respondent's registrations. Therefore, the petition claims
that, since the respective marks as used for the respective services create a likelihood of confusion and because petitioner has used its mark long prior to respondent's use, respondent's registrations should be cancelled. Respondent, in its answer, has denied the salient allegations of the petition to cancel. On February 14, 2000, the Board ordered these two cancellation proceedings consolidated. Both parties have filed briefs, and attended the oral hearing held on November 15, 2001.

The record in this proceeding consists of the pleadings; the registration files; the testimony deposition of petitioner's president, Margaret A. Rubino, with exhibits; the testimony deposition of respondent, Jami Voulgaris, with exhibits; and respondent's notice of reliance on petitioner's answers to respondent's first set of interrogatories.

Likelihood of Confusion

[2] Serial No. 75/428,837, filed February 4, 1998, claiming first

We note for the record that both petitioner's and respondent's marks are for the identical words and that the services are virtually identical. Petitioner's witness testified that prior to 1993, it was selling all the goods and services identified in respondent's registrations. Rubino dep. at 21-22. When the identical words are used on virtually the same services, there is no dispute that confusion is likely. In any event, respondent does not dispute that there is a likelihood of confusion, and therefore, it effectively concedes that the only issue here is priority.[3]

Priority

Respondent's registrations are presumed valid, and a petitioner seeking to cancel a registration must rebut this presumption by a preponderance of the evidence. Cerveceria Centroamericana S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989); Martahus v. Video Duplication Services Inc., 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993).

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use and first use in commerce as of 1987.

[3] Respondent requests that petitioner's application should be refused registration (Respondent's Br. at 9 and 29). This application, which is under ex parte examination, is not involved in this proceeding.

Both parties agree that the critical date for priority purposes is May 1993.[4] "Petitioner's evidence allegedly showing use of the Mark after May 1993, Respondent's date of first use, has no bearing on the resolution of the issue before the Board. Petitioner must prove its priority rights based upon evidence of its use of the Mark **prior** to Respondent's date of first use, **not after**." Respondent's Br. at 9 (emphasis in original). See also Respondent's Br. at 7 ("Since May 1993, Respondent has used the Marks Rooms & Gardens and Rooms & Gardens and design as a source indicator"). Petitioner does not dispute that in order to prevail it must demonstrate that it used its mark prior to May of 1993. Therefore, we must determine if petitioner has met its burden of establishing that it used the mark ROOMS & GARDENS before respondent used the mark in May 1993.[5]

Petitioner's witness testified that its predecessor opened a store called ROOMS & GARDENS in Washington,

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[4] Respondent's evidence supports its May 1993 priority date, and petitioner does not contest this date. See Voulgaris dep. at 6; Voulgaris Ex. 5 and 6

[5] This case is simply about who used the service mark ROOMS & GARDENS first. Use analogous to trademark use is not an issue in this case. Reply Br. at 1 ("Petitioner has not relied on use 'analogous' to trademark use. Nonetheless, Respondent spent considerable time arguing this point. Those arguments can be ignored").

D.C., in 1987. This store carried "French and American antique furniture, as well as some modern accessories, reproductions of furniture and accessories." Rubino dep. at 6. The store was operated as a partnership, which dissolved in 1989. Rubino dep. at 10. Under the terms of the dissolution agreement, "Rubino shall retain the name of 'Rooms & Gardens.'" Rubino Ex. 3, p. 2. In April of 1991, petitioner incorporated in the District of Columbia. Rubino dep. at 43; Rubino Ex. 4. Ms. Rubino testified that when Rooms & Gardens, Inc. was incorporated she transferred the trademark rights that she acquired in the partnership dissolution agreement to the corporation. Rubino dep. at 11; Rubino Ex. 3 and 4. Petitioner maintains that the mark ROOMS & GARDENS has been continuously used for retail services from 1987 through the date of the witness's testimony. Rubino dep. at 35. Petitioner's witness also testified that petitioner opened a store in New York in 1992. Rubino dep. at 43.

In order to determine whether the evidence supports petitioner's claim that it has priority of use, we must not view the individual items in the evidence standing alone, but rather as a whole.

The TTAB concluded that each piece of evidence individually failed to establish prior use.

> However, whether a particular piece of evidence by itself establishes prior use is not necessarily dispositive as to whether a party has established prior use by a preponderance. Rather, one should look at the evidence as a whole, as if each piece were part of a puzzle which, when fitted together, establishes prior use. The TTAB failed to appreciate this. Instead, the TTAB dissected the evidence to the point it refused to recognize, or at least it overlooked, the clear interrelationships existing between the several pieces of evidence submitted.

West Florida Seafood Inc. v. Jet Restaurants Inc., 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994).

Thus, after reviewing the evidence in this manner, we conclude that the record supports petitioner's prior use of the mark and, therefore, we grant the petition to cancel respondent's registrations.[6]

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[6] Respondent has also argued that petitioner has abandoned its mark. In a similar case, the Federal Circuit has held that respondent has the burden at a minimum of coming forward with some evidence of abandonment. West Florida Seafood, 31 USPQ2d at 1666. Respondent's only "evidence" of abandonment is its arguments regarding the transfer of trademark rights to Rooms & Gardens, Inc. and possibly "naked licensing." Considering the Rubino testimony (p. 11) and Rubino Ex. 3 and 4, respondent has simply failed to come forward with any evidence that petitioner's "use has been discontinued with an intent not to resume such use." 15 U.S.C. § 1127. Insofar as respondent argues that the unwritten assignment of the ROOMS & GARDENS mark from Ms. Rubino to petitioner was ineffective and somehow left petitioner without rights in the mark, we disagree. Respondent has not cited any authority for the proposition that the assignment was ineffective absent a written conveyance, nor are we aware of any such requirement. Furthermore, its contention that petitioner has engaged in "naked licensing" is unsupported by the record. Respondent's Br. at 14, 15. Use by third parties of petitioner's name on shipping receipts is not a naked license, but it is evidence that supports petitioner's claim that its mark was in use before respondent's first use.

Petitioner called as its only witness, its president, Margaret Rubino. "[O]ral testimony, if sufficiently probative, is normally satisfactory to establish priority of use in a trademark proceeding." Powermatics, Inc. v. Globe Roofing Products Co., 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965). Such testimony should "not be characterized by contradictions, inconsistencies and indefiniteness but should carry with it conviction of its accuracy and applicability." B.R. Baker Co. v. Lebow Bros., 150 F.2d 580, 66 USPQ 232, 236 (CCPA 1945).

We find that Ms. Rubino's testimony is not characterized by contradictions, inconsistencies, or indefiniteness. Ms. Rubino testified that she is currently the president and owner of the business and has been involved with the "Rooms & Gardens" business since 1987.

Rubino dep. at 5-6. National Blank Book Co. v. Leather Crafted Products, 218 USPQ 827, 828 (TTAB 1983) ("It was incumbent upon opposer in attempting to prove the date of first use of 1968 either to have a witness testify from personal knowledge that the mark 'ESP' was in use as of 1968 or, if no such person was still employed by opposer, to prove the date of first use by authenticating business

records"). She testified that the store opened in 1987 as a partnership and, after the partnership dissolved, the rights in the trademark were transferred to her. In 1991, she transferred her rights in the mark to petitioner. Rubino dep. at 11.

Ms. Rubino testified that "[o]nce I no longer had a store in Georgetown, Rooms & Gardens was working out of my house, and we had regular open houses on weekends where people from our mailing lists were invited to the house to see furnishings and accessories to buy." Rubino dep. at 32. In addition, she testified that between 1987 and the date of her testimony, there was never a period in which the mark ROOMS & GARDENS was discontinued. Rubino dep. at 35.

Ms. Rubino's testimony was supported by other exhibits that were produced during her testimony. An Annual Report for Foreign and Domestic Corporations dated April 11, 1991, indicated that Rooms & Gardens, Inc. was licensed to operate a "retail/antiques" store in Washington, D.C. Rubino Ex. 4.[7] An advertisement for Sanford Smith's Fall Antique Show at the Pier listed "Rooms & Gardens" in Washington, D.C. as one of "110

[7] Accord West Florida Seafood, 31 USPQ2d at 1665 ([W]here there is additional evidence relating to actual use, such a license

distinguished dealers from 22 states, exhibiting a complete range of American Antiques, Folk Art, Quilts, Pottery, Garden Furniture, Paintings and Sculpture." Rubino Ex. 11, p. 28. The date of the show was October 22-25, 1992. Petitioner's Ex. 28 was identified by Ms. Rubino as an ad in a 1991 issue of a now defunct magazine known as "Museum & Arts Washington" for ROOMS & GARDENS featuring "19c French Antiques, Interior Consultation Flower & Garden Design." Rubino dep. at 31. A shipping receipt to Rooms & Gardens from Faroy, Inc. dated July 18, 1988 (Rubino Ex. 1) also supports the existence of the store prior to 1993.

Finally, several pre-1993 articles in magazines mention the ROOMS & GARDENS store: *HG House & Garden*, April 1989 ("ROOMS & GARDENS: French garden antiques have been given an achingly romantic air in rooms filled with herb topiaries by Margaret Rubino, a lawyer who always wanted to design gardens…"); *Metropolitan Home*, April 1989 (Washington, D.C.; Rooms & Gardens – "At this new indoor/outdoor emporium"); *Washingtonian*, May 1989 (Rubino Ex. 16) (Rubino [dep. at 16] identifies Ms. Rubino as the person pictured in the article, which

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becomes quite probative in that it further corroborates the other evidence").

describes her as the "co-owner of Rooms & Gardens, a store featuring mostly antique furnishing and accessories for gardens and garden rooms"); *Metropolitan Home* July 1990 ("To gaze at the eloquent objects at Washington, D.C.'s Rooms & Gardens – turn-of-the-century mosaic bowls and urns embedded with glistening bits of china…"). Ms. Rubino testified that: "The impact of these listings, what we call editorial pieces as opposed to paid advertising, are incalculable because we are not having to blow our horn. Someone is doing it for us, and they are the objective reporters in this field, and so that's why it carries great weight." Rubino dep. at 17-18. Petitioner maintains that articles such as those discussed above helped it develop a national reputation in the home décor field by 1989. Petitioner's Br. at 3; Rubino dep. at 11 ("Because even in September of 1989, the name already had--was already known. It was already recognized as an important source of design and good furniture, and because of the reputation had already been made by these national publications").

Respondent attacks petitioner's evidence on several grounds. It notes that shipping receipts are not evidence of use in commerce by petitioner. Respondent's Br. at 11. It also alleges that the magazines merely

prove "incidental, uncontrolled third[-]party use of the mark." Respondent's Br. at 17. We disagree. The receipts and magazines are simply further corroboration of Ms. Rubino's testimony that petitioner's mark was in use prior to 1993. Also, respondent argues that petitioner's mark "did not consistently represent a single source of services, and thus is not a source indicator." Respondent's Br. at 8. Petitioner's witness, though, did explain that the partnership dissolved in 1989 and the rights in the trademark were assigned to the witness who subsequently testified that she assigned the mark to the corporation (petitioner). There is simply no evidence that multiple entities were using the mark. We note that even if there was some issue regarding abandonment by previous entities that owned the mark, Ms. Rubino testified that petitioner incorporated in early 1991 (Rubino dep. at 11) and petitioner's Ex. 4 shows that petitioner was incorporated by April of 1991. Subsequently, an advertisement for petitioner's store appeared subsequently in *Museum & Arts Washington*. See Rubino Ex. 28 (Since the exhibits refers to a previous March/April issue, the magazine must have appeared subsequent to petitioner's incorporation date). Also, ROOMS & GARDENS is identified as an exhibitor at

the October 22-25, 1992, Fall Antique Show at the Pier. Rubino Ex. 28. Thus, at an absolute minimum, petitioner has shown that it, not a predecessor, used its mark beginning in 1991, which is before respondent's date of first use.

The testimony of Ms. Rubino and the exhibits overcome the presumption that attaches to respondent's registrations because they show that petitioner's marks were in use prior to respondent's marks. The other evidence of record corroborates the witness's testimony. The evidence shows that petitioner "was already in a position to register its mark, had it chosen to do so, and that it would have been able to state in its application that the mark is in use in commerce." Powermatics, 144 USPQ at 431 (quotation marks omitted). Because there is no dispute that when the identical words ROOMS & GARDENS are used on virtually the same services, confusion is likely, we grant the petition to cancel respondent's two registrations.

Decision: The petition for cancellation is granted. Registration Nos. 2,128,231 and 2,171,437 will be cancelled in due course.