

**THIS DECISION IS NOT
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OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TruServ Corporation

Serial No. 76067950

Christopher J. Schulte and Kristine M. Boylan of Meagher & Geer for applicant.

Doritt Carroll, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Hanak, Quinn and Drost, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by TruServ Corporation to register the mark PARTY PLUS ("PARTY" disclaimed) for

retail store services and wholesale distributorship services featuring the rental and leasing of party equipment and supplies, such as tables, chairs, glassware, china, flatware, plastic ware, food service, linen, concession equipment, disposables, dance floor and staging, tenting[,] party favors, balloons and decorations.¹

¹ Application Serial No. 76067950, filed June 12, 2000, alleging a bona fide intention to use the mark in commerce. Applicant subsequently filed an amendment to allege use setting forth a

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when used in connection with applicant's services, so resembles the previously registered mark shown below



for "retail store services specializing in party supplies"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

Applicant argues, in urging that the refusal be reversed, that the numerous third-party uses of the common terms of each mark, in connection with similar services, have created a situation where the likelihood of confusion is de minimus. In connection with its principal contention that the cited mark is weak, applicant submitted the

date of first use anywhere and a date of first use in commerce of 1990.

² Registration No. 2,169,375, issued June 30, 1998; Section 8 affidavit filed and accepted. The registration sets forth dates of first use of August 1983. The words "Party" and "Warehouse" are disclaimed apart from the mark.

following evidence: copies of thirteen third-party registrations of marks employing the term "party" for retail store services featuring party supplies; and the declaration of Judi Stinson, a paralegal at the law firm representing applicant, accompanied by information relating to nineteen third-party common law uses of marks employing both of the terms "party" (or "parties") and "plus" in the party supplies industry. Ms. Stinson states that she called each of the nineteen users to confirm that they were actually using the respective marks. The information on these third-party uses includes Dun & Bradstreet reports, excerpts from websites on the Internet, and brochures. According to applicant, this evidence of third-party usage of PARTY (or PARTIES) PLUS marks in the party supplies field is competent to suggest that purchasers have been conditioned to look to other elements of the marks as a means of distinguishing the source of the goods or services in the field. Applicant further contends that its mark uses a simple alliteration which creates a commercial impression that is distinct from the one engendered by registrant's mark. Applicant also contends that the absence of any instances of actual confusion over a ten-year period of contemporaneous use weighs in its favor.

The examining attorney maintains that the marks are similar and that the services are closely related. The examining attorney points to applicant's evidence to show that the same entities offer both sales and rental of party supplies in retail outlets. The examining attorney also discounts applicant's evidence of third-party usage and states that, in any event, even a weak mark is entitled to protection against the registration of a similar mark for closely related services.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also: *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Insofar as a comparison of registrant's "retail store services specializing in party supplies" with applicant's

"retail store services and wholesale and distributorship services featuring the rental and leasing of party equipment and supplies" is concerned, the services are, at least in part, legally identical, or otherwise closely related.³ Applicant does not seriously contend to the contrary. The Federal Circuit has stated that when "marks would appear on virtually identical goods or services, 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, 1701 (Fed. Cir. 1992).

When comparing applicant's mark PARTY PLUS with registrant's mark PARTY PLUS WAREHOUSE and design, we find that the marks are sufficiently similar that, when used in connection with legally identical or closely related services, confusion is likely to occur among consumers in the marketplace.

Although we have considered the marks in their entirety, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a

³ Registrant's recitation of services is broad enough to encompass retail store services featuring the rental or leasing of party supplies. In any event, the sale of party supplies is closely related to the rental of party supplies, a point highlighted by the evidence of record showing that single entities have done both under the same mark.

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, a literal portion of a mark usually dominates over any design portion because the literal portion would be most likely to be remembered by consumers and used by them in calling for the services. In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987).

In the present case, we find that the literal portion of registrant's mark dominates over the design portion. Although consumers would see the teddy bear holding the balloons design, the literal portion PARTY PLUS WAREHOUSE would be most likely to be remembered by consumers and would be used by them in calling for registrant's services. This literal portion, PARTY PLUS WAREHOUSE, of registrant's mark is similar to applicant's mark PARTY PLUS in sound, appearance and meaning. Moreover, the registered mark shows the words PARTY PLUS in strikingly bold type and in a font size larger than that of the word WAREHOUSE. Thus, the PARTY PLUS portion of registrant's mark, which is identical to the entirety of applicant's mark, stands out even more in the mark as depicted. Consumers encountering both marks might well assume that the services originated

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with or are associated with the same source, further thinking that the goods/services at PARTY PLUS WAREHOUSE are offered at a discount price or that the variety of goods/services there exceeds that found at the PARTY PLUS brand store.

Both services feature party supplies, and we do not believe anything more than ordinary care would be used by purchasers in availing themselves of these services. In finding that the marks are similar, we have kept in mind the fallibility of purchasers' memories, and that they normally retain a general rather than a specific impression of trademarks encountered in the marketplace.

In sum, applicant's deletion of the word WAREHOUSE and of the teddy bear design from registrant's mark does not result in a sufficiently distinguishable mark. See, e.g., *Hewlett Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *In re Computer Systems Center Inc.*, 5 USPQ2d 1378 (TTAB 1987). We are not persuaded by applicant's arguments that the marks in their entireties convey significantly different commercial impressions, or that the matter common to the marks (PARTY PLUS) is not likely to be perceived by purchasers as distinguishing source because it is diluted (see

discussion, infra). Cf. In S.D. Fabrics, Inc., 223 USPQ 54 (TTAB 1984).

Applicant's principal argument is that the cited mark is weak and, in this connection, applicant supplied evidence of third-party uses and registrations of similar marks in the party supplies field.

With respect to the thirteen third-party registrations of marks which include the term "party," this evidence is of limited probative value. The registrations do not establish that the marks shown therein are in use, much less that consumers are so familiar with them that they are able to distinguish among such marks by focusing on slight differences between them. Smith Bros. Manufacturing Co. v. Stone Manufacturing Co., 476 F.2d 1004, 177 USPQ 462 (CCPA 1973). We would add that, in any event, none of these registered marks (all of which contain the term "party" but not "plus") is as similar to registrant's mark as is applicant's mark.

We also have considered applicant's evidence of nineteen third-party uses of marks which employ both of the terms "party" (or "parties") and "plus" in the party supplies field. The Board has in the past, in likelihood of confusion cases, given weight to evidence of widespread and significant use by third parties of marks containing

elements in common with the involved marks to demonstrate that confusion is not, in reality, likely to occur in the marketplace. See, e.g., *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1462 (TTAB 1987). The justification is, of course, that the presence in marks of common elements extensively used by others unrelated as to source may cause purchasers not to rely upon such elements as source indicators, but to look to other elements as a means of distinguishing the source of the services. By relying on the third-party marks which employ both of the terms "party" and "plus," applicant would have us conclude that small variations in the PARTY (PARTIES) PLUS marks in the field, including applicant's and registrant's marks, are sufficient to avoid confusion.

We have carefully considered the evidence of third-party use, but find that it is not persuasive to reach the result urged by applicant. Although Ms. Stinson's declaration (indicating that she verified the various uses by telephone calls to the parties) and the accompanying exhibits show that the nineteen marks are in use, there is no evidence regarding the extent of this use. *Carl Karcher Enterprises Inc. v. Stars Restaurant Corp.*, 35 USPQ2d 1125, 1131 (TTAB 1995). Thus, while we have taken the third-party uses into account, the probative value of this

evidence is clearly diminished by the absence of any significant information regarding the extent of use. It may well be that the third parties are small businesses and that the uses are local in nature. In point of fact, what evidence we do have shows that most of the businesses employ only a small number of employees, and that when sales are shown, the figures are relatively modest. See *Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835, 1839 n. 5 (TTAB 1989) [The probative value of Dun & Bradstreet reports and telephone verifications of use is limited, since this evidence does not indicate the extent to which an entity's name is used or what opportunity the public has had to become aware of any use.]

Although applicant has relied upon the Board's decision in *In re Broadway Chicken Inc.*, 38 USPQ2d 1559 (TTAB 1996), that case is clearly distinguishable on its facts. The nineteen common law uses herein stand in stark contrast to the several hundreds of uses of BROADWAY for restaurants shown by applicant in that case.⁴

Our conclusion in this case is not diminished by applicant's unsupported assertion that it has not

⁴ In that case, the record included more than 500 uses of BROADWAY shown in Dun & Bradstreet reports, a number of listings in telephone directories, and over 300 uses in the American Business Directory search report.

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encountered any instances of actual confusion between its mark and registrant's mark during ten years of contemporaneous use. While the absence of any instances of actual confusion over a significant period of time is a factor indicative of no likelihood of confusion, it is a meaningful factor only where the record demonstrates appreciable and continuous use by the applicant of its mark in the same markets as those served by the registrant under its mark. *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). It is not a mitigating factor where, as here, the record is devoid of information concerning the nature and extent of the marketing activities of applicant and registrant under their respective marks during the asserted period of contemporaneous use. *Cunningham v. Laser Golf Corp.*, 222 F.2d 943, 55 USPQ 1842, 1847 (Fed. Cir. 2000).

We conclude that purchasers familiar with registrant's retail store services specializing in party supplies rendered under registrant's mark PARTY PLUS WAREHOUSE and design would be likely to believe, upon encountering applicant's mark PARTY PLUS for retail store services and wholesale and distributorship services featuring the rental and leasing of party equipment and supplies, that the

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services originated with or are somehow associated with or sponsored by the same entity.

Lastly, to the extent that any of the points argued by applicant cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.