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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77106782
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark application Serial No. 77/106,782

For the mark SPORT BEANS

Appeal Resumed May 21, 2008

JELLY BELLY CANDY COMPANY,

Applicant Appellant

APPEAL BRIEF

FACTS

Applicant, through its attorneys submitted a Request for Reconsideration of the Examining Attorney's final refusal of registration of the subject mark on the ground that that mark allegedly so closely resembles the mark shown in U.S. Registration No. 2,697,973 as to be likely, when used on the identified goods, to cause confusion, or to cause mistake, or to deceive. Applicant's Request for Reconsideration was denied.

ISSUES

The issue is whether or not the subject mark so closely resembles the mark shown in U.S. Registration No. 2,697,973 as to be likely, when used on the identified goods, to cause confusion, or to cause mistake, or to deceive.

ARGUMENTS

I. Likelihood of Confusion

In the first Office Action, the Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act on the ground that Applicant's mark, SPORT BEANS, so closely resembles the mark shown in U.S. Registration No. 2,697,973 as to be likely, when used on the identified goods, to cause confusion, or to cause mistake, or to deceive. In the second Office Action, the Examining Attorney continued, and made Final, the refusal to register Applicant's mark under Section 2(d). The Examining Attorney has denied Applicant's Request for Reconsideration.

Applicant renews and reiterates the arguments advanced in its response to the first Office Action and in the Request for Reconsideration. Based on those arguments and the additional arguments set forth below, Applicant avers that its mark does not

so closely resemble the mark shown in U.S. Registration No. 2,697,973 as to be likely, when used on the identified goods, to cause confusion, or to cause mistake, or to deceive. Accordingly, Applicant requests that the refusal to register under Section 2(d) be withdrawn.

A. Applicable Legal Standard

In order for a mark to be refused registration under Section 2(d), it must so resemble a registered mark that it is likely, when applied to the goods, to cause confusion, mistake or to deceive the potential customer as to the source of the goods. TMEP § 1207.01.

B. No Doubt Exists as to Likelihood of Confusion

Applicant avers that there is no likelihood of confusion between Applicant's mark and the mark shown in U.S. Registration No. 2,697,973. The Examining Attorney has stated that "any doubt as to the existence of likelihood of confusion must be resolved in favor of the registrant," citing *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) and *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

The marks considered in *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988), were "bigg's" and "Biggs" shown with an oval border, marks that are virtually identical in appearance and sound and which are therefore easily confused. The fact that the court entertained any doubt as to the likelihood of confusion with such strikingly similar marks suggests that there can be no doubt that Applicant's mark, SPORT BEANS, and the mark shown in U.S. Registration No. 2,697,973, BEANSPORT, are not confusingly similar, as they are strikingly different in appearance and sound.

The marks considered in *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974), were relatively dissimilar in sound and appearance, but there was evidence of actual confusion and the court found that the marks were "similarly suggestive of the nature of the goods … , … convey to prospective purchasers the same idea, same mental reaction, and same meaning." *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 182 USPQ at 370 (C.C.P.A. 1974). Applicant's mark, SPORT BEANS, and the mark shown in U.S. Registration No. 2,697,973, BEANSPORT, are not similarly suggestive of the nature of the goods and the marks do not convey the same idea, same mental reaction or the same meaning.

C. <u>The Marks are Dissimilar in Sound, Appearance, Meaning and Connotation</u>

The Examining Attorney has stated that Applicant's mark and the mark shown in U.S. Registration No. 2,697,973 are similar in sound, appearance, meaning and connotation, but has not compared the marks in sound, appearance, meaning or connotation. Applicant asserts that the marks are dissimilar in sound, appearance, meaning and connotation and, consequently, there is no likelihood of confusion between them. In support of Applicant's assertion, Applicant attached, as Exhibit 2, the declaration of Laurel Sutton, Linguistics and Project Director of Catchword brand name development, to the Request for Reconsideration filed April 4, 2008.

D. <u>No Common Elements</u>

If and when the respect marks are considered without reference to external information, it is not even clear that they share common elements. Certainly, SPORT BEANS is not susceptible of any other reading. However, BEANSPORT can be read either as "BEAN SPORT," or as "BEANS PORT." "BEANS PORT" may be no more or less similar to SPORT BEANS than "BEAN SPORT," but the fact that BEANSPORT is susceptible of two alternate readings means that it is more likely to be closely parsed than a less ambiguous mark. It is, therefore, less likely to be confused with an allegedly similar mark.

E. Different Connotations and Meanings

First, it is not clear that BEANSPORT is, in fact, a compound word. It may be a coined word that has no meaning at all and a connotation so obscure that it is impossible to compare to SPORT BEANS in any logical way at all.

Second, if one assumes that BEANSPORT is a compound word, it is not clear what the elements are. As argued above, BEANSPORT can be broken up either as "BEANS PORT" or as "BEAN SPORT." These two phrases have different potential connotations, none of which is similar to SPORT BEANS.

Third, if one is unaware of the connection to L. L. Bean (as one would be if one simply heard BEANSPORT spoken aloud), and one nevertheless chooses to parse BEANSPORT as "BEAN SPORT," the most likely connotation is probably "a sport played with one or more beans." That connotation has nothing in common with the most likely connotation of SPORT BEANS, which is probably "beans related in some way to one or more sports." In this case, "BEAN SPORT" describes a sport. SPORT BEANS describes a bean. Nothing suggests that the two have any beans in common.

In sum, the Examining Attorney can only have arrived at confusingly similar connotations or meanings by (1) electing to parse BEANSPORT in only one of at least three possible ways, (2)

electing only one of several possible meanings of BEANSPORT, and (3) electing to interpret both BEANSPORT and SPORT BEANS as phrases that each comprise two unrelated nouns, "BEAN(S)" and "SPORT," rather than phrases that each comprise an adjective followed by a noun. None of these elections by the Examining Attorney is legitimate, and all three taken together impose an arbitrary and capricious standard on the interpretation of the marks at issue.

F. Transposition of Elements Has Created Dissimilar Commercial Impressions and Meaning

Applicant avers that the transposition and separation of the elements SPORT and BEAN, and the pluralization of BEAN to BEANS, creates a mark, SPORT BEANS, that makes a dissimilar commercial impression and conveys a different meaning than the mark BEANSPORT. The Examining Attorney has stated that these differences do not change the overall commercial impression, citing *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989), *In re Nationwide Indus. Inc.*, 6 USPQ2d 1882 (TTAB 1988), and *In re General Tire & Rubber Co.*, 213 USPQ 870 (TTAB 1982). *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989), addresses two marks in which the dominant elements are descriptive phrases, "THE WINE SOCIETY OF AMERICA" and "AMERICAN WINE SOCIETY 1967", which have virtually identical meanings, despite the transposition of elements. *In re Nationwide Indus.*

Inc., 6 USPQ2d 1882 (TTAB 1988), addresses two marks, RUST BUSTER and BUST RUST, which are both highly descriptive and have virtually identical meanings, despite the transposition of elements. *In re General Tire & Rubber Co.*, 213 USPQ 870 (TTAB 1982), also addresses two marks, SPRINT STEEL RADIAL and RADIAL SPRINT, which are both highly descriptive and have virtually identical meanings, despite the transposition of elements. As noted above, SPORT BEANS connotes sporty, or sporting, beans. If one is aware of the connection to L. L. BEAN, BEANSPORT probably connotes something sporty or sporting made by L. L. Bean. Under this interpretation, SPORT BEANS and BEANSPORT, do not convey similar meanings.

Marks that contain transposed elements are not confusingly similar if they create different commercial impressions. In *McCallum-Legaz Fish Company, Inc. v. The Frozen Food Forum Inc.*, 118 USPQ 178 (Comm'r Pat. 1958), the court allowed the mark FROSTY SEAS to be registered for "a variety of frozen sea food products, including deviled crabs, fish sticks, fantail shrimp, skinless haddock, cod, flounder, ocean perch and ocean catfish". *McCallum-Legaz Fish Company, Inc. v. The Frozen Food Forum Inc.*, 118 USPQ at 179 (Comm'r Pat. 1958). The prior registration of the mark SEAFROST was for "frozen salmon and halibut, and for frozen whole halibut, whole salmon, and steaks and fillets therefrom." *McCallum-Legaz Fish Company, Inc. v. The*

Frozen Food Forum Inc., 118 USPQ at 179 (Comm'r Pat. 1958). The court noted:

Applicant's mark appears to be considerably more than a mere reversal of the terms "sea" and "frost" in that "FROSTY SEAS" stimulates an association with cold sea water, whereas "SEAFROST" stimulates an association with white frost crystals. Applicant's mark does not look like opposer's; it does not sound like opposer's; and it stimulates a quite different mental association than opposer's, thereby creating a different commercial impression. Under the circumstances of this case, it is concluded that there is no likelihood of purchaser confusion. *McCallum-Legaz Fish Company, Inc. v. The Frozen Food Forum Inc.*, 118 USPQ at 179 (Comm'r Pat. 1958).

In *In re Mavest, Inc.*, 130 USPQ 40 (TTAB 1961), the court allowed the mark SQUIRETOWN to be registered for "men's sport coats". *In re Mavest, Inc.*, 130 USPQ at 41 (TTAB 1961). The prior registration of the mark TOWN SQUIRES was for "men's shoes". *In re Mavest, Inc.*, 130 USPQ at 41 (TTAB 1961). The court noted that, "[w]hile 'SQUIRETOWN' is a substantial transposition of the registered mark 'TOWN SQUIRES', it is clear that these marks create distinctly different commercial impressions." *In re Mavest, Inc.*, 130 USPQ at 41 (TTAB 1961). Furthermore, the court concluded that "whatever doubt that may exist as to likelihood of

confusion in trade should be resolved in applicant's behalf". *In re Mavest, Inc.*, 130 USPQ at 41 (TTAB 1961).

In *In re Best Products Co., Inc.*, 231 USPQ 988 (TTAB 1986), the court allowed the mark BEST JEWELERS to be registered for "retail jewelry store services". *In re Best Products Co., Inc.*, 231 USPQ at 988 (TTAB 1986). The prior registration of the mark JEWELER'S BEST was for "men's and ladies' bracelets and watch bracelets, sold separately from the watches." *In re Best Products Co., Inc.*, 231 USPQ at 989 (TTAB 1986). The court noted that "[t]here is no question that jewelry store services and jewelry are highly related goods and services from the standpoint of the likelihood of confusion issue." *In re Best Products Co., Inc.*, 231 USPQ at 989 (TTAB 1986). However, the court also noted that "[t]he mark JEWELER'S BEST connotes a selection of jewelry reflecting a quality level perceived by the jeweler personally … On the other hand, BEST JEWELRY consists of the house mark 'Best' coupled with the generic name of the services." *In re Best Products Co., Inc.*, 231 USPQ at 989 (TTAB 1986). In BEST JEWELRY, "the house mark impression clearly dominates … One reason, obviously, is that 'Best' is also a surname." *In re Best Products Co., Inc.*, 231 USPQ at 989 (TTAB 1986). Similarly, the "BEAN" in "BEANSPORT" is the house mark and surname of L. L. Bean.

These cases are all closely analogous to the present situation, in which two marks with transposed elements (like SEAFROST and

FROSTY SEAS, SQUIRETOWN and TOWN SQUIRES, and JEWELER'S BEST and BEST JEWELERS) make different commercial impressions because they convey different meanings with those transposed elements, and despite their application to related goods and services. SPORT BEANS connotes sporty, or sporting, beans. Hypothetically, BEANSPORT connotes something sporty or sporting made by L. L. Bean. Applicant's mark, SPORT BEANS, and the mark shown in U.S. Registration No. 2,697,973, BEANSPORT, do not convey similar meanings and hence create different commercial impressions.

Applicant's mark, SPORT BEANS, is arbitrary or fanciful as applied to clothing, whereas the cited mark, BEANSPORT, is at least suggestive and may be viewed as at least partially descriptive of sport clothing made by L. L. Bean. SPORT BEANS connotes sporty, or sporting, beans. In addition to clothing, the Applicant makes a jelly bean product called SPORT BEANS. BEANSPORT connotes something sporty or sporting made by L. L. Bean. As a general rule, English adjectives come before the nouns that they modify.

G. Different Channels of Trade

One of the factors addressed by the court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), is channels of trade. L. L. Bean, the owner of U.S. Registration No. 2,697,973 for BEANSPORT, has always sold its products directly to

consumers through its L. L. Bean stores, its L. L. Bean catalog, and its Web site at www.llbean.com (Applicant attached, as Exhibit 3, the 4/1/2008 printout of company background information at http://www.llbean.com/customerService/ aboutLLBean/background.html has been attached to the Request for Reconsideration filed April 4, 2008.). Registrant's BEANSPORT goods can only be purchased directly from L. L. Bean. Any and all purchasers know the source of the goods. Applicant's SPORT BEANS goods cannot be purchased from L. L. Bean, either directly or indirectly. Consequently, there can be no confusion as to the source of either goods.

H. No Actual Confusion

One of the factors addressed by the court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), is actual confusion. The absence of actual confusion suggests that there is no likelihood of confusion. Applicant knows of no actual confusion between Applicant's mark, SPORT BEANS, and the mark shown in U.S. Registration No. 2,697,973, BEANSPORT. In support of Applicant's claim of no actual confusion, Applicant attached, as Exhibit 1, the declaration of Robert M. Simpson, Jr., President & COO of Applicant, to the Request for Reconsideration filed April 4, 2008.

II. Conclusion

In light of the above, there is no likelihood of confusion between Applicant's mark SPORT BEANS and the mark BEANSPORT shown in U.S. Registration No. 2,697,973 because the marks are very different in appearance, sound, connotation, meaning and commercial impression. Furthermore, the goods move in different channels of trade and, despite three years of concurrent use, there has been no actual confusion on the part of consumers.

Respectfully submitted,

By /Nicolas S. Gold/ Date July 21, 2008

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TABLE OF AUTHORITIES

In re Best Products Co., Inc., 231 USPQ 988 (TTAB 1986)

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