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298733-00001

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# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 77/290085

**MARK:** GOURMET CHOICE



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** Del Monte Corporation

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

298733-00001

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant has appealed a likelihood of confusion finding under Trademark Act Section 2(d) between its mark GOURMET CHOICE for "seafood" and the registrant's mark THE GOURMET'S CHOICE SALMONES ANTARTICA LTDA. and design for fresh and frozen salmon.

### **STATEMENT OF FACTS**

On September 27, 2007, the applicant applied to register its mark GOURMET CHOICE in standard characters for "seafood." By Office Action of December 3, 2007, the examining attorney refused registration pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because of the likelihood of confusion between the applicant's

mark and the mark THE GOURMET'S CHOICE SALMONES ANTARTICA LTDA. and design in Registration No. 1,457,628 for "fresh and frozen salmon." The registrant's mark is reproduced below.



The applicant responded to the initial Office Action on June 3, 2008. A Final Action maintaining the refusal to register was issued on June 25, 2008. On December 23, 2008, the applicant filed this appeal.

## ISSUE

**Whether a likelihood of confusion exists between the applicant's mark GOURMET CHOICE for "seafood" and the registrant's mark THE GOURMET'S CHOICE SALMONES ANTARTICA LTDA. and design for fresh and frozen salmon.**

## ARGUMENTS

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when

determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see*

*Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

### **I. Marks Are Similar**

The marks are highly similar in this case. First, the word portions are generally the dominant and most significant features of marks because consumers will call for the goods and/or services in the marketplace by that portion. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); *In re Drug Research Reports, Inc.*, 200 USPQ 554, 556 (TTAB 1978).

When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and/or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729, 735 (TTAB 1976); TMEP §1207.01(c)(ii).

The word portions of the marks are nearly identical in appearance, sound and meaning. The addition of the design element does not obviate the similarity of the marks in this case. *See In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); TMEP §1207.01(c)(ii).

In addition, marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii). The marks contain GOURMET CHOICE and GOURMET'S CHOICE, which are essentially identical marks.

The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on

the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b). The difference between GOURMET'S and GOURMET is insignificant and the marks have the same overall commercial impression. Consumers are likely to be confused as to the source of the goods when they encounter the goods bearing the marks because they are likely to believe that the goods derive from a single source of seafood.

Moreover, the mere deletion of wording from a registered mark may not be sufficient to overcome a likelihood of confusion. *See In re Optical Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(b)(iii). Applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark. In the present case, applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrant's mark. The applicant's mark deletes the design and SALMONES ANTARTICA LTDA.

The applicant argues that there is no likelihood of confusion because the marks are not similar. It emphasizes the design and words SALMONES ANTARTICA LTDA. to differentiate the marks. The applicant argues that the words SALMONES ANTARTICA LTDA. function as the source indicator of the registrant's goods and therefore, their absence in the applicant's mark obviates any likelihood of confusion. Finally, the

applicant argues that the words GOURMET('S) and CHOICE are weak and diluted, and that GOURMET'S CHOICE versus GOURMET CHOICE have distinct meanings.

The examining attorney has considered the applicant's arguments carefully and found them unpersuasive. First, as discussed above, the design portions of a mark are the least dominant portions because consumers tend to recall trademarks by the words. In addition, although the words SALMONES ANTARTICA LTDA. do not appear in the applicant's mark, the fact remains that the applicant's mark contains the words GOURMET CHOICE, which is essentially identical to the words GOURMET'S CHOICE in the registrant's mark. A party cannot avoid a likelihood of confusion by merely deleting wording from a registered mark. *See In re Optical Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(b)(iii).

Further, the distinction between GOURMET'S CHOICE and GOURMET CHOICE is insignificant and the marks are similar. The applicant concedes that it is "not a major distinction." App. Brief pg. 3. Any semantic difference does not discount the fact that they convey the same idea, stimulate the same mental reaction, or have the same overall meaning. *Proctor & Gamble Co. v. Conway*, 419 F.2d 1332, 1336, 164 USPQ 301, 304 (C.C.P.A. 1970) (holding MR. STAIN likely to be confused with MR. CLEAN on competing cleaning products); *see Ralston Purina Co. v. Old Ranchers Canning*, 199 USPQ 125 (TTAB 1978) (holding TUNA O' THE FARM for canned chicken likely to be confused with CHICKEN O' THE SEA for canned tuna); *Downtowner Corp. v.*

*Uptowner Inns, Inc.*, 178 USPQ 105 (TTAB 1973) (holding UPTOWNER for hotel name likely to be confused with DOWNTOWNER for a hotel name); TMEP §1207.01(b).

Finally, the applicant's argument that the words GOURMET and CHOICE are weak is also not persuasive in this case because the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 18 USPQ 337 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975). It is also noted that the applicant has submitted third party registrations with its Appeal Brief in support of this argument; however, the record in an application must be complete prior to the filing of an appeal. Because the proposed evidence was untimely submitted, this evidence should not be considered. 37 C.F.R. §2.142(d); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1059 n.2 (TTAB 2002); *In re Trans Cont'l Records Inc.*, 62 USPQ2d 1541, 1541 n.2 (TTAB 2002); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

Assuming, *arguendo*, that GOURMET and CHOICE appear separately in numerous marks as the applicant argues, the words appear together as a unit in only a few third party registrations. And more significantly, the use of GOURMET('S) CHOICE for seafood is isolated to the applicant's and the registrant's goods only.

## **II. Goods are Related**

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

The goods are highly related in this case. Likelihood of confusion is determined on the basis of the goods and/or services as they are identified in the application and registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 1207 n.4, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); TMEP §1207.01(a)(iii).

In this case, applicant's goods and/or services are identified broadly. Therefore, it is presumed that the application encompasses all goods and/or services of the type described, including those in the registrant's more specific identification, that they move in all normal channels of trade, and that they are available to all potential customers. *See* TMEP §1207.01(a)(iii); *see, e.g., In re Americor Health Servs.*, 1 USPQ2d 1670, 1670-71 (TTAB 1986); *In re Equitable Bancorporation*, 229 USPQ 709, 710 (TTAB 1986).

The applicant's seafood may encompass salmon. In addition, various seafood emanate from common sources. Please refer to the previously attached definition of "seafood" and third party registrations showing that salmon and seafood emanate from the same sources. This evidence has probative value to the extent that they serve to suggest that the parties' goods are of a kind that may emanate from a single source. *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

The applicant does not set forth any arguments regarding the relatedness of the goods, which is a tacit admission that the goods are related.

### **CONCLUSION**

The applicant's mark GOURMET CHOICE for "seafood" is confusingly similar to the registrant's mark THE GOURMET'S CHOICE SALMONES ANTARTICA LTDA. and design for "fresh and frozen salmon." For the foregoing reasons, the examining attorney respectfully requests that the Board affirm the refusal to register the applicant's mark under Trademark Act Section 2(d).

Respectfully submitted,

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