

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: June 11, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Starkist Co.¹

Serial No. 77290085

David V. Radak of Eckert Seamans Cherin & Mellot, LLC for
Del Monte Corp. and Starkist Co.

Alex Seong Keam, Trademark Examining Attorney, Law Office
114 (K. Margaret Le, Managing Attorney).

Before Drost, Zervas and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Starkist Co. is the owner of an application to
register on the Principal Register the mark GOURMET CHOICE
in standard characters for "seafood" in International Class
29.²

¹ Assignment of the involved application from original applicant
Del Monte Corp. to Starkist Co. was recorded with the Assignment
Branch of this Office on October 16, 2008 at Reel 3871/Frame
0607.

² Application Serial No. 77290085 was filed on September 27,
2007, based upon applicant's assertion of December 31, 1998 as
the date of first use of the mark anywhere and in commerce for
the goods. GOURMET is disclaimed apart from the mark as shown.

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as used on or in connection with its goods, so resembles the mark shown below, previously registered on the Principal Register for "fresh and frozen salmon" in International Class 29,³ as to be likely to cause confusion.



When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs on the issue under appeal.

Evidentiary Objection and Request for Remand

As a preliminary matter, we note that applicant submitted for the first time with its brief copies of several third-party registrations assertedly to show that

³ Registration No. 1457628 issued on September 15, 1987 with a disclaimer of LTDA and SALMONES, and the following translation: The English translation of the word "SALMONES ANTARTICA LTDA." in the mark is "ANTARTICA SALMONS LTD." Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

"gourmet" and "choice" are weak as applied to seafood and other foods. Applicant stated the following: "Applicant notes that this evidence was not submitted prior to appeal. Applicant has a new attorney who did not prosecute this application before the appeal. In the event that the Board does not consider this evidence, Applicant requests the Board to suspend this appeal and remand the application for further examination." (Brief, p. 2, fn. 1).

Trademark Rule 2.142(d) provides that the record in an application should be complete prior to the filing of the appeal. In that regard, the file of the involved application indicates that applicant filed its revocation of previous power of attorney and appointment of the above-noted attorney of record on October 17, 2008. The examining attorney issued his final Office action on June 25, 2008, affording applicant six months to respond thereto. Applicant filed its notice of appeal on December 23, 2008. The Board issued an order acknowledging the notice of appeal the same day, allowing applicant until February 21, 2009 to file its brief. Applicant filed its brief on February 19, 2009. Applicant's present counsel thus had from October 17, 2008 until December 26, 2008 in which to file a request for reconsideration of the examining attorney's June 25, 2008 final refusal to

register that is the subject of the instant appeal. See Trademark Rule 2.64(b). In addition, applicant's present counsel had an additional sixty days from its December 23, 2008 filing of its notice of appeal in which to request remand of the involved application for consideration of the evidence it attached to its brief on appeal. See Trademark Rule 2.142(d). See also TBMP §1207.02 and the authorities cited therein.

Thus, applicant's current counsel of record had a two-month opportunity to file a request for reconsideration, accompanied by the new evidence, prior to the appeal, as well as an additional two months to request remand of the application to submit additional evidence after appeal. What is not acceptable is for applicant simply to submit evidence with its appeal brief, without making any prior attempt to introduce such evidence despite having ample time and the two above-noted mechanisms in which to do so. Applicant's submission of the evidence with its appeal brief is untimely. Accordingly, the exhibits accompanying applicant's appeal brief have not been considered in reaching our decision.⁴

⁴ We hasten to add, however, that even if we had considered this evidence, we would not reach a different result in this appeal because applicant's evidence pertains solely to the strength of the mark in the cited registration, which is only one factor in

Likelihood of Confusion

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, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (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, 27 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

The Goods

In determining the issue of likelihood of confusion in ex parte cases, the Board must compare applicant's goods as set forth in its application with the goods as set forth in the cited registration. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). In this case, applicant's broadly identified "seafood" encompasses registrant's more specifically identified "fresh and frozen salmon." With

our determination of the du Pont factor concerning the similarity of the marks.

his June 25, 2008 Office action, the examining attorney made of record definitions of "salmon" and "seafood." According to these definitions, "salmon" may be defined as "a large food fish with soft fins that spends most of its life in the ocean but migrates up freshwater rivers to spawn; Native to northern Atlantic, northern Pacific"⁵ and "seafood" may be defined as "edible fish or shellfish from the sea."⁶ Thus, as identified, applicant's "seafood" is presumed to include registrant's "fresh and frozen salmon."

Finally, we note that applicant does not argue in its brief that the goods are dissimilar. Accordingly, this du Pont factor also favors a finding of likelihood of confusion.

Channels of Trade

Neither applicant's goods nor those of registrant contain any restrictions as to the channels of trade in which they are distributed or the class of purchasers to whom they are marketed. Because there are no recited trade channel restrictions and further because applicant's goods encompass those of registrant, the goods are legally identical, registrant's goods are presumed to move in all normal channels of trade and be available to all classes of

⁵ Microsoft Encarta (2007).

⁶ Bartleby.com

potential consumers, including consumers of applicant's goods. See *In re Elbaum*, supra. Accordingly, this du Pont factor further favors a finding of likelihood of confusion.

The Marks

In its briefing of the issue under appeal, applicant focuses its arguments exclusively on various aspects of the similarity or dissimilarity between its mark and the mark in the cited registration. We turn then to the first du Pont factor, i.e., whether applicant's mark and registrant's mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We note initially that the test under the first du Pont factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). We

further note that under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. See *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980).

In this case, applicant's mark, GOURMET CHOICE in standard characters, is comprised in its entirety of wording that is nearly identical to the wording THE GOURMET'S CHOICE in the registered mark shown below.



Registrant's mark contains the additional wording SALMONES ANTARTICA LTDA as well as the design of two fish and an oval carrier. However, we find that THE GOURMET'S CHOICE is the dominant element of the cited mark, and accordingly it is entitled to more weight in our analysis. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has

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been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In registrant's mark, the wording THE GOURMET'S CHOICE appears in prominently sized letters at the top of registrant's mark. Moreover, the significance of THE GOURMET'S CHOICE in registrant's mark is reinforced by its location as the first words in the mark. See *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered"). See also *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word). Further, we agree with applicant that the wording SALMONES ANTARTICA LTDA, translated into English as "Antarctic salmons ltd," appears to "function as a brand name/company name placed on Registrant's product" (brief, p. 2). While such a house mark or brand name possesses source-identifying significance, the addition of a house mark to registrant's mark is normally insufficient to distinguish the marks as a whole and avoid confusion. See

In re Hill-Behan Lumber Co., 201 USPQ 246 (TTAB 1978). Further, the oval carrier design has very little source-identifying significance and the fish design, while visually prominent, is not highly stylized and would likely be perceived as identifying the goods. If a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. See In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). For these reasons, we consider THE GOURMET'S CHOICE to be the dominant feature of the registered mark.

Applicant's mark GOURMET CHOICE is nearly identical to the wording THE GOURMET'S CHOICE in registrant's mark in sound and in appearance. As a result we find that, viewing the marks as a whole, the similarities between the marks in appearance and sound outweigh the dissimilarities. Further, both marks suggest that the goods identified thereby are the choice of discriminating purchasers, or gourmets. Thus, we find that the marks are highly similar in terms of overall connotation and convey highly similar commercial impressions. With regard to the strength of these terms, we note that while applicant has disclaimed GOURMET, registrant has not disclaimed the nearly identical term GOURMET'S. Neither has disclaimed CHOICE. As a

result, we do not find that the terms comprising the nearly identical portion of registrant's mark with that of applicant are weak or otherwise entitled only to a narrow scope of protection.

In this case, we find that consumers who are familiar with registrant's mark, used in connection with its goods, and then see the mark GOURMET CHOICE in standard character form used in connection with applicant's goods, are likely to view the marks as variations of each other, but indicating a single source. Thus, despite the fact that registrant's mark includes additional wording and design elements, the marks, taken as a whole, are highly similar in appearance, sound, connotation and commercial impression. Accordingly, this du Pont factor also favors a finding of likelihood of confusion.

Summary

In light of the foregoing, we conclude that consumers familiar with registrant's goods sold under its above-referenced mark would be likely to believe, upon encountering applicant's goods rendered under its mark that the goods originated with or are associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that

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doubt is required to be resolved in favor of the prior registrant. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal of registration is affirmed.