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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sunland, Inc.

Serial Nos. 77310231 and 77307289

Samantha A. Updegraff of Peacock Myers, P.C. for Sunland, Inc.

Barbara Brown, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

Before Rogers, Walsh and Taylor, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

In an order dated March 30, 2009, the Board consolidated the above-referenced appeals because they involved the same applicant, the same mark and the same issue. Accordingly, we will decide both appeals in this opinion.

In Application Serial No. 77310231, filed on October 22, 2007, Sunland, Inc. (applicant) applied to register the mark SUNLAND in standard characters on the Principal

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Register for goods now identified as "processed nuts and nut butters" in International Class 29 and "raw nuts" in International Class 31. Applicant claims both first use of the mark anywhere and first use of the mark in commerce on November 1, 1988 as to both classes.

In Application Serial No. 77307289, filed on October 18, 2007, applicant also applied to register the mark SUNLAND in standard characters on the Principal Register for goods now identified as "peanut butter" in International Class 29 and "raw peanuts" in International Class 31. Applicant also claims both first use of the mark anywhere and first use of the mark in commerce on November 1, 1988 as to both classes in this application.

In both applications, the Examining Attorney has finally refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion between applicant's SUNLAND mark and the mark in Registration No. 1109554, SUN-LAND in typed form, owned by Sun-Maid Growers of California (Sun-Maid), for "raisins, dried fruits, preserved fruits" in International Class 29. The registration, which issued on December 19, 1978, has been renewed twice and is active. The registration claims first use of the mark anywhere and first use of the mark in commerce since July 27, 1925.

Applicant has appealed the refusals in both applications. Applicant and the Examining Attorney have filed briefs.¹

We affirm the refusals in both applications.

Before proceeding to the merits, we will address the Examining Attorney's objection to certain evidence applicant submitted for the first time with its appeal brief. The Examining Attorney objects on the grounds that applicant's submissions are untimely. Specifically, Applicant submitted (1) copies of pages from its own website showing how it uses the SUNLAND mark, (2) what applicant asserts to be copies of the Sun-Maid packaging to show how the registrant uses its SUN-LAND mark, and (3) a copy of the cited registration from the USPTO TESS data base to show that "roaster nuts" and other goods had been deleted from the registration since the cited registration issued.

The USPTO records regarding the cited registration which the Examining Attorney provided to applicant when the Examining Attorney issued the refusals in these applications also included the same references to the deleted goods as the TESS record. Thus, the TESS records

¹ Applicant filed separate brief for each of the appeals. The briefs are essentially identical, except for the references to the differing goods identified in each of the applications.

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add no new evidence. It appears that these items of goods were deleted at the time registrant filed an affidavit of use and/or renewal under Trademark Act Sections 8 and 9, 15 U.S.C. § 1058 and 1059.

The Examining Attorney's objection is well taken. The record must be complete prior to appeal, subject to certain exceptions not relevant here. See 37 C.F.R. § 2.142(d).

Applicant's submissions here are manifestly late.

Therefore, we sustain the objection and exclude this evidence from consideration. Furthermore, we will address more fundamental problems with the arguments based on this evidence below.

Turning to the merits, Section 2(d) of the Trademark Act precludes registration of an applicant's mark "... which so resembles a mark registered in the Patent and Trademark Office... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion..." 15 U.S.C. § 1052(d). The opinion in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors to consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of applicant and registrant. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29

(CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

First, we consider the marks. In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Also, "... it is well established that the test to be applied in determining likelihood of confusion is not whether marks are distinguishable on the basis of a side-by-side comparison but rather whether they so resemble one another as to be likely to cause confusion, and this necessarily requires us to consider the fallibility of memory over a period of time. That is to say, the emphasis must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks." *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975) (internal citations omitted).

The Examining Attorney argues that the marks, SUN-LAND and SUNLAND, are virtually identical.

Applicant argues (1) that, when we view the marks as used on the particular packaging of applicant and Sun-Maid, there is no likelihood of confusion, and (2) that the marks are pronounced "very differently" because of the hyphen in the registered mark. Applicant's Brief at 11.

As we noted above, applicant submitted an example of what applicant asserts is packaging used by registrant, Sun-Maid, to support its argument that the marks can be distinguished because Sun-Maid uses the SUN-LAND mark in an inconspicuous manner along with more prominently displayed word and design marks. We excluded this evidence as untimely. Even if applicant had submitted this evidence prior to appeal, we would still not find it appropriate for consideration.

In an ex parte proceeding such as this, we cannot consider extrinsic evidence offered by applicant regarding the registrant's actual use of its mark offered to show that the registrant's rights in the mark should be restricted. *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986).

Furthermore, the particular arguments applicant presents based on this evidence are likewise inappropriate in this ex parte proceeding. Applicant attempts, through this evidence, to show that the registrant uses its SUN-

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LAND mark in an inconspicuous manner on its packaging and that there are more prominent word marks, as well as design marks, which would enable a potential purchaser to distinguish registrant's goods from those of applicant. Applicant uses its own packaging also in making this argument.

The Examining Attorney correctly notes that the cited, registered mark is SUN-LAND alone in typed form. In determining likelihood of confusion here, we must and do accord the mark in the registration the full scope of protection Trademark Act Section 7(b), 15 U.S.C. § 1057(b), affords. Among other things, Section 7(b) requires that we recognize the registration as prima facie evidence of the "... validity of the registered mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate." Accordingly, in applying Section 7(b) in this case, we reject applicant's argument that the registrant's rights in the registered mark are somehow restricted based on applicant's assertions as to how the registrant uses the registered mark. There are no

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restrictions or elements, other than SUN-LAND, in the cited registration.

In this regard we also note that in asserting these arguments, and elsewhere, applicant relies nearly exclusively on infringement cases from the federal courts, for example, *Sun-Maid Raisin Growers of California v. Sunaid Food Products, Inc.*, 356 F.2d 467, 149 USPQ 238 (5th Cir. 1966). The analysis required in an infringement case differs significantly from the analysis in this registration case. *In re Bercut-Vandervoort & Co.*, 229 USPQ at 765. Thus, applicant's arguments based on these cases are not persuasive.

Furthermore, a number of the cases applicant cites predate the effective date of the Trademark Act of 1946 (the Lanham Act) which now governs our proceedings, for example, *Mutual Orange Distributors v. Silver Seal Dairy Products Co.*, 22 USPQ 255 (Comm'r Pat. 1934). These cases do not reflect current law. The Examining Attorney provided extensive citations to relevant, current law in the Office actions in these applications, but applicant has not addressed those authorities.

Accordingly, we reject applicant's arguments that the marks can be distinguished because of the particular way in which registrant and applicant use their respective marks.

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See In re General Electric Co., 180 USPQ 542, 544 (TTAB 1973).

As to applicant's unsupported assertion that SUNLAND and SUN-LAND are distinguishable because they would be pronounced differently, we first note the axiom that there is no correct pronunciation of a trademark. *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006). Furthermore, applicant offers no support for its assertion that the pronunciations would differ. Therefore, we reject applicant's argument based on the asserted differences in the pronunciations of the marks. More generally, the presence or absence of a hyphen is hardly sufficient under these circumstances to distinguish the marks. *Id.* The presence of the hyphen in the cited mark is the only difference between the marks.

In sum, we conclude that the marks are not only similar in appearance, sound, connotation and commercial impression, but virtually identical.

Next we consider the respective goods. In general, the goods of applicant and the registrant need not be identical to find a likelihood of confusion under Trademark Act Section 2(d). They need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the

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goods originate from or are associated with the same source. See *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Also, in a case such as this, where the marks are virtually identical, the relationship between the respective goods need not be as close to find a likelihood of confusion as might apply where there are significant differences between the respective marks. *Ancor, Inc. v. Ancor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981) ("... where both parties are using the identical designation ... the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar.").

Furthermore, in comparing the goods we must consider the goods as identified in the application and cited registration. See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

Applicant identifies its goods as processed nuts, nut butters, raw nuts, peanut butter and raw peanuts. The goods identified in the cited registration are raisins, dried fruits, preserved fruits.

Applicant argues:

Sunland's peanut butter and raw peanuts [and processed nuts, nut butters and raw nuts] are not related to Registrant's raisins, dried fruits and preserved fruits. Simply because raw peanuts [and raw nuts] and raisins are sometimes sold together in snack mixes does not mean the goods are closely related. There are many unrelated foods that are sold together but that does not change the fact that the foods are unrelated. ... Further, average shoppers would not confuse a brand of pretzels with a brand of corn cereal because an unrelated third company sells a mix containing pretzels and corn cereal. An average shopper would readily recognize that a company selling raisins under one brand is not the same company selling peanut butter and raw peanuts [and processed nuts, nut butters and raw nuts] sold under a separate brand.

Applicant's Brief at 6-7.

Applicant also argues that the respective goods of applicant and registrant "do not possess the same descriptive properties," such as, nutritional value. *Id.* at 7. Applicant argues further that the same companies do not sell both the type of goods identified in the cited registration and the type of goods applicant identifies in its applications. Applicant points to Dole and Sun-Maid as examples of such companies, stating, "The fruit based

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companies focus only on fruit based products and do not expand into peanut butter and raw peanuts [and processed nuts, nut butters and raw nuts]." *Id.*

In its Reply Brief applicant continues with this same line of argument, stating, "A purchaser of raisins and dried fruits at a store knows fruits from nuts." Reply Brief at 4.

Applicant also argues that the registrant "expressly abandoned" its registration for "roasted nuts." To support this claim applicant submitted a copy of the cited registration from the USPTO TESS data base to show that the cited registration included "roasted nuts" and other items when it issued and that those goods have been deleted. As we noted, the record the Examining Attorney provided also reflected these deletions. Applicant argues that this evidence also shows that the goods of applicant and registrant are not related. Applicant's Brief at 10.

The Examining Attorney argues that the goods identified in the applications and the cited registration are related. He states, "The goods of the parties are closely related because they are both natural snack products commonly sold by the same companies, they travel in the same channels of trade and are complimentary (sic)

goods commonly packaged and/or sold together." Examining Attorney's Brief at 6.

To support his position the Examining Attorney has provided numerous third-party, use-based registrations for marks for both the type of goods identified in the applications and the type of goods identified in the cited registration, for example:

Registration No. 2996302 for the mark KLEIN'S DELIGHT for "processed nuts, namely almonds, cashews, peanuts, sunflower seeds, pecans, filberts, macadamia nuts, brazil nuts, pepitas, pignolias, pistachios, pumpkin seeds, walnuts, poppy seeds, sesame seeds, shredded coconut and processed fruit and nut mix, dried fruits, namely, apricots, pineapple, ambrosia, papaya, cantaloupe, raisins, cranberries, bananas, prunes, dates, apples, mangos, peaches, pears, cherries, blueberries, figs and citrons..." and "fresh, raw and unprocessed nuts, namely almonds, cashews, peanuts, sunflower seeds, pecans, filberts, macadamia nuts, brazil nuts, pepitas, pignolias, pistachios, pumpkin seeds, walnuts, poppy seeds, sesame seeds, unprocessed fruit and nut mix";

Registration No. 3106169 for the mark REVERENCE FOR THE LAND for "nut butters, fruit butters, peanut butter, tahini, frozen vegetables, frozen fruit, French fried potatoes, raisins, dried fruit, dried vegetables, processed edible seeds, nuts, candied nuts, snack foods made of vegetables, snack foods made of fruit, snack mix consisting primarily of processed fruits, processed nuts and/or raisins, tomato paste, tomato puree, peeled tomatoes, stewed tomatoes, diced tomatoes, fruit sauce, butter, milk";

Registration No. 3176367 for the mark PETERSON'S for "salad topping consisting primarily of roasted soybeans with spices, croutons, dried

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vegetables, nuts, bacon bits, dried noodles or combinations thereof; flavored, roasted snacking peanuts; natural snacks, namely, roasted cashew snacks, snack mixes consisting primarily of roasted nuts, dried fruits, raisins, or combinations thereof and also consisting of granola, spices, sesame sticks, candy, toasted corn kernels, edible seeds or combinations thereof; shelled, roasted or otherwise processed packaged nuts; snack mixes consisting primarily of processed fruits, processed nuts and/or raisins" and "mixes for making bakery goods packaged together in pre-measured proportions, and bakery products; candies and snack mixes consisting primarily of crackers, pretzels, candied nuts and/or popped corn; granola based snack food; corn and wheat based snack foods" and "unprocessed or raw packaged nuts";

Registration No. 3148741 for the mark EARTH FARE for "processed beans; olive oil for food; peanut butter, vegetable-based snack foods; eggs; processed nuts, roasted nuts and processed almonds; raisins; and snack mix consisting primarily of processed fruits, processed nuts and/or raisins" and "fresh nuts, raw nuts and unprocessed nuts";

Registration No. 3415917 for the mark NY SNACKS and Design for "salty snacks, namely, potato chips, barbeque flavored potato chips, sea salt and vinegar flavored potato chips, potato sticks; banana chips; sweet and sour processed onion rings; preserved meats, namely, fried pork rinds, barbeque flavored pork rinds, fried pork skins, beef jerky, beef sausages in stick form, beef pepperoni and cheese sticks; pizza flavored potato sticks, pizza flavored potato chips, pizza flavored cheese, pizza flavored beef jerky; processed nuts, namely, cashews, peanuts, and pistachios; processed edible seeds, namely, sunflower seeds, party/bar mix consisting primarily of processed fruits, processed nuts and/or raisins"; and

Registration No. 3258800 for the mark TORN & GLASSER for "banana chips; blanched nuts; candied

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fruit; candied nuts; compotes; dehydrated fruit snacks; desiccated coconut; dried beans; dried figs; dried fruit mixes; dried fruits; dry or aromatized fruit; flaked coconut; fruit chips; fruit pectin; fruit-based snack food; fruits, namely, processed, dried and preserved; glazed fruits; instant or pre-cooked soup; lentils; nut butters; nut butters, namely peanut and honey roasted peanut; nut meats; nut topping; peanut butter; preparations for making soups; prepared coconut; prepared pistachio; prepared walnuts; processed almonds; processed apples; processed apricots; processed beans; processed blueberries; processed cherries; processed coconut; processed dates; processed edible seeds; processed fruits; processed lemons; processed mangos; processed nuts; processed oranges; processed papayas; processed peaches; processed peels; processed pumpkin seeds; processed soy beans; raisins; roasted nuts; shelled nuts; snack mix consisting primarily of processed fruits, processed nuts and/or raisins; soup mixes."

Attachments to Office Action of May 28, 2008. These examples are representative of the numerous other similar records the Examining Attorney provided.

The Examining Attorney also provided evidence from Internet websites of specialty retailers, including fruit and nut companies, which offer both the type of goods identified in the applications and the type of goods identified in the cited registration under the same mark, for example, preparedpantry.com, nutsonline.com, harryanddavid.com, foodler.com, and futtersnutbutters.com. Attachments to Office Action of December 31, 2008.

Applicant has not addressed the Examining Attorney's evidence in either of its briefs. The Examining Attorney's evidence belies applicant's unsupported assertions that fruits and nuts are unrelated products. The Internet evidence shows that both types of goods are sold by the same party under the same mark and that they are complementary.

The third-party registrations provide further evidence that the goods in the applications and the goods in the cited registration are the types of goods which may emanate from the same source. *In re TSI Brands Inc.*, 67 USPQ2d 1657, 1659 (TTAB 2002); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The proper inquiry is not whether the goods could be confused, but rather whether the *source* of the goods could be confused. *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 186 USPQ 476, 480 (CCPA 1975); *In re Rexel, Inc.*, 223 USPQ 830, 831 (TTAB 1984). Much of applicant's argument overlooks this fundamental point.

Furthermore, the fact that the cited registration may have included "roasted nuts," which have been deleted, in no way supports applicant's argument that the goods are not related. If anything, it would support the contrary position, that is, that historically companies have sold

both types of goods under the same mark. For the record, we reject applicant's implication that this deletion from the registration, by itself, would establish that Sun-Maid had expressly abandoned any rights.

Furthermore, the point is not whether Sun-Maid now offers both types of goods under the SUN-LAND mark or any other mark, but rather whether the circumstances surrounding the marketing of these types of products in general would result in relevant consumers mistakenly believing that the respective goods originate from or are associated with the same source. *See In re International Telephone & Telegraph Corp.*, 197 USPQ at 911.

Based on the evidence of record, we have no hesitation in concluding that the goods identified in the applications and the cited registration are closely related. We find all of applicant's arguments to the contrary unpersuasive. *See also In re Diamond Walnut Growers, Inc., and Sunsweet Growers Inc.*, 204 USPQ 507 (TTAB 1979).

Also, in its reply brief applicant argues that there is no dilution as between its SUNLAND mark and the cited, registered SUN-LAND mark. The Examining Attorney has not refused registration based on dilution. In fact, Trademark Act Section 2(f), 15 U.S.C. § 1052(f), precludes examining attorneys from issuing a refusal based on dilution in the

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ex parte examination of applications. Accordingly, we fail to see the relevance of applicant's arguments regarding dilution and we reject them.

Finally, after considering all evidence and arguments bearing on the *du Pont* factors, including any we have not specifically discussed here, we conclude that there is a likelihood of confusion between applicant's SUNLAND mark when used in connection with processed nuts, nut butters, raw nuts, peanut butter and raw peanuts and the registered SUN-LAND mark when used in connection with raisins, dried fruits and preserved fruits.

Decision: We affirm the refusals to register applicant's mark under Trademark Act Section 2(d) in both applications.