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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Viterra Inc.

Serial No. 77608885

Scott A. Duvall of Middleton Reutlinger for Viterra Inc.

James T. Griffin, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Quinn, Bucher and Zervas, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Viterra Inc. filed, on November 6, 2008, an intent-to-use application to register the mark XCEED (in standard characters) for "agricultural seed" (in International Class 31).

The trademark examining attorney refused registration under Section 2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark shown below



for "agricultural seeds" (in International Class 31)¹ as to be likely to cause confusion.

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

Applicant asserts that the "key issue" presented in this case is "whether an applicant's mark in Standard Characters format must be construed broadly to include the depiction of a registered mark that appears in special form, having both wording and a distinctive design, and multiple color claims." (Reply Brief, p. 3). Applicant argues that the registered mark, with its dominant design feature and color claims, must be narrowly construed in comparing it with applicant's mark. Thus, applicant contends, "the scope of registration rights to be afforded to the Cited Registration for purposes of likelihood of confusion must also be exceedingly narrow." (Brief, p. 5). In comparing the marks, applicant asserts that they are

¹ Registration No. 3339424, issued November 20, 2007. The word "seed" is disclaimed. The registration includes the following statements: "The mark consists of the stylized letter X and the surrounding dots appear in red and the term '-SEED' is black and outlined in gray. The colors black, red and gray are claimed as a feature of the mark."

visually different, and that they are not phonetic equivalents. Applicant also argues that the marks have different connotations and commercial impressions. In support of its position, applicant submitted a dictionary listing of the word "exceed"; and listings of the letter "X" in a dictionary and in Wikipedia.

The examining attorney maintains that the marks are phonetic equivalents; that the literal elements of the marks are very similar, differing by only one letter and a hyphen; and because applicant seeks to register its mark in standard characters, applicant would be free to adopt any stylization it chooses for its mark, including stylization similar to that employed by registrant in the cited mark.

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 Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn to consider the goods. It is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods identified in the cited registration. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). Where the goods in the application at issue and/or in the cited registration are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefore, and that they would be purchased by all potential buyers thereof. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

The goods in this appeal are identical. In view of the identity between applicant's and registrant's "agricultural seed(s)," we presume that they travel in the same trade channels (e.g., agricultural supply outlets, nurseries and the like) and are bought by the same classes

of purchasers (e.g., farmers of both big and small farms, and home gardeners).

The identity between the goods, and the overlap in purchasers and trade channels weigh heavily in favor of a finding of likelihood of confusion.

We next turn to consider the *du Pont* factor of the similarity between the marks. Applicant urges that this appeal presents the Board "with a valuable opportunity to clarify how an applied-for mark must be compared to a cited registration in an ex parte prosecution pursuant to Section 2(d), where the applicant's mark is presented in Standard Characters and the basis for refusal is a registration the mark of which is presented in special form." (Brief, p. 2).

Contrary to the gist of applicant's remarks, the present proceeding hardly breaks new ground; in determining the likelihood of confusion in this appeal, we are required to compare applicant's mark in standard characters to registrant's cited mark in special form. TMEP §1207.01(c)(iii) (7th ed. 2010), captioned "Comparison of Standard Character Marks and Special Form Marks," reads, in pertinent part, as follows: "If a mark (*in either an application or registration*) is presented in standard characters, the owner of the mark is not limited to any

particular depiction. The rights associated with a mark in standard characters reside in the wording (or other literal element, e.g., letters, numerals, punctuation) and not in any particular display." (emphasis added). Trademark Rule 2.52(a) provides that an applicant who submits a standard character drawing, as in this case, must also submit a statement that "the mark is in standard characters and no claim is made as to any particular font style, size, or color." See TMEP §807.03(a) (7th ed. 2010).

Prior to 2003, if the application was for the registration only of a word not depicted in "special form," the drawing could consist of the mark typed in capital letters. Thus, prior to the rules changes in 2003, when a drawing of the applicant's mark was typed in capital letters, this meant that "the application is not limited to the mark depicted in any special form or lettering." Trademark Rule 2.52(a)(1). In this connection, the Federal Circuit observed that "[r]egistrations with typed drawings are not limited to any particular rendition of the mark, and, in particular, are not limited to the mark as it is used in commerce." *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

The Trademark Rules were amended in 2003 to replace the terminology "typed" drawings with "standard character"

drawings, and the statement regarding no limitations with respect to marks shown in typed drawings was deleted from the rule. The relevant rule was amended, however, to indicate, as set forth above, that when using a drawing showing the mark in standard characters, applicant must also submit a statement that "the mark is in standard characters and no claim is made to any particular font style, size or color." Trademark Rule 2.52(a).

After the 2003 amendments, the Board continued to cite to cases decided under the pre-2003 rules, and to state that the rule remains the same as before, namely when a mark is presented in typed or standard character form the mark must be considered as appearing in "all reasonable manners" in which applicant's mark could be depicted. *In re Cox Enterprises, Inc.*, 82 USPQ2d 1040, 1044 (TTAB 2007). For example, with respect to applicant's standard character mark in the present case, the letter "X" may be depicted in much larger print or type, followed by "ceed" in smaller print; that is, in a format that is similar to the literal X-SEED portion of the cited mark. *See, e.g., Phillips Petroleum Co. v. C.J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) ("we must not be misled by considering [applicant's] mark only in its printed or typewritten form, with all of the characters being of equal height").

Thus, when an applicant seeks registration of its word mark in standard characters, "then the Board must consider all reasonable manners in which those words could be depicted." *INB National Bank v. Metrohost, Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992). The Board has in the past stated that "[p]resentation of a mark for registration in typewritten [now "standard character"] form means that the mark may be displayed in any style of lettering, including, presumptively, the same style as that used by the owner of the cited registration." *In re Deutsche Calypsolgesellschaft MBH & Co.*, 220 USPQ 922, 923 (TTAB 1983). See also *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 93 (Fed. Cir. 1983) (if applicant uses a typed drawing it asserts rights in no particular display and cannot argue differences in display when its application is opposed).

Moreover, there are reported decisions where this Board found likelihood of confusion when a special form

mark was cited against applicant's typed or standard character mark. See *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007); and *In re Continental Graphics Corp.*, 52 USPQ2d 1374 (TTAB 1999).



v.
**ZOGGS
TOGGS**



v.
**CONTINENTAL
GRAPHICS**

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In view of the above, simply put, the Board sees no reason to "clarify" what are well established legal principles that have been consistently applied for many years, both before and after the 2003 rule changes. See J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, §19:58 (4th ed. 2010) ("[A] 'standard character' drawing registration, like a pre-2003 'typed' drawing registration, will not be limited to the exact format of the mark as it is depicted in the 'standard character' drawing.").

We thus turn to compare applicant's mark XCEED in standard characters with registrant's mark X-SEED and design in special form. We must compare the marks in their entireties as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). 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 offered under the respective marks is likely to result. Where, as in the present case,

the marks are used on identical goods, the degree of similarity between the marks that is necessary to support a finding 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).

It is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.").

Where both words and a design comprise the mark (as in registrant's mark), then the words are normally accorded greater weight because the words are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods. *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to

indicate the origin of the goods to which it is affixed"); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). See also *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Thus, although we have taken into account the design and color features of registrant's mark, we find that the dominant portion of registrant's mark is the literal portion. In this case, the literal portion of registrant's mark is X-SEED.

The literal portion of registrant's mark, X-SEED, sounds identical or, at the very least, virtually identical to applicant's mark XCEED. Although we acknowledge that there is no correct pronunciation of a trademark, it is hard to imagine that the two marks will not sound alike when spoken. Applicant painstakingly points to differences in sound based upon dictionary evidence, but we simply are not persuaded that any such difference would even be noticed by prospective purchasers when they hear the marks.

As to meaning, we recognize that applicant's mark, based on the meaning of the word "exceed," conveys the idea that its agricultural seed is superior to or surpasses the quality of the seed offered by competitors. (www.merriam-webster.com). The meaning of registrant's mark is less

clear, given the different meanings attributed to the letter "X." However, given the laudatory suggestiveness of superiority conveyed by the word "exceed," it is reasonable that purchasers will perceive registrant's mark in a similar manner, that is, purchasers may give the same meaning of superiority to registrant's mark. Thus, both marks are likely to be perceived as a play on the commonly known and understood word "exceed," conveying the same laudatory suggestion.

There is little question that the most significant difference between the marks is in appearance. However, as discussed earlier, applicant's mark, shown in standard character form, could be depicted in a variety of reasonable variations, including a large capital letter "X" followed by "ceed" in smaller letters, that is, in a manner that resembles the format of the cited mark. By saying this, we do not mean to suggest that the specific special form of registrant's mark in its entirety constitutes a "reasonable" variation of applicant's standard character mark. We acknowledge that registrant's mark is highly stylized, with colors. Nevertheless, we reiterate that a reasonable variation of applicant's standard character mark would be a capital "X" followed by the small letters "ceed" in a format that is similar to that of registrant's mark.

Because of the similarities between XCEED and X-SEED (the dominant portion of registrant's mark), the marks engender sufficiently similar overall commercial impressions when the marks are applied to identical goods.

Contrary to applicant's arguments, we fail to see how the Board's decision in *In re White Rock Distillers, Inc.*, 92 USPQ2d 1282 (TTAB 2009) (no confusion between VOLTA for energy vodka infused with caffeine and TERZA VOLTA and design for wines) compels a reversal of the refusal in this appeal. Firstly, the appeal did not involve identical goods as is the case herein. Secondly, registrant's mark included an additional word, "TERZA," which the Board found to be dominant in the cited mark, as well as a design feature. Further, although the Board ultimately reversed the refusal in that case, reference was made to TMEP §1207.01(c)(iii), with the Board indicating that "rights associated with a word mark in standard character (or typed) form reside in the wording and not in any particular display of the word." *Id.* at 1284.

In sum, the identical nature of the goods has been given heavy weight in our analysis. Due to the identity between the goods, the marks need not be as similar as in the case of goods that are not identical. Keeping this in mind, we find that the marks, when applied to identical

Ser No. 77608885

goods, are sufficiently similar that confusion is likely to occur among purchasers. We conclude that purchasers familiar with registrant's agricultural seed sold under the mark X-SEED and design would be likely to mistakenly believe, upon encountering applicant's mark XCEED for agricultural seed, that the goods originated with or are somehow associated with or sponsored by the same entity.

Decision: The refusal to register is affirmed.