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MARK: PRESIDENT



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EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 0988411

The applicant has appealed the trademark examining attorney's refusal to register the trademark **PRESIDENT** on the ground that a likelihood of confusion exists under Section 2(d) of the Trademark Act between the applicant's mark and the mark **PRESIDENT**, in Registration No. 2958848.

ISSUE

Whether **PRESIDENT** for retail store services featuring dairy products so closely resembles **PRESIDENT** for retail grocery store services as to be likely to cause a likelihood of confusion when the services are so closely related.

FACTS

The applicant applied to register the mark PRESIDENT for “retail store services featuring dairy products.” Registration was refused under Trademark Act Section 2(d), based on a likelihood of confusion between the applicant’s mark and the mark PRESIDENT, in Registration No. 2958848, as applied to “retail grocery store services.”

The refusal to register was made FINAL August 25, 2009. The applicant filed a request for reconsideration in support of registration. Applicant’s request was considered but found to be unpersuasive. The finality of the refusal issued January 27, 2009 was maintained. Applicant subsequently appealed.

ARGUMENT

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in their appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or commercially related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §§1207.01 *et seq.*

A. THE MARKS OF THE PARTIES ARE IDENTICAL

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.*, *supra*. 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); *see* TMEP §1207.01(b).

The applicant's mark is PRESIDENT and the registrant's mark is PRESIDENT. The marks of the parties are identical in sound, appearance and meaning. The wording PRESIDENT comprises the entirety of both marks; there is no additional wording or other elements to distinguish one mark from the other.

Therefore, the similarities in the elements that exist are sufficient to find a likelihood of confusion.

The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services 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.3d 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).

If the marks of the respective parties are identical, the relationship between the goods and/or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Amtcor, Inc. v. Amtcor Indus., Inc.*, 210 USPQ 70, 78 (TTAB 1981); TMEP §1207.01(a).

The Applicant does not dispute the identical nature of the marks.

B. THE SERVICES OF THE PARTIES ARE RELATED

The 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). Rather, it is sufficient that the services are related in some manner and/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 services come from a common source. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000).

The Applicant's services are "retail store services featuring dairy products." The registrant's services are "retail grocery store services." The services of the parties are related, because grocery stores typically offer a wide range of foods including dairy products. In the FINAL Office action, the examining attorney provided evidence, referenced and incorporated herein, that the relevant meaning of 'grocer' is "a dealer in staple foodstuffs, meat, produce, and dairy products, and usually household supplies."¹ Thus, by definition, the Registrant's grocery store services encompass the Applicant's retail store services featuring dairy products.

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, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same

¹ See evidence attached to the August 25, 2009 FINAL Office action.

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 examining attorney makes reference to and incorporates herein the third-party registrations and screenshots from websites attached to the FINAL Office action dated August 25, 2009.² That evidence demonstrates retail grocery store services and retail services featuring dairy products commonly emanate from the same source. The conditions surrounding the marketing of the services may be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the services come from a common source.

The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); *see* TMEP §1207.01(a)(iii).

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); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1637-38 (TTAB 2009); TMEP §1207.01(a)(iii).

² *Id.*

In this case, the registrant's goods and/or services are identified broadly. Therefore, it is presumed that the registration encompasses all goods and/or services of the type described, including those in applicant's more specific identification, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(a)(iii).

Here, the Applicant specifies the type of grocery products featured by its retail store services as being dairy products. The Registrant provides a broad identification of its retail store services as being grocery store services. In the FINAL refusal issued August 28, 2009, the examining attorney provided evidence in the form of screenshots from retail grocery store websites that cheese and other dairy products comprise major departments within the grocery stores. Accordingly, it is presumed the Registrant's retail grocery store services encompass dairy products. Also provided was evidence that the Applicant's cheese products are commonly found in general grocery stores and are even advertised as being among the items sold there³ All prior evidence is included by reference herein.

That the Applicant's retail store services are narrowly defined to dairy products while the Registrant's retail grocery store services are more general does not obviate the likelihood of confusion.

The fact that the services of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular services, but

³ *Id.*

likelihood of confusion as to the source of those services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); TMEP §1207.01.

The real question is whether the customers of each party's services will be confused as to the source of those services. In this instance, the consumers of the parties' closely related services may be confused because the same single word comprises the entirety of both parties' marks. If the average consumer believes that the services of PRESIDENT grocery stores and PRESIDENT dairy stores emanate from the same source, then a likelihood of confusion has occurred.

Because of the similarities between the marks and the services of the parties, a likelihood of confusion is created.

C. DISTINCTIVENESS FOR DAIRY PRODUCTS DOES NOT NECESSARILY TRANSFER TO RETAIL STORE SERVICES FOR THOSE GOODS

It is the Applicant's position, based upon its prior registrations, that its mark has acquired distinctiveness, obviating any likelihood of confusion. Respectfully, the examining attorney disagrees with this conclusion.

Although the mark may have acquired distinctiveness with regard to cheese and other dairy products, there is no evidence the mark has acquired distinctiveness with regard to retail store services, even store services featuring the same goods.

The Applicant argues the proposed mark has acquired "distinctiveness" and "secondary" meaning based upon its two prior registration for the same mark used in connection with

cheese and other dairy products. The Applicant believes consumers will associate the mark PRESIDENT with cheese and other dairy products based upon the two prior registrations. In support, applicant cites a decision in which the Board reversed a Section 2(d) refusal because it determined the minor difference in the marks and identifications of services, “mail order and catalog showroom services” versus “retail jewelry store services” permitted inference of secondary meaning to arise from prior registration. *In re Best Products, Inc.*, 231 U.S.P.Q. 988, 989 no. 6 (T.T.A.B. 1986). The instant matter is distinguished from *In re Best* because the prior registrations are for cheese and other dairy products while the instant application is for retail store services featuring those goods. Notably, the Board made clear it decided confusion was not likely based in part on “the fact that one mark is for services whereas the other is for goods lead us to conclude that the marks’ contemporaneous use in commerce is not likely to result in confusion.” *See id.* In the instant matter, however, the proposed mark and the cited registered mark are both for use in connection with retail store services.

In the case of applicant’s PRESIDENT marks, the underlying registrations are for goods, specifically cheese and other dairy products, while the instant application is for services, specifically retail store services. The Applicant furnished no evidence that the Board in *Best* would still conclude the marks’ contemporaneous use in commerce would not likely result in confusion if both marks were used for retail store services. Nor does the Applicant provide support for its contention that consumers would assume cheese and other dairy products bearing the mark PRESIDENT have the same source as retail store services bearing that mark and featuring dairy products, but that consumers would not reach the same conclusion for retail grocery store services bearing that mark that also feature dairy products.

Moreover, the existence of a registration for related goods is not necessarily sufficient in all cases

to justify the grant of the new registration. VANDENBURGH, TRADEMARK LAW AND PROCEDURE, 127, footnote 35.1 (2d ed., 1968 & Supp., 1979). *In re Loew's Theatres, Inc.*, 1984 TTAB LEXIS 53, 223 U.S.P.Q. (BNA) 513 (Trademark Trial & App. Bd. Aug. 31, 1984).

Yet, without providing any support for its argument, the Applicant argues the average consumer will assume retail stores featuring dairy products share a common source with actual dairy products, rather than assuming retail stores featuring dairy products share a common source with retail grocery stores.

Respectfully, the examining attorney disagrees.

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).

Because the marks are identical and the services closely related, a likelihood of confusion is created.

CONCLUSION

For the foregoing reasons, the refusal to register the mark under Section 2(d) should be affirmed.

Respectfully submitted,

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