

**This Opinion is Not a  
Precedent of the TTAB**

Mailed:  
September 17, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Special Fruit NV*

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Serial No. 79112203

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Alejandro J. Fernandez of Feldman Gale, P.A. for Special Fruit NV.<sup>1</sup>

Inga Ervin, Trademark Examining Attorney, Law Office 111,  
Robert L. Lorenzo, Managing Attorney.

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Before Seeherman, Taylor and Shaw,  
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Special Fruit NV has applied to register BERRY FRESH and design, as shown below, on the Principal Register for “fresh fruits and vegetables” in Class 31.<sup>2</sup> The words BERRY FRESH have been disclaimed. The mark is described as consisting “of the wording BERRY FRESH written in red. There are three red

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<sup>1</sup> A different attorney and law firm represented Applicant during the prosecution of the application.

<sup>2</sup> Application Serial No. 79112203, filed January 11, 2012, requesting an extension of protection of International Registration No. 1102048 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141(f).

berries above the F in FRESH. The wording is on a black oval shaped background. The wording and the cherries are surrounded by a white oval, which is surrounded by a thin black border.” The colors red, black and white are claimed as a feature of the mark.



Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that Applicant’s mark so resembles the following marks, all owned by the same entity, and all registered on the Supplemental Register, that, if used on Applicant’s identified goods, it is likely to cause confusion or mistake or to deceive:

BERRY FRESH in standard characters, with BERRY disclaimed, for “independent sales representatives in the field of assorted fresh berries specifically, fresh blueberries, blackberries, raspberries and strawberries” in Class 35<sup>3</sup>;

BERRY FRESH PRODUCE in standard characters, with BERRY and PRODUCE disclaimed, for “fresh fruits; fruits, namely, assorted fresh berries specifically, fresh blueberries, blackberries, raspberries and strawberries<sup>4</sup>; and

Berry Fresh, in standard characters, with BERRY disclaimed, for “fresh fruits; fruits, namely, assorted fresh berries, specifically, fresh blueberries, blackberries, raspberries and strawberries.<sup>5</sup>

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<sup>3</sup> Registration No. 3548546, issued December 16, 2008; Section 8 affidavit accepted.

<sup>4</sup> Registration No. 3624925, issued May 19, 2009 Section 8 affidavit accepted.

<sup>5</sup> Registration No. 4148088, issued May 22, 2012.

After the Examining Attorney made the refusal final, Applicant filed a notice of appeal and a request for reconsideration, which was denied.<sup>6</sup>

Both Applicant and the Examining Attorney have filed briefs.

We affirm the refusal of registration in part.

As a preliminary matter, we note that Applicant has referenced in its brief the specimens in the files of the cited registrations, and has even put a depiction of one of those specimens in its brief. The file of a registration cited against an application is not automatically of record. Accordingly, we have given Applicant's argument regarding the specimens no consideration, but add that, even if they were of record, it would not affect our decision herein.

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).

At the outset, we address the fact that the cited registrations all issued on the Supplemental Register. There is no question that marks registered on the Supplemental Register may serve as a basis for refusal under Section 2(d) of the

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<sup>6</sup> In its recital of the history of the examination in its appeal brief, Applicant made the statement that a final Office Action maintained the refusal based on the likelihood of confusion with Registration Nos. 3548546 and 3624925, "as well as the newly cited mark BERRY FRESH, Reg. No. 4,148,088..." 15 TTABVue 8. To clarify, at the time that the two earlier registrations were cited by the Examining Attorney, Registration No. 4148088 had not issued. After the mark was registered, the Examining Attorney issued an Office Action on December 14, 2012 also citing this registration, and on July 8, 2013, after considering Applicant's June 14, 2013 Response, the Examining Attorney issued the final Office Action. Thus, the final refusal, as well as the appeal itself, was procedurally proper.

Act. See *In re The Clorox Company*, 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978). However, registration on the Supplemental Register may be considered to establish prima facie that, at least at the time of registration, the registered mark was not distinctive. See *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975). See also, *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686, n.9 (Fed. Cir. 2010) (“A descriptive term lacking secondary meaning may not appear on the Principal Register, but may appear on the Supplemental Register.”) In the present case, there is no dispute that the cited marks were registered on the Supplemental Register because they possessed a merely descriptive significance.<sup>7</sup> Accordingly, the cited marks may be considered weak marks that are entitled to a narrow scope of protection. As the Court said in *Sure-Fit Products Company v. Saltzson Drapery Company*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958), a statement that was recently reiterated by this Board in *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458 (TTAB 2014):

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

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<sup>7</sup> We acknowledge that, because under Section 23 the standard for registrability on the Supplemental Register is that the mark be “capable of distinguishing applicant’s goods or services and not registrable on the principal register,” not all marks on this Register may be considered merely descriptive. See, for example, *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1533 (TTAB 1994), in which the cited mark was registered on the Supplemental Register not because it was descriptive, but because the Examining Attorney was of the opinion that it would be perceived as ornamentation on the then-applicant’s t-shirts, rather than as a trademark.

Applying this general principle to the present case, we find that the services in cited Registration No. 3548546, “independent sales representatives in the field of assorted fresh berries specifically, fresh blueberries, blackberries, raspberries and strawberries,” are sufficiently different from the “fresh fruits and vegetables” identified in Applicant’s application to avoid a finding of likelihood of confusion. The “independent sales representatives” services are apparently offered to retailers, who will be sophisticated and discriminating purchasers. We reverse the refusal of registration based on this registration.

However, we reach a different conclusion when we consider the issue of likelihood of confusion based on the remaining two cited registrations. First, the goods are, in part, legally identical. The identifications in both of these registrations are “fresh fruits; fruits, namely, assorted fresh berries specifically, fresh blueberries, blackberries, raspberries and strawberries.” Applicant’s identification is for “fresh fruits and vegetables.” The “fresh fruits” in Applicant’s identification is identical to the “fresh fruits” in the cited registrations, and encompasses the fresh berries identified in those registrations. Because the goods are legally identical, the channels of trade must be deemed identical as well. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). These *du Pont* factors favor a finding of likelihood of confusion.

We turn next to a consideration of the marks, keeping in mind that, when the goods at issue are identical, the degree of similarity necessary to support a conclusion of likely confusion declines. *Viterra*, 101 USPQ2d at 1912; *Century 21*

*Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Moreover, 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 been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Both of the cited marks are registered in standard character form, and therefore their depiction is not limited to any particular font, size, style, or color. *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010). Thus, we must view these word marks as being depicted in the same font and red color as the words in Applicant's mark.

The real crux of the similarity question is the effect of the design in Applicant's mark. It has frequently been recognized that when a mark consists of words and a design, the words play a dominant role. As the Court said in *Viterra*, 101 USPQ2d at 1911:

The Board's conclusion is also in line with our decisions holding that the verbal portion of a word and design mark likely will be the dominant portion. [*CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82, 218 USPQ 198 (Fed. Cir. 1983)] (“[T]he verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.”). This makes sense given that the literal component of brand names likely will appear alone when used in text and will be spoken when requested by consumers. *See id.* at 1582 (“This is particularly true when a mark appears in textual material, such as catalog descriptions, in which it is often impossible or impractical to include the design feature of the mark” (footnote omitted)); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593 (TTAB 2001) (“In the case of marks

which consist of words and a design, the words are normally accorded greater weight because they would be used by purchasers to request the goods.”); *see also Alzheimer's Found. of Am., Inc. v. Alzheimer's Disease & Related Disorders Ass'n, Inc.*, 796 F.Supp.2d 458, 465 (SDNY 2011) (“While a composite mark (consisting of both a word element and a design element) must be considered in its entirety, trademark law recognizes that the word portion is often more likely to be impressed upon a purchaser's memory because it is the word that purchasers use to request the goods and/or services.”).

Applicant argues that in the present case its design element should be considered the dominant part of its mark, particularly in view of the descriptiveness of the word portion. We disagree. The oval design is, as Applicant itself recognizes, merely a background for the words BERRY FRESH and the berries design. The oval shape is also a common geometric figure that is frequently used as a carrier for marks and would not be accorded source-identifying significance. *See In re Anton/Bauer Inc.*, 7 USPQ2d 1380, 1381 (TTAB 1988) (“In particular, common geometric shapes such as circles, ovals, triangles, diamonds, and stars, when used as backgrounds for the display of word or letter marks, are not regarded as trademarks for the goods to which they are applied absent evidence of distinctiveness of the design alone”). The red berries are a noticeable part of the mark, but even with the limited scope of protection to which the cited registrations are entitled, the berry design is not sufficient to distinguish the marks. The berries merely are a visual representation of the word BERRY, a pictorial element that reinforces the meaning of the word, and tells consumers what the goods are.

Thus, we find that Applicant's mark and the Registrant's mark Berry Fresh are very similar in appearance, and are identical in pronunciation, connotation and

commercial impression. We also find that Applicant's mark is very similar to the cited mark BERRY FRESH PRODUCE; although this mark includes the word PRODUCE, PRODUCE is a generic word for fresh fruit, and therefore consumers will not accord this term any source-identifying significance.<sup>8</sup> As a result, the marks are very similar in appearance, pronunciation, connotation and commercial impression. The *du Pont* factor of the similarity of the marks favors a finding of likelihood of confusion.

In addition, the goods are general consumer items that are inexpensive and purchased frequently, and can be purchased on impulse and without care. This *du Pont* factor of the conditions of purchase favors a finding of likelihood of confusion.

The final factor that has been discussed is the number and nature of similar marks in use on similar goods. Applicant has submitted webpages showing four instances of use of the term "Berry Fresh," to wit, a "Berry Fresh Farms" located in Iowa that advertises one can come to the farm to pick fruit ([www.berryfreshfarms.com](http://www.berryfreshfarms.com)); Yelp reviews for a "Berry Fresh Farm" in Astoria, NY that is listed under the category "grocery" ([www.yelp.com](http://www.yelp.com)); a webpage from top10produce, copyright 2012, listing Berry Fresh Farm in Salinas Valley, CA with the "about" statement that "We grow because we like to offer the quality ... Strawberries" ([www.top10produce.com](http://www.top10produce.com)); and a listing from Business Finder for

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<sup>8</sup> We take judicial notice of the definition of "produce" as "agricultural products collectively, especially vegetables and fruits." Dictionary.com, based on the *Random House Dictionary*, © 2014. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).



“Berry Fresh Farms” in Brick, NJ, that is listed under the categories “Produce Market, Lawn and Garden Store” (<http://businessfinder.nj.com>).<sup>9</sup> We consider these webpages to have limited probative value. It appears that these four listings are for entities in different geographic areas, and we frankly can draw no conclusion as to consumer confusion or lack thereof in the present case from the fact that four different entities with the name Berry Fresh Farm/s exist in different areas of the country. In the present case, the goods are identical and, for the reasons discussed herein, the marks are very similar.

In conclusion, although the marks in the cited registrations are weak and thus entitled to a limited scope of protection, that protection extends to prevent the registration of Applicant’s very similar mark for identical goods. Accordingly, for the foregoing reasons, we affirm the refusal on the basis of Registrations Nos. 4148088 and 3624925.

**Decision:** The refusal is affirmed solely on the basis of Registration Nos. 4148088 and 3624925.

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<sup>9</sup> This evidence can be found as part of the Response filed November 21, 2012, pages 34-37. We note that Applicant also made of record numerous third-party registrations containing either the word BERRY or the word FRESH. Third-party registrations are not evidence that the marks are in use. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).