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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

<p>U.S. APPLICATION SERIAL NO. 79119647</p> <p>MARK: 2GOOD</p>	
<p>CORRESPONDENT ADDRESS: JOSEPH F SCHMIDT TAFT STETTINIUS & HOLLISTER LLP 111 E WACKER DR STE 2800 CHICAGO, IL 60601</p>	<p>GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp</p> <p>TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp</p>
<p>APPLICANT: August Storck KG</p>	
<p>CORRESPONDENT'S REFERENCE/DOCKET NO: N/A</p> <p>CORRESPONDENT E-MAIL ADDRESS: sf-ipdocket@taftlaw.com</p>	

EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1133636

Applicant has appealed the examining attorney's final refusal to register the mark 2GOOD for goods described as "chocolate candy, namely, chocolate candy bars" in Class 30 on the grounds that the applied-for mark is likely to cause confusion under Trademark Act Section 2(d) 15 U.S.C. § 1052(d), with the mark TOOGOOD & DESIGN in U.S. Reg. 4235722 for goods in Class 30 described as "Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and cereal preparations, namely, cereal based snack foods; bread, pastry and confectionery made of sugar; edible ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces; spices; ice for refreshment; sandwiches, pizzas; pancakes; cookies; cakes; rusks; chocolate; cocoa, coffee, chocolate or tea based beverages."

I. **FACTS**

The present application was filed on August 22, 2012 for the mark 2GOOD for goods described as "Confectionery, chocolate, chocolate products, pastries, ice-cream, preparations for making the aforementioned products included" in class 30.

In an office action sent on December 18, 2012 the mark was refused registration under Section 2(d) based on a likelihood of confusion with the mark in U.S. Reg. 4235722. Applicant was also advised that the mark in pending application No. 85337757 may present a bar to registration and the applicant was required to clarify its description of goods and its entity information.

Applicant responded on June 18, 2013 by amending its description of goods, clarifying its entity type and submitting arguments against the refusal to register the mark under Section 2(d) as well as the potential refusal under Section 2(d).

Based on applicant's response the requirement to clarify the entity was withdrawn in an office action sent on July 10, 2013. The requirement to clarify the description of goods was continued and an additional refusal under Section 2(d) was issued because application serial no. 85337757 matured into U.S. Registration 4313703.

Applicant responded on January 10, 2014 by amending its description of goods and arguing against the refusal to register under Section 2(d) based on a likelihood of confusion with the marks in U.S. Reg. Nos. 4235722 and 4313703.

On February 4, 2014 the application was re-assigned to the undersigned examining attorney and the refusal under Section 2(d) with respect to the mark in U.S. Reg. 4313703 was withdrawn. Applicant's amended description of goods was also accepted. The refusal under Section 2(d) based on a likelihood of confusion with the mark in U.S. Reg. 4235722 was made final.

On July 31, 2014 applicant filed a motion for reconsideration, which was denied on August 26, 2014, as well as a notice of appeal.

Applicant filed its appeal brief on October 24, 2014 which was then forwarded to the examining attorney for a response on Oct. 27, 2014.

II. ISSUE

The sole issue presented on appeal is whether the applied-for mark, when used in connection with the identified goods so resembles the mark in U.S. Registration 4235722 as to be likely to cause confusion under Section 2(d) of the Trademark Act.

III. ARGUMENT

APPLICANT'S MARK CREATES A COMMERCIAL IMPRESSION SIMILAR TO THE REGISTRANT'S MARK AND APPLICANT'S CHOCOLATE CANDY BARS ARE CLOSELY RELATED TO REGISTRANT'S GOODS IN CLASS 30 SUCH THAT CONSUMERS ARE LIKELY TO BE CONFUSED, MISTAKEN, OR DECEIVED AS TO THE SOURCE OF THE RESPECTIVE GOODS.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of

record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

A. APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO THE REGISTRANT'S MARK.

When comparing marks, the test is not whether the marks can be distinguished in 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 and/or services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

Applicant's mark is 2GOOD while the registrant's mark consists of the wording TOOGOOD enclosed within a square outline.

The literal element TOOGOOD is the most distinctive portion of applicant's mark because for a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

The dominant portion of registrant's mark is very similar to the applicant's mark based on the identical wording GOOD and the fact that the first terms in the parties' marks 2 and TOO are phonetic equivalents. The difference in appearance between the number 2 and the word TOO does not obviate the similar nature of the marks because of the phonetic similarities between the terms and the fact that both marks combine these phonetically equivalent terms with the identical wording GOOD. The phonetic and visual similarities between the marks cause them to create similar commercial impressions

and applicant's arguments that the visual differences created by the use of the number 2 versus the word TOO and the square outline were therefore not found to be persuasive.

i. Applicant's arguments regarding the appearance, connotation and sound of the marks

Applicant also argues that the differences created by the positioning of the wording TOOGOOD on a vertical axis and the different fonts in the marks are sufficient to distinguish them. These arguments were also found to be unpersuasive because although registrant has positioned its wording in a unique manner, consumers viewing the mark would still pronounce and recall the mark as TOOGOOD. In other words, the positioning of the literal element does not change the manner in which consumers would read or pronounce the mark. Applicant's argument regarding the differing fonts used in the marks fails for the same reason, i.e. the differing fonts do not so drastically alter or stylize the marks that consumers viewing them would be unable to discern that the literal elements in the marks consisted of the wording 2GOOD or TOOGOOD.

Applicant also argues that the use of the number 2 in its mark versus the word TOO in the registrant's mark changes the connotation of the marks because the number two relates to a pair and denotes some sort of numerical meaning while the word TOO when combined with the word GOOD appears to describe the goods in a laudatory fashion. Though persuasive, this argument by itself is insufficient to overcome the refusal because, as discussed above, the marks are still alike in both sound and appearance. Also, the number 2 is phonetically similar to the words to and too and the mark could therefore be perceived as 2GOOD, TOGOOD, or TOOGOOD such the connotation of the mark is not strictly to one relating to the numeral 2. When comparing the marks, "[a]ll relevant facts pertaining to

appearance, sound, and connotation must be considered before similarity as to **one or more of those factors may be sufficient** to support a finding that the marks are similar or dissimilar.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000)

Finally, applicant argues that the fact that the marks are phonetic equivalents is irrelevant and “should not be given any weight” (See applicant’s appeal brief at 8) because the goods at issue are the sort of goods that are selected from shelves at retail locations and are therefore not purchased by vocal selection. Applicant’s reliance on and interpretation of *La Maur, Inc. v. Revlon, Inc.*, 245 F. Supp. 839, 146 U.S.P.Q. 654 (D. Minn. 1965) is misplaced. Applicant cites *La Maur* as supporting the proposition that “phonetic similarity not so important where goods sold in self-service rather than by verbal request to sales clerk” (see applicant’s appeal brief at 9). However, the decision in *La Maur* actually states that “similarity in pronunciation may be particularly important when the goods are generally purchased by verbal request, rather than in a self-service store.” The decision in *La Maur* indicates that the pronunciation of a mark is even more important than usual for goods purchased by verbal request but does not in any way indicate that the pronunciation of a mark should not be a factor when the goods are purchased off of the shelf or that this factor should be of diminished importance. In fact, it is well established that similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

ii. Applicant’s arguments regarding weakness and dilution

Applicant also argues that the fact that the mark in U.S. 4313703 was not cited against registrant's mark weighs in favor of withdrawing the refusal. The mark in the '703 registration is 2GOOD2B and the addition of the term 2B changes the commercial impression of the mark so that it is not likely to be confused with the registrant's mark in the same way that it was not found to be likely to cause confusion with the applicant's mark. This argument is therefore unpersuasive.

Applicant further argues that the registrant's mark is weak and due only a narrow scope of protection due to its laudatory nature and the fact that several other registrations exist with similar wording. This line of reasoning was not found to be persuasive because the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). As discussed in more detail below, several of registrant's goods are closely related to applicant's goods and its mark is therefore deserving of the full scope of protection under Section 2(d) with respect to applicant's mark. It is for this same reason that applicant's argument regarding dilution of the phrase TOO GOOD was also found to be unpersuasive. None of the Internet evidence or third party registrations provided by applicant using the term TOO GOOD appears to relate directly to chocolate products. For example, applicant attached a webpage showing use of Richard's Too Good BBQ Sauce as well as another website providing a recipe for "Too Good Baked Chicken." (See exhibit A of applicant's appeal brief). Neither of the products at issue in applicant's evidence show use of goods that could be considered related to chocolate or chocolate based products

and therefore do not show dilution of the term TOO GOOD with respect to the goods at issue in the present case.

Applicant's third party registrations showing use of the term TOO GOOD were equally unpersuasive. For example, exhibit B of applicant's appeal brief attaches a copy of U.S. Registration 4059900 for the mark TOO GOOD TO BE FOOD for services in Class 41 related to nutrition blogs while applicant also attaches a copy of U.S. Registration 3668767 for the mark TWO TOO GOOD for retail services featuring popcorn. Although some of the registrations attached by applicant relate to goods that are more relevant to the goods in the present case, none of them are as closely related as the goods in the cited registration¹.

Based on the foregoing, applicant's numerous arguments regarding the differences in the marks' appearances or the perceived dilution or weakness of the cited mark were not found to be persuasive. The marks create similar commercial impressions based on their similar appearances and the fact that they are phonetic equivalents.

B. APPLICANT'S CHOCOLATE CANDY BARS ARE CLOSELY RELATED TO SEVERAL OF THE REISTRANT'S GOODS IN CLASS 30.

¹ See for example exhibit B of applicant's appeal brief wherein copies of U.S. Reg. Nos. 4335462 and 4313703 for the marks 2GOOD2B...GLUTEN FREE and 2GOOD2B for goods described respectively as "bakery goods and bakery desserts" and "gluten free bakery goods and gluten free desserts."

The goods of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Applicant’s goods are described as “chocolate candy, namely, chocolate candy bars” in Class 30.

The registrant’s goods in Class 30, in relevant part, are described as “coffee; bread, pastry and confectionary made of sugar; cookies; chocolate; cocoa, coffee, chocolate or tea based beverages.”

The goods of the parties are related because they are the sort of goods that are likely to be encountered by consumers in the market place in a manner suggesting they emanate from the same

source, under the same mark since parties that sell chocolate bars often sell registrant's goods referenced above.

Applicant argues that based on its amended description, the parties' goods are "sufficiently different" and "would be sold in different sections of stores." (See applicant's appeal brief at 9).

This argument was not found to be persuasive because the evidence shows that several items listed in registrant's description of goods are related to applicant's chocolate bars because they are the sort of goods that are likely to emanate from the same source, under the same mark and travel through similar trade channels because parties that offer chocolate bars are also likely to offer cocoa, chocolate, or chocolate based beverages. The office action sent on February 4, 2014 included several third party websites² that showed third parties offering chocolate, chocolate bars, cocoa, and/or chocolate based beverages. For example, the websites from grenadachocolate.com³ and cocopolo.com⁴ both offered chocolate, chocolate bars and cocoa while the website from hersheys.com⁵ offered both chocolate bars and chocolate based beverages.

² See for example the website from <http://www.lindtusa.com/shop/chocolates> offering both chocolate and chocolate bars as well as a wide variety of chocolate based products at 4-6, the website from <http://www.lilyssweets.com/chocolate-bars> offering chocolate bars and chocolate for baking at 15, the website from <http://www.vosgeschocolate.com/category/vosges-shop-by-product-categories> offering chocolate bars, chocolate based beverages, and chocolate for baking at 23-25, or the website from <http://www.godiva.com/collections> offering chocolate bars and chocolate based beverages at 26-30.

³ See outgoing office action sent on Feb. 4, 2014 at 7-10.

⁴ See outgoing office action sent on Feb. 4, 2014 at 11-14.

⁵ See outgoing office action sent on Feb. 4, 2014 at 16-22.

Additionally, the following third party registrations were attached to the Feb. 4, 2014 and August 26, 2014 office actions showing parties offering chocolate bars and cocoa, cookies, and chocolate or cocoa beverages under the same mark:

Registration No.	Mark	Description of goods ⁶
4238208	KAIZER	Cocoa; cookies; candies; candy and chocolate bars
4415165	FRANCOIS PRALUS MAITRE CHOCOLATIER & DESIGN	Chocolate dips, snack mixes containing chocolate; chocolate, cocoa, chocolate bars and chocolate products, namely, chocolate candies, chocolate confections, chocolate mousse, chocolate syrups , chocolate truffles, chocolate filling for cakes, chocolate covered cookies, chocolate covered fruit, chocolate covered nuts, chocolate covered popcorn, chocolate covered raisins; Cocoa products, namely, candy with cocoa, cocoa mixes, cocoa spread, cocoa powder, cocoa based condiments, cocoa based seasonings, cocoa based ingredient for confectionery products; chocolate pastry, chocolate for confectionery, coffee, tea
4270025	SUPERFOOD ENERGY	Candies; chocolates; chocolate glazes; chocolate bars; chocolate spreads; chocolate coatings; chocolate sauces; chocolate fondues; chocolate mousses;

⁶ The recitation of goods lists those relevant to the refusal under Section 2(d).

		chocolate pastes; chocolate powders; chocolate or cocoa based food beverages not being dairy-based or vegetable based; cocoa; cocoa extracts; cocoa mixes; cocoa powder; cocoa spreads; cocoa based beverages; chocolate syrups; chocolate toppings; chocolate fillings; baking chocolate; chocolate or cocoa coated or covered nuts; chocolate or cocoa coated or covered fruits; chocolates containing nutrients; cacao nibs; chocolate chips; breakfast cereals;
4337245	ONE GREEN STREET	Candies; Candy; Candy bars; Candy mints; Candy with caramel; Caramels; Chocolate; Chocolate bars; Chocolate candies; Chocolate confections; Chocolate confections, namely, candy and truffles; Cocoa; Confectioneries, namely, snack foods, namely, chocolate; Snack foods, namely, chocolate-based snack foods
4448584	MOFO DELUXE	Chocolate; chocolate products, namely, chocolate powder and chocolate bars; coffee; tea; cocoa; chocolate-based beverages; coffee-based beverages
4463815	MAMA GANACHE ARTISAN CHOCOLATES	Chocolate; chocolates; cocoa; chocolate chips; chocolate bars; chocolate candies; chocolate covered fruit; chocolate covered pretzels; chocolate covered cookies; candy; and caramels

4368500	MELANIE	<p>Candies; Candy; Candy bars; Candy with cocoa; Chocolate; Chocolate and chocolates; Chocolate bars; Chocolate candies; Chocolate confections; Candies; Candy; Candy bars; Candy with cocoa; Caramels; Chocolate; Chocolate and chocolates; Chocolate bars; Chocolate candies; Chocolate chips; Chocolate food beverages not being dairy-based or vegetable based; Chocolate syrup; Cocoa; Cocoa; Cocoa mixes; Cocoa powder; Cocoa-based condiments and seasonings for food and drink; Cocoa-based ingredient in confectionery products; Cookies; Cookies and crackers; Milk chocolate; Chocolate covered cookies; Milk chocolate; Snack foods, namely, chocolate-based snack foods</p>
4399963	PASKESZ	<p>Candy; Candy bars; Cereal bars; Chewing gum; Chocolate; Chocolate bars; Chocolate chips; Chocolate confections; Chocolate covered cookies; Chocolate covered fruit; Chocolate powder; Chocolate syrup; Chocolate truffles; Chocolates and chocolate based ready to eat candies and snacks; Cocoa powder; Confectioneries, namely, snack foods, namely, chocolate; Cookies; Snack foods, namely, chocolate-based snack foods;</p>

4199588	LIFE'S PERFECT BLEND	Candy; Chocolate bars; Chocolate-based ready-to-eat food bars; Chocolates and chocolate based ready to eat candies and snacks; Chocolates containing nutrients; Cocoa mixes; Cocoa-based beverages; Cookies; Filled chocolate; Snack foods, namely, chocolate-based snack foods
4236284	SOAKOLOGY	chocolate, chocolates and candies, namely, 'feet' shaped chocolates and chocolate bars; chocolate covered cookies; cookies; hot chocolate; prepared cocoa and cocoa-based beverages
4179412	DERDOR	Beverages with a chocolate base; Chocolate; Chocolate and chocolates; Chocolate bars; Chocolate covered cookies; Chocolate food beverages not being dairy-based or vegetable based; Chocolate-based beverages; Chocolate-based beverages with milk; Chocolate-based ready-to-eat food bars; Filled chocolate; Hot chocolate; Milk chocolate;
4433893	NUTS ABOUT CHOCOLATE	Beverages with a chocolate base; Chocolate; Chocolate and chocolates; Chocolate bars; Chocolate candies; Chocolate chips; Chocolate confections; Chocolate confections, namely, truffle; Chocolate covered cocoa nibs; Chocolate covered cookies;

The websites and third party registrations discussed above are probative because they show that several of the goods listed in registrant's description of goods are the sort of goods that are likely to emanate from the same source, under the same mark as applicant's goods and that consumers are likely to encounter these goods in the marketplace in a manner suggesting they emanate from the same source. Consequently, applicant's argument that the goods are not related was not found to be persuasive and the goods are related under Section 2(d) of the Trademark Act.

IV. CONCLUSION

The examining attorney respectfully request affirmation of the refusal under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) based on a likelihood of confusion with the mark in U.S. Registration 4235722. Here, the marks are confusingly similar due to the fact that they are phonetic equivalents and they are similar in appearance because they both consist of a combination of the terms 2 or TOO with the word GOOD. The parties' goods are related because the evidence shows it is common for parties that offer chocolate bars to also offer several of registrant's goods such as its cookies, chocolate, cocoa, and chocolate based beverages and to market these goods together so that they will be encountered by consumers in the marketplace in a manner suggesting they emanate from the same source.

Respectfully submitted,

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