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Subject: U.S. TRADEMARK APPLICATION NO. 79162427 - NORTHWOOD - N/A - Request for Reconsideration Denied - Return to TTAB

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 79162427

MARK: NORTHWOOD



CORRESPONDENT ADDRESS:

ELIZABETH W KING

SUTTON MCAUGHAN DEEVER PLLC

THREE RIVERWAY SUITE 900

HOUSTON, TX 77056

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

APPLICANT: Lidl Stiftung & Co. KG

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

INTERNATIONAL REGISTRATION NO. 1240591

This Office action is in response to applicant's communication filed on May 2, 2016 where applicant requested reconsideration of the Section 2(d) refusal.

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The Section 2(d) Refusal made in the October 30, 2015 Office action is hereby maintained and continued. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

As applicant has filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

SUMMARY OF ISSUES:

- Section 2(d) Refusal – Likelihood Of Confusion

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

The final refusal of registration of the applied-for mark is maintained and continued because of a likelihood of confusion with the mark in U.S. Registration No. 2009770. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 et seq. See registration enclosed in first Office action.

The applicant has applied to register NORTHWOOD for “Pastry and confectionery in the nature of desserts, namely, chocolate confections, tarts; gateaux; cakes, cookies, muffins and biscuits” in International Class 30.

The registered mark is NORTHWOODS for “table syrup” in International Class 30.

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 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, 1361, 177 USPQ 563, 567 (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 Vitterra 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.*

Comparison of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

In the present case, the applied-for mark and the registered mark are comprised of the singular or plural form of the term NORTHWOOD. The Collins American English Dictionary has no definition for the term "northwood." See *evidence attached to the first Office action*. The term NORTHWOOD has no literal connection to applicant's or registrant's goods, and thus has an equally arbitrary connotation and commercial impression. Even if the term "northwood" is divided into its component parts "north" and "wood," the marks share a similar commercial impression. Individually, the term "north" is defined as "the northern part of the earth" and "woods" is defined as "a thick growth of trees; forest or grove" giving both marks a similar impression of goods that come from forests in the northern part of the earth. See *evidence attached to final Office action*. The use of the similar term "northwood" for both marks gives the marks a similar commercial impression.

In the applied-for mark the word NORTHWOOD appears in the singular form while in the registered mark it appears in the plural form. Trademarks consisting of the singular and plural forms of the same term are essentially the same mark. See *Wilson v. Delaunay*, 245 F.2d 877, 878, 114 USPQ 339, 341 (C.C.P.A. 1957) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark); *In re Pix of Am., Inc.*, 225 USPQ 691, 692 (TTAB 1985) (noting that the pluralization of NEWPORT is "almost totally insignificant" in terms of likelihood of confusion among purchasers). As a result, the different use of the plural and singular form of NORTHWOOD is not significant when comparing the marks for likelihood of confusion.

Thus, when looking at the various food goods identified in the marks, a consumer would be confused as to the source of the goods because of the singular or plural form of the word NORTHWOOD. Therefore, the marks are confusingly similar.

Comparison of the Goods

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 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 chocolate confections, tarts, gateaux, cakes, cookies, muffins, and biscuits are related to the registrant’s table syrup because they are all sweet food products manufactured by the same food manufacturers. According to the attached evidence, “table syrup” is a broad category applying to syrup used in household, typically for breakfast and often as a substitute for pure maple syrup, that is also known as pancake syrup or just syrup. See *evidence attached to final Office action*. Companies that make table syrup also commonly make other sweet food items such as those identified by applicant. Stonewall Kitchen manufactures multiple syrups for use at breakfast including holiday syrup and raspberry syrup as well as chocolate confections, cookies, cakes, biscuits, and tarts. See *evidence attached to final Office action*. Golden Barrel manufactures table syrup and also cookies. See *evidence attached to final Office action*. South Georgia Pecan Co. manufactures maple praline flavored syrup for use at breakfast, chocolate confections, and cookies. See *evidence attached to final Office action*. DaVinci Gourmet manufactures pancake syrup and chocolate confections. See *evidence attached to final Office action*. Sur La Table manufactures pancake syrup and tarts. See *evidence attached to final Office action*. Knott’s Berry Farm manufactures raspberry syrup and cookies. See *evidence attached to final Office action*. Velata manufactures blueberry syrup for use at breakfast, chocolate confections, cookies, and cakes. See *evidence attached to final Office action*. Grocery stores such as Trader’s Joes, Meijer, Wegman’s, Walmart’s Great Value, and Hannaford also commonly sell their own brands of chocolate confectionery, cookies, tarts, gateaux, cakes, muffins, biscuits, and table syrup. See *attached evidence and evidence attached to first Office action*. This evidence establishes that the same entity commonly manufactures the relevant goods and markets the goods under the same mark and that the relevant goods are sold through the same trade channels and used by the same classes of consumers in the same fields of use. Therefore, applicant’s and registrant’s goods are considered related for

likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Section 2(d) that goods are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007). Specifically, the widespread use of the Internet in the United States suggests that Internet evidence may be probative of public perception in trademark examination. *See In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1642 (TTAB 2015).

The trademark examining attorney has attached to the record evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case. This evidence shows that the goods listed therein, specifically pastry, confectionery, tarts, gateaux, cakes, muffins, biscuits, and table syrup, are of a kind that may emanate from a single source under a single mark. *See In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); TMEP §1207.01(d)(iii).

As discussed above, applicant and registrant identify virtually identical marks. Where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the goods needed to support a finding of likelihood of confusion declines. *See In re i.am.symbolic, Llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)); TMEP §1207.01(a). As applicant and registrant identify virtually identical marks, the relationship between the relevant goods need not be as close to support a finding of likelihood of confusion.

In the request for reconsideration, applicant argues that the goods are dissimilar because applicant identifies different goods than registrant. This argument is not convincing because, while the goods of the parties are not identical, they are closely related. As discussed previously, the goods 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 to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods would be encountered by the same consumers under circumstances such that offering the goods under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i). In this case, the evidence of record amply demonstrates that the goods are related goods because they commonly emanate from the same manufacturer, are marketed under the same marks, and are offered to the same groups of consumers in the same trading channels.

In the request for reconsideration, applicant argues that the evidence in the first Office action only shows retail grocery stores, distributors or importers who manufacture both dessert goods and table syrup. The evidence discussed above includes many manufacturers that are not retail grocery stores, distributors, or importers that manufacture both dessert goods and syrup goods and sell them both under the same trademark. While the evidence also includes evidence from companies that operate retail grocery stores, those companies also manufacture table syrup and desserts and sell both syrup and desserts under the same trademark which demonstrates that consumers would be accustomed to table syrup and desserts being sold under the same trademarks.

Applicant previously argued that two cases, *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) and *Irwin AugerBit Co. v. Irwin Corp.*, 134 USPQ 37, 39 (TTAB 1962) to support the proposition that “Registrations owned by department stores or food distribution chains or grocery stores are not evidence of confusing similarity product to product.” However, the circumstances of those cases are not present in the current application because in those two cases the goods being compared were a wide of goods in multiple international classes. *Id.* Those cases did not address closely related food products carrying the same retail grocery store trademark. *Id.* The goods at issue in this case are all in the same international class and are similar sweet food products. The evidence discussed above of food manufacturers who also happen to operate retail grocery stores is not presented to establish a relationship due to the retail grocery stores services or the location of the goods on the grocery store shelves, but instead the evidence from grocery stores is included, along with evidence from other food manufacturers, to demonstrate how consumers would be accustomed to table syrup and desserts being sold under the same trademarks. As consumers would be accustomed to table syrup and desserts being sold under the same trademarks, the goods are related and a likelihood of confusion exists.

Applicant argues that there are thousands of registrations for desserts or table syrup but only a very small percentage of those sell both. Applicant has included improper evidence of the referenced third-party registrations in the form of a list of the registrations. The Trademark Trial and Appeal Board does not take judicial notice of registrations, and the submission of a list of registrations does not make these registrations part of the record. *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974); TBMP §1208.02. To make registrations of record, copies of the registrations or the complete electronic equivalent (i.e., complete printouts taken from the USPTO's Trademark database) must be submitted. *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002); *In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d 1455, 1456 n.2 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1561 n.6 (TTAB 1996); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994). Therefore, the examining attorney objects to the improper evidence of third-party registrations. See TMEP §710.03. Applicant argues that submitting the search string is the only method of establishing that there are thousands of registrations for desserts or table syrup but only a very small percentage of those sell both. However, applicant is mistaken as the only way to establish what goods a third-party registration identifies is to submit copies of the registrations themselves. *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB

1974); TBMP §1208.02. A search string does not establish what goods a particular registration is identifying. Without submitting copies of the registrations themselves, applicant has not established that there are thousands of registrations for desserts or table syrup but only a very small percentage of those sell both.

Notwithstanding the insufficiency of the evidence, and in the event that the Board overrules the objection and considers the evidence, applicant's arguments related to the third-party registrations are unpersuasive because even though some manufacturers of desserts do not also manufacture table syrup, that does not mean that consumers would not believe the same manufacturers make both. Instead, the evidence of record amply demonstrates that the goods are related goods because they commonly emanate from the same manufacturer, are marketed under the same marks, and are offered to the same groups of consumers in the same trading channels.

Thus, when confronted by applicant's and registrant's goods, consumers would likely be confused as to the source of the goods because they are similar sweet goods manufactured by the same food manufacturers. Therefore, the goods are closely related.

Since the marks are similar and the goods are related, there is a likelihood of confusion as to the source of applicant's goods. Applicant's request for reconsideration is denied. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The Section 2(d) Refusal made in the October 30, 2015 Office action is hereby ***maintained and continued***. See TMEP §§715.03(a)(ii)(B), 715.04(a).

/Timothy Schimpf/

Examining Attorney

Law Office 113

(571) 272-9072

timothy.schimpf@uspto.gov