

From: Lott, Maureen D.

Sent: 12/30/2011 10:21:44 AM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85067330 - TOP-TOP'S - T-10740.RF - EXAMINER BRIEF

\*\*\*\*\*

Attachment Information:

Count: 1

Files: 85067330.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**APPLICATION SERIAL NO.** 85067330

**MARK:** TOP-TOP'S



**CORRESPONDENT ADDRESS:**

STEWART L GITLER  
WELSH FLAXMAN & GITLER LLC  
2000 DUKE STREET SUITE 100  
ALEXANDRIA, VA 22314

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** Fritos Totis S.A. de C.V.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

T-10740.RF

**CORRESPONDENT E-MAIL ADDRESS:**

gitler@iplawsolutions.com

**EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant Fritos Totis S.A. de C.V. has appealed the examining attorney's final refusal to register the mark "TOP-TOP'S" under Section 2(d) of the Trademark Act on the basis that it is likely to cause confusion with the registered mark "TOPS" in Registration Nos. 1433101, 2856078, and 3001996.

**FACTS**

Applicant applied to register the mark "TOP-TOP'S" on the Principal Register in connection with corn chips. Registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), based on a likelihood of confusion with the mark "TOPS" in Registration Nos. 1433101, 2856078, and 3001996. This appeal follows the Examining Attorney's final refusal under Section 2(d).

**ISSUE**

The sole issue on appeal is whether applicant's mark "TOP-TOP'S" is likely to cause confusion with the mark "TOPS" in Registration Nos. 1433101, 2856078, and 3001996 as set forth under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

## **ARGUMENTS**

### **I. Section 2(d) - Likelihood of Confusion**

#### **A. Overview of Likelihood of Confusion Analysis**

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or 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). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 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 of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); TMEP §§1207.01 *et seq.*

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. *See In re E. I. du Pont de*

*Nemours & Co.*, 476 F.2d 1357, 1361-62, 177 USPQ 563, 567 (C.C.P.A. 1973); *In re Ist USA Realty Prof'ls Inc.*, 84 USPQ2d 1581, 1584 (TTAB 2007); *see also In re Dixie Rests. Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

**B. Applicant's Mark is Similar to Registrant's Mark**

Applicant's mark is the standard character mark "TOP-TOP'S." The mark in Registration Nos. 1433101, 2856078, and 3001996 is the typed or standard character mark "TOPS."

In this case, "TOPS" in the registered mark and "TOP'S" in applicant's mark are the same, except that the latter contains an apostrophe. This apostrophe has little, if any, trademark significance and does not otherwise affect the overall similarity of the words in terms of commercial impression. *See In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (noting that "[t]he absence of the possessive form in applicant's mark . . . has little, if any, significance for consumers in distinguishing it from the cited mark"); *In re Curtice-Burns, Inc.*, 231 USPQ 990, 992 (TTAB 1986) (finding the marks McKENZIE'S and McKENZIE "virtually identical in commercial impression"); *Winn's Stores, Inc. v. Hi-*

*Lo, Inc.*, 203 USPQ 140, 143 (TTAB 1979) (noting that “little if any trademark significance can be attributed to the apostrophe and the letter ‘s’ in opposer’s mark”).

It, therefore, appears that applicant has merely added a term to the registered mark. The mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR’S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY’S ACCU TUNE); TMEP §1207.01(b)(iii).

Significantly, the term that applicant added to its mark is the singular form of registrant’s entire mark. Applicant’s mark and registrant’s mark are, therefore, quite similar with each being comprised only of the term “tops” or its variations. Because the marks are similar in sound, appearance, and overall commercial impression, it is likely that consumers would be confused as to the origin of applicant’s goods.

Applicant argues that there is no likelihood of confusion, because marks containing the term "top" or "tops" are weak or diluted. In support of its argument, applicant refers

to information submitted with its appeal brief regarding several registrations for marks containing the term “top” or “tops.”<sup>1</sup> Applicant’s brief, pp. 2-4. The examining attorney respectfully disagrees with applicant’s analysis.

In this regard, many of the registered marks referred to by applicant have very distinct commercial impressions. They are clearly distinguishable from both applicant’s mark and registrant’s mark, and it is easy to see why they co-exist on the register. For example, the mark “BIG TOP” in Registration No. 3110290 creates the impression of a circus tent. The mark “THE TASTE THAT’S TOPS” in Registration No. 3056416 creates the impression of food that has the best taste, and the mark “TOPVALU QUALITY AND TRUST” and design in Registration No. 3329619 creates the impression of something with the best quality and value, which is also trustworthy.

As an additional matter, many of the registrations referred to by applicant cover goods unrelated to the snack foods found in the application and registrations at issue here. For example, applicant referred to Registration No. 1830476 for frozen confections and to Registration Nos. 2993286 and 3056416 for breakfast cereal.

Even assuming *arguendo* that marks containing the term “top” or “tops” are weak in connection with the relevant goods, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” 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). This protection extends

---

<sup>1</sup> The examining attorney objects to applicant's submission of the registration information with its appeal brief, because it is untimely. See TBMP 1207.01.

to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975).

The examining attorney, therefore, turns to an analysis of the relevant goods.

### **C. Applicant's Goods Are Related to Registrant's Goods**

Applicant's goods and registrant's goods both include snack foods. In this regard, applicant's goods are corn chips. The goods in Registration No. 1433101 include potato chips. The goods in Registration No. 2856078 include crackers, and the goods in Registration No. 3001996 include cheese and cracker combinations.

#### **1. Applicant's Goods are Related to the Goods in Registration No. 1433101**

The record contains registration information on numerous third-party marks registered in connection with both corn chips and potato chips. For example, please see the information regarding the following registrations, which is attached to the April 14, 2011 final Office action.

- Registration No. 0930102 for "SNACKTIME" (pp. 8-10).
- Registration No. 1242227 for "BARREL O' FUN" (pp. 13-14).
- Registration No. 1261053 for "EVANS" (pp. 15-17).
- Registration No. 1344829 for "GOLDEN FLAKE" (pp. 21-23).
- Registration No. 1365785 for a miscellaneous design (pp. 24-25).
- Registration No. 1589134 for "BIG GRAB" (pp. 31-32).
- Registration No. 2325068 for "WISE" (pp. 33-35).
- Registration No. 3021425 for "AFTER-SCHOOL FUEL" (pp. 36-37).
- Registration No. 3247957 for "LEO" (pp. 41-43).

- Registration No. 3707176 for “JANS” (pp. 44-46).

The internet evidence attached to the April 14, 2011 final Office action also establishes that the same entity commonly provides corn chips and potato chips under the same mark. It establishes that such goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields. Therefore, applicant’s goods 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). In particular, please see the excerpts regarding the following:

- Wise® potato chips and tortilla/corn chips (pp. 65-67).
- Frito Lay® potato chips and corn/tortilla chips (pp. 68-73).
- Herr’s® potato chips and tortilla/corn chips (pp. 74-75).
- Utz® potato chips and corn/tortilla chips (pp. 82-84).
- Snyder’s of Hanover ® potato chips and tortilla/corn chips (p. 87-88).
- Kettle Brand® corn chips and potato chips (pp. 76-79).
- Terrell’s potato chips and corn/tortilla chips (pp. 80-81).

## **2. Applicant’s Goods are Related to the Goods in Registration Nos. 3001996 and 2856078**

The record contains registration information on numerous third-party marks registered in connection with both corn chips and crackers or cracker and cheese combinations. For example, please see the following registration information, which is attached to the April 14, 2011 final Office action.

- Registration No. 1344829 for “GOLDEN FLAKE” (pp. 21-23).
- Registration No. 2325068 for “WISE” (pp. 33-35).

- Registration No. 3021425 for “AFTER-SCHOOL FUEL” (pp. 36-37).
- Registration No. 3247957 for “LEO” (pp. 41-43).
- Registration No. 3707176 for “JANS” (pp. 44-46).
- Registration No. 2900693 for “KRABBY PATTIES” (pp. 47-48).
- Registration No. 2902341 for “NICK CANDY” (pp. 49-50).
- Registration No. 3048916 for “CLASSIC SNACKS” (pp. 53-55).
- Registration No. 3195082 for “WORLD GOURMET” (pp. 56-58).
- Registration No. 3415917 for “NY SNACKS” (pp. 62-64).

The internet evidence attached to the April 14, 2011 final Office action also establishes that the same entity commonly provides corn chips and crackers or cheese and cracker combinations. It establishes that such goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields. Therefore, applicant’s goods and registrant’s goods are related. In particular, please see the excerpts regarding the following:

- Frito Lay® corn/tortilla chips and crackers with cheese (pp. 68-73).
- Nature’s Promise® tortilla/corn chips and animal crackers (pp. 103).
- Goya® tortilla/corn chips, crackers, and cheese crackers (pp. 110-111).
- RW Garcia tortilla chips and crackers (pp. 112).
- 365 Every Day Value® tortilla/corn chips and crackers (pp. 113-116).

### **3. The Goods Need Only be Related for Confusion to Be Likely**

Applicant argues that there is no likelihood of confusion because the goods differ and because the “something more” test set forth *In re Coors Brewing Co.*, 343 F.3d 1340,

1345, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003), has not been satisfied. Applicant's brief, pp. 4-5.

The examining attorney respectfully disagrees with applicant's analysis. As a preliminary matter, 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 to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services 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).

Additionally, the "something more" test in *In re Coors Brewing Co.* indicates that when determining whether there is a likelihood of confusion between a mark used for food products and a mark used for restaurant services, one must show "something more" than that the marks are similar or even identical. The present case is distinguishable, because neither applicant nor registrant has restaurant services. Instead, applicant and registrant have closely related snack foods.

Even if the "something more" test were applicable here, it has been satisfied. The third-party registration and internet evidence of record establishes that 1) the same entity commonly provides corn chips and potato chips, crackers or cheese and cracker

combinations, and 2) such goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields. Therefore, applicant's goods are related to registrant's goods.

**D. Doubt Must Be Resolved in Favor of Registrant**

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).

**CONCLUSION**

The foregoing demonstrates that applicant's mark is likely to cause confusion with the marks in Registration Nos. 1433101, 2856078, and 3001996. Therefore, the examining attorney respectfully requests that the refusal to register under Trademark Act Section 2(d), 15 U.S.C. §1052(d), be affirmed.

Respectfully submitted,

/MaureenDallLott/

Maureen Dall Lott  
Trademark Examining Attorney  
Law Office 117

J. Brett Golden  
Managing Attorney  
Law Office 117