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Mailed:  
September 16, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re East Meadow Corp. d/b/a Uncle Giuseppe's Marketplace*

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Serial No. 85540708

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for East Meadow Corp.

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Managing Attorney).

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Before Zervas, Cataldo and Gorowitz, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

East Meadow Corp. ("Applicant") seeks registration on the Principal Register  
of the mark



Serial No. 85540708

for “ready-made sauces,” in International Class 30.<sup>1</sup> Applicant entered a disclaimer of the term “marketplace.”

The Examining Attorney has refused registration of applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), having determined that Applicant’s mark is likely to cause confusion or mistake or to deceive in view of Reg. No. 3418356 for the stylized mark

*Uncle Giuseppe's*

for “pre[-]prepared prepackaged frozen entrees consisting primarily of pasta and sauces for sale in food stores” in International Class 30.<sup>2</sup>

When the refusal was made final, Applicant appealed and filed a request for reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

*Applicable Law*

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of

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<sup>1</sup> Application Serial No. 85540708 was filed on February 13, 2012, based on an allegation of first use and first use in commerce of November 1, 2007. Applicant entered the following description of the mark into the record:

The mark consists of the lettering "Uncle Giuseppe's" written in black, with the "G" in "Giuseppe's" in a larger stylized red font, positioned over the word "marketplace" in black, along with a picture of a man with peach color skin and hands, with grey hair and a mustache wearing a red shirt with green suspenders and gold buckles and a green hat, holding a brown loaf of bread in one hand and holding one finger up on the other hand, the image of the man being positioned above the word "Uncle".

<sup>2</sup> Registered April 29, 2008; Section 8 accepted.

confusion. See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); see also *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); see also *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014).

#### Similarity or Dissimilarity of the Goods

We base our evaluation on the goods as they are identified in the registration and application. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). It is settled that it is not necessary that the respective goods be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). The goods need only be sufficiently related that consumers would be likely to assume, upon encountering the goods under similar marks, that the goods originate from, are sponsored or

authorized by, or are otherwise connected to the same source. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

The Examining Attorney contends that Applicant's goods, ready-made sauces, are closely related to Registrant's goods, characterized as "entrées comprised of pasta and sauce" and relies on four website printouts.<sup>3</sup> The following three are most relevant:

[www.amys.com/products](http://www.amys.com/products), depicting "Amy's" brand pasta sauces and an "Amy's" brand premade entrée comprised of macaroni and creamy cheese sauce;

[www.198.61.211.135/products/type/skillet-meals/](http://www.198.61.211.135/products/type/skillet-meals/) depicting "Newman's Own" brand premade skillet meals comprised of pasta and sauce combinations and "Newman's Own" pasta sauces sold separately;

[www.barilla.com/italianentrees](http://www.barilla.com/italianentrees) depicting "Barilla" brand pasta and sauce prepared entrées (e.g., meat sauce gemelli and marinara penne) and "Barilla" pasta sauce.<sup>4</sup>

According to the Examining Attorney, the "evidence shows consumers will be very familiar with the notion that ready-made sauces and pasta-and-sauce entrées may be sold by a single entity under a single trademark."<sup>5</sup> Applicant has not challenged the sufficiency of the Examining Attorney's evidence, and this evidence establishes that Applicant's and Registrant's goods are commercially related.

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<sup>3</sup> In the final Office action, the Examining Attorney states that the goods are identical in that both parties offer sauces. Because the Examining Attorney did not repeat this argument in her brief or in the denial of the request for reconsideration, we consider the argument to have been waived by the Examining Attorney.

<sup>4</sup> The Examining Attorney also relies on evidence taken from [www.wholefoods.com](http://www.wholefoods.com). This evidence has limited persuasive value because Whole Foods is a large grocery chain that sells many food products, the evidence only shows a list of foods and not any particular relationship among them, and at best refers to a pizza and not a pasta and sauce entrée.

<sup>5</sup> Brief at unnumbered p. 7.

In view of the foregoing, the Examining Attorney has established that the goods set forth in the application and registration are similar to one another.

Similarity or Dissimilarity of the Marks

We compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. The test is not whether the marks can be distinguished when subjected to 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 or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Association of the United States Army*, 85 USPQ2d 1264 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). See also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 23, 234 (CCPA 1981) (“It is axiomatic that a mark should

not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion”). There is nothing improper, however, in according more or less weight to particular features of a mark if rational reasons are provided and the ultimate conclusion rests on a consideration of the marks in their entireties. *National Data Corp.*, 224 USPQ at 751.

We agree with the Examining Attorney that the marks are similar. “Uncle Guiseppe’s” is the only wording in Registrant’s mark, and there is no design element. In addition, the letter stylization of the wording is not particularly unusual. Applicant’s mark features the same wording, UNCLE GUISEPPE’S. The term is in large lettering that spans the length of Applicant’s mark and dwarfs the only other term in the mark, i.e., MARKETPLACE. As correctly noted by the Examining Attorney, the term MARKETPLACE is a merely descriptive term that has been disclaimed by Applicant, and disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). This disclaimed term does not, as Applicant argues, “suggest a different origin of the parties’ respective goods.”<sup>6</sup> Applicant’s additional contention that MARKETPLACE in combination with the drawing of the man, “creates the commercial impression of a country store selling fresh ingredients,” is merely attorney argument and without evidentiary basis.

Applicant points out and relies heavily on the design elements of its mark - “the stylized and exaggerated letter ‘G’ in the term ‘GUISEPPE’S’ and the character design of the old man pointing upward and holding a loaf of bread” - maintaining

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<sup>6</sup> Br. at 8.

that a design feature may distinguish marks with the same wording. For support, Applicant cites to *In re Coors Brewing Co.*, 343 F.3d 1340, 1344 (Fed. Cir. 2003); and *Shen Mfg. Co., Inc. v. The Ritz Hotel Ltd.*, 393 F.3d 1238, 1242 (Fed. Cir. 2004). While in certain situations a design feature may distinguish two marks, in the present case, Applicant's design elements do not distinguish the marks. First, the design of "a man with peach color skin and hands, with grey hair and a mustache ..." merely reinforces the wording in the mark, providing a visual representation for "Uncle Guiseppe's," which is written in very large lettering. Second, the "G" in "Guiseppe's" still looks like a "G" and would not be pronounced any differently or create any impression other than as the first letter of the term GUISEPPE'S. Third, the two cases cited by Applicant – where both marks under consideration had a design element - are not apposite to the situation facing us in this appeal, where only one of the marks under consideration has a design element. Fourth, as is often stated, it is well-established that, when a mark consists of both words and a design, the literal portion of a mark generally is the dominant feature because it is the element by which consumers will refer to and call for the goods or services. *In re Decombe*, 9 USPQ2d 1812, 1814 (TTAB 1988); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987).

Thus, we find no error in the Examining Attorney's determination that the marks are similar.

Strength of the Mark of the Cited Registration

Applicant contends that “[t]he widespread use of the terms ‘UNCLE’ and ‘GUISEPPE’ result in the conclusion that the Registrant’s Mark is weak”; that “there are over a dozen other marks that incorporate the term ‘GUISEPPE’ in association with types of food and items offered for sale at grocery stores and through caterers”; that “[t]here are at least five (5) applications ... that incorporate the term ‘GUISEPPE’ with Class 30 goods; and that “there are at least one-hundred sixty nine (169) U.S. trademark registrations that incorporate the term ‘UNCLE’ in classes 029, 030, 035 or 043.”<sup>7</sup> The third-party registrations are not evidence of the extent of any use or the market impact any of the marks may have made upon consumers.<sup>8</sup> “The probative value of third-party trademarks depends entirely upon their usage.” *Palm Bay*, 73 USPQ2d at 1693. Absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); *Productos Lacteos Tocumbo S.A. de C.V.*

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<sup>7</sup> Brief at 13.

<sup>8</sup> Applicant states at p. 12 of its brief that “[t]hird-party registrations are useful to show that a registered mark is a “weak” mark and therefore only entitled to a narrow scope of protection,” citing *In re Box Solutions Corp.*, 79 USPQ2d 1953 (2006). This is not an accurate citation of what the Board stated in *Box Solutions*. The Board stated, “third-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry” and used the third party registrations to confirm that the term BOX is highly suggestive of computers and accorded the term a narrow scope of protection. *Id.* at 1957-58.



*v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011). *See also In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983).

[I]t would be sheer speculation to draw any inferences about which, if any of the marks subject of the third[-]party registrations are still in use. Because of this doubt, third[-]party registration evidence proves nothing about the impact of the third-party marks on purchasers in terms of dilution of the mark in question or conditioning of the purchasers as to their weakness in distinguishing source.

*Id.* at 286. *See also Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (“As to strength of a mark, however, registration evidence may not be given any weight”).

Further, the search results from the Trademark Electronic Search System (TESS) database on which Applicant relies have limited probative value because the corresponding goods or services are not shown, and they appear to have been taken from a filing made years ago in 2007 by Registrant. In addition, to the extent that Applicant relies on the third-party applications contained within those search results, third-party applications are evidence only of the fact that they have been filed. *See Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1956 n.9 (TTAB 2014) (“The applications are not evidence of anything except that they were filed.”). The record also includes ten Google search results from a 2007 search for “uncle giuseppe and food.” These results are also of limited probative value because (i) there is no indication whether the websites located were active when Applicant submitted them to the Board, (ii) the excerpts from the websites are substantially abbreviated so that we cannot determine whether references to “Uncle Guiseppe’s” are to individuals or to businesses, (iii) to the

extent that businesses are identified, there is no indication as to the nature of the business, and particularly whether the business concerns food products of the type involved in this appeal, and (iv) whether there are multiple references to the same “Uncle Guiseppe’s.”

Thus, in view of the foregoing, Applicant has not established that UNCLE GUISEPPE’S or its components are weak terms, and we therefore accord the wording UNCLE GUISEPPE’S ordinary weight.

#### Registrant’s Prior Statements

Applicant also relies on statements made by Registrant’s predecessor-in-interest when prosecuting its application that resulted in the cited registration. See Registrant’s response (dated November 21, 2007) filed as Exhibit F to Applicant’s August 30, 2012 response. The Office evidently initially denied registration of Registrant’s mark based on a registration for a different mark owned by Applicant. In contesting the refusal to register, Registrant asserted that there was no likelihood of confusion between the marks. Applicant relies on this statement, maintaining that “their prior response to the Office Action issued against Registrant’s Mark is particularly probative here ....”<sup>9</sup> Applicant’s reliance on Registrant’s statements is not persuasive because Applicant’s prior registration which the Office cited against Registrant’s application at the time is for a mark that has notable differences from Applicant’s present mark. In addition, the Board is not

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<sup>9</sup> Brief at 14.

bound by previous determinations made at the examination level. *McDonald's Corp. v. McClain*, 37 USPQ2d 1274, 1277 (TTAB 1995).<sup>10</sup>

Conclusion

Thus, in view of the similarity of the marks and the services, and because on the present record Applicant has not established that Registrant's mark is weak, we agree with the Examining Attorney that Applicant's mark is likely to cause confusion with Registrant's mark.

**Decision:** The refusal to register Applicant's mark under Section 2(d) of the Trademark Act is affirmed.

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<sup>10</sup> In this regard, Applicant's stated at p.15 of its brief that the Board previously held that "there is no likelihood of confusion between Registrant's Mark and Applicant's Registered Mark is compelling evidence that is no likelihood of confusion between Registrant's Mark and Applicant's Mark herein." There is no evidence in the record, and we are not aware, that the Board previously had the occasion to consider likelihood of confusion between Registrant's mark and Applicant's Registered Mark.