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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Magverz, Inc.

Serial No. 85614128

Matthew H. Swyers of The Trademark Company for Magverz, Inc.

Paul Moreno, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Bucher, Bergsman and Wolfson, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Magverz, Inc. (“applicant”) filed an intent-to-use application for the mark WELLS FRUIT CANDY and design, shown below, for “Candy; Chocolate confections; Frozen confections; Non-dairy frozen confections,” in Class 30.



In the application, applicant described its mark as follows:

The mark consists of WELLS in blue stylized font that is outline [sic] in light blue. There is a blue leaf coming [sic] of the second L. Below this is FRUIT CANDY in small blue stylized font. Below these terms is a blue waving line. All wording contained in a light blue circle.

Applicant disclaimed the exclusive right to use the term “Fruit Candy.”

The Trademark Examining Attorney refused to register applicant’s mark pursuant to Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that applicant’s mark so resembles the mark WELLS A FAMILY COMPANY SINCE 1913 and design, shown below, for “frozen confections,” in Class 30, as to be likely to cause confusion.¹



The registration includes the following description of the mark:

The color(s) red, yellow, gold and black is/are claimed as a feature of the mark. The mark consists of the words "WELLS A FAMILY COMPANY SINCE 1913" in a red oval. The word "WELLS" is in yellow letters with black shadowing and the words "WELLS A FAMILY COMPANY SINCE 1913" are in yellow letters. A gold oval shaped frame extends around the oval and includes a red ruffled border.

Registrant disclaimed the exclusive right to use the term “Family Company” and “Since 1913.”

¹ Registration No. 3922504 registered on February 22, 2011.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks”). These factors, and any other relevant *du Pont* factors in the proceeding now before us, will be considered in this decision.

A. The similarity or dissimilarity and nature of the goods, the likely-to-continue channels of trade and classes of consumers.

Applicant is seeking to register its mark for “candy; chocolate confections; frozen confections; non-dairy frozen confections.” The description of goods in the cited registration is “frozen confections.” The description of goods in the application and the cited registration are in part identical. It is not necessary that all of the goods listed in the application and registrations be related. In the context of likelihood of confusion, it is sufficient if likelihood of confusion is found with respect to use of the mark on any item that comes within the description of goods in the application or registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648

F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

Because the goods described in the application and the cited registration are in part identical, we must presume that the channels of trade and classes of purchasers are the same. *See American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.”). *See also In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

Applicant argues that its goods and the goods in the cited registration are different. According to applicant, applicant’s mark is “used exclusively in connection with sugar-free mints and confectionary products. [Applicant’s] products are vitamin enhanced using high quality raw materials that assist in freshening breath and enhancing health.”² On the other, “the cited mark is used in connection with a producer of frozen confections, namely, frozen confections that are sold under the BLUE BUNNY BRAND.”³

The problem with applicant’s argument is that its identification of goods includes “frozen confections.” Moreover, its identification of goods is not limited to

² Applicant’s Brief, p. 13.

³ *Id.*

sugar-free mints and confectionary products comprised of high quality raw materials that assist in freshening breath and enhancing health. Finally, there are no restrictions or limitations as to channels of trade or classes of consumers in either identification of goods. Because the scope of the registration applicant seeks is defined by its application (and not by its actual use), it is the application (and not actual use) that we must look to in determining applicant's right to register:

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Syst. Inc. v. Houston Computers Svcs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

In view of the foregoing, we find that the goods are in part identical and that there is a presumption that the goods move in the same channels of trade and are sold to the same classes of consumers.

B. The strength of the mark in the cited registration.

Applicant contends that the term "Wells" is not so distinctive that it should prevent applicant's mark and registrant's mark from coexisting on the Principal Register.⁴ To support this argument, applicant submitted copies of 11 registered marks which applicant contends incorporate the term "Well" or variations thereof for related products. The registered marks are set forth below:

⁴ Applicant's Brief, pp. 11-13.

1. Registration No. 3716902 for the mark SIMPLY WELL;
2. Registration No. 3690851 for the mark WELLMADE;
3. Registration No. 3916253 for the mark WELLABY'S;
4. Registration No. 3505675 for the mark OPTIWELL;
5. Registration No. 4064691 for the mark WELLTHY CHOCOLATES;
6. Registration No. 3793627 for the mark MEDWELL FOODS;
7. Registration No. 4128014 for the mark WEL CREAM DESSERTS;
8. Registration No. 4050652 for the mark TEACH THEM WELL;
9. Registration No. 4169702 for the mark SOY WELL;
10. Registration No. 3204577 for the mark EAT WELL BE WELL; and
11. Registration No. 2877309 for the mark OATWELL.⁵

There are two problems with applicant's evidence and contention which prevents us from finding that the mark in the cited registration is weak and entitled to only a narrow scope of protection or exclusivity of use such that consumers will be able to distinguish the marks. First, 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. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934

⁵ Applicant's January 29, 2013 response to Office action.

(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”).

Second, none of the marks in the third-party registrations are as close to the mark in the cited registration as applicant’s mark. In this regard, we note that the commercial impression engendered by the use of the term “Wells” by both applicant and registrant is that of a surname. *See [The Random House Dictionary of the English Language \(Unabridged\)](#)*, p. 2159 (2nd ed. 1987) definition for “Wells”:

1. Henry, 1805-78, U.S. businessman: pioneered in banking, stagecoach services, and express shipping. **2. H(erbert) G(eorge)**, 1866-1946. English novelist and historian. **3. Horace**, 1815-48, U.S. dentist: pioneered use of nitrous oxide as an anesthetic. **4. Ida Bell (Ida Bell Wells-Barnett)**, 1862-1931, U.S. journalist and civil-rights leader.⁶

In view of the foregoing, we find that the strength of the mark is a factor that weighs in favor of finding that there is a likelihood of confusion.

⁶ 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).

C. The similarity or dissimilarity of the marks in terms of appearance, sound, connotation and commercial impression and the strength of the mark in the cited registration.

We turn now to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Furthermore, 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 so that confusion as to the source of the goods or services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the

average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Since the goods at issue are “frozen confections,” the average customer is an ordinary consumer.

The marks are similar because they share the name WELLS. However, our analysis of the similarity or dissimilarity of the marks 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, 751 (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”). On the other hand, different features may be analyzed to determine whether the marks are similar. *Price Candy Company v. Gold Medal Candy Corporation*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). In fact, 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 entirety. *In re National Data Corp.*, 224 USPQ at 751.

We find that the word WELLS is the dominant element of both marks. The term “Fruit Candy” in applicant’s mark is a generic term for candy and the term “A Family Company Since 1913” describes registrant and has little trademark significance.

The design elements associated with both marks (primarily a round carrier and an oval carrier) serve as a background design for the presentation of the WELLS name. When the marks consist of words and a design, the words are normally given greater weight because they would be used by consumers to request the services. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 2 USPQ2d 1553, 1554 (TTAB 1987). *See also Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). In the settings of both marks, the name WELLS projects the primary significance of the marks while the design elements serve to display the WELLS name.

Applicant argues that its mark has a modern, cooler appearance when contrasted to the registrant's nostalgic look.

On the one hand, the Applicant's mark has a new and streamlined look and feel with the blue wave line made popular in trademarks over the past 10 to 15 years. The blue evokes a feeling of coolness with the leaf design element a touch of freshness. Finally, the disclaimed portion of the mark, FRUIT CANDY, informs the prospective consumer of exactly what they are getting with this mark.

To the contrary, the cited registration uses and claims the more bold colors gold, yellow, and red and appears in a font and manner evoking an old-time look and feel. The colors, moreover, are highly suggestive of a turn-of-century San Francisco establishment using the traditional colors of that great city. The old-time look and feel of this trademark are impressed upon the prospective

consumer by the language A FAMILY COMPANY and SINCE 1913.⁷

However, consumers familiar with the WELLS family frozen confections are just as likely to perceive applicant's "new and streamlined look and feel" display of the WELLS mark as just that: a new look for the WELLS family "Fruit Candy" line of products.

As discussed in the previous section, the name WELLS as used in both applicant's mark and registrant's mark has the same meaning and engenders the commercial impression of a surname.

In view of the foregoing, we find the marks are similar in appearance, sound, connotation and commercial impression.

D. Balancing the factors.

In view of the facts that the marks are similar, the goods are in part identical and there is a presumption that the goods move in the same channels of trade and are sold to the same classes of consumers, we find that applicant's mark WELLS FRUIT CANDY and design for "candy; chocolate confections; frozen confections; non-dairy frozen confections" is likely to cause confusion with the mark WELLS A FAMILY COMPANY SINCE 1913 and design for "frozen confections."

Decision: The refusal to register is affirmed.

⁷ Applicant's Brief, p. 10.