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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85748352

MARK: IMPRESS



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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: Gamila Company

CORRESPONDENT'S REFERENCE/DOCKET NO:

T-4456.001-A

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EXAMINING ATTORNEY'S APPEAL BRIEF

The proposed mark IMPRESS (standard character) (for "aerated beverage making machines; coffee extracting machines; non-aerated beverage making machines" and "non-electric coffee makers; non-electric coffee pots; tea infusers; tea pots; thermal insulated containers for food or beverages") has been refused registration under Section 2(d) of the Trademark Act 15 U.S.C. §1052(d). The mark has been held confusingly similar to U.S. Reg. No. 2695561 (IMPRESSA (typed drawing) for "electric coffee

machines, espresso coffee machines and automatic espresso coffee machines”). Applicant appealed the Trademark Examining Attorney’s final refusal to register.

I. FACTS

On October 8, 2012, Applicant applied for registration on the Principal Register of the standard character mark IMPRESS for “aerated beverage making machines; coffee extracting machines; non-aerated beverage making machines” and “non-electric coffee makers; non-electric coffee pots; tea infusers; tea pots; thermal insulated containers for food or beverages.”

In the first Office action issued on February 6, 2013, registration of applicant’s mark was refused under Section 2(d) based on the typed drawing trademark IMPRESSA for “electric coffee machines, espresso coffee machines and automatic espresso coffee machines.” Applicant traversed the refusal, and the Examining Attorney subsequently issued a final Office action with regard to the refusal based on likelihood of confusion under Section 2(d). Applicant filed a request for reconsideration on October 8, 2013, in which applicant presented arguments in response to the refusal under Section 2(d). The Examining Attorney denied applicant’s request for reconsideration on October 25, 2013. Applicant filed an appeal brief on December 27, 2013, with the Trademark Trial and Appeal Board (hereafter “the Board”) appealing the likelihood of confusion refusal under Section 2(d) of the Trademark Act.

As a preliminary matter, the examining attorney objects to Exhibit H included in applicant’s brief. This evidence was not previously submitted and, therefore, is untimely. *See* TBMP §1203.02(e).

II. ISSUE

The issue before the Board is whether there is a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S. C. §1052(d), between applicant’s mark IMPRESS in standard character format for “aerated beverage making machines; coffee extracting machines; non-aerated beverage making machines” and “non-electric coffee makers; non-electric coffee pots; tea infusers; tea pots; thermal insulated containers for food or beverages” and the cited registrant’s mark IMPRESSA in typed character format for “electric coffee machines, espresso coffee machines and automatic espresso coffee machines.”

III. ARGUMENT

APPLICANT'S MARK IS UNREGISTRABLE BECAUSE IT IS CONFUSINGLY SIMILAR TO U.S. REGISTRATION NO. 2695561 UNDER SECTION 2(d) OF THE TRADEMARK ACT.

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 of the applicant and registrant. 15 U.S.C. §1052(d). The Court in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d) of the Trademark Act. However, not all the factors are necessarily relevant or of equal weight, and any one of the factors listed may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of the trade channels and consumers. Any doubt as to the issue of likelihood of confusion must be resolved in favor of the registrant and against applicant as the newcomer. *In re Hyper Shoppes (OHIO), Inc.*, 837 F.2d 463, 464-465, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

A. The goods are similar in nature, overlapping and marketed by a single source, under the same mark, via the same channels of trade and to the same consumer.

It is well-settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods as they are identified in the application and the registration, without limitations or restrictions that are not reflected therein. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1492-1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

In this case, the applied-for goods, namely "aerated beverage making machines; coffee extracting machines; non-aerated beverage making machines" and "non-electric coffee makers; non-electric coffee pots; tea infusers; tea pots; thermal insulated containers for food or beverages," are related to the registered goods, namely, "electric coffee machines, espresso coffee machines and automatic espresso coffee machines" because they are similar in nature, overlapping and frequently provided by a single source, under the same mark, via the same channels of trade, and to the same consumer.

The applied-for and registered goods are similar in nature because both applicant and registrant identify beverage-making apparatus. For example, the applied-for "aerated beverage making machines" and "non-aerated beverage making machines" broadly encompass any and all such goods, including those for making coffee in registrant's more narrow identification. In turn, the registered "electric coffee

machines, espresso coffee machines and automatic espresso coffee machines” include those characterized as aerated and/or non-aerated. Accordingly, these goods are legally identical and, therefore, the examining attorney must presume that they frequently emanate from a single source, under the same mark, via the same channels of trade and to the same consumer, for example people and businesses interested in beverage-makers. *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

In addition, the evidence from *Wikipedia* attached to the final Office action indicates that “coffeemakers or coffee machines are cooking appliances used to brew coffee.”¹ Accordingly, the applied-for “coffee extracting machines,” “non-electric coffee makers; non-electric coffee pots” and registered “electric coffee machines, espresso coffee machines and automatic espresso coffee machines” are all similar in nature because each is an appliance used to brew coffee.

Furthermore, the applied-for “coffee extracting machines” are related to the registered goods because this wording broadly encompasses the registered goods, namely “electric coffee machines, espresso coffee machines and automatic espresso coffee machines,” each of which is a machine that extracts coffee. Specifically, the evidence from *Wikipedia* attached to the final Office action indicates that “proper brewing of coffee requires using the correct amount of coffee grounds, extracted to the correct degree.”² Similarly, the evidence from *CoffeeResearch.Org* attached to the final Office action indicates that “the espresso is ready to be extracted after correctly roasting, blending, grinding, dosing, and tamping the coffee.”³ The website evidence from *Starbucks* attached to the final Office action instructs consumers that “the Verismo™ system offers different levels of pressure to extract the right beverage, from high-pressure extraction for espresso to low-pressure for brewed coffee.”⁴ And the evidence from *Dalla Corte* attached to the final Office action advertises that “Dalla Corte espresso systems are designed to give baristas the tools they need to achieve the perfect extraction consistently.”⁵ This evidence together establishes that the applied-for “coffee extracting machines” broadly encompass the registered “electric coffee machines, espresso coffee machines and automatic espresso coffee machines,” each of which extracts coffee to produce the desired coffee beverage.

Furthermore, there is considerable market evidence supporting that the applied-for and registered goods are related because they are frequently manufactured by a single source, featured under the same mark, sold via the same channels of trade and targeted to the same consumers. For example,

¹ Final Office action dated 04/08/2013 at page 27

² Final Office action dated 04/08/2013 at page 8

³ Final Office action dated 04/08/2013 at page 25

⁴ Final Office action dated 04/08/2013 at page 21-22

⁵ Final Office action dated 04/08/2013 at page 23

website evidence from *Bodum* indicates that electric coffee machines, tea pots, and thermal insulated beverage containers are provided by a single source.⁶ Website evidence from *Breville* shows that aerated beverage making machines, e.g. for infusing milk with bubbles to make cappuccino, tea infusers and espresso coffee machines are sold under the same mark.⁷ Evidence from *Fetco* illustrates that thermal insulated beverage containers, coffee extracting machines, and electric coffee machines are frequently sold to the same consumer, for example people and business who enjoy and sell coffee.⁸ Evidence from *Cuisinart* shows that aerated beverage making machines and coffee and espresso makers are marketed by a single source and sold under the same mark.⁹ And website evidence from *World Market*, *Sur La Table* and *Williams-Sonoma* shows significant overlap of the applied-for and registered goods in the marketplace. For example, this evidence shows teapots, non-electric coffee makers, tea infusers, coffee extracting machines and espresso makers are sold via the same channels of trade, such as home goods stores, and to the same consumer, e.g., people who enjoy hot beverages.¹⁰ This evidence together shows the extensive overlap of the applied-for and registered goods in the marketplace and, therefore, in the minds of consumers.

In addition, the evidence from *Bunn Online* attached to the final Office action shows that manufacturers of coffee makers frequently also sell thermal insulated containers.¹¹ The evidence from *Melitta Online* attached to the final Office action shows electric coffeemakers, espresso machines and manual coffee makers and pots produced by a single source and marketed under the same trademark.¹² The evidence from *Bonjour Online* attached to the final Office action shows French presses, teapots and espresso makers sold by a single source and under the same mark.¹³ The evidence from *Primula Products* attached to the final Office action shows coffee makers, for example coffee presses and espresso coffee makers, thermal insulated containers, and teaware, for example teapots and tea infusers, marketed by a single source under the same mark.¹⁴ And the evidence from *Gevalia* attached to the final Office action shows electric and non-electric coffee makers marketed side-by-side in the same channels of trade.¹⁵ Furthermore, *Gevalia* also markets thermal insulated containers under the same mark.¹⁶ Moreover, this evidence together establishes that applicant and registrant both identify goods targeted to the same consumer, for example people who enjoy brewed beverages, particularly tea and coffee.

⁶ Office action dated 02/06/2013 at page 4-9

⁷ Office action dated 02/06/2013 at page 10-13

⁸ Office action dated 02/06/2013 at page 14-21

⁹ Office action dated 02/06/2013 at page 22-24

¹⁰ Office action dated 02/06/2013 at page 25-41

¹¹ Final Office action dated 04/08/2013 at page 32-33

¹² Final Office action dated 04/08/2013 at page 34-39

¹³ Final Office action dated 04/08/2013 at page 40-43

¹⁴ Final Office action dated 04/08/2013 at page 47-56

¹⁵ Final Office action dated 04/08/2013 at page 44

¹⁶ Final Office action dated 04/08/2013 at page 44-46

Applicant suggests that the applied-for and registered goods are distinguishable because “the two types of goods fall under different categories on the websites offering the two types of goods.”¹⁷ However, applicant’s submission of website printouts solely from *Bed Bath & Beyond* does not conclusively establish this point.¹⁸ Moreover, applicant’s submission supports that the applied-for and registered goods are of a sort that are likely to be found in the same channels of trade. And, furthermore, as applicant notes in the immediately succeeding sentence, “[t]he essential question is whether the marks alleged to infringe are likely to cause confusion as to the source of origin of the goods.”¹⁹ Specifically, the fact that the goods of the parties differ in manner of display is not necessarily controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source or sponsorship of those goods. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01. In this regard, the fact that a single source frequently manufactures both the applied-for and registered goods under the same mark, via the same channels of trade and to the same consumer is particularly compelling.

While applicant suggests that the applied-for and registered goods are distinguishable because “Applicant’s clientele is comprised mostly of coffee aficionados, whereas, naturally, Registrant’s goods are directed to customers interested in sophisticated, ‘office type’ coffee machines,”²⁰ these limitations are not reflected in the identification of goods. Although applicant attempts to restrict the nature and/or intended user(s) of the registered goods, such limitation(s) is impermissible. With respect to applicant’s and registrant’s goods, the question of likelihood of confusion is determined based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Applicant’s reliance on the standard of care exercised by consumers of the applied-for and/or registered goods is not persuasive.²¹ The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, [34 USPQ2d 1526, 1530](#) (Fed. Cir. 1995); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

¹⁷ Applicant’s Brief at page 10

¹⁸ Applicant’s Brief at Exhibit E

¹⁹ Applicant’s Brief at page 10

²⁰ Applicant’s Brief at page 10

²¹ Applicant’s brief at page 14

In sum, the applied-for goods are similar in nature, overlapping and frequently provided by a single source, under the same mark, via the same channels of trade and to the same consumer, for example home goods stores and people who enjoy brewed beverages, e.g., tea and coffee. As such, the factor of relatedness of the goods favors a finding of likelihood of confusion.

Furthermore, where the goods of an applicant and registrant are “similar in kind and/or closely related,” the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

B. The marks are nearly identical in appearance, sound and commercial impression.

The marks must be compared for similarities in sound, appearance, meaning, and/or connotation. *E.I. du Pont de Nemours*, 476 F.2d 1357, 1361. Similarity in any one of the elements of sound, appearance or meaning is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755, 757 (TTAB 1977). 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 their entireties that confusion as to the source of the goods offered under applicant’s and registrant’s marks is likely to result. *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L’Oreal S.A. v. Marcon*, 102 USPQ2d at 1438; *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

The respective marks, IMPRESS and IMPRESSA, are very similar in appearance, sound, meaning and commercial impression because they are nearly identical. Specifically, the sole difference between the applied-for and registered marks is that applicant has removed the letter “A” from the end of registrant’s mark. However, this minor alteration does not change the overall appearance, sound or commercial impression of the term, namely as a reference to the word “impress.”

Applicant’s assertion that registrant’s mark is “always used in combination with additional wording” is irrelevant here.²² The cited registration is for a typed mark, and a mark in typed characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R.

²² Applicant’s brief at page 12

§2.52(a); TMEP §1207.01(c)(iii). Moreover, evidence and arguments that constitute a collateral attack on a cited registration are not relevant during ex parte prosecution. See *In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); TMEP §1207.01(d)(iv).

Applicant's reliance on a variety of case law to support absence of likelihood of confusion is misplaced. Specifically, none of the cited cases assess likelihood of confusion particularly as it relates to coffee and/or beverage makers. Accordingly, they are not relevant to the instant facts.

Applicant contends that "the Examining Attorney made the incorrect presumption that 'impress' and 'impressa' are foreign equivalents."²³ However, applicant misconstrues the issue. Rather than basing the refusal on the doctrine of foreign equivalents, the translation of record from *Babylon*²⁴ is included simply to bolster that the applied-for mark, in addition to consisting in its entirety of the root word of the registered mark and carrying the impression of being an English version of registrant's mark, shares the same meaning as applicant's mark and may be interpreted by consumers as a translated version of registrant's mark because IMPRESSA may be translated to mean IMPRESS. Furthermore, applicant's arguments regarding the rarity of American consumers who speak Italian is unfounded.²⁵ Specifically, it is well established that common, modern languages include Italian. See, e.g., *In re Ithaca Indus., Inc.*, 230 USPQ 702 (TTAB 1986) (Italian). And applicant's inclusion of alternative translations for IMPRESSA²⁶ is not conclusive because, as discussed elsewhere, independent of translation it is readily apparent that the applied-for and registered marks are nearly identical.

Moreover, applicant contends that "the Examining Attorney erroneously compared the respective marks side-by-side, mainly focusing on the appearance of the marks."²⁷ However, this statement is without merit. The applied-for and registered marks not only appear nearly identical, but sound nearly identical and share the same meaning. Considered as a whole in connection with the applied-for and registered goods, both marks convey the commercial impression of goods that are "impressive" and/or make beverages using pressure. Accordingly, the commercial impression of the applied-for and registered marks is also the same. And consumer confusion has been held likely even for marks that do not physically sound or look alike where they convey the same idea, stimulate the same mental reaction, or may have the same overall meaning. *Proctor & Gamble Co. v. Conway*, 419 F.2d 1332, 1336, 164 USPQ 301, 304 (C.C.P.A. 1970) (holding MISTER STAIN likely to be confused with MR. CLEAN on competing cleaning products); see *Ralston Purina Co. v. Old Ranchers Canning Co.*, 199 USPQ 125 (TTAB 1978)

²³ Applicant's Brief at page 9

²⁴ Final Office action dated 4/8/2013 at pg. 2

²⁵ Applicant's brief at page 9

²⁶ Applicant's brief at page 9 and Exhibit C

²⁷ Applicant's brief at page 6

(holding TUNA O' THE FARM for canned chicken likely to be confused with CHICKEN OF THE SEA for canned tuna); TMEP §1207.01(b). Moreover, applicant's reliance on differing number of syllables to establish "that confusion is vastly reduced," falls prey to the same side-by-side pitfall applicant earlier projects onto the examining attorney.²⁸

Applicant's reliance on *Kellogg Co. v. Pack'Em Enters.*, 951 F.2d 330 (Fed. Cir. 1991), is also misplaced.²⁹ Specifically, this case dealt with the likelihood of confusion between FROOTEE ICE (and design) for flavored liquid frozen into bars and FROOT LOOPS for cereal breakfast foods, stickers, and cereal-derived products to be used as breakfast food, snack food, and ingredients for making food.³⁰ Contrary to the instant case, in *Kellogg* the marks shared no identical wording and the goods were also distinguishable. However, in this case, the marks are nearly identical. Furthermore, far from being divergent, the applied-for and registered goods are similar in nature, overlapping and frequently manufactured by a single source, under the same mark, via the same channels of trade and to the same consumer.

Because the applied-for and registered marks are nearly identical in sound and appearance, and share the same commercial impression, the marks are similar. Considered in their entireties, the applied-for mark conveys the commercial impression of being a variation of registrant's mark.

Generally, the greater degree of similarity between the applied-for mark and the registered mark, the lesser the degree of similarity between the goods of the respective parties that is required to support a finding of likelihood of confusion. *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009).

In sum, the marks at issue are nearly identical in appearance and sound, and create the same overall commercial impression. Applicant has simply removed a single ending letter from registrant's mark and, rather than creating a distinct commercial impression in connection with overlapping and highly related goods, both the applied-for and registered marks create the impression of a product that is "impressive" and/or prepares beverages using pressure. Because the marks are nearly identical, and the goods are closely related, overlapping and commonly marketed by a single source, under the same mark, via in the same channels of trade and to the same consumer, consumers encountering applicant's mark and the registered mark in the marketplace are likely to mistakenly believe that the goods emanate from a common source.

²⁸ Applicant's brief at page 9

²⁹ Applicant's brief at page 7

³⁰ *Kellogg Co. v. Pack'Em Enters.*, 951 F.2d 330, 332 (Fed. Cir. 1991)

IV. CONCLUSION

The Examining Attorney has shown that the goods provided by applicant and registrant are similar in nature, overlapping, and likely to travel through the same channels of trade and to target the same consumers. The Examining Attorney has also demonstrated that, despite a single spelling difference between the applied-for and registered mark, the applied-for mark consists in its entirety of the root word of in the registered mark, namely IMPRESS. The Examining Attorney has also established that, when confronted overlapping and highly similar goods bearing nearly identical marks, confusion as to source is likely. For the forgoing reasons, the refusal to register the mark should be affirmed.

Respectfully submitted,

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