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Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Steven A. Huber

Serial No. 86323047

Matthew H. Swyers of The Trademark Company PLLC,
for Steven A. Huber.

Drew M. Sander, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

Before Bergsman, Lykos and Greenbaum,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Steven A. Huber ("Applicant") seeks registration on the Principal Register of the mark EARTH PETS NATURAL PET MARKET (in standard characters) for "retail pet stores," in International Class 35.[1] Applicant disclaims the exclusive right to use the words "Pets" and "Natural Pet Market."

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground

[1] Application Serial No. 86323047 was filed on June 27, 2014, based upon Applicant's claim of first use anywhere and use in commerce since at least as early as October 2000.

that Applicant's mark so resembles the two registered marks listed below as to be likely to cause confusion. The two cited registrations are owned by the same entity.

1. Registration No. 3351024 for the mark NATURAL PET MARKET and design, shown below, for "retail stores featuring health food for pets," in Class 35.[2]

   Registrant disclaimed the exclusive right to use the words "Natural Pet Market."

2. Registration No. 3621455 for the mark NATURAL PET MARKET, in standard character form, for "retail pet stores," in Class 35.[3] The mark was registered under the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). Registrant disclaimed the exclusive right to use the words "Pet Market."

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

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 Co., Inc.,* 315 F.3d

[2] Registered December 7, 2011; Section 8 affidavit accepted.

[3] Registered May 19, 2009; Sections 8 and 15 affidavits accepted and acknowledged.

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.").

Because the cited mark with the design element contains an additional point of difference with Applicant's mark, we confine our analysis to Applicant's mark and the cited registration for the mark in standard character form. That is, if confusion is likely between those marks, there is no need for us to consider the likelihood of confusion with the cited mark with a design element; the standard character mark would be a sufficient basis for us to affirm the refusal of registration. Conversely, if there is no likelihood of confusion between Applicant's mark and the cited mark in standard character form, then there would be no likelihood of confusion with the mark with a design element. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. The similarity or dissimilarity and nature of the services and established, likely-to-continue channels of trade.

The services at issue, retail pet stores, are identical.[4] Because the services described in the application and the cited registration are identical, we must presume that the channels of trade and classes of purchasers are the same. *See In re Viterra*

[4] Applicant concedes "the similarity of the services as recited in the Applicant's applied-for-trademark as well as the registered trademarks." 4 TTABVUE 10.

Inc., 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute,* 101 USPQ2d 1022, 1028 (TTAB 2011).

B. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In a particular case, "two marks may be found to be confusingly similar if there are sufficient similarities in terms of sound *or* visual appearance *or* connotation." *Kabushiki Kaisha Hattori Seiko v. Satellite Int'l, Ltd.,* 29 USPQ2d 1317, 1318 (TTAB 1991), *aff'd mem.,* 979 F.2d 216 (Fed. Cir. 1992) (citation omitted). *See also Eveready Battery Co. v. Green Planet Inc.,* 91 USPQ2d 1511, 1519 (TTAB 2009) (citing *Krim-Ko Corp. v. Coca-Cola Co.,* 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.")).

In comparing the marks, we are mindful that where, as here, the services are 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 services. *Coach*

Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *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).

"The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721. *See also 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 mem.,* 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *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). In this appeal, the average customer is a pet owner, who we deem to be an ordinary consumer.

Applicant's mark is EARTH PETS NATURAL PET MARKET and the mark in the cited registration is NATURAL PET MARKET. Applicant argues that consumers will be able to distinguish the marks because the common portion of the marks "is the

arguably generic but definitely highly descriptive NATURAL PET MARKET which describes, if not is, exactly the services that are provided by the Applicant," and because the dominant part of Applicant's mark is "Earth Pets" which is not part of the registered mark.[5]

Registrant's mark, NATURAL PET MARKET, was registered under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), with the exclusive right to use the words "Pet Market" disclaimed. Therefore, the lack of inherent distinctiveness in the word "Natural" is a nonissue. *See Yamaha International Corp. v. Hoshino Gakki Co. Ltd.,* 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). However, registration under Section 2(f) recognizes that the primary significance of the word "Natural" when used in connection with "retail pet stores" is not descriptive, but the source of those services.

> A term which is descriptive . . . may, through usage by one producer with reference to his product, acquire a special significance so that to the consuming public the word has come to mean that the product is produced by that particular manufacturer. 1 Nims, *Unfair Competition and Trademarks* at §37 (1947). This is what is known as secondary meaning.
>
> The crux of the secondary meaning doctrine is that the mark comes to identify not only the goods but the source of those goods. To establish secondary meaning, it must be shown that the *primary* significance of the term in the minds of the consuming public is not the product but the producer (citations omitted). This may be an anonymous producer, since consumers often buy goods without knowing the personal identity or actual name of the manufacturer.

[5] 4 TTABVUE 13-14.

Ralston Purina Co. v. Thomas J. Lipton, Inc., 341 F. Supp. 129, 133, 173 USPQ 820, 823 (SDNY 1972).

As Professor McCarthy explains,

> Acquired distinctiveness is known as "secondary meaning" not because it is second in importance or in impact, but because it is a meaning acquired second in time. It is a new meaning added second in time to the original primary meaning of the designation. The new "secondary" trademark meaning does not replace or overshadow the original meaning, but adds a new layer of meaning. For example, the original, "primary" descriptive meaning of a word remains free for all sellers to use in a non-trademark sense under the classic fair use rule.

McCarthy on Trademarks and Unfair Competition § 15:1 (4th ed. 2016). *See also Coach Services, Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1729 ("To establish secondary meaning, or acquired distinctiveness, an applicant must show that 'in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.'").

Since the mark in the cited registration NATURAL PET MARKET is registered on the Principal Register, it is entitled to the presumptions accorded by Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b):

> A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate

Because Applicant's mark incorporates the entirety of the mark in the cited registration, customers and potential customers mistakenly may believe that the pet

store services emanate from a single source, or are somehow associated or affiliated with one another. Likely consumer confusion about association or affiliation may suffice to show likelihood of confusion:

> Thus, the issue in these cases is whether [Applicant's marks] … so resemble [Opposer's mark] … *that consumers would be likely to believe that the services originated with or were somehow associated with or sponsored by the same entity*. Although confusion, mistake or deception about source or origin is the usual issue posed under Section 2(d), any confusion made likely by a junior user's mark is cause for refusal; *likelihood of confusion encompasses confusion of sponsorship, affiliation or connection*. See: J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, Section 24.O3 [3] (3d ed. 1992). (Emphasis added).

Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, 1429 (TTAB 1993). *See also See In re Azteca Restaurant Enterprises Inc.,* 50 USPQ2d 1209, 1211 (TTAB 1999) ("The average consumer, therefore, would be likely to view Mexican food items and Mexican restaurant services as emanating from or sponsored by the same source if such goods and services are sold under the same or substantially similar marks."); *In re National Novice Hockey League, Inc.,* 222 USPQ 638, 641 n.7 (TTAB 1984) ("It may be appropriate at this point to note, as has been observed by one commentator, that the statutory concept of 'likelihood of confusion" denotes any type of confusion, including not only source confusion but also "confusion of affiliation; confusion of connection; or confusion of sponsorship.'" (quoting T. J. McCarthy, op. cit, 24.3.B (4 *McCarthy on Trademarks and Unfair Competition* § 24:6 (4th ed. 2016))); *Roush Bakery Products Co., Inc. v. Ridlen,* 190 USPQ 445, 448 (TTAB 1976) (customers of opposer's HILLBILLY bread and rolls and likely to believe that

applicant's restaurant, using essentially the same mark, is approved or sponsored by, or is affiliated with opposer; the likelihood of confusion is aggravated by applicant's sales of bread which is precisely opposer's product); *Saks & Co. v. TFM Industries Inc.,* 5 USPQ2d 1762, 1764 (TTAB 1987) ("the use of the phrase BY FIRE ISLANDER may only tend to increase and not decrease the likelihood of confusion, mistake or deception by suggesting that applicant is the source of or affiliated with at least some of the women's sportswear featured in opposer's catalogs and retail department stores."). In other words, because of the similarity of the marks, consumers are likely to mistakenly believe that Applicant's EARTH PETS NATURAL PET MARKET retail pet stores are somehow associated or affiliated with or sponsored by the source of the previously used NATURAL PET MARKET retail pet stores.

We find that the marks are similar in appearance, sound, connotation and commercial impression.

C. The nature and extent of any actual confusion and the length of time during which there has been concurrent use without evidence of actual confusion.

Applicant asserts that there have been over 13 years of concurrent use without any known instances of confusion.[6] The alleged contemporaneous use of Applicant's and Registrant's marks for a period of 13 years without actual confusion is entitled to little weight, especially in an *ex parte* context. *See In re Majestic Distilling Co., Inc.*, 65 USPQ2d at 1205 ("uncorroborated statements of no known instances of actual confusion are of little evidentiary value"). *See also In re Bisset-Berman Corp.*, 476

[6] 4 TTABVUE 15.

F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of applicant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion); *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965).

D. Balancing the factors.

Because the marks are similar, the services are identical and there is a presumption that the services move in the same channels of trade, we find that Applicant's mark EARTH PETS NATURAL PET MARKET for "retail pet stores" is likely to cause confusion with the registered mark NATURAL PET MARKET for "retail pet stores."

Decision: The refusal to register Applicant's mark is affirmed.