

This Opinion is Not a
Precedent of the TTAB

Mailed: March 28, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re RaceTrac Petroleum, Inc.
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Serial No. 86636421
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Kevin W. Grierson of Culhane Meadows PLLC,
for RaceTrac Petroleum, Inc.

Jeane Yoo, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

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Before Taylor, Pologeorgis and Larkin,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

RaceTrac Petroleum, Inc. (“Applicant”) seeks registration on the Principal Register of the mark SWIRL WORLD and design, as illustrated below, for “frozen yogurt” in International Class 30 and “self-serve yogurt shop services” in International Class 35.¹

¹ Application Serial No. 86636421, filed on May 20, 2015, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming September 30, 2011 as both the date of first use and the date of first use in commerce for both classes of goods and services. The application includes the following description of the mark: “The mark consists of the word ‘Swirl’, in stylized form, in white letters and outlined in blue, with the graphic of a pink, blue, and white frozen yogurt cup inside a pink circle and outlined in blue,



The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the mark SWIRLZ WORLD and design, as displayed below, registered on the Principal Register for "self-serve frozen yogurt shop services" in International Class 35.²



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

I. Evidentiary Objection

We initially turn to an evidentiary objection lodged by the Examining Attorney regarding evidence presented by Applicant for the first time with its appeal brief. The Examining Attorney objects to the submission of a listing of registered trademarks

forming the dot in the letter 'i', all of which is above the word 'World', in white letters inside a pink oval and outlined in blue." The application also claims the colors white, pink and blue as a feature of the mark. Additionally, Applicant claims ownership of Registration Nos. 4238768, 4246941, and 4246942.

² Registration No. 4323387, issued on April 23, 2013, claiming January 2, 2012 as the date of first use and May 25, 2012 as the date of first use in commerce.

generated from a Trademark Electronic Search System (“TESS”) search that include the term SWIRL used in association with “yogurt.”³

The record in an *ex parte* proceeding must be complete prior to appeal. Trademark Rule 2.142(d); 37 CFR § 2.142(d). Exhibits that are attached to a brief but not made of record during examination are untimely, and will not be considered. *See In re Fitch IBCA, Inc.*, 64 USP2d 1058, 1059 n.2 (TTAB 2002); *see also* TBMP §§ 1203.02(e) and 1207.01 (January 2017). Similarly, lists of marks that include certain terms that are submitted for the first time in an appeal brief are also untimely. To the extent that Applicant wished to introduce additional evidence after its appeal had been filed, Applicant should have filed a written request with the Board to suspend the appeal and remand the application for further examination pursuant to Trademark Rule 2.124(d). Applicant did not do so. Accordingly, we cannot consider the list of registered trademarks that include the term “SWIRL,” submitted for the first time with the appeal brief, as evidence in our analysis. In view thereof, the Examining Attorney’s objection is sustained.

As a final matter, we also note that, for the first time in its appeal brief, Applicant submitted status and title copies of the three registrations it specifically claimed

³ Applicant’s submission of the TESS-generated list of registered trademarks that include the term “SWIRL” was apparently made to demonstrate the weakness of said term when used in connection with yogurt and/or yogurt related products and services. 7 TTABVUE 7-8. Even if the list of registered trademarks had been timely submitted, we note that the submission of a list is not the proper way to make registrations of record. As noted by the Examining Attorney, in order to make registrations of record, copies of the registrations themselves, or the electronic equivalent thereof, i.e., printouts of the registrations taken from the electronic records of the Patent and Trademark Office’s database, must be submitted prior to the appeal. *See In re Jump Designs LLC*, 80 USPQ2d 1370, 1372-73 (TTAB 2006); *In re Ruffin Gaming*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002).

ownership of in its application, in addition to Registration No. 4238767. Inasmuch as the Examining Attorney did not object to the submission of these registrations and presented substantive arguments regarding these registrations in her brief, we deem any objection to the submission of these registrations as waived and we, therefore, have considered these registration is our decision. *Cf. In re Rodale Inc.* 80 USPQ2d 1696, 1699 n. 4 (TTAB 2006) (Board considered summary of applicant's prior registrations presented for the first time in its appeal brief because the examining attorney did not object and also presented substantive arguments regarding the registrations).

II. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all 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.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or 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.").

A. Comparison of the Marks

We first address 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.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “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*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quotation omitted).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our 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 Nat’l 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 233, 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, 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 entireties. *In re Nat’l Data*, 224 USPQ at 751.

Applicant's mark is SWIRL WORLD appearing in stylized lettering with the pictorial element of a small cup with swirled frozen yogurt to dot the letter "I" in the word "SWIRL." Additionally, Applicant's mark appears in the colors pink, white and blue. The cited mark is SWIRLZ WORLD also in stylized lettering with a swirl design functioning to dot the letter "I" in the term "SWIRLZ." The cited registration makes no claim to color as a feature of the mark.

Applicant argues that marks are visually different and that the different design elements incorporated in each of the marks at issue are as prominent and distinctive as the literal portions of the marks. Applicant contends that these differences are sufficient to avoid a likelihood of confusion.⁴ We disagree.

We find that the literal portion of Applicant's mark, i.e., SWIRL WORLD, and the literal portion of the mark in the cited registration, i.e., SWIRLZ WORLD, are highly similar. The only difference between the literal portions of the respective marks is the addition of the letter "Z" at the end of the term "SWIRL" in the cited mark. The record demonstrates, however, that the letter "Z" is a common misspelling of the letter "S" to indicate a plural version of a term.⁵ Therefore, we find that the consuming public would view Applicant's SWIRL WOLRD mark as merely the singular version of the cited SWIRLZ WORLD mark. An applied-for mark that is the singular or plural form of a registered mark is essentially identical in sound, appearance, meaning, and commercial impression, and thus the marks are confusingly similar. *Swiss Grill Ltd.*,

⁴ Applicant's Appeal Brief, pp. 6-8, 7 TTABVUE 7-9.

⁵ See August 14, 2015, Office Action.

v. Wolf Steel Ltd., 115 USPQ2d 2001, 2011 n.17 (TTAB 2015) (holding “it is obvious that the virtually identical marks [the singular and plural of SWISS GRILL] are confusingly similar”); *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (finding the singular and plural forms of SHAPE to be essentially the same mark) (citing *Wilson v. Delaunay*, 245 F.2d 877, 878, 114 USPQ 339, 341 (C.C.P.A. 1957) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark)).

We also find, contrary to Applicant’s arguments, that the differing design elements in the respective marks are insufficient to distinguish the marks and avoid a likelihood of confusion. Specifically, the presence of the design of a small cup with swirled frozen yogurt in Applicant’s mark is less dominant since it appears in a significantly smaller size than the literal elements of Applicant’s mark and is nonetheless highly suggestive of the goods and services offered under Applicant’s mark. Similarly, the “swirl” design in the cited mark also appears in a smaller size than the literal elements of the cited mark and tends to reinforce the term SWIRLZ in the cited mark.

In any event, when considering a composite mark containing both words and a design, the word portion may be more likely to indicate the origin of the goods and/or services because it is that portion of the mark that consumers use when referring to or requesting the goods and/or services. *See In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Bond v. Taylor*, 119 USPQ2d 1049, 1055 (TTAB 2016).

Because the design elements in a mark are less dominant than its literal elements and because the literal portions of Applicant's and Registrant's respective marks are highly similar in sound, appearance, and commercial impression, we find that, when the marks are considered in their entirety, their similarities outweigh their differences, including the differences noted by Applicant. Thus, the first *du Pont* factor favors a finding of likelihood of confusion.

B. Strength of Registrant's Mark

Applicant argues in its request for reconsideration⁶ and in its appeal brief⁷ that the term SWIRL is weak when used in connection with yogurt or yogurt-related services. In support of its argument, Applicant submitted for the first time with its appeal brief a list of 36 trademark registrations generated from a TESS search that include the term SWIRL for yogurt related products and services. As discussed *supra*, this evidence was untimely submitted and therefore has been given no consideration.

Accordingly, on this record we cannot find that the term "SWIRL" is weak or diluted for yogurt products or for the services identified in the cited registration. This *du Pont* factor is therefore neutral.⁸

⁶ 4 TTABVUE 3.

⁷ Applicant's Appeal Brief, pp. 6-7, 7 TTABVUE 7-8.

⁸ Even if Applicant had timely and properly submitted the third-party registrations upon which it relies and such evidence demonstrated that the term SWIRL was in fact weak for yogurt-related products and services, we note that even weak marks are entitled to protection against registration of similar marks for identical goods and/or services. *In re Max Capital Group*, 93 USPQ2d 1243, 1246 (TTAB 2010). *See also In re Colonial Stores*, 216 USPQ 793, 795 (TTAB 1982).

C. Comparison of the Goods and Services

We next compare Applicant's goods and services and the Registrant's services. In making our determination under this second *du Pont* factor, we look to the goods and services as identified in the involved application and cited registration. *See Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("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 [and services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [and services], the particular channels of trade or the class of purchasers to which the sales of goods [and services] are directed."). *See also Paula Payne Prods. v. Johnson Pub. Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

In determining whether Applicant's goods and services are related to Registrant's services, it is not necessary that the goods and services of Applicant and Registrant be similar or competitive in character to support a finding of likelihood of confusion; it is sufficient for such purposes to establish that the goods and services are related in some manner and/or that conditions and activities surrounding marketing of these goods and services are such that they would or could be encountered by same persons under circumstances that could, because of similarities of marks used with them, give rise to the mistaken belief that they originate from or are in some way associated with the same producer. *Coach Servs., Inc.*, 101 USPQ2d at 1722; *Edwards*

Lifesciences Corp. v. VigiLanz Corp., 94 USPQ2d 1399, 1410 (TTAB 2010); *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 507 (TTAB 1980); *Oxford Pendaflex Corp. v. Anixter Bros. Inc.*, 201 USPQ 851, 854 (TTAB 1978).

As noted above, Applicant's identified goods and services are "frozen yogurt" in International Class 30 and "self-serve yogurt shop services" in International Class 35. The services identified in the cited registration are "self-serve yogurt shop services" in International Class 35.

The parties' respective Class 35 services are identical. With regard to Applicant's Class 30 goods, i.e., "frozen yogurt," the Examining Attorney made of record the following Internet evidence demonstrating that entities in addition to Applicant itself provide both frozen yogurt and self-serve yogurt shop services under the same mark:⁹

Web page printouts from www.menchies.com – showing frozen yogurt and the service of self-service yogurts shops offered under a common mark.

Web page printouts from www.orangeleafyogurt.com – showing frozen yogurt and the service of self-service yogurts shops offered under a common mark.

Web page printouts showing frozen yogurt and the service of self-service yogurts shops offered under the common SWEET FROG mark.¹⁰

⁹ See August 14, 2015, Office Action.

¹⁰ We note that the Examining Attorney did not include the URL designation of this particular site. The Board generally will not consider Internet evidence if such evidence does not include URL designations and the date on which this evidence was downloaded from the Internet. See *In Re White*, 73 USPQ2d 1713, 1716 (TTAB 2004) ("Internet evidence would be acceptable in an ex parte case when the full address for the page, and the date the page was accessed and downloaded, are provided."). However, since Applicant has not objected to this evidence on the ground that the Examining Attorney failed to provide the URL designation, we deem any such objection waived and, therefore, in our discretion, we have considered the web page printouts from this particular site in our analysis.

We find this evidence sufficient to demonstrate that the Class 30 goods identified in Applicant's application and the services identified in the cited registration are related. Thus, the second *du Pont* factor also weighs in favor of finding a likelihood of confusion.

D. Similarity of Trade Channels and Classes of Purchasers

Because Applicant's services in Class 35 are identical to Registrant's services, we presume that the services travel through the same trade channels and are offered to the same classes of customers. *In re Viterra*, 101 USPQ2d at 1908 (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). For the services in this class, the *du Pont* factor of trade channels and classes of purchasers weighs in favor of a finding of likelihood of confusion.


With respect to the trade channels and classes of purchasers for Applicant's Class 30 frozen yogurt product, the only evidence relating to the trade channels through which the goods at issue travel is the third-party website evidence submitted by the Examining Attorney, discussed above. This evidence shows that frozen yogurt and self-serve yogurt shop services may be provided in the same marketplace to all relevant classes of purchasers. Thus, Applicant's Class 30 goods and Registrant's Class 35 services, as identified, would be provided in the same or at least overlapping channels of trade to the same or overlapping classes of purchasers. Thus, the third *du Pont* factor also weighs in favor of finding a likelihood of confusion with regard to Applicant's Class 30 goods.

E. Consistency of Examination

Applicant has claimed ownership of the following registrations:

1. Registration No. 4238767 for the mark SWIRL WORLD (in standard characters) for “frozen yogurt;”¹¹
2. Registration No. 4246941 for the mark SWIRL WORLD (in standard characters) for “self-serve yogurt show services;”¹²

3. Registration No. 4246942 for the mark  for “self-serve yogurt shop services;”¹³ and

4. Registration No. 4238768 for the mark  for “frozen yogurt.”¹⁴

Pursuant to the thirteenth *du Pont* factor, which permits the Office to consider other information relevant to likelihood of confusion, *see In re E. I. du Pont*, 177 USPQ at 567, Applicant argues that since it already owns two registrations for a mark that is identical to its applied-for mark, except for the claim of color, that identify identical goods and services as those identified in its application, and because it has priority of use over the cited registration, it would be inequitable to not allow its applied-for mark to register, particularly since Applicant’s prior registrations have coexisted

¹¹ Issued on November 6, 2012, claiming September 30, 2011 as both the date of first use and the date of first use in commerce.

¹² Issued on November 20, 2012, claiming September 30, 2011 as both the date of first use and the date of first use in commerce.

¹³ Issued on November 20, 2012, claiming September 30, 2011 as both the date of first use and the date of first use in commerce.

¹⁴ Issued on November 6, 2012, claiming September 30, 2011 as both the date of first use and the date of first use in commerce.

with the cited registration for over four years.¹⁵ In support of its arguments, Applicant relies on the Board's decision in *In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012).¹⁶ Applicant's reliance on this decision is misplaced.

In *Strategic Partners*, appellant owned a registered mark that had coexisted with the cited mark for over five years. Because appellant's prior registration was over five years old, it was not subject to challenge by the owner of the cited registration based on a claim of likelihood of confusion. 102 USPQ2d at 1399.

In finding no likelihood of confusion in *Strategic Partners*, the Board provided the following explanation:

[T]he present case involves the unique situation presented by the coexistence of applicant's existing registration with the cited registration for over five years, when applicant's applied-for mark is substantially similar to its existing registered mark, both for identical goods. When we consider these facts under the thirteenth *du Pont* factor, we find in this case that this factor outweighs the others and leads us to conclude that confusion is unlikely.

Strategic Partners, 102 USPQ2d at 1400.

While we acknowledge that refusing to register the mark now before us is obviously inconsistent with the issuance of Applicant's earlier registrations and although we are sympathetic to Applicant's position on this point, we do not consider the issuance of Applicant's earlier registrations to be a dispositive factor against a finding of likelihood of confusion. As discussed above, the Examining Attorney's refusal is justified on the record in this case. Unlike the situation in *Strategic*

¹⁵ Applicant's Appeal Brief, pp. 9-11, 7 TTABVUE 10-12.

¹⁶ *Id.* at 9-10, 7 TTABVUE 10-11.

Partners, Applicant's earlier registrations were issued in November of 2012 and, therefore, are still subject to cancellation on the basis of priority and likelihood confusion, an important distinction from *Strategic Partners*. See Section 14 of the Trademark Act, 15 U.S.C. § 1064. We find, on this record, that the existence of Applicant's prior registrations does not outweigh the other *du Pont* factors. To hold otherwise would give preclusive effect to the decisions of the Examining Attorneys in granting Applicant's prior registrations, and the Board is not bound by the decisions of Examining Attorneys. To the contrary, "the [US]PTO must decide each application on its own merits, and decisions regarding other registrations do not bind either the [USPTO] or [the reviewing] court." See *In re Boulevard Entm't*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003). The issuance of Applicant's four prior registrations does not compel the issuance of a fifth registration if it would otherwise be improper to do so. Cf. *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009).

In that regard, Applicant was not without any remedy against the refusal of registration in this case. Applicant could have sought a suspension of this appeal or the prosecution of its application after receiving the Section 2(d) refusal to pursue (1) a cancellation proceeding against the cited registration, or (2) possibly a consent agreement with the Registrant. The record demonstrates, however, that Applicant pursued neither of these alternatives.

Furthermore, we find unavailing Applicant's argument that, based on its prior registrations, it has priority of use over the cited registration. It is well established

that an applicant's assertion of priority of use may be given no consideration in an *ex parte* proceeding when registration has been refused under Section 2(d) of the Act in view of a subsisting registration. See *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971) ("As the board correctly pointed out, 'the question of priority of use is not germane to applicant's right to register' in this *ex parte* proceeding."); *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373, 1375 n.3 (TTAB 2001). The rationale behind these decisions is that the portion of Section 2(d) which proscribes registration of a mark likely to be confused with a mark registered in the Patent and Trademark Office does not speak of priority but of a "mark registered"; and that an applicant's assertion of priority of use in such a case constitutes a collateral attack upon the cited registration, which attack cannot be entertained in an *ex parte* proceeding. *In re Calgon*, 168 USPQ at 280. As discussed above, Applicant's possible priority of use gave Applicant a remedy by way of a petition to cancel the cited registration, but overall, this is not a case in which the existence of Applicant's earlier registrations outweighs the impact of the other *du Pont* factors on the issue of a likelihood of confusion.

F. Conclusion

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. Because we have found that (1) the marks at issue are highly similar; (2) Applicant's services in Class 35 are identical to those of Registrant and travel through the same channels of trade to the same classes of customers; and (3) Applicant's Class 30 goods are commercially

closely related to Registrant's identified services, would move in the same or overlapping trade channels, and are offered to the same classes of purchasers, we conclude that Applicant's mark, as used in connection with the goods and services identified in the application, so resembles the cited mark for the identified services as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

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