

This Opinion is Not a
Precedent of the TTAB

Mailed: August 2, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re UBC Food Distributors, Inc.

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Serial No. 90820054

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UBC Food Distributors, Inc., pro se.

Sang Lee, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

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Before Johnson, Acting Deputy Chief Administrative Trademark Judge, and Wolfson
and Larkin, Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

UBC Food Distributors, Inc. (“Applicant”), appearing pro se, seeks registration on
the Principal Register of the mark shown below



Prime®

for “Chocolate; Chocolate and chocolates; Chocolate bars; Chocolate cakes; Chocolate candies; Chocolate truffles; Filled chocolate; Milk chocolate” in International Class 30.¹

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 that it so resembles four marks registered on the Principal Register, and owned by two different registrants, as to be likely, when used in connection with the goods identified in the application, to cause confusion, to cause mistake, or to deceive.

Two of the cited registrations show the standard-character mark PRIME PASTRIES (PASTRIES disclaimed) and the composite word-and-design mark shown below (PASTRIES disclaimed)



for, among other things, “baked goods, namely, croissants, croissant pockets, danishes, cakes, pastries, bear claws, puff pastries, namely, turnovers, fruit-filled pastry sticks, strudel puffs and puff sheets, rolls, buns, strudels, puff dough, and cookies, and frozen dough” in International Class 30.²

¹ Application Serial No. 90820054 was filed on July 9, 2021 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intention to use the mark in commerce. Applicant has disclaimed the exclusive right to use PRIME apart from the mark as shown. Applicant describes its mark as consisting of the “stylized word ‘PRIME’ in brown with a grey semi-circle to the upper right of the ‘E.’” The colors brown and grey are claimed as a feature of the mark.

² Registration No. 5332433 of the standard-character mark (the “433 Registration”) issued on November 14, 2017, and Registration No. 5481469 of the composite mark issued on May 29, 2018.

The second two cited registrations show the standard-character mark PRIME PLANET and the composite word-and-design mark shown below



for, among other things, numerous food products in International Class 30.³

Applicant appealed after the Examining Attorney made the refusal final. Applicant and the Examining Attorney have filed briefs.⁴ We affirm the refusal to register.

I. Record on Appeal and Evidentiary Matters⁵

The record on appeal was made entirely by the Examining Attorney and consists of USPTO electronic records regarding the four cited registrations,⁶ and third-party webpages displaying various food products.⁷

³ Registration No. 5553199 of the standard-character mark and Registration No. 5553200 of the composite mark both issued on September 4, 2018.

⁴ Citations in this opinion to the briefs refer to TTABVUE, the Board's online docketing system. See *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Applicant's brief, in the form of a two-page letter addressed to the Board, appears at 4 TTABVUE, and the Examining Attorney's brief appears at 6 TTABVUE.

⁵ Citations in this opinion to the application record are to pages in the Trademark Status & Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO").

⁶ April 1, 2022 Office Action at TSDR 2-15.

⁷ *Id.* at TSDR 18-24; May 17, 2022 Final Office Action at TSDR 2-22.

Applicant attached to its brief what it described as “data” for cited Registration Nos. 5332433 and 5481469 and “findings” on the marks shown in cited Registration Nos. 5553199 and 5553200, 4 TTABVUE 2, 6-10, as well as what Applicant described as “specimens” of use of its mark. *Id.* at 2-5.⁸ The Examining Attorney objects only to the specimens, which he describes as “photos of their goods,” on the ground of untimely submission on appeal, and requests that the Board disregard this evidence. 6 TTABVUE 10.⁹

“[T]he record should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal.” *In re ZeroSix, LLC*, 2023 USPQ2d 705, at *1 (TTAB 2023) (quoting Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), and excluding a list of third-party registrations attached to the applicant’s appeal brief). We sustain the Examining Attorney’s objection to what Applicant described as specimens of use of its mark, and have given them no consideration in our decision.

We also note that there are materials attached to the Examining Attorney’s brief. 6 TTABVUE 12-77. The Examining Attorney does not describe them in his brief, but they appear to be the third-party webpages that were made of record during

⁸ As noted above, Applicant filed this application based on its allegation of a bona fide intention to use its mark in commerce and did not amend the application to allege use prior to the filing of this appeal. Therefore, the specimens are not in the prosecution history of the application.

⁹ The “data” and “findings” regarding the cited registrations to which the Examining Attorney does not object are USPTO electronic records regarding the cited registrations.

prosecution. The Board strongly discourages both applicants and examining attorneys from attaching such materials to briefs:

Parties to Board cases occasionally seem to be under the impression that attaching previously-filed evidence to a brief and citing to the attachments, rather than to the original submission is a courtesy or a convenience to the Board. It is neither. When considering a case for final disposition, the entire record is readily available to the panel. Because we must determine whether attachments to briefs are properly of record, citation to the attachment requires examination of the attachment and then an attempt to locate the same evidence in the record developed during the prosecution of the application, requiring more time and effort than would have been necessary if citations directly to the prosecution history were provided.

In re Michalko, 110 USPQ2d 1949, 1950-51 (TTAB 2014). The Examining Attorney properly provided citations to the record in the body of his brief, 6 TTABVUE 8-9, and it was unnecessary and unhelpful to attach the referenced materials.¹⁰

II. Analysis of Refusal

“The Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion [or] mistake, or to deceive.” *In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *2 (Fed. Cir. 2023) (cleaned up).

¹⁰ The Examining Attorney’s brief also contains active hyperlinks to websites from which the Examining Attorney made webpages of record during prosecution. 6 TTABVUE 8-9. Such links are improper in general because they may resolve to different versions of the webpages than those that were made of record during prosecution. Given the ephemeral nature of Internet websites, “the Board does not accept Internet links as a substitute for submission of a copy of the resulting page.” *TV Azteca, S.A.B. v. Martin*, 128 USPQ 2d 1786, 1789 n.15 (TTAB 2018) (internal citation omitted). It is sufficient simply to cite the URLs from which webpages in the record were taken and to direct the Board to the portions of the record in which the webpages may be found.

Our determination of the likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). *Id.*, at *4. We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

“In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the [goods or] services.” *Monster Energy Co. v. Lo*, 2023 USPQ2d 87, at *14 (TTAB 2023) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). Applicant does not reference any *DuPont* factors in its brief, but does discuss the involved marks and goods, stating that it “genuinely believe[s] that there is no likelihood of confusion based on the Examining Attorney’s findings” 4 TTABVue 3.

We will confine our analysis of the Section 2(d) refusal to the cited standard-character PRIME PASTRIES mark shown in the ’433 Registration for “baked goods, namely, croissants, croissant pockets, danishes, cakes, pastries, bear claws, puff pastries, namely, turnovers, fruit-filled pastry sticks, strudel puffs and puff sheets, rolls, buns, strudels, puff dough, and cookies, and frozen dough” in Class 30. This standard-character mark “has the most points in common with” Applicant’s stylized PRIME mark, *Monster Energy*, 2023 USPQ2d 87, at *12, and if we find a likelihood of confusion as to this mark based on the goods identified in the ’433 Registration,

“we need not find it as to [the other cited] registered marks; conversely, if we do not find a likelihood of confusion as to [this] mark” for those goods, “we would not find it as to [the other cited] registered marks for [the] goods identified therein.” *New Era*, 2020 USPQ2d 10596, at *9-10.

A. Similarity or Dissimilarity of the Goods, Channels of Trade, and Classes of Consumers

“The second *DuPont* factor ‘considers [t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,” *In re Embiid*, 2021 USPQ2d 577, at *22 (TTAB 2021) (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567)), while “the third *DuPont* factor considers ‘the similarity or dissimilarity of established, likely-to-continue trade channels.’” *Id.* (quoting *Detroit Athletic Co.*, 128 USPQ2d at 1052 (quoting *DuPont*, 177 USQ at 567)).

Evidence that goods are related may come from a variety of sources, *Embiid*, 2021 USPQ2d 577, at *22-23, and “[t]he application and registration themselves may provide evidence of the relationship between the [goods],” *Monster Energy*, 2023 USPQ2d 87, at *14 (citations omitted), based on the identifications of the goods themselves.

The “Examining Attorney need not prove, and we need not find, similarity as to each product listed in the description of goods.” *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at *3-4 (TTAB 2020). “[I]t is sufficient for finding a likelihood of confusion if relatedness is established for any good encompassed by the identification of goods within a particular class in the application.” *Id.*, at *4 (quoting *In re*

Aquamar, Inc., 115 USPQ2d 1122, 1126 n.5 (TTAB 2015)). *See also Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). The Examining Attorney is thus required to show only that one of the goods identified in the application is similar to one of the goods identified in the '433 Registration to support a conclusion of a likelihood of confusion.

We “begin with the identifications of [goods] in the registration and application under consideration,” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *5 (TTAB 2019), and we end there as well. The '433 Registration covers goods identified as “cakes,” and we must construe those goods as broadly as reasonably possible “to include all goods of the nature and type described therein.” *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413 (TTAB 2018) (quoting *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006)). Applicant’s application covers goods identified as “Chocolate cakes.” We agree with the Examining Attorney that the broad word “cakes” in the '433 Registration “encompasses all goods of the type described, including applicant’s more narrow ‘chocolate cakes.’” 6 TTABVUE 8. The goods are thus legally identical, and “there is no need for us to further consider the relatedness of the goods.” *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018). The second *DuPont* factor strongly supports a conclusion that confusion is likely. *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at *4 (TTAB 2020).

“Because the goods are legally identical, and there are no limitations in the respective identifications as to the channels of trade or classes of consumers, we must also presume that the channels of trade and classes of consumers are identical.” *Id.*

“The third *DuPont* factor thus also strongly supports a finding of a likelihood of confusion.” *Id.*

B. Similarity or Dissimilarity of the Marks

“Under the first *DuPont* factor, we consider ‘the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.’” *Sabhnani v. Mirage Brands LLC*, 2021 USPQ2d 1241, at *26 (TTAB 2021) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 369 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Id.* (quoting *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

“The proper test regarding similarity ‘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.’” *Id.* (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (internal quotation omitted)). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *Id.* (quoting *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018)). The average customers here are consumers of cakes, including chocolate cakes, which include members of the general public.

“Because the identified goods are identical in part, a lesser degree of similarity between the marks is required for confusion to be likely.” *Sabhnani*, 2021 USPQ2d 1241, at *27 (citing *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 Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *New Era*, 2020 USPQ2d 10596, at *14).

Applicant does not address the similarity or dissimilarity of its mark and the standard-character mark shown in the '433 Registration. The Examining Attorney argues generally that Applicant's mark is “very similar in appearance, sound, commercial impression, and connotation” to all of the cited marks because “they share the identical term PRIME for related goods” and the “additional wording and design elements in the marks do not diminish confusion as the dominant, source-identifying element remains PRIME.” 6 TTABVUE 5. With respect to the PRIME PASTRIES mark shown in the '433 Registration, the Examining Attorney argues that the registrant “has conceded the descriptive/generic nature of the word PASTRIES by disclaiming it,” *id.*, and that the first word PRIME is the “dominant, highly distinctive portion of the mark[.]” *Id.* at 6.

We agree. Although the marks must be considered in their entirety, *Charger Ventures*, 2023 USPQ2d 451, at *5, “in articulating reasons for reaching a conclusion on the issue of confusion, 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 consideration of the marks in their entirety.”

Sabhnani, 2021 USPQ2d 1241, at *30-31 (quoting *Detroit Athletic Co.*, 128 USPQ2d at 1050 (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)). PRIME is the first word in the PRIME PASTRIES word mark, and the second word PASTRIES is the generic name for the “pastries” identified in the '433 Registration and is also descriptive of, if not generic for, several other goods identified in the '433 Registration. As a generic and disclaimed term, PASTRIES has no source-identifying capacity, although we must consider it when comparing the marks in their entirety. *Charger Ventures*, 2023 USPQ2d 451, at *5. The word PRIME is thus the dominant, source-identifying portion of the mark shown in the '433 Registration. The stylized word PRIME is also the dominant portion of Applicant's mark, which also contains a barely visible grey semi-circle. Indeed, Applicant originally described its mark simply as “Prime italicized in brown.”¹¹

We turn now to the required comparison of the marks in their entirety, giving greater weight in that comparison to the word PRIME in the cited mark and in Applicant's mark than to other elements of the marks.

A consumer with a general rather than specific impression of the PRIME PASTRIES word mark for cakes who separately encounters Applicant's brown stylized PRIME mark for chocolate cakes is likely to view the marks as more similar than dissimilar in appearance, and could readily view Applicant's mark simply as a

¹¹ July 9, 2021 Application at TSDR 1. As noted above, Applicant subsequently voluntarily disclaimed the word “PRIME,” April 29, 2022 Response to Office Action at TSDR 1, but “[d]isclaimer of a word in an application to register a mark has ‘no legal effect on the issue of likelihood of confusion’ because the public is unaware of what words have been disclaimed,” *Charger Ventures*, 2023 USPQ2d 451, at *5 (quoting *Nat'l Data Corp.*, 224 USPQ at 751), and we “must consider the mark in its entirety.” *Id.* (citation omitted).

shortened, stylized version of the PRIME PASTRIES mark displayed in the color brown to refer to chocolate cakes.

Because the word “PRIME” will sound the same when both marks are verbalized and will be the first word heard when the cited mark is verbalized, the marks are also more similar than dissimilar in sound. “The similarity in sound will be greater if consumers engage in ‘the penchant of consumers to shorten marks’” and shorten “PRIME PASTRIES” to “PRIME” alone. *Sabhnani*, 2021 USPQ2d 1241, at *36 (quoting *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1961 (TTAB 2016) (finding that the penchant to shorten marks “would lead many consumers to drop the highly descriptive/generic term ‘Blonde’ when calling for” the applicant’s TIME TRAVELLER BLONDE beer)). A consumer with a general rather than specific impression of the sound of the cited PRIME PASTRIES mark for cakes who separately hears Applicant’s mark for chocolate cakes verbalized as “PRIME” could readily hear that mark as a shortened version of “PRIME PASTRIES.”

Finally, the word PRIME has the same laudatory connotation in each mark. A consumer with a general rather than specific impression of the cited PRIME PASTRIES mark for cakes who separately encounters Applicant’s mark for chocolate cakes could readily conclude that the goods originate from the same source. The marks are more similar than dissimilar in appearance, sound, and connotation and commercial impression when used with legally identical goods. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260-61 (Fed. Cir. 2010) (affirming the Board’s conclusion of a likelihood of confusion between the applicant’s standard-character

mark ML and the cited mark ML (stylized) MARK LEES for virtually identical goods). The first *DuPont* factor supports a conclusion that confusion is likely.

C. Summary

The key first and second *DuPont* factors support a conclusion that confusion is likely because the goods, channels of trade, and classes of consumers are legally identical, and the marks are similar. Consumers familiar with the PRIME PASTRIES mark for cakes who separately encounter Applicant's stylized PRIME mark for chocolate cakes are likely to believe mistakenly that those goods have a common source.

Decision: The refusal to register is affirmed.