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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

Tea Forté, Inc.

v.

Dr. Dünner AG

Opposition No. 91179751
to Application No. 77036208
filed November 3, 2006

Douglas R. Wolf, Wolf Greenfield & Sacks PC, for opposer.

Gary M. Nath, The Nath Law Group, for applicant.

**Before Rogers, Chief Administrative Trademark Judge,
Mermelstein and Greenbaum, Administrative Trademark Judges.**

Opinion by Mermelstein, Administrative Trademark Judge:

Applicant Dr. Dünner AG filed an application seeking
registration of the following mark:



for "bags for packaging made of paper or plastic materials,
not included in other classes," in International Class 16.

The mark is described in the application as follows:

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The mark consists of a three dimensional configuration of a cardboard packaging for holding teabags filled with tea, and consists of a tetrahedron with a string protruding from one apex and holding a cloudlike label at its end.

Applicant has disclaimed the exclusive right to use "the label and the string connecting the tea bag^[1] and label" apart from the mark as shown."²

Tea Forté, Inc. opposes registration based on its prior use and registration of several marks, and alleges that the applied-for mark is so similar to opposer's marks as to be likely to cause confusion when used on the identified goods. Trademark Act § 2(d).³ By its answer, applicant denied the salient allegations of the notice of opposition.⁴

We dismiss the opposition.

¹ "Tea bag" and "teabag" appear to be used interchangeably. In this context, we see no difference in their meaning.

² Based on the allegation of a *bona fide* intent to use the mark in commerce under Trademark Act § 1(b). Applicant claims priority pursuant to Trademark Act § 44(d), based on Swiss Application No. 54516/2006 filed May 19, 2006.

³ Opposer also alleged that registration of applicant's mark would falsely suggest a connection with opposer and that applicant's mark is likely to cause dilution. These claims were neither tried nor briefed, and we consider them waived.

⁴ Applicant also set out a number of so-called "affirmative defenses" which, for the most part are merely denials of opposer's claims. In any event, applicant introduced no evidence or argument in support of these allegations.

I. Description of the Record/Evidentiary Issues

The record comprises the pleadings and the file of the opposed application. Trademark Rule 2.122(b). In addition, opposer filed a notice of reliance during its assigned testimony period. Opposer did not file any testimony.

Applicant did not file testimony or any other evidence during its assigned testimony period, nor did applicant file a brief on the merits of the opposition.

Opposer's notice of reliance raises a number of issues that require our consideration. Despite applicant's having not filed evidence or a brief, we may not consider evidence which was "not obtained and filed in compliance with" the relevant rules. Trademark Rule 2.123(1). Accordingly, we review the evidence opposer proffered under its notice of reliance and with its brief:



A. Registrations and Applications





In its notice of opposition, opposer claimed ownership of six pending trademark applications and use of the applied-for marks. By the time of trial, registrations had been granted on two of opposer's applications, and the rest remained pending as applications. Opposer did not amend its notice of opposition to claim ownership of the newly-issued registrations and a likelihood of confusion based

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upon them. However, when an application has been clearly identified in the notice of opposition and use of the applied-for mark is asserted as a bar to registration, we will construe the notice of opposition to allege a likelihood of confusion in view of a subsequently-issued registration based on the pleaded application if the registration issues prior to the close of the opposer's trial period. See *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 n.12 (TTAB 2009) (citing *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1919-20 (TTAB 2006)). We therefore deem the notice of opposition amended to allege a likelihood of confusion in view of opposer's two registrations.

With its notice of reliance, opposer submitted records from the USPTO's online database of its two registrations and four applications, indicating their registered or pending status and opposer's ownership of each of them:

Mark	Description	Goods	SN/RN	Filing Date	Issue Date
	The mark consists of the distinctive trade dress for a tea bag product comprising a three-dimensional triangle-shaped tea bag, a string in the shape of a tea leaf vine, and a tea leaf on the end of the string.	Tea infusers not of precious metal — IC 21	3334940	6/5/06	11/13/07
	The mark consists of the distinctive trade dress of the packaging for a product comprising a three-dimensional pyramidal-shaped package with a flat base and an opening at the top through which extends a string, which retains its shape when bent, and a leaf on the end of the string.	Tea infusers; Tea infusers not of precious metal — IC 21	3772093	8/1/07	4/6/10

Mark	Description	Goods	SN/RN	Filing Date	Issue Date
	The mark consists of the configuration of the product comprising a three-dimensional pyramidal-shaped infuser that stands upright on a flat base, a stem that is able to retain its shape which extends through the top of the infuser, and a leaf icon supported at the end of the stem.	Tea canisters; Tea infusers; Tea infusers not of precious metal; Tea sets — IC 21	77275747	9/10/07	
	The mark consists of the configuration of the product comprising a three-dimensional pyramidal-shaped infuser that stands upright on a flat base, a stem that is able to retain its shape which extends through the top of the infuser, and a leaf icon supported at the end of the stem.	Honey; Tea; Tea bags; Tea for infusions; Herb tea; Herbal tea; Iced tea; Tisanes; Chocolate; Hot chocolate; Flavorings for beverages; Herbal food beverages; Herbal infusions; Bonbons — IC 30	77275750	9/10/07	
	The mark consists of the configuration of the product packaging comprising a three-dimensional pyramidal-shaped product packaging that stands upright on a flat base, a stem that is able to retain its shape which extends through the top of the product packaging, and a leaf icon supported at the end of the stem.	Tea; Tea bags; Tea for infusions — IC 30	77289491	9/26/07	
	The mark consists of the configuration of the product packaging comprising a three-dimensional pyramidal-shaped product packaging that stands upright on a flat base, a stem that is able to retain its shape which extends through the top of the product packaging, and a leaf icon supported at the end of the stem.	Honey; Tea; Tea bags; Tea for infusions; Herb tea; Herbal tea; Iced tea; Tisanes; Chocolate; Hot chocolate; Flavorings for beverages; Herbal food beverages; Herbal infusions; Bonbons — IC 30	77275754	9/10/07	

1. Opposer's Registrations

In view of opposer's submission, opposer's Registration Nos. 3334940 ('940 Registration) and 3772093 ('093 Registration) are of record. Trademark Rule 2.122(d)(2). However, we emphasize that the submission of status and title copies of registrations (or their equivalent) under Rule 2.122(d)(2) only makes *the registration* itself of record. The contents of the

prosecution *file*⁵ of a registration is not automatically made of record when a party offers the registration in evidence under Trademark Rule 2.122(d)(2); a plaintiff wishing to introduce such material in evidence must proffer it, either under a notice of reliance or by identifying and submitting it as an exhibit to testimony, as may be appropriate. Opposer did not do so in this case.

In this regard, we note that opposer cites in its brief items such as the affidavit of Thomas Ginivisian, who is alleged to be opposer's CFO, and results from a public relations report commissioned by opposer, both papers apparently from the file of one of the applications or registrations submitted by opposer under Trademark Rule

⁵ The *file* of the registration includes the application itself (with amendments), the registration certificate (or a facsimile of it), post-registration filings such as affidavits of continuing use and incontestability, and applications for renewal. The file also contains any correspondence between the USPTO and the registrant regarding the application or subsequent registration, such as Office actions setting out refusals and requirements and any argument or evidence submitted by applicant in response to them.

By contrast, the *registration* which is made of record pursuant to Trademark Rule 2.122(d)(2) by submitting a status and title copy of it (or the equivalent from the Office's online database) is not the *file* of the application/registration but only the registration itself – *i.e.*, what is on the certificate of registration issued by the USPTO. For the most part, this consists of the mark (and a description or translation of it, if any), the registration number and date, the registrant's name and address, the goods or services for which registration has been granted, the application number and filing date, claimed dates of use, any disclaimer or Trademark Act § 2(f) claim, and information relating to registrability under Trademark Act § 44 (Paris Convention) or § 66 (Madrid Protocol), if relevant.

2.122(d)(2). Copies of these and other papers were purportedly attached to opposer's brief (more on that topic below).

Although opposer cites this material as evidence in its brief, none of it has been properly submitted into evidence. Trademark Rule 2.122(d)(2) does not provide for the submission of anything other than the registration itself, and the material in question was not submitted under a timely notice of reliance, nor was it identified and submitted as an exhibit to the testimony of any witness.

Opposer relies on the Federal Circuit's opinion in *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 92 USPQ2d 1626 (Fed. Cir. 2009), in maintaining that the files of its registrations and applications are of record in this proceeding. App. Br. at 8, n.1 (also citing TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 704.03(a) (3d ed. rev. 2012)). Opposer misreads *Cold War Museum*, the TBMP, and Trademark Rule 2.122(b)(1), the rule upon which both are based. The rule provides in relevant part that

[t]he file ... of the application *against which* a notice of opposition is filed, or of each registration *against which* a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made

to the file for any relevant and competent purpose.

Trademark Rule 2.122(b)(1) (emphasis added). The rule makes clear that it applies only to a *defendant's* application or registration, or as relevant here, the application in an opposition "*against which* a notice of opposition is filed." *Id.* (emphasis added).

Likewise, *Cold War Museum* is of no help to opposer. In that case – an appeal from a Board cancellation proceeding – the Court of Appeals stated that the issue was "governed by" Trademark Rule 2.122(b), and quoted that rule, before going on to say that "[t]he entire registration file – including any evidence submitted by the applicant during prosecution – is part of the record in a cancellation...." *Cold War Museum*, 92 USPQ2d at 1628. It is quite clear from the context that the Court's reference to "[t]he entire registration file" is the same registration referred to in the rule quoted immediately prior, *i.e.*, the "registration ... *against which* a petition ... for cancellation is filed," *i.e.*, the defendant's registration in the cancellation proceeding.

Because a notice of opposition has been filed *against* Dr. Dünner's application, the file of that application is of record pursuant to Trademark Rule 2.122(b)(1). But

opposer's applications have not been opposed, nor has applicant filed a counterclaim to cancel opposer's registrations, so neither Trademark Rule 2.122(b)(1) nor the *Cold War Museum* decision provide a basis for consideration of the prosecution files of opposer's registrations or applications as part of the record.⁶ Thus, while opposer's registrations are of record pursuant to Trademark Rule 2.122(d)(2), the contents of the prosecution files pertaining to them are not.

2. Opposer's Applications

In addition to its two registrations, opposer submitted records of its four pending applications from the USPTO's TARR database. These records were purportedly offered under Trademark Rule 2.122(d)(2), Not. of Rel. at

⁶ And even if opposer's applications and registrations were part of the record, there are a variety of reasons why the cited materials are unlikely to be "competent" evidence as opposer seeks to use them. See Trademark Rule 2.122(b)(1) ("reference may be made to the file for any relevant and competent purpose"). While parties may stipulate to the submission of evidence by affidavit, absent such a stipulation, testimony may be taken only "by depositions upon oral examination," as set out in detail in Trademark Rule 2.123.

Therefore, Mr. Ginivisian's affidavit would appear to be improper testimony, *id.*, as well as inadmissible hearsay. Fed. R. Evid. 801(c). Likewise, the public relations report commissioned by opposer might have been admissible as a survey but without the testimony of the person who conducted it, it too is hearsay, and lacks a foundation establishing that it was conducted and analyzed by a qualified expert according to accepted methodology. See Fed. R. Evid. 702. Having offered no testimony during its trial period, opposer's attempted submission of these and other papers with its brief is too little and too late.

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1, although, as discussed above, the cited rule provides for the submission of registrations, not applications. Trademark Rule 2.122(d)(2). Nonetheless, applications are official records of the USPTO, and as such may be submitted under a notice of reliance pursuant to Trademark Rule 2.122(e).

We hasten to add, however, that while opposer's pending applications have been made of record, they have very little probative value, as applications are proof of nothing more than the fact that they were filed. *Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012); *In re Binion*, 93 USPQ2d 1531, 1535 n.3 (TTAB 2009). An application is entitled to none of the presumptions afforded an issued registration under Trademark Act § 7(b). And as was the case with opposer's registrations, we consider opposer's notice of reliance to cover only what is shown on the face of the USPTO records opposer submitted; the files of the applications were not proffered, and are not of record. As a result, the TARR records of opposer's applications are of record, but are proof of nothing more than that opposer filed such applications.

B. Applicant's Admissions

Opposer proffered applicant's responses to opposer's requests for admission. To the extent that opposer's

requests were admitted, applicant's responses are admissible under Trademark Rule 2.120(j)(3)(i).

C. Printed Publications

Opposer proffered excerpts from a number of printed publications "pursuant to [Trademark] Rule 2.122(d)(2)" [sic] to "establish Opposer's prior use of Opposer's Pyramidal Trade Dress Marks and Opposer's notoriety associated with Opposer's Pyramidal Trade Dress Marks." Not. of Rel. at 3.

Printed publications are admissible, pursuant to Trademark Rule 2.122(e), under a notice of reliance "if the publication ... is competent evidence and relevant to an issue." *Id.* It is well-settled that printed publications submitted under Trademark Rule 2.122(e) are generally admissible only for what they show "on their face." *Boyd's Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2020 n.8 (TTAB 2003). Printed publications can be offered, for example, to show when and how a party used a mark in advertising its goods or services, that branded goods received certain publicity, or that an alleged family of marks was advertised together. But printed publications such as the articles and advertisements submitted by opposer are not competent evidence of the truth of any matters stated in them because the printed publication

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would be hearsay if offered for that purpose. *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1956 n.5 (TTAB 2008) ("a printed publication is only admissible for what it shows on its face; unless it falls within an exception to the hearsay rule it will not be considered to prove the truth of any matter stated in the publication" (citing *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.2 (TTAB 2007))); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112 (TTAB 2009); Fed. R. Evid. 801(c).

Accordingly, opposer's printed publications are admissible to show, *inter alia*, that the public has been exposed to what is in them and that opposer and its goods have received some publicity. See e.g., Opp. Br. at 6 ("[o]pposer was featured in an article entitled '*Elegance is in the Bag*'"). However, the printed publications are not admissible to prove matters such as opposer's use of the mark on the identified goods in commerce, or the opposer's growth, revenue, and sales. In this regard, we note that opposer relies on magazine articles quoting Peter Hewitt – apparently opposer's founder – regarding opposer's business and its success. See e.g., Opp. Br. at 6, 14. These statements are inadmissible hearsay. Fed. R. Evid. 802. If opposer wished to offer the statement of Mr. Hewitt or anyone else on such matters, it was required to

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present that evidence by testimony pursuant to Trademark Rule 2.123. We cannot consider magazine articles where testimony was required. Trademark Rule 2.123(1). We therefore disregard arguments in opposer's brief based on the contents of these publications.

D. Design Patent

Pursuant to Trademark Rule 2.122(e), opposer submitted a copy of its Design Patent No. D613114S with its notice of reliance. The patent is admissible under the cited rule as a public record. We note, however, that opposer's notice of reliance refers to the "File History" of this patent. Not. of Rel. at 5. To the extent that opposer intended to submit the entire prosecution file for this patent as evidence, opposer has not done so. Only the patent itself has been proffered, see Not. of Rel. Attachment 33, and that is all that we consider to be of record.

E. Attachments to Opposer's Brief

Attached to opposer's brief were 237 pages of exhibits. We have not reviewed this material, as it was not properly submitted and is not part of the record. As we have noted in the past, it is usually pointless to attach evidence to a brief: If the evidence was not previously submitted, it is untimely; if the evidence was previously submitted it is unnecessary and duplicative. In

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either case, it should not be attached to a brief. *Life Zone Inc.*, 87 USPQ2d at 1955 ("Exhibits or attachments to briefs are of little or no use in a Board proceeding."). We have disregarded this material in reaching our decision.

II. Standing

To establish standing to oppose registration of applicant's mark, opposer must prove that it has a real interest in the outcome of this proceeding and a reasonable basis for its belief that it would be damaged by issuance of a registration of the mark to applicant. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002).

Opposer's submission of its trademark registrations for its own pyramidal tea infusers adequately establishes opposer's interest in this proceeding and a reasonable basis for its belief that damage would result from registration.

III. Priority

A. Opposer's Registrations

Opposer has established its ownership of two valid and subsisting trademark registrations. As a result, with respect to the marks in those registrations and the goods

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respectively identified in them, priority is not an issue.⁷

King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

B. Allegation of Prior Use

As noted earlier, the notice of opposition alleges use of opposer's marks in connection with "tea infusers, tea, and tea packaging since at least as early as October 31, 2003," Not. of Opp. ¶ 6, and opposer makes extensive references in its brief to its prior use of the marks on various goods. *E.g.*, Opp. Br. at 1 ("Opposer has ... extensively used virtually identical pyramidal shaped designs in connection with tea and related packaging."). Nonetheless, the evidence of record does not support opposer's claim of use, let alone use as early as 2003.

⁷ As noted above, the subject application claims priority pursuant to Trademark Act § 44(d) based on a Swiss application filed May 19, 2006. Opposer may rely on the filing date of its now-registered applications for priority. See Trademark Act § 7(c). Opposer's applications were filed on June 5, 2006 ('940 Reg.), and August 1, 2007 ('093 Reg.). However, both of those dates are subsequent to applicant's foreign priority date.

Thus on this record, applicant would likely prevail on priority *if priority were an issue*. But as *King Candy* and its progeny make clear, when the opposer proves ownership of an unchallenged registration, priority is irrelevant. Unless applicant seeks to cancel opposer's registrations by way of a counterclaim, opposer need not prove its prior use – or indeed, any use at all – with respect to the marks and goods in opposer's registrations.

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Opposer's claim of use since 2003 is apparently based on the dates of first use and use in commerce recited in its registrations, but such reliance is mistaken:

The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony.

Trademark Rule 2.122(b)(2).

To the extent opposer alleges rights based on use, as opposed to its registrations, opposer was obliged to prove its use and that such use was prior to applicant's priority date, *i.e.*, prior to May 19, 2006. See *Sanyo Watch Co., Inc. v. Sanyo Elec. Co., Ltd.*, 691 F.2d 1019, 215 USPQ 833, 834 (Fed. Cir. 1982) (opposer "bears the burden of proof which encompasses not only the ultimate burden of persuasion, but also the obligation of going forward with sufficient proof of the material allegations of the Notice of Opposition, which, if not countered, negates appellee's right to a registration"). Trademark Rule 2.122(b)(2) makes clear that neither the dates of use nor the specimens in an application or registration are evidence of use or priority. Such facts must be "established by competent

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evidence," *id.*, which usually means testimony by a witness with firsthand knowledge of opposer's actual use of the mark in commerce prior to applicant's priority date, often supported by business records for which a proper foundation has been laid in testimony. But in this case, opposer offered no testimony, and we are able to find no other support for opposer's use or priority in this record.⁸

(Again, opposer's printed publications are admissible only to demonstrate that such material was distributed to the public, but not to prove the truth of any matter therein, such as opposer's actual use of the marks on the identified goods.)

Inasmuch as opposer has proven neither use nor priority with respect to any unregistered trademarks (including the marks and respective goods set out in its pending applications), it cannot establish a claim under Trademark Act § 2(d) with respect to them. Trademark Act § 2(d). We therefore consider the merits of the opposition only with respect to the marks in opposer's '940 and '093

⁸ Opposer states that "[u]se and registration of Opposer's Registrations has never been challenged, including by Applicant." Opp. Br. at 5. To the extent that opposer refers here to rights arising from use (as opposed to registration) of its mark, it is opposer who bears the burden of proving its prior use in commerce on the relevant goods. Applicant has no burden to challenge opposer's prior use of unregistered marks until opposer establishes those facts in the first instance.

Registrations and the goods respectively identified in them.

IV. Likelihood of Confusion

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); see *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).


A. The similarity or dissimilarity of the marks in their entireties

In a likelihood of confusion analysis, we compare the marks for similarities and dissimilarities in appearance,



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sound, connotation and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. "[T]he 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 offered under the respective marks is likely to result." *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1727 (TTAB 2008).

Applicant's mark is depicted and described as follows in the subject application:

Mark	Description	Disclaimer
	The mark consists of a three dimensional configuration of a cardboard packaging for holding teabags filled with tea, and consists of a tetrahedron with a string protruding from one apex and holding a cloudlike label at its end.	the label and the string connecting the tea bag and label

The marks in opposer's registrations are as follows:

Mark	Description	Registration No.
	The mark consists of the distinctive trade dress for a tea bag product comprising a three-dimensional triangle-shaped tea bag, a string in the shape of a tea leaf vine, and a tea leaf on the end of the string.	3334940
	The mark consists of the distinctive trade dress of the packaging for a product comprising a three-dimensional pyramidal-shaped package with a flat base and an opening at the top through which extends a string, which retains its shape when bent, and a leaf on the end of the string.	3772093

1. Drawings

The similarities between the drawings of applicant's mark and opposer's⁹ are obvious. All three marks are pyramidal configurations with a string emerging from the apex, and having an attachment on the free end of the string.

The marks also differ in some respects: applicant's mark is described as a tetrahedron, while opposer's mark is a square pyramid.¹⁰ Moreover, applicant's mark appears to be approximately a *regular* tetrahedron, *i.e.*, one in which each face, including the base, is an equilateral triangle (and thus the same size), while opposer's square pyramid has a considerably greater height than width, giving it a taller, more elongated appearance. Finally, the string on applicant's pyramid ends in a "cloudlike label," while

⁹ The drawings of the marks in opposer's two registrations are virtually identical, except that the position of the string and "leaf" differ slightly. The parties have ignored any difference between the drawings in opposer's registrations, and we likewise consider them to be essentially identical for purposes of our analysis.

¹⁰ A *tetrahedron* is "a solid figure having four plane faces." *i.e.*, a pyramid with a triangular base. COLLINS ENGLISH DICTIONARY (10th ed. unabridged 2009) (<http://dictionary.reference.com/browse/tetrahedron> (visited July 23, 2012)). By contrast, a *square pyramid* is "a three-dimensional geometric figure with a square base and four triangular sides that connect at one point; a pyramid with a square base." DICTIONARY.COM'S 21ST CENTURY LEXICON. ([http://dictionary.reference.com/browse/square pyramid](http://dictionary.reference.com/browse/square%20pyramid) (visited July 23, 2012)). We take judicial notice of these definitions. Fed. R. Evid. 201(b); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

opposer's strings end in what appears to be a leaf, and is described in the '940 Registration as "a tea leaf." But despite being able to list several specific differences, we think that these drawings are nonetheless quite similar, even when viewed side-by-side – a more stringent comparison than is usually made by consumers in the marketplace.

Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corp., 206 USPQ 255, 259 (TTAB 1980) (in actual marketplace conditions consumers rarely have the advantage of a side-by-side comparison, and must rely on their imperfect recollection of a prior mark). Allowing for the realities in the marketplace, the impressions formed by these drawings would likely be quite similar.

2. Descriptions of the Marks

Our comparison of the marks does not end with the drawings, because the record includes descriptions of all of the involved marks, which must be considered in determining their similarity and their likely impression on the relevant consumer as they would be encountered. The description of the mark is more than just an aid to examination. When one is necessary, a description of the mark is a formal requirement, and it becomes part of the registration (if and when one is issued). The description of the mark is essentially part of the mark itself.

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Trademark Rule 2.72, which governs amendments to the description or the drawing of the mark, makes clear that the description of the drawing may be amended "only if ... [t]he proposed amendment does not materially alter the mark," as compared with the drawing and description originally filed. Trademark Rule 2.72(a)(2), 2.72(b)(2), 2.72(c)(2).¹¹

At the time both applicant's and opposer's applications were examined, the relevant rule stated that "[a] description of the mark may be included in the application and must be included if required by the trademark examining attorney." Trademark Rule 2.37 (effective Nov. 2, 2003). But then, as now,¹² the examining attorney had no discretion with configuration or trade dress marks: "If an acceptable statement describing the mark is not in the record, the examining attorney *must* require the applicant to submit a description to clarify what the applicant seeks to register." TMEP § 1202.02(d) (5th ed. 2007) (emphasis in original). Further, if a

¹¹ The cited sections cover applications based on use in commerce, on a *bona fide* intent to use, and those based on Trademark Act § 44.

¹² Trademark Rule 2.37 has since been amended to explicitly require a description of the mark in any application in which "the mark is not in standard characters." 73 Fed. Reg. 13,780 (March 14, 2008) (effective for any application filed on or after May 13, 2008).

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description of the mark is placed in the record, it must "state[s] accurately what the mark comprises, and not create a misleading impression by either positive statement or omission of facts." TMEP § 808.02 (5th ed. 2007).

Applicant describes its mark as follows:

The mark consists of a three dimensional configuration of a cardboard packaging for holding teabags filled with tea, and consists of a tetrahedron with a string protruding from one apex and holding a cloudlike label at its end.

From applicant's drawing, considered in light of the description of its mark, we conclude that applicant claims as its trademark the configuration or shape of a cardboard package or box for teabags. The box is in the shape of a three-sided pyramid with a string affixed to its apex, and to which a label is affixed. The string and label are part of applicant's mark, although applicant has disclaimed the exclusive right to use such features.

The descriptions of the marks in opposer's two registrations differ. The '940 Registration indicates that the depicted configuration is of a "three-dimensional triangle-shaped tea bag," with a string reminiscent of a "tea leaf vine" ending with a tea leaf. The mark in opposer's '093 Registration is described pyramidal "packaging for a product," again, with a string emerging from its apex, surmounted with a leaf. (The '093

description does not say that the appendage is in the shape of a tea vine and tea leaf, although it does not exclude that possibility, either.)

3. Comparison of the Marks

As noted, the drawings of the marks are quite similar. Both of opposer's drawings and applicant's depict a pyramidal object with a string attached to or emerging from its apex, terminating in a cloud-shaped label or a leaf shape. Opposer describes the mark in the '940 Registration as being the shape of a tea bag, while the mark in its '093 Registration is the shape of packaging for some product. And similar to the '093 Registration, applicant's mark is described as "packaging for holding teabags."

We find that the overall commercial impression of applicant's mark and the mark in opposer's '093 Registration would likely be substantially similar. As discussed, the drawings are similar, and the marks are both described as used on packaging. The similarity of the mark in opposer's '940 Registration to applicant's mark is less certain. Again, the marks are undeniably in the same general shape and otherwise similar, but it is less clear — and there is no argument or evidence bearing on the question — whether consumers would be likely to see the shape of opposer's teabag mark and the shape of applicant's

packaging mark as the same or similar trademarks.

Nonetheless, it seems likely to us that consumers would view as similar the presumptively distinctive shape of a package with the same shape used as a trademark on something which might be packaged therein. The degree to which customers are likely to see those marks as similar in a trademark sense (*i.e.*, similarity as an indication that they share a common source) may depend on evidence which is not in this record – such as how distinctive (unique) the shape is – but we conclude that they are likely to consider the marks at least somewhat similar.

The similarity of the marks thus favors a finding of likelihood of confusion.

B. The Similarity or Dissimilarity and Nature of the Goods and Trade Channels

Opposer asserts that its goods and those of applicant are identical or nearly so, both being essentially teabags or tea,¹³ and the ensuing presumption that the goods move in the same channels of trade, *id.* at 11-12. As will be seen, the record does not support opposer's contention.

¹³ Opp. Br. at 4 ("Peter Hewitt, founder of Tea Forte, Inc., ... first developed the pyramidal-shaped tea bag (also called an 'infuser') on September 7, 2000."); *id.* at 10-11 ("There is no dispute that the underlying goods for the [a]pplicant's packaging is tea and related products." (under the heading "Applicant's and Opposer's Goods are Identical"))).

In determining applicant's right to register in view of opposer's registrations, we are constrained to consider the goods *as they are set out in the respective application and registrations*, because those are the goods for which applicant seeks registration, and the goods which define the scope of opposer's registrations.¹⁴ *E.g., Octocom Sys. Inc. v. Houston Computers Svcs. 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 set forth in the application *regardless of what the record may reveal as to the particular nature of an applicant's goods....*" (emphasis added)); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1646 (TTAB 2008) (applicant may not restrict by extrinsic evidence the goods set out in a prior registration (citing *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986))). Thus, when we consider the likelihood of confusion between an applied-for mark and registrations, the relevant goods for comparison are those identified in

¹⁴ Had opposer properly submitted evidence establishing its prior use of the marks, we would also consider any goods in connection with which opposer proved such use. But because opposer has not submitted any competent evidence of use, we are limited to a determination of applicant's right to register vis-à-vis the marks and goods set out in opposer's registrations only.

the application and registrations, even if evidence shows that the parties' actual goods are different than those which are identified.

As will be seen, this record leaves much to be desired by way of explanation of the involved goods and how they relate to the parties' marks. We have done our best to understand this record, but it is opposer who bears the burden of proof in this case. And to the extent that the evidence is unclear or there are gaps in the record, the fault lies solely with opposer.

1. Applicant's Goods

Opposer seems to misconstrue the nature of applicant's goods. In arguing that "Applicant's and Opposer's Goods are Identical," Opp. Br. at 10, or related, *id.* at 11, opposer notes that "the underlying goods for the [a]pplicant's packaging is [sic] tea and related products." Opp. Br. at 11. To the contrary, the goods identified in the subject application are not tea, tea bags, or tea infusers. Rather, applicant's goods are "bags for packaging made of paper or plastic materials, not included in other classes."

Opposer refers to applicant's description of its *mark*, arguing that "[a]pplicant's packaging is for use with 'holding teabags filled with tea.'" Opp. Br. at 11.

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Because the purpose of applicant's packaging is not stated in its identification of goods, we agree that such packaging includes packaging for teabags, although applicant's goods are not limited to that use.¹⁵

Finally, we note that applicant's goods are classified in International Class 16, which includes goods made of paper or cardboard. TMEP § 1401.02(a). This is consistent with applicant's description of the goods as "bags for packaging..." or "cardboard packaging..." although Class 16 would clearly be inappropriate for food such as tea, tea bags, or (as we will see) tea infusers.

Thus, we agree with opposer that applicant's goods could be read as packaging for tea bags. But it is quite clear from this record that applicant's goods do not include tea, tea bags, or tea infusers.¹⁶

¹⁵ We also believe that opposer's construction of applicant's goods is likely to be closest to opposer's goods. Accordingly, while applicant's goods are not limited to bags for packaging teabags, we will concentrate on that subset of applicant's goods.

¹⁶ The file of the subject application indicates that as originally filed, it included "medical tea" in International Class 5 and "tea" in International Class 30. Those goods were ultimately deleted, apparently to avoid a refusal to register in view of a third-party registration for a mark comprising a pyramid-shaped tea bag and covering various teas. The refusal was directed to applicant's Class 5 and 30 goods only, and applicant's mark was approved for publication only after deletion of "tea" and "medical tea." This course of action suggests that applicant clearly did not intend the application (as it now stands) to include any kind of tea, nor did the examining attorney construe it to include tea or tea bags.

2. Opposer's Goods

Opposer's goods are identified as "tea infusers not of precious metal" (both registrations) and "tea infusers" ('093 Registration), both in International Class 21. In its brief, opposer apparently operates under the premise that the identified tea infusers are the same as tea bags. Opp. Br. at 4. They are not.

A *tea infuser* is a utensil used for holding loose tea while preparing a tea beverage for drinking. Typically made of mesh or perforated material, and often with a handle, chain, or similar appendage, the infuser allows the tea to come into contact with the water to steep until the beverage reaches the desired strength, when the infuser can be removed from the water using the handle or chain, and reused. We take notice¹⁷ of the following definitions:

Infuse To steep or soak herbs, spices, or vegetables in liquid to extract their flavor and transfer it to the liquid; the solids are then strained out; a tea infuser is a small perforated ball for that purpose.

Elizabeth Riely, A CULINARY DICTIONARY—THE CHEF'S COMPANION, 146 (3d ed. 2003);

infuser (ɪnˈfjuːzə)

— n

any device used to make an infusion, esp a tea maker

¹⁷ See Fed. R. Evid. 201(b).

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COLLINS ENGLISH DICTIONARY—COMPLETE & UNABRIDGED (10th ed. 2009)

(<http://dictionary.reference.com/browse/infuser?o=100074>

(accessed Sept. 15, 2012));

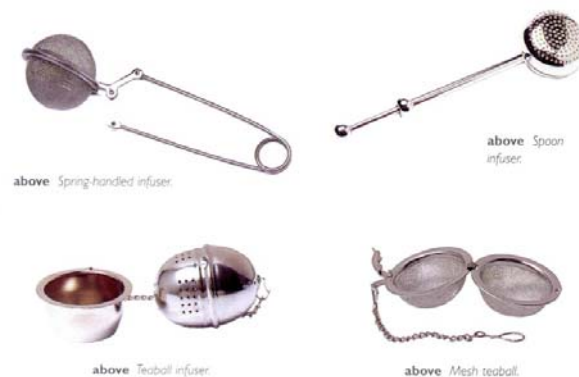
infuser A small perforated closed container which allows boiling water to come into contact with tea, herbs, spices, etc. thus extracting flavor from the solid

Charles G. Sinclair, INTERNATIONAL DICTIONARY OF FOOD & COOKING, 271 (1998).

TEA BALL or **TEA INFUSER**, also called Steeper, is a small, perforated metal ball of two halves that snap together for holding tea leaves to be steeped in hot water.

Barbara Ann Kipfer, THE CULINARIAN: A KITCHEN DESK REFERENCE, 552 (2011).

Tea infusers come in a variety of styles; the following image shows a few examples, which we include for illustrative purposes only:



Jane Pettigrew, THE TEA COMPANION (2004).

As noted above, opposer has made of record a patent

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issued to it for the design of a tea infuser. One of the drawings of opposer's patented infuser is reproduced below:



Patent No. D613114S (issued Apr. 6, 2010), fig. 8 ("FIG. 8 is an exploded view of the tea infuser of this invention").

Finally, we note that opposer has properly classified its tea infusers in International Class 21. Class 21 ("Housewares and Glass") "includes mainly small, hand-operated utensils and apparatus for household and kitchen use...." See TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP"), § 1401.02(a) (8th ed. 2011). Further, both "tea infusers" and "tea infusers not of precious metals" appear in the USPTO's online ACCEPTABLE IDENTIFICATION OF GOODS AND SERVICES MANUAL ("ID Manual") (<http://tess2.uspto.gov/netathtml/tidm.html>), in Class 21, as acceptable without further qualification.

While it is also used to prepare tea, a *tea bag* differs from a tea infuser. We take note of the following definitions:

tea bag

noun

a container of thin paper or cloth holding a measured amount of tea leaves for making an individual serving of tea.

RANDOM HOUSE DICTIONARY (2012) (<http://dictionary.reference.com/browse/tea+bag?s=t> (visited Sept. 17, 2012)).

tea bag

— n

a small bag of paper or cloth containing tea leaves, infused in boiling water to make tea

COLLINS ENGLISH DICTIONARY—COMPLETE & UNABRIDGED (10th ed. 2009) (<http://dictionary.reference.com/browse/tea+bag?s=t> (visited Sept. 17, 2012)). In other words, a teabag is a small packet made of filter paper (or similar material) prefilled with tea, so that it may be steeped in water to prepare a tea beverage. The tea bag is usually made in an individual serving size and usually includes an attached string so that it may be easily removed when the beverage reaches the desired strength.

Unlike opposer's tea infusers, tea bags are properly classified in International Class 30 ("Staple Foods"). See ID Manual. Class 30 includes "[c]offee, tea, cocoa," and a variety of other food items. TMEP § 1401.02(a). Notably, Class 30 does not include tea infusers or any other items

of kitchenware, nor does it include packaging of any kind.¹⁸ At least for purposes of trademark registration, "tea bags" are not kitchen utensils for preparing tea, but rather items of food, *i.e.*, tea packaged in ready-to-use portions. So although either can be used in tea preparation, a tea bag and a tea infuser are not the same thing; a tea infuser is a reusable utensil which can be filled with tea, but cannot make tea by itself, while a tea bag is a portion of tea sold in a disposable packet for preparing a beverage.¹⁹ And the identified goods in opposer's pleaded registrations are clearly tea infusers, not tea bags.

3. Opposer's '940 Registration

While we are convinced that this construction of opposer's identified goods is correct, we frankly admit

¹⁸ Although called a tea bag, the identification and classification of tea bags in Class 30 (rather than in Class 16 with paper bags) rests on the premise that the purchaser of a tea bag is buying tea, not bags – although both are clearly involved in the transaction. In fact, containers which are sold filled with their intended contents are universally classified and identified with reference to the contents, not the container. For instance, an identification reading "cans of soda" would be treated as a soft drink (Class 32), rather than a metal can (Class 6). While the ID Manual includes many examples of containers, when the container itself is identified, it will usually indicate that the container is "sold empty," *e.g.*, "metal cans for beverages, sold empty." "Tea bags" are therefore classified and considered as tea, not bags for ID and classification purposes, and for determining likelihood of confusion with other marks.

¹⁹ Opposer's seeming confusion on this issue is all the more puzzling, as opposer has clearly applied for both tea infusers in Class 21 and tea and tea bags in Class 30 in its pending applications.

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that it raises a serious problem. Recall that opposer argued that applicant's "bags for packaging made of paper or plastic materials" should be construed in conjunction with the description of applicant's mark, which indicates that the mark is the "configuration of ... packaging for holding teabags filled with tea...." We agreed with opposer, to the extent that the description of applicant's mark does indicate one possible purpose for applicant's identified packaging, and is therefore consistent with the identification of goods.

By contrast, the description of the mark in opposer's '940 Registration is plainly inconsistent with its identified goods. Although this registration covers "tea *infusers* not of precious metal," the description of the registered mark indicates that "the mark consists of the ... trade dress for a tea bag product comprising a three-dimensional triangle-shaped *tea bag*." But as we have discussed, tea infusers are not tea bags, and vice versa. Thus, although the registration indicates that the *mark* is the configuration of a tea bag, the identified *goods* are not tea bags, but tea infusers. We do not understand – and opposer has not explained – how a tea bag serves as a trademark for tea infusers. Unlike the subject application, in which the description of the mark refers to

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one of the possible uses for the identified packaging, the description of the mark and the identification of goods in opposer's '940 Registration appear to be irreconcilable, at least on this record.

Opposer bears the burden of proving by a preponderance of the evidence that the mark in the subject application is likely to cause confusion with the marks in opposer's registrations. *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008). Clearly, an appropriate comparison of the relevant goods and marks is crucial to a likelihood of confusion analysis, although it is impossible to do so when the mark, the goods, or both, are unclear on the record presented.

Given the uncertainties inherent in the '940 Registration, we are unable to find that opposer has met its burden to demonstrate a likelihood of confusion with respect to that registration.

Opposer's '093 Registration fares better in this regard. That registration is also for "tea infusers," but the description indicates that the mark is "the ... trade dress of the packaging for a product...." Because the packaging which comprises the mark could include packaging for tea infusers, there is no discrepancy between the identification of the goods and the description of the mark

in this registration. We will therefore focus on whether confusion is likely with respect to opposer's '093 Registration.

4. Comparison of the Goods; Customers and Channels of Trade

We compare, finally, the goods set out in the subject application to those in the '093 Registration. The goods in the '093 Registration are "tea infusers," and "tea infusers not of precious metals" (we refer to both as "tea infusers"), while applicant's goods are bags for packaging including, as opposer urges, bags for packaging tea bags. But while opposer equates packaging for tea bags with "tea and related products," Opp. Br. at 11, the record does not support that leap. For one thing, these goods are very different and serve different purposes. Opposer's tea infusers would be used by a consumer to make tea, while the purpose of applicant's packaging would be to pack teabags for shipment or sale. One seeking an implement with which to make tea would not look for or purchase something in which a teabag is packaged, and one needing packaging for tea bags would not consider a tea infuser for that purpose.

Given our findings as to the parties' respective goods, it is apparent that the customers for them are likely to be different. Opposer's tea infusers are likely

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to be purchased by ordinary consumers who enjoy drinking or making tea. By contrast, applicant's *packaging* for tea bags would not likely be purchased by consumers (the purchasers of tea infusers), but by manufacturers or purveyors of tea bags who themselves package teabags for shipment or sale. While it is true that one who buys a package of tea bags also receives the packaging, the goods at issue in that transaction are the tea, not the packaging the teabags come in.

It is axiomatic that unless expressly restricted, goods are presumed to move in all channels of trade normal for such items, and that they are purchased by all of the usual consumers for such goods. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958)). But because applicant's and opposer's goods are not identical, we cannot presume that their trade channels are identical. In fact, although neither applicant's nor opposer's goods are restricted in their channels of trade, we find that the normal channels of trade for their respective goods are different, and do not overlap.

Although opposer has not submitted any evidence as to the usual channels of trade for its tea infusers, it is well-known that such items can be purchased in a variety of

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retail outlets, such as specialty stores selling houseware, kitchenware, or tea, department stores, and even well-stocked grocery stores. On the other hand, we know little about the normal channels of trade for packaging for teabags,²⁰ and opposer has supplied no evidence or argument on this point. We are unaware whether packaging for teabags is sold in the same channels of trade as opposer's tea infusers, or in any retail outlets at all. Rather, the nature of such goods suggests that applicant's packaging would be purchased by teabag manufacturers – or possibly retailers – wholesale from either the packaging manufacturers or those who supply tea bag manufacturers or teabag retailers. There is no evidence – and we are not

²⁰ We must assume here that applicant's packaging is sold empty for use by others, because applicant's use of its mark on packaging for its own goods would not constitute use of its trademark on the identified goods. When goods are sold in a package, the customer is not normally buying the packaging, but what is *in* the package. In other words, if applicant's packaging is sold full of tea bags, its goods would not be considered "packaging" in Class 16, but "tea" or "tea bags" in Class 30. Once the packaging is applied to the goods, transfer of the packaging becomes incidental to the sale of the packaged goods, and the packaging is not considered to be separate goods in trade for which a trademark registration can be granted. See *In re MGA Entm't Inc.*, 84 USPQ2d 1743, 1745-47 (TTAB 2007) (trapezoidal box for applicant's goods not considered goods in trade).

Opposer has not raised as a ground for opposition the issue of whether applicant has a *bona fide* intent to use the mark on the packaging itself (*i.e.*, apart from any use on packages containing tea or other items), or whether applicant's intended use on packaging will be incidental to applicant's sale of other items, such as tea. In the absence of such a claim, we must assume that applicant intends to make proper use of its mark in commerce, that is, by selling its packaging empty.

aware – that ordinary consumers would normally purchase “bags for packaging [teabags].”

In summary, we find that opposer’s tea infusers differ significantly from applicant’s packaging for teabags. One is a kitchen utensil, while the other is an enclosure or wrapping for other items. Tea infusers are used to prepare tea, while packaging would be used to wrap or package teabags for shipment or sale. Opposer’s goods would be sold to consumers, while applicant’s goods are likely to be sold to those who manufacture and package tea bags or possibly to retailers. Thus the parties’ goods differ significantly, and both the customers and channels of trade for the goods differ. This factor supports a finding of no likelihood of confusion.

C. Conditions of Sale

Opposer contends that its goods and those of applicant are both “likely to be ‘impulse’ buys rather than careful, sophisticated purchases,” thus increasing the likelihood of confusion. Opp. Br. at 12-13.

Opposer has not submitted any evidence supporting this theory, such as a range of prices for the identified goods or any other evidence of market conditions. Nonetheless, we think it likely that the universe of tea infusers includes some relatively low-cost items. On the other

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hand, we are unaware of the cost of applicant's bags for packaging (tea bags). While they are likely to be individually inexpensive (tea bags are relatively inexpensive, which generally limits the cost of their packaging), if they are purchased by teabag manufacturers or shippers, they are probably purchased in bulk quantities at greater expense, and even if they are inexpensive, someone packaging tea bags is likely to take care in their purchase to make sure that such packaging is suitable for the task.

Thus, although opposer's goods are likely to be relatively inexpensive, because of the lack of evidence regarding applicant's goods, we are unable to conclude that this factor weighs in opposer's favor, and we treat it as neutral.

D. Fame of the Prior Mark

Opposer argues that its marks are well-known. Opp. Br. at 13-14. Evidence of the fame of a prior mark is entitled to "a dominant role" in our analysis. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (internal quotations and citations omitted). In considering fame, we look to the sales, advertising, and length of use of the senior mark. *du Pont*, 177 USPQ at 567; *Packard Press Inc. v. Hewlett-*

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Packard Co., 227 F.3d 1352, 56 USPQ2d 1351, 1356 (Fed. Cir. 2000).

In this case, opposer has submitted no competent evidence of its sales or length of use. Opposer has made of evidence a number of articles or promotional features depicting its goods (usually along with a number of other goods). But in the absence of any other information, we can conclude from them only that the public has been exposed to opposer's mark. It is not possible to determine the length or effect of that exposure on this record, and we can give no weight to counsel's unsupported argument. On this limited record, we are unable to tell whether opposer's mark has achieved any significant level of renown.

Because of the dominant role a finding of fame plays in a likelihood of confusion analysis, "it is the duty of the party asserting that its mark is famous to clearly prove it." *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009). Opposer has not done so, and we consider this factor neutral.

E. Balancing the Factors

We have found that the mark in opposer's '093 Registration is substantially similar to applicant's mark. The relationship of opposer's tea infusers to applicant's

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bags for packaging, however, is considerably more tenuous. Although both are potentially related to tea in some fashion, there are substantial differences in the uses and function of such goods and the likely customers and channels of trade for them. Opposer has failed to address these issues in its brief, and has presented little evidence relevant to any of the other *du Pont* factors.

On balance, we cannot find that opposer has carried its burden to show that registration of applicant's mark would lead to a likelihood of confusion. Similarity of the marks alone is not enough.

V. Remand of Application

As will be obvious by now, a considerable difficulty in this proceeding has been the determination of just what marks and goods are at issue. Applicant's current identification of goods – "bags for packaging made of paper or plastic materials" – is very broad. However, it appears from the description of applicant's mark that applicant may in fact intend to use the mark on only a narrow subset of those goods, namely, "cardboard packaging for holding teabags filled with tea." If applicant in fact intends to apply its mark only to a specific type of packaging for specific purposes (as it appears from the description of the mark), the examining attorney should consider requiring

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a limitation or clarification of the identification of goods.²¹ Depending on whether the goods are amended, it may also be appropriate to amend the description of the mark. Other issues may have to wait until after submission of a statement of use.²²

Accordingly, we remand this application to the trademark examining attorney to determine whether any limitation of applicant's identified goods is appropriate. Trademark Rule 2.131.

²¹ Again, our assumption is that applicant intends to sell its packaging empty, and it may be appropriate to explicitly state that fact in the identification of goods.

²² Another issue suggested by the facts of record is whether applicant's "bags for packaging" are goods in trade, or are merely incidental to applicant's sale of other goods. See *supra* n.20. Because this issue usually depends on the manner in which applicant uses its mark, it is generally not considered an appropriate refusal for an intent-to-use application until an allegation of use has been filed (or sooner, if applicant seeks to rely solely on a foreign registration as a basis). TMEP § 1202.06(c). Nonetheless, if the circumstances of this case are determined to be an exception to this general rule, the examining attorney is not precluded from exploring this topic on remand.

VI. Conclusion

We have carefully considered all of the evidence of record and opposer's argument, including that which we have not specifically discussed. For the foregoing reasons, we conclude based on this record, that registration of applicant's mark for the identified goods is not likely to cause confusion with opposer's registered marks.

Decision: The opposition is DISMISSED. The application will be remanded to the examining attorney in accordance with this decision.