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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Cloverhill Pastry-Vend, LLC

v.

10 Star Enterprises, Inc.

Opposition No. 91181131
to application Serial No. 76667126
filed on October 6, 2008

Teresa D. Tambolas of Pattishall, McAuliffe, Newbury,
Hilliard & Geraldson LLP for Cloverhill Pastry-Vend LLC.

William D. Hall, Esq. for 10 Star Enterprises, Inc.

Before Zervas, Bergsman and Shaw,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

10 Star Enterprises, Inc. ("applicant") filed an
intent-to-use application for the mark TEXAS BIG BITES, in
standard character form, for "organic pastries," in Class
30. Applicant disclaimed the exclusive right to use the
word "Texas."

Cloverhill Pastry-Vend Corporation¹ ("opposer") filed a notice of opposition against the registration of applicant's mark on the ground of priority of use and likelihood of confusion pursuant to Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), and on the ground that applicant did not have a *bona fide* intent to use its mark at the time it filed the application. Opposer alleged ownership of the following three registrations:

1. Registration No. 2235589 for the mark BIG TEXAS, in typed drawing form, for danish and puffed pastry, in Class 30;²

2. Registration No. 3271078 for the mark BIG TEXAS BUTTERKRUNCH, in standard character form, for "bakery products, namely, sweet bakery goods," in Class 30.³ Opposer disclaimed the exclusive right to use the word "Butterkrunch"; and

3. Registration No. 3475697 for the mark BIG TEXAS, in standard character form, for "bakery products, namely sweet bakery goods," in Class 30.⁴

¹ During the prosecution of this proceeding, Cloverhill Pastry-Vend Corporation merged into Cloverhill Pastry-Vend LLC. The merger was recorded in the Assignment Section of the USPTO on October 13, 2009, at reel 4077, frame 0804. In view thereof, Cloverhill Pastry-Vend LLC is substituted as the opposer.

² Issued March 30, 1999; renewed.

³ Issued July 31, 2007.

⁴ Issued July 29, 2008.

Opposer alleged that applicant's use of the mark TEXAS BIG BITES for "organic pastry" so resembles opposer's registered marks as to be likely to cause confusion.

Applicant denied the essential allegations in the notice of opposition.

The Record

By rule, the record includes applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b). In addition, the parties introduced the following testimony and evidence:

A. Opposer's evidence.

1. Notice of reliance on the following items:
 - a. Photocopies of opposer's pleaded registrations printed from the electronic database records of the USPTO showing their current status and title;
 - b. Excerpts from printed publications; and
 - c. Applicant's responses to opposer's written discovery; and
2. Testimony deposition of Michael C. Wolnik, an employee of opposer responsible for accounting, finance, information technology and legal matters, with attached exhibits.

B. Applicant's evidence.⁵

1. Notice of reliance on copies of three third-party registrations;
2. Notice of reliance on opposer's responses to applicant's written discovery; and
3. Notice of reliance on the following items:
 - a. A Department of Agriculture publication regarding "Organic Labeling and Marketing Information";
 - b. An excerpt from the Code of Federal Regulations defining "organic" products; and
 - c. A Department of Agriculture publication regarding the guidelines for enforcement actions against misidentifying products as organic.

Standing

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

⁵ Although applicant did not caption its evidence as notices of reliance, they are in effect notices of reliance.

Priority

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and the goods covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the 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. The similarity or dissimilarity and nature of the goods at issue, likely-to-continue channels of trade and classes of consumers.

Opposer's Registration No. 3475697 for the mark BIG TEXAS and Registration No. 3271078 for the mark BIG TEXAS

BUTTERKRUNCH are registered for "bakery products, namely, sweet bakery goods." Opposer's Registration No. 2235589 for the mark BIG TEXAS is registered for danish and puffed pastry. Applicant is seeking to register its mark TEXAS BIG BITES for "organic pastries." Mr. Wolnik, opposer's witness, testified that "organic pastries" are "sweet bakery goods."⁶

Moreover, because the description of goods in opposer's registrations and applicant's description of goods are unrestricted as to their nature, type, channels of trade or classes of consumers, we must presume that the scope of applicant's goods encompasses all goods of the nature and type described, that the goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential consumers. *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1073 (TTAB 2011). See also *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1992). Thus, where as here, the identifications of goods are broadly constructed, we must allow for all possible items that may fall within the identifications. In this regard, we find that "sweet bakery goods," as well as danish and puffed pastry, are broad enough to encompass "organic pastries." In other words, "sweet bakery goods," danish and

⁶ Wolnik Dep., p. 45.

puffed pastry may include organic pastries and organic pastries may include danish, puffed pastries and "sweet bakery goods." Under these circumstances, we find that the goods at issue are legally identical.

Because the goods described in the application and opposer's registrations are legally identical, we must presume that the channels of trade and classes of purchasers are the same. *See Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

In view of the foregoing, applicant's argument that the goods at issue are different because applicant's organic pastries are different than opposer's non-organic sweet bakery goods, danish and puffed pastries is not persuasive.⁷ We find that the goods are legally identical, and therefore

⁷ Applicant's Brief, pp. 5-6.

they are presumed to move in the same channels of trade and are sold to the same classes of consumers.

B. The strength of opposer's marks.

Applicant argues that "[t]he words Big Texas are merely descriptive of a State" and opposer has failed to show that its marks have acquired secondary meaning.⁸ Because applicant may not attack the validity of opposer's pleaded registrations absent a counterclaim to cancel those registrations, we construe applicant's argument as asserting that opposer's marks are weak and entitled to only a narrow scope of protection. Trademark Rule 2.106(b)(ii), 37 CFR § 2.16(b)(ii). First, opposer's pleaded registrations are entitled to the presumptions of Section 7(b) of the Trademark Act of 1946, 37 U.S.C. § 1057(b) (a certificate of registration is *prima facie* evidence of the validity of the registered mark and of the registration of the mark). Because opposer's marks are registered on the Principal Register, we must consider them to be at least suggestive. Moreover, even if we were to agree with applicant's argument that opposer's marks are weak (which on this record we do not), even weak marks are entitled to an orbit of protection sufficiently broad to encompass the subsequent registration of similar marks for identical goods. *See Pickering &*

⁸ Applicants' Brief, pp. 4-5.

Company, Inc. v. Bose Corporation, 181 USPQ 602, 603 (TTAB 1974).

Second, opposer's BIG TEXAS products have earned marketplace renown. In 2005, 2006 and 2009, opposer's BIG TEXAS pastries were selected as the Automatic Merchandiser's Pastry of the Year and, in 2008, it was the first runner up.⁹ Furthermore, opposer's products are sold in almost all 50 states through retailers such as Sam's Clubs, grocery stores, convenience stores and vending machines.¹⁰ Finally, although opposer designated its sales figures as confidential and, therefore, we may only refer to them in general terms, opposer's sales have been substantial by any standard. Accordingly, opposer has demonstrated that its mark has acquired marketplace strength.

Applicant also introduced the following three third-party registrations owned by two entities into evidence:

1. Registration No. 2560037 for the mark BIGGEST BIG BITE for sandwiches, namely hot dogs, owned by 7-eleven, Inc.;
2. Registration No. 2780103 for the mark BIG BITE both for sandwiches, namely hot dogs, owned by 7-eleven, Inc.; and

⁹ Wolnik Dep., pp. 22-24 and Exhibits 11-14.

¹⁰ Wolnik Dep., pp. 9-10, 35 and Exhibit 18.

3. Registration No. 2624868 for the mark BIG TEX for paper and plastic cups.¹¹

First, third-party registrations are of little probative value in deciding likelihood of confusion because they do not prove that the marks are in use or that the public is familiar with them. *The Conde Naste Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 USPQ 422, 424-25, (CCPA 1975); *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d at 1110. Second, the 7-eleven "Big Bite" marks are not similar to opposer's BIG TEXAS marks. Finally, there is no evidence that paper and plastic cups identified by the BIG TEX mark are related to pastries.

C. The similarity of the marks in their entirety in terms of appearance, sound, meaning, and connotation.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*,

¹¹ Applicant did not reference Registration No. 2624868 in its brief; rather, it referenced Registration No. 1226815 for the mark BIG TEX for hamburgers. Applicant did not submit a copy of that registration during its testimony period. Because the Board does not take judicial notice of the records in the USPTO, we cannot give applicant's arguments regarding that registration any consideration. *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007).

8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*,
6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we
are mindful that where, as here, the goods are legally
identical, the degree of similarity necessary to find
likelihood of confusion need not be as great as where there
is a recognizable disparity between the goods and services.
Century 21 Real Estate Corp. v. Century Life of America,
970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real
Estate One, Inc. v. Real Estate 100 Enterprises Corporation*,
212 USPQ 957, 959 (TTAB 1981); *ECI Division of E-Systems,
Inc. v. Environmental Communications Incorporated*, 207 USPQ
443, 449 (TTAB 1980).

Moreover, in comparing the marks, the 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. *San
Fernando Electric Mfg. Co. v. JFD Electronics Components
Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons
Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741
(TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June
5, 1992). The proper focus is on the recollection of the
average customer, who retains a general rather than a
specific impression of the marks. *Winnebago Industries*,

Inc. v. Oliver & Winston, Inc., 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In this case, the average customer is a purchaser of pastries, organic or otherwise.

Opposer's marks are BIG TEXAS and BIG TEXAS BUTTERCRUNCH while applicant's mark is TEXAS BIG BITES. The marks are similar to the extent that the first two words of the marks are "Big" and "Texas." The most significant differences between the marks is that the words BIG TEXAS and TEXAS BIG are reversed and that applicant added the word "Bites" to its mark. Except for the reversal of the words "Big" and "Texas," the marks are similar in sound and appearance.

When marks comprise "reverse combinations of the same elements, the primary concern is that ordinary prospective purchasers, not being infallible in their ability to recall trade designations, may transpose the elements in their minds and, as a result, mistakenly purchase the wrong products or engage the wrong services." *In re Best Products Co. Inc.*, 231 USPQ 988, 989 (TTAB 1986). See also *In re General Tire & Rubber Co.*, 213 USPQ 870, 871 (TTAB 1982) [SPRINT STEEL RADIAL v. RADIAL SPRINT, both for tires, are similar because the transposition of the words does not change the commercial impression of the marks]; *Bank of America National Trust and Savings Association v. American*

National Bank of St. Joseph, 201 USPQ 842, 845 (TTAB 1978).

[BANKAMERICA v. AMERIBANC, both for banking services, are similar because the marks create the same commercial impression]. In other words, consumers could inadvertently transpose TEXAS BIG into BIG TEXAS (or BIG TEXAS BUTTERKRUNCH) and TEXAS BIG BITES into BIG TEXAS BITES.

Furthermore, applicant's mark and opposer's marks are presented in standard character and typed drawing form; therefore, they are not limited to any special form or style as displayed on or in connection with leather for furniture. When a mark is presented in standard character or typed drawing form, the Board must consider all manners in which a party could depict the mark. *In re Cox Enterprises Inc.*, 82 USPQ2d 1040, 1043 (TTAB 2007), *citing Phillips Petroleum Co. v. C.J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) ("we must not be misled by considering [applicant's] mark only in its printed or typewritten form, with all the characters being of equal height."). Thus, the marks of both parties could be depicted with TEXAS emphasized or applicant could emphasize TEXAS BIG as show below:

TEXAS BIG
BITES

Despite applicant's arguments to the contrary, we find that the marks convey a similar connotation and commercial impression, and that the reversal of the word elements is

not sufficient to distinguish them. Applicant argues that the marks engender different commercial impressions.

The word "Big," in Opposer's mark [sic], refers to the size of Texas. In Applicant's mark "Big" refers to the size of the "bite."

... In Applicant's mark the word "TEXAS" refers to the State of Texas, whereas the words "Texas Big", in Applicant's mark refers to the size of the "bite."¹²

* * *

The mark "BIG TEXAS" is merely stating the well known fact that Texas is big.

* * *

Applicant's mark emphasizes a big bite. (Emphasis in the original).¹³

However, we find that both marks could suggest that the pastry is large. For example, opposer's mark TEXAS BIG engenders the commercial impression that the product is as big as Texas while applicant's mark TEXAS BIG BITES engenders the commercial impression of bites as big as Texas. In both instances, the commercial impression is something as big as Texas - the largest state in the continental United States - and, therefore, the marks have a similar connotation and commercial impression.

We consider it important to point out that it is unlikely that consumers will see the products sold side-by-side where they have the opportunity to compare the marks.

¹² Applicant's Brief, p. 3.

¹³ Applicant's Brief, p. 4.

It is more likely that consumers will rely on memory and impressions in making purchasing decisions, especially for pastries. Human memories, even of discriminating purchasers who desire organic products, are not infallible. We find that it is probable that even discriminating purchasers would be likely to assume that TEXAS BIG BITES is another product of opposer because of the similarity of the marks.

Thus, although the marks have certain differences, when we compare them in their entirety, we find that on the whole they are similar in appearance, sound, connotation and commercial impression, and that the reversal of the elements in the marks and applicant's addition of the word "Bites," are not sufficient to distinguish them when used on legally identical goods. This *du Pont* factor favors a finding of likelihood of confusion.

D. Balancing the factors.

In view of the facts that the marks are similar, the goods are legally identical, and the presumption that the channels of trade and classes of consumers are the same, we find that applicant's mark TEXAS BIG BITES for "organic pastries" is likely to cause confusion with opposer's marks BIG TEXAS for danish, pastries and sweet bakery products and BIG TEXAS BUTTERKRUNCH for sweet bakery products.

Applicant's Bona Fide Intent To Use Its Mark

For purposes of completeness, we now turn to opposer's allegation that applicant did not have a *bona fide* intent to use its mark when it filed its application. The following evidence may be used to prove that applicant did not have a *bona fide* intent to use its mark:

1. Applicant has no documents disclosing its plans to sell or offer its organic pastries;¹⁴

2. Applicant has no documents disclosing its future marketing plans;¹⁵

3. Applicant has no documents disclosing where its products are "planned to be displayed, used or distributed;"¹⁶

4. Applicant does not keep records of its advertising expenditures;¹⁷

5. Applicant does not keep records of its sales;¹⁸
and

6. Applicant does not keep records of its customers;¹⁹

¹⁴ Applicant's response to opposer's request for production of documents No. 29.

¹⁵ Applicant's response to opposer's request for production of documents No. 31.

¹⁶ Applicant's response to opposer's request for production of documents No. 32.

¹⁷ Applicant's response to opposer's interrogatory No. 8.

¹⁸ Applicant's response to opposer's interrogatory Nos. 11 and 12.

¹⁹ Applicant's response to opposer's interrogatory No. 17.

On the other hand, the following evidence information may be used to prove that applicant had a *bona fide* intent to use the mark:

1. Applicant used its marks on cookies from January 21, 2001 to the present;²⁰

2. Applicant has sold its products in Maryland and Florida;²¹

3. Applicant has sold its product through personal contacts;²²

4. Applicant has advertised its product through "printed advertising sheets, (January 21, 2001 - date)";²³

5. Applicant has sold its products to coffee shops and personal customers;²⁴ and

6. Applicant's early sales of TEXAS BIG BITE cookies were made with non-organic ingredients.²⁵

Since then she has diligently and continuously looked for suitable organic ingredients. The organic ingredients were used to make cookies. She believes that after she finds a few more organic ingredients she will be satisfied. She will rely on her attorney to decide when to seek Department of Agriculture approval.²⁶

²⁰ Applicant's response to opposer's interrogatory No. 1.

²¹ Applicant's response to opposer's interrogatory No. 3.

²² Applicant's response to opposer's interrogatory No. 5.

²³ Applicant's response to opposer's interrogatory No. 6.

²⁴ Applicant's response to opposer's interrogatory No. 18.

²⁵ Applicant's supplementary response to opposer's interrogatory No. 1.

²⁶ Applicant's supplementary response to opposer's interrogatory No. 1.

Opposer argues that applicant did not introduce any evidence of its alleged *bona fide* intent to use TEXAS BIG BITES for organic pastries as evidenced by its failure to produce any documents proving that it had any such intent, including documents to support applicant's search for suitable organic ingredients.²⁷

The determination of whether an applicant has a *bona fide* intention to use the mark in commerce is to be a fair, objective determination based on all the circumstances. In that regard, applicant's mere statement of an intention to use, without more, is not sufficient to prove applicant's *bona fide* intent to use its mark in commerce. *Lane Ltd. v. Jackson Int'l Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994). In evaluating whether applicant had a *bona fide* intent to use a mark in commerce, "absent other facts which adequately explain or outweigh the failure of an applicant to have any documents supportive of or bearing upon its claimed intent to use its mark in commerce, the absence of any documentary evidence on the part of an applicant regarding such an intent is sufficient to prove that applicant lacks a *bona fide* intention to use its mark in commerce as required by Section 1(b)." *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993). In other words, the lack of documents may be sufficient to prove that

²⁷ Opposer's Brief, pp. 13-14.

applicant did not have a *bona fide* intent to use the mark in commerce, but it does not *ipso facto* prove that applicant did not have a *bona fide* intent to use the mark in commerce.

In this case, opposer failed to meet its burden of proof because opposer submitted evidence that applicant had been selling cookies, albeit not organic cookies, under its mark prior to the filing of its application, and that applicant was searching for the proper organic ingredients to use in its organic cookies. Furthermore, applicant's lack of documents could be explained by applicant's lack of sophistication with respect to starting a business. We find that the circumstances in this case indicate that applicant did, in fact, have a *bona fide* intent to use its mark.

Decision: The opposition is dismissed on the ground that applicant did not have a *bona fide* intent to use its mark in commerce.

The opposition is sustained on the ground of priority and likelihood of confusion and registration to applicant is refused.