

Goodman

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: August 20, 2009

Opposition No. **91186494**

Kraft Foods Global Brands LLC

v.

Anthony Brown

Before Hairston, Rogers and Taylor, Administrative Trademark Judges.

By the Board:

Anthony Brown, ("applicant") has filed an application to register the mark KOOL in standard character form for "non-alcoholic beverages, namely, carbonated beverages" in International Class 32.¹ Kraft Foods Global Brands LLC ("opposer") has opposed registration on the ground of priority and likelihood of confusion. In the notice of opposition, opposer has pleaded ownership of KOOL-AID and KOOL-AID formative marks as well as marks that incorporate KOOL for beverage products.²

¹ Application Serial No. 77355857, filed December 19, 2007 asserting intent to use the mark under Section 1(b) of the Trademark Act.

² Pleded registrations include the following: Registration No.

Kool-Aid
317955 for the mark for "prepared powder containing flavor, fruit acid, and color put up in a number of flavors for making nonalcoholic beverage in the home" in International Class 30; issued October 9, 1934; Section 8 accepted/Section 9 granted (fourth renewal) January 9, 2004.

In his answer, applicant denies the salient allegations in the notice of opposition.

This case now comes up on the parties' cross-motions, filed February 11, 2009 and March 18, 2009, for summary judgment on the ground of likelihood of confusion.³ The motions are fully briefed.

Applicant's evidence on summary judgment consists of the declaration of Anthony Brown and a related exhibit. Opposer's evidence on summary judgment consists of the declaration of Gregory Nesmith, Senior Brand Manager of the

The logo for KOOL-AID, featuring the words "KOOL-AID" in a bold, black, sans-serif font with a white outline, slanted slightly to the right.

Registration No. 384244 for the mark for "carbonated beverages" in International Class 32; issued January 7, 1941; Section 8 accepted/Section 9 (third renewal) granted May 16, 2001.

The logo for KoolAid, featuring the words "KoolAid" in a stylized, black, sans-serif font with a white outline, slanted slightly to the right.

Registration No. 1133277 for the mark for "powders, syrups and concentrates used in the preparation of soft drinks" in International Class 32; issued April 15, 1980; Section 9 (first renewal) granted March 31, 2000. Registration No. 2321815 for KOOL-AID for "beverages, namely, soft drinks, soft drink mixes; powders, syrups or concentrates for making soft drinks" in International Class 32; issued February 22, 2000; Section 8 accepted/Section 15 acknowledged November 26, 2005.

³ Applicant also moved (on March 16, 2009) for "default judgment" arguing that opposer failed to file a timely response. However, because opposer was allowed thirty-five days or until March 18, 2009 to file a response to applicant's motion, opposer's March 18, 2009 response is timely. Trademark Rules 2.127(e) and 2.119(a). In view thereof, applicant's motion for default judgment is denied. Additionally, to the extent that applicant has argued that opposer's motion for summary judgment should be stricken because it exceeds the page limits under Trademark Rule 2.127(e), we find that opposer's brief, which is twenty-four pages in length, complies with the Trademark Rule. Accordingly, applicant's motion to strike is denied.

KOOL-AID brand, and related exhibits, the declaration of Susan Hanaway Frohling, Chief Trademark Counsel, and related exhibits, and the declaration of J. Kevin Fee, counsel for opposer, and related exhibits.

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). In reviewing a motion for summary judgment, the evidentiary record and all reasonable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). In this case, because there are cross-motions, we view each party's motion in the light most favorable to the other party, and must determine whether, when the motions are so viewed, either party can be found entitled to judgment.

Initially, we note that applicant has not challenged opposer's standing to oppose applicant's application. Moreover, opposer has submitted copies from the Office's Tarr database and the Office's Assignment database showing current status and title of the pleaded registrations and the declaration of Susan Hanaway Frohling which declares that the pleaded registrations are owned by opposer and valid and subsisting. Therefore, there is no genuine issue

of material fact that opposer has established its standing to oppose the registration of applicant's mark. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Likewise, there is no genuine issue of material fact that priority is not an issue in this case as to those marks and goods covered by opposer's pleaded registrations in view of the submission of the TARR copies and the Frohling declaration. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Accordingly, the focus of our analysis is whether there are any genuine issues of material fact in dispute as to opposer's claim of likelihood of confusion. Such analysis involves consideration of all of the *du Pont* factors which are relevant under the present circumstances and for which there is evidence of record. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

In this case, the most important factors are the fame of opposer's marks, the similarity of the marks, the similarity of the goods, and the presumptive similarity of the trade channels/classes of consumers. In analyzing likelihood of confusion we will focus our discussion on opposer's KOOL-AID marks and goods recited in the registrations for the same.

We turn first to the factor of fame, because, when present, evidence pertaining to this factor "plays a 'dominant role' in the process of balancing the *du Pont* factors." *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *see also Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Opposer has provided evidence of fame through the declaration of Gregory Nesmith and related exhibits which applicant has not specifically disputed.⁴ Opposer has been using its KOOL-AID marks throughout the United States for over seventy-five years. Opposer has extensively promoted the KOOL-AID marks by advertising in such media as television, print, radio, billboard, newspapers, the internet and at point of sale. In the last forty years, opposer has launched eighty television campaigns involving the KOOL-AID marks. Opposer's advertising figures for the last ten years, which it has designated as confidential, support its claim of substantial advertising expenditures.⁵ In the last five years, opposer has sold in excess of \$165

⁴ The fame or strength of a mark is determined by a variety of factors, including the length of time the mark has been in use, the volume of sales under the mark and the extent of advertising or promotion of the goods or services with which the mark is used. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 394 (Fed. Cir. 1983). Opposer has provided such evidence.

⁵ Because opposer designated its advertising figures as confidential, we may only refer to them in general terms.

million worth of beverage products under the KOOL-AID marks and consumers drink over 450,000,000 gallons of KOOL-AID beverage products each year. Based on opposer's evidence, applicant's failure to show that any of the evidence should be discounted or given little weight, and the absence of any reasonable argument that such evidence is not of the type that would normally be used to establish fame, we find there is no genuine issue of material fact that opposer's KOOL-AID marks are famous as used in connection with opposer's goods.

Applicant has argued, however, that opposer's KOOL-AID mark is entitled to a limited scope of protection due to "extensive third party use" of the term KOOL. Applicant has relied, however, only on third party registrations referenced in the declaration of Anthony Brown, which is unaccompanied by copies of the registrations. The declaration, by itself, is insufficient to make the third party registrations of record. *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992) (Trademark search report "is not credible evidence of the existence of the registrations listed" and legible copies of the registrations, or the electronic equivalent of such copies from USPTO records are required); TBMP Section 528.05(d) (2d ed. 2004). Therefore, the reported registrations have not been considered.

We note, in any event, that even if applicant had properly made these third party registrations of record, they would have been insufficient to raise a genuine issue as to the strength of opposer's marks. "As to strength of a mark, however, registration evidence may not be given any weight." See *Olde Tyme Foods*, supra, 22 USPQ2d at 1544 (emphasis in original), citing *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); see also, *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007) ("[T]hird-party applications and registrations are not evidence that the marks shown therein are in use, or that the public is familiar with them."). Additionally, even if properly made of record, the referenced third party registrations would have been of little probative value as none of the goods set forth in the third party registrations are related to applicant's and opposer's goods as set forth in the application and pleaded registrations. *Mack Trucks, Inc. v. California Business News, Inc.*, 223 USPQ 164, 169 (TTAB 1984) (finding little relevance in third party registrations introduced to demonstrate weakness, when registrations covered products unrelated to the types of products for which registration was sought). Consequently, we find there is no genuine issue of material fact that opposer's KOOL-AID marks are strong marks entitled to a broad scope of protection.

Turning next to the similarity of the marks, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Nonetheless, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In cases where the applicant's goods are identical (in part) to the opposer's goods, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applicant has argued that the parties' marks are dissimilar because applicant "utilizes only one word, 'Kool'" while opposer "uses the word 'Kool' but incorporates it with the additional word 'Aid', making it a compound word trademark." It is applicant's contention that the addition of the term 'AID' gives opposer's mark a "distinct commercial meaning" and connotation. Opposer, on the other hand, argues that KOOL is the "dominant portion" of

opposer's KOOL-AID marks and that applicant has applied for a mark with "a term identical in sight, sound and meaning to the common and dominant component of the KOOL-AID marks."

Opposer submits that "[c]onsumers are accustomed to seeing KOOL, the common and dominant segment of all KOOL-AID marks, combined with numerous other terms." In this regard, opposer has put in the record evidence of its use and registration of not just KOOL-AID, but its use and registration of marks such as KOOL POINTS, KOOL POPS and KOOLSPACE.

In this case, we find there is no genuine issue of material fact that the marks are similar in appearance and sound to the extent that they both contain the term KOOL and use the letter K to spell KOOL but dissimilar to the extent that opposer's marks contain the additional term AID. As opposer notes, KOOL is the first term purchasers will encounter when seeing or hearing opposer's KOOL-AID marks and the term KOOL is likely to make an impression or be remembered by purchasers when they encounter applicant's KOOL mark on very similar goods at a different time. *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988).

Although applicant points to the standard character form of its KOOL mark as a basis for distinguishing the appearance of the parties' marks, this fact is insufficient

to raise a genuine issue as to the similarity of the marks. In standard character form, applicant would be entitled to display his mark in a variety of lettering styles, including a style the same as or similar to those of the various presentations of the KOOL-AID mark in opposer's pleaded registrations. See *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971) (in comparing the parties' marks for purposes of likelihood of confusion, all reasonable forms of display for applicant's typed mark are to be considered). Displayed in such a manner, applicant's mark would appear to consumers to be merely a shortened version of opposer's mark. Additionally, applicant's arguments regarding opposer's use in the marketplace of the "Kool-Aid Man" pitcher character in connection with opposer's KOOL-AID marks is insufficient to raise a genuine issue because opposer's display of its marks in actual use is irrelevant to the likelihood of confusion analysis which must focus on the marks as they appear in the application and pleaded registrations. See *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2 (CCPA 1977) ("Opposer's rights are not to be tied into its current business practices, which may change at any time. Its rights are as broad as its registration.").

While the presence of the term AID in KOOL-AID arguably results in a different connotation for that mark, when compared to applicant's mark, we find that when considered in their entirety, there is no genuine issue of material fact that when viewed as a whole, the marks are more similar than dissimilar.⁶ See e.g., *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283 (TTAB 2007) (BARB'S BUNS BAKERY, INC. AND BARBARA'S BAKERY considered similar in overall commercial impression, despite differences between marks); *AVA Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783 (TTAB 2006) (finding AUDIO BSS USA and BOSS AUDIO SYSTEMS have the same commercial impressions despite differences between the marks).

With regard to connotation, applicant argues that his mark connotes "being hip and in style" while opposer's mark connotes "aiding the consumer to lower ones[sic] temperature and goes toward the refreshing aspect of the beverage." However, "applicant's intended interpretation of the mark is not necessarily the same as the consumer's perception of it." *In re Yale Sportswear Corp.*, 88 USPQ2d 1121, 1125 (TTAB 2008). There is nothing in the record which indicates that a consumer's perception of opposer's marks could not

⁶ See *Plus Products v. Brown*, 221 USPQ 1015, 1018 (TTAB 1984) (term ADE is suggestive or descriptive in connection with beverage; one common meaning of ADE is a noun suffix indicating a fruit drink).

include the impression that opposer's mark connotes a "hip" beverage or that applicant's mark connotes a refreshing beverage.

Accordingly, we find there is no genuine issue of material fact that applicant's mark is substantially similar to opposer's pleaded KOOL-AID marks in terms of appearance, sound, connotation and commercial impression. See e.g., *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (Application to register mark CONFIRM refused because mark confusingly similar with prior registered mark CONFIRMCELLS for related goods).

With respect to the relatedness of the parties' goods, applicant argues that the goods are different because his goods are a pre-mixed "Jamaican flavored carbonated beverage" while opposer sells "a sugar-based powdered drink mix and a pre-mixed sugar based drink in a pouch." However, the Board has long held that drink concentrates, mixes and syrups and soft drinks, whether carbonated or uncarbonated, are related goods because they are ultimately consumed as a beverage and purchased with this in mind. See e.g., *Plus Products, supra*, 221 USPQ at 1017 and cases cited therein (finding drink additive and mixes and soft drinks related). We note too that opposer's pleaded KOOL-AID Registration No. 384244 is for "carbonated soft drinks" and therefore, the parties' goods are not only highly related but are legally

identical. Lastly, with respect to applicant's argument that his "Jamaican flavored" drink is distinguishable from opposer's goods because opposer's drinks are not "Jamaican flavored," neither goods of the parties are so limited, and it is well established that likelihood of confusion must be evaluated on the basis of such descriptions and not actual product usage at a given time. *Octocom Systems, Inc. v. Houston Computers Services 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, the particular channels of trade or the class of purchasers to which the sales of goods are directed"); *see also The Seven-Up Company v. Aaron*, 216 USPQ 807, 810 (TTAB 1982).

Thus, we find there is no genuine issue of material fact that applicant's application and opposer's KOOL-AID registrations encompass identical or highly related goods.

Turning next to the channels of trade/classes of consumers, applicant appears to argue that there is little overlap between the parties' channels of trade/classes of consumers because opposer markets its goods "primarily to children" and advertises through television commercials and print advertising directed at children and teenagers while

applicant intends to market his goods to "children with a Jamaican heritage" but also "non-Jamaicans, teenagers and adults" and to use print advertisements in newspapers targeted at Jamaican communities and advertisements in magazines related to health and nutrition.

However, there are no specific limitations in either applicant's application or opposer's registrations. In the absence of such limitations, we must presume that the goods at issue will travel in all normal and usual channels of trade and methods of distribution and be sold to all classes of consumers, which in this case is the general public. *Squirtco v. Tomy Corp.* 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983). We note too that even if we were to assume that applicant's goods were directed to the Jamaican community in the United States or individuals interested in health or nutrition, there would still be no genuine issue of material fact that the classes of consumers overlap because opposer's goods are marketed and sold to the general public which includes the Jamaican community and those interested in health and nutrition.

Therefore, we find there is no genuine issue of material fact that the parties' channels of trade and classes of consumers are legally identical.

Lastly, applicant's arguments regarding the lack of actual confusion do not mean that confusion is less likely,

as evidence of actual confusion is not a prerequisite for finding likelihood of confusion. *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1756 (TTAB 2009) (citation omitted) (the "test is likelihood of confusion and the absence of evidence of actual confusion alone is not particularly probative"); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1027 (TTAB 2009) ("absence [of evidence of actual confusion] does not necessarily overcome a finding of likelihood of confusion"). We note that the assertion of a lack of actual confusion is particularly ineffective to raise a genuine issue when the application is based on an intent to use, there is no evidence of the extent of applicant's actual use, and the assertion of no actual confusion is simply that--as there has been no real opportunity for confusion. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992) ("absence of any reported instances of actual confusion would be meaningful only if the record indicated appreciable and continuous use by applicant of its mark for a significant period of time in the same markets as those served by opposer under its marks").

Also, applicant essentially argues that he adopted his mark in good faith and without any intent to trade on the good will of opposer.⁷ While we draw an inference in

⁷ The declaration of Anthony Brown declares that he planned "not to infringe on the rights of the opposer or anyone else" and that he "performed a trademark search before filing his intent to use

applicant's favor on this issue, evidence of good faith adoption typically does not aid an applicant attempting to establish no likelihood of confusion. *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991).

It is a well-established principle that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril, and any doubt as to likelihood of confusion must be resolved against the newcomer and in favor of the prior user or registrant, especially where the established mark is one which is famous. The Federal Circuit has stated repeatedly that there is no excuse for even approaching the well-known trademark of a competitor inasmuch as "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys, Inc.*, 22 USPQ2d at 1456 (citing *Nina Ricci S.A.R.L. v. E. T. F. Enters.*, 889 F.2d 1070, 1074, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989)).

In summary, we find that opposer has carried its burden of proof and that no genuine issues of material fact remain as to opposer's standing, as to the absence of priority as an issue, or as to likelihood of confusion. In view thereof, opposer's motion for summary judgment is

application and found no prior use of 'Kool' for carbonated drinks." Paragraphs 16 and 17, declaration of Anthony Brown.

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granted, and applicant's motion for summary judgment is denied.

Judgment is hereby entered against applicant, the opposition sustained, and registration of applicant's mark is refused.