

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: May 17, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Inter-IKEA Systems B.V.

v.

Arsen Manasyan

Opposition No. 91194783
to Application Serial No. 77816273

Richard Lehv of Fross Zelnick Lehman and Zissu PC, for
Inter-IKEA Systems B.V.

Christopher J. Day of Law Office of Christopher Day, for
Arsen Manasyan.

Before Bucher, Taylor, and Ritchie, Administrative Trademark
Judges.

Opinion by Ritchie, Administrative Trademark Judge:

On August 31, 2009, Arsen Manasyan ("applicant")
applied to register the mark NIKEA on the Principal Register
in standard character format for "chocolates, candy" in
International Class 30.¹

¹ Application Serial No. 77816273, based on a bona fide intent to
use in commerce.

Opposition No. 91194783

On May 6, 2010, opposer, Inter-IKEA Systems B.V., opposed the registration of applicant's mark on the ground that applicant's mark is likely to cause confusion in violation of Section 2(d) of the Trademark Act with, among other registered marks,² opposer's previously used and registered mark IKEA (Registration No. 1661360), in typed drawing format, for, as relevant, "coffee, bread, biscuits, cakes, pastry, candy, mustard, sauces, excluding cranberry and applesauce, and spices," in International Class 30.³

Opposer maintains its IKEA mark is "a well-known mark, famous throughout the country." (Notice at Para. 2). Further to this, opposer has also has brought the opposition on the ground of dilution under Sections 13(a) and 43(c) of the Lanham Act. *Id.* at Para. 9.

Applicant denied the salient allegations of the notice of opposition except that he made no use of the mark prior to his filing date. (Answer at Para. 5 and 6) Only opposer filed a brief.

² Opposer additionally pleaded several marks for IKEA and design for various other goods and services. We find it unnecessary to consider them herein.

³ Registered October 22, 1991. Renewed twice. Sections 8 and 15 accepted and acknowledged. The mark includes goods and services in other classes.

The Record

The record consists of the pleadings; the file of the involved application; and the following:

1. The testimonial deposition, dated March 31, 2010, of Robert Wotherspoon, the IKEA executive responsible for "IKEA food businesses within the 37 stores in the U.S."
2. Opposer's two notices of reliance on
 - a. Magazines, news, and other print articles submitted to show the fame of opposer's pleaded marks; and
 - b. Copies of opposer's pleaded IKEA, and IKEA and design registrations (including No. 1661360) showing both the current status of, and title to, the registrations.

Applicant did not submit any testimony or evidence.

Priority and Standing

As a result of opposer's submission of status and title copies of its IKEA registration (No. 1661360), among others, opposer has established its priority as well as its standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) and *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the relevant, probative evidence in the record. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

For purposes of our likelihood of confusion analysis, we will consider the applicable *du Pont* factors as to pleaded Registration No. 1661360, for IKEA, which has the most relevant goods and mark. If we find a likelihood of confusion as to this mark, then our analysis with regard to the others would be moot. Similarly if we do not, then we would not find it as to the others either. See *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

The Goods and Channels of Trade

The goods listed in the application are "chocolates, candy" in International Class 30. The goods listed in opposer's Registration No. 1661360 include "coffee, bread, biscuits, cakes, pastry, candy, mustard, sauces, excluding cranberry and applesauce, and spices," in International

Class 30. These goods overlap, in that both identify "candy." The other goods are related, as opposer has shown, for example that it sells "almond cake with dark chocolate topping" (Wotherspoon depo. at 17) and "double chocolate crisp cookies" *Id.* at 21.

Because the noted goods described in the application and opposer's registration are identical-in-part, we must presume that the channels of trade and classes of purchasers for these goods 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 other words, we conclude that the channels of trade and classes of purchasers of the parties' goods are the same. These second and third *du Pont* factors heavily favor finding a likelihood of consumer confusion.

The Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their

entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Preliminarily, we note that the more similar the goods at issue, the less similar the marks need to be for the Board to find a likelihood of confusion. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

In comparing the marks, we are mindful that 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 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).

Opposer's mark consists of a typewritten mark for IKEA. This is a coined and arbitrary or fanciful term with no

apparent meaning in any language. Applicant's mark consists of the term NIKEA, in standard character format. Also not a word in any apparent language, applicant's mark appears to rhyme with the strong IKEA mark, thereby giving a substantially similar connotation and commercial impression. Meanwhile, in sight and sound, the marks differ by only one letter. Indeed, applicant's mark incorporates opposer's mark in its entirety. Likelihood of confusion has been found where the entirety of one mark is incorporated within another. *See The Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) ("When one incorporates the entire arbitrary mark of another into a composite mark, the inclusion of a significant, non-suggestive element will not necessarily preclude a likelihood of confusion."). *See also Coca-Cola Bottling Co. v. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL LANCER and Bengal Lancer soldier design for club soda, quinine water and ginger ale is likely to cause confusion with BENGAL for gin); *Johnson Publishing Co. v. International Development Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY DRUM for hairdressing and conditioner is likely to cause confusion with EBONY for cosmetics).

We find the similarities between opposer's and applicant's marks in sight, sound, connotation and commercial impression to outweigh their dissimilarities,

particularly considering that the goods are identical-in-part. Accordingly, this first *du Pont* factor also weighs in favor of finding a likelihood of confusion.

Fame

A famous mark is one "with extensive public recognition and renown." *Id.* See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

As described by opposer, the business of IKEA is selling "everything—all furnishings products, from sofas to kitchens to beds, and everything accompanying that, such as cookware, linens and so forth." (Wotherspoon depo. at 11-12). The IKEA concept is "good quality products at the lowest price compared to our competitors." *Id.* Opposer uses its IKEA brand on all of its products. *Id.* at 13. The 37 U.S. stores annually receive 69 million visits, with 150 million more visits to the websites. *Id.*

Opposer sells, among its other products, "sweets and chocolates." *Id.* These are sold via restaurants at every IKEA store and also as retail products at each one. *Id.* at

8 and 9. Opposer's chocolate bars are among "the top selling products in IKEA food in the U.S." *Id.* at 16. Opposer submitted sales information for "pastries, desserts and cookies" as well as for "cookies, candies, chocolates" sold in the U.S. for FY 2009 through the first through months of FY 2011. Although the numbers were submitted as confidential, we can note that even those involving just chocolate, as identified by applicant, appear to be substantial in both quantity and dollar amount. (Wotherspoon depo. at 25-31 and Exs. 17-24).

Opposer spends "approximately 160 million annually" on advertising in the U.S. *Id.* at 33. Typical magazines and news media outlets where opposer advertises include *Better Homes and Gardens; O;* and *Everyday with Rachael Ray;* as well as ABC, NBC, CBS, Fox, Univision, Food Network and HGTV. *Id.* at 34. Opposer also receives unsolicited media attention from some of the same news outlets as well as other outlets such as the *Chicago Tribune* and *Consumer Reports*. To further show the reach of its brand, opposer's IKEA mark was ranked 28 in the *Business Week/Interbrand* "Best Global Brands Ranking for 2010."

We conclude that while opposer has shown a fair amount of market exposure over the time period provided, opposer has not provided clear context for its sales and advertising numbers with regard to the industry, nor as to how the fame

of its IKEA mark in the media relates specifically to its chocolate and candy products. Furthermore, the information and media coverage provided by opposer appear to relate solely to the 2009-2011 time frame, a rather narrow time period, and one that is not sufficient to establish fame for purposes of this proceeding.

Accordingly, we do not find on this record that opposer's IKEA mark is famous for purposes of our likelihood of confusion determination. Nonetheless, we do find that the evidence establishes that the IKEA mark has garnered some degree of renown and strength amongst the relevant public.

Consumer Sophistication

Opposer urges us to consider the lack of consumer sophistication and degree of purchaser care likely to be exercised for the goods at issue in this proceeding. In this regard, as with the other *du Pont* factors, we are bound by the parties' respective identifications of goods.

Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("[t]he 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." [citations omitted]).

There is no evidence of record regarding the typical price of candy and chocolates or the average sophistication of the consumers thereof. Certainly while goods such as candy and chocolates may be very fine and expensive, they may also be inexpensive, highly accessible to the average consumer and purchased on impulse. We deem this fourth *du Pont* factor to be neutral.

Balancing the Factors

Considering all of the evidence of record as it pertains to the relevant *du Pont* factors, we conclude that the goods are identical in relevant part, and are likely to be marketed through the same channels of trade to generally unsophisticated consumers. We further find that the IKEA mark is arbitrary and strong, and the marks are substantially similar. Based on the foregoing, we find a likelihood of consumer confusion between applicant's mark, NIKEA for "chocolates, candy," and opposer's mark IKEA and design for the goods for which it is registered, including "coffee, bread, biscuits, cakes, pastry, candy, mustard, sauces, excluding cranberry and applesauce, and spices."⁴

⁴ In light of our finding of likelihood of confusion, we find it unnecessary to consider opposer's claim of dilution.

Opposition No. 91194783

DECISION: The opposition is sustained on the grounds of likelihood of confusion under Section 2(d) of the Trademark Act.