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Mailed:
January 12, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Rich Products Corporation
v.
VegiPro Brands, LLC dba Exposure SMI

Opposition No. 91206921
Application Serial No. 85577551

Brian E. Turung, Sandra M. Koenig, and Jude A. Fry of Fay Sharpe LLP
for Rich Products Corporation.

Bruno W. Tarabichi of Owens Tarabichi LLP
for VegiPro Brands, LLC dba Exposure SMI.

Before Cataldo, Bergsman and Gorowitz Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

VegiPro Brands, LLC dba Exposure SMI ("Applicant") filed an application to register the mark BETTER ON TOP! in standard characters for "whipped topping" in International Class 29.[1] Rich Products Corporation ("Opposer") opposed the

[1] Application Serial No. 85577551 was filed on March 22, 2012, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

application on the grounds of likelihood of confusion under Sections 2(d) and 43(a) of the Trademark Act, 15 U.S.C. §§ 1052(d) and 1125 (a)(1)(A).[2] An amended notice of opposition was filed on July 25, 2013 in which Opposer deleted all reference to 43(a). In both notices, Opposer alleges ownership of the following registrations, all of which cover "non-dairy whipped topping":

- Registration No. 1882377 for the mark ON TOP (typed drawing)[3]
  Registered March 7, 1995, renewed;
- Registration No. 1496918 for the mark RICH'S ON TOP (typed drawing)
  Registered July 19, 1988, renewed; and
- Registration No. 4215194 for the mark

  Registered September 25, 2012.

Applicant filed an amended answer denying all salient allegations in the amended notice of opposition and asserting three "affirmative" defenses. The first two allegations (no injury or damage and no likelihood of confusion) are merely amplifications of Applicant's denials of the allegations in the amended notice of opposition, not affirmative defenses. The third affirmative defense, failure to state a

[2] On the opposition cover sheet, Opposer also asserted "deceptiveness" and "false suggestion of a connection," pursuant to Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), however, neither of these grounds were pleaded in the body of the notice of opposition.

[3] Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. § 2.52, was amended to replace the term "typed" drawing with "standard character" drawing. Applicants who seek to register a mark without any claim as to the manner of display must submit a standard character drawing that complies with the requirements of 37 C.F.R. §2.52(a).

claim of deceptiveness and false suggestion of a connection is moot since neither of these claims was pleaded or pursued at trial.

Accelerated Case Resolution.

On January 23, 2015, Opposer filed a motion for summary judgment. When the motion was denied, the parties stipulated to proceed under the Accelerated Case Resolution ("ACR") procedure.

Pursuant to their ACR agreement, the parties entered into procedural stipulations approved by the Board and summarized below:

> 1. The parties may rely on the "Summary Judgment Submission," which consists of Rich's motion for summary judgment and supporting memorandum, VegiPro's opposition, Rich's reply brief and all declarations and evidence submitted therewith;
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> 2. Each party may submit one supplemental brief, the page limit for which is fifteen pages. Opposer may submit a supplemental brief in reply with a ten page limit. ("Supplemental Briefs");
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> 3. The parties may submit supplemental testimony by declaration (which may include additional exhibits). ("Supplemental Testimony");
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> 4. The evidence submitted in connection with the Summary Judgment Submission and the Supplemental Testimony is authentic for purposes of admission into evidence and deemed properly of record; and
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> 5. The Board may resolve any genuine disputes of material fact and issue a final ruling based on the parties ACR submissions.

The Record.

The record includes the pleadings, and by operation of Trademark Rule 2.122(b), 37 CFR § 2.122(b), the application file. In addition, the record includes the following evidence introduced by the parties:

A. Opposer's evidence.

1. Declaration of Erica Frank, Manager of IP for Opposer, in support of Opposer's motion for summary judgment, and exhibits thereto (Frank Dec.) (16 TTABVUE 20-35);

2. Declaration of Diane M. Jacquinot, paralegal at Opposer's law firm, Fay Sharpe LLP in support of Opposer's motion for summary judgment, and exhibits thereto (Jacquinot Dec.1) (16 TTABVUE 36-46);

3. Declaration of Sandra M. Koenig, member of Opposer's law firm, Fay Sharpe LLP reply brief in support of Opposer's motion for summary judgment, and exhibits thereto (Koenig Dec.) (19 TTABVUE 9-25);

4. Confidential Declaration of Jeff Malchoff, Marketing Manager – Toppings & Icings, Food Service Division of Opposer in support of Opposer's supplemental ACR trial brief, and exhibits thereto) (Malchoff Dec.) (29 TTABVUE 13-100) and

5. Declaration of Diane M. Jacquinot, paralegal at Opposer's law firm, Fay Sharpe LLP in support of Opposer's supplemental ACR trial brief, and exhibits thereto (Jacquinot Dec.2) (29 TTABVUE 101-199).

B. Applicant's evidence.

1. Declaration of Bruno Tarabachi, partner of Owens Tarabichi LLP, Applicant's law firm in opposition to Opposer's motion for summary judgment, and

exhibits thereto (Tarabachi Dec.) (18 TTABVUE 22-51);

2. Declaration of Andrew Harrison, owner and a director of Applicant in opposition to Opposer's motion for summary judgment, and exhibits thereto (Harrison Dec.) (18 TTABVUE 52-57).

Standing.

Opposer has properly made its registrations of record, with evidence that its registrations are subsisting and owned by Opposer. Accordingly, Opposer has established its standing in this proceeding. *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).

Priority.

Opposer is the owner of the following pleaded registrations: Registration No. 1882377 for the mark ON TOP for non-dairy whipped topping; Registration No. 1496918 for the mark RICH'S ON TOP for non-dairy whipped topping; and Registration No. 4215194 for the mark

for non-dairy whipped topping. Opposer's ownership of these pleaded registrations removes priority as an issue with respect to non-dairy whipped topping. *Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1169 (TTAB 2011), citing *King Candy, Inc. v. Eunice King's Kitchen, Inc.,* 496 F.2d 1400, 82 USPQ 108 (CCPA 1974).

Likelihood of Confusion.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also*, *In re Majestic Distilling Co., Inc.,* 315 F.3d 1311, 65 USPQ2d 1201 (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 (CCPA 1976). *See also In re Dixie Restaurants Inc.,* 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The similarity or dissimilarity of the parties' goods.

We start our evaluation with the second *du Pont* factor, the similarity or dissimilarity of the parties' goods. It is well established that in a proceeding such as this, the similarity of the goods must be determined on the basis of the goods as identified in the registration. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, NA,* 811 F.2d 1490, 1 USPQ2d 1813, 1814 (Fed. Cir. 1987). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP,* 76 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Opposer's goods are identified as "non-dairy whipped topping" and Applicant's goods are identified as "whipped topping." The term "whipped topping" encompasses both "non-dairy whipped toppings" and "dairy-based whipped toppings." As such,

Applicant's goods, as identified, include Opposer's goods and thus, the goods are legally identical.

Accordingly, the second *du Pont* factor strongly favors a finding of likelihood of confusion.

Channels of trade and class of customers.

It is well established that absent restrictions in the application and registration, [identical] goods and services are presumed to travel in the same channels of trade to the same class of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d, 1905, 1908 (Fed. Cir. 2012). In this case, there are no restrictions of the channels of trade or the customers in the application or registration. Therefore, because the goods are legally identical, they are presumed to travel in the same channels of trade to the same classes of purchasers.

Despite Applicant's assertion that both it and Opposer sell their goods to sophisticated customers,[4] we are constrained to consider the parties' goods as they are identified in the relevant registrations. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014). Neither party's goods are restricted and thus we must consider the sophistication of all potential consumers of whipped toppings, including those that impulsively purchase both non-dairy whipped toppings and diary-based whipped topping inexpensively at supermarkets. *See In re Bercut-Vandervoort & Co.,* 229 USPQ 763, 764 (TTAB

[4] Applicant asserts that "Opposer sells it goods directly to business in the food service industry, such as restaurants, hotels, and caterers …Applicant also sells (or will sell) its goods to sophisticated business purchasers, namely organic, natural food retailers." Applicant's Supplemental ACR Brief, 30 TTABVUE 9-10.

1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). We consider the purchasers of both Applicant's and Opposer's goods to be the same.

Accordingly, the third and fourth *du Pont* factors strongly favor a finding of likelihood of confusion.

Third party use and registration.

Prior to comparing the marks to determine their similarities or dissimilarities, we look at the sixth *du Pont* factor, the number and nature of similar marks in use on similar goods.

> Sufficient evidence of third-party use of similar marks can show that customers ... have been educated to distinguish between different ... marks on the basis of minute distinctions. More broadly, evidence of third-party use bears on the strength or weakness of an opposer's mark. The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.

Juice Generation, Inc. v. GS Enters. LLC, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (internal citations omitted) (Record included examples of twenty-six registered or unregistered marks beginning with the phrase "PEACE LOVE.) While Applicant has submitted evidence of eight registrations for marks containing the word "TOP," owned by seven different entities,[5] Applicant has submitted no evidence of use of any of these marks.

[5] The identification of goods in each registration includes or consists of "whipped toppings."

While extensive evidence of third-party registrations is "powerful on its face" even where the specific extent and impact of usage has not been established,[6] Applicant has not submitted evidence of an extensive number of registrations. Applicant has only submitted eight registrations, two of which are owned by the same party. Moreover, other than the registrations owned by Opposer for marks, there are no registrations of record that consist of or contain the term ON TOP for whipped toppings.

Accordingly, Applicant has not established that marks consisting of or containing the term ON TOP are weak when used in connection with whipped toppings. However, Opposer has similarly not established that ON TOP is a strong mark. As such, the sixth *du Pont* factor has no bearing on our comparison of the similarity or dissimilarity of the marks.

The similarity or dissimilarity of the marks.

Next, we look at the first *du Pont* factor, the similarity or dissimilarity of the marks. In this regard, we confine our analysis to the issue of likelihood of confusion between Opposer's mark ON TOP in typed form and the Applicant's mark BETTER ON TOP! in standard character form. That is, if confusion is likely between those marks, there is no need for us to consider whether likelihood of confusion exists between Applicant's mark and Opposer's other marks RICH'S ON TOP and

[6] *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F3d 1263, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015).

, since if there is no likelihood of confusion between Applicant's mark and the mark ON TOP in typed form, then there would be no likelihood of confusion with Opposer's other marks. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d at 1692. While "the similarity or dissimilarity of the marks is determined based on the marks in their entireties … there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

To evaluate the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1645 (TTAB 2009), citing *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Since the marks at issue are for whipped topping, the average purchaser is an ordinary consumer.

In addition, "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir.

2010), citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

In this case, Applicant has adopted Opposer's entire mark, ON TOP adding only a preface consisting of the merely descriptive word "BETTER" and an exclamation point at the end. The term "BETTER" is merely descriptive because it is simply a claim of superiority and thus laudatory. See *In re Boston Beer Co., L.P.,* 198 F3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (The slogan THE BEST BEER IN AMERICA is merely descriptive since marks that are merely laudatory and descriptive of the alleged merit of a product are also regarded as being descriptive of product itself.").

Relying on the findings, *In re Electro-Voice, Inc.,*[7] Opposer contends that "a consumer encountering whipped toppings respectively labeled 'ON TOP' and 'BETTER ON TOP!,' would get the commercial impression the 'the latter is the product of the manufacturer of the former but of better quality.'" Opposer's MSJ Brief, 16 TTABVUE 12.

Applicant put forth several arguments to support its position that the appearance, sound, connotation, and overall commercial impression of the marks at issue are dissimilar. First, Applicant argues that the appearance of the marks is different because Applicant's mark includes more words than Opposer's mark; and that the inclusion of "additional word is sufficient to avoid a likelihood of confusion."

[7] 148 USPQ 616, 617 (TTAB 1966) (Likelihood of confusion found between AMERICAN for microphones and AMERICAN ELITE for microphones because consumers would "assume that the latter is the product of the manufacturer of the former but of better quality or inversely that the former is the cheaper grade of the latter.")

Applicant's MSJ Opposition Brief, 18 TTABVUE 7. However, the examples provided in Applicant's brief, which are discussed below, do not support Applicant's position:

1. In *Inc. Publ. Co. v. Manhattan Magazine*,[8] the mark

was held not to be confusingly similar to Inc. in part because "Manhattan, the first, longest and only capitalized word in the mark exercises a visual dominance over the trailing lower-case 'inc.'" In the current case, since Applicant's mark BETTER ON TOP! is depicted in standard character form,[9] Applicant's depiction of the mark may be identical to Opposer's depiction of its mark or the word "BETTER" may be depicted in smaller type than "ON TOP";

2. In *First Savings Bank F.S.B. v. First Bank System Inc.*,[10] the Court found the mark

described as being "written in a fancy script [with] the words vertically stacked … appearing against a distinct, black television background," only minimally similar to the mark FirstBank, which is "arranged left-to-right" with "the words [] pushed together and [] accompanied by the distinctive walking-one-logo." The Court found that the term "FIRST BANK" and variations thereof were extensively used by third-parties and thus weak. *Id.* at 1872. In this case, there is no evidence of any third party

[8] 616 F. Supp. 370, 227 USPQ 257, 264 (S.D.N.Y. 1985).

[9] "'Standard character … registrations are federal mark registrations that make no claim to any particular font style, color, or size of display and, thus, are not limited to any particular presentation." *Citigroup Inc. v. Capital City Bank Group Inc.,* 637 F3d 1344, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011).

[10] 101 F3d 645, 40 USPQ2d 1865, 1871 (10th Cir. 1996)

> use or registration of the term "ON TOP" for whipped toppings or any other goods; and
>
> 3. In *Bed & Breakfast Registry,*[11] the descriptive nature of the phrase "bed & breakfast" reservation services and the large number of marks embodying these words for similar services obviates any likelihood of confusion. In this case, the evidence neither establishes that the common term "ON TOP" is descriptive of whipped toppings nor that there is extensive use of the phrase.

Second, Applicant argues that the word "BETTER" is the dominant portion of its mark since it is the first word in the mark. Applicant's MSJ Opposition Brief, 18 TTABVUE 7. While Applicant correctly states that the dominant part of the mark is often the first word, this is not always the case. In this case, given the laudatory and descriptive nature of the word "BETTER," the term "ON TOP" is the dominant portion of Applicant's mark. The word "BETTER" should be accorded little weight as it does not distinguish the marks in the context of the parties' goods. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (In considering the similarity of the marks STONE LION CAPITAL and LION CAPTAL, the Board "reasoned that 'LION' was 'dominant' in both parties' marks … [and the Board correctly accorded] little weight to the adjective 'STONE' on the ground that it did not 'distinguish the marks in the context of the parties' services.'"). The addition of a suggestion or descriptive element to a mark is generally not sufficient to avoid confusion. *See In re Rexel Inc.*, 223 USPQ 830 (T.T.A.B. 1984) (finding likelihood of confusion between GOLIATH for pencils and

[11] 791 F2d 157, 229 USPQ 818 (Fed. Cir. 1986)

LITTLE GOLIATH for a stapler) and 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:50 (4th ed.).

Thus, Applicant's addition of the word "BETTER" prior to Opposer's mark ON TOP is not sufficient to avoid confusion.

Finally, Applicant argues that its use of an exclamation point at the end of its mark is sufficient to differentiate the marks. It is not. Punctuation does not per se change the character of a mark. See, *In re Champion International Corporation*, 196 USPQ 48, 49 (TTAB 1977) (holding - no distinction, vague or otherwise, can be drawn between "CHECK MATE" with or without a hyphen between the words so that for purposes herein they are identical); *Winn's Stores, Incorporated v. Hi-Lo, Inc.*, 203 USPQ 140 (TTAB 1979) (Likelihood of confusion found between Opposer's use of the mark WINN'S and Applicant's use of the mark WIN-WAY DOLLAR STORES since little if any trademark significance can be attributed either to the apostrophe and letter "S" in Opposer's mark or the hyphen in Applicant's mark.). Applicant attempts to distinguish the explanation point from other punctuation by asserting that "[a]n exclamation point is an uncommon method of punctuation, especially with brands." Applicant relies on *In re Sela Prods., LLC*, 107 USPQ2d 1580 (TTAB 2013) to support its argument. Applicant's reliance is misplaced. The cited mark in the *Sela Prods.*[12] case, is:

[12] Applicant's mark is FORZA.

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The translation of the mark is "GO MILAN!" The mark includes the crest of the Italian soccer team Associazione Calcio Milan (ACM). Based on the information of record the Board stated "we have no doubt that those familiar with world soccer would recognize this mark as connoting the Italian soccer club and would readily distinguish it from [A]pplicant's mark FORZA." *Id.*, at 1588. Further, potential purchasers who may not be familiar with soccer but are familiar with the Italian language will also understand the mark to mean "Go Milan." *Id.* Potential purchasers who are not familiar with either soccer or Italian would still differentiate the mark from Applicant's mark because "the word MILAN appears in the largest letters in the mark and is followed by an exclamation point …[which] is not the manner in which the geographic location of a company is normally shown in a mark." *Id.* The design element "which is large and noticeable" also distinguishes the marks. In this case, both marks are in standard character form (or its equivalent typed form), thus there is no design. The exclamation point appears after the term "ON TOP," which merely emphasizes the similarity between Applicant's and Opposer's marks, particularly since Applicant's mark can be viewed in connection with whipped topping as a "better" version of Opposer's ON TOP whipped toppings.

Accordingly, we find that the marks are similar in appearance, sound and commercial impression and thus the first *du Pont* factor also favors a finding of likelihood of confusion.

The fame of Opposer's mark.

Opposer asserts that its mark has become famous and that the fifth *du Pont* factor weighs in favor of a finding of likelihood of confusion. Fame for confusion purposes arises as long as a significant portion of the relevant consuming public … recognizes the mark as a source indicator." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005). In its motion for summary judgment, Opposer notes that the goods at issue, non-dairy whipped topping and whipped topping, are simple consumer food items that are inexpensive and may potentially be purchased on impulse by ordinary consumers." Opposer's Motion for Summary Judgment, 16 TTABVUE 14. However, none of the evidence introduced established that a significant portion of the relevant consuming public recognized the mark ON TOP as a source indicator. To the contrary, the only evidence introduced establishes that Opposer sells its ON TOP products to the food service industry and not to ordinary consumers.

As such, while it appears that Opposer's ON TOP has met with success in the marketplace, we are not persuaded on this record that Opposer's mark is a famous mark. Accordingly, the fifth *du Pont* factor weighs against a finding of likelihood of confusion.

Conclusion.

Having considered all the evidence and argument on the relevant *du Pont* factors, whether specifically discussed herein or not, we conclude that the marks are very similar and the goods are legally identical. Therefore, there is a likelihood of confusion between Opposer's use of the mark ON TOP for "non-dairy whipped toppings" and Applicant's use of the mark BETTER ON TOP for "whipped toppings."

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