

This Opinion Is Not a
Precedent of the TTAB

Mailed: November 29, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Global Commodities, Inc.

v.

*Capital Distributors, LLC and
Capital Imports, LLC*

Cancellation No. 92078857

Thomas A. O'Rourke, of Bodner & O'Rourke, LLP
for Global Commodities, Inc.

Ruth Rivard and Adrianna M. Chavez, of Stinson LLP
for Capital Distributors, LLC and Capital Imports, LLC.

Before Taylor, Pologeorgis and Thurmon, Administrative Trademark Judges.

Opinion by Thurmon, Administrative Trademark Judge:

Capital Imports, LLC is the owner of a Principal Register registration, by way of assignment from Capital Distributors, LLC (collectively "Respondents"), for the mark, shown below, for "rice" in International Class 30. We refer to this mark as the "impala mark."



Global Commodities, Inc. (“Petitioner”) seeks cancellation of the registration identified above, alleging priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on the two registered marks, shown below, both for “rice” in International Class 30. We refer to these marks as the “fawn marks.”



¹ Registration No. 5926738 was issued on December 3, 2019. The registration is based on an application filed July 18, 2019, under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), alleging April 1, 2018, as the date of first use anywhere and in commerce.

The mark is described as follows: “The mark consists of an impala design in black outline with black shading. Above the impala at top right appears a red partial outline of a heart design. The color white merely represents background and is not being claimed as a feature of the mark.” The black and red colors are claimed as part of the mark.

² Registration No. 3239488 (‘488 Reg.) was issued on May 8, 2007. The registration is based on an application filed June 30, 2006, under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), alleging December 31, 1997, as the date of first use anywhere and in commerce.

The mark is described as follows: “The mark consists of the words AAHU BARAH curved over the drawing of a fawn.” The translation of the literal elements “in the mark translates into English as fawn.” Color is not claimed as a part of the mark.

³ Registration No. 3966152 (‘152 Reg.) was issued on May 24, 2011. The registration is based on an application filed September 28, 2010, under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), alleging December 31, 1997, as the date of first use anywhere and in commerce.

Respondent Capital Distributors, LLC filed an answer denying the salient allegations in the Petition, and presented no defenses or counterclaims.⁴ The parties submitted evidence and briefs, and the proceeding is now ready for decision. We deny the petition to cancel because Petitioner has failed to prove a likelihood of confusion.

I. The Record

The record consists of the pleadings and, pursuant to Trademark Rule 2.122(b)(1), the prosecution file for Respondents' subject registration. The record also includes evidence submitted by the parties. Petitioner submitted the following:

- Petitioner's First Notice of Reliance, which provided status and title records for the two registrations it relies upon in this proceeding;⁵
- Petitioner's Second Notice of Reliance on provided discovery responses of Respondents, an abandoned trademark application file of Respondent Capital Distributors, LLC and copies of judgments from other proceedings involving Petitioner's fawn marks;⁶
- Petitioner's Third Notice of Reliance on Internet materials with information about deer, impalas and other animals;⁷
- Declaration of Nazifa Bakhtari, General Manager of Petitioner;⁸

The mark is described as follows: "The mark consists of a drawing of a fawn." Color is not claimed as a feature of the mark.

⁴ Respondent Capital Imports, LLC did not file a separate answer, but effectively steps into the shoes of its assignor, Capital Distributors, LLC, for purposes of this proceeding. *NSM Res. Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1031 (TTAB 2014) ("When there has been an assignment of a mark that is the subject of, or relied upon in, an *inter partes* proceeding before the Board, the assignee may be joined or substituted, as may be appropriate, upon motion granted by the Board, or upon the Board's own initiative.").

⁵ 10 TTABVUE 5-6 (Registration No. 3966152), 7-8 (Registration No. 3239488). When we cite to the record, we refer to TTABVUE, the Board's docketing system, by docket entry and page number of the downloaded document (e.g., 18 TTABVUE 14).

⁶ 11 TTABVUE.

⁷ 12 TTABVUE.

⁸ 14 TTABVUE 2-27 (exhibits begin at 45). One paragraph in the declaration provides confidential sales figures and is found at 13 TTABVUE 3.

- Declaration of Zarghouna Bakhtari, widow of Petitioner’s founder;⁹
- Seven videos showing recipes made with Petitioner’s goods;¹⁰ and
- A rebuttal declaration of Nazifa Bakhtari.¹¹

Respondents submitted the following evidence:

- Respondents’ First Notice of Reliance, on an Internet article titled “New hope for the hirola;”¹²
- Respondents’ Second Notice of Reliance, which provided status and title records for six trademark registrations;¹³
- Respondents’ Third Notice of Reliance, which provided discovery responses of Petitioner;¹⁴
- Declaration of Ibrahim Osman, owner of both Respondents;¹⁵ and
- Cross-examination Depositions of Nazifa Bakhtari and Zarghouna Bakhtari.¹⁶

II. The Claims

Petitioner’s Section 2(d) claim is the only claim or defense before us. In the Petitioner to Cancel, Petitioner included dilution claims (by blurring and by tarnishment), but we agree with Respondent that Petitioner did not pursue those claims at trial. Petitioner’s dilution claims, therefore, are forfeited. *In re Google Tech.*

⁹ 14 TTABVUE 28-44. The exhibits in 14 TTABVUE are shared by the two declarations, though the declaration of Nazifa Bakhtari identifies the majority of the exhibits. There are no confidential parts of Zarghouna Bakhtari’s declaration.

¹⁰ 15 TTABVUE. These videos are identified by Nazifa Bakhtari in her declaration, but were submitted separately because they are on a DVD.

¹¹ 24 TTABVUE.

¹² 18 TTABVUE. According to Respondents, hirola is another name for an impala.

¹³ 19 TTABVUE.

¹⁴ 20 TTABVUE.

¹⁵ 21 TTABVUE.

¹⁶ 25 TTABVUE (both deposition transcripts and exhibits, minus confidential portions); 26 TTABVUE (confidential portions of the transcripts).

Holdings LLC, 980 F.3d 858, 2020 USPQ2d 11465, at *3-4 (Fed. Cir. 2020) (holding that arguments not presented to the Patent Trial and Appeal Board were forfeited, while noting that the loss of such rights has been identified as “waiver” in prior decisions); *see also Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *2 (TTAB 2020) (party “did not present any evidence or argument with respect to these asserted defenses at trial, so they are deemed waived”); *TPI Holdings, Inc. v. TrailerTrader.com LLC*, 126 USPQ2d 1409, 1413 n.28 (TTAB 2018) (“Respondent also asserted ‘estoppel, acquiescence and waiver,’ but does not argue any of these in its brief. They are therefore waived.”); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014) (“As applicant did not pursue the affirmative defenses of failure to state a claim and unclean hands, either in its brief or by motion, those defenses are waived.”).

There is a closer question concerning whether Petitioner’s Section 2(d) claim includes a common law basis, in addition to its reliance on the two registrations identified above. Petitioner presented such a claim in the Petition to Cancel.¹⁷ But Petitioner made no mention of a common law claim in its trial brief. Petitioner’s arguments and evidence all relate to its fawn marks, which are the subject of its two relied-upon registrations. There is nothing in the trial record or Petitioner’s trial brief that would put Respondents on notice of a separate common law claim for relief.

¹⁷ 1 TTABVUE 11 (alleging that continued registration of the challenged mark “is inconsistent with Petitioner’s rights and the common law ...”).

That does not mean Petitioner limited its arguments to the registered marks. To the contrary, Petitioner alleges that Respondents copied Petitioner's fawn marks and its packaging. However, this proceeding challenges Respondents' registered mark only. It is not a challenge to Respondents' packaging. As we explain below, most of Petitioner's arguments regarding bad faith adoption are supported only by the testimony of Petitioner's witnesses, who point to similar features in the parties' packaging and the fact that Respondent Capital Distributors, LLC was a distributor of Petitioner's rice. We will consider this evidence only in connection with our evaluation of Respondents' intent.

Finally, while we agree that opposer has established on the record that its use of green as part of the trade dress for its product, i.e. on the reels, and in advertising and promotional materials has been extensive, this aspect would only be relevant to the question of registration to the extent that the trade dress was a factor in corroborating bad faith on the part of applicant in adopting its green and yellow strand trademark.

Armsted Indus. Inc. v. West Coast Wire Rope & Rigging Inc., 2 USPQ2d 1755 (TTAB 1986). When it comes to the other *DuPont* factors we address below, however, the parties' packaging is not relevant. *Id.* ("Thus, while an allegedly confusingly similar trade dress might give rise to a claim of unfair competition based on a collocation of all features, including the marks and the associated trade dress, such a claim is beyond the jurisdiction of this Board.").

To summarize, we hold that Petitioner tried a single claim in this proceeding, its claim under Section 2(d) based on its two registered fawn marks. To the extent elements of the parties' trade dresses are relevant at all, that evidence is relevant

only to the evaluation of whether Respondents adopted their subject mark in bad faith.

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be established in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 U.S. 82 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may petition to cancel a registration when it demonstrates (i) an interest falling within the zone of interests protected by the statute, 15 U.S.C. §§ 1063 & 1064, and (ii) a reasonable belief in damage that is proximately caused by registration of the mark. *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at *2 (Fed. Cir. 2022) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129, 132 (2014)); *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020).

In other words, Petitioner must demonstrate a real interest in the proceeding and a reasonable belief of damage from continued registration of Respondents’ impala mark. *Australian Therapeutic Supplies*, 2020 USPQ2d 10837 at *3; *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012). Demonstrating a real interest in cancelling the registration of a mark satisfies the zone-of-interests requirement, and “[i]n most

settings, a direct commercial interest satisfies the ‘real interest’ test.” *Herbko Int’l v. Kappa Books*, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002).

Petitioner meets these requirements based on its submission of copies of electronic records from the USPTO’s Trademark Electronic Search System (TESS) database showing status and title in its two relied-upon registrations for “fawn marks,” which arguably are similar to Respondent’s “impala mark” identified in the challenged registration. *Empresa Cubana Del Tabaco*, 111 USPQ2d at 1062 (citing *Ritchie v. Simpson*, 171 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)); *see also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1532 (TTAB 2018); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012). Petitioner’s interest in canceling the challenged registration is real and shows that it is not a mere intermeddler.

IV. Priority

In a cancellation proceeding on a likelihood of confusion claim under Section 2(d) of the Trademark Act,¹⁸ and where both parties own registrations, priority is in issue.¹⁹ *See Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *15-16 (TTAB 2021) (quoting *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 374409, at *4

¹⁸ There are two elements to a Section 2(d) claim: priority and likelihood of confusion. 15 U.S.C. § 1052(d); *Herbko Int’l*, 64 USPQ2d at 1378 (“[A] party petitioning for cancellation under section 2(d) must show that it had priority and that registration of the mark creates a likelihood of confusion”).

¹⁹ Petitioner incorrectly argues that “prior use need not be shown.” 14 TTABVUE 18. As we noted above, priority must be established by a cancellation petitioner bringing a Section 2(d) claim.

(TTAB 2019) (quoting *Couch/Braunsdorf Affinity, Inc. v. N. Atl. Operating Co.*, 110 USPQ2d 1458, 1474 (TTAB 2014)). Petitioner must prove that it has a proprietary interest in its pleaded mark obtained before any date of priority on which Respondents may rely. *Sabhnani*, 2021 USPQ2d 1241, at *15-16.

Respondents established, through unrefuted testimony, a first use in commerce of its impala mark in April, 2018.²⁰ This is Respondents' earliest priority date, for purposes of this proceeding.

Petitioner's established priority dates for both pleaded marks are prior to the earliest date established by Respondents. While Petitioner submitted evidence regarding the asserted first use dates of the two pleaded marks, no precise first-use date was established for either of its pleaded marks. We accordingly rely on the constructive priority date for the marks in each pleaded registration. Petitioner's registrations of record have statutory priority dates of June 30, 2006 ('488 Reg.) and September 28, 2010 ('152 Reg.), the filing dates of the underlying applications. *See* Trademark Act Section 7(c), 15 U.S.C. § 1057(c), (filing date of application to register constitutes constructive use and confers a right of priority as against another person who has not used the mark prior to such filing); *see also J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965). The priority date for each

²⁰ 21 TTABVUE 6 (Declaration of Ibrahim Osman). Because Mr. Osman did not provide a specific date, we treat its priority date as April 30, 2018.

asserted registration is prior to the earliest priority date established by Respondents. Petitioner therefore has established priority for purposes of its Section 2(d) claim.²¹

V. Likelihood of Confusion

Our determination under Trademark Act Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). A likelihood of confusion analysis often focuses on the similarities between the marks and the similarities between the goods 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.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). We must consider each *DuPont* factor for which there is evidence or argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Before we begin our analysis of the *DuPont* factors, it is important, in this case, to define what is and is not relevant to that inquiry. Petitioner challenges the registered impala mark shown above, based on its two registered fawn marks, also shown above. As noted earlier, no other trademarks or trade dress used by the parties are at issue

²¹ Respondents do not contest Petitioner’s priority. After noting that “Petitioner asserts priority and likelihood of confusion ...,” Respondents make no further mention of the priority element of Petitioner’s Section 2(d) claim. 28 TTABVUE 16.

in this proceeding, unless such other marks or trade dress have a bearing on Respondents' intent in selecting its impala mark. So, for example, when we compare the marks, we will **not** consider the appearance of the bags in which the rice is packaged by the parties in the marketplace. We make this point because much of Petitioner's case appears to focus on the trade dress of the parties' rice packaging. We will discuss that packaging when we consider Respondents' intent below, but when we compare the marks, our analysis will be limited to the marks as shown in the registrations.

A. Strength of Petitioner's Fawn Mark ('152 Reg.)²²

Before we make our comparison of the marks, we consider the strength, as well as any weakness, of Petitioner's fawn mark as used in connection with rice. We do so because a determination of the strength or weakness of the mark helps inform us as to its scope of protection. *See In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) (“[T]he strength of the cited mark is — as always — relevant to assessing the likelihood of confusion under the *DuPont* framework.”).

When evaluating the strength or weakness of a mark, we look at the mark's inherent strength based on the nature of the term itself and its commercial strength in the marketplace. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (measuring both conceptual and marketplace strength); *see also*

²² As explained *infra*, we base our likelihood of confusion analysis on a comparison of Petitioner's fawn mark with no wording, i.e., the mark in the '152 registration, because this mark is more similar to the Respondents' impala mark. We thus similarly base our strength analysis on Petitioner's fawn mark with no wording.

Made in Nature, LLC v. Pharmavite LLC, 2022 USPQ2d 557, at *17 (TTAB 2022) (quoting *DuPont*, 177 USPQ at 567); *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *10 (TTAB 2020).

“[T]he strength of a mark is not a binary factor, but varies along a spectrum from very strong to very weak.” *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003). Finally, with regard to commercial strength, “[t]he proper standard is the mark’s ‘renown within a specific product market,’ ... and ‘is determined from the viewpoint of consumers of like products,’ ..., and not from the viewpoint of the general public.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings*, 857 F.3d 1323, 122 USPQ2d 1733, 1734-35 (Fed. Cir. 2017).

1. Conceptual Strength of Petitioner’s Fawn Mark

Conceptual strength is a measure of a mark’s distinctiveness and may be placed “in categories of generally increasing distinctiveness: . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). Because Petitioner’s pleaded fawn mark registration issued on the Principal Register, without a claim of acquired distinctiveness, the fawn mark is are presumed to be inherently distinctive for the goods listed in the registration, i.e., rice. Trademark Act Section 7(b), 15 U.S.C. 1057(b); *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006) (a “mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods”).

Respondents do not argue that Petitioner's fawn mark is conceptually weak. Instead, Respondents maintain that Petitioner's fawn mark is commercially weak. Notwithstanding, we note that Respondents submitted three third-party registrations for various marks depicting deer for "rice."²³ The third-party marks are reproduced below.



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²³ 28 TTABVue 32-33.

²⁴ Registration No. 5002800, issued July 19, 2016. A Sections 8 and 15 combined declaration has been accepted and acknowledged.

²⁵ Registration No. 2171848, issued July 7, 1998, and has been renewed.



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We find that Respondents' three third-party registrations, without any evidence of actual use, are insufficient in number to be probative of any conceptual weakness of Petitioner's fawn mark for rice. Unlike *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015), in which extensive evidence of third-party registrations was found to be "powerful on its face," this record presents only a very limited number of such registrations for identical goods. *See, e.g., Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.2d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *cf. TPI Holdings*, 126 USPQ2d at 1427-28 n.92 (67 third-party registrations and numerous uses of TRADER-formative marks showed that the formative was weak and could not form the basis of petitioner's claimed family of marks).

To summarize, we find that there is insufficient evidence of record regarding the conceptual weakness of Petitioner's pleaded fawn mark. Accordingly, we find

²⁶ Registration No. 5534006, issued August 7, 2018. This registration identifies "Noodles; Pasta; Rice; Rice noodles" in International Class 30. The other two registrations identify only "rice" in International Class 30.

Petitioner's fawn mark is arbitrary and distinctive and that, as a result, Petitioner's fawn mark is entitled to the normal scope of protection accorded arbitrary or fanciful marks.

2. Commercial Strength or Weakness of Petitioner's Fawn Mark

Petitioner has used its fawn mark since 1995 on rice, and now uses the mark on a wider range of goods.²⁷ While Petitioner provided confidential sales figures, it did not provide any context for those figures.²⁸ And at other times, Petitioner has pointed out that it "is a small, family run company with approximately 15 employees and competes with much larger companies"²⁹

We find that Petitioner is a successful, small business. It sells many different products to a large number of customers. There is, however, no brand awareness evidence in the record and nothing to place the sales figures into perspective.³⁰ *See, e.g., Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002) (noting the need for "some context in which to place [Petitioner's] raw statistics."). Petitioner has not shown that its fawn mark is famous or that the mark

²⁷ 14 TTABVUE 31-32 (adoption of the fawn mark); *Id.* at 11-15 (range of goods sold under the fawn mark).

²⁸ 13 TTABVUE 3 (confidential sales figures).

²⁹ 14 TTABVUE 32.

³⁰ Petitioner sells its rice to retailers and to restaurants, but does not distinguish these types of sales in its evidence. Sales to restaurants are in a different trade channel than sales to consumers in grocery stores, and for that reason, are likely to have a different impact on consumer awareness of the fawn marks. So, even within the sales figures provided, there is ambiguity as to how much of those sales went to ordinary consumers and how much went to restaurants or others who use Petitioner's rice to prepare other goods offered to consumers.

has market strength.³¹ “Because of the wide latitude of legal protection accorded a famous mark and the dominant role fame plays in the likelihood of confusion analysis, the party asserting fame must clearly prove it.” *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1353 (TTAB 2014). Here, Petitioner did not, and accordingly, Petitioner’s mark is not entitled to a broader scope of protection that would be afforded a commercially strong mark.

To counter Petitioner’s evidence of commercial strength, Respondents introduced evidence of third-party uses of deer-formative marks used in connection with rice. The third-party uses are identified below:

Customers who viewed this item also viewed

Product	Price	Count
Aahu Barah Basmati Sela Rice 10lb	\$24.99 (\$0.16/Ounce)	394
Royal White Basmati Rice, 10 Pound	\$24.50 (\$0.15/Ounce)	1,119
Aahu Barah Mother Basmati Sela Rice, 10 Pound	\$26.99 (\$0.17/Ounce)	83

Jeer Basmati Rice - 20 Lbs
Brand: Deer
2 ratings
\$50.94 (\$2.55 / pound)
FREE delivery February 8 - 9.
Or fastest delivery February 7 - 8. Order within 17 hrs 57 mins.
Only 18 left in stock - order soon.
Add to Cart
Buy Now

Consider a similar item
Khazana Premium Basmati Rice - 10lb
Resealable Zipper Bag | NON-GMO, Gluten-Free, Kosher & Cholesterol Free | Aged Aromatic, Flavorful, Authentic Grain From India

³¹ We do not disclose here the specific figures Petitioner submitted, but suffice it to say the Board has found much larger sales and advertising figures unhelpful absent context. *Bose Corp.* 63 USPQ2d at 1309 (“[R]aw numbers alone in today’s world may be misleading.... Consequently, some context in which to place raw statistics is reasonable.”).

³² 21 TTABVUE 11.



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The preceding three images show a very similar product to that sold by Petitioner and Respondents. This product features an image of a deer, with horns or antlers, and leaping or running in the same direction at Petitioner's fawn. The product also uses the word mark DEER, which deepens the connection with the image of a deer.

³³ *Id.* at 25.

³⁴ *Id.* at 31.

This deer mark is more similar to Petitioner’s fawn marks than is Respondents’ mark.³⁵

Another similar rice product bearing a deer on its packaging follows.



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And another one.



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³⁵ Nazifa Bakhtari testified that the deer image featured on this product was similar to Petitioner’s fawn marks and that she has been aware of this product for the “[p]ast couple of years, I guess, when we were going after a lot of people.” 25 TTABVUE 43.

³⁶ *Id.* at 27.

³⁷ *Id.* at 23.

And one with a pair of deer.



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While we have no sales evidence for these products, there is unrefuted testimony that each product is “available in the market.” We therefore find this evidence probative of third-party marketplace use of deer design marks on or in connection with rice. More specifically, the third-party uses of deer marks for rice are sufficient to show that a deer design has been adopted and used as a trademark for rice to a nontrivial extent.

As a result, a mark comprising, in whole or in part, of the pictorial display of a deer in connection with rice is entitled only to a restricted scope of protection. *See Anthony’s Pizza & Pasta Int’l, Inc. v. Anthony’s Pizza Holding Co.*, 95 USPQ2d 1271, 1278 (TTAB 2009), *aff’d*, 415 F. Appx. 222 (Fed. Cir. 2010) (citing *Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB 1983)). In other words, Petitioner’s fawn mark for rice is not entitled to such a broad scope of protection that it will bar the registration of every mark comprising, in whole or in part, the pictorial representation of a deer.

³⁸ *Id.* at 35.

Petitioner's fawn mark will only bar the registration of marks "as to which the resemblance to [Petitioner's mark] is striking enough to cause one seeing it to assume that there is some connection, association or sponsorship between the two." *Id.* Compare *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1566 (TTAB 1996) (widespread third-party use supported the finding that the marks were not likely to cause confusion because "at least half, if not more, of the third-party telephone directory listings of enterprises whose trade name names/marks contain the term BROADWAY have listed addresses on a street, road, avenue, etc., named 'BROADWAY.' To purchasers familiar with these enterprises, the term BROADWAY will have geographic significance.").

Additionally, while the three third-party registrations submitted by Respondents discussed above are not evidence of market use of the marks, they, along with the use evidence highlighted above, are "powerful on [their] face," even where the specific extent and impact of the usage has not been established," and tend to show that consumers of rice may be familiar with deer marks. *Jack Wolfskin*, 116 USPQ2d at 1136 (quoting in part *Juice Generation*, 115 USPQ2d at 1675). Furthermore, while we have no sales evidence for these identified third-party uses, there is unrefuted testimony that each product is "available in the market." We therefore find this evidence probative of third-party marketplace use of deer design marks on or in connection with rice.

In summary, the record includes evidence of three registered marks that use deer in their marks for rice. We also have evidence of four other rice products in the

marketplace that feature deer in their packaging. So, there is evidence of at least seven different rice products that feature a deer in their marks, that is, seven in addition to the marks of Petitioner and Respondents.

We do not know how many brands of rice are found in the market. But our record shows nine different marks for rice that include a deer or similar animal. We find this evidence probative, in part because the goods are all identical. This evidence is sufficient to show that consumers are at least somewhat familiar with seeing deer on the packaging. In other words, consumers are less likely to rely on the deer images alone to distinguish rice products. *See, e.g., ProQuest Info. & Learning Co. v. Island*, 83 USPQ2d 1351, 1359 (TTAB 2007) (PRO found not to be the dominant portion of the opposer's PROQUEST mark because it was a "common, widely-used prefix[]"); *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *37 (TTAB 2021) (finding that the word MIRAGE was the more significant portion of the respondent's ROYAL MIRAGE word mark); *Monster Energy Co. v. Chun Hua Lo*, 2023 USPQ2d 87, at *33 (TTAB 2023) (finding that the word MONSTER was the dominant portion of the applicant's ICE MONSTER and design mark for restaurant services even though it was the second word in the mark).

In sum, while Petitioner's fawn mark is conceptually strong, the mark is commercially weakened by the existence of other deer images on competing products. Considering all the probative evidence, we find Petitioner's fawn mark is commercially weak in the market for rice. This weakness reduces the scope of protection to be accorded Petitioner's fawn mark.

B. Similarity of the Marks

To evaluate the similarity of the marks, we consider the marks in their entireties as to appearance, sound, connotation and commercial impression. *See, e.g., Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (citing *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d, 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516 (Fed. Cir. 2019). *Accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted). We will proceed, therefore, with a comparison of Petitioner’s fawn mark with no wording because this mark is more similar to the Respondents’ impala mark, both of which are shown again below. If there is no likelihood of confusion between these marks, there will be none with Petitioner’s composite word and design mark. *See In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

We present the two marks below, for convenience below, with Respondents’ impala mark on the left and Petitioner’s fawn mark on the right.

Respondent's mark



Petitioner's mark (with no literal elements)



While shown side-by-side above for ease of reference, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs.*, 101 USPQ2d at 1721. The focus is on the recollection of the average purchaser, who normally “retains a general rather than a specific impression of marks.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018).

The registration for Petitioner's mark identifies the animal as a “fawn,” which is defined as “a young deer.”³⁹ Petitioner's fawn mark shows an animal with visible spots on its side and curved antlers. The mark creates a sense of motion or action, as the fawn is leaping or running. The entire mark is the fawn in motion. Respondents'

³⁹ We take judicial notice of dictionary definitions, this one from Merriam-Webster's online dictionary. <https://www.merriam-webster.com/dictionary/fawn> (visited November 13, 2023). *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) (The Board may take judicial notice of dictionary definitions, including definitions in online dictionaries which exist in printed format or that have regular fixed editions.).

impala mark shows an animal standing and most of the red outline of a heart above the animal. There are no spots on this animal and it is not in motion. The animal appears alert, but is not leaping or running. This animal has no antlers or horns.

These marks are **not** similar in appearance. The only similarity we see is that both marks feature somewhat similar animals. Petitioner argues that Respondents' mark is a deer, not an impala.⁴⁰ Petitioner even asserts, "[m]ost people cannot tell the difference between an Impala and a deer, because both of these animals are so similar. Anyone seeing Capital's mark will think that it is a deer."⁴¹ Petitioner, however, offers only the declaration of Nazifa Bakhtari as support for this proposition. We cannot determine how Ms. Bakhtari knows what consumers know about deer and impala, as used on packaging for rice. We note, too, that Ms. Bakhtari was not involved in the family business until 2018.⁴² We give no weight to this testimony, as it is not about Petitioner's business and lacks any supporting evidence.

We find few similarities in these two marks, regardless of what kind of animal consumers believe is shown in Respondents' mark. Even if consumers think both animals are deer, they are not similar. One mark shows a juvenile animal—the spots on the side are consistent with Petitioner's animal being a young deer—while the other mark shows what appears to be a mature animal. So, if we accept Petitioner's unsupported assertion that consumers will believe Respondents' mark features a

⁴⁰ 27 TTABVUE 25 ("Although Capital calls its mark an Impala design, it appears to really be a deer.").

⁴¹ *Id.*

⁴² 25 TTABVUE 13 (Nazifa Bakhtari deposition).

deer, it does not follow that consumers will see these marks as similar for purposes of our analysis. Respondents' animal clearly has no spots and no antlers or horns. These are striking features of the fawn in Petitioner's mark and they are wholly absent from Respondents' mark.

The marks also differ visually in terms of the motion or lack of motion perceptible from the appearance of the marks. Petitioner's young deer is in motion, either running or leaping. Its body is elongated and its legs extended in front and behind the animal. None of these features are found in Respondents' mark, which features a stationary animal, with an alert look. One mark is in motion, while the other is not. Consumers are likely to recall such a striking difference.

Finally, the red heart outline featured prominently above the animal in Respondents' mark is absent from Petitioner's fawn mark. Respondents' claim color, so the red color is part of their mark. The addition of a visually significant feature is also something consumers are likely to recall.

Petitioner's argument that the marks are "virtually identical" is simply unavailing. Indeed, the only similarity Petitioner identifies is its unsupported assertion that Respondents' mark shows a deer, or an unidentified animal that will be considered a deer by consumers. Even if true, and there is no evidence in the record of what consumers actually think, it does not follow that consumers believe that all deer look alike. Put another way, even if these marks were intended to feature the same species of animal, the respective marks are almost entirely different in appearance. All the striking features of these marks differ.

The marks also convey a different commercial impression. Petitioner's mark, as we noted above, creates a sense of action. As stated, there is no evidence of record regarding how these marks are perceived by consumers, and we find the differences in appearance are likely to carry over to differences in commercial impression. More specifically, Petitioner's mark shows a young deer running or leaping. This image creates a commercial impression of action and, perhaps, youth. Respondents' mark shows an alert, stationary animal with a red heart shape above it. This mark creates an impression of vigilance (the alert animal) and caring (the red heart shape). There is nothing similar in the commercial impressions created by these marks, except that both marks include images of somewhat similar animals.

We find the respective marks, when viewed in their entirety, are **not** similar. As discussed, the only similarity is that both depict somewhat similar animals as design marks. While the animals are somewhat similar in type, they are presented in very different manners, and with Respondents' mark including a red heart outline.

Accordingly, the similarity of the marks factor favors a finding of no likelihood of confusion.

C. Similarity of the Goods and Trade Channels

The goods are identical, as Petitioner's registration and Respondents' challenged Registration both identify "rice" in International Class 30. Respondents concede this fact and that the trade channels overlap. "It is not disputed that for purposes of this analysis, the parties' respective services [sic] and channels of trade should be

considered the same.”⁴³ *DuPont* factors two and three, therefore, favor a likelihood of confusion finding.

D. Purchasing Conditions

The goods are rice, with no limitations. Both parties miss this important point. Respondents argue that “the particular nature of the goods—a specialty rice sold to consumers of rice in the East African communities in the U.S. ...” and other considerations mean customers will exercise more care when purchasing the goods.⁴⁴ Petitioner argues that there is no “evidence on the sophistication of the members of the Middle Asian, South Asian, Middle Eastern or East African communities with respect to [Respondents’] products.”⁴⁵ The goods are “rice,” not rice sold only to certain segments of the rice market.

While it may be true that purchasers of specialty rice exercise more care than other rice purchasers, the parties’ registrations identify “rice,” which necessarily includes all types of rice. As such, and as the parties appear to agree, we must take into account that some rice will be purchased by ordinary consumers who will exercise no more than ordinary care.⁴⁶ *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (“Board precedent requires the decision to be based ‘on the least sophisticated potential purchasers.’”). This

⁴³ 28 TTABVUE 36.

⁴⁴ *Id.* at 29.

⁴⁵ 27 TTABVUE 48.

⁴⁶ 27 TTABVUE 13-14 (Petitioner’s argument that consumers of rice “are not sophisticated” and exercise no special care); 28 TTABVUE 28-29 (Respondents’ argument that the evidence does not “justify applying a lower standard of care than that of ordinary consumers.”).

factor (*DuPont* factor four), therefore, is neutral in the likelihood of confusion analysis.

E. Nature and Extent of Any Actual Confusion/Length of Time During and Conditions Under Which There Has Been Concurrent Use Without Evidence of Actual Confusion

We next turn to the seventh *DuPont* factor (nature and extent of any actual confusion) and the related eighth *DuPont* factor (extent of the opportunity for actual confusion). The seventh and eighth *DuPont* factors evaluate the impact of evidence of actual confusion and, on the other hand, when the lack of such evidence may be probative of an absence of a likelihood of confusion. *See, e.g., In re Guild Mort.*, 2020 USPQ2d 10279, *7-8. Ironically, while these two factors may be important in some cases, in the majority of our Section 2(d) proceedings, these factors are neutral. *See, e.g., Integrated Embedded*, 120 USPQ2d 1504, 1515 (TTAB 2016) (absence of evidence of actual confusion “is not compelling in support of a finding of no likelihood of confusion.”). As we explain below, we find these factors are neutral in this case, too.

Petitioner argues that Nazifa Bakhtari experienced an instance of actual confusion in November, 2022. She asserts, “On November 9, 2022 I performed a Google search and came upon the following listing from African Grocery Online, www.africamarket.com”



Ms. Bakhtari continues,

Curious about the listing, I ordered rice from the website. I wasn't sure which rice the listing on African Grocery Online, www.africamarket.com, was referring to, it could have been either AahuBarah or Dreamland. The image of the product offered indicates either Aahubarah or Dreamland as being the product I was buying. It ended up being neither. It was Capital's Al Afia brand that I received. I believe the store owner thinks their customers might not notice the difference and shipped out Capital's Al Afia bag of rice because it is cheaper.⁴⁷

Ms. Bakhtari provided an image of a bag of Respondents' rice, which she asserts is the product received in the experience she described above. No further explanation or evidence was provided about this incident.

Petitioner did not disclose this incident in its discovery responses, as Respondents point out.⁴⁸ Instead, Petitioner responded that it was not aware of any evidence of actual confusion.⁴⁹ These discovery responses were never updated to include the

⁴⁷ 14 TTABVUE 23-24.

⁴⁸ 28 TTABVUE 16-17.

⁴⁹ 20 TTABVUE 25-31 (discovery responses).

incident described above, and for this reason, we do not consider it. Fed. R. Civ. P. 36(b).

Even if we did consider this evidence, the incident Ms. Bakhtari recounts is ambiguous. It is possible that this incident was a result of confusion, but that is only one possible explanation. Ms. Bakhtari clearly was not confused and we have no evidence concerning the state of mind of the persons involved in selecting and shipping the wrong product.⁵⁰ Being shipped an incorrect product is not always, or even often we suspect, a result of brand confusion. We note, however, that this incident is further evidence that the Dreamland rice product is available on the market. That product also prominently features a deer on its packaging, this one being chased by a tiger.

So, we are left with no evidence of actual confusion. The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Respondents of their mark for a significant period of time in the same markets as those served by Petitioner under its pleaded marks. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007)

⁵⁰ Ms. Bakhtari admitted that she does not know how or why she was sent the wrong rice. 25 TTABVUE 52.

(the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring”). In most cases, that result has no impact on the likelihood of confusion analysis for reasons we have explained before. *See, e.g., Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1560-61 (Fed. Cir. 2001); *New Era Cap Co.*, 2020 USPQ2d 10596 at *10.

Respondents, however, argue that the lack of actual confusion evidence shows that confusion is unlikely. Put simply, Respondents argue, with citations to evidence in the record, that the parties’ rice products have coexisted for five years in the same specialty markets in the Twin Cities region, with no reports of confusion.⁵¹ As we noted above, the parties concede that the goods are identical and that the goods travel through identical trade channels.

There is also testimonial evidence, from both parties, showing the close trade channel overlap in this case. For example, Respondent Capital Distributors, LLC was a distributor of Petitioner’s rice from 2012 until 2020, and it sold Petitioner’s rice bearing the fawn marks to grocery stores during that period.⁵² From 2018 through

⁵¹ 28 TTABVUE 34-35.

⁵² 14 TTABVUE 30 (Zarghouna Bakhtari declaration) (“Capital was a Global distributor in the Minneapolis market and purchased Global’s Basmati Sela Rice sold under the fawn

2020, Respondents offered to grocery stores both Petitioner's fawn marks rice and Respondents' impala mark rice.⁵³ These parties market their goods in specialized markets that target different segments of the overall rice market.⁵⁴

Respondents sell their rice only to grocers in the Twin Cities area of Minnesota.⁵⁵ The parties' rice is sold in ten- and twenty-pound bags that are often placed on pallets in grocery stores.⁵⁶ Zarghouna Bakhtari testified that bags of rice are sometimes mixed together on store shelves or on pallets.⁵⁷ While there is no other evidence to

trademark until shortly after my husband passed away in 2016. Capital's final purchase of rice from Global was in June of 2020.").

⁵³ 21 TTABVUE 2-3 (Osman declaration); 14 TTABVUE 3-4 (Nazifa Bakhtari declaration).

⁵⁴ Respondents describe the markets they serve in the following manner:

Capital has four segments of markets that it sells rice products to; each brand Capital sells has its own market. The markets are: Royal brand rice for the mainstream and Indian market; Aahu Barah rice for the Afghani and Pakistani market; Al Afia rice for the Somali market; and the Three Deer brand rice for the oriental market.

Id. at 3. Petitioner seems to also view the market as having distinct segments, as Nazifa Bakhtari explains:

Basmati rice is a variety of long, slender grain, aromatic rice that is traditionally grown in India, Pakistan and Nepal, and is popular in the Middle Asian, South Asian, Middle Eastern and East African communities in this country. These communities in the United States includes people with a heritage from Afghanistan, Pakistan, India, Persia (Iran), Tajikistan, Uzbekistan, Nepal, Turkmenistan, Iraq, Saudi Arabia, Lebanon, Jordan and Somalia. The rice has also been introduced by my father in the Haitian community in the United States.

14 TTABVUE 4-5.

⁵⁵ 21 TTABVUE 7.

⁵⁶ 14 TTABVUE 35 (providing a photo of a pallet of Respondents' rice).

⁵⁷ *Id.* at 35-36 ("We noticed it has become a common practice to mix Global's bag and infringing bags among each other either on pallets or on shelves. There are even times where

support the latter point, Ms. Bakhtari's testimony, together with Mr. Osman's testimony, show that the parties goods are sold in some of the same stores and in the same geographic area. However, there is no indication as to whether a significant number of consumers have been exposed to both parties' rice, given that Respondent only sells its rice in the twin cities area of Minnesota.

Respondents have shown the existence of conditions that could lead to actual confusion in the market. The parties have operated in identical, specialized trade channels, and under such circumstances, it is reasonable to expect that some reports of confusion would have arisen if there is a likelihood of confusion. The flaw in this argument is that Respondents were just getting their new impala mark rice product started during this period. There is no evidence of Respondents' sales volume, the number of stores it was in, or other contextual evidence. Without such evidence, we cannot quantify the importance of the five years of coexistence without reports of actual confusion, particularly given the limited overlap in geographic area.

To summarize, there is no actual confusion evidence in the record.⁵⁸ That normally would be the end of the analysis. But in this case, the evidence shows the trade channels overlap in a close and specialized way. We cannot say anything more on this

the distributors would put their rival bags on top of ours and make it appear like it was the same group of rice.”).

⁵⁸ We do not consider Nazifa Bakhtari's receipt of the wrong product an instance of actual confusion, as we explained above. Zarghouna Bakhtari, however, testified that the parties' goods are sold through some of the same stores in the Minnesota area, confirming the overlap in trade channels. *Id.* at 35-36.

point, however, because we lack key contextual evidence. Having considered all the arguments and evidence, we find these factors neutral.

F. *DuPont* Factors Nine, Ten and Twelve

Petitioner presents arguments under every *DuPont* factor. It is rare that every factor will be relevant in a single case. This is **not** such a case. The ninth factor, for example, stands for the following proposition: “If a party in the position of plaintiff uses its mark on a wide variety of goods, then purchasers are more likely to view a defendant’s related good under a similar mark as an extension of the plaintiff’s line.” *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *14 (TTAB 2020). This factor may be relevant when the goods are different, but it adds nothing to the analysis when the goods are identical, as they are here. No line extension is needed to place the parties’ goods into direct competition. Thus, the ninth *DuPont* factor is neutral.

The tenth *DuPont* factor addresses any market interface evidence. Petitioner raises the factor, and then acknowledges, “None of these matters are present in this proceeding.”⁵⁹ Accordingly, the tenth *DuPont* factor is also neutral.

The twelfth *DuPont* factor refers to the extent of potential confusion, but it is not meant to repeat the entire analysis conducted under the other factors. There is no specific evidence suggesting that any potential confusion will be either de minimis or substantial, the inquiry mentioned in the twelfth factor, so we also treat this factor as neutral.

⁵⁹ 27 TTABVUE 52.

G. *DuPont* Factor Eleven

The eleventh *DuPont* factor considers “the extent to which [a defendant] has a right to exclude others from use of its mark on its goods.” *DuPont*, 177 USPQ at 567.

Here, under this *DuPont* factor, Petitioner invokes its own policing efforts. However, as explained above, the eleventh *DuPont* factor does not concern Petitioner’s policing efforts, but instead focuses on Respondents. There is no evidence that Respondents have “attempted to assert [their] rights so as to ‘exclude’ anyone else from using [the same mark] or any similar mark.” *McDonald’s Corp. v. McSweet*, 112 USPQ2d 1268, 1284-85 (TTAB 2013). The eleventh factor therefore is neutral in our analysis. *DeVivo*, 2020 USPQ2d 10153, at *15.

H. *DuPont* Factor Thirteen – Respondents’ Intent

Much of Petitioner’s position is based on its assertions of bad faith against Respondents. The declarations of Nazifa Bakhtari and Zarghouna Baktari are filled with allegations of wrongdoing, but offer only circumstantial evidence based on the products’ trade dress and Respondent Capital Distributors, LLC’s prior role as a distributor of Petitioner’s fawn mark rice. We evaluate this argument below, but we stress at the outset that there is no objective evidence of bad faith in the record.

In arguing that Respondents acted in bad faith, Petitioner points out that Respondent Capital Distributors, LLC was a distributor for Petitioner’s rice.⁶⁰ The founder of Petitioner’s business died in 2016, and both Nazifa Bakhtari and

⁶⁰ 14 TTABVUE 3-4.

Zarghouna Baktari suggest Capital Distributors took advantage of that fact to copy Petitioner's trademarks and trade dress.⁶¹ But the only real evidence Petitioner offers to support these allegations is the appearance of the two product bags, which it argues are similar to each other, but different from other brands, as an image Petitioner created suggests.



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Based on this comparison, Petitioner's witnesses note the following similarities between its bag (far left) and Respondents' bag (just right of Petitioner's bag):

- Both bags are a non-woven material with a plastic interior with a printed brown mesh look that gives the bag the appearance of an old-fashioned jute bag.
- Both bags have a green decorative border around the perimeter of the bag. The green border on both bags has decorative corners.
- Both bags use the same color scheme.
- Capital's bag has the words AL AFIA across the top, which is similar to Global's AAHU BARAH trademark in look and placement on the bag.
- Both bags have a red starburst on the right side that says Supreme Quality.

⁶¹ *Id.* at 4 (“I believe that Capital selected a trademark so similar to Global’s U.S. Trademark Registration Nos. 3,239,488 and 3,966,152 because Capital felt that Global would not object to their use of a similar trademark after my father died.”) (Nazifa Bakhtari declaration); *Id.* at 30 (Zarghouna Bakhtari declaration).

⁶² *Id.* at 10.

- Both bags have a box on the left side of the bag that says “Net WT.”
- Both bags have the look of stitching on the top of the bag.
- Both bags have a box on the right side of the bag with the weight of the bag.
- Capital puts its name in the same location on the bag where Global places its name.⁶³

We provided above images of four different basmati rice products available in the market, and those products share many of the features Petitioner noted. Three of those products are reproduced below.



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These three products use either jute or have a plastic exterior printed to look like an “old-fashioned jute bag.” All three have a green border, with decorative corners. The bags use the same color scheme and two of the three have red starbursts with the words “SUPREME QUALITY.” All three bags show the net wt. in the same area and with a red border. Each bag features a word mark near the top.

⁶³ *Id.* at 7.

⁶⁴ 21 TTABVue 27.

⁶⁵ *Id.* at 23.

⁶⁶ *Id.* at 31.

Exactly the same features that Petitioner identifies as evidence of bad faith copying are present on at least three other similar products on the market. This evidence shows that there is nothing striking about the trade dress Petitioner and Respondents use with their rice. Respondent, Capital Distributors, LLC, offers a rice that competes, at least to some extent, with Petitioner's rice, but competition, standing alone, is not evidence of bad faith.

Respondents submitted testimony that their impala mark was selected for cultural reasons. Mr. Osman, owner of the Respondents, is a Somali-American who lived in a large refugee camp in Garissa County, Kenya before he emigrated to the United States.⁶⁷ He explains that the impala has special significance with Somali-Americans.⁶⁸ While Nazifa Bakhtari opined that Respondents' impala "appears to really be a deer," Petitioner offered no evidence to rebut any of Mr. Osman's story about his adoption of the impala mark.⁶⁹ We find no evidence to support Petitioner's aggressive allegations of bad faith. The thirteenth *DuPont* factor is neutral.

I. Weighing the Likelihood of Confusion Factors

The goods are identical and the trade channels overlap. These two factors suggest confusion is likely. Indeed, Petitioner correctly notes that when "the goods at issue

⁶⁷ 21 TTABVUE 4-5 ("Garissa County hosts the largest refugee camp in Africa. Most of the Somali, Ethiopian, and Sudanese refugees in America have, at one point in their life, lived in the Garissa County refugee camp.").

⁶⁸ *Id.* at 5 ("Because of the impala's symbolism, I made it a feature of Capital's brand.").

⁶⁹ Both parties introduced evidence about animals. Petitioner submitted numerous Internet materials, apparently to show that deer and impalas are similar. 12 TTABVUE. Respondents submitted materials to show the significance of the impala to Somalis and Somali refugees. 18 TTABVUE.

are identical, the degree of similarity necessary to support a conclusion of likely confusion declines.” *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (internal quotation marks and citation omitted).

While less similarity is needed, at least some similarity is required to cause confusion. The marks at issue here are not similar. This factor weighs heavily against a finding that confusion is likely. Petitioner’s fawn marks are not commercially strong, given the evidence of other uses of deer, or similar animals, on other rice brands. The *DuPont* strength factors (five and six), therefore, also suggest that confusion is not likely. While the record demonstrates an overlap in the geographic markets of the parties’ rice products, and despite the five-year co-existence of the parties’ respective marks, there is nonetheless no evidence of actual confusion evidence. The actual confusion factor, therefore, is neutral. Similarly, ??

Petitioner offered no evidence, beyond the declarations of Nazifa Bakhtari and Zarghouna Baktari to support its allegations of bad faith and we find this factor neutral, as are the remaining factors.

In sum, we have two factors—similarity of the goods and trade channels—that favor Petitioner. We have two factors—lack of similarity of the marks and the weakness of Petitioner’s fawn marks—that favor Respondents. The remaining factors are neutral. The likelihood of confusion analysis, however, is not merely a counting of factors. It requires assigning appropriate weight to the various factors. In this case, the lack of similarity of the marks is the most important factor. At least some threshold level of similarity is required to cause a likelihood of confusion. There is

almost no similarity in the marks at issue here, beyond the fact that both feature similar types of animals. This fact outweighs the identical goods and trade channels. When the strength factor is added to the balance, the result is clear. Petitioner has failed to prove, by a preponderance of the evidence, that confusion is likely.

Decision: The petition to cancel is **denied**.