

This Opinion is Not a
Precedent of the TTAB

Mailed: January 22, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

In re Eastside Food Cooperative

Serial No. 97253512

Caroline L. Marsili of Carlson, Caspers, Vandenburg & Lindquist, P.A.,
for Eastside Food Cooperative.

Howard Levine, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

Before Lykos, Adlin and Brock, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Eastside Food Cooperative seeks registration of the composite word and
design mark shown below



(“FOOD CO-OP” disclaimed) for “retail grocery store services, namely, cooperative
grocery store services provided by a food distribution outlet organized as a cooperative

owned and governed by its members,” in International Class 35.¹ The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the registered mark EASTSIDE MARKETPLACE, in standard characters (“MARKETPLACE” disclaimed), for “supermarkets,” also in International Class 35,² that it is likely to cause confusion. After the refusal became final, Applicant appealed and filed a request for reconsideration that was denied. Applicant and the Examining Attorney filed briefs.

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003).³ We must consider each *DuPont* factor about which there is evidence and

¹ Application Serial No. 97253512, filed February 4, 2022 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first use anywhere and in commerce on March 1, 2016. The application includes this description of the mark: “The mark consists of the wording ‘EASTSIDE FOOD CO-OP’ in a stylized font with the words ‘FOOD CO-OP’ centered below the word ‘EASTSIDE,’ all wording centered below the stylized image of a carrot containing a stylized letter ‘E’.”

² Registration No. 4726965, issued April 28, 2015; Section 8 Declaration accepted; Section 15 Declaration acknowledged.

³ As part of an internal Board pilot program to broaden acceptable forms of legal citation in Board cases, citations in this opinion are in the form recommended in TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 101.03 (2024). This opinion cites U.S. Court of Appeals decisions by the page numbers on which they appear in the Federal Reporter (e.g. F.2d, F.3d, or F.4th). For Board opinions, this decision cites to the Westlaw legal database.

argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 1381 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”).

A. The Services, and Their Channels of Trade and Classes of Consumers

The second *Du Pont* factor considers the “similarity or dissimilarity and nature of the ... services as described in an application or registration.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018) (quoting *Du Pont*, 476 F.2d at 1361). Here, Applicant’s and Registrant’s services are legally identical. Specifically, Registrant’s “supermarkets” encompass retail grocery store services, including Applicant’s “retail grocery store services ... organized as a cooperative owned and governed by its members.” *See In re Hughes Furniture Indus., Inc.*, Ser. No. 85627379, 2015 WL 1734918, at *3 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”). Applicant’s arguments to the contrary, 6 TTABVUE 19-21,⁴ are unpersuasive.

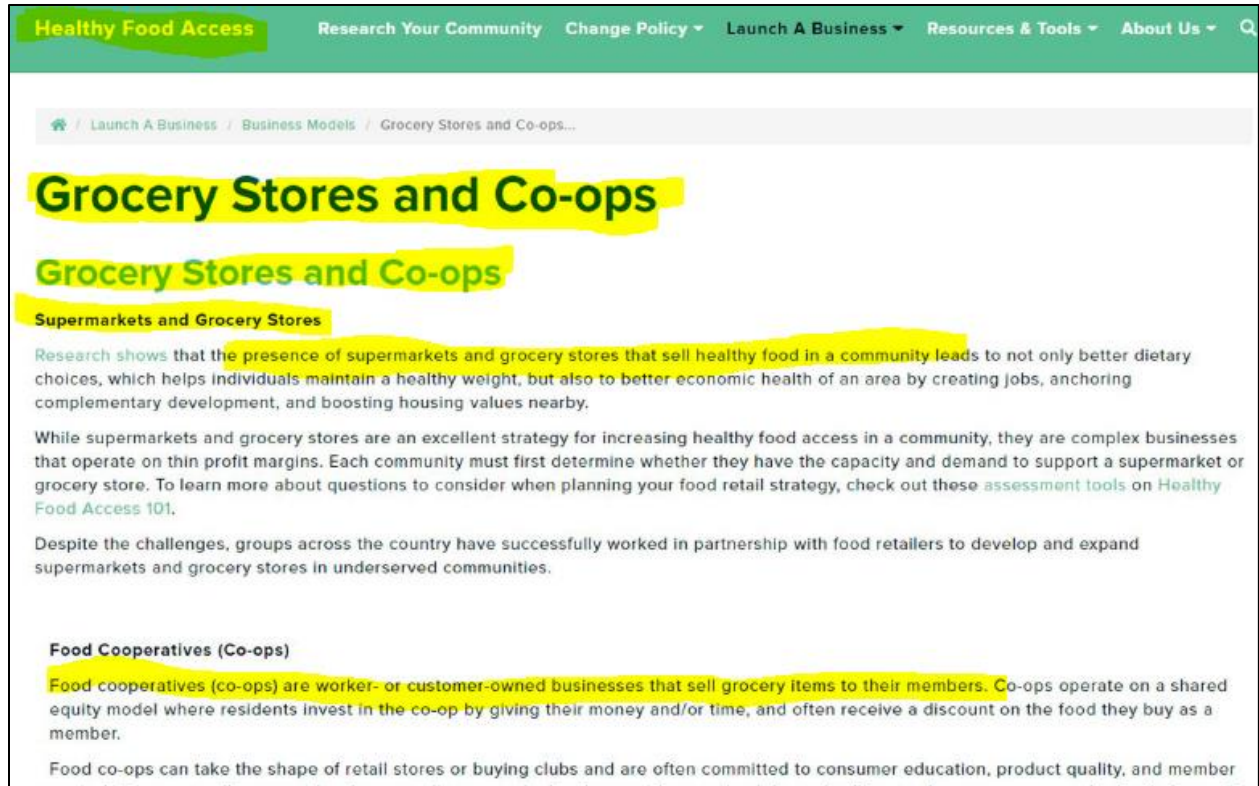
In fact, according to evidence Applicant itself introduced, supermarkets and food cooperatives, or “food co-ops,” are both a type of grocery store. Indeed, a

⁴ Citations to the appeal record are to TTABVUE, the Board’s online docketing system. The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

“supermarket” is defined as “a self-service retail market selling especially foods and household merchandise.” December 28, 2023 Request for Reconsideration TSDR 32;⁵ *see also* June 28, 2023 Office Action TSDR 8 (essentially identical American Heritage Dictionary definition). According to Wikipedia, a “supermarket is a self-service shop offering a wide variety of food, beverages and household products, organized into sections. This kind of store is larger and has a wider selection than **earlier grocery stores ...**” December 28, 2023 Request for Reconsideration TSDR 34, 36 (emphasis added). In other words, a supermarket is a modern type of grocery store. As the Wikipedia entry for “supermarket” states, “[i]n **everyday U.S. usage**, however, **‘grocery store’ is often used to mean ‘supermarket’.**” *Id.* at 34 (emphasis added). We find this assessment of how United States consumers use the term “grocery store” (essentially as a synonym for “supermarket”) credible, as it is consistent with not just dictionary definitions, but other evidence of record.

For example, the Healthy Food Access website features a page about “Grocery Stores and Co-ops,” which includes a subsection entitled “Supermarkets and Grocery Stores,” as shown below:

⁵ merriam-webster.com/dictionary/supermarket. Citations to the application file are to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) online database, by page number, in the downloadable .pdf format.

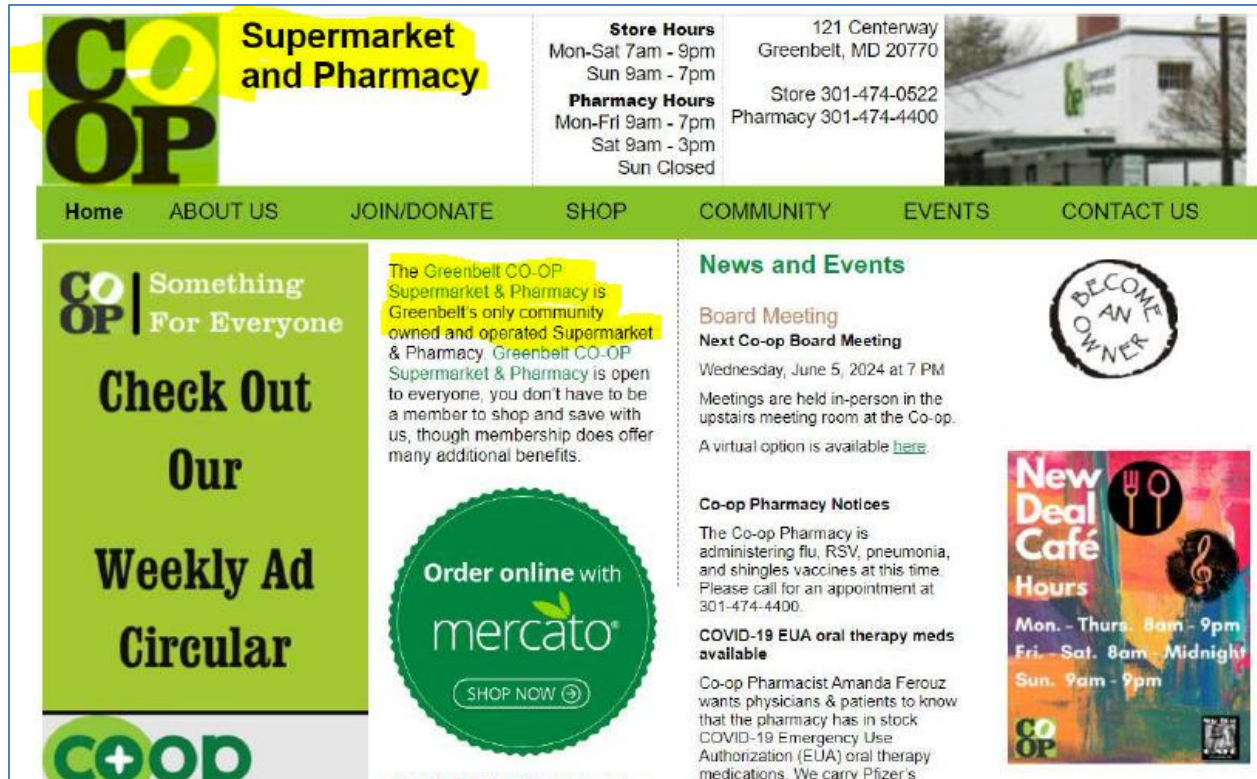


December 28, 2023 Request for Reconsideration TSDR 30 (highlighting added). As shown, the website categorizes grocery stores, supermarkets and food co-ops together, and indicates that all three sell food and “grocery items.” In other words, food co-ops such as Applicant and supermarkets such as Registrant both sell food via retail stores.

Wikipedia indicates that a food cooperative or “food co-op” is “a food distribution outlet organized as a cooperative,” meaning that “decisions regarding the production and distribution of its food are chosen by its members.” *Id.* at 31. Similarly, the National Cooperative Business Association CLUSA International website asks “What is a food co-op? What makes it different from your typical grocery store?,” and answers the question as follows: “These organizations are member-based groups securing access to high-quality food at competitive prices. The cooperative movement has

changed how millions of Americans shop for food.” *Id.* at 38. According to the “grocery.coop” website, “[a] food co-op is a grocery store owned by folks in their community (and by you, if you choose).” November 18, 2022 Office Action TSDR 8. In other words, the difference between “food co-ops” and “supermarkets” (or grocery stores) is not in the type of services they offer, because both offer food to customers via retail stores, but in how they are organized, managed and owned.

This is clear from other evidence of record. Specifically, The Fredericksburg Food Co-op refers to itself as “a full-service community-owned grocery store.” May 23, 2024 Denial of Request for Reconsideration TSDR 12. And an article on the Taste of Home website about “food co-ops” indicates that joining one “can help you save money at the grocery store.” *Id.* at 22. Sometimes, “co-ops” also refer to themselves as “supermarkets.” For example, according to its website, “[t]he Greenbelt **CO-OP Supermarket & Pharmacy** is Greenbelt’s only **community owned and operated Supermarket & Pharmacy**,” as shown below:



May 23, 2024 Denial of Request for Reconsideration TSDR 9 (emphasis and highlighting added). Thus, the record as a whole clearly establishes that the services are legally identical.

Moreover, because Applicant's services are legally identical to Registrant's, we presume that the channels of trade and classes of purchasers for those legally identical services also overlap. *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Rsch. Inst.*, Opp. No. 91190361, 2011 WL 4090447, at *6 (TTAB 2011).

The legal identity of the services and their overlapping channels of trade and classes of purchasers not only weigh heavily in favor of finding a likelihood of

confusion, but also reduce the degree of similarity between the marks necessary to conclude that there is a likelihood of confusion. *In re Viterra*, 671 F.3d at 1360; *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348 (Fed Cir. 2010).

B. Strength of Registrant’s Mark

Before addressing the marks themselves, we consider the strength of the cited mark, to ascertain the scope of protection to which it is entitled. There are two types of strength: conceptual and commercial. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength ... and its marketplace strength ...”).

Here, Applicant argues, based almost exclusively on a number of third-party registrations, that “[t]he term EASTSIDE is already diluted in the fields of food-related services, restaurants, and food and beverage,” 6 TTABVUE 15-19 (argument); December 28, 2023 Request for Reconsideration TSDR 76-127 (third-party registrations). Applicant explicitly states that its argument goes to the sixth *Du Pont* factor, which considers “the number and nature of similar marks **in use on similar goods** [or services].” 6 TTABVUE 15 (emphasis added) (citations omitted). We disagree that Applicant has shown “use” of EASTSIDE on “similar” services, or that the cited mark is commercially weak.

In fact, with only a single exception, the third-party registrations upon which Applicant relies are accompanied by “no evidence of the extent of the use of the marks in commerce,” and thus “do not diminish the commercial strength of” the cited mark. *In re Embiid*, Ser. No. 88202890, 2021 WL 2285576, at *16 (TTAB 2021) (quoting *Tao Licensing, LLC v. Bender Consulting Ltd.*, Canc. No. 92057132, 2017 WL 6336243, at

*14 (TTAB 2017)). *See also Mighty Leaf Tea*, 601 F.3d at 1347. This is because “third-party registrations are not evidence of third-party use of the registered marks in the marketplace, for purposes of the sixth *du Pont* factor.” *In re Davey Products Pty Ltd.*, Ser. No. 77029776, 2009 WL 2420527, at *7 (TTAB 2009) (citing *Olde Tyme Foods Inc. v. Roundy’s Inc.*, 961 F.2d 200, 204 (Fed. Cir. 1992)); *In re Thor Tech, Inc.*, Ser. No. 78634024, 2009 WL 1098997, at *6 (TTAB 2009). *See also AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406 (CCPA 1973) (“The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.”).

The only exception, for which Applicant has introduced evidence of third-party use, is LOWER EAST SIDE for whiskey. December 28, 2023 Request for Reconsideration TSDR 128. This mark is registered for “Scotch whisky” (Reg. No. 5796442). *Id.* at 114. A single example of third-party use would not be enough to establish commercial weakness of EASTSIDE MARKETPLACE. By no measure may a single use be considered “ubiquitous” or “considerable.” *Cf. In re i.am.symbolic, LLC*, 866 F.3d 1315, 1329 (Fed. Cir. 2005) (citations omitted).

Moreover, even if there was evidence of use of a significant number of third-party marks, which there is not, and we could consider all of them, which we cannot,⁶ none

⁶ We have not counted each commonly-owned variation of a single mark. For example, we have counted EASTSIDE TACOS in standard characters, but not the commonly-owned variation EASTSIDE TACOS & Design, because both of these variations of EASTSIDE TACOS have a single owner. December 28, 2023 Request for Reconsideration TSDR 78-81.

of these marks are registered for the supermarket/grocery store services at issue in this case, greatly reducing their probative value. *See Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1324-25 (Fed. Cir. 2018); *In re i.am.symbolic, LLC*, 866 F.3d 1315, 1329 (Fed. Cir. 2017) (“Symbolic has not pointed to any record evidence to support a finding that multiple third parties use the mark I AM for the listed goods in its class 3 and 9 applications.”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877-78 (Fed. Cir. 1992) (“The relevant *du Pont* inquiry is ‘[t]he number and nature of similar marks in use on *similar goods*’ ... It is less relevant that ‘Century is used on unrelated goods or services such as ‘Century Dental Centers’ or ‘Century Seafoods.’”) (quoting *Weiss Assocs. v. HRL Assocs.*, 902 F.2d 1546, 1548 (Fed. Cir. 1990)); *In re Inn at St. Johns, LLC*, Ser. No. 87075988, 2018 WL 2734893, at *3 (TTAB 2018). In short, Applicant has not established that the cited mark is commercially weak.

While the third-party registrations Applicant introduced “may bear on conceptual weakness if a term is commonly registered for similar goods or services,” *In re Embiid*, 2021 WL 2285576 at *17, here, as indicated, the registrations upon which Applicant relies do not identify “similar goods or services.” Rather, the third-party registrations upon which Applicant relies identify the following goods or services:

restaurant or bar services (Reg Nos. 97452247, 6852105, 6368572, 6023553, 5579310, 4183079, 4327725, 3621637, 1802958); December 28, 2023 Request for Reconsideration TSDR 76, 80-83, 89-90, 98-99, 108-11, 120-21, 126-27);

Furthermore, we have not considered the cited Registration, because it is not owned by a third-party. *Id.* at 102-03.

alcoholic beverages (Reg. Nos. 6849003, 6557704, 6375490, 6681750, 5425040, 5465350, 5271030, 5787992, 5781840, 5171778, 5796442, 3880246,); *id.* at 84-89, 92-97, 100-101, 104-07, 112-15, 122-23;

food products (Reg. Nos. 6023553, 2268448); *id.* at 89-90, 124-25; and

entertainment services (Reg. Nos. 4385852,); *id.* at 116-17.

Applicant argues that “the goods and services in [these] third-party registrations are similar to those in Applicant’s Mark and Cited Mark,” based on a separate collection of third-party registrations identifying both supermarket/grocery store services and “restaurant, catering, and bar services, food items, and beverage items.” 6 TTABVue 16 (argument); December 28, 2023 Request for Reconsideration TSDR 39-75 (separate collection of third-party registrations). We are not persuaded, because Applicant’s mark is much closer to Registrant’s mark than the marks in the cited third-party registrations. Indeed, Applicant’s mark identifies services legally identical to Registrant’s services, while the third-party registrations upon which Applicant relies identify goods and services which are at best merely related to Registrant’s services.

Nonetheless, we acknowledge that “EASTSIDE” has some conceptual weakness, to the extent it identifies the eastern part of a town or place. At the same time, however, because the cited mark is registered on the Principal Register without a claim of acquired distinctiveness, we must presume that EASTSIDE MARKETPLACE is inherently distinctive, i.e., that it is at worst suggestive of Registrant’s services. 15 U.S.C. § 1057(b) (registration is “prima facie evidence of the

validity of the registered mark”); *In re Fiesta Palms, LLC*, Ser. No. 76595049, 2007 WL 950952, at *3 (TTAB 2007) (when mark is registered on the Principal Register, “we must assume that it is at least suggestive”). *See also In re Dixie Rests., Inc.*, 105 F.3d 1405, 1408 (Fed. Cir. 1997)). As an inherently distinctive, registered mark, EASTSIDE MARKETPLACE is entitled to protection against confusingly similar marks. The question we answer below is whether the parties’ marks are close enough for confusion to occur despite Registrant’s mark being conceptually somewhat weak.

C. The Marks

We consider the marks “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371 (Fed. Cir. 2005) (quoting *DuPont*, 476 F.2d at 1361). Here, the marks are similar because they both include and begin with “EASTSIDE,” and different because Applicant’s mark includes a design while Registrant’s does not, and the trailing term in Applicant’s mark (“FOOD CO-OP”) is not the same as the trailing term in Registrant’s mark (“MARKETPLACE”). We find that the marks’ similarities outweigh their differences.

In fact, the term EASTSIDE is the dominant portion of both marks, for several reasons. First, it is the most distinctive literal element of the marks because the trailing terms in each mark are descriptive if not generic, and disclaimed. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 947 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 1060 (Fed. Cir. 1985)); *see also In re*

Dixie Rests., Inc., 105 F.3d 1405 (Fed. Cir. 1997) (DELTA, not the disclaimed term CAFÉ, is the dominant portion of the mark THE DELTA CAFÉ).

Second, “EASTSIDE” is the first literal element of both marks, and the marks’ trailing terms are less significant. *In re Detroit Athletic*, 903 F.3d at 1303 (“The identity of the marks’ initial two words is particularly significant because consumers typically notice those words first.”); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, Opp. No. 74797, 1988 WL 252340, at *3 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”).

Third, while Applicant’s mark includes a design, here, as is typically the case, the mark’s literal element is entitled to more weight in our analysis than the design. *In re Viterra Inc.*, 671 F.3d at 1362 (“the verbal portion of a word and design mark likely will be the dominant portion”); *In re Appetito Provisions Co. Inc.*, Ser. No. 73423405, 1987 WL 124293 at *1 (TTAB 1987) (holding that “if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services” and “because applicant’s mark shares with registrant’s mark that element responsible for creating its overall commercial impression, the marks are confusingly similar”). Indeed, Applicant describes its design as “the stylized image of a carrot consisting a [sic] stylized letter ‘E’.” As a result, the design is not particularly distinctive, because the carrot is suggestive of food typically found in grocery stores, perhaps especially “food

co-ops,”⁷ and the “E” merely highlights the first letter of the first, dominant term in Applicant’s mark.

Finally, the term “marketplace” means “an open square or place in town where markets or public sales are held.” May 17, 2023 Office Action response TSDR 21. Thus, a “marketplace” could include a “food co-op,” and as a result consumers could be confused into thinking that the EASTSIDE FOOD CO-OP grocery store is part of, or affiliated with, the EASTSIDE MARKETPLACE supermarket.

In fact, while the terms “FOOD CO-OP” in Applicant’s mark and “MARKETPLACE” in Registrant’s mark make the marks look and sound somewhat different, this difference is outweighed by the marks’ similarities. Not only do the marks both begin with the dominant term EASTSIDE, but the marks’ remaining terms convey similar meanings, specifically places where products are sold. Thus, some consumers could perceive “EASTSIDE” as a house mark that identifies affiliated stores or markets.

Indeed, the marks both convey the meaning, and create the commercial impression, of a place on the “eastside” of a town or city that sells goods. And, because Applicant’s and Registrant’s services are legally identical, the likelihood of confusion is increased, as consumers would likely perceive the marks as identifying food sellers with either a corporate connection, or in the same location. Some consumers could very well shorten Applicant’s mark or Registrant’s mark to just “EASTSIDE,”

⁷ Food co-ops “typically offer natural foods.” December 28, 2023 Request for Reconsideration TSDR 31.

especially given the descriptiveness of the disclaimed terms “FOOD CO-OP” and “MARKETPLACE.” See *In re Bay State Brewing Co., Inc.*, Ser. No. 85826258, 2016 WL 1045677, at *3 (TTAB 2016) (“we also keep in mind the penchant of consumers to shorten marks”); *United Rum Merchs. Ltd. v. Fregal, Inc.*, 1982 WL 52025, at *3 (TTAB 1982); *Big M, Inc. v. U.S. Shoe Corp.*, 1985 WL 71976, at *3 (TTAB 1985) (“we cannot ignore the propensity of consumers to often shorten trademarks”). And, because the terms “FOOD CO-OP” and “MARKETPLACE” could both describe food sellers, some consumers could perceive the marks as both identifying the same EASTSIDE food co-op or food market.

In short, the marks are more than similar enough in their entireties that confusion is likely despite the conceptual weakness of the cited mark.

II. Conclusion

The services are legally identical, and their channels of trade and classes of consumers are presumed to overlap. This reduces the degree of similarity between the marks necessary to conclude that there is a likelihood of confusion. In any event, the marks are similar by any measure, especially because the dominant portion of both of them is identical, and the remaining portions of the marks are descriptive and convey similar meanings. These factors significantly outweigh the conceptual weakness of Registrant’s mark. Indeed, Applicant’s involved application identifies services legally identical to Registrant’s, and Applicant’s mark is more similar to Registrant’s mark than any of the third-party registered marks upon which Applicant relies. See *Specialty Brands*, 748 F.2d at 675; *Sabhani v. Mirage Brands, LLC*, Canc. No. 92068086, 2021 WL 6072822, at *13 (TTAB 2021) (“while the registered marks

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all contain the word ‘MIRAGE,’ they contain additional elements that cause many of them to be less similar to Petitioner’s mark than Respondent’s marks are”); *In re I-Coat Co., LLC*, Ser. No. 86802467, 2018 WL 2753196, at *6 (TTAB 2018) (“none of the marks [in third-party registrations] are as similar to the mark in the cited registration as is Applicant’s mark”); *Nike, Inc. v. WNBA Enters., LLC*, Opp. No. 91160755, 2007 WL 763166, at * (TTAB 2007) (“Simply put, none of the marks in these registrations and applications is as similar to opposer’s mark as applicant’s mark.”). Confusion is likely.

Decision: The refusal to register Applicant’s mark under Section 2(d) of the Trademark Act is affirmed.