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Mailed: October 29, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sun Chlorella Corp.

Serial Nos. 97350448 and 97350457

The following corrected version of the Board's October 29, 2024 decision in the above-captioned consolidated appeal corrects the second page of the decision to indicate that: "We reverse the refusal to register in both applications."

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sun Chlorella Corp.


Serial Nos. 97350448 and 97350457¹

Rebecca Liebowitz and Sahar Ahmed of Venable LLP.

Lee-Anne Berns, Trademark Examining Attorney, Law Office 118,
Michael Baird, Managing Attorney.

Before Cataldo, Greenbaum and Lavache,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Sun Chlorella Corp., filed applications to register on the Principal Register the marks SUN CHLORELLA (in standard characters) and , both identifying the following goods: “Udon noodles made in whole or significant part of chlorella,” in International Class 30.²

¹ These appeals were consolidated in a Board order issued on May 15, 2024. 9 TTABVUE. In this decision, we will refer to the briefs and record in application Serial No. 97350448 unless otherwise noted.

² Application Serial Nos. 97350448 and 97350457 were filed on April 6, 2022 under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), both based upon an assertion of a bona fide intent to use of the mark anywhere and in commerce. “CHLORELLA” is disclaimed in both marks. Application Serial No. 97350457 includes the following description of the mark and

The Trademark Examining Attorney refused registration of Applicant's marks under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d) on the ground of likelihood of confusion with six registered marks, all issued to the same entity, including the following:

SUN NOODLE ("NOODLE" disclaimed), identifying

noodles; instant noodles; meal kits consisting primarily of noodles; noodles and sauce mixes combined in unitary packages; noodles and seasoning mixes combined in unitary packages; noodles, sauce and processed vegetables combined in unitary packages; noodles, sauce, and seasoning toppings combined in unitary packages; noodles, seasonings, edible oil, and flavorings combined in unitary packages; noodle-based prepared meals; seasoning mixes for soups; flavourings for soups; alimentary paste; mix for making combined noodle and sauce dish; dumpling wrappers and skins in International Class 30.³

Applicant appealed to this Board.⁴ The appeal is fully briefed. We reverse the refusal to register in both applications.

color statement: The mark consists of a red stripe over a blue stripe over a green stripe, across which, from end to end, is the wording "SUN CHLORELLA" in white, with the words "SUN" and "CHLORELLA" connected by a white circle with a blue center that is straddling the center, blue stripe. The color(s) red, white, blue and green is/are claimed as a feature of the mark.

³ Registration No. 4574991 issued on July 29, 2014. First Renewal.

⁴ All citations to documents contained in the Trademark Status & Document Retrieval (TSDR) database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. *See, e.g., In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1402 n.4 (TTAB 2018). References to the briefs on appeal refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, *2 n.1 (TTAB 2020).

I. Likelihood of Confusion

We base our determination of likelihood of confusion under Trademark Act Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019).

We have considered all *DuPont* factors that are relevant. See *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.”)); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the relatedness of the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (the

Serial Nos. 97350448 and 97350457

“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”); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018).

A. Focus on Reg. No. 4574991

For purposes of our determination, we will focus our likelihood of confusion analysis on the mark SUN NOODLE (“NOODLE” disclaimed), identifying

noodles; instant noodles; meal kits consisting primarily of noodles; noodles and sauce mixes combined in unitary packages; noodles and seasoning mixes combined in unitary packages; noodles, sauce and processed vegetables combined in unitary packages; noodles, sauce, and seasoning toppings combined in unitary packages; noodles, seasonings, edible oil, and flavorings combined in unitary packages; noodle-based prepared meals; seasoning mixes for soups; flavourings for soups; alimentary paste; mix for making combined noodle and sauce dish; dumpling wrappers and skins in International Class 30.

in cited Reg. No. 4574991 (hereinafter, “cited registration”). When that mark is considered vis-à-vis the applied-for marks and identified goods, it is that mark that is most likely to support a finding of likelihood of confusion. *See, e.g., In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010). If likelihood of confusion is found as to the mark and goods in this registration, it is unnecessary to consider the other cited registrations. Conversely, if likelihood of confusion is not found as to the mark and goods in this registration, we would not find likelihood of confusion as to the mark and goods in the other cited registrations. *See, e.g., In re Max Cap. Grp. Ltd.*, 93 USPQ2d at 1245.

B. The Goods, Channels of Trade, and Classes of Customers

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). “This factor considers whether ‘the consuming public may perceive [the respective goods or services of the parties] as related enough to cause confusion about the source or origin of the goods and services.’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard*, 62 USPQ2d at 1004).

We must base our likelihood of confusion determination on the basis of the goods as they are identified in the applications and registration at issue. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976). *See also Octocom*, 16 USPQ2d at 1787 (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed”).

The “noodles” identified in the cited registration encompass Applicant’s more narrowly identified “Udon noodles made in whole or significant part of chlorella.” The goods thus are overlapping and legally identical. *See, e.g., In re i.am.symbolic, llc*, 127

Serial Nos. 97350448 and 97350457

USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014).

With regard to the third *DuPont* factor, the similarity of the trade channels in which the goods are encountered, we must again base our likelihood of confusion determination on the goods as they are identified in the applications and registration at issue. *In re Elbaum*, 211 USPQ at 640; *In re William Hodges & Co., Inc.*, 190 USPQ at 48. *See also Octocom*, 16 USPQ2d at 1787. Because Applicant's goods are legally identical, in part, to the goods in the cited registration, we presume that such goods of Applicant and the registrant move in the same channels of trade and are offered to the same classes of consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (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); *see also American Lebanese Syrian Associated Charities Inc. v. Child Health Rsch. Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994).

Accordingly, the *DuPont* factors relating to the similarity or dissimilarity of the goods and the similarity or dissimilarity of their trade channels heavily favor a finding of likelihood of confusion.

C. Strength or Weakness of the Mark for the Identified Goods

In determining the strength of the cited SUN NOODLE mark or elements thereof, we consider both its inherent strength, based on the nature of the mark itself, and commercial strength or recognition. *See In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength”). “[T]he strength of a mark is not a binary factor,” but instead “varies along a spectrum from very strong to very weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal citations omitted).

“The weaker [the registrant’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.” *Id.* at 1676 (internal citations omitted). *See also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 369 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”).

The fifth *DuPont* factor, the fame of the prior mark, and the sixth *DuPont* factor, the number and nature of similar marks in use for similar goods or services, may be considered in tandem to determine the strength of the cited mark and the scope of

Serial Nos. 97350448 and 97350457

protection to which it is entitled.⁵ *See DuPont*, 177 USPQ at 567; *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017).

Additionally, the Federal Circuit has held that if there is evidence a mark, or an element of a mark, is commonly adopted by many different registrants, that may indicate the common element has some non-source identifying significance that undermines its conceptual strength as an indicator of a single source. *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1364, 2023 USPQ2d 737, at *5-6 (Fed. Cir. 2023); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ ... that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak’”) (quoting *Juice Generation*, 115 USPQ2d at 1674).

We note that the cited registration issued on the Principal Register with a disclaimer of “NOODLE” but without any requirement for a showing of acquired distinctiveness in whole or in part under Section 2(f) of the Trademark Act. *See 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


⁵ Because the owner of the cited registration is not a party to this appeal, and further because the Examining Attorney is under no obligation to demonstrate the fame of the cited mark, we find the fifth *DuPont* factor to be neutral. *In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006) (fame of the mark in a cited registration is not normally a factor in ex parte proceedings).

Serial Nos. 97350448 and 97350457

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.”). We further note there is no evidence that the term “SUN” in any language or its pictorial representation possesses any significance with respect to the “noodles” or any of the other goods identified in the cited registration.

With its April 27, 2023 response to Office action,⁶ Applicant submitted copies of thirty-four live third-party registrations for SUN-formative marks, all identifying various food items. The most probative are the sixteen that identify various types of noodles among their goods. These include:⁷

- Reg. No. 5577347 for the mark SUN DELI FOOD (“DELI FOOD” disclaimed) identifying “noodles, instant noodles ” in Class 30;
- Reg. Nos. 6185296, 5333659 and 5333920 for the mark SUNFAT, SUN

FAT and  (“SINCE 1985” disclaimed) (both translated as

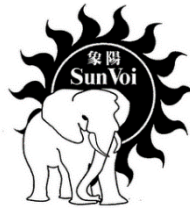
⁶ At 63-124.


⁷ All marks are registered on the Principal Register and presented in standard characters unless otherwise noted. The third-party registrations all are owned by different entities except as noted. For conciseness, the most closely related identified goods are shown.

Any additional registrations in the list that subsequently have been cancelled have no probative value. They are “evidence only of the fact that [they] previously existed.” *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1872 n.2 (TTAB 2011). Any benefits conferred by the registrations, including the evidentiary presumptions afforded by Section 7(b) of the Trademark Act, were lost when the registrations expired. *See, e.g., Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46 (CCPA 1973); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002).


“successful” and “rich”) identifying “Asian noodles, rice noodles” in Class 30;

- Reg. No. 1904123 for the mark SUN LUCK identifying “noodles, won ton wrappers, chow mein noodles” in Class 30;
- Reg. No. 6359113 for the mark SUN RIGHT identifying “noodles” in Class 30;
- Reg. No. 3475663 for the mark GREAT EASTERN SUN identifying “instant noodles, instant udon noodles, noodles” in Class 30;





- Reg. No. 4454687 for the mark  (translated as “Elephant Sun”) identifying “noodles” in Class 30;




- Reg. No. 5549557 for the mark  (translated as “GRASSLAND RED SUN”) identifying “noodles” in Class 30;



- Reg. No. 3433330 for the mark  (“SHIN SUN MI” translated as “fresh taste,” disclaimed) identifying various noodles and pasta in Class 30;

- Reg. No. 3384272 for the mark  identifying “noodles, sauce, and processed vegetables combined in unitary packages” in Class 30;
- Reg. No. 6328028 for the mark RED SUN identifying “prepared food dish consisting of ramen” in Class 30;
- Reg. No. 3680218 for the mark SUNDELIGHT identifying “noodles” in Class 30;



- Reg. No. 5126470 for the mark  identifying “noodle” in Class 30; and
- Reg. Nos. 4297727 and 4774171 for the marks MENU DEL SOL and



(translated as ‘MENU OF THE SUN’) identifying “noodles” in Class 30.

The Examining Attorney argues that Applicant’s third-party registration evidence is insufficient in quantity and in similarity to show that the cited mark SUN NOODLE is conceptually weak.⁸ Specifically, the Examining Attorney contends that,

Specifically, it appears that only one referenced mark, “SUN DELI FOOD” comprises the first term “SUN” combined with highly descriptive or generic food terms. The majority of the registrations feature additional distinctive wording in addition to the “SUN” portion

⁸ 10 TTABVUE 15-16.

of the marks, altering the commercial impression created between these marks and the cited registered marks. For example, the marks “SUN RIGHT”, “SUN LUCK”, “SUN HARVEST”, “SUN BLUSH”, “SUNBASKET”, “SUN VOI” (with a translation of record of “SUN VOI” as “Elephant Sun”), “SUNWISE”, “ASAHI” (with a translation of record of “RISING SUN”) and “MINH DUONG” (with a translation of record as “shining sun”) create significantly different commercial impressions to the applicant's and registrant's marks.⁹

The Examining Attorney concludes that the third-party registration evidence submitted by Applicant has little probative value in showing that the cited mark SUN NOODLE is weak in the context of the relevant goods.

We disagree with the Examining Attorney's assessment of Applicant's third-party registration evidence. We note that this evidence goes not to the commercial strength of the cited mark, but rather to its conceptual strength. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017) (“Use evidence may reflect commercial weakness, while third-party registration evidence that does not equate to proof of third-party use may bear on conceptual weakness if a term is commonly registered for similar goods or services.”) (citing *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976)). Indeed, as previously noted, “third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Juice Generation, Inc.*, 115 USPQ2d at 1675.

⁹ 10 TTABVUE 16.


We acknowledge that the submitted third-party registrations may not be as similar to the registered SUN NOODLE mark as Applicant's SUN CHLORELLA marks. That being said, we note that the distinctive component of the cited mark, i.e., the term SUN (or the foreign equivalent thereof), has been registered for goods identical to those listed in the cited registration in sixteen instances by thirteen different entities, and for arguably related food items in an additional eighteen registrations. The Federal Circuit has held that "extensive evidence of third-party use and registrations is 'powerful on its face,' **even where the specific extent and impact of the usage has not been established.**" *Jack Wolfskin*, 116 USPQ2d at 1136 (citing *Juice Generation*, 115 USPQ2d at 1674). (emphasis added).

Under these circumstances, based on the evidence of record, we accord marks consisting, in whole or in part, of the words "SUN" and its foreign equivalents in connection with noodles a narrow scope of protection. Such marks travel in a crowded field. The term "SUN," whether as an English language term or a term in an Asian language translated to "successful" or "rich," retains a positive connotation suggesting prosperity. These connotations, while not exactly the same in meaning, nonetheless suggest a beneficial outcome from the goods under the SUN marks. When we consider all of the evidence of record, we find that the cited SUN NOODLE mark is conceptually weak. This weighs against finding a likelihood of confusion. *See Primrose Ret. Cmty.*, 122 USPQ2d at 1036 (accordng "significant weight" to "extensive" evidence of third-party use and registration); *see also Juice Generation*, 115 USPQ2d at 1674 ("The weaker [a cited mark], the closer an applicant's mark can

Serial Nos. 97350448 and 97350457

come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.”); *Exxon Corp. v. U.S. Indus., Inc.*, 213 USPQ 393, 396 (TTAB 1982) (“[I]t has often been stated that a party who chooses a weak or suggestive term as its trademark may expect that its competitors will choose marks which are closer to his than would be true if that party had chosen an arbitrary or coined mark.”).

D. The Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s SUN CHLORELLA and  marks and the registered SUN NOODLE mark in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Cap. v. Lion Cap.*, 110 USPQ2d at 1160; *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “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) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); 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.”).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire

Serial Nos. 97350448 and 97350457


marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, 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 entirety. *Nat'l Data*, 224 USPQ at 751. In this case, the highly descriptive or generic wording “NOODLE” in the cited mark contributes far less to the overall commercial impression of the mark than the inherently distinctive wording SUN.

According to a definition introduced into the record by the Examining Attorney with her January 30, 2023 first Office action¹⁰ “chlorella” is defined as “any of a genus (*Chlorella*) of unicellular green algae,” “any of a genus of single-celled green algae that have been grown as a possible source of food” or “a genus of unicellular green algae potentially a source of high-grade protein and B-complex vitamins.” The identification of goods in both applications states that the recited Udon noodles are made in whole or significant part of chlorella. The Examining Attorney also introduced website evidence discussing Applicant’s goods: “Chlorella Udon Noodles by Sun Chlorella (Applicant) contain the freshwater algae known as chlorella that’s

¹⁰ At 31-37.

Serial Nos. 97350448 and 97350457




billed as one of the newest superfoods that's rich in minerals and vitamins like D and B12.”¹¹ Applicant argues: “even though “CHLORELLA” may be considered descriptive of the applied-for goods, it is significant in informing consumers that Applicant’s mark is associated with a particular type of udon noodle containing chlorella green algae.”¹²

Viewing the marks as a whole, SUN CHLORELLA and  marks are similar to the registered SUN NOODLE mark inasmuch as the first term of Applicant’s mark is the same distinctive term “SUN” as the registered mark. Applicant’s marks and the cited mark contain the identical first word “SUN,” followed by the terms NOODLE, describing a broad category of products and CHLORELLA, describing a more specific type of product encompassed by the term NOODLE. The marks thus are similar in appearance and sound.

Moreover, the significance of the term SUN is reinforced by its location as the first word in the marks. *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered”); *see also Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word).

¹¹ At 23-30; 38.

¹² 6 TTABVUE 12.

As discussed above, the cited mark SUN NOODLE and the involved marks SUN CHLORELLA and  similarly suggest noodles or noodles containing chlorella green algae both emanating from a “SUN” brand. With regard to Applicant’s stylized  mark, the cited registration for a standard character mark would give the registrant the right to depict its mark in any form, including the stylized and colored lettering shown in Applicant’s mark. *Citigroup Inc. v. Cap. City Bank Grp, Inc.*, 98 USPQ2d at 1255. In any event, the stylization of Applicant’s  mark is not so distinct that it would serve to distinguish that mark from the registrant’s mark for the similar wording.


“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) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 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.”); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988) (“In appropriate cases, a finding of similarity as to any one factor (sight, sound or meaning) alone ‘may be sufficient to support a holding that the marks are confusingly similar’”) (citations omitted)). Therefore, even if the marks had different meanings, it would not necessarily mean there was no likelihood of confusion.

We recognize the differences between the marks. Nonetheless, viewing the marks as a whole, we find purchasers could mistakenly believe the marks are variations of each other, pointing to a common source. The marks are similar in appearance, sound and meaning and, overall, create similar commercial impressions.

The first *DuPont* factor weighs in favor of finding a likelihood of confusion.

E. Applicant's Prior Registrations


We now consider Applicant's prior registrations under the thirteenth *DuPont* factor which relates "to 'any other established fact probative of the effect of use.'" *In re. Strategic Partners, Inc.*, 102 USPQ2d 1397, 1399 (quoting *DuPont*, 177 USPQ at 567).¹³ With its April 27, 2023 response to Office action¹⁴ Applicant submitted copies of its prior registrations, issued on the Principal Register:

- Reg. No. 4297167 for the mark SUN CHLORELLA (in standard characters, "CHLORELLA" disclaimed, Section 2(f) in part as to the goods identified in Class 3) for "cosmetics, and facial and body creams all containing chlorella," in Class 3; and "dietary supplements, dietary supplements for pets, pet food supplements, and nutritional supplements all containing chlorella," in Class 5;
- Reg. No. 5485820 for the mark  ("CHLORELLA" disclaimed) for "online retail store services in the field of supplements, health and nutrition products, skin care preparations and supplements and nutrition products for pet," in Class 35;

¹³ To the extent Applicant relies upon the so-called *Morehouse* defense, (6 TTABVue 17) *see Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 166 USPQ 715 (CCPA 1969). "The *Morehouse* defense is an equitable affirmative defense which, in appropriate circumstances, may be asserted by a defendant/applicant in an *inter partes* proceeding. . . . This defense does not apply in an *ex parte* context." *Strategic Partners*, 102 USPQ2d at 1399-400.

¹⁴ At 57-62.

Serial Nos. 97350448 and 97350457

- Reg. No. 2767864 for the mark SUN CHLORELLA CREAM (in typed or standard characters,¹⁵ “CHLORELLA” and “CREAM” disclaimed) for “facial and body cream not intended for sunscreen use,” in Class 3; and
- Reg. No. 1341970 for the mark  (in stylized form) for “dietary supplement,” in Class 5.

Applicant argues that it “has been using its SUN CHLORELLA house mark in connection with related goods and services that are related to or made in whole or in part of chlorella since as early as 1971.”¹⁶ “The majority of these marks predate Registrant’s cited marks. Applicant’s marks have peacefully coexisted with Registrant’s marks and the above listed third-party registrations, which cover related goods and services.”¹⁷

The Board’s decision in *Strategic Partners* is instructive. In that case, the applicant owned a registration for a substantially identical mark identifying goods identical in part to those recited in its challenged application that had coexisted with the cited mark for over five years. Because the applicant’s prior registration was over five years old, the Board noted that any challenge thereto by the owner of the cited registration based on a claim of likelihood of confusion would be time-barred under Section 14 of the Act. 102 USPQ2d at 1399. In finding no likelihood of confusion in *Strategic Partners*, the Board provided the following explanation:

¹⁵ 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. A mark depicted as a typed drawing is the legal equivalent of a standard character mark.

¹⁶ 6 TTABVUE 16.

¹⁷ 6 TTABVUE 17.

The present case involves the unique situation presented by the coexistence of applicant's existing registration with the cited registration for over five years, when applicant's applied-for mark is substantially similar to its existing registered mark, both for identical goods. When we consider these facts under the thirteenth du Pont factor, we find in this case that this factor outweighs the others and leads us to conclude that confusion is unlikely.

In this case, Applicant's prior registrations issued between 2013 and 2018 and thus are incontestable, for marks with similar elements identifying goods and services that differ from those at issue herein. Applicant argues:

As to the second factor, Applicant noted that for purposes of likelihood of confusion, the Board has typically found that nutritional and dietary supplements (covered under the above prior registrations) are similar and related to the goods covered under the present application, namely pasta and prepared food products. ... Accordingly, Applicant's present application is more similar and related to its prior registrations than it is to Registrant's cited marks. To further demonstrate the relatedness of the goods and channels of trade of Applicant's current application to its prior registrations, Applicant pointed to numerous third-party registrations covering both noodles and supplements. TSDR printouts of the marks were attached as Exhibit 3 in Applicant's Request for Reconsideration¹⁸

Applicant's argument seeks to extend the "unique" situation presented in *Strategic Partners*, involving substantially identical marks reciting identical goods identified in a prior registration and challenged application to goods that are not identical, but may be shown to be related by evidence in a likelihood of confusion analysis. Applicant has not cited to a precedential decision in which the Board has made such a finding, and we do not feel compelled to extend our previous holding in *Strategic Partners* to this set of facts.

¹⁸ 6 TTABVue 18-19; December 19, 2023 Request for Reconsideration at 110-.

We do not consider, on this record, the issuance of Applicant's earlier registrations to outweigh the other *DuPont* factors. Moreover, it would be improper to give preclusive effect to the decision of the Examining Attorney in granting Applicant's earlier registrations, and the Board is not bound by the prior decisions of examining attorneys in allowing marks for registration. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) ("The [US]PTO is required to examine all trademark applications for compliance with each and every eligibility requirement ... even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect."); *see also In re Boulevard Entm't Inc.*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) ("The fact that, whether because of administrative error or otherwise, some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the agency must forgo applying that standard in all other cases."); *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017).

Indeed, as is often noted by the Board and the courts, each case must be decided on its own merits. The determination of registrability of a mark in another case does not control the merits in the case now before us. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("[D]ecisions regarding other registrations do not bind either the agency or this court."); *see also, In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001); *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001). The issuance of earlier registrations to Applicant does not compel the approval of another if it would otherwise be improper to do so. *See, e.g., In re Perez*,

Serial Nos. 97350448 and 97350457

21 USPQ2d 1075, 1077 (TTAB 1991) (Section 2(d) refusal affirmed even though the cited registration had not been cited against applicant's previous registration, now expired, of the same mark for the same goods).

This *DuPont* factor is neutral.

F. Weighing and Balancing the *DuPont* Factors

We have carefully considered, weighed, and balanced all of the evidence made of record, and the arguments related thereto. *In re Charger Ventures LLC*, 64 F.4th 1375, 1384 (Fed. Cir. 2023) (“[I]t is important . . . that the Board . . . weigh the *DuPont* factors used in its analysis *and* explain the results of that weighing.”). We find the marks to be more similar than dissimilar. The goods and their channels of trade are legally identical. However, evidence of extensive registration by third parties of “SUN” formative marks for goods identical or related to those identified in the cited registration demonstrates that the cited mark is conceptually weak to such an extent that it is entitled to a very narrow scope of protection. We thus find that the cited registration cannot prevent registration of Applicant's involved applications. Applicant's prior registrations for goods and services different from those at issue in its challenged applications are neutral in our analysis. The other *DuPont* factors do not appear to be relevant inasmuch as we have neither arguments nor evidence related thereto.

Decision: The refusal to register Applicant's marks is reversed under Section 2(d) of the Trademark Act.