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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Blanching Company

Serial No. 76443653

Douglas W. Kenyon of Hunton & Williams for American
Blanching Company.

Caryn Glasser, Trademark Examining Attorney, Law Office 108
(Andrew Lawrence, Managing Attorney).

Before Quinn, Holtzman and Ritchie de Larena,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

American Blanching Company filed an application to
register the mark shown below

Cinderella

for "peanut butter." The application is based on a date of first use anywhere of March 1885, and a date of first use in commerce of December 1885.

The trademark 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, when used in connection with applicant's goods, so resembles the previously registered mark shown below



for "coffee, tea, sugar; bread, pastry; candy, chocolate, white chocolate, cocoa mixes, cookies, lollipops, macaroni, pasta, peppermint candy sweets, fruit gummy candies, [and] pretzels"¹ as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.²

By way of background applicant states that its predecessor began using the mark CINDERELLA for a variety

¹ Registration No. 3057988, issued February 7, 2006, alleging first use on August 31, 2002.

² The exhibit accompanying applicant's appeal brief, to which the examining attorney objected due to its untimely submission, has not been considered. Trademark Rule 2.142(d).

of goods, including peanut butter, in 1885. Another predecessor then registered the mark for various food items, including peanut butter, in 1950 (Reg. No. 525873). After a second renewal in 1990, the registration was canceled on June 22, 2001 for failure to file a Section 8 affidavit of continued use. Later in 2001, the common law rights in the mark were assigned to applicant.

With respect to the refusal, applicant argues that the marks are different, with the registered mark comprising, in part, the possessive name WALT DISNEY'S, "a well-known provider of entertainment services." The presence of WALT DISNEY in the cited mark is sufficient, according to applicant, to distinguish the marks, giving registrant's mark a different commercial impression from the one engendered by applicant's mark. Applicant's mark makes no reference to Disney, nor does the mark include "the distinctive Disney Cinderella character." In this connection applicant points to registrant's own arguments, when it attempted to distinguish its mark from a cited mark to overcome a Section 2(d) refusal during prosecution of the underlying application for its registration, that these additional elements distinguished its mark from the cited mark. Applicant also contends that the goods are different, stating that "[a]lthough many candies, snacks

and cookies can be combined or flavored with peanut butter, the products of Applicant and Registrant are nevertheless separate and distinct, even in separate classes." In this connection applicant refers to the fact that registrant owns another registration for the mark PETER PAN for a variety of snack food items, some identical to the ones listed in the cited registration. This registration, applicant asserts, was allowed to issue over an existing third-party registration of the identical mark PETER PAN for "peanut butter." Applicant also contends that its peanut butter and registrant's snack food items are purchased after careful consideration, especially given food-related safety issues such as allergies. Applicant asserts that it is an industry leader in the processing of peanuts and distribution of peanut butter, and that it is unaware of any instances of actual confusion between its mark and registrant's mark. Applicant further argues that the cited mark is weak in view of "numerous other registrations." In support of its arguments, applicant submitted a printout summary of the TESS search results of a search of "Cinderella," and copies of the PETER PAN registrations mentioned above.

The examining attorney maintains that the marks are similar in that registrant's mark is dominated by the

literal portion of the mark, and that applicant merely has deleted the trade name and pictorial representation of the fictional character Cinderella in registrant's mark. The examining attorney points out that the third-party registrations referenced by applicant were not properly introduced; the examining attorney goes on to discount applicant's evidence that the mark CINDERELLA is weak and entitled to a narrow scope of protection. The examining attorney also contends that the goods are related inasmuch as they are used together, travel through the same trade channels to the same classes of purchasers, and often are purchased in the same shopping trip. The examining attorney is not persuaded by the lack of actual confusion, asserting that the test is likelihood of confusion. In support of the refusal the examining attorney submitted articles retrieved from the Internet, and a Wikipedia excerpt about peanut butter. Pursuant to the examining attorney's request, we take judicial notice of the dictionary listing of "Cinderella" as follows: "fairy-tale heroine who is used as a drudge by her stepmother but ends up married to a prince." Merriam-Webster Online Dictionary (10th ed. 2005).

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative

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facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Insofar as the marks are concerned, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered under the respective marks is likely to result.

With respect to registrant's mark, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression

created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ["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 consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable."].

Where both words and a design comprise the mark (as in registrant's mark), then the words are normally accorded greater weight because the words are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). See also *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Thus, in the case of registrant's mark, we find that the dominant portion is the literal portion of the mark, namely WALT DISNEY'S CINDERELLA.

In considering the literal portion of registrant's mark, this portion, in turn, is dominated by the term CINDERELLA. We so find because the term CINDERELLA is in larger type than WALT DISNEY'S, and the accompanying pictorial representation of the well-known fictional

character named "Cinderella" serves to reinforce the literal CINDERELLA portion of registrant's mark.

In view of the above, we find that the dominant portion of registrant's mark is the term CINDERELLA. This term is identical to the entirety of applicant's mark. The stylization of the terms in the marks is not sufficient to distinguish them in any meaningful manner.

Although the dominant portion, CINDERELLA, of registrant's mark is identical to applicant's mark in sound, appearance, meaning and commercial impression, we must do more than just compare the individual components of the marks; it is necessary that we compare the marks as a whole. *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006). Nevertheless, as indicated above, the design feature of registrant's mark only reinforces the literal CINDERELLA portion. And, WALT DISNEY'S would be viewed merely as the trade name of the entity that is the source of the goods sold under the mark. The deletion of these additional features to form applicant's mark simply is not enough to sufficiently distinguish applicant's mark from registrant's mark. Generally, likelihood of confusion is not avoided between otherwise confusingly similar marks by adding or deleting a house mark. *See In re Chatam International Inc.*, 380 F.3d

1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986); and *In re Riddle*, 225 USPQ 630 (TTAB 1985).

Insofar as the goods are concerned, we find applicant's peanut butter to be related and complementary to, at the very least, registrant's candy, chocolate, cookies, pretzels and bread. As often stated, it is not necessary that the respective goods be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). Likelihood of confusion may be found based on any item that comes within the identification of goods in the involved application or registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). We also recognize that there is no *per se* rule requiring a finding of likelihood of confusion

when both types of goods are food items. *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 927, 198 USPQ 151 (CCPA 1978).

In the present case, the examining attorney submitted several articles retrieved from the Internet showing that peanut butter is used in food items in combination with chocolate, candy, cookies and pretzels; peanut butter also may be used as an ingredient in candy and cookies. Further, it is common knowledge that peanut butter spread on bread is often eaten as a snack. Thus, applicant's product is often used in combination with some of the snack products listed in the cited registration. These complementary uses are probative in finding that the goods are related for purposes of our likelihood of confusion analysis. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Neither the identification of goods in the application nor the identification in the registration includes any limitation regarding trade channels or classes of purchasers. Where the goods in the cited registration and/or application are broadly identified as to their nature and type (as is the case herein), such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is

presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Thus, the goods are presumed to move through the same trade channels normal for such products (e.g., grocery stores, and the grocery departments of mass merchandisers such as Wal-Mart and Target). The same classes of purchasers, including ordinary consumers, would buy both types of products, even on the same shopping trip. Further, goods of the type involved herein are relatively inexpensive, and would be the object of impulsive purchases and frequent replacement. Applicant's argument that the goods are targeted to different consumers, or that customers are sophisticated, is irrelevant given the lack of any limitation in the identifications of goods.

We find that applicant's and registrant's goods are related, complementary snack food items that move in the same trade channels to the same classes of purchasers.

These factors weigh in favor of finding likelihood of confusion.³

Another du Pont factor on which evidence has been introduced is the number and nature of similar third-party marks in use on similar goods. In this connection applicant argues that the cited mark is "weak" and "entitled to a narrow scope of protection." In support thereof, applicant submitted a printout summary of a search of CINDERELLA registered marks retrieved from the USPTO's TESS database. The summary merely lists the mark, the registration number, and the "Live/Dead" status of the registration.⁴ The examining attorney, in the final refusal, indicated that the search report was insufficient to make the registrations of record, further pointing out the inherent deficiencies of such reports that do not list the goods and/or services for which the mark is registered. The examining attorney went on to state that, in any event, third-party registrations are entitled to limited weight in the absence of evidence of use. Applicant, in its brief, is silent on this evidentiary matter, but continues to

³ Applicant's argument relating to the different classification of the goods has no bearing on the issue before us. *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771 (Fed. Cir. 1993).

⁴ Several of the listed marks do not even include CINDERELLA as a portion thereof. See, e.g., LINCELLA, SAN DERELLA and FAIRY WAND.

argue its point about the weakness of the cited mark. The examining attorney, in her brief, addresses, in more detail, the deficiencies of the search report.

As correctly pointed out by the examining attorney, a TESS summary is insufficient to make the listed registrations of record. See *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001); and *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). Accordingly, the third-party registrations have not been considered in reaching our decision. Even if the list itself were considered, the mere listing of registered marks (many of which are "dead"), without any accompanying indication of the goods and/or services associated therewith, has virtually no probative value. Further, the expired registrations are of no value. See *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ["[A] cancelled registration does not provide constructive notice of anything."].

Even if copies of the "live" registrations had been submitted, it is unlikely that we would reach a different result on the merits of this appeal. Third-party registrations are not evidence of use of the marks shown therein. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1407, 177 USPQ 268 (CCPA 1973). Thus, they are not

proof that consumers are familiar with such marks so as to be accustomed to the existence of similar marks in the marketplace, and as result are able to distinguish among CINDERELLA marks based on any differences in the marks.

Smith Bros. Mfg. Co. v. Stone Mfg. Co., 476 F.2d 1004, 177 USPQ 462 (CCPA 1973). Moreover, marks for goods far removed from the types involved herein would be of no value.

Applicant also relies upon registrant's arguments made in prosecuting the underlying application that matured into the registration now cited as a Section 2(d) bar to applicant's mark. Applicant points to registrant's remarks directed to the state of the register, in particular, that the term "Cinderella" is a weak indicator of source given its registration by a number of third parties. These remarks were made during the prosecution of registrant's application, as part of its efforts to overcome the refusal of registration based on one of the third-party registrations. Although we have considered these remarks, we do not view them as a substitute for applicant's own obligation to establish any purported weakness of the cited mark.

Applicant also relies upon the coexistence on the register of registrations of the mark PETER PAN, one owned

by a third party for peanut butter, and the other owned by registrant for various snack foods, including cookies, candies, chocolates, and pretzels.

As often stated, each case must be decided on its own merits. We are not privy to the records of those registrations and, in any event, previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding on the USPTO or the Board. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); and *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994).

Although we have considered applicant's claim that there has been no actual confusion between the marks, we have accorded limited probative value to this factor. There is no evidence regarding the extent of use of the respective marks, and whether the use has been sufficient for opportunities of actual confusion to occur. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). In any event the relevant test is likelihood of confusion, not actual confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

We also have considered, of course, the fact that applicant's predecessor at one time owned a registration

for the identical mark covering the identical goods involved in its present application. As noted earlier, the registration was cancelled in 2001. Further, so as to be clear on this point, the record is devoid of any consent agreement between registrant and applicant. Such an agreement, had one been submitted, would be given great weight. The earlier registration, now cancelled, once owned by applicant's predecessor, while worthy of consideration, is outweighed by the factors weighing in favor of finding likelihood of confusion. See *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001).

Finally, applicant asserts that it is the senior user of the mark CINDERELLA for food items, and that, therefore, it has priority over the cited mark. To the extent that applicant's allegations constitute a collateral attack on registrant's registration, they are impermissible. Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in connection with the goods or services identified in the certificate. During *ex parte* prosecution, including an *ex parte* appeal, an applicant will not be heard on matters

that constitute a collateral attack on the cited registration (e.g., applicant's claim of priority over the cited mark). *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); and *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992). See TMEP §1207.01(d)(iv) (5th ed. 2007). Further, there is nothing to indicate that applicant has sought to cancel the cited registration. Accordingly, no consideration has been given to applicant's arguments in this regard.

In sum, the similarities between the marks and goods, and the identity between the trade channels and classes of purchasers, coupled with the inexpensive nature of the goods that are subject to frequent replacement, weigh in favor of finding likelihood of confusion.

We conclude that consumers familiar with registrant's candy, chocolate, cookies, pretzels and bread sold under the mark WALT DISNEY'S CINDERELLA and design would be likely to believe, if they were to encounter applicant's mark CINDERELLA (stylized) and design for peanut butter, that the goods originated from or are associated with or sponsored by the same entity.

Decision: The refusal to register is affirmed.