

From: Rossman, William

Sent: 5/6/2010 2:29:45 PM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 76699640 - SALAD CHEF - P-4172-2

\*\*\*\*\*

Attachment Information:

Count: 1

Files: 76699640.doc

**E UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 76/699640

**MARK:** SALAD CHEF



**CORRESPONDENT ADDRESS:**

MYRON AMER  
Myron Amer, P.C.  
350 NATIONAL BLVD STE 2B  
LONG BEACH, NY 11561-3327

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** REPAC, CEDOMIR

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

P-4172-2

**CORRESPONDENT E-MAIL ADDRESS:**

**EXAMINING ATTORNEY'S APPEAL BRIEF**

**STATEMENT OF THE CASE**

Applicant has appealed the Trademark Examining Attorney's Final Refusal to register the Trademark SALAD CHEF (standard character) Application No. 76699640 for, "FOOD STORAGE DEVICE, NAMELY, PLASTIC FOOD STORAGE CONTAINERS FOR HOUSEHOLD USE" on the grounds of likelihood of confusion, mistake or deception under Trademark Act Section 2(d), 15 U.S.C. §1052(d), with the mark in Registration No. 2521220, SALAD CHEF (also standard character) for, "ELECTRIC HAND-HELD MIXER, IN COMBINATION WITH A CRUET, FOR MIXING SALAD DRESSINGS AND OTHER FOOD PRODUCTS". The examining attorney respectfully requests that the Trademark Trial and Appeal Board (TTAB) uphold the refusal based on the

likelihood of confusion with Registration No. 2521220 for the reasons and authorities cited below.

## **STATEMENT OF FACTS**

Applicant filed this application on September 25, 2009 applying to register on the Principal Register the mark SALAD CHEF (standard character) for, “CUTTING TOOLS AND FOOD STORAGE DEVICE” in international class 021. In the Initial Office Action dated December 30, 2009 registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d) on the grounds that the mark, when used in connection with the recited goods, so resembles the mark in Registration No. 2521220 as to cause confusion, to cause mistake, or to deceive. The examining attorney also required a disclaimer of the descriptive wording “SALAD” under TMEP §§1213.03 and a definite amendment to the identification of goods under TMEP §§1402.01.

In an amendment received on January 15, 2010 the applicant argued that the goods were not related by reason of product diversity. It is applicant’s contention that their goods would not be marketed in such a way as to be encountered by the same consumers and thus would not be confusingly similar with Registration No. 2521220. The applicant submitted an acceptable definite identification of goods, namely, “FOOD STORAGE DEVICE, NAMELY, PLASTIC FOOD STORAGE CONTAINERS FOR HOUSEHOLD USE” and a disclaimer of the descriptive wording “SALAD”. The applicant also unnecessarily changed the classification of goods to class 016 which is misclassified, in that the wording “PLASTIC FOOD STORAGE CONTAINERS FOR HOUSEHOLD

USE” is clearly delineated in class 021 in the Trademark Manual of Acceptable Identifications.<sup>1</sup>

On February 12, 2010 the refusal of registration under §2(d) was maintained and made Final. The acceptance of the definite identification of goods and the required disclaimer were then made of record. On March 5, 2010 applicant filed an appeal to the board without a request for reconsideration and on March 10, 2010 the file was forwarded to the examining attorney for statement.

### **ISSUES PRESENTED**

1. The only issue presented on appeal is whether the mark, when used in connection with the recited goods, so resembles the mark in Registration No. 2521220 as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act §2(d).

#### **(A). LIKELIHOOD OF CONFUSION: APPLICABLE LEGAL PRINCIPLES**

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods and/or services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods

---

<sup>1</sup> It is noted that this misclassification was not entered by the Office. If the application should be remanded to the examining attorney after appeal, a no call examiner’s amendment will be processed in order to show the proper classification in the record, as Class 21. Proper classification of goods and services is a purely administrative matter within the sole discretion of the United States Patent and Trademark Office. *In re Tee-Pak, Inc.*, 164 USPQ 88, 89 (TTAB 1969).

and/or services. TMEP §1207.01. The Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider when determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods and/or services. The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

The Court in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

In this appeal, the following factors are the most relevant: similarity of the marks as they are identical, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999); *In re L.C. Licensing Inc.*, 49 USPQ2d 1379 (TTAB 1998); TMEP §§1207.01 *et seq.*

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

**(B). LIKELIHOOD OF CONFUSION: SIMILARITY BETWEEN THE MARKS**

*I. EXAMINING ATTORNEY'S ARGUMENT: THE MARKS OF THE APPLICANT AND REGISTRANT ARE CONFUSINGLY SIMILAR AS THEY ARE IDENTICAL IN SOUND, APPEARANCE AND CONNOTATION*

The applicant's mark is SALAD CHEF (standard character with "SALAD" disclaimed) for, "FOOD STORAGE DEVICE, NAMELY, PLASTIC FOOD STORAGE CONTAINERS FOR HOUSEHOLD USE" in International Class 021. The registered mark is SALAD CHEF (standard character also with "SALAD" disclaimed) for, "ELECTRIC HAND-HELD MIXER, IN COMBINATION WITH A CRUET, FOR MIXING SALAD DRESSINGS AND OTHER FOOD PRODUCTS" in International Class 007.

The applicant has submitted no arguments as to the similarities between the marks. The examining attorney will address the similarities below as the two marks are identical. In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

First, both marks are phonetic equivalents and are thus similar sounding. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963); TMEP §1207.01(b)(iv).

Second, the applicant's mark and the registered mark are identical in appearance and connotation. There is no additional wording or design in either mark to change the appearance or commercial connotation and impression. Both marks also contain a disclaimer of the wording "SALAD" but this does not alleviate the likelihood of confusion. The marks must be considered in their entireties when determining whether there is likelihood of confusion. A disclaimer does not remove the disclaimed portion from the mark for the purposes of this analysis. *In re Nat'l Data Corp.*, 753 F.2d 1056,

224 USPQ 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214 (TTAB 2001); *In re MCI Commc'ns Corp.*, 21 USPQ2d 1534 (Comm'r Pats. 1991); see TMEP §1207.01(b)(viii), (c)(ii). Purchasers are not aware of disclaimers that reside only in the records of the Office.

Regarding the issue of likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b). Accordingly, the marks are similar in sound, appearance and commercial impression.

**(C). LIKELIHOOD OF CONFUSION: COMPARISON OF GOODS AND SERVICES**



I. EXAMINING ATTORNEY'S ARGUMENT: APPLICANT'S GOODS ARE CLOSELY RELATED TO THE REGISTRANT'S GOODS

If the marks of the respective parties are identical, the relationship between the goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. However, in this instance, both the applicant's and registrant's goods may be used by the same consumers for common kitchen tasks such as the preparing and storage of foodstuffs. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Ancor, Inc. v. Ancor Industries, Inc.*, 210 USPQ 70 (TTAB 1981); TMEP §1207.01(a).

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and/or services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

Although the goods are in different classes, the examining attorney has found evidence of relatedness between the goods as discussed below. The fact that the Office classifies goods or services in different classes does not establish that the goods and services are unrelated under Trademark Act Section 2(d). *See* TMEP §1207.01(d)(v). The determination concerning the proper classification of goods or services is a purely administrative determination unrelated to the determination of likelihood of confusion. *Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971, 975, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993); *Nat'l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990).

As listed above in the Statement of Facts, the applicant's recited goods/services are, "FOOD STORAGE DEVICE, NAMELY, PLASTIC FOOD STORAGE CONTAINERS FOR HOUSEHOLD USE" in International Class 021. The registrant's identified goods are, "ELECTRIC HAND-HELD MIXER, IN COMBINATION WITH A CRUET, FOR MIXING SALAD DRESSINGS AND OTHER FOOD PRODUCTS" in International Class 007.

In this instance, the applicant's "STORAGE CONTAINERS" and registrant's "ELECTRIC MIXERS AND CRUETS" could be offered through the same channels of trade by the very same manufactures. This is because items such as storage containers and kitchen mixers are often sold in the same retail or wholesale environments and

manufactured by the same producers for similar and or complimentary uses in the kitchen.

The examining attorney has attached Internet evidence illustrating that “FOOD STORAGE CONTAINERS” and “ELECTRIC MIXERS AND CRUETS” are offered through the same channels of trade and by the same manufacturer. For example, on pages 2-11 of the examining attorney’s Final Office Action dated February 12, 2010 the evidence shows that the Kitchen Aid Company manufactures and offers for sale to the public both electric mixers and food storage containers through the same channels of trade. Further evidence, namely, websites attached from the Final Office Action listing Cuisinart Company (pages 12-15), Black and Decker Company (pages 16-26), Jarden Company (pages 27-37) and Sunbeam (pages 38-47) also indicate that “FOOD STORAGE CONTAINERS” and “ELECTRIC MIXERS” are manufactured by the same type of producer and sold to consumers in the same channels of trade. Additional evidence indicates that the Kenwood Company also offers both electric mixers and mini storage cups and bowls to consumers through trademe.com and the Comet accessories website as attached on pages 48-52 of the examining attorney’s Final Office Action.

The examining attorney also included, as part of the record, relevant Third Party Registrations that are listed below. In the First Office Action dated December 30, 2009 the examining attorney provided Third Party Registrations illustrating that “STORAGE CONTAINERS” and “ELECTRIC MIXERS” are frequently offered through the same channels of trade. For example, the attached Registration Nos. 3718177 and 3306563

indicate that storage containers and small kitchen appliances are offered through similar trade channels and would be encountered by the same consumer. (*see First Office Action attachments pages 19-21 and 62-64 respectively*). Furthermore, Registrations Nos. 3490218 and 3138407 indicate that the same goods may emanate from a single source as the registrations list both electric mixers and common kitchen items such as carafes, pans plates and sheets which can all be utilized as food storage containers and comprised of plastic. (*see First Office Action attachments pages 53-55 and 56-58 respectively*).

In the Final Office Action, the examining attorney has offered additional Third Party Registrations as evidence of the relatedness of the goods. For example, see Registration Nos. 3125391 listing cruets, mixers and containers for household use and 3635725 listing electric mixers and storage containers for household use (*see Final Office Action attached pages 62-66 and 67-70 respectively*).

As part of the record for the First Office Action, the examining attorney offered Third Party Registrations that were predicated on applicant's identification at the time, namely, "CUTTING TOOLS AND FOOD STORAGE DEVICE". These registrations are now not as relevant to the final acceptable identification, namely, FOOD STORAGE DEVICE, NAMELY, PLASTIC FOOD STORAGE CONTAINERS FOR HOUSEHOLD USE" in International Class 021. The applicant, however, has submitted redacted "SNIPPETS" of several of these Third Party Registrations as evidence of the un-relatedness of the goods for purposes of the 2(d) refusal.

Applicant's sole argument is that "it has not been established that the applicant's and registrant's line of products are marketed in a way that they would be encountered in a situation that would create the incorrect assumption that they would originate from the same source". Applicant's appeal relies upon these cut and pasted parts of the examining attorney's Third Party Registrations from the First and Final Office Actions as evidence in support of their contention. For example, applicant has submitted in their Appeal Statement that Registration Nos. 3125391 and 3262116, are not relevant to show relatedness of the goods and do not contain applicant's goods. However, these cited registrations all contain a reference to the goods at issue as the examining attorney has already submitted above in his examples of relevant Third Party Registrations. For Registration No. 3196039, which is not included above, the applicant does not make any connected comment or argument on the goods in question in their Appeal Brief.

The examining attorney acknowledges that some of the similar goods at issue, namely, cruets and assorted containers have been removed from Registration Nos. 0578183 and 0633394 as noted in the applicants Appeal Brief and does not rely on these registrations as additional or necessary evidence. Most notable, however, is the fact that the applicant has not addressed any of the Internet websites submitted in by the examining attorney in the Final office Action which clearly show that the same manufacturers commonly produce both storage containers and electric mixers under the same trademark.

In addressing applicant's channel of trade argument above, it must be noted that the registrant's identification of goods does not contain a restriction to retail trade channels.

The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. In this case it is presumed that the electric mixers are for household use just as applicant's food storage containers. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-5 (TTAB 1980). Therefore the applicant may not restrict the scope of the registrant's goods by extrinsic argument or evidence TMEP 1207.01 (a)(iii).

The examining attorney finds that applicant's goods will nonetheless be encountered by the same class of purchasers in the same channels of trade. Both the applicant's and registrant's goods, as identified, can be offered in the same trade channels, including retail trade channels, and since the registrant's goods do not have a trade channel restriction, they can be offered in the same retail trade channels being occupied by the applicant.

Therefore, the examining attorney has no alternative but to conclude from the evidence attached that the applicant's goods will be offered to the same consumers and through the same channels of trade as the registrant's goods thus creating a likelihood of confusion as the source of the goods.

## **CONCLUSION**

The applicant's mark SALAD CHEF (standard character) is likely to be confused with the registered mark SALAD CHEF (Standard Character) where the applicant's mark creates a highly similar visual impression and a nearly identical commercial impression as the registrant's mark and is used on substantially related services and goods. As such, it is highly likely that the applicant's mark SALAD CHEF and the registered mark will cause consumer confusion with the registered mark. For the foregoing reasons, it is respectfully submitted that the refusal of registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d) be upheld.

a

Respectfully submitted,

/wrossman/  
William M. Rossman  
Trademark Examining Attorney  
Law Office 109  
William.Rossman@USPTO.GOV  
571-272-9029  
Dan Vavonese  
Managing Attorney  
Law Office - 109