

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Hearing:
May 12, 2010

Mailed:
May 14, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Himalaya Global Holdings, Ltd.

Serial No. 77117183

Robert T. Maldonado and Tonia A. Sayour of Cooper & Dunham
LLP for Himalaya Global Holdings, Ltd.

Marilyn D. Izzi, Trademark Examining Attorney, Law Office
112 (Angela B. Wilson, Managing Attorney).

Before Seeherman, Walsh and Bergsman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Himalaya Global Holdings, Ltd. has applied to register
SOLIGA FOREST HONEY, in standard character format, for
honey.¹ In response to a requirement by the examining
attorney that the term FOREST HONEY is "highly descriptive,
if not generic, for applicant's goods," Office action
mailed January 24, 2008, applicant disclaimed exclusive

¹ Application Serial No. 77117183, filed February 27, 2007,
based on Section 1(b) of the Trademark Act (intent-to-use).

rights to this term. Applicant also stated, in response to the examining attorney's inquiries, that there is no English translation of the word SOLIGA, "which refers to a tribal group living in the forest regions of the Karnataka State of India," and that "SOLIGA FOREST appearing in the mark has no significance in the relevant trade or industry or as applied to the goods/services listed in the application, no geographical significance, nor any meaning in a foreign language." Response filed December 20, 2007.

Applicant has appealed the refusal of the examining attorney to register its mark, made pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark so resembles the mark FOREST HONEY and design, shown below, registered for honey,² that if used on applicant's identified goods it is likely to cause confusion or mistake or to deceive.



² Registration No. 3303923, issued October 2, 2007.

The word HONEY has been disclaimed, and the registration includes the following statement:

The colors black, white, yellow and green are claimed as a feature of the mark. The color green appears in the word Forest; the color light yellow appears in the inside portion of the flower; the color white appears on the outside portion of the flower; the color dark yellow appears on the wording Honey, on the line below the wording Honey and on the bee; and the color black appears on the bee.

The appeal has been fully briefed, and applicant and the examining attorney appeared at a hearing before the Board.

Before reaching the substantive issue of whether or not there is a likelihood of confusion, there are some procedural points we must address. First, although the examining attorney had objected in her brief to the exhibit attached to applicant's brief, at the hearing she withdrew that objection. In any event, the exhibit appears to be a copy of evidence that the examining attorney had previously made of record. Therefore, we have considered it. Second, applicant referred in its brief and at the hearing to a letter from the registrant. The examining attorney stated that this letter apparently was sent by the registrant to the Office and was erroneously placed in the application file, and because of this error, it was subsequently

removed. Accordingly, this letter does not form part of the record of the application, and we have given it no consideration.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative 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). The examining attorney asserts in this case that the relevant factors are the similarity of the marks, the similarity of the goods, and the similarity of the trade channels. Applicant does not dispute that the goods and the trade channels are identical. However, applicant asserts that the marks are so different that, even though the du Pont factors of the similarity of the goods and channels of trade favor a finding of likelihood of confusion, the single factor of the differences in the marks outweighs them, and must result in a finding that confusion is not likely. See *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (a single du Pont factor - the dissimilarity of the marks - can be dispositive of the likelihood of confusion issue).

In comparing the marks, it is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, 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 entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). The feature common to both marks in this case, FOREST HONEY, is descriptive. Indeed, the examining attorney required applicant to disclaim the term on the basis that it is "highly descriptive, if not generic," and she submitted evidence that, as she characterizes it, "defines 'forest honey' as a type of honey produced by bees that gather pollen in a forest environment." Office action mailed January 24, 2008.

The evidence consists of an article from the Science Direct website, www.sciencedirect.com, discussing the elements in Slovenian honey and which includes the statement:

Statistically significant differences were established between different types of honey (acacia, floral, lime, chestnut, spruce, fir, forest and *Metcalfa pruinosa* honeydew honey). The highest content of elements was

determined in forest honey and the lowest in acacia honey.

Although normally more than this single document would be necessary for applicant to support its position that FOREST HONEY is a type of honey, in this case both applicant and the examining attorney agreed on this point, so there was no need for applicant to submit additional evidence.³

As a general rule, descriptive or generic terms are given less weight when comparing marks because "the public can be said to rely more on the non-descriptive portion of each mark." National Data, 224 USPQ at 752. The examining attorney appears to believe that, although FOREST HONEY is descriptive of applicant's identified "honey," it cannot be considered merely descriptive of the registrant's identified "honey" because the registration contains a disclaimer of only the word HONEY, not FOREST HONEY. "[A]pplicant's arguments that the term 'FOREST HONEY' is generic amount to a collateral attack to the validity of

³ We recognize that at the oral hearing the examining attorney stated that she was retreating from her position that FOREST HONEY is generic or even highly descriptive, and now believes that it is merely descriptive. However, throughout the prosecution of the application the examining attorney continued to treat FOREST HONEY as being generic or at least highly descriptive. "[A]pplicant intends to use the term 'FOREST HONEY' to describe the type of honey being provided to consumers..." Brief, p. 10. Therefore, applicant was never put on notice that it should submit additional evidence to show that FOREST HONEY is a generic or highly descriptive term.

the cited registration as the registration exists with only a disclaimer of 'HONEY'." Brief, p. 10.

However, this is not a correct statement of the law.

In a very similar situation, the Court explained:

The board acknowledged that National's evidence was credible with respect to some financial services, but refused to give it any weight in resolving the ultimate issue because of the *absence* of a disclaimer in the registered mark. The absence of a disclaimer does not, however, mean that a word or phrase in a registration is, or has become, distinctive in the registered mark, so that that part of the mark must be treated the same as an arbitrary feature.

Thus, National was entitled to show, if it could, that CASH MANAGEMENT in the registered mark was descriptive, and its proof should not have been disregarded on the ground that the registration could not be attacked in this proceeding. The registration affords *prima facie* rights in the mark *as a whole*, not in any component. Thus, a showing of descriptiveness or genericness of a *part* of a mark does not constitute an attack on the registration.

National Data, 224 USPQ at 751, 752.

The examining attorney also considers the words FOREST HONEY in the cited mark to be entitled to greater weight in the likelihood of confusion analysis because of the case law that has found words to be dominant over designs.

Certainly there are any number of cases that reflect the principle that if a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). However, this is not a rule, and whether or not the principle should be followed depends on the circumstances of the individual case. See *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007) (prominently displayed design considered to be dominant element of BODYMAN and design mark).

In the present case, because of the highly descriptive, if not generic, nature of the words FOREST HONEY, the prominent display of the design, and the depiction of the word HONEY, which gives the appearance of being written with honey, we consider the design portion of the cited mark to be dominant.⁴ Similarly, because of the unusual word SOLIGA, which is also the first word of applicant's mark, and the fact that the rest of the mark

⁴ The examining attorney has pointed out that, because applicant has applied for its mark in standard character format, it could be presented in the same manner of display as the registered mark. That is not entirely correct. Although the protection for a mark registered in standard character format is not limited to a particular type font or style of lettering, it would not include the design element of making the word appear to be written with honey.

consists of the descriptive words FOREST HONEY, we consider SOLIGA the dominant part of applicant's mark. This is not to say that the inclusion of the identical words FOREST HONEY in both marks can be ignored, or that they do not contribute to the commercial impressions of the marks. However, when the marks are compared in their entireties, FOREST HONEY deserves less weight because consumers are likely to regard this term as merely describing the type of honey, and look to other elements in the marks to indicate the source of this forest honey.

Accordingly, we find that the marks are sufficiently different that confusion is not likely to result from their contemporaneous use on honey, and on the basis of this single du Pont factor, find that applicant's mark SOLIGA FORST HONEY for honey is not likely to cause confusion with the registration for FOREST HONEY and design for honey.

Decision: The refusal of registration is reversed.