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EXAMINING ATTORNEY'S APPEAL BRIEF

I. INTRODUCTION

Applicant has appealed the trademark examining attorney's refusal to register the mark OLD TYME DELI for "food items, namely, meats and cheeses, and dairy products, excluding ice cream, ice milk and frozen yogurt, used on packing for the goods" under Trademark Act Section 2(d), 15 U.S.C. § 1052(d) on the basis of Registration No. 0942886 for OLD TIME for "processed foods, can packed, glass packed, dry packed and frozen and consisting of fruits, vegetables, juices (both fruit and vegetables), jellies, preserves, pickles, salad dressing, coffee, tea, peanut butter, margarine, soups, donuts, rolls, buns, bread, and fruit pies; and fresh foods consisting of fruits, vegetables, ice cream butter, and cheese"¹ and Registration No. 1755573 for OLD TYME for "ham."²

¹ On October 9, 2006, registrant amended the identification of goods in cited Reg. No. 0942886 to read: "Processed foods, can packed, glass packed, dry packed and frozen, and consisting of fruits, vegetables,

II. FACTS

On June 11, 2003, applicant filed an application under Section 1(a) of the Trademark Act for the mark OLD TYME DELI, in typeset words, for “food items, namely meats and cheeses, fruits and other dairy products used on packaging for the goods.” On December 18, 2003, registration was refused under Section 2(d) on the basis of Reg. Nos. 0806997, 0942886, 1277236, 1416822, and 1755573. In addition, applicant was required to disclaim DELI and to clarify the identification of goods and to attend to related classification/insufficient fee/specimen matters. A response was not timely filed and the application abandoned on June 28, 2004.

Applicant filed a Petition for Reinstatement on September 15, 2004, and the application was revived on February 16, 2005. On February 17, 2005, the initial office action was re-issued. A timely response was filed on August 16, 2005 in which applicant amended the identification of goods, disclaimed DELI, and presented arguments to overcome the Section 2(d) refusals. Applicant simultaneously filed a change of correspondence request. On August 25, 2006, a final refusal was issued under Section 2(d) on the basis of Reg. Nos. 0806997, 0942886, 1277236, 1416822, and 1755573.

juices (fruit), jellies, preserves, pickles, salad dressing, coffee, tea, peanut butter, margarine, soups, buns, bread; and fresh foods consisting of ice cream, butter, and cheese.” The amended identification does not impact the Section 2(d) refusal.

² In the Notice of Suspension issued May 19, 2006, the Section 2(d) refusal was continued and maintained for Registration Nos. 0942886 and 0806997. The Suspension Notice should have stated that the Section 2(d) refusal was continued and maintained as to Registration Nos. 0806997 (subsequently cancelled), 0942886 and 1755573. As a result of this error, the subsequent action of June 21, 2007, returning the instant case to the Board, erroneously stated that the Section 2(d) refusal was continued and maintained as to Reg. No. 0942886 only. The June 21, 2007 action should have correctly stated that the Section 2(d) refusal was continued and maintained for Reg. Nos. 0942886 and 1755573. Applicant has not been prejudiced by these errors as applicant’s appeal brief was written and filed prior to the issuance of the Suspension Notice. Accordingly, applicant’s appeal brief addresses both Reg. Nos. 0942886 and 1755573.

Final requirements were also issued for clarification of the identification of goods, as well as related classification/insufficient fee/specimen matters. This timely appeal followed.

Following appeal, applicant amended the identification of goods. The examining attorney moved to remand the case and on May 19, 2006, the application was suspended pending disposition of Reg. No. 0806997. The notice of suspension additionally noted that, due to cancellation of cited registrations Nos. 1277236 and 1416822, the Section 2(d) refusals as to these registrations were withdrawn. Finally, the notice of suspension continued and maintained a remaining identification of goods requirement, namely, deletion of superfluous wording. Cited Registration No. 0806997 was cancelled on January 20, 2007, and the instant case was returned to the Board on June 21, 2007.

III. ISSUES ON APPEAL

- A. WHETHER APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO THE MARKS IN U.S. REGISTRATION NOS. 0942886 AND 1755573 SUCH THAT A LIKELIHOOD OF CONFUSION EXISTS UNDER TRADEMARK ACT SECTION 2(d).**
- B. CLARIFICATION OF THE IDENTIFICATION OF GOODS TO DELETE SUPERFLUOUS WORDING.**

IV. ARGUMENT

THE MARKS OF THE APPLICANT AND THE REGISTRANTS ARE SIMILAR AND THE GOODS AS DESCRIBED IN THE APPLICATION AND REGISTRATIONS ARE IDENTICAL AND/OR RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

A. General Rules of Analysis for Section 2(d) Cases

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 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 in 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.

With respect to these first two *du Pont* factors, the examining attorney must analyze the marks for similarities in sound, appearance, meaning or connotation. *Du Pont, supra*. Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §1207.01(b). Second, the examining attorney must compare the goods or services to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §§1207.01 *et seq.*

1. Comparison of the Marks

Applicant's mark is OLD TYME DELI, with DELI disclaimed. The registered marks are OLD TIME (Reg. No. 0942886) and OLD TYME (Reg. No. 1755573).

Regarding Reg. No. 0942886 for the mark OLD TIME, the dominant and recognizable portion of applicant's mark is phonetically equivalent to registrant's mark. In particular, the first terms are identical and the respective second terms are phonetically equivalent. 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).

Regarding Reg. No. 1755573 for the mark OLD TYME, the dominant and recognizable portion of applicant's mark is identical to registrant's mark.

The additional term DELI in applicant's mark is given less weight because it is descriptive of a feature of applicant's goods, namely, deli food, and applicant has, in fact, disclaimed the term.

It is noted that the cited marks are arbitrary as applied to registrants' goods and thus are strong trademarks to be given greater protection. *See, Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005), *citing, Nautilus Group, Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340 (Fed. Cir. 2004) (identifying an arbitrary mark as "a known word used in an unexpected or uncommon way").

Applicant argues that the term DELI distinguishes applicant's mark from the cited marks. Applicant's Brief, p. 4.

Applicant's argument has no merit. Although the marks must be considered in their entireties, it is well settled that a feature of the mark may be recognized as more significant in creating a commercial impression and that there is nothing improper in giving more weight, for rational reasons, to that feature of the mark. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 947, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000) ("[T]he Board was justified in examining each component of the mark LASERSWING and the effect of that component on the issue of likelihood of confusion as between the respective

marks in their entirety"); *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1566, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987) ("[I]t is not error in articulating reasons en route to a conclusion to indicate that some features of a mark are more distinctive than others"); *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided that the ultimate conclusion rests on consideration of the marks in their entirety."). For example, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark . . ." *In re National Data Corp.*, *supra*, 224 USPQ at 751.

As such, in the instant case, it is appropriate to give more weight to the "OLD TYME" portion of applicant's mark because of the descriptive nature of the wording "DELI." Moreover, the fact that DELI was disclaimed by applicant further supports the conclusion that DELI contributes less to the commercial impression that applicant's mark would make on purchasers. *See In re National Data Corp.*, *supra*.

In view of the above, applicant's mark is confusingly similar to the cited marks.

2. Comparison of the Goods

Applicant's goods are "food items, namely meats and cheeses, and dairy products, excluding ice cream, ice milk and frozen yogurt, used on packing for the goods."

Regarding Reg. No. 0942886, registrant's goods (as amended) are "processed foods, can packed, glass packed, dry packed and frozen, and consisting of fruits, vegetables, juices (fruit), jellies, preserves, pickles, salad dressing, coffee, tea, peanut

butter, margarine, soups, buns, bread; and fresh foods consisting of ice cream, butter, and cheese.”

Accordingly, the parties’ respective goods are in part identical as to cheeses, legally identical as to applicant’s “dairy products” which encompass registrant’s margarine and butter, and otherwise related food items. Specifically, applicant’s “meats” are complementary to registrant’s pickles, buns, and bread as the goods are common sandwich components. Moreover, all of the parties’ respective goods may be found in a typical retail grocery store.

Regarding Reg. No. 1755573, registrant’s goods are “ham.” Applicant’s “meats” are legally identical to registrant’s “ham” as ham is a type of meat. Moreover, applicant’s “cheeses” and “dairy products” are complementary to registrant’s “ham” because they are often eaten together in a typical meal, for example, a grilled ham and cheese sandwich. In addition, all of the parties’ respective goods are sold in retail grocery stores.

If the goods or services of the respective parties are identical or virtually identical, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *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 J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980); TMEP §1207.01(b).

However, even where the respective goods are not identical, the instant analysis still points to a likelihood of confusion given the relatedness of the parties’ respective

goods. 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 are such that they would be encountered by the same purchasers under circumstances that would 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); TMEP §1207.01(a)(i).

In its brief, applicant concedes the similarity of the parties' respective goods and, further, that all of the respective goods travel in identical channels of trade. Applicant's Brief, p. 4.

3. Applicant's Additional Arguments are Without Merit

Applicant's unsupported argument that there is no likelihood of confusion because there is no evidence of actual confusion has little merit. *See* Applicant's Brief, p. 5. First, it is unnecessary to show actual confusion in establishing likelihood of confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and cases cited therein. Second, it may be the case that, despite the overlapping years of use, there has not been meaningful opportunity for actual confusion to have occurred in the marketplace. *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992) (" . . . the absence of any reported instances of actual confusion would be meaningful only if the record indicated appreciable and continuous use by applicant of its mark for a significant period of time in the same

markets as those served by opposer under its marks.”) Third, given the relatively inexpensive nature of the goods, purchasers may not even be aware of their confusion, and even if they were, they may not take the trouble to inform the applicant or the registrant about the confusion. *See Hard Rock Cafe Int’l (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1514 (TTAB 2000) wherein the Board recognizes that “evidence of actual confusion is notoriously difficult to obtain” and thus it “cannot conclude from the lack of such evidence that confusion is not likely to occur.”

To the extent that applicant is also asserting priority of use over the registrants, priority of use is not germane to an applicant’s right to register in an ex parte proceeding. *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971).

Although applicant has addressed additional *du Pont* factors, the record contains no evidence with respect to these additional factors and thus they do not appear to be relevant to the case at issue. *In re National Novice Hockey League, Inc.*, *supra*, 222 USPQ at 640. (“Thus, it seems clear that the *du Pont* case mandate applies, as logic and legal relevance would indicate, only to those evaluation criteria for which relevant evidence of record exists.”); *see also Cunningham v. Laser Golf Corp.*, *supra*, 222 F.3d at 946, 55 USPQ2d at 1845. (“[T]he obligation to consider a factor does not arise in a vacuum and only arises if there is evidence of record relating to that factor.”)

Finally, it is noted that the examining attorney must resolve any doubt as to the issue of likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *See, e.g., In re Shell Oil Co.*, 992 F.2d 1204, 1209, 26 USPQ2d 1687, 1691 (Fed. Cir. 1993); *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d

1901, 1904 (Fed. Cir. 1989); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

For the foregoing reasons, the Section 2(d) refusal should be affirmed.

B. Identification of Goods

Pursuant to TMEP § 1402.01(e), the examining attorney “may require amendment of the identification of goods or services to ensure that it is clear and accurate and conforms to the requirements of the statute and rules.”

Applicant’s amendment to its identification of goods, submitted simultaneously with applicant’s appeal brief, is still indefinite because applicant failed to delete superfluous wording which relates to the method of use of the mark on the goods, namely, “used on packing for the goods.” This requirement was addressed in the initial office action issued December 18, 2003 and continued and maintained in the Notice of Suspension issued May 19, 2006.

In view of the above, applicant must amend its identification of goods to read as follows: “Food items, namely meats and cheeses, and dairy products, excluding ice cream, ice milk and frozen yogurt.”

CONCLUSION

There is a likelihood of confusion in the instant case and the examining attorney respectfully requests that this Board affirm the refusal to register applicant’s mark on the basis of likelihood of confusion under Section 2(d) of the Trademark Act, and, further, that this Board affirm the requirement to amend the identification of goods to delete superfluous wording.

Respectfully submitted,

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