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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79171734

MARK: CHEF SELECT TO GO



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Lidl Stiftung & Co. KG

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

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

INTERNATIONAL REGISTRATION NO. 1263075

### I. INTRODUCTION

Applicant, Lidl Stiftung & Co. KG, has appealed the examining attorney's final refusal under Section 2(d) of the Trademark Act, as amended, 15 U.S.C. §1052(d), to register the proposed mark CHEF SELECT TO GO for, as amended, "sushi."

The Section 2(d) refusal was issued on the ground that applicant's mark, as applied to applicant's goods, so resembles the mark in the cited registration that it is likely to cause confusion, or to cause mistake, or to deceive as to the source of the goods. The cited registration is U.S. Reg. No. 3873838 for CHEF SELECT for "sushi".

## II. FACTS

On February 6, 2015, applicant filed the instant application to register the design mark CHEF SELECT TO GO for various goods, later amended to "sushi."

Upon initial examination, an Office action was issued on September 11, 2015, mailed on September 15, 2015, refusing registration under Section 2(d) because of a likelihood of confusion with Reg. Nos. 3769435, 3873838, 4156570 and 4282252. On April 6, 2016, action on the application was suspended pending the filing of registration maintenance documents for U.S. Reg. No. 2873838.

On July 6, 2017, the application was removed from suspension after USPTO records indicated that the maintenance documents had been filed and accepted in U.S. Reg. No. 2873838, the refusal under Section 2(d) based on U.S. Reg. Nos. 3769435 and 4282252 was withdrawn, and a final refusal was issued under Section 2(d) based on U.S. Reg. Nos. 3873838 and 4156570. On January 30, 2018, applicant's Request for Reconsideration after Final Action was denied, withdrawing the refusal under Section 2(d) based on U.S. Reg. No. 4156570, and maintaining the final refusal issued under Section 2(d) based on U.S. Reg. No. 3873838.

On April 9, 2018, the application was divided into two applications, wherein the identification of goods in the instant application was amended to "sushi", and the rest of the goods in the original application were transferred to a child application. On April 29, 2018, applicant's subsequent Request for Reconsideration after Final Action was denied. This appeal followed.

### III. ARGUMENTS

#### **THE MARKS ARE HIGHLY SIMILAR AND THE PARTIES' RESPECTIVE GOODS ARE IDENTICAL CAUSING A LIKELIHOOD OF CONFUSION UNDER SECTION 2(d) OF THE TRADEMARK ACT.**

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. See 15 U.S.C. §1052(d). Determining likelihood of confusion is made on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). However, “[n]ot all of the [*du Pont*] factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1366, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)). The USPTO may focus its analysis “on dispositive factors, such as similarity of the marks and relatedness of the goods.” *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); see TMEP §1207.01. In this case, the following factors are the most relevant: similarity of the marks and similarity and nature of the goods and/or services. *Id.*

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

Additionally, the goods are compared to determine whether they are similar, commercially related, or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

Further, where the goods of an applicant and registrant are identical the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods. See *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014) (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)); TMEP §1207.01(b).

#### **A. THE MARKS ARE HIGHLY SIMILAR**

Applicant's design mark CHEF SELECT TO GO is highly similar to the registered standard character mark CHEF SELECT.

In this instance, the registered mark is entirely incorporated in the applicant's mark. Incorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See *Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (finding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL LANCER and design and BENGAL confusingly similar); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (finding BARR GROUP and BARR confusingly similar); *In re Mr. Recipe, LLC*, 118

USPQ2d 1084, 1090 (TTAB 2016) (finding JAWS DEVOUR YOUR HUNGER and JAWS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.

Furthermore, when evaluating a composite mark containing both words and designs, the word portion is more likely to indicate the origin of the goods because it is that portion of the mark that consumers use when referring to or requesting the goods. *Bond v. Taylor*, 119 USPQ2d 1049, 1055 (TTAB 2016) (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012)); TMEP §1207.01(c)(ii). Thus, although marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

In this instance, the dominant portion of applicant's mark is "CHEF SELECT", as the stylization and graphical elements do not materially overcome this feature. Further, and as supported by evidence in the application record, the wording "TO GO" in applicant's mark is descriptive and separated from the other wording. (See evidence attached to 09/11/2015 Office Action, TSDR pp 55-63, 67-68). For example:

- <https://www.collinsdictionary.com/dictionary/american/to-go> - shows that "to go" is defined as "to be taken out of (*said of food in a restaurant*)" (See 09/11/2015 Office Action, TSDR page 67);
- <http://www.mydemoulas.net/menus/markets-kitchen/> - shows food menu items described as "Grab & Go" items (See 09/11/2015 Office Action, TSDR page 56);
- <http://northshorefarms.com/departments/deli-prepared-food/> - offers food items that consumers can "[s]ample something today, and go home with a new favorite" (See 09/11/2015 Office Action, TSDR page 59); and

- <https://www.timessupermarkets.com/taste-of-times-food-to-go-deli-and-kitchen/> - refers to menu items as “food-to-go” (See 09/11/2015 Office Action, TSDR page 60).

As such, the applicant has disclaimed the wording “TO GO” in its mark. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party’s goods is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat’l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii).

Thus, when comparing the marks at issue, potential consumers are most likely to confuse the marks as referring to the same source of the goods, where the applied-for-mark’s additional wording “TO GO” could be understood by consumers as merely referring to a line of goods provided by the registrant that can be taken out of a restaurant or establishment to be consumed elsewhere.

## **B. THE RESPECTIVE GOODS ARE IDENTICAL**

When analyzing an applicant’s and registrant’s goods for similarity and relatedness, that determination is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application and/or registration, the identified goods are presumed to travel in the same channels of trade to the same class of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281

F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods of the type described. *See, e.g., Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015); *In re N.A.D., Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000).

In this case, the identifications set forth in the application and registration are identical and have no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers. *See Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). Accordingly, the goods of applicant and the registrant are considered related for purposes of the likelihood of confusion analysis.

### **C. APPLICANT’S ARGUMENTS ARE NOT PERSUASIVE**

The applicant argues that the wording identical in both marks, CHEF SELECT, is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. In support of this, applicant has submitted third-party evidence and printed or electronic copies of third-party registrations for marks containing the wording CHEF SELECT or variations thereof. Some of the third-party evidence and registrations appear to be for goods that are predominantly different from or unrelated to those identified in applicant’s application, while others appear to be for goods that are similar to those identified by the applicant.

The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods. *See Nat’l Cable Tel. Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of widespread third-party use of similar marks with similar goods “is relevant to show

that a mark is relatively weak and entitled to only a narrow scope of protection” in that particular industry or field. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); see *In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1062-63 (Fed. Cir. 2003).

However, evidence comprising only a small number of third-party evidence or registrations for similar marks with similar goods, as in the present case, is generally entitled to little weight in determining the strength of a mark. See *In re i.am.symbolic, llc*, 866 F.3d 1315, 1328-29, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017); *AMF Inc. v. Am. Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). These few third-parties or registrations are “not evidence of what happens in the market place or that customers are familiar with them.” *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d at 1406, 177 USPQ at 269; see *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). Thus, the few similar third-party evidence and registrations submitted by applicant are insufficient to establish that the wording CHEF SELECT is weak or diluted.

Further, evidence comprising third-party registrations for similar marks with different or unrelated goods and/or services, as in the present case, has “no bearing on the strength of the term in the context relevant to this case.” See *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058 (TTAB 2017) (citing *In re i.am.symbolic, llc*, 866 F.3d at 1328, 123 USPQ2d at 1751)). Thus, these third-party evidence and registrations submitted by applicant are insufficient to establish that the wording CHEF SELECT is weak or diluted.

Furthermore, while the examining attorney does not concede that the marks at issue are weak, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection under Section 2(d) against the registration by a subsequent user of a similar mark for closely related goods. TMEP

§1207.01(b)(ix); see *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010). Thus, this protection under Section 2(d) extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); see, e.g., *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1743 (TTAB 2016) (citing *Towers v. Advent Software, Inc.*, 913 F.2d 942, 946, 16 USPQ2d 1039, 1042 (Fed. Cir. 1990); *In re Research & Trademark Corp.*, 793 F.2d 1276, 1278, 230 USPQ 49, 49 (Fed. Cir. 1986); *In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978)). Accordingly, even assuming, *arguendo*, that the respective marks are weak, such a finding does not obviate the likelihood of confusion in the instant case.

The applicant also contends that, given the alleged weakness of the marks at issue, the fact that the applicant's mark contains design elements and additional descriptive wording help distinguish its mark from the registered mark. The examining attorney respectfully requests that these arguments be rejected.

In this instance, the registered mark is in standard characters. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. See *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. See, e.g., *In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "the argument concerning a difference in type style is not viable where one party asserts rights in no particular display").

Thus, the fact that the wording in applicant's mark is presented in stylized format and in color does not obviate the similarities between the marks at issue because the registered mark could be presented in the same style and color. Further, and as discussed above, the added descriptive wording "TO GO" and the design elements in applicant's mark will also not avoid a likelihood of confusion between the marks because these added elements do not alter the meaning and, therefore, commercial impression of the wording identical in both marks, CHEF SELECT, nor do they constitute the most dominant portion of the applicant's mark. Therefore, a potential consumer encountering the marks at issue used in connection with the same goods could mistakenly believe that the goods originate from one single or same source.

#### IV. CONCLUSION

The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Applicant's mark CHEF SELECT TO GO is highly similar to the cited mark, namely, CHEF SELECT. Moreover, the record shows that the goods at issue are identical and that the relevant consumer anticipates the goods will travel in the same channels of trade to the same consumer such that there exists a likelihood of confusion under Trademark Act Section 2(d). For the foregoing reasons, the examining attorney respectfully requests that the refusal to register applicant's mark be affirmed.

Respectfully submitted,

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