

This Opinion is not a
Precedent of the TTAB

Mailed: December 19, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Foodcare SP. Z.O.O.
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Serial No. 85699749
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John Alunit of Alunit IP,
for Foodcare SP. Z.O.O.¹

Jeffrey J. Look, Trademark Examining Attorney, Law Office 108,
Andrew Lawrence, Managing Attorney.

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Before Cataldo, Bergsman, and Pologeorgis,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Foodcare SP. Z.O.O. (“Applicant”) seeks registration on the Principal Register of the mark ORIGINAL PREMIUM BLACK ENERGY DRINK and design, shown below,



¹ The original applicant, Top Brand Spólka Z Ograniczona Odpowiedzialnoscia W Zabierzowie, assigned the application to Foodcare SP. Z.O.O. pursuant to a “court order” recorded in the USPTO Assignment Branch on November 13, 2015, at reel 5685, frame 0688.

for the goods listed below (emphasis added):²

Fizzy non-alcoholic drinks containing tannins, namely, **energy drinks**; Non-alcoholic beverages being fruit based; Non-alcoholic beverages having a fruit juice base; Non-alcoholic beverages with tea flavor; Non-alcoholic beverages, namely, soft drinks that are cherry flavored and contain cola extract; Non-alcoholic cherry flavored beverages, namely, **energy drinks**, soft drinks, bottled water, sparkling water, colas; Non-alcoholic beverages consisting of mixtures of fruit juices; Soft drinks consisting of non-fermented fruit juices; Non-alcoholic drinks made from water from the ground, namely, sparkling water, flavored mineral water, isotonic drinks, sports drinks; vitamin enriched non-alcoholic beverages vitamins not predominating, namely, drinking water with vitamins, energy drinks enhanced with vitamins, sports drinks enhanced with vitamins; Non-alcoholic soft drinks made from natural extracts; Non-alcoholic soft drinks made from artificial extracts; Non-alcoholic beverages containing fruit juices; Non-alcoholic beverages containing mineral water, namely, fruit drinks, isotonic drinks, energy drinks; Soft drinks; non-alcoholic sparkling drinks, namely, sparkling water, sparkling fruit juices; Colas being soft drinks; Non-fizzy non-alcoholic drinks containing tannins, namely, **energy drinks**, energy shots, sports drinks, soft drinks; Fruit-based soft drinks flavored with tea; non-alcoholic Cordials; isotonic non-alcoholic drinks containing caffeine; Mineral and aerated waters; Non-alcoholic drinks containing pineapple, namely, juices and pineapple juice based beverages; Soya bean based carbonated non-alcoholic beverages not being milk substitutes; Peanut milk being a soft drink; Non-alcoholic beverages made from syrups, namely, soft drinks, fruit drinks, **energy drinks**, sports drinks; Non-alcoholic beverages, namely, soft drinks, sports drinks, isotonic drinks, **energy drinks containing milk ferments**; Squashes being non-alcoholic soft drinks; Soya bean based non-carbonated non-alcoholic

² Application Serial No. 85699749 was filed on August 9, 2012, under Section 44(e) of the Trademark Act, 15 U.S.C. 1126(e), based upon Applicant's European Office for Harmonization in the Internal Market (OHIM) Registration No. 010149672 (registered April 19, 2012) (expires November 2021).

drinks not being milk substitutes; Mineral waters, in Class 32, and

Alcoholic beverages except beers; sparkling drinks, namely, wine; alcoholic cordials, in Class 33.

Applicant disclaimed the exclusive right to use the terms “Original Premium” and “Energy Drink.”

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the registered mark BLACK COLA ENERGY DRINK and design, shown below, for “energy drinks,” in Class 32, as to be likely to cause confusion.³



Registrant disclaimed the exclusive right to use “Cola Energy Drink.” The refusal is limited to the goods listed only in Class 32.

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177

³ Registration No. 4680427, registered February 3, 2015.

USPQ 563, 567 (CCPA 1973) (“*du Pont*”) (cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 135 S.Ct.1293, 113 USPQ2d 2045, 2049 (2015)); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant and for which there is evidence of record. *See M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See In re Chatam Int’l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015).

A. The similarity or dissimilarity and nature of the goods.

Because Applicant’s description of goods includes “energy drinks,” the goods are in part identical. Under this *du Pont* factor, the Trademark Examining Attorney need not prove, and we need not find, similarity as to each and every product listed in the description of goods. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods in a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun*

Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014);

B. Established, likely-to-continue channels of trade.

Because the goods described in the application and the cited registration are in part identical, we must presume that the channels of trade and classes of purchasers are the same as to those goods. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011).

C. The number and nature of similar marks in use on similar goods.

Applicant argues that the word “Black” in both marks is a weak term, entitled to only a narrow scope of protection or exclusivity of use.⁴ To support its argument, Applicant submitted copies of 11 third-party registrations for energy drinks that include the word “Black” as part of their marks.⁵ The registrations are listed below:

1. Registration No. 3294381 for the mark BLACK DOG;

⁴ Applicant’s Brief, 5 TTABVUE 6.

⁵ We did not consider Registration No. 4366034 for the mark BRUISER BLACKBERRY because “Blackberry” is a specific flavor and does not engender a commercial impression relating to the color “Black.”

2. Registration No. 3851986 for the mark **BIG BLACK M JAVA MONSTER** and design, shown below:



3. Registration No. 3528857 for the mark **BLACK MAMBA**;
4. Registration No. 3822775 for the mark **POWER IN BLACK**;
5. Registration No. 3924894 for the mark **28BLACK** for energy drinks;
6. Registration No. 4277150 for the mark **BLACK STEEL** and design, shown below:



7. Registration No. 4018064 for the mark **BLACK DEATH**;
8. Registration No. 4371218 for the mark **BLACK SUN**;
9. Registration No. 4685465 for the mark **BLAK MAX**;
10. Registration No. 4385185 for the mark **BLACK LABEL**; and
11. Registration No. 4716820 for the mark **NEW BLACK GOLD**

Applicant also submitted excerpts from websites showing advertisements for **BIG BLACK M JAVA MONSTER**, **VENOM ENERGY BLACK MAMBA**, **28 BLACK**, **BLACK STEEL**, **BLACK DEATH**, **BLACK SUN**, **BLAK MAX**, **BLACK LABEL**, and

NEW BLACK GOLD energy drinks. The letter “M” and MONSTER JAVA are the dominant elements displayed on the BIG BLACK M JAVA MONSTER product.



The term “Venom Energy” is the dominant element displayed on the VENOM ENERGY BLACK MAMBA product.



The term “Gold” is the dominant element displayed on in the NEW BLACK GOLD advertisement.



Applicant's mark ORIGINAL PREMIUM BLACK ENERGY DRINK and design and the registered mark BLACK COLA ENERGY DRINK and design are closer to each other than any of the other third-party marks because the word "Black" creates the dominant commercial impression of those marks. In the third-party marks such as BLACK DOG, BLACK MAMBA, BLACK STEEL, BLACK DEATH, BLACK SUN, BLAK MAX, and BLACK LABEL, the word "Black" is used to modify the word that follows "Black" creating a unitary mark engendering the commercial impression of a black colored object. For example, the mark BLACK DOG engenders the commercial impression of a dog that is colored black, the mark BLACK MAMBA engenders the commercial impression of a black snake, and BLACK DEATH engenders the commercial impression of a plague.

This leaves BIG BLACK M JAVA MONSTER and design, POWER IN BLACK, and 28BLACK. With respect to the mark BIG BLACK M JAVA MONSTER and design, the letter "M" and the term JAVA MONSTER are the dominant elements. Even if we include BIG BLACK M JAVA MONSTER and design, three registrations incorporating the word "Black" does not substantially dilute the word "Black" in connection with energy drinks.

Nevertheless, when comparing the marks, we will keep in mind that the word "Black" is a color, that it is often used to modify the word that it precedes, and that Registrant's mark is not entitled to such a broad scope of protection that it will bar the registration of every mark comprising, in whole or in part, the word "Black." It will bar the registration of marks "as to which the resemblance to [Registrant's mark]

is striking enough to cause one seeing it to assume that there is some connection, association or sponsorship between the two.” *Anthony's Pizza & Pasta Int'l Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1278 (TTAB 2009), *aff'd*, 415 Fed. Appx. 222 (Fed. Cir. 2010) (quoting *Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB 1983)).

D. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. We are mindful that where, as here, the goods are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Prod. Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721; *see also San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*,

565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because the products at issue are energy drinks, the average customer is an ordinary consumer.

Applicant's mark and Registrant's mark are shown below:

Applicant's Mark



Registered Mark



Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our analysis is not predicated on dissecting the marks into their various components. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). On the other hand, 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 entirety. *In re Nat'l Data*, 224 USPQ at 751.

For the reasons set forth below, we find that the word “Black” is dominant part of both marks. In the case of marks consisting of words and a design, as we have in this case, 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 services. *See In re Viterro Inc.*, 101 USPQ2d at 1908 (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). Thus, the words have more trademark significance than the designs.

The word “Black” is the dominant part of both marks because the term “Energy Drink” is the generic term for the goods at issue (*i.e.*, energy drinks). With respect to the registered mark, the terms “Cola Energy Drink” describes Registrant’s product as a cola-based energy drink. The term “Original Premium,” in Applicant’s mark is laudatory and it is presented in much smaller type than BLACK. It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re National Data Corp.*, 224

USPQ at 752; *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

Consumers encountering Applicant’s ORIGINAL PREMIUM BLACK ENERGY DRINK are likely to shorten the mark to BLACK ENERGY DRINK. Likewise, consumers familiar with Registrant’s product are likely to shorten its name to BLACK COLA. “[U]sers of language have a universal habit of shortening full names – from haste or laziness or just economy of words. Examples are: automobile to auto; telephone to phone; necktie to tie; gasoline service station to gas station.” *In re Abcor Development Corp.*, 588 F.2d 511, 200 USPQ 215, 219 (CCPA 1978) (J. Rich, concurring); *see also Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1333 (TTAB 1992); *Big M Inc. v. The United States Shoe Co.*, 228 USPQ 614, 616 (TTAB 1985). Under such circumstances, consumers are likely to mistakenly believe that Applicant’s ORIGINAL PREMIUM BLACK ENERGY DRINK is the original BLACK energy drink and that Registrant’s BLACK COLA is the cola line of the BLACK energy drink company.

In view of the foregoing, we find that the marks are similar in appearance, sound, meaning and commercial impression.

E. Balancing the factors.

Because the marks are similar, the goods are identical in part and there is a presumption that the identical goods move in the same channels of trade and are sold to the same class of consumers, we find that Applicant's mark ORIGINAL PREMIUM BLACK ENERGY DRINK and design for, *inter alia*, energy drinks, is likely to cause confusion with the registered mark BLACK COLA ENERGY DRINK and design for "energy drinks."

Decision: The refusal to register Applicant's mark ORIGINAL PREMIUM BLACK ENERGY DRINK and design in Class 32 is affirmed.

The application will be forwarded for publication for the goods listed in Class 33 in due course.