

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Epic Naturals LLC
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Serial No. 85762380
Serial No. 85762427
—

Neal P. Pierotti of Metz Lewis Brodman Must O’Keefe,
for Epic Naturals LLC

J. Peter Bodri, Trademark Examining Attorney, Law Office 105,
Susan Hayash, Managing Attorney.

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Before Zervas, Kuhlke and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Epic Naturals LLC (“Applicant”) seeks registration on the Principal Register of
the marks THE EPIC SEED (in standard characters) and



(word and design mark), both for “yogurt, strained yogurt, and
probiotic yogurt-based beverages not for medical purposes” in International Class

29.¹

The Trademark Examining Attorney has refused registration of Applicant's marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's marks so resemble the mark EPIC (in typed form),² registered for "cheese" in International Class 29, that if used in connection with Applicant's identified goods, they are likely to cause confusion or mistake or to deceive. In addition, the Examining Attorney refused registration under Section 6 of the Trademark Act, 15 U.S.C. § 1056(a), based on Applicant's failure to comply with the requirement to disclaim exclusive right to use the merely descriptive word "SEED" in both marks.

After the Trademark Examining Attorney made the refusals final,³ Applicant appealed to the Board, which consolidated the two appeals. We affirm both refusals to register.

I. Analysis

A. The Disclaimer Requirement.

We address the disclaimer requirement first because it bears upon the likelihood

¹ Application Serial No. 85762380 for the standard character mark and Application Serial No. 85762427 for the word and design mark were both filed on October 24, 2012, based upon applicant's allegation of a *bona fide* intention to use the marks in commerce under Section 1(b) of the Trademark Act.

² Registration No. 2358175, issued June 13, 2000, alleging first use in commerce on June 1, 1999, and renewed on August 7, 2009. Until 2003, "standard character" marks were known as "typed" marks. See *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258 n.1 (Fed. Cir. 2011). A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (2015).

³ Final Office Action, April 27, 2014. (All references to the record and TTABVUE refer to both applications, unless otherwise indicated.)

of confusion issue.

Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), provides that “The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” Under its terms, an Examining Attorney may require the disclaimer of unregistrable components, such as descriptive or generic terms. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1394 (TTAB 2013). The disclaimer disavows any exclusive right to use the specified word outside of its use within a composite mark. *Id.* (citing *In re Franklin Press, Inc.*, 597 F.2d 270, 201 USPQ 662, 665 (CCPA 1979)). The Examining Attorney can condition the registration of the composite mark on disclaimer of the unregistrable portion. *In re Louisiana Fish Fry Products, Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015). And failure to comply with such a disclaimer requirement is a ground for refusing registration. *See In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395 (Fed. Cir. 2006); *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087 (Fed. Cir. 2005).

Merely descriptive terms are unregistrable under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), and are therefore subject to disclaimer if the mark is otherwise registrable. *E.g.*, *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re RiseSmart, Inc.*, 104 USPQ2d 1931, 1934 (TTAB 2012). A term is merely descriptive if it immediately conveys knowledge of an ingredient, quality, or characteristic of the goods with which it is used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). *See In re Box Solutions Corp.*, 79 USPQ2d 1953, 1954 (TTAB 2006).

As noted in *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978), the major reasons for requiring a disclaimer of such descriptive terms are:

(1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

Id. at 217. See also *In re Greenliant Systems Ltd.*, 97 USPQ2d 1078, 1085 (TTAB 2010) (“Highly descriptive terms... are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms.”) quoted in *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1767 (TTAB 2013). Trademark Manual of Examining Procedure (TMPEP) § 1209.

Here, the Examining Attorney required Applicant to disclaim the word “SEED” in both applied-for marks because it describes an ingredient of its yogurt product: chia seeds.⁴ Applicant’s yogurt containers, pictured below, announce their content: “GREEK YOGURT + CHIA”:⁵

⁴ Office Action of April 27, 2014, p. 1.

⁵ Office Action of October 3, 2013, p. 30, Applicant’s Facebook page.

It quickly became our go-to breakfast. But it wasn't always perfect – fruit and yogurt would spoil and our bag of chia wouldn't last forever. We wanted to bring all the pieces together into one perfect cup. It was at that moment that The Epic Seed was created. We set out to make exactly what we had grown to love – a perfect combination of Greek Yogurt, fruit and chia.⁸

Applicant's founder was quoted as follows: "Chia is the Mayan word for strength, and some consider it nature's perfect food," said Jesse Rodoply, founder, Epic Naturals. "We believe we've filled a void in the marketplace and created a brand, that like the little chia seed itself, packs a real punch."⁹

Applicant does not dispute that chia seeds are an important, nay indispensable, ingredient of its goods. Rather, it contends, somewhat dubiously, that "Chia seeds are what is in the product, not seeds."¹⁰ "Applicant does not list 'seed' as an ingredient on Applicant's goods. Chia seeds are what is in the product, not seeds."¹¹

All the same, seeds are seeds. The generic category of seeds encompasses the subset of chia seeds.¹² The question is not whether someone presented only with the THE EPIC SEED marks could guess that the yogurt products to which the marks

⁸ Office Action of April 27, 2014, pp. 113-117.

⁹ Office Action of April 27, 2014, p. 118, quote in Sept. 4, 2013 article, www.FoodBev.com.

¹⁰ Response to Office Action, April 4, 2014, p. 1.

¹¹ Applicant's brief, 4 TTABVUE 19 (App. Ser. No. 85762427); 4 TTABVUE 18-19 (App. Ser. No. 85762380).

¹² "Seed' 1. A ripened plant ovule containing an embryo. 2. A propagative part of a plant, as a tuber or spore. Seeds considered as a group." --Office Action of Oct. 3, 2013, p. 19, Online Houghton Mifflin Dictionary. "Chia' a plant, *Salvia columbariae*, of the mint family, native to the southwestern U.S. and Mexico, having mostly basal, oblong leaves and small blue flowers: the seeds are used as food and as the source of a beverage." --Office Action of April 27, 2014, p. 88, Dictionary.infoplease.com. The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also *In re Heatcon*, 116 USPQ2d 1366, 1374n. 19 (TTAB 2015).

are affixed contain chia seeds. Rather, the question is whether someone who knows what the products are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002)). In fact, Applicant's argument may prove that its use of the word SEED is generic, rather than merely descriptive. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001) ("Generic terms are common names that the relevant purchasing public understands primarily as describing the genus of goods or services being sold."); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986) (generic terms are "the ultimate in descriptiveness"). But it does not overcome the disclaimer requirement. *In re Creative Goldsmiths of Wash., Inc.*, 229 USPQ 766, 768 (TTAB 1986) (disclaimer may be required for descriptive or generic component).

Applicant argues that THE EPIC SEED is a double entendre, which should not be broken up for purposes of requiring a disclaimer,¹³ citing *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983). According to Applicant, the mark has two meanings: (1) an impressive, natural, and healthy product (a meaning derived from "epic" which means impressive in quality, and "seed," which is an item found in nature), and (2) something that allows you to start out on your own important journey (a meaning derived from "epic," which refers to a story of some importance, and "seed,"

¹³ Applicant's brief, 4 TTABVUE 19.

which is associated with something that is about to start or grow).¹⁴ The Examining Attorney responds that this asserted double entendre “more closely resembles an extended metaphor. Moreover, this metaphor is not readily apparent from the mark itself such that a consumer would identify it as a double entendre.”¹⁵

A double entendre is an “ambiguity of meaning arising from language that lends itself to more than one interpretation.” *In re The Place, Inc.*, 76 USPQ2d 1467, 1470 (TTAB 2005) (citing *Webster's Third New International Dictionary* (1993)). For trademark purposes, “a ‘double entendre’ is an expression that has a double connotation or significance as applied to the goods or services. ... The multiple interpretations that make an expression a ‘double entendre’ must be associations that the public would make fairly readily.” *Id.* (citing TMEP § 1213.05(c)). *Compare In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE double entendre for bakery products), *with In re RiseSmart*, 104 USPQ2d at 1934 (“We do not find TALENT ASSURANCE to present a double entendre such that ‘the merely descriptive significance of the term [TALENT] is lost in the mark as a whole.’”) (distinguishing *Colonial Stores*).

The present case is unlike cases where double entendres have been found to obviate the necessity for a disclaimer of a descriptive element. In *In re Kraft*, 218 USPQ2d at 573, on which Applicant relies, the record included “evidence of applicant's long and extensive use of its [LIGHT N' LIVELY] mark in connection with food products as well as copies of its four subsisting registrations of the mark

¹⁴ Applicant's brief, 4 TTABVUE 10-11.

¹⁵ Examining Attorney's brief, 8 TTABVUE 11.

for various food products closely related to the goods here involved.” *Id.* That, coupled with “the alliterative lilting cadence which encourages persons encountering [LIGHT N’ LIVELY] to perceive it as a whole,” convinced the Board that “the merely descriptive significance of the term ‘LIGHT’ is lost in the mark as a whole.” *Id.* And in *In re Colonial Stores Inc.*, the mark SUGAR & SPICE evoked an old, familiar nursery rhyme, which would induce purchasers to view it as a unitary mark, disregarding its otherwise descriptive elements. 157 USPQ at 385 n.7.

Here, Applicant has applied for registration based on its intent to use the marks under Section 1(b) of the Trademark Act, and has not presented evidence that consumers would understand the asserted double entendre, or that it owns other registrations for closely related goods in which SEED is not disclaimed. The dual meanings suggested by Applicant are at most creative interpretations that would not be readily apparent to relevant purchasers upon seeing the THE EPIC SEED marks on the goods. The word SEED refers to its chia seeds, an ingredient it advertises as a selling point,¹⁶ and that meaning is not lost in the mark as a whole. *See In re RiseSmart, Inc.*, 104 USPQ2d at 1934.

All in all, Applicant’s arguments fail to overcome the disclaimer requirement, and both marks may be refused registration based on Applicant’s failure to comply with that requirement.

¹⁶ Office Action of April 27, 2014, p. 118, attaching online article from FoodBev.com.

Office Action of October 3, 2013, p. 36.

B. Likelihood of Confusion With the Registered Mark.

We next consider whether Applicant's marks are likely to be confused with Registrant's EPIC mark. Our determination of likelihood of confusion under Section 2(d) of the Trademark Act 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, 567 (CCPA 1973) ("*DuPont*"). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor that is relevant and for which there is evidence of record. See *M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006); *ProMark Brands Inc. and H.J. Heinz Company 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 or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also *In re i.am.symbolic, LLC*, 116 USPQ2d 1406, 1409 (TTAB 2015).

1. Comparison of the Marks.

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant's and Registrant's marks, as compared in their entireties, taking into account their appearance, sound, connotation and commercial impression. *Palm*

Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013).

Applicant argues that THE EPIC SEED “has four syllables and is eleven letters in length and is made of three words while the mark ‘EPIC’ only has two syllables and is only four letters in length and is but a single word.”¹⁷ But the extra words in Applicant’s marks are not distinctive. The article THE at the beginning of the marks does not add any trademark significance. *E.g. In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (WAVE and THE WAVE confusingly similar); *In re Narwood Prod., Inc.*, 223 USPQ 1034 (TTAB 1984) (THE MUSIC MAKERS confusingly similar to MUSICMAKERS). And the word SEED at the end of the marks is, as we have determined, merely descriptive and subject to disclaimer. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (quoting *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1983) (“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”)); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 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”). The seed-shaped design element in Applicant’s word-and-design mark merely serves to reinforce the meaning of the descriptive term SEED,

¹⁷ Applicant’s brief, 4 TTABVUE 9.

without adding to its commercial distinctiveness. In *Joel Gott Wines LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424 (TTAB 2013), the Board stated:

As for the design element, it does not create a separate commercial impression but serves merely as a carrier for the words. Further even if we were to consider the ...design as creating a separate impression, it is of less significance than the dominant [word] feature...; moreover, as a water feature, the ocean wave imagery reinforces the connection to applicant's goods as water beverages and related goods. In the case of marks consisting of words and a design, the words are normally given greater weight because they would be used by consumers to request the products.

Id. at 1430-31.

So too here. Applicant insists that its marks, taken in their entirety, convey a distinct connotation because they are a double entendre,¹⁸ but this argument has already been addressed above. Applicant provides no reason to believe that the relevant purchasing public will readily associate its marks with its claimed double entendre. *See In re The Place, Inc.*, 76 USPQ2d at 1470.

The only distinctive element of Applicant's mark is the term EPIC, which it shares with Registrant's mark. While we are aware that the decision must be based on the entire marks, not just part of the marks, *see Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014), 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 National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

¹⁸ Applicant's brief, 4 TTABVUE 10-11.

The *DuPont* factor regarding the similarity of the marks favors a finding of likelihood of confusion.

2. Relatedness of the Goods and Channels of Trade.

We turn now to the *DuPont* factors of the relatedness of the goods and channels of trade. We base our evaluation on the goods as they are identified in the application and registration. *Stone Lion Capital*, 110 USPQ2d at 1161; *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Applicant's identified goods are "yogurt, strained yogurt, and probiotic yogurt-based beverages not for medical purposes,"¹⁹ and Registrant's goods are "cheese."²⁰

Applicant urges that "There is no overlap between the goods called for in the application, and the goods called for in the registration. The goods are not similar. Applicant's goods are provided in a gel form or a beverage. They are eaten with a spoon or sipped. ... Registrant's goods, on the other hand, are provided in a solid form and are not a liquid and are not in a gel form. ... The textures and tastes of cheese and yogurt are different from one another."²¹ The issue, though, is not whether purchasers would confuse the goods, but whether there is a likelihood of confusion as to the source of these goods. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984). The goods need only be sufficiently related that consumers would be likely to assume, upon

¹⁹ Application Serial Nos. 85762380, 85762427.

²⁰ Registration No. 2358175.

²¹ Applicant's brief, 4 TTABVUE 13, (App. Ser. No. 85762427); 4 TTABVUE 12 (App. Ser. No. 85762380).

encountering the goods under similar marks, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *Joel Gott Wines*, 107 USPQ2d at 1431.

The Examining Attorney has submitted evidence to show the relatedness of the goods. With the April 27, 2014 Office Action, the Examining Attorney made of record third-party use-based registrations showing that various entities have registered a single mark for the Applicant and Registrant's respective goods. E.g.:

- TIA ANGELITA Reg. No. 4169160 for "Cheese, meat, yogurt" in International Class 29.
- GREAT DAIRY NO BULL! Reg. No. 4478496 for "Dairy products, namely, milk, cheese, yogurt, crème fraiche" in International Class 29.
- GLENVIEW FARMS, Reg No. 4444468 for "Dairy products, namely, natural cheese, processed cheese, butter, milk, cream, whipping cream, cottage cheese, sour cream, eggs, yogurt, non-dairy creamers, powdered milk, canned milk, powdered eggs and egg substitutes, cream cheese, margarine" in International Class 29.²²

With the March 1 and October 3, 2013 Office Actions, the Examining Attorney submitted excerpts from various third-party websites showing that the same entities can and often do offer cheese and yogurt products under the same marks.

- Samish Bay organic cheese and yogurt;

²² Office Action of April 27, 2014, pp. 28-32.

- Tillamook cheese and yogurt;
- Cabot Greek-Style yogurt and cheddar cheeses;
- Wake Robin family farm dairy products –milk, yogurt and cheese;
- Old Chatham Shepherding Company sheep’s milk products, including Camembert, sheep’s milk Yogurt;
- Sierra Nevada Cheese Company goat’s milk dairy products, including Caprae raw aged goat cheddar and Capretta Goat yogurt;
- Karoun Dairies cheeses, yogurt, and yogurt drink;
- Redwood Hill Farm goat dairy farm and creamery goat milk cheese in chevre, feta, goat cheddar, and rind-ripened artisanal cheese, goat milk yogurt, and goat milk kefir, “a deliciously mild beverage packed with beneficial probiotics.”²³

Applicant points to certain producers who purvey only one type of good, but not the other, such as KRAFT, which sells cheese but not yogurt, and DANNON, which sells yogurt but not cheese.²⁴ But that misses the point. Third-party registrations that individually cover a number of different items and that are based on use in commerce serve to suggest that the listed goods are of a type that may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). As the Examining Attorney points out, a multitude of companies

²³ Office Action of March 1, 2013, pp. 13, 16, 18-22; Office action of Oct. 3, 2013, pp. 4, 6-8, 14, 17-18.

²⁴ Applicant’s brief, 4 TTABVUE 14 (App. Ser. No. 85762380), 4 TTABVUE 15 (App. Ser. No. 85762427).

provide both products.²⁵ This evidence, taken together with the complementary nature of the goods, demonstrates that Applicant's identified goods are related to the "cheese" identified in the cited registration. Moreover, the Internet evidence shows that the goods and services can be offered to the same classes of customers through the same channels of trade.

The *DuPont* factors of relatedness of goods and channels of trade weigh in favor of finding a likelihood of confusion.

3. Sophistication and Care of Purchasers.

The next *du Pont* factor we consider is the conditions under which and buyers to whom sales are made, i.e., "impulse" versus careful, sophisticated purchasing. Applicant maintains that buyers of its yogurt-based products tend to be health-conscious consumers—the kind of consumers who would exercise care and sophistication in their purchasing decisions and avoid cheese, which can have high amounts of saturated fat.²⁶ For this reason, Applicant implies, these consumers would be unlikely to encounter both Applicant's and Registrant's marks under circumstances engendering confusion.

Both yogurt and cheese are relatively inexpensive dairy products that would tend to be displayed in the refrigerated sections of grocery stores. *See In re Martin's Famous Pastry Shoppe, Inc.*, 223 USPQ 1289 at 1290; *Gen. Mills, Inc. & Gen. Mills Ip Holdings II, LLC v. Fage Dairy Processing Industry S.A.*, 100 USPQ2d 1584, 1600 (TTAB 2011) *judgment set aside, opinion not vacated* 110 USPQ2d 1679 (TTAB

²⁵ Examining Attorney's brief, 8 TTABVUE 9.

²⁶ Applicant's brief, 4 TTABVUE 15-16.

2014). Generally, purchasers of casual, low-cost ordinary consumer items exercise less care in their purchasing decisions and are more likely to be confused as to the source of the goods. *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1519 (TTAB 2009).

Although some of the parties' more health-conscious consumers may be more careful in their purchases, we must base our decision on the least sophisticated potential purchasers. *Gen. Mills v. Fage*, 100 USPQ2d 1584 at 1600 (citing *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1027 (TTAB 2009)). Moreover, we must base our decision on the goods as identified in the cited registration, which does not exclude low-fat cheeses. *See Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987); *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999).

Consequently, this factor is neutral.

4. Weakness of the Registered Mark

We next consider the sixth *DuPont* factor: the number and nature of similar marks in use on similar goods. Applicant cites five registrations for marks containing the word EPIC for edible products:

- Reg. No. 4308909, EPIC SHAVE ICE for shave ice;
- Reg. No. 4333926, EPIC FORTUNE for cookies;
- Reg. No. 3943990, EPIC ROOTS for packaged salad mixes;
- Reg. No. 3092984, EPIC ROOTS MACHE MIX for packaged salads;

- Reg. No. 4385570, EPIC SPICES for edible spices.²⁷

Applicant offers these registrations to show that the word EPIC, as used in the cited registration, is relatively weak and entitled to a narrow scope of protection. It observes that, “All of the aforementioned goods are for items that are eaten by a person and are similar to cheese in that they are foods that are eaten.”²⁸

If there is evidence that a mark, or an element of a mark, has been used extensively in commerce by a number of third parties, that would tend to undermine its commercial strength, as it may show that the consuming public has become familiar with a multiplicity of similar marks, and can distinguish them based on minor differences. *Palm Bay Imps.*, 73 USPQ2d at 1693 (“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”). But where the “record includes no evidence about *the extent of [third-party] uses ... [t]he probative value of this evidence is thus minimal.*” *Id.* at 1693 (quoting *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1561 (Fed. Cir. 2001) (emphasis in original)). Applicant has introduced no evidence that these registered third-party trademarks were actually used by the third parties, that they were well promoted, or that they were recognized by consumers. *See Scarves by Vera, Inc. v. Todo Imports, Ltd.*, 544 F.2d 1167, 1173, 192 USPQ 289 (2d Cir. 1976) *quoted in Palm*

²⁷ Applicant’s brief, 4 TTABVUE 16 (App. Ser. No. 85762380); 4 TTABVUE 17 (App. Ser. No. 85762427); copies of registrations in September 4, 2013 Response to Office Action at p. 21 et seq.

²⁸ Applicant’s brief, 4 TTABVUE 1616 (App. Ser. No. 85762380); 4 TTABVUE 17 (App. Ser. No. 85762427).

Bay Imps., 73 USPQ2d at 1693. The registrations thus fail to demonstrate commercial weakness of the Examining Attorney's cited EPIC registration. Consequently, this factor does not weigh against a finding of likelihood of confusion.

On the other hand, if there is evidence that a mark, or an element of a mark, has been adopted by a multiplicity of different registrants, that may indicate that the common element has some significance that undermines its conceptual strength as an indicator of a single source. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ ... that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak’”(quoting 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 11:90 (4th ed. 2015)), *quoted in Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). *Juice Generation* addressed at least 26 uses or registrations of the same phrase for restaurant services or food products. *Id.* at 1673n.1. Applicant addresses only five third-party registrations for food products, none of which relate to dairy products (which would explain why they were not cited against Applicant's application), and all of which, taken together, fail to demonstrate that EPIC has “a normally understood and well-recognized descriptive or suggestive meaning” in Applicant's or Registrant's product area. *See Jack Wolfskin*, 116 USPQ2d at 1136.

The cited third-party registrations thus fail to prove that Registrant's mark is weak and subject to a narrower scope of protection.

5. Actual Confusion.

Finally, Applicant asserts that "Actual consumer confusion in this case does not exist" despite its sale of goods under the THE EPIC SEED mark since at least as early as July 2013, concurrently with EPIC cheese sales.²⁹

Such an assertion, however, is of little probative value in an *ex parte* proceeding such as this:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an *ex parte* proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

Here, we have nothing more to go on than an assertion made by Applicant's counsel in its appeal brief. As in *In re Kangaroos*, we have no evidence of the extent and nature of Applicant and Registrant's concurrent advertising, marketing and provision of their goods under their respective brands, and cannot determine whether there has been an opportunity for confusion to have occurred. As our principal reviewing court has observed, "A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The

²⁹ Applicant's brief, 4 TTABVUE 17-18 (App. Ser. No. 85762380); 4 TTABVUE 18-19 (App. Ser. No. 85762427).

opposite is not true, however. The lack of evidence of actual confusion carries little weight, especially in an *ex parte* context.” *Majestic Distilling*, 65 USPQ2d at 1205 (internal citation omitted).

In this case, Applicant’s assertion is entitled to no probative value, so this factor does not weigh against a finding of likelihood of confusion.

6. Balancing the Factors.

Taking into account the totality of the evidence of record, we find that Applicant’s two applied-for marks are confusingly similar to the cited registration. They are similar marks for closely related goods that could emanate from the same source and travel through the same channels of trade to the same class of relevant consumers, who would not, under the circumstances, be expected to exercise great sophistication or care to avoid confusion. Further, the existence of third-party registrations for marks containing the word EPIC does not militate against a likelihood of confusion, nor does the asserted, but unproven, absence of actual confusion.

We treat as neutral any *DuPont* factors for which there is no evidence or argument of record. We conclude, after considering all evidence and arguments bearing on the *DuPont* factors, including the evidence and arguments that we have not specifically discussed herein, that Applicant’s THE EPIC SEED marks, as used on the goods identified in the applications, so resemble the registered EPIC mark, as used on the goods identified in the registration, as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

II. Conclusion

Decision: The refusals to register Applicant's marks THE EPIC SEED and



are affirmed on both grounds: failure to disclaim SEED and likelihood of confusion with the registered mark.