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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Applied for Mark	JUDICAKES
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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Mark:	JUDICAKES	)	
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**APPLICANT'S REPLY BRIEF**

Applicant hereby submits the present brief in reply to the Trademark Examining Attorney's  
Appeal Brief filed December 18, 2015.

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## **II. DESCRIPTION OF THE RECORD**

Further to Applicant's Appeal Brief, the following is a supplement statement of the record.

On December 18, 2015, the Examining Attorney filed an Appeal Brief in response to Applicant's Appeal Brief.<sup>1</sup> In the Examining Attorney's Appeal Brief, the Examining Attorney maintained her likelihood of confusion rejection based on U.S. Registration No. 3,582,876.

Applicant does not agree with the Examining Attorney's position that the applied-for mark JUDICAKES is likely to cause consumer confusion with the mark JUDY'S BREADSTICKS in U.S. Registration No. 3,582,876.

## **III. ARGUMENT**

### **A. THE EXAMINING ATTORNEY HAS FAILED TO COMPARE THE MARKS IN THEIR ENTIRETIES**

Although the Applicant agrees with the Examining Attorney that "marks are compared in their entirety for similarities in appearance, sound, connotation, and commercial impression,"<sup>2</sup> Applicant respectfully asserts that the Examining Attorney has failed to compare the marks in their entirety. Rather, the Examining Attorney has continued to conduct piecemeal review of the marks by arguing that: (1) "consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark;"<sup>3</sup> (2) "one feature of a mark may be more significant or dominant in creating a commercial impression;"<sup>4</sup> and (3) "a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial

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<sup>1</sup> December 18, 2015 Examining Attorney's Appeal Brief, TSDR p. 1.

<sup>2</sup> December 18, 2015 Examining Attorney's Appeal Brief, TSDR p. 5.

<sup>3</sup> December 18, 2015 Examining Attorney's Appeal Brief, TSDR p. 6.

<sup>4</sup> December 18, 2015 Examining Attorney's Appeal Brief, TSDR p. 6.

impression,”<sup>5</sup> without then evaluating the marks in their entirety. Although the cases cited by the Examining Attorney appear to indicate that each of these assumptions/approaches may be considered in determining a likelihood of confusion, the facts of the cases relied upon by the Examining Attorney are clearly distinguishable from the present facts. Moreover, each of these cases makes it clear that marks must be compared in their entireties even if the above initial considerations are conducted.

### **1. The Examining Attorney has Misapplied Case Law Regarding Consumers’ Inclination to Focus on the First Word of a Trademark**

The cases the Examining Attorney cited in connection with the contention that “consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark”<sup>6</sup> do not support the Examining Attorney’s argument that Applicant’s mark is confusingly similar to the registered mark. In fact, neither of the cases cited by the Examining Attorney state that consumers are more inclined to focus on the first prefix or syllable.<sup>7</sup> Rather, these cases state that the first word in a mark “remains a ‘prominent feature’ as the first word in the mark”<sup>8</sup> and “it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.”<sup>9</sup> Nevertheless, even when focusing on the first word or the first part of the mark when comparing Applicant’s mark to the registered mark, the cases cited by the Examining Attorney still do not support the Examining Attorney’s assertion that Applicant’s mark is confusingly similar to the registered mark.

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<sup>5</sup> December 18, 2015 Examining Attorney’s Appeal Brief, TSDR p. 6.

<sup>6</sup> December 18, 2015 Examining Attorney’s Appeal Brief, TSDR p. 6.

<sup>7</sup> See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En*, 396 F.3d 1369 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2D 1895 (TTAB 1988).

<sup>8</sup> *Palm Bay Imps., Inc.*, 396 F.3d at 1372.

<sup>9</sup> *Presto Prods., Inc.*, 9 USPQ2D at \*3.

The first case cited by the Examining Attorney, *Palm Bay Imps.*, involved the applicant's mark VEUVE ROYALE, which was rejected based on the registered marks VEUVE CLICQUOT and VEUVE CLICQUOT PONSARDIN.<sup>10</sup> In this case, the Federal Circuit determined that, although CLICQUOT was an important term in the mark, VEUVE nevertheless remained a "prominent feature" as the first word in the mark and the dominant feature, "especially in light of the largely laudatory (and hence non-source identifying) significance of the word ROYALE."<sup>11</sup> Although the court in *Palm Bay Imps., Inc.* was easily able to determine that VEUVE was a prominent and dominant feature of the marks at issue, the court was not considering a single word mark compared to a multi-word mark as in the present case, thus limiting the holding to instances where a multi-word mark is compared to another multi-word mark.

Unlike the marks in *Palm Bay Imps., Inc.*, which involved a multi-word mark being compared to another multi-word mark, the present case is clearly distinguishable because it does not involve comparisons between multi-word marks.<sup>12</sup> Rather, the present case concerns a single made-up word mark being compared to a multi-word mark. Therefore, because the court only dealt with a multi-word mark in comparison with another multi-word mark, this case is not purely analogous to the present facts and the same analysis applied in *Palm Bay Imps., Inc.* simply cannot be applied in the present case. Moreover, the court in *Palm Bay Imps., Inc.* placed emphasis on the fact that the second word in the mark VEUVE ROYALE was laudatory.<sup>13</sup> In the present case, there is no laudatory second word in the mark JUDICAKES since Applicant's mark is a neologism. Thus, because the court considered more factors than just the prominence

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<sup>10</sup> *Palm Bay Imps., Inc.*, 396 F.3d 1369.

<sup>11</sup> *Id.* at 1372-74.

<sup>12</sup> *See id.*

<sup>13</sup> *See id.* at 1372.

of first word of the mark in refusing registration of the applicant's mark, this case has been misapplied to the facts in the present case.

Similarly, in the second case cited by the Examining Attorney to support the contention that consumers focus on the first word in a trademark, the applicant's mark KIDWIPES was rejected over the registered mark KID STUFF.<sup>14</sup> Although this case involved a single word mark compared to a double word mark, the court held that there were similarities between the marks because both marks start with the term KID *and* "have the same number of letters and syllables."<sup>15</sup> Therefore, the court did not base its refusal of applicant's registration merely on the fact that both marks started with the term KID.<sup>16</sup> Rather, the court gave weight to the fact that both marks started with the same term, had the same number of letters, AND had the same number of syllables.<sup>17</sup> Moreover, the court in *Prest Prods. Inc.* also considered the fact that "prior to the applicant's first use of 'KIDWIPES,' opposer was the only party using the term 'KID' as part of a mark for moist towelettes, or wipes; [and] that applicant and opposer are the only parties which now use such a mark," in determining there was a likelihood of confusion.<sup>18</sup>

The present case is clearly distinguishable from *Prest Prods. Inc.* Although Applicant's mark JUDICAKES and registrant's mark JUDY'S BREADSTICKS both start with JUD, the similarities end there. Applicant's mark and the registrant's mark, in contrast to the marks found in *Presto Prods. Inc.*, do not have the same number of letters nor do they have the same number of syllables. Moreover, unlike the fact that the parties in *Prest Prods. Inc.* were, and continued

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<sup>14</sup> *Presto Prods. Inc.*, 9 USPQ2D 1895.

<sup>15</sup> *See id.* at \*3.

<sup>16</sup> *See id.*

<sup>17</sup> *See id.*

<sup>18</sup> *Id.*



to be, the only parties using the term KID “as part of a mark for moist towelettes, or wipes,”<sup>19</sup> the same is not true in the present case. In fact, in the present case, the Examining Attorney cited several marks in the first refusal of Applicant’s mark on February 12, 2015, including: U.S. Registration No. 2,533,954 for JUDY’S HANDMADE THE OLD FASHION WAY; U.S. Registration No. 3,400,138 for JUDY’S CANDY COMPANY HANDMADE THE OLD-FASHIONED WAY; and the mark currently the subject of the present refusal U.S. Registration No. 3,582,876 for JUDY’S BREADSTICKS.<sup>20</sup> In addition to the marks cited by the Examining Attorney, which all begin with JUDY’S, another mark exists that was registered after the JUDY’S BREADSTICKS mark: U.S. Registration No. 4,472,360 for JUDYMAN.<sup>21</sup> Therefore, it simply is not the case that only the registrant and the applicant are using the term “JUD” as part of a mark for allegedly similar goods. Rather, the field of marks is crowded and there is no more of a likelihood of confusion between JUDY’S BREADSTICKS and JUDICAKES than there is between JUDYMAN and JUDY’S BREADSTICKS. Consequently, in contrast to the court in *Presto Prods. Inc.*, which refused registration of the applicant’s mark based on the fact that both marks started with the same term, the marks had the same number of letters, the marks had the same number of syllables, AND the parties were the only ones using the term KID as part of a mark for moist towelettes;<sup>22</sup> in the present case, the only similarity in the marks is the first three letters. The marks do not have the same number of letters, the marks do not have the same number of syllables, NOR are the parties the only ones using the term JUD as part of a mark for goods in International Class 030 and U.S. Class 046. As such, because the facts are

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<sup>19</sup> *Id.*

<sup>20</sup> *See* 4 TTABVUE 4.

<sup>21</sup> JUDYMAN is registered for use for Biscuits; cappuccino; chocolate; coffee; coleslaw dressing; fruit ices; ice cream; ice-cream; molasses; salad dressings; sandwiches; sauces; spices; tea.

<sup>22</sup> *Presto Prods. Inc.*, 9 USPQ2D 1895, at \*3.

drastically different in *Presto Prods. Inc.* when compared to the present case, it is improper for the Examining Attorney to only consider “JUD” in JUDICAKES when comparing the Applicant’s mark to JUDY’S BREADSTICKS. Moreover, given the nature of the differences between JUDICAKES and JUDY’S BREADSTICKS in conjunction with the current crowding in the field of the mark without corresponding consumer confusion, a reasonable court would likely not find a likelihood of confusion between the marks.

**2. The Examining Attorney has Misapplied Case Law Regarding Determining Which Feature of a Mark May be More Significant or Dominant and Giving Greater Weight to this Dominant Feature**

The cases cited by the Examining Attorney in connection with the contention that “one feature of a mark may be more significant or dominant in creating a commercial impression”<sup>23</sup> do not support the Examining Attorney’s argument that Applicant’s mark is confusingly similar to the registered mark because the facts in each of these cases are clearly distinguishable from the present facts. Further, the cases cited as standing for the rule that “a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression”<sup>24</sup> also do not support the Examining Attorney’s arguments in this context.

The first case cited in connection with the Examining Attorney’s contention that “one feature of a mark may be more dominant” is readily distinguishable from the present facts because the case involved a single word mark compared to a composite mark comprising a single word and design. In making her argument, the Examining Attorney relied on *In re Viterra Inc.*<sup>25</sup> In this case, the Federal Circuit determined that the applied-for mark, XCEED, was likely to cause confusion with the previously-registered word and design mark, X-Seed, as shown:

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<sup>23</sup> *Id.* at page 9.

<sup>24</sup> *Id.*

<sup>25</sup> 671 F.3d 1358 (Fed. Cir. 2012).



<sup>26</sup> The Federal Circuit determined that the literal portion of the X-Seed mark, not the design portion, was the dominant part of the mark.<sup>27</sup> In determining that the literal portion was the dominant portion, the court noted that the X-Seed mark and design did not include “a larger design...separate and independent from the literal features of the mark.”<sup>28</sup> Rather, the “design itself is a stylized letter that overlaps with, and is covered by, other literal portions of the mark,” making the entire literal portion “X-Seed” the dominant portion of the mark.<sup>29</sup> Thus, the court only considered the design element and the literal element of the same mark when determining the dominant portion of that mark and found that the design element was merely a background for the literal element of the mark. The court also held that “although the court may place more weight on a dominant portion of a mark, for example if another feature of the mark is descriptive or generic standing alone, the ultimate conclusion nonetheless must rest on consideration of the marks in total.”<sup>30</sup>

In contrast to *In re Viterra*, Applicant’s mark does not consist of a word and a design. Although it was relatively simple for the court to determine the dominant feature in the word/design mark X-Seed to be the literal portion because the design formed the background to the literal portion,<sup>31</sup> the court was not presented with the question of what the dominant portion of a single word mark would be that does not include an easily separable design element. Thus, because the court in *In re Viterra* only considered the issue of determining a dominant portion of a mark when presented with a composite mark consisting of a word element and a design element and not just a single word mark, the facts of the present case are not analogous to the

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<sup>26</sup> *Id.* at 1359.

<sup>27</sup> *Id.* at 1360.

<sup>28</sup> *Id.* at 1366.

<sup>29</sup> *Id.*

<sup>30</sup> *Id.* at 1362.

<sup>31</sup> *See id.* at 1366.

facts in *In re Viterra*. As shown in *In re Viterra*, the court has limited determining a dominant portion of a mark to marks that may be clearly separated into parts, for instance separating the design portion from the word portion in a composite mark. In the present case, the single word mark JUDICAKES cannot easily be separated like the word and design mark X-Seed to determine the dominant portion because JUDICAKES is not a composite mark and is instead a neologism. Therefore, it is improper to rely on *In re Viterra* to support the assertion that the dominant part of Applicant's mark should be "JUDI."

Similarly, in the case cited in connection with the Examining Attorney's contention that one feature of a mark may be more dominant and may receive greater weight, the Examining Attorney relied on *In re National Data Corp.*<sup>32</sup> In this case, the Federal Circuit affirmed the refusal of applicant's mark THE CASH MANAGEMENT EXCHANGE based on a likelihood of confusion with the registered mark CASH MANAGEMENT ACCOUNT.<sup>33</sup> Although the Examining Attorney asserts that this case shows that "greater weight is often given to this dominant feature when determining whether marks are confusingly similar," the facts presented in this case do not comport with the Examining Attorney's argument against registration of Applicant's mark. Rather, the discussion in *In re National Data Corp.* concerning the dominant feature of a mark was presented by the parties and not the court.<sup>34</sup> Whereas the applicant alleged the generic part of the marks CASH MANAGEMENT should be given less weight and EXCHANGE and ACCOUNT should be considered the dominant features, the board argued that a lack of a disclaimer to the words CASH MANAGEMENT made the terms distinctive.<sup>35</sup> Nevertheless, the court rejected both arguments and noted that "where a descriptive term forms

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<sup>32</sup> 753 F.2d 1056 (Fed. Cir. 1985).

<sup>33</sup> *See id.* at 1060.

<sup>34</sup> *See id.* at 1058.

<sup>35</sup> *Id.*

part of two or more marks for related products...[prior] decisions recognize that the purchasing public has become conditioned to this frequent marketing situation and will not be diverted from selecting what is wanted unless the overall combinations have other commonality.”<sup>36</sup> Thus, the court held that while “the public can be said to rely more on the non-descriptive portion of each mark,” “the marks must be considered as the public views them...in their entirety.”<sup>37</sup> Therefore, *In re National Data Corp.* does not simply stand for the interpretation that “greater weight is often given to this dominant feature when determining whether marks are confusingly similar,”<sup>38</sup> as indicated by the Examining Attorney. Rather, the court held that “to determine likelihood of confusion[, t]he marks must be considered as the public views them, that is, in their entirety.”<sup>39</sup>

Moreover, even applying the Examining Attorney’s limited interpretation of the case to the present facts would not yield the result the Examining Attorney has suggested because the facts of *In re National Data Corp.* drastically differ from the facts of the present case.<sup>40</sup> Whereas, applying more or less weight to a particular feature of the mark in *In re National Data Corp.* would comprise determining which word or words of the multi-word mark to give more weight, in the present case, applying more or less weight to a particular feature of the mark JUDICAKES would comprise determining where to divide the single neologism word mark. It is impossible to say where the first part of the mark JUDICAKES ends and the second part begins because it is not a multi-word mark easily separated like THE CASH MANAGEMENT

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<sup>36</sup> *Id.* at 1058-60.

<sup>37</sup> *Id.* at 1060.

<sup>38</sup> December 18, 2015 Examining Attorney’s Appeal Brief, TSDR p. 7.

<sup>39</sup> *In re National Data Corp.*, 753 F.2d at 1060.

<sup>40</sup> *See id.*

EXCHANGE. Therefore, the facts found in *In re National Data Corp.* are not analogous to the present set of facts making it improper to apply the holding in this case to the present facts.

The Examining Attorney has also misapplied case law to the present facts in connection with the contention that “matter that is descriptive of or generic for a party’s goods is typically less significant or less dominant in relation to other wording in a mark.”<sup>41</sup> In support of this argument, the Examining Attorney relied upon *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*<sup>42</sup> In this case, the applicant’s mark BUDWINE was refused registration based on the opposer’s registrations BUD, BUDWEISER, BUD MAN, BUD LIGHT, BUD BOWL, BUD DRY, and BUDWEISER SELECT.<sup>43</sup>

Although the court concluded that the dominant element in applicant’s mark was BUD,<sup>44</sup> the facts of *Anheuser-Busch, LLC* differ from those in the present case. For example, even if the court had not determined that the dominant part of applicant’s mark was BUD, the court would have still refused registration because, “to state the obvious, Applicant’s WINEBUD mark is similar to Opposer’s BUD mark in that it incorporates the entirety of Opposer’s mark.”<sup>45</sup> Thus, had the court not refused registration of the mark WINEBUD, the opposer’s mark BUD would have been subsumed within the applicant’s mark. In contrast, in the present case, JUDY’S BREADSTICKS would not be subsumed within Applicant’s mark JUDICAKES. Accordingly, reliance on *Anheuser-Busch, LLC* simply to state that “matter that is descriptive of or generic for a party’s goods is typically less significant or less dominant in relation to other wording in a

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<sup>41</sup> December 18, 2015 Examining Attorney’s Appeal Brief, TSDR p. 6.

<sup>42</sup> 115 USPQ2D 1816 (TTAB 2015).

<sup>43</sup> *See id.*

<sup>44</sup> *See id.* at \*10.

<sup>45</sup> *See id.* at \*8.

mark,”<sup>46</sup> as indicated by the Examining Attorney, is misplaced when so many other factors were considered in *Anheuser-Busch, LLC*.<sup>47</sup> Therefore, because the facts in the present case differ from those found in *Anheuser-Busch, LLC*, it would be inappropriate to conclude based on this case that CAKES is less significant in terms of affecting the mark’s commercial impression and that JUDI is the more dominant element.

#### **IV. CONCLUSION**

The Examining Attorney continues to dissect Applicant’s marks without comparing Applicant’s mark and the registered mark in their entireties. In doing so, the Examining Attorney has misapplied the case law regarding consumers’ inclination to focus on the first word of a trademark and regarding determining which feature of a mark may be more significant or dominant and giving greater weight to this dominant feature. In fact, the Examining Attorney’s logic of dissecting the mark and focusing on JUDI in Applicant’s mark and JUDY’s in the cited mark only strengthens the differing characteristics of the two marks when compared in their entireties. Moreover, the fact that multiple marks exist that include the term JUDY for similar or related goods further supports Applicant’s assertion that confusion in the market place would not occur when each of the marks are examined in their entirety. For example, JUDICAKES is no more confusingly similar to JUDY’S BREADSTICKS than JUDYMAN is to JUDY’S BREADSTICKS. For all of these reasons, Applicant requests registration of its mark.

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<sup>46</sup> December 18, 2015 Examining Attorney’s Appeal Brief, TSDR p. 6.

<sup>47</sup> See *Anheuser-Busch, LLC*, 115 USPQ2D 1816.

Respectfully submitted this 7th day of January 2016,

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