

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: June 19, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Jay Cutler Elite, LLC

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Serial No. 86627769

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Ernesto M. Rubi of Carey Rodriguez Milian Gonya, LLP
for Jay Cutler Elite, LLC.

Rebecca T. Caysido, Trademark Examining Attorney, Law Office 123,
Susan Hayash, Managing Attorney.

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Before Bergsman, Gorowitz and Pologeorgis,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Jay Cutler Elite, LLC (“Applicant”) seeks registration on the Principal Register of the mark TOTAL CARB (in standard characters) for “dietary and nutritional supplements for providing fast digesting carbohydrates to improve athletic endurance, heighten energy levels and promote rapid recovery,” in Class 5.¹ Applicant disclaimed the exclusive right to use the word “Carb.”

¹ Application Serial No. 86627769 was filed on May 13, 2015, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce.

The Trademark Examining Attorney 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 mark TOTAL CARB BLOCKER (standard characters) for "vitamin and mineral supplements," in Class 5, as to be likely to cause confusion.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. 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 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 or services. *See In re Chatam Int'l Inc.*, 380 F.2d 1340,

² Registration No. 4370750, registered July 23, 2013.

71 USPQ2d 1944, 1945-46 (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.

Applicant is seeking to register its mark for “dietary and nutritional supplements for providing fast digesting carbohydrates to improve athletic endurance, heighten energy levels and promote rapid recovery.” The goods in the cited registration are “vitamin and mineral supplements.”

A dietary supplement is defined as “any vitamin, mineral, herbal product, or other ingestible preparation that is added to the diet to benefit health.”³

In the United States, dietary supplements are defined as products (other than tobacco) intended to supplement the diet that contain at least one of the following ingredients: vitamin, mineral, herb or botanical including extracts of

³ Dietary Supplement, **Encyclopaedia Britannica**. The Board may take judicial notice of information from encyclopedias. *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (“dictionaries and encyclopedias may be consulted”); *Productos Lacteos Tocumbo S.A. de C.V. v. Paletteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.61 (TTAB 2011); *In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1514 n.4 (TTAB 2001) (dictionary entries and other standard reference works). *See also* Dietary Supplements, *Wikipedia.com* attached to the August 26, 2015 Office Action, TSDR p. 8. “[T]he Board will consider evidence taken from Wikipedia so long as the non-offering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information. Our consideration of Wikipedia evidence is with the recognition of the limitations inherent with Wikipedia (*e.g.*, that anyone can edit it and submit intentionally false or erroneous information).” *In re IP Carrier Consulting Grp.*, 84 USPQ2d 1028, 1032 (TTAB 2007).

References to TSDR pages are in .pdf format.

herbs or botanicals), amino acid, metabolite, or any combination thereof.⁴

Vitamins are essential nutrients.⁵

The *Wikipedia* entry also states that “more than half the U.S. adult population (53% - 55%) consume dietary supplements with most common ones being multivitamins.”⁶ “A multivitamin is a preparation intended as a dietary supplement with vitamins, dietary minerals, and other nutritional elements.”⁷

Registrant’s “vitamins and mineral supplements” is a broad enough description of goods to include Applicant’s “dietary and nutritional supplements for providing fast digesting carbohydrates to improve athletic endurance, heighten energy levels and promote rapid recovery.” *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and

⁴ *Id.*

⁵ Vitamin, **Encyclopaedia Britannica**.

⁶ August 26, 2015 Office Action, TSDR p. 8. The *Wikipedia* article cites Madison Park, “Half of Americans use supplements,” *CNN* (retrieved October 3, 2013) and Emily Grace, “How to choose the best supplement,” *Health Beacon* (retrieved October 3, 2013) to support the statement that more than half the U.S. population consumes dietary supplements with the most common supplement being a multivitamin. August 26, 2015 Office Action, TSDR 14. *See also* Dietary Supplement, **Encyclopaedia Britannica**.

⁷ Multivitamin, *Wikipedia.com* attached to the August 26, 2015 Office Action, TSDR p. 18 (citing Code Guidelines for Vitamin and Mineral Food Supplements (accessed December 27, 2007). A vitamin is defined as “any group of organic substances essential in small quantities to normal metabolism, found in minute amounts in natural foodstuffs or sometimes produced synthetically: deficiencies of vitamins produce specific disorders.” *Dictionary.com* based on the **Random House Dictionary** (2017). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010).

commercial furniture.”). Accordingly, although described differently, the goods identified in the descriptions of goods are identical.

Applicant argues that the descriptions of goods are distinguishable because Registrant’s goods are designed to block carbohydrates.⁸

The use of “Blocker” [in Registrant’s mark TOTAL CARB BLOCKER] clearly indicates that the purpose of the product is block or inhibit the absorption of carbohydrates. In sharp contrast, the applied-for mark, “TOTAL CARB” aims to provide carbs for absorption by the body of the user.⁹

This contention is unavailing, as there is no limitation or restriction to the breadth of the vitamin and mineral supplements in the registration’s description of goods. Thus, we are required to give “full sweep” to Registrant’s description of goods. *See generally Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-1535 (Fed. Cir. 1997); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000); *Paula Payne Prods. Co. v. Johnson Publ’g Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77-78 (CCPA 1973). Registrant’s goods are presumed to encompass all goods of the nature and type identified in the registration. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006).

Moreover, the Trademark Examining Attorney submitted excerpts from third-party websites demonstrating that vitamin makers manufacture vitamins for various purposes (*e.g.*, ONE A DAY, ONE A DAY WOMENS, ONE A DAY MENS, etc. and

⁸ Applicant’s Brief, p. 4 (9 TTABVUE 5).

⁹ Applicant’s Brief, p. 5 (9 TTABVUE 6).

CENTRUM SILVER, CENTRUM BASE, CENTRUM SPECIALIST, *etc.*)¹⁰ and that at least one dietary and nutritional supplement maker manufactures multiple lines of supplements for various purposes (e.g., SHEER BCA, SHEER NO. 2, SHEER TESTOSTERONE, *etc.*).¹¹

In addition, the Trademark Examining Attorney submitted two sets of trademark registrations consisting of a core term followed by descriptive wording for various lines of dietary and nutritional supplements or vitamins. For example,

L. Perrigo Company registered the following marks for supplements for various purposes:

- Registration No. 4552671 for 4X ADVANCED EYE HEALTH;
- Registration No. 4556876 for 4X IMMUNE;
- Registration No. 4467924 for 4X PROSTATE HEALTH;
- Registration No. 4482493 for 4X COMFORT FLEX;
- Registration No. 4483778 for 4X; and
- Registration No. 4285309 for 4X PROBIOTIC.¹²

4 Life Holdings registered the following marks for supplements for various purposes:

- Registration No. 4151606 for Q BLOCKER PLUS;
- Registration No. 4151603 for Q FAT BURNER;
- Registration No. 4109602 for Q VIT;

¹⁰ March 21, 2016 Office Action, TSDR pp. 6-7.

¹¹ *Id.* at 21.

¹² March 21, 2016 Office Action, TSDR pp. 8-20.

- Registration No. 4109601 for Q FATS;
- Registration No. 4109599 for Q BOOST;
- Registration No. 4035934 for Q BLOCKERS; and
- Registration No. 4337647 for Q FIBER STICKS +K.¹³

Thus, consumers encountering multiple lines of dietary, vitamin and mineral supplements identified by similar marks will mistakenly believe that the products emanate from the same source.

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

Because the goods described in the application and the cited registration are identical, we must presume that the channels of trade and classes of purchasers are the same. *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).

Applicant argues that the goods are sold in different channels of trade.

¹³ March 21, 2016 Office Action, TSDR pp. 22-40.

Registrant's goods are sold on his online store only whereas Applicant's goods are sold through different websites, gyms, and other workout locations.¹⁴

As indicated above, in considering the scope of the cited registration, we look to the registration itself, and not to extrinsic evidence about the Registrant's actual goods, customers, or channels of trade. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987) (quoting *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983)); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958)). We do not read limitations into the identification of goods. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983).

C. 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. *du Pont*, 177 USPQ at 567. In comparing the marks, we are mindful that where, as here, the goods are 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);

¹⁴ Applicant's Brief, p. 5 (9 TTABVUE 6).

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.*, 101 USPQ2d at 1721 (quoting *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007); 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).

Applicant is seeking to register the mark TOTAL CARB and the mark in the cited registration is TOTAL CARB BLOCKER. Applicant disclaimed the exclusive right to use the word “Carb” because it is descriptive. Likewise, the Registrant disclaimed the exclusive right to use “Carb Blocker” because it is descriptive. 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.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *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"). Thus, the word "Total" is the dominant element of the marks and creates the dominant commercial impression. There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 224 USPQ at 751.

Further reinforcing the significance of the word "Total" as the dominant element of the marks is its position as the first part of the marks. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *Presto Prod. Inc. v. Nice-Pak Prod., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered").

While there is no specific rule that the marks are automatically similar where the registrant's mark encompasses an applicant's entire mark, the fact that Applicant's mark is subsumed by Registrant's increases the similarity between the two. *See, e.g., Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2014) (applicant's mark PRECISION is similar to opposer's mark PRECISION DISTRIBUTION CONTROL) (citing *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260

(Fed. Cir. 2010) (applicant's mark ML is similar to registrant's mark ML MARK LEES); *see also Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (THE LILLY as a mark for women's dresses is likely to be confused with LILLI ANN for women's apparel including dresses); *In re United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (CAREER IMAGE for women's clothing stores and women's clothing likely to cause confusion with CREST CAREER IMAGES for uniforms including items of women's clothing). In *United States Shoe*, the Board observed that "Applicant's mark would appear to prospective purchasers to be a shortened form of registrant's mark." 229 USPQ at 709.

Finally, as discussed above in the analysis of the similarity or dissimilarity and nature of the goods, other manufacturers of dietary and nutritional supplements and vitamins use the same dominant element with other descriptive terms to identify their different dietary and nutritional supplement and vitamin product lines (*e.g.*, ONE-A-DAY, CENTRUM, SHEER, 4X and Q). Thus, a consumer familiar with Registrant's TOTAL CARB BLOCKER for "vitamins and minerals" encountering Applicant's TOTAL CARB "dietary and nutritional supplements for providing fast digesting carbohydrates to improve athletic endurance, heighten energy levels and promote rapid recovery" will mistakenly believe that the products emanate from the same source because of the similarity of the marks.

In view of the foregoing, we find that Applicant's mark TOTAL CARB BLOCKER is similar to Registrant's mark TOTAL CARB in appearance, sound, connotation and commercial impression.

D. Analyzing the factors.

Because the marks are similar, the goods are identical, and there is a presumption that the goods move in the same channels of trade, we find that Applicant's mark TOTAL CARB for "dietary and nutritional supplements for providing fast digesting carbohydrates to improve athletic endurance, heighten energy levels and promote rapid recovery" is likely to cause confusion with the registered mark TOTAL CARB BLOCKER for "vitamin and mineral supplements."

Decision: The refusal to register Applicant's mark TOTAL CARB is affirmed.