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Subject: U.S. TRADEMARK APPLICATION NO. 86903690 - THE FRESH CATCH - 510121.0478 - Request for Reconsideration Denied - Return to TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 86903690

MARK: THE FRESH CATCH

CORRESPONDENT ADDRESS:
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GENERAL TRADEMARK INFORMATION:

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APPLICANT: Performance Food Group, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

510121.0478

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 4/12/2017

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following refusal made final in the Office action dated October 5, 2016 is maintained and continue to be final: Trademark Act Section 2(d) for a likelihood of confusion with the registered marks. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

SECTION 2(d) LIKELIHOOD OF CONFUSION

REQUEST FOR RECONSIDERATION DENIED

As stated, the trademark examining attorney has carefully considered applicant's arguments but has found them to be unpersuasive as to finding that applicant's applied-for mark, **THE FRESH CATCH**, is not confusingly similar to the registrant's marks in U.S. Registration Nos. 2392246 and 2640390 for **FRESH CATCH**.

Applicant has presented a number of arguments which will be addressed below in order of presentation by application in its Request for Reconsideration.

SIMILARITY OF THE GOODS

As a general matter, where the marks of the respective parties are virtually identical, as in this case, the degree of similarity or relatedness between the goods needed to support a finding of likelihood of confusion declines. *See In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)); TMEP §1207.01(a).

In this case, applicant's mark is **THE FRESH CATCH** and registrant's marks are **FRESH CATCH**. The marks are virtually identical in sound, appearance, and connotation, which applicant has not disputed. Thus, the degree of similarity or relatedness between the goods needed to support a finding of likelihood of confusion is not as great.

Applicant argues that its goods are not related to registrant's goods because (1) it has attached evidence showing that registrant's goods are packed in soft pouch containers, and because (2) registrant's goods are provided only to limited consumers found in long-term confinement facilities. Applicant argues that the removal of these limitations from its goods is sufficient to obviate any similarities between these goods.

With respect to applicant's and registrant's goods, the question of likelihood of confusion is determined based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Here, applicant identifies its goods as "frozen seafood, not live, excluding seafood packed in containers approved for delivery to long-term confinement facilities." Registrant identifies its goods as "seafood packed in containers approved for delivery to long term confinement facilities" and "tuna for human consumption packed in containers approved for delivery to long term confinement facilities." Although it may be possible that registrant packs its food for different purposes, the underlying goods in the identifications are both seafood. Registrant's identification does not have any limitation as to the type of containers that are used to pack its seafood, nor does it state that the goods are sold exclusively to long term confinement facilities. The identification merely states that the seafood is packed in containers approved for delivery to long term confinement facilities.

Although applicant has limited its goods to "frozen seafood" and excludes "seafood packed in containers approved for delivery to long-term confinement facilities," these limitations are not sufficient to obviate the fact that the underlying nature of both goods is seafood. Further, it does not obviate the fact that the marks are virtually identical.

Applicant also cites to case law and argues that there is no likelihood of confusion even when the marks are identical. However, the goods in those cited cases compared "cooking classes" to "kitchen textiles," "liquid drain openers" to "advertising services," and "coaxial cables" to "lamps, tubes." *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field). Unlike these cited cases where the underlying nature of the goods are different, the underlying goods in this case are closely related because they consist of "seafood."

For these reasons, the examining attorney finds applicant's arguments unpersuasive.

THIRD PARTY REGISTRATIONS

Applicant also argues that the presence of other seafood-related registrations owned by distinct companies show that the wording "FRESH CATCH" is weak. Specifically, applicant cites the following registrations:

- FRESH CATCH (Registration No. 2616500) for "wrapping paper and plastic wrap used for packaging and storing frozen fish products" in International Class 016.
- FRESH CATCH (Registration No. 3216333) for "fish oil dietary supplements, sold in capsule and liquid form" in International Class 005.

Although the marks in these cases may be similar, the underlying goods are not related. Here, applicant's and registrant's goods are for "seafood" in International Class 029 and are for consumption purposes. However, the marks cited by applicant are for "wrapping paper and plastic wrap" in International Class 016 and "fish oil dietary supplements" in International Class 005. These types of goods are categorically different from applicant's and registrant's "seafood," which are meant to be consumed for sustenance, as opposed to "plastic wrap," which is not designed to be consumed at all, and "dietary supplements" which are intended to merely provide supplemental nutrition. Thus, the examining attorney does not find applicant's argument persuasive.

Additionally, applicant cites TMEP §1207.01(d)(iii) and argues that "evidence of third party registrations are relevant to show that a mark or a portion of the mark is so commonly used that the public will look to other elements to distinguish the source of the goods" and that consumers in this case will look to the other elements in the respective identifications to distinguish the source. However, this section actually states that "active third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services." TMEP §1207.01(d)(iii). This TMEP section does not refer to elements in the identification of goods, but instead refers to additional elements in the marks. Here, the only difference between the marks is that applicant has merely added the word "THE" to registrant's mark.

Moreover, third-party registrations are entitled to little weight on the issue of confusing similarity because the registrations are "not evidence that the registered marks are actually in use or that the public is familiar with them." *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1167 n.5 (TTAB 2013) (citing *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)); *see* TMEP §1207.01(d)(iii). Moreover, the existence on the register of other seemingly similar marks does not provide a basis for registrability for the applied-for mark. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Total Quality Grp., Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999).

For all of the foregoing reasons, applicant's Request for Reconsideration is ***denied***.

GUIDELINES

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

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