

This Opinion is Not a
Precedent of the TTAB

Mailed: February 6, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Hy-Vee, Inc.

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Serial No. 87120774

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Timothy J. Zarley of Zarley Law Firm PLC
for Hy-Vee, Inc.

Caryn Glasser, Trademark Examining Attorney, Law Office 105,
Jennifer L. Williston, Managing Attorney.

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Before Zervas, Wolfson and Adlin,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Pursuant to Federal Rule of Civil Procedure Rule 60(a), (Fed. R. Civ. P. R.60(a)), we hereby vacate our August 30, 2017 decision, *sua sponte*, to address an omission related to Applicant's application in International Class 30.

Hy-Vee, Inc. ("Applicant") seeks registration on the Principal Register of the mark PEACEFUL PIRANHA (in standard characters) for "Potato chips; processed nuts; snack mix consisting primarily of processed nuts and also including seeds, dried fruit, chocolate, raisins, popcorn, pretzels, crackers, granola and corn-based cereals and

chips” in International Class 29; and “Processed popcorn; corn-based chips; snack mix consisting primarily of pretzels, popcorn, crackers and granola, and also including corn-based cereals and chips, dried fruit, processed nuts, seeds, raisins and chocolate” in International Class 30.¹

The Trademark Examining Attorney refused registration of Applicant’s mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with Registration No. 5024721 for the mark PIRAÑA for:

Nut-based snacks, potato snacks, potato chips, packaged potato chips, potato chips as snacks; potato sticks; prepared nuts; roasted nuts, candied nuts, shelled nuts, salted nuts, blanched nuts; canned nuts, processed nuts, seasoned nuts; roasted peanuts, canned peanuts, processed peanuts, coated peanuts; shelled walnuts, prepared walnuts, seasoned walnuts; prepared hazelnuts; snack food mixes consisting of dehydrated fruit; edible sunflower seeds, prepared sunflower seeds, processed sunflower seeds.²

In International Class 29; and

Savory ready-to-eat snacks made of extruded corn foodstuffs; savory food preparations made of potato flour; puffed corn snacks; cheese-flavored corn snacks; cereal-based prepared snacks; flour-based savory snacks; corn chips; roasted corn kernels; corn curls; processed corn, roasted corn; fried corn; popcorn; corn chips flavored with vegetables; snack foods made with rice; snack foods made from corn; flours and preparations made from cereals

¹ Application Serial No. 87120774 was filed on July 29, 2016, under Section 1(b) of the Trademark Act, based upon Applicant’s allegation a *bona fide* intent to use the mark in commerce.

² Registered on the Principal Register on August 23, 2016. The registration includes the following translation statement: “The English translation of the word ‘PIRAÑA’ in the mark is ‘PIRANHA.’”

In International Class 30.

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

I. Likelihood of Confusion

Our determination of the issue of likelihood of confusion 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 (CCPA 1973); *see also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key, though not exclusive, considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

A. Similarities Between The Goods; Trade Channels

We first compare the similarities between Applicant's goods and Registrant's goods, including their respective channels of trade and classes of purchasers. Our determination regarding the similarity of the goods, channels of trade and classes of purchasers is based on the goods as they are identified in the application and registration, respectively. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 17893, 1787 (Fed. Cir. 1990); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

In this case, the goods in Applicant's application and the cited registration are identical in part in Class 29: each includes "potato chips" and "processed nuts." In class 30, Applicant's goods include "processed popcorn" and "corn-based chips" and Registrant's goods include "popcorn" and "corn chips." These goods are legally identical. Likelihood of confusion must be found with respect to a class of goods or services in an application if there is likely to be confusion with respect to any item that comes within the identification of the goods or services in that class. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Because the goods in the application and the cited registrations are identical in part and otherwise legally identical, we must presume that the channels of trade and classes of purchasers are the same for these goods. *See Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *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); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

Accordingly, the second and third *du Pont* factors regarding the goods, and the trade channels and classes of purchasers to whom the goods are offered, favor a finding of likelihood of confusion.

B. The Marks

We next consider the first *du Pont* factor, that is, whether Applicant's PEACEFUL PIRANHA mark and Registrant's PIRAÑA mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *See Stone Lion*, 110 USPQ2d at 1160 (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)). In comparing the marks, we are mindful that where, as here, the goods are in part identical, the degree of similarity between the marks 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 Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

The test under the first *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains

a general rather than a specific impression of trademarks. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Applicant's mark is PEACEFUL PIRANHA. The cited mark is PIRAÑA. Because the marks share the term "piranha" (or "piraña"), they are similar in appearance and somewhat similar in pronunciation. While "it is well-established that it is improper to dissect a mark, and that marks must be viewed in their entirety," *Coach Services*, 101 USPQ2d at 1721, "one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark." *Id.* (citing *Leading Jewelers Guild*, 82 USPQ2d at 1905); *see also In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[T]here 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 consideration of the marks in their entirety.").

We find that "piranha" is the dominant portion of Applicant's mark because it is modified by the term "peaceful" in the same manner as an adjective modifies a noun. *See, e.g., Stone Lion*, 110 USPQ2d at 1161 (affirming TTAB's finding that the noun LION was the dominant part of applicant's mark STONE LION CAPITAL). Although the shared term is not the first term of Applicant's mark, consumers are likely to focus on this dominant term. *See Hewlett-Packard Co.*, 62 USPQ2d at 1004 (finding applicant's mark PACKARD TECHNOLOGIES similar to opposer's HEWLETT

PACKARD marks); *Ava Enters. v. Audio Boss USA, Inc.*, 77 USPQ2d 1783 (TTAB 2006) (finding AUDIO BSS USA and design similar in appearance to BOSS AUDIO SYSTEMS (stylized)); *In re Jewelmasters, Inc.*, 221 USPQ 90 (TTAB 1983) (JEWELMASTERS for retail jewelry store services held likely to be confused with MASTER JEWELER'S COLLECTION for jewelry).

For English language speakers who are unfamiliar with Spanish, the differences between the terms PIRANHA and PIRAÑA are insignificant. Both terms start with the same four letters and end with the same letter "A." Although Applicant's mark contains a silent letter "H," there is little difference in appearance between the "N" and the "Ñ." Without knowledge of the purpose of the tilde in a Spanish "n" (i.e., that it changes the pronunciation of the letter "n" to the "ny" sound such as is used in the English word canyon), a consumer of Applicant's goods may perceive the tilde as simply a design feature of the mark or consider Registrant's mark as a misspelling of the English word "piranha." Those consumers who do not speak or understand Spanish are unlikely to pronounce the "ny" sound and will consider the pronunciations of the terms to be the same. For these reasons, such consumers will associate both the terms PIRANHA and PIRAÑA with the fish.³

For consumers having a knowledge of Spanish, the terms will be perceived as equivalents, under the doctrine of foreign equivalents. Under this doctrine, "foreign

³ A "piranha" is a type of fish, "any of various usually small South American characin fishes (genera *Serrasalmus* and *Pygocentrus*) that have very sharp teeth, often appear in schools, and include some that may attack and inflict dangerous wounds upon humans and large animals." At <https://www.merriam-webster.com>, attached to Applicant's Brief, 4 TTABVUE 8.

words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks.” *Palm Bay*, 73 USPQ2d at 1696; *see also In re Am. Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987) (holding BUENOS DIAS for soap, and GOOD MORNING and design for latherless shaving cream, likely to cause confusion); *In re Hub Distrib., Inc.*, 218 USPQ 284 (TTAB 1983) (holding EL SOL for clothing and footwear, and SUN and design for footwear, likely to cause confusion). Because Spanish is a common modern language, the doctrine of foreign equivalents applies to marks displayed in Spanish. *In re Highlights for Children, Inc.*, 118 USPQ2d 1268, 1271 (TTAB 2016) (“Spanish is a modern language that is widely spoken in the United States.”). The evidence shows that the relevant English translation of PIRAÑA is PIRANHA. The cited registration itself states that “piraña” translates to the English “piranha,” and two Spanish-English bilingual dictionaries, of which we take judicial notice, also translate the Spanish “piraña” to the English “piranha.”⁴ Thus, those purchasers who are familiar with, or fluent in, Spanish will readily translate PIRAÑA to PIRANHA, and associate both terms with the fish.

With respect to their connotations and overall commercial impressions, Applicant argues that the two words in its mark “are counter-intuitive and pose a juxtaposition that requires thought and imagination on behalf of the consumer. Thus, there is an

⁴ *See* Collins Spanish Dictionary, 703 (9th ed. 2009); Larousse Español-Inglés/English-Spanish Dictionary, 536 (5th ed. 1994). The Board may take judicial notice of dictionary definitions that appear in print format. *See Univ. of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1334 n.1 (TTAB 2009).

incongruity in the Appellant’s PEACEFUL PIRANHA mark which creates an entirely different connotation to the consumer with no comparable connotation or association by the PIRANA mark.”⁵ We agree that piranhas may be considered vicious and that a “peaceful piranha” does not jibe with that perception, although given the popular understanding of what characterizes a piranha, even a “peaceful piranha” may be seen to have an incipient propensity to be vicious. However, we do not agree that the juxtaposition of the two words creates a trademark that is so counterintuitive in its word-play on “piranha” that confusion with the cited mark PIRAÑA would be obviated. The presence of the additional term PEACEFUL in Applicant’s mark is not likely to distinguish the marks since it would merely indicate an atypical piranha, possibly for use with a subset of snack foods offered under the PIRAÑA mark.

For the above reasons, we find that the first *du Pont* factor favors a finding of likelihood of confusion.

II. Summary

Prospective consumers familiar with Registrant’s PIRAÑA snack food would be likely, when confronted with Applicant’s PEACEFUL PIRANHA snack food, to believe that the goods are manufactured by the same company. Applicant’s mark and Registrant’s mark are similar in appearance and somewhat similar in pronunciation. They are similar in connotation, because each evokes in meaning that specific fish of the genera *Serrasalmus* or *Pygocentrus*. While Applicant’s mark may convey an atypical piranha, Registrant’s PIRAÑA mark does not ascribe any particular

⁵ Appeal Brief, 4 TTABVUE 6.

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attribute to the fish, and thus the term “peaceful” would not prevent consumers from mistakenly believing that Applicant’s PEACEFUL PIRANHA goods and Registrant’s PIRAÑA goods emanate from the same source.

III. Decision:

The refusal to register Applicant’s mark under Trademark Act Section 2(d) is affirmed.