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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87120774

MARK: PEACEFUL PIRANHA



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

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**CORRESPONDENT'S REFERENCE/DOCKET NO:**

T62116US0

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

### **I. INTRODUCTION**

Applicant has appealed the Trademark Examining Attorney's final refusal to register the proposed mark PEACEFUL PIRANHA, in standard characters, under Section 2(d) of the Trademark Act, as amended, 15 U.S.C. 1052(d). The Section 2(d) refusal was issued on the basis that the applicant's mark, as applied to

the applicant's goods – “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 Class 029, 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 Class 030, so resembles the mark PIRAÑA, in standard characters, in Registration No. 5024721 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” in Class 029, 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” in Class 030, such that it is likely to cause confusion.

## **II. FACTS**

On July 29, 2016, the present application was filed to register the mark “PEACEFUL PIRANHA” in standard characters for “Potato chips; processed nuts; snack mix consisting primarily of processed nuts including seeds, dried fruit, chocolate, raisins, popcorn, pretzels, crackers, granola and corn-based cereals and chips” in Class 029, and “Processed popcorn; corn-based chips; snack mix consisting

primarily of pretzels, popcorn, crackers and granola, also including corn-based cereals and chips, dried fruit, processed nuts, seeds, raisins and chocolate” in Class 030.

On October 5, 2016, the prior examining attorney issued an Office Action refusing registration pursuant to Section 2(d) of the Trademark Act citing Registration No. 5024721 and requiring a clarification of the identification of goods. The applicant responded on January 30, 2017, arguing against the Section 2(d) refusal and providing an acceptable amendment of the identification of goods. After the issuance of a final refusal on February 28, 2017, this appeal ensued. The applicant filed its appeal brief on August 28, 2017. The application was reassigned to the undersigned examining attorney who now submits her brief within the statutory sixty-day period.

### **III. ISSUE**

The issue in dispute is whether applicant’s mark PEACEFUL PIRANHA, was properly refused with respect to the mark in U.S. Registration No. 5024721, PIRAÑA, pursuant to Trademark Act Section 2(d), 15 U.S.C. §1207.01 *et seq.*

### **IV. ARGUMENT – CONSUMERS ARE LIKELY TO CONFUSE APPLICANT’S “PEACEFUL PIRANHA” MARK WITH THE REGISTRANTS’ “PIRAÑA” MARK**

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the

goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

The applicant's mark, PEACEFUL PIRANHA, is to be used with "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" 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."

The registrant's mark, PIRAÑA, is used with "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" 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.

In the present case, confusion is likely because applicant's mark is highly similar and has the same commercial impression as the registrant's mark, and applicant's goods are identical and closely related to the registered goods.

**A. THE DOMINANT FEATURE OF APPLICANT'S "PEACEFUL PIRANHA" MARK IS HIGHLY SIMILAR IN OVERALL APPEARANCE AND HAS THE SAME COMMERCIAL IMPRESSION AS THE REGISTRANT'S "PIRAÑA" MARK**

Applicant's mark is PEACEFUL PIRANHA and registrant's mark is PIRAÑA; the marks share the virtually identical term PIRANHA, the Spanish and English words for a fish with sharp teeth. Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

First, the words PIRANHA and PIRAÑA are virtually identical in appearance and sound. Specifically, the words share six letters with the first five being identical. The terms only differ with the presence of the silent H in PIRANHA and the presence of a tilde in PIRAÑA. With proper pronunciation of the word PIRAÑA with the tilde, there is minimal difference between the sound of PIRANHA and PIRAÑA. Slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983); see *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012). Notably, if the consumer does not pronounce the word “PIRAÑA” with the tilde, the words are essentially phonetic equivalents because there is no difference in sound.

Moreover, under the doctrine of foreign equivalents, the words PIRANHA and PIRAÑA are equivalent terms that have identical meanings. Under the doctrine, a mark in a foreign language and a mark that is its English equivalent may be held to be confusingly similar. TMEP §1207.01(b)(vi); see, e.g., *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1127-28 (TTAB 2015); *In re Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006). Therefore, marks comprised of foreign words are translated into English to determine similarity in meaning and connotation with English word marks. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). Equivalence in meaning and connotation can be sufficient to find such marks confusingly similar. See *In re Aquamar, Inc.*, 115 USPQ2d at 1127-28; *In re Thomas*, 79 USPQ2d at 1025. The doctrine is applicable when it is likely that an ordinary American purchaser would “stop and translate” the foreign term into its English equivalent. *Palm Bay*, 396 F.3d at 1377, 73 USPQ2d at 1696; TMEP §1207.01(b)(vi)(A). The ordinary American purchaser refers to “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.” *In re Spirits Int'l*,

*N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009); *see In re Thomas*, 79 USPQ2d at 1024 (citing J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §23:26 (4th ed. 2006)), which states “[t]he test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent.”). In the present case, the registration indicates the term PIRAÑA translates to PIRANHA. Consumers familiar with Spanish are likely to view these terms as legal equivalents, not only because they are highly similar in appearance, but because they have the same meaning when translated.

Second, adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). *See Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (finding MACHO and MACHO COMBOS confusingly similar); TMEP §1207.01(b)(iii). Here, the addition of the adjective PEACEFUL in the applicant’s mark does not change the overall commercial impression of the mark from that of the fish PIRANHA.

Third, the applicant argues that the addition of the word PEACEFUL is the dominant portion of its mark and creates a different commercial impression because of the counter-intuitive words PEACEFUL and PIRANHA. The examining attorney disagrees with this argument. The addition of the adjective “peaceful” merely modifies the dominant word “PIRANHA” imparting a characteristic of the fish, rather



than creating a different commercial impression. In the minds of the consumer, both marks convey the commercial impression of a specific fish, irrespective of whether the fish is non-violent.

Finally, the word “PIRANHA” or “PIRAÑA” is an arbitrary term in relation to the goods and deserving of a broad scope of protection against the registration of a similar mark for closely related or identical goods.

Applicant argues that there is no likelihood of confusion because the marks differ in sight, sound and meaning. In support of these arguments, the applicant relies mainly on the addition of the word ‘PEACEFUL,’ noting that its mark differs in length (due to the addition of the word “peaceful”), begins with the “unshared term ‘peaceful’” creating a “balanced, rhythmic phrase,” and lastly, imparts a different commercial impression due to the counter-intuitive words of “peaceful” and “piranha.”

August 28, 2017, Appeal Brief, TSDR pg.5. The examining attorney respectfully disagrees with these arguments and maintains that the marks are similar so as to cause confusion as to the source of the goods, and moreover, creates a highly similar impression, notwithstanding the differences in the marks indicated by the applicant.

**B. APPLICANT’S GOODS ARE VIRTUALLY IDENTICAL AS WELL AS CLOSELY RELATED TO THE REGISTRANT’S GOODS**

In addition to the marks being highly similar, applicant’s goods are virtually identical as well as closely related to the registrant’s goods, and sold in the same channels of trade to the same class of purchasers.

Notably, the applicant did not dispute the relatedness of the goods.

Where the goods and/or services of an applicant and registrant are identical or virtually identical, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods and/or services. See *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014) (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)); TMEP §1207.01(b).

Here, with the exception of “chocolate” as part of its snack mix, the goods of the applicant and registrant are virtually identical. Specifically, both provide potato chips, corn-based snack foods, processed nuts, edible seeds and dried fruits. Further, registrant’s identification of goods contains broad wording and this wording encompasses the goods in applicant’s more narrow identification. For example, the registrant provides “cereal-based prepared snacks, “flour-based savory snacks” and “flours and preparations made from cereals” which encompass the applicant’s pretzels, crackers, granola and corn-based cereals. Both applicant’s goods and the registrant’s goods are a variety snack products sold in the same channels of trade to the same consumers.

The February 20, 2017, Final Office attached the following evidence demonstrating the relatedness of chocolate to the aforesaid snack foods:

- Chex Mix combinations of cereal-based snack foods including processed nuts, chocolate and pretzels; February 28, 2017, Final Office Action, TSDR pg. 2);
- Planters Nuts and Chocolate Trail Mix, also with Cranberries (dried fruit) and seeds; February 28, 2017, Final Office action, TSDR pp. 3-5;
- Woodstock Farms providing trail mix snack foods that include dried fruits, chocolate, processed nuts; February 28, 2017, Final Office Action, TSDR pg. 6;
- Kar's Snacks featuring nut mixes with chocolate, crackers and dried fruits; February 28, 2017, Final Office Action, pg. 6.

Therefore, given the highly similar nature of the marks, and the virtually identical nature of the goods, consumers encountering the goods in the same trade channels are likely to reach the conclusion that the goods are related and originate from a common source.

## **V. CONCLUSION**

Applicant's mark PEACEFUL PIRANHA contains the same wording, namely PIRANHA as the sole term in the registered mark, PIRAÑA. The goods at issue are virtually identical goods that would be encountered by, and purchased by the same class of purchasers and are marketed through the same channels of trade. Accordingly, consumers are likely to reach the conclusion that the goods are related and originate from a common source.

As such, the refusal under Section 2(d) should be affirmed.

Respectfully submitted,

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