

This Opinion is Not a  
Precedent of the TTAB

Mailed: October 15, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Minibar North America, Inc.*  
—

Serial No. 87130884  
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Gregory M. Stone of Whiteford Taylor & Preston LLP,  
for Minibar North America, Inc.

Tarah Hardy Ludlow, Trademark Examining Attorney, Law Office 110,  
Chris A.F. Pedersen, Managing Attorney.

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Before Taylor, Lykos and Larkin,  
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Minibar North America, Inc. (“Applicant”) seeks registration on the Principal Register of the mark MINIBAR SMARTSNAX (in standard characters) for, as amended:

“packaged snack food, namely, processed nuts packaged for sale to hotels, motels, and temporary stay facilities for distribution through refrigerators and food storage cabinets having sensors to detect presence and removal of packages” in International Class 29; and

“packaged snack food, namely, candies, pretzels, popcorn, and cookies packaged for sale to hotels, motels, and temporary stay facilities for distribution through

refrigerators and food storage cabinets having sensors to detect presence and removal of packages” in International Class 30.<sup>1</sup>

The Trademark Examining Attorney has finally refused registration of the mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the marks in the following two Principal Register registrations owned by different registrants:

Registration No. 2690257 (“257 Reg.) for the standard character mark SMART SNACKS (SNACKS disclaimed) for “candy, caramels, chocolate, and chewing gum,” in International Class 30;<sup>2</sup> and

Registration No. 3119552 (“552 Reg.) for the standard character mark THE SMART SNACK (SNACK disclaimed) for “dried fruits; dried fruit mixes; dried fruit snack foods; snack mix consisting primarily of processed fruit, processed nuts and/or raisins; shelled, roasted or otherwise processed nuts; candied nuts; raisins,” in International Class 29.<sup>3</sup>

Registration was also finally refused under Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), based on Applicant’s failure to comply with the requirement to disclaim the word MINIBAR on the ground that it is merely descriptive of a characteristic or feature of the goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

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<sup>1</sup> Application Serial No. 87130884 was filed on August 8, 2016, and is based upon Applicant’s claim of first use of the mark anywhere and in commerce as to the goods identified in both classes since at least as early as August 5, 2016.

<sup>2</sup> Issued on February 25, 2003, renewed.

<sup>3</sup> Issued on July 25, 2006, renewed.

Applicant appealed, and the appeal is fully briefed. For the reasons discussed, we affirm the refusal based on the disclaimer requirement and reverse the Section 2(d) refusal.

## I. Disclaimer

We first consider the requirement for a disclaimer of the term MINIBAR because the determination may have a bearing on our likelihood of confusion analysis. Under Section 6(a) of the Trademark Act, “[t]he Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” 15 U.S.C. § 1056(a). Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1), and therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is a basis for refusing registration of the entire mark. *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005).

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *See In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought. *Id.* It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant ingredient, quality, characteristic, function, feature,

purpose or use of the goods or services. *Id.*; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

Relying on MERRIAM-WEBSTER online dictionary which defines “minibar” as “a small refrigerator in a hotel room that is stocked with especially alcoholic beverages and snacks for guests,”<sup>4</sup> the Examining Attorney has required a disclaimer of the term MINIBAR. She particularly maintains that the wording MINIBAR merely describes a feature of the goods, namely the means through which Applicant distributes its goods.

We are unpersuaded by Applicant’s argument that the term MINIBAR is more than merely descriptive of its goods, because it has a source-identifying role given Applicant’s longstanding use of the term as a supplier to the relevant hospitality industry.<sup>5</sup> Applicant claims that MINIBAR functions as its “house mark” by virtue of its use of the term as its trade name and in marks that have been registered by it and its corporate parent.<sup>6</sup> Although Applicant made of record two prior registrations that include the term MINIBAR for use in connection with, among other things, refrigerators, the term has been disclaimed in both of them.<sup>7</sup> To the extent that


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<sup>4</sup> May 20, 2017 Office Action; TSDR 7.

<sup>5</sup> 4 TTABVUE 22-23.

<sup>6</sup> *Id.* at 12.

<sup>7</sup> Applicant made of record copies of Registration No. 1917816 for the composite mark

MINIBAR SYSTEMS (MINIBAR SYSTEMS disclaimed), , for, inter alia, “refrigerators; and Registration No. 3247748 for the composite mark MINIBAR SYSTEMS

(MINIBAR SYSTEMS disclaimed), , for, inter alia, “refrigerators, [and] mobile

Applicant asserts that the disclaimers were made to facilitate registration, the disclaimer of a term pursuant to a requirement by the Examining Attorney is a concession that the term is at best merely descriptive. *See In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2014 n.4 (TTAB 1988) (“By its disclaimer of the word LITE, applicant has conceded that the term is merely descriptive as used in connection with applicant’s goods.”) (citing *State Oil Ref. Corp. v. Quaker Oil Corp.*, 161 USPQ 547 (TTAB 1969), *aff’d*, 453 F.2d 1296 , 172 USPQ 361 (CCPA 1972)).

Similarly, although Applicant identifies itself on its website as Minibar North America,<sup>8</sup> it also uses the term descriptively on its website in discussing the Minibar and SmartSnax portion of the business when it touts its “[s]uperior food for your minibar and guest amenity needs.”<sup>9</sup> Notably, Applicant did not, as part of its application, seek registration pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. §1141(f), in part, based on acquired distinctiveness of MINIBAR.

As noted above, the term “minibar” is defined as a small refrigerator in a hotel room stocked with, among other things, snacks. Applicant’s identification of goods specifically indicates that the identified packaged snack goods will be distributed “through refrigerators and food storage cabinets” located in hotels, motels and other temporary stay facilities. As such, consumers familiar with Applicant’s packaged snacks will understand upon viewing Applicant’s mark MINIBAR SMARTSNAX that

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refrigerating cabinets for transporting foodstuffs and beverages.” November 20, 2017 Response to Office Action, TSDR 6, 19.

<sup>8</sup> November 20, 2017 Response to Office Action, TSDR 12-13 and 16-17.

<sup>9</sup> November 28, 2017 Final Office Action, TSDR 8.

the term MINIBAR immediately describes the means by which Applicant distributes in snack products. We thus find that MINIBAR is a merely descriptive component of Applicant's mark and must be disclaimed.

## II. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). *See also, In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *du Pont* factor for which there is evidence or argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). “[E]ach case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

### A. The Marks

We first consider the *du Pont* likelihood of confusion factor concerning the similarity or dissimilarity of the marks. In a likelihood of confusion analysis, we compare the marks in their entireties for similarities and dissimilarities in appearance, sound, connotation and overall commercial impression. *Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1048 (Fed. Cir. 2018). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d*, Slip Op. No. 18–2236 (Fed. Cir. Sept. 13, 2019) (mem) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB

2014)). “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.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir 2018) (quotation omitted).

Because similarity is determined based on the marks in their entireties, our analysis is not predicated on dissecting the marks into their various components. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015). On the other hand, “there 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 entireties.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

We compare Applicant’s mark MINIBAR SMARTSNAX and Registrants’ marks THE SMART SNACK and SMART SNACK and find them similar in appearance and sound in that each includes, or consists of, the word SMART together with the word SNACK(S) or the variant SNAX. Applicant acknowledges that the SNAX portion of its mark “provide[s] an alternative spelling of the term SNACKS,”<sup>10</sup> and Applicant’s use of the mark, which displays SMARTSNAX as “SmartSnax,” reinforces that SMARTSNAX is the visual and aural equivalent of SMART SNACKS. Contrary to Applicant’s contention, and as previously discussed, the word MINIBAR in Applicant’s mark has no source-identifying significance; it merely denotes the means

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<sup>10</sup> 4 TTABVUE 16.

by which Applicant's goods are distributed. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) ("DELTA," not the disclaimed generic term "CAFE," was the dominant portion of the mark THE DELTA CAFE). Moreover, although MINIBAR is the first word in Applicant's mark and, as Applicant correctly notes, "it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered," *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988), that general principle applies where the first part of the mark is a strong distinctive term. *See Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In this case, because MINIBAR is descriptive, and therefore inherently weak, the general principle does not apply.

As regards connotation and commercial impression, given the structure and syntax of Applicant's mark, the "MINIBAR" portion, which as noted is descriptive and not source-indicating, while appearing first and contributing to the mark's commercial impression, merely modifies SMARTSNAX in that it denotes the means by which Applicant's goods are delivered. Likelihood of confusion is not necessarily avoided between otherwise confusingly similar marks merely by adding or deleting other matter. If an important or, as in the case here, a significant portion of the marks is the same, then the marks may be confusingly similar notwithstanding some differences. *See, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (affirming Board's finding that applicant's mark STONE LION CAPITAL incorporated the entirety of the registered



marks LION CAPITAL and LION, and that the noun LION was the dominant part of both parties' marks); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (finding that, even though applicant's mark PACKARD TECHNOLOGIES, with "TECHNOLOGIES" disclaimed, does not incorporate every feature of opposer's HEWLETT PACKARD marks, a similar overall commercial impression is created); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (holding CAREER IMAGE (stylized) for retail women's clothing store services and CREST CAREER IMAGES (stylized) for uniforms likely to cause confusion).

Applicant's argument that the marks have different meanings is unpersuasive. Consumers familiar with both Applicant's and Registrants' marks will most likely ascribe the same meaning conveyed by the cited marks to Applicant's mark such that all three convey the meaning of being a beneficial snack, notwithstanding the novel spelling of SNACKS (SNAX) in Applicant's mark. We nonetheless acknowledge that consumers who are aware of the precise nature of Applicant's goods, i.e., that they are used in association with a technologically-enabled distribution method, may additionally attribute some technological meaning to the term SMART in Applicant's mark.

At bottom, we recognize that in comparing the marks, we must consider them in their entireties. Thus, we have taken into account the differences in appearance, sound and meaning between them. We nonetheless find that despite these

differences, the marks are more similar than dissimilar and engender similar commercial impressions.

The *du Pont* factor of the similarity of the marks favors a finding of likelihood of confusion.

#### B. Strength of the Cited Marks

We must consider evidence of “[t]he number and nature of similar marks in use on similar goods.” *du Pont*, 177 USPQ at 567. In this regard, the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) has stated that evidence of the extensive registration and use of a term by others can be “powerful” evidence of weakness. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015).

“[T]he strength of a mark is not a binary factor” and “varies along a spectrum from very strong to very weak.” *Juice Generation*, 115 USPQ2d at 1675-76 (internal citations omitted). “The weaker [the registrant’s] mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Id.* at 1676 (internal citations omitted). *See also Palm Bay*, 73 USPQ2d at 1693 (“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”). “In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value

of the mark.” *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011) (citing *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) and MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (4th ed. 2011) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”)).

Applicant relies on five record third-party registrations, arguing that “the existence of such numerous prior registrations that include the terms ‘SMART’ and ‘SNACK’ for goods similar to those set forth in the cited Registrations shows that consumers ... are well-able to distinguish sources of goods based on other distinctions among the marks and their respective goods and services.<sup>11</sup> The registrations themselves are not of record, but we have considered them as they are described in the brief. They include: Registration Nos. 5151159 (A SMART INDULGENT SNACK for cookies); 4975861 (SNACK SMART|BE HAPPY for nuts and other foods); 4874414 and 3627724 (SMART SNACK for meat snacks); and 2107921 (SNACK SMART for cookies and other baked goods).<sup>12</sup>

Third-party registrations may be relevant to show that the mark or a portion of the mark is descriptive or suggestive, such that the public will look to other elements to distinguish the source of the goods or services, in the same way dictionary

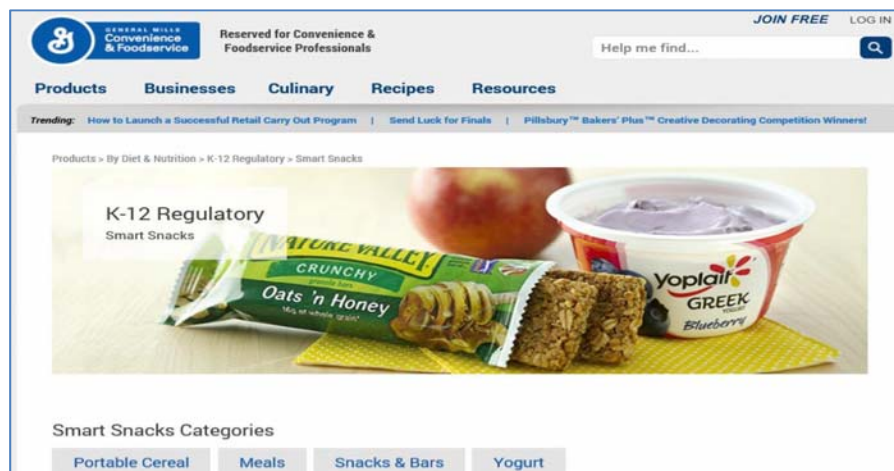
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<sup>11</sup> 4 TTABVUE 17.

<sup>12</sup> *Id.*

definitions are used to illustrate how a term is perceived in the trade or industry, and therefore, may be considered somewhat weak. *Juice Generation*, 115 USPQ2d at 1675 (third-party registration evidence may show that a term carries a highly suggestive or descriptive connotation in the relevant industry and therefore may be considered somewhat weak). *See also Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987).

Applicant also made of record pages from seven websites reflecting uses of the term “Smart Snack(s)” to show the “common understanding of the meaning of the term ‘smart’ when used in combination with the term ‘snack,’”<sup>13</sup> and Applicant refers to these uses under the sixth *du Pont* factor as well. We reproduce below portions of three of the webpages:



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<sup>13</sup> 4 TTABVUE 14-15; November 20, 2017 Response to Office Action, TSDR 21-43.

<sup>14</sup> November 20, 2017 Response to Office Action, TSDR 33.

Golden Cheese Sticks with Marinara Sauce

SMART SNACKS Cheesy Broccoli Baked Potatoes

SMART SNACKS Apple-Nut Cheese Snack

Try Our Other Products

SARGENTO® ULTRA THIN® BABY SWISS CHEESE SLICES

SARGENTO® NATURAL BLENDS® CHEDDAR-MOZZARELLA CHEESE STICKS

SARGENTO® NATURAL EXTRA SHARP CHEDDAR CHEESE STICKS

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### School Meals

Tools for Schools: Focusing on Smart Snacks

SMART SNACKS IN SCHOOL

Before the New Standards					After the New Standards					
Chocolate Sandwich Cookies (200)	Fruit Flavored Candies (248)	Donut (202)	Chocolate Bar (235)	Regular Soda (150)	Peanuts (170)	Light Popcorn (103)	Low-Fat Tostitos Chips (118)	Granola Bar (100)	Fruit Cup (100%) Juice (100)	No-Calorie Sweetener Water (100)
162	177	147	112	126	0	0	0	0	0	0

Smart Snacks | Fruits & Vegetables | Sodium | Whole Grain-Rich

Starting in school year 2014-15, all foods sold at school during the school day are required to meet nutrition standards. The Smart Snacks in School regulation applies to foods sold a la carte, in the school store, vending machines, and any other venues where food is sold to students.

A number of tools and resources are available to help schools identify food items that meet Smart Snacks criteria. See the resources below for information about the Smart Snacks requirement, helpful tools, and ways to encourage children to make healthier snack choices that give them the nutrition they need to grow and learn.

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<sup>15</sup> *Id.* at 24.

<sup>16</sup> *Id.* at 42.

The third-party uses and registrations do not persuade us that the cited marks are so weak due to common usage of the term SMART SNACK(S) that confusion is not likely between those marks and Applicant's mark. As for the registrations, four of the five are for food items that are unrelated to the nuts and candy identified in the cited registrations. As such, they are not probative in our analysis of the strength to be accorded the term SMART SNACK(S). To establish weakness, the identified goods should be in the same or highly related fields. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration). While all of the registrations cover food items, there is no evidence to show that consumers would believe that food items as diverse as cookies and other baked items and meat snacks, on the one hand, are related to nuts and candy on the other. Here a single registration, Reg. No. 4975861 for "nuts and other foods," does not convince us that the term SMART SNACK(S) is commonly used in the candy and nut industries.

Similarly, Applicant's third-party use evidence does not satisfy the standards for relevance set forth by the Federal Circuit. The Federal Circuit recently reiterated in *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ 1686, 1693-95 (Fed. Cir. 2018) that third-party uses are probative under the sixth *du Pont* factor only if they are for goods that are similar to the goods identified in the subject application and registration. Of the printouts from the seven websites made of record by Applicant, only two (shown in part above) are those of sellers of branded

snack foods, and they offer foods other than those identified in the application and the cited registrations under marks other than SMART SNACK.<sup>17</sup> The other five websites discuss and display various unbranded “smart” snacks.<sup>18</sup> There is thus no evidence of a third-party’s use of a SMART SNACK mark for any of the goods identified in the application and cited registrations.

A single registration does not evidence such a widespread and significant use of the term “SMART SNACK(S)” in the candy and nut industries that we can conclude that the cited mark is so weak that the public would be able to distinguish the source of Applicant’s goods from those of Registrants by the differences in their respective marks. *Cf. Jack Wolfskin*, 116 USPQ2d at 1136 n.2 (at least fourteen relevant third-party uses or registrations of record); *Juice Generation*, 115 USPQ2d at 1672 n.1 (at least twenty-six relevant third-party uses or registrations of record); *see also, In re Broadway Chicken Inc.*, 38 USPQ2d 1559 (TTAB 1996) (“Broadway” is weak for restaurant services based on evidence that hundreds of restaurants and eating establishments use Broadway as a trademark or trade name).

Notwithstanding Applicant’s failure to demonstrate the commercial weakness of the term SMART SNACK(S), based on the record we find that it has some degree of

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<sup>17</sup> November 20, 2017 Response to Office Action, TSDR 21-24 (Sargento cheese snacks), TSDR at 33-34 (General Mills cereal bars, Betty Crocker oatmeal bars, Nature Valley granola bars, and Yoplait yogurt).

<sup>18</sup> *Id.* at TSDR 25-32 (Pinterest pages); TSDR at 35-37 (Colgate Oral Care Center); TSDR at 38-39 (health.com); TSDR at 40-41 (Alliance for a Healthier Generation); and TSDR at 42-43 (United States Department of Agriculture).

inherent weakness, as least with regard to the identified processed nuts, in that it connotes a beneficial snack.

Accordingly, we find this *du Pont* factor neutral or that it slightly favors Applicant.

### C. The Goods

We now turn to a comparison of the goods under the second *du Pont* factor. In making our determination regarding the relatedness of the goods, we must look to the goods as identified in Applicant's application and the cited registration. *See In re Detroit Athletic* 128 USPQ2d at 1052; *Dixie Rest.*, 41 USPQ2d at 1534. "This factor considers whether 'the consuming public may perceive [the respective goods of the parties] as related enough to cause confusion about the source or origin of the goods and services.'" *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014).

Under this *du Pont* factor, we need not find similarity as to each and every product listed in Applicant's identification of goods. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods in a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014).

The goods identified in the application are "packaged snack foods," namely, "processed nuts" in Class 29 and "candies, pretzels, popcorn, and cookies" in Class 30,



all of which are further described as “packaged for sale to hotels, motels, and temporary stay facilities for distribution through refrigerators and food storage cabinets having sensors to detect presence and removal of packages.” The goods identified in the cited ‘257 Reg. (SMART SNACKS) are “candy, caramels, chocolate, and chewing gum” and the goods identified in the cited ‘552 Reg. (THE SMART SNACK) are identified as “dried fruits; dried fruit mixes; dried fruit snack foods; snack mix consisting primarily of processed fruit, processed nuts and/or raisins; shelled, roasted or otherwise processed nuts; candied nuts; raisins.” The more narrowly defined “packaged snack foods, namely candy” identified in the application is encompassed by the broadly identified candy in the ‘257 Reg., and are to that extent legally identical to Registrant’s candy. Similarly, the “packaged snack foods, namely processed nuts” in the application are encompassed by the broadly identified “processed nuts” in the registration, and are to that extent legally identical to Registrant’s nuts. However, although Registrants’ broadly identified candy and nuts encompasses packaged candy and nuts, as more fully discussed, *infra*, we do not find that those broadly worded snack food items would include those packaged in all types of product packaging, such as the specialized packaging that enables Applicant’s goods to be “distribut[ed] through refrigerators and food storage cabinets having sensors to detect presence and removal of packages.”

Nevertheless, because Applicant’s and Registrants’ goods are legally identical to the extent noted above, “there is no need for us to further consider the relatedness of the goods.” *FabFitFun*, 127 USPQ2d 1670, 1672 (TTAB 2018).

The second *du Pont* factor thus favors a finding of likelihood of confusion.

D. The Channels of Trade and Classes of Consumers

To determine the established, likely-to-continue channels of trade and classes of consumers, we must look to the goods as identified in the involved application and registrations. *Stone Lion*, 110 USPQ2d at 1162.

The Examining Attorney cites to *In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir 2012) (quoting *Hewlett-Packard*, 62 USPQ2d at 1005), asserting that because there are no restrictions in the cited registrations, the identified goods are presumed “to travel in the same channels of trade to the same class of purchasers.” The Examining Attorney’s reliance on *Viterra* is misplaced. The legal presumptions set forth in *Viterra* only apply when the goods are identical or legally identical **and** unrestricted with respect to categories of purchasers and/or channels of trade. *Id.* (“*Viterra* concedes that the goods at issue are identical . . . [and] it is well established that, ‘absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same classes of purchasers’”) (internal quotation omitted). *See also i.am.symbolic*, 123 USPQ2d at 1750 (“In the absence of meaningful limitations in either the application or the cited registrations, the Board properly presumed that the goods travel through all **usual** channels of trade and are offered to all **normal** potential purchasers.”) (Emphasis added).

Such is not the case here. Based on the identifications themselves, combined with the usual channels of trade for goods of the types identified by the Registrants, we

find that the established, likely-to-continue channels of trade are distinct.<sup>19</sup> Applicant's "packaged snack food, namely, candies and processed nuts" are limited to "sale to hotels, motels, and temporary stay facilities" and "for distribution through refrigerators and food storage cabinets having sensors to detect presence and removal of packages." While the Registrants' goods, namely "candy" (257 Reg.) and "processed nuts," (552 Reg) by contrast, include no limiting language, and accordingly we must presume that Registrants' goods will travel in all the usual trade channels for such goods, this does not entitle Registrant to a presumption that its goods will travel in every trade channel possible. That is, the unrestricted identifications in the cited registrations mean that those registrations are entitled to trade channel presumptions that include **usual** trade channels, which in this case as set forth by Applicant and unchallenged by the Examining Attorney would include mass distribution mediums to the general public such as vending machines, convenience stores, grocery stores and the like. To extend the presumption to trade channels that include those outside the norm would inaptly extend the presumption. Here Applicant's goods are limited not only to hotels, motels and temporary stay facilities, but also for distribution through sensor-enabled refrigerator or food storage cabinets. While a Registrant may always expand its trade channels, application of the trade channel presumption is limited to the usual ones. *Id.* Because Applicant's trade

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<sup>19</sup> We recognize that there may be some overlap in purchasers because the purchasers of Applicant's packaged candy and nuts for sale in hotels, motels and temporary stay facilities may also purchase candy and nuts in their capacity as ordinary consumers. However any overlap in purchasers is mitigated by the care exercised by these purchasers when purchasing Applicant's goods, as more fully explained, *infra*.

channels are outside of the usual ones, it was incumbent on the Examining Attorney to introduce evidence to show relatedness between Applicant's trade channels and those of Registrants.

We thus find that the *du Pont* factor concerning the channels of trade strongly favor a finding of no likelihood of confusion.

E. Sophistication of the Purchasers/Conditions of Sale

Next we consider the conditions under which the goods are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. *See, e.g., Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) (finding that, "even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily").

Applicant contends that the purchasers of its goods are not impulse purchasers, but rather are "sophisticated, institutional, professional product buyers for hotel and hospitality facilities" who exercise care in their purchasing decisions. Applicant explains that these purchasers are "tasked with maintaining appropriate stock of food products in a guest's room"<sup>20</sup> and are "tasked with ensuring that product packages meet the technical requirements necessary to allow them to be detected by the specific

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<sup>20</sup> 4 TTABVue 20.

sensors in hotel refrigerators and storage [and, thus] exercise significant care before purchasing.”<sup>21</sup>

We agree with Applicant and conclude that the professional temporary lodging purchasers for Applicant’s goods will exercise more than ordinary care in their purchasing decisions. We find so because Applicant’s packaged candy and nuts will most likely be purchased in larger quantities given the institutional nature of its consumers, i.e., hotels, motels and temporary stay facilities, and must be packaged in a manner that is compatible with sensor-enabled refrigerators or food storage cabinets. There is nothing in the record that shows a correlation between Applicant’s ordering form and the care exercised by its product purchasers. That Applicant’s order form is relatively simple is of no moment.

We find that this *du Pont* factor favors Applicant.

#### F. Conclusion

When we consider all of the arguments and evidence relating to the relevant likelihood of confusion factors, we conclude, on balance, that confusion is not likely between Applicant’s mark MINIBAR SMARTSNAX and the cited registered marks, SMART SNACKS and THE SMART SNACK. We find so principally because the similarity between the marks and the legal identity of the goods is outweighed by the distinct trade channels, and the care that will be exercised by purchasers of Applicant’s goods. Because the goods of Applicant and the Registrants travel in

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<sup>21</sup> 7 TTABVUE 10.

distinct trade channels, and because purchasers of Applicant's goods will exercise more than ordinary care in their purchasing decisions, it is highly unlikely that prospective purchasers will encounter Applicant's goods and the goods of Registrants under circumstances that would lead them to believe that Applicant's goods emanate from the same source as that of either Registrant.

**Decision:** The refusal to register Applicant's mark MINIBAR SMARTSNAX under Section 2(d) is reversed. The refusal to register based on the requirement for a disclaimer of the word MINIBAR is affirmed. However, if Applicant submits the required disclaimer of MINIBAR to the Board within thirty days of the mailing date of this decision, the decision will be set aside as to the affirmance of the disclaimer requirement.<sup>22</sup> See Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g).

**Opinion by Larkin, Administrative Trademark Judge, concurring in part and dissenting in part:**

I concur in the majority's decision to affirm the refusal to register MINIBAR SMARTSNAX without a disclaimer of MINIBAR. I respectfully dissent, however, from the majority's reversal of the refusal to register under Section 2(d) of the Trademark Act. For the reasons discussed below, the majority incorrectly analyzes the third *DuPont* factor in finding distinct channels of trade for legally identical goods, and this leads the majority to find incorrectly that the sophistication of purchasers under the fourth *DuPont* factor makes confusion unlikely.

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<sup>22</sup> The standard printing format for the required disclaimer text is as follows: "No claim is made to the exclusive right to use MINIBAR apart from the mark as shown." TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1213.08(a)(i) (Oct. 2018).

### **Third *DuPont* Factor**

When Applicant filed the involved application, it identified its goods simply as “packaged snack foods, namely, candies, nuts, pretzels, popcorn, and cookies.”<sup>23</sup> Applicant added the trade channel restriction during prosecution in an effort to overcome the citation of the two registered marks, which cover goods identified as “candy, caramels, chocolate, and chewing gum” (‘257 Reg.) and “dried fruits; dried fruit mixes; dried fruit snack foods; snack mix consisting primarily of processed fruit, processed nuts and/or raisins; shelled, roasted or otherwise processed nuts; candied nuts; raisins” (‘552 Reg.).<sup>24</sup>

The majority correctly finds that the “more narrowly defined ‘packaged snack foods, namely candy’ identified in the application is encompassed by the broadly identified candy in the ‘257 Reg., and are to that extent legally identical to Registrant’s candy,” and that “the ‘packaged snack foods, namely processed nuts’ in the application are encompassed by the broadly identified “processed nuts” in the registration, and are to that extent legally identical to Registrant’s nuts.” Op. at 17. But the majority then proceeds to find that the channels of trade for these legally identical goods are not only different, but “distinct.” *Id.* at 19. The majority notes that “Applicant’s goods are limited not only to hotels, motels and temporary stay facilities, but also for distribution through sensor-enabled refrigerator or food storage cabinets,” *id.* at 19, and finds that these channels of trade are completely distinct

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<sup>23</sup> August 8, 2016 Application at TSDR 1.

<sup>24</sup> May 17, 2017 Response to Office Action at TSDR 2.

from what the majority finds to be “the **usual** trade channels, which in this case would include mass distribution mediums to the general public such as vending machines, convenience stores, grocery stores and the like.” *Id.* The majority acknowledges that “a Registrant may always expand its trade channels, *id.*, but argues that the “application of the trade channel presumption is limited to the usual ones.” *Id.* Because Applicant’s trade channels are outside of what the majority finds to be the usual ones, the majority concludes that “it was incumbent on the Examining Attorney to introduce evidence to show relatedness between Applicant’s trade channels and those of Registrants.” *Id.* at 19-20.

I respectfully disagree with the majority’s analysis and conclusion. When the unrestricted identifications of goods in the cited registrations are construed properly, they encompass the specific trade channels in the application and the classes of purchasers who purchase the goods in those specific channels.

The majority acknowledges that “the Registrants’ goods, namely ‘candy’ (‘257 Reg.) and ‘processed nuts’ (‘552 Reg) . . . include no limiting language,” Op. at 19, and that “accordingly we must presume that Registrants’ goods will travel in all the usual trade channels for such goods,” *id.*, but argues that “this does not entitle Registrant to a presumption that its goods will travel in every trade channel possible.” *Id.* The majority effectively reads into the unlimited identifications in the registrations an exclusion of the specific trade channels in Applicant’s amended identification.

“We have no authority to read any restrictions or limitations into the registrant[s]’ description[s] of goods.” *In re I-Coat Co., LLC*, 126 USPQ2d 1730, 1739 (TTAB 2018)



(quoting *In re Thor Tech. Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009)). “Indeed, the owner of an unrestricted registration is entitled to change its current trade channels at any time.” *Detroit Athletic*, 128 USPQ2d at 1052 (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983) (“although a registrant’s current business practices may be quite narrow, they may change at any time from, for example, industrial sales to individual consumer sales”)); *see also San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2 (CCPA 1977) (“Opposer’s rights are not tied to its current business practices, which may change at any time. Its rights are as broad as its registration for ‘capacitors’.”).

The issue is not whether we must presume that the Registrants may sell their goods “in every trade channel possible,” op. at 19, but rather whether the Registrants’ unrestricted identifications of goods encompass the specific trade channels identified in the application. As noted above, Applicant itself began with a virtually identical unrestricted identification of goods and amended it to specify and narrow its trade channels. On this record, which contains no evidence showing that Applicant’s channels of trade are unusual or unique to Applicant,<sup>25</sup> we may not assume, as the majority does, that only Applicant, and never the Registrants, would sell candy and nuts to “hotels, motels, and temporary stay facilities” for “distribution through refrigerators and food storage cabinets having sensors to detect presence and removal

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<sup>25</sup> A page from Applicant’s website, which indicates that several of Applicant’s executives have been involved in the minibar business for more than two decades, November 20, 2017 Response to Office Action at TSDR 16, suggests that this is a well-established market for snack foods.

of packages.” *Detroit Athletic*, 128 USPQ2d at 1052 (finding that it would be improper to assume that the cited registrant, a private social club that owned a registration for various types of clothing that it sold to its members, “will never sell clothing online or through third-party distributors”); *see also In re Hester Indus., Inc.*, 231 USPQ 881, 883 (TTAB 1986) (the “fact that the registrations are currently owned by a retail supermarket chain does not mean that limitations as to channels of trade and classes of purchasers may be read into the registrations when no such limitations are incorporated in the identification of goods.”).

When the unrestricted identifications of goods in the cited registrations are properly given their full scope, the channels of trade for the Registrants’ and Applicant’s legally identical goods are themselves identical in part. *I-Coat Co.*, 126 USPQ2d at 1739 (applicant’s “corrective lenses sold through eye care professionals” and the registrant’s unrestricted spectacles deemed to be “offered in at least one common channel of trade” where identification of goods in cited registration contained no trade channel limitations). Because the channels of trade for the goods are identical in part, the same is true for the consumers of the goods.<sup>26</sup> *In re Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013) (“although applicant has limited its trade channels to casinos and its purchasers presumably to casino patrons, registrant’s unrestricted registration encompasses bar services rendered in

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<sup>26</sup> The majority acknowledges that even in the distinct trade channels that it finds, there “may be some overlap in purchasers because the purchasers of Applicant’s packaged candy and nuts for sale in hotels, motels and temporary stay facilities may also purchase candy and nuts in their capacity as ordinary consumers.” Op. at 20 n.20.

a casino setting to casino patrons”). Under a proper construction of the identifications of goods in the cited registrations, the third *DuPont* factor supports a finding of a likelihood of confusion.

#### **Fourth *DuPont* Factor**

The majority concludes that “the professional temporary lodging purchasers for Applicant’s goods will exercise more than ordinary care in their purchasing decisions,” op. at 21, because “Applicant’s packaged candy and nuts will most likely be purchased in larger quantities given the institutional nature of its consumers, i.e., hotels, motels and temporary stay facilities, and must be packaged in a manner that is compatible with sensor-enabled refrigerators or food storage cabinets.” *Id.* I have some doubt that these purchasers exercise a high degree of care given the relative simplicity of Applicant’s order form,<sup>27</sup> which discusses case prices and quantities, serving sizes, and shelf lives, and requires purchasers to provide only basic contact and quantity information in online transactions with Applicant, and given the apparently generic nature of Applicant’s packaging.<sup>28</sup> But even assuming that the least sophisticated of these purchasers exercises some greater degree of care than purchasers of candies and nuts in other trade channels, because the channels of trade and classes of consumers are identical in part, we must assume the same degree of care on the part of the overlapping purchasers of the goods. Under a proper

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<sup>27</sup> May 17, 2017 Substitute Specimen of Use.

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

construction of the identifications of goods in the cited registrations, the fourth *du Pont* factor is neutral in the analysis of likelihood of confusion.

### **Conclusion**

The majority persuasively demonstrates that the marks are similar and the goods are legally identical. Even assuming that the cited marks are somewhat weak conceptually, as the majority finds, op. at 15-16, when the identifications of goods in the cited registrations are properly given their full scope in terms of channels of trade and classes of consumers, the *DuPont* factors as a whole support a finding of a likelihood of confusion, and I would affirm the refusal to register.