

From: Nasserghodsi, Sahar

Sent: 2/22/2018 12:43:38 PM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 87222634 - PRETTY PLEASE WITH CHERRY ON TOP? - T62148US0 - EXAMINER BRIEF

Attachment Information:

Count: 1

Files: 87222634.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87222634

MARK: PRETTY PLEASE WITH CHERRY ON TOP?



CORRESPONDENT ADDRESS:

TIMOTHY J ZARLEY

ZARLEY LAW FIRM PLC

400 LOCUST STREET CAPITAL SQUARE SUITE 2

00

DES MOINES, IA 50309-2350

GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: Hy-Vee, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

T62148US0

CORRESPONDENT E-MAIL ADDRESS:

tzarley@zarleylaw.com

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant appeals the refusal to register the applied-for mark, "PRETTY PLEASE WITH CHERRY ON TOP?", based on a likelihood of confusion with U.S. Registration No. 4581889, for "PRETTY PLEASE WITH A CHERRY...", under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

FACTS

On November 1, 2016, applicant applied to register the mark “PRETTY PLEASE WITH CHERRY ON TOP?” for “ice cream; ice cream bars; ice cream desserts; ice cream sandwiches; ice cream cones” in International Class 030. The trademark examining attorney refused registration on December 26, 2016 on the basis of a likelihood of confusion with the mark in U.S. Registration No. 4581889, “PRETTY PLEASE WITH A CHERRY...” for “ice cream” in International Class 030. Applicant’s arguments with respect to the Section 2(d) likelihood of confusion refusal were not persuasive, and the Section 2(d) refusal was made final on June 30, 2017.¹ The applicant did not file a request for reconsideration. The sole issue to be decided on appeal is whether the applicant’s mark is likely to cause confusion with U.S. Registration No. 4581889.

OBJECTION TO NEW EVIDENCE

Applicant has submitted new evidence with its appeal brief. Specifically, applicant has attached copies of third party websites as Exhibits A-M; Q-U. The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because applicant’s new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. *See In re Fiat Grp. Mktg. & Corp. Commc’ns S.p.A*, 109 USPQ2d 1593, 1596 (TTAB 2014); *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

ARGUMENTS

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d). Determining likelihood of confusion is

¹ The Office reassigned this case to the undersigned trademark examining attorney after the appeal was instituted.

made on a case-by-case basis by applying 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). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). However, “[n]ot all of the [*du Pont*] factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1366, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)). The USPTO may focus its analysis “on dispositive factors, such as similarity of the marks and relatedness of the goods [and/or services].” *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); see TMEP §1207.01.

A. The Applicant’s Goods and the Registrant’s Goods are Identical in Part and are Highly Related

The applicant’s goods are “ice cream; ice cream bars; ice cream desserts; ice cream sandwiches; ice cream cones” in International Class 030. The registrant’s goods are “ice cream” in International Class 030.

When analyzing an applicant’s and registrant’s goods for similarity and relatedness, that determination is 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)).

Absent restrictions in an application and/or registration, the identified goods are presumed to travel in the same channels of trade to the same class of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods of the type described. See, e.g., *Sw. Mgmt., Inc. v.*

Ocinomled, Ltd., 115 USPQ2d 1007, 1025 (TTAB 2015); *In re N.A.D., Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000).

In this case, the identifications set forth in the application and registration are identical in part and have no restrictions as to nature, type, channels of trade, or classes of purchasers. Both applicant and registrant provide the identical goods of “ice cream.” Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers. *See Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). Accordingly, the goods “ice cream” are considered related for purposes of the likelihood of confusion analysis.

Furthermore, applicant’s “ice cream bars; ice cream desserts; ice cream sandwiches; ice cream cones” are highly related to registrant’s “ice cream” because the wording “ice cream” is very broad and encompasses applicant’s “ice cream bars, ice cream desserts, and ice cream sandwiches.” *See, e.g., Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015); *In re N.A.D., Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000). Additionally, applicant’s “ice cream cones” and registrant’s “ice cream” are complementary goods that are appropriate for use together and can be sold to the same purchaser for use together. Furthermore, the Final Office action issued on June 30, 2017 included webpage printouts of various third-party entities that manufacture the relevant goods under the same mark. For example,

- famous ice cream and fast food restaurant chain DQ offers ice cream, ice cream cones, and ice cream sandwiches (pp. 17-21);
- ice cream parlor chain based in Moline, Illinois Whitey’s Ice Cream offers ice cream and ice cream cones (pp. 22-23);
- famous brand of chocolate Dove offers ice cream and ice cream bars (pp. 24-25);

- famous brand of frozen desserts Breyers offers ice cream and ice cream bars (pp. 26-29);
- ice cream specialty shop restaurant Baskin-Robbins offers ice cream and ice cream cakes (pp. 30-31).

This evidence shows the same entity commonly manufactures the relevant goods and markets the goods under the same mark, and the relevant goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use. Thus, applicant's and registrant's goods are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Furthermore, the Office action issued on December 26, 2016 contains numerous third-party registrations showing the relatedness of the applied for goods, including,

- "DARK HORSE" U.S. Registration No. 5091609 (pp. 7-8) for, *inter alia*, "Ice cream; Ice cream bars; Ice cream desserts; Ice cream drinks; Ice cream floats; Ice cream sandwiches;"
- "HOT BOX COOKIES" U.S. Registration No. 5103065 (pp. 9-11) for, *inter alia*, "Ice cream, Ice Cream Sandwiches, icing filled cookie sandwiches, frozen cookie dough;"
- "DOLCE MARE" U.S. Registration No. 5096891 (pp. 12-14) for, *inter alia*, "Ice cream; Frozen confections; Ice cream cakes; Ice cream desserts; Gift baskets containing candy, bakery goods, coffee, chocolates, gelato, chocolate, confections;"
- "BOFANNA" U.S. Registration No. 5096952 (pp. 15-16) for "Ice cream bars; Ice creams;"
- "IZZY'S" U.S. Registration No. 5094431 (pp. 17-19) for "Ice cream; ice cream bars; ice cream pies; ice cream desserts; soy-based ice cream substitute; frozen soy-based

desserts; sorbet; gelato; sherbet; frozen confections; ice cream sandwiches; ice-cream cakes; ice-cream cupcakes; ice-cream pies; sauces and toppings for ice cream, namely, hot fudge, caramel and raspberry sauces for ice cream; custom-made ice cream novelties; candy toppings for ice cream; ice cream party kits consisting of ice cream, topping sauces, candy and dry nut toppings, cups, spoons and napkins, whipped topping and an ice cream scoop;”

- “LOVE CREAMERY” U.S. Registration No. 5085928 (pp. 20-21) for “Frozen confectionery; Frozen confections; Ice cream; Ice cream bars; Ice cream sandwiches; Sorbets; Non-dairy frozen confections;”
- “COCONUT GIRL” U.S. Registration No. 5104962 (pp. 22-24) for “Non Dairy Frozen Dessert made with coconut milk; Frozen confections; Frozen dessert consisting of fruit and cream or cream substitutes; Ice cream; Ice cream desserts; cookies; cakes;”
- “SO GOOD” U.S. Registration No. 5104962 (pp. 25-26) for “Ice cream sandwiches; ice cream confections;”
- “CARVEL” U.S. Registration No. 4823009 (pp. 27-29) for “Ice cream and ice cream novelties, sherbets, frozen confections, cakes made of ice cream and combinations of ice cream and frozen desserts, ice cream cones and ice cream products, namely, non-fruit toppings for ice cream, namely, chocolate and caramel syrup toppings, marshmallow toppings and candy sprinkles, wafers or cookies with interlayers of ice cream, for consumption on or off the premises;”
- “DI LORENZO” U.S. Registration No. 5072115 (p. 30-31) for, *inter alia*, “Frozen confections; Italian Ice Cream; Ice Cream Cones; Ice Cream Floats, Milkshakes, Gelato; Gelato Desserts; Ice Cream Desserts; Gelato Cakes.”

This evidence shows that “ice cream, ice cream bars; ice cream desserts; ice cream sandwiches; ice cream cones,” are of a kind that may emanate from a single source under a single mark. See *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988)).

Notably, applicant did not set forth any arguments against the relatedness of the goods, thereby effectively acknowledging the relatedness of the goods.

B. Applicant’s Mark and Registrant’s Mark are Highly Similar in Appearance, Sound and Overall Commercial Impression

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).

Where the goods of an applicant and registrant are “similar in kind and/or closely related,” 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. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); see *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b). In the present case, although the degree of similarity between the marks required to support a finding of a likelihood of confusion is not as great, the marks, nevertheless, are still highly similar.

Specifically, applicant's mark, "PRETTY PLEASE WITH CHERRY ON TOP?" and the registrant's mark, "PRETTY PLEASE WITH A CHERRY..." are highly similar in sound, appearance, and overall commercial impression because they share the identical phrase "PRETTY PLEASE WITH" followed by the shared term "CHERRY". 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).

Namely, the marks have similar overall commercial impressions by conjuring the cliché phrase consumers use when humorously or coyly asking for something. Applicant argues that "[r]egistrant's mark vaguely requests a cherry, [a]pplicant's mark requests a location for the cherry." See June 6, 2017 Response to Office Action, TSDR p. 5. However, registrant's mark is merely a truncated version of the same well-known phrase. Also, applicant states that the wording "'ON TOP'" is readily associated with the placement of a cherry on top of a traditional ice cream sundae." *Id.* Applicant's statement supports that the marks have similar commercial impressions. Both applicant's and registrant's mark has the term "CHERRY", both for ice cream; therefore, consumers are likely to perceive that registrant's "PRETTY PLEASE WITH A CHERRY" will also mean that the "CHERRY" is placed on top of the ice cream.

Applicant argues that the marks do "not share the same phrase or word combination" because "applicant's mark consists of 9 syllables where Registrant's 7 syllables, thus changing the pronunciation and metronomic interpretation of the marks." See June 7, 2017 Response to Office Action, TSDR p. 4. Applicant further states that the question mark in applicant's mark distinguishes the pronunciation of

the phrase from registrant's mark because the phrase is associated "with a common request for help or goods in a pleading manner." *Id.* However, when comparing marks, "[t]he 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 [consumers] who encounter the marks would be likely to assume a connection between the parties." *In re U.S. Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1795 (TTAB 2017) (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); TMEP §1207.01(b). Here, the marks are similar because they begin with the same dominant phrase, "PRETTY PLEASE WITH", and contain the same identical term, "CHERRY". Thus, the marks convey the same overall commercial impression. Therefore, applicant's arguments are unpersuasive.

Additionally, applicant argues that the Trademark Examining Attorney has improperly dissected the marks into only their common features when determining that the overall commercial impressions are identical. However, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1322, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) ("[Regarding the issue of confusion,] there is nothing improper in stating that . . . 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." (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985))). In this case, it is important to note that the marks are identical in part, and more specifically, they begin with the same phrase "PRETTY PLEASE WITH". Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin*

Maison Fondée En 1772, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (“[T]he dominance of BARR in [a]pplicant’s mark BARR GROUP is reinforced by its location as the first word in the mark.”); *Presto Prods., Inc. v. Nice-Pak Prods., 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” when making purchasing decisions). When comparing the marks “PRETTY PLEASE WITH CHERRY ON TOP?” and “PRETTY PLEASE WITH A CHERRY...”, both for ice cream and very closely related goods, such as applicant’s ice cream bars, desserts, sandwiches and cones, consumers would not likely notice or recall the minor differences between the marks and will inevitably focus on the first phrase “PRETTY PLEASE WITH” as well as the distinct term “CHERRY”.

Therefore, the marks are highly similar in appearance, sound and overall commercial impression. The marks are sufficiently similar under Section 2(d) of the Trademark Act such that a likelihood of confusion exists between the marks.

C. The Registrant’s Mark Is Neither Weak Nor Diluted

Furthermore, the applicant argues that the registered mark is sufficiently weakened by third party use such that registration of applicant’s mark should be allowed. However, the examining attorney notes that currently there are no other registered marks for the goods “ice cream” or related ice cream products that contain the wording “PRETTY PLEASE WITH A CHERRY ON TOP,” “PRETTY PLEASE WITH A CHERRY,” “PRETTY PLEASE” or “CHERRY ON TOP” besides the registrant’s mark. Thus, the registrant’s mark appears to be very strong and undiluted with regard to ice cream and ice cream products. As such, this mark must be afforded a wide scope of protection. In fact, applicant has not submitted other printed or electronic copies of third-party registrations for marks containing the

wording “PRETTY PLEASE WITH A CHERRY ON TOP,” “PRETTY PLEASE WITH A CHERRY,” “PRETTY PLEASE” or “CHERRY ON TOP” to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection.

Furthermore, the Internet evidence that applicant has properly made of record provides only one example with a portion of the marks at issue, that is, the phrase “CHERRY ON TOP” (“Cherry on Top” frozen yogurt shop” used in connection with ice cream). See June 6, 2017 Response to Office Action, TSDR pp. 7-11. The evidence from the Carnival Cruise Lines® website references the phrase “Cherry On Top” as the name of an on-board candy and gift shop, and the page from the blog “My Cupcake Life” shows a recipe for “Pretty Please with a Cherry on Top Cupcakes.” *Id at* pp. 12-23. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods. See *Nat’l Cable Tel. Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Thus, this one example is insufficient to support that registrant’s mark is “weak” in connection with ice cream or ice cream products.

Moreover, the trademark examining attorney continues to object to the applicant’s new evidence consisting of copies of third-party websites to support the argument that the marks at issue are weak and requests that the Board disregard it. Thus, applicant has not established that the wording in the marks is weak or diluted. Even if applicant had successfully shown this mark to be “weak,” the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection under Section 2(d) against the registration by a subsequent user of a similar mark for closely related goods. TMEP §1207.01(b)(ix);

see King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010).

Since the goods are identical in part and highly related and the marks are so highly similar, there is a strong likelihood that purchasers would confuse the sources of the goods or believe they stemmed from a single source.

CONCLUSION

The goods are identical in part and are highly related. Furthermore, the registrant's mark and the applicant's mark are highly similar in appearance, sound and overall commercial impression. Thus, similarities among the goods and the marks are so great as to create a likelihood of confusion among consumers. Accordingly, the examining attorney respectfully requests that the Section 2(d) likelihood of confusion refusal be affirmed.

Respectfully submitted,

Sahar Nasserghodsi

/Sahar Nasserghodsi/

Examining Attorney

Law Office 115

(571)272-9192

Sahar.Nasserghodsi@uspto.gov

Daniel Brody

Managing Attorney

Law Office 115