

This Opinion is Not a  
Precedent of the TTAB

Mailed: May 30, 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. 87222634

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for Hy-Vee, Inc.

Sahar Nasserghodsi, Trademark Examining Attorney, Law Office 115,  
Daniel Brody, Managing Attorney.

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Before Kuczma, Adlin, and Lynch,  
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background and Evidentiary Objection

Hy-Vee, Inc. (“Applicant”) seeks registration on the Principal Register of the mark PRETTY PLEASE WITH CHERRY ON TOP? in standard characters for “Ice cream; ice cream bars; ice cream desserts; ice cream sandwiches; ice cream cones” in

International Class 30.<sup>1</sup> The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the registered mark PRETTY PLEASE WITH A CHERRY... in standard characters for “Ice cream” in International Class 30.<sup>2</sup> After the Examining Attorney made the refusal final, Applicant appealed.

Before turning to the merits, we sustain the Examining Attorney’s objection<sup>3</sup> to the evidence Applicant submitted for the first time as exhibits to its Appeal Brief.<sup>4</sup> Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d) provides that the record should be complete prior to the filing of an appeal. *See also* TBMP § 1203.02(e) (June 2017) (“Exhibits attached to a brief that were not made of record during examination are untimely, and generally will not be considered”); *see also id.* at n.2 (collecting supporting precedential cases excluding such evidence).

## II. Likelihood of Confusion

The determination under Section 2(d) involves 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) (setting forth factors to be considered, hereinafter referred to as “*du Pont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). As Applicant

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<sup>1</sup> Application Serial No. 87222634 was filed November 1, 2016 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an alleged intent to use the mark in commerce.

<sup>2</sup> Registration No. 4581889 issued August 5, 2014.

<sup>3</sup> 6 TTABVue 3 (Examining Attorney’s Brief).

<sup>4</sup> Regardless, even had it been considered, the objected-to evidence would not change the outcome of this case.

has acknowledged,<sup>5</sup> in any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). “[I]t is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application.” *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015); *see also Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

A. The Goods, Trade Channels, and Classes of Consumers

The subject application and cited registration both identify ice cream. Thus, the goods are identical in part. We must therefore presume that the channels of trade are also identical. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (affirming Board finding that where the identification is unrestricted, “we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods”); *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion); *Am. Lebanese Syrian Assoc.*

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<sup>5</sup> 4 TTABVUE 3 (Applicant’s Brief, stating that “[t]he two most weighted factors for the *du Pont* factor test” are similarity of the marks and relatedness of the goods).

*Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011). Thus, the second and third *du Pont* factors strongly weigh in favor of a finding of likely confusion.

The legal identity of Applicant's and the registrant's goods and their overlapping channels of trade not only weighs heavily in favor of finding a likelihood of confusion, but also reduces the degree of similarity between the marks necessary to find a likelihood of confusion. *Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

#### B. Number and Nature of Similar Marks for Similar Goods

Because the strength of the cited mark under the sixth *du Pont* factor impacts our comparison of the marks, we first address Applicant's claim under this factor that the cited registration deserves a narrow scope of protection in view of third-party uses of allegedly similar marks. The Federal Circuit has held that evidence of extensive registration and use of a term by others for similar goods can be powerful evidence of the term's weakness. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. 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). If the evidence establishes that the consuming public is exposed to widespread third-party use of similar marks for similar goods, it "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm*

*Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

Applicant's properly introduced third-party use evidence consists of the following three items:

- A Yelp entry for "Cherry on Top" Ice Cream & Frozen Yogurt Dessert Shop in Lincoln, Nebraska.<sup>6</sup>
- A webpage from Carnival.com describing "Onboard Activities" that include a "well-stocked candy-and-more store" called "Cherry On Top".<sup>7</sup>
- An article and recipe from the "My Cupcake Life" website entitled "Pretty Please with a Cherry on Top Cupcakes" where the cupcakes include a cherry on top.<sup>8</sup>

The evidence does not establish that the cited mark is commercially weak.

First, only one of the three references includes the entire term in the cited mark (PRETTY PLEASE WITH A CHERRY). Second, it appears that only one of the third parties uses the term in question in connection with ice cream, and other than being broadly describable as desserts, there is no evidence that cupcakes or candy are related to ice cream. *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). Third, the record lacks information as to the extent of consumer exposure to these uses. For example, the Yelp entry appears to be

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<sup>6</sup> June 7, 2017 Response to Office Action at 2-6 (yelp.com).

<sup>7</sup> June 7, 2017 Response to Office Action at 7-9 (carnival.com).

<sup>8</sup> June 7, 2017 Response to Office Action at 10-18 (mycupcakelife.com).

for a single-location small business, which would have limited consumer exposure. Fourth, even assuming, *arguendo*, that we were to credit all three uses as involving marks sufficiently similar to the cited mark and goods sufficiently similar to ice cream, the third-party evidence here is far less voluminous and compelling than that in *Juice Generation*, 115 USPQ2d at 1673 n.1, or in *Jack Wolfskin*, 116 USPQ2d at 1136. See also *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1033-36 (TTAB 2016) (weakness of term ROSE in opposer's mark PRIMROSE found based on at least 85 actual uses of ROSE-formative marks for similar services, eight similar third-party registrations, expert testimony and other evidence regarding the common nature of ROSE-formative marks in the industry, and testimony by opposer that it did not vigorously enforce its mark). This record may indicate some degree of suggestiveness of CHERRY ON TOP, but is insufficient to show that the cited mark is weak. Regardless, even suggestive marks are entitled to appropriate protection against the registration of confusingly similar marks. See *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); *In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978) (ERASE for a laundry soil and stain remover held confusingly similar to STAIN ERASER, registered on the Supplemental Register, for a stain remover).

### C. Similarity of the Marks

We turn to comparing PRETTY PLEASE WITH CHERRY ON TOP? to PRETTY PLEASE WITH A CHERRY... “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay*, 73 USPQ2d at 1691 (quoting *du*

*Pont*, 177 USPQ at 567). The test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods and services offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012). We bear in mind that where, as here, marks would appear on identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir.1992).

The record reflects that variations of “pretty please with a cherry on top” are used as an “[e]xaggerated form of please or pretty please,”<sup>9</sup> to express a strong desire for something.<sup>10</sup> Thus, the marks are alike in their meaning and commercial impression because they bring to mind the known expression, apparently derived from requesting a cherry on an ice cream sundae.<sup>11</sup> In the context of both marks’ use on ice cream, the meaning and commercial impression draws both on the literal and figurative meanings of the known expression. The connotations and commercial impressions of Applicant’s and the registrant’s marks are essentially the same.

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<sup>9</sup> June 30, 2017 Office Action at 10-11 (Wiktionary.org).

<sup>10</sup> June 30, 2017 Office Action at 2-11 (urbandictionary.com, freedictionary.com, Wiktionary.org).

<sup>11</sup> *See* 4 TTABVUE 6 (Applicant’s Brief) (in Applicant’s mark, “ON TOP’ is readily associated with the placement of a cherry on top of a traditional ice cream sundae”).

As for the look and sound, the registrant's mark PRETTY PLEASE WITH A CHERRY is the same as Applicant's mark, except for Applicant's omission of "A," and addition of "ON TOP" and the question mark instead of ellipses. We find these differences relatively insignificant. The registrant's use of ellipses in its mark indicates that words have been omitted at the end, and Applicant's addition of ON TOP merely adds the wording to complete the known expression. As for the question mark, either with or without that punctuation, the expression constitutes an entreaty. Moreover, the portion of the mark shared in common with the cited mark comes at the beginning of Applicant's mark, and therefore "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). Overall, these marks look and sound very similar. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("in articulating reasons for reaching a conclusion on the issue of confusion, 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"); *see also Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

Given their resemblance in sound, appearance, connotation and commercial impression, Applicant's and the registrant's marks are very similar. This factor weighs heavily in support of finding a likelihood of confusion.



### III. Conclusion

The overall similarity of these marks for in-part identical goods that move in the same channels of trade to the same classes of customers renders confusion likely.

**Decision:** The refusal to register Applicant's mark is affirmed.