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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gel Shotz, Inc.

Serial No. 87387430

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for Gel Shotz, Inc.

Jared M. Mason, Trademark Examining Attorney, Law Office 119,
J. Brett Golden, Managing Attorney.

Before Bergsman, Lykos and Pologeorgis,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Gel Shotz, Inc. ("Applicant") seeks to register on the Principal Register under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), the stylized mark displayed below

(GEL disclaimed) for "Flavored and sweetened gelatins" in International Class 30.[1]

Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's applied-for mark so resembles the registered standard character mark GEL SHOTS (SHOTS disclaimed) on the Principal Register for "aperitifs with a wine base" in International Class 33,[2] that it is likely to cause confusion or mistake or to deceive.[3]

When the refusal was made final, Applicant appealed. The appeal is now briefed. For the reasons set forth below, we affirm the refusal to register.

I. Evidentiary Objection

The Examining Attorney objects to Applicant's reference and discussion of two third-party applications in Applicant's appeal brief. The Board does not take judicial notice of third-party applications. *In re Olin*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) (internal citation omitted). Copies of the applications demonstrating their title and status were not submitted during prosecution.

Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d) provides that "[t]he record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the

[1] Application Serial No. 87387430, filed March 27, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). Color is not claimed as a feature of the mark. Applicant's claim of acquired distinctiveness under Section 2(f) applies to the mark as a whole.

[2] Registration No. 2911162, registered December 14, 2004; renewed.

[3] Registration was also refused under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive of the goods. The Examining Attorney withdrew the refusal following Applicant's claim of acquired distinctiveness under Section 2(f) based on five years of substantially exclusive and continuous use of the mark. *See* January 9, 2019 Office Action.

Board by the appellant or by the examiner after the appeal is filed." The Examining Attorney's objection is sustained, and Applicant's reference and discussion of the two applications has been given no consideration.[4] *See In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018), *aff'd*, Slip Op. No. 18–2236 (Fed. Cir. Sept. 13, 2019) (mem); *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d 1593, 1596 (TTAB 2014).

II. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.,* 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). When analyzing these factors, the overriding concerns are not only to prevent buyer confusion as to the source of the goods, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004);

[4] In fact, Applicant agrees that the Examining Attorney's objection was proper. Reply Brief, p. 3; 18 TTABVUE 3.

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."). These factors and others are discussed below.

A. The Marks

This *DuPont* likelihood of confusion factor involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772,* 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (citing *DuPont*, 177 USPQ at 567). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's,* 126 USPQ2d at 1746) (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." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). Our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on a comparison of the entire marks, not just part of the marks. *In re Nat'l Data Corp.,* 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.,* 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in

determining likelihood of confusion.").

Applicant argues that the marks are "sufficiently distinct," pointing to the inclusion of a hyphen between the terms GEL and SHOTZ in its mark, the spelling of "shotz" with the letter "z" instead of the letter "s," and the stylized lettering. We disagree. Applicant's and Registrant's marks are phonetic equivalents that also share the same connotation and meaning. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *See e.g., In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). Because "there is no correct pronunciation of a mark" and because "it is impossible to predict how the public will pronounce a particular mark," we must assume that the marks could be pronounced in the same manner by consumers. *See Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012)); *In re The Belgrade Shoe Co.*, 411 F.2d 1352, 1353, 162 USPQ 227, 227 (CCPA 1969). *See, e.g., Kabushiki Kaisha Hattori Tokeiten v. Scuotto*, 228 USPQ 461 (TTAB 1985) (holding SEYCOS and design for watches, and SEIKO for watches and clocks, likely to cause confusion); *In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985) (holding CAYNA (stylized) for soft drinks, and CANA for, inter alia, canned and frozen fruit and vegetable juices, likely to cause confusion). In this regard, consumers will verbalize GEL-SHOTZ and GEL SHOTS the same based on normal U.S. English pronunciation.

Neither the hyphen nor the stylization present in Applicant's mark serve as distinguishing factors. *Cf. In re ING Direct Bancorp,* 100 USPQ2d 1681, 1690 (TTAB

2011) (finding "Person2Person Payment" generic despite deletion of spaces); *Giersch v. Scripps Networks Inc.,* 90 USPQ2d 1020, 1025 (TTAB 2009) (finding that DESIGNED TO SELL does not create a distinct commercial impression from DESIGNED2SELL). In general, differences in punctuation fail to obviate the similarities in sounds, meaning and commercial impression of the involved mark. *See, e.g., Nahshin v. Prod. Source Int'l LLC*, 107 USPQ2d 1257, 1258 n.2 (TTAB 2013) ("the presence or absence of a hyphen is insignificant to our . . . decision"); *Mag Instrument Inc. v. Brinkmann Corp*., 96 USPQ2d 1701, 1712 (TTAB 2010) (hyphen did not distinguish MAGNUM from MAG-NUM); *Goodyear Tire & Rubber Co. v. Dayco Corp.,* 201 USPQ 485, 489 n.4 (TTAB 1978) ("Fast-Finder" with hyphen is in legal contemplation substantially identical to "Fastfinder" without hyphen); *cf. In re Litehouse, Inc.*, 82 USPQ2d 1471, 1474 (TTAB 2007) (the presence of the exclamation points in the mark CAESAR!CAESAR! fails to negate the mere descriptiveness of the mark as a whole as applied to salad dressings). Such is the case here where the hyphen in Applicant's mark between GEL and SHOTZ does not alter the meaning of the literal terms. In addition, the cited mark GEL SHOTS is registered in standard characters meaning that it can be presented in any stylized format, including a font identical to Applicant's applied-for mark. *See* Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a); *see also In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (rejecting an argument that the specific style of a registered mark could serve to distinguish the applicant's mark in standard character form).

We therefore find this *DuPont* factor weighs in favor of finding a likelihood of confusion.

B. The Goods

Next, we compare the goods as they are identified in the involved application and cited registration. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *Stone Lion Capital Partners, LP v. Lion Capital LLP,* 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). The goods need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both applicant's goods and the goods listed in the cited registration.

See, e.g., In re Davia, 110 USPQ2d at 1817 (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores).

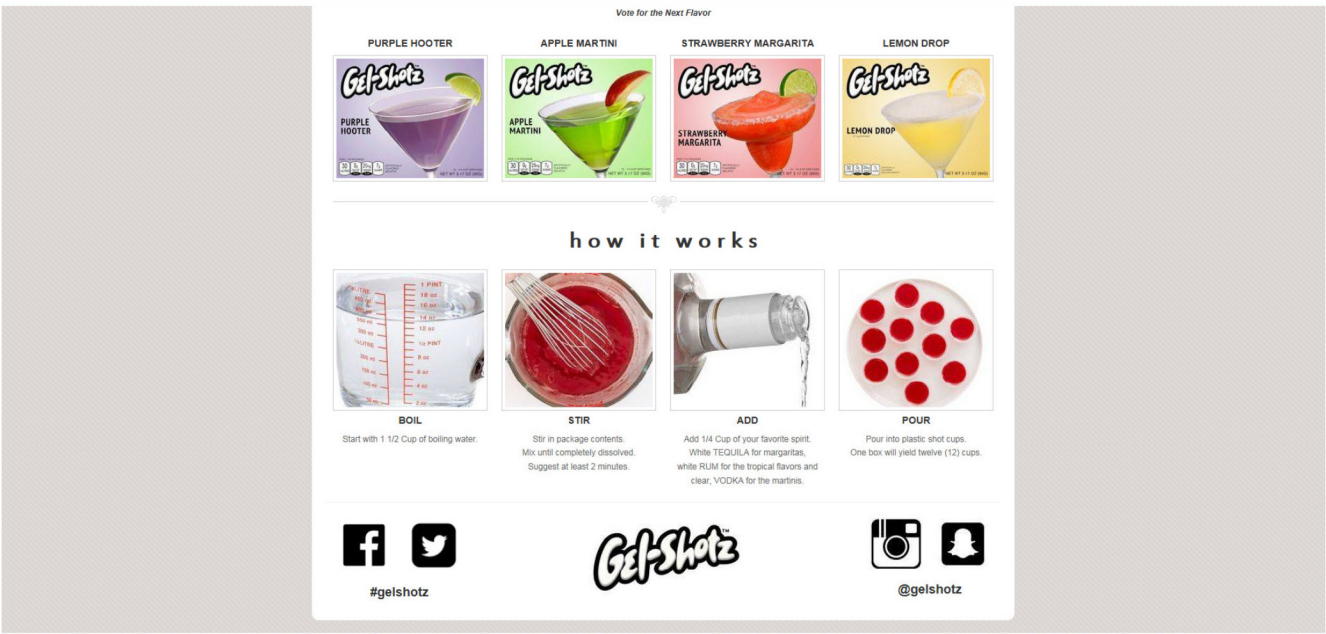
Applicant argues that the goods are unrelated, asserting that its "[f]lavored and sweetened gelatins" are "boxes of gelatin-style desserts that can be used to mix with alcohol or without, and can be used in baking for flavoring pies, cupcakes and fondant" whereas Registrant's goods consist of "one-liter bottles or gallon size jugs of wine based alcohol." Applicant's Brief, p. 9; 4 TTABVUE 10.

Applicant's arguments are belied by the record evidence which show that Applicant's "[f]lavored and sweetened gelatins" and Registrant's "aperitifs with a wine base" are complementary products designed to be mixed together in the same recipes to make alcohol infused gelatin in a shot-sized serving. *See, e.g., In re Vienna Sausage Mfg. Co.*, 230 USPQ 799, 799-80 (TTAB 1986) (sausage and cheese related based in part on copies of pages from cookbooks containing recipes for dishes having cheese and sausage as principal ingredients). Applicant's website (www.gelshotz.com) promotes its goods as "Jello for Grown-Ups!" to be mixed with alcoholic beverages:

> Gel-Shotz flavored gelatin is the world's first ever retail gelatin product specifically formulated to mix with alcohol. Gel-Shotz works best when combined with the base alcohol of your favorite cocktail (clear tequila with the Margaritas, white rum with the Tropicals, and vodka with Martini flavors.

June 25, 2017 Office Action, p. 35. The website even provides step-by-step recipe instructions for mixing Applicant's Gel-Shotz branded gelatin with spirits:

http://www.gelshotz.com/ 06/24/2017 07:30:23 AM



Id. Applicant's substitute specimen consisting of product packaging displays a similar recipe using vodka to make Cosmopolitan flavored gelatin shots:

See August 11, 2017 Response, p. 7. *Cf. In re N.C. Lottery,* 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017) (evidence of descriptiveness may be obtained from Applicant's own specimen of use and any explanatory text included therein). While

Applicant's web site and substitute specimen suggest mixing its flavored gelatin with spirits, it is foreseeable that consumers of these types of goods may substitute other types of alcoholic beverages such as Registrant's "aperitifs with a wine base."

We acknowledge that the principle "the mere appearance of different items in a recipe will not necessitate a finding that the goods are related." *In re Davia*, 110 USPQ2d at 1817. Here, however, Applicant instructs the consumer to use both its and Registrant's type of goods together. In short, we can conclude that Applicant's and Registrant's goods are complementary products that could be purchased and used together to make shot-sized alcohol infused gelatin. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984) ("[C]omplementary use has long been recognized as a relevant consideration in determining a likelihood of confusion."). As such, this *DuPont* factor also favors a finding of likelihood of confusion.

C. Trade Channels

Next we direct our attention to the established, likely-to-continue channels of trade. Applicant contends that while Registrant's goods are sold only in "bars, restaurants, and drive-through daiquiri bars" to consumers of legal drinking age, Applicant's goods are sold exclusively in grocery stores. Applicant's Brief, p. 9; 4 TTABVUE 10.

Because the identifications in the application and cited registration have no restrictions on channels of trade, we must presume that the goods travel in all channels of trade appropriate for such goods. *See Octocom*, 16 USPQ2d at 1787. It is

common knowledge that in some states, wine and wine products are sold in grocery stores where gelatin is also sold. The classes of purchasers overlap as well – persons of drinking age. As such, the *DuPont* factor regarding the similarity or dissimilarity of established, likely to continue trade channels also favors a finding of likelihood of confusion.

D. Other Factors – Prior Registration

The thirteenth and final *du Pont* factor pertains to "any other established fact probative of the effect of use." *du Pont*, 177 USPQ at 567. Rarely invoked, this factor "accommodates the need for flexibility in assessing each unique set of facts…." *In re Strategic Partners Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012). This includes a variety of circumstances such as an applicant's ownership of a previously registered mark. Where an applicant owns a prior registration that is over five years old and the mark is "substantially the same" as in the applied-for application, this can weigh against finding that there is a likelihood of confusion. *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1748 (TTAB 2018) (citing *In re Strategic Partners Inc.*, 102 USPQ2d at 1399 (no likelihood of confusion found with the registered mark ANYWEAR BY JOSIE NATORI and design where the applicant's previously registered mark ANYWEARS was substantially similar to the applied-for mark ANYWEAR for identical goods)).

Applicant points to its ownership through a predecessor in interest of the same registered mark as set forth in the application at issue. But as Applicant acknowledges, this registration was inadvertently cancelled, meaning that prior

ownership of a "substantially similar" mark is no longer a factor for consideration. While it is unfortunate that Applicant's prior registration was not maintained, our precedent is clear; a cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act. *In Re Ginc UK Ltd.*, 90 USPQ2d 1472, 1480 (TTAB 2007). *See also Action Temp. Servs. Inc. v. Labor Force Inc.,* 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("a cancelled registration does not provide constructive notice of anything."); *In re Hunter Publ'g Co.*, 204 USPQ 957, 963 (TTAB 1979) (cancellation "destroys the Section [7(b)] presumptions and makes the question of registrability 'a new ball game' which must be predicated on current thought.").

This *DuPont* factor is therefore neutral.

E. Balancing the Factors

We have carefully considered all of the evidence made of record, as well as all of the arguments related thereto. The marks are phonetic equivalents with the same connotation and commercial impression. This, coupled with the complementary nature of the goods sold in at least one overlapping trade channel to the same class of consumers leads us to the conclusion that prospective consumers are likely to confuse the involved goods as originating from or associated with or sponsored by the same entity.

Decision: The Section 2(d) refusal to register Applicant's mark is affirmed.