

This Opinion is Not a
Precedent of the TTAB

Mailed: May 6, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Friedman and Wieder Enterprises Inc.

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Serial No. 87612654

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Tuvia Rotberg of Amster Rothstein & Ebenstein LLP
for Friedman and Wieder Enterprises Inc.

Alexandra Foster,¹ Trademark Examining Attorney, Law Office 117,
Hellen Bryan-Johnson, Managing Attorney.

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Before Cataldo, Bergsman and Greenbaum,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

¹ The above application was originally examined by another Examining Attorney, but was subsequently reassigned to the attorney whose name is shown on the appeal brief.

Applicant, Friedman and Wieder Enterprises Inc., seeks registration on the Principal Register of the mark HULA DELIGHTS, in standard characters, identifying “gift baskets featuring processed nuts” in International Class 29.²

The Trademark Examining Attorney finally 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 HULA PRINCESS, issued in typed form³ on the Principal Register, identifying “shelled nuts and roasted nuts” in International Class 29.⁴

After the final Office Action, Applicant appealed. Applicant and the Examining Attorney filed briefs on appeal.⁵ We reverse the refusal to register for the reasons set out below.

I. 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*

² Application Serial No. 87612654 was filed on September 18, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), asserting May 12, 2014 as a date of first use of the mark anywhere and in commerce.

³ Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks, but the preferred nomenclature was changed in 2003 to conform to the Madrid Protocol ... we do not see anything in the 2003 amendments that substantively alters our interpretation of the scope of such marks”);

⁴ Registration No. 2394383 issued on October 10, 2000. First Renewal.

⁵ Applicant did not file a reply brief.

Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods or services. See *In re Chatam Int'l Inc.*, 380 F.2d 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.”). We have considered each relevant *du Pont* factor for which there is evidence or argument, and have treated any other factors as neutral. See *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). Varying weights may be assigned to each *du Pont* factor depending on the evidence presented. *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (factors “may play more or less weighty roles in any particular determination”).

A. Strength of the Registered Mark

We begin by evaluating the strength of the registered mark and the scope of protection to which it is entitled. The fifth *du Pont* factor is the “fame” or strength of the prior mark, and the sixth factor is the number and nature of similar marks in use for similar goods or services. *Du Pont*, 177 USPQ at 567. In determining strength of

a mark, we consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition. *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”).

Turning first to inherent strength, there is no evidence in the record regarding the possible significance of the terms comprising the mark HULA PRINCESS, either individually or in combination, in relation to the goods identified in the cited registration. Thus, concerning conceptual strength, we find on this record that HULA PRINCESS appears to be inherently distinctive and arbitrary in connection with the recited goods. Further, there is no evidence regarding the mark’s commercial or marketplace strength.

In its brief, Applicant argues that while the

term HULA, defined generally as a dance performed by Hawaiian women, is not descriptive of any food or beverage – nonetheless, due to extensive third party use of that term either alone or as part of composite marks for food and/or beverage goods, it is very weak as applied to food and beverage, and is entitled to only a fairly narrow scope of protection, where even minor differences in the marks and/or the goods will be enough to prevent a likelihood of confusion.⁶

In support of its position that the cited mark is weak and entitled only to a limited scope of protection, Applicant introduced into the record copies of twenty-six third-party registrations issued to twenty-one different entities for the following HULA-

⁶ 4 TTABVUE 4 (Applicant’s brief).

formative marks identifying various food products (all marks issued on the Principal Register in typed or standard characters unless otherwise noted):⁷

Reg. No. 5270381 for the mark HULA JUICE (JUICE disclaimed), identifying “Alcoholic beverages, except beer; Alcoholic cocktail mixes; Alcoholic mixed beverages except beers; Prepared alcoholic cocktail;”

HULA BOY
CHARBROIL



Reg. No. 5070464 for the mark (CHARBROIL disclaimed), identifying “sauces;” “restaurant”;

Reg. No. 4971635 for the mark HAWAIIAN HULA KOOKIE (HAWAIIAN and COOKIE disclaimed) and Reg. No. 4971634 for the mark HULA GIRL KOOKIE (COOKIE disclaimed), both identifying “candy; cookies;”

Reg. No. 5004083 for the mark HULA BERRY (BERRY disclaimed), identifying “live plants, namely, white strawberries;”

Reg. No. 5304074 for the mark HULA, Reg. No. 4605932 for the mark

POM
HULA

and Reg. No. 4495348 for the mark POM HULA, all identifying “fruit juice; fruit juices; fruit juice concentrate; fruit-flavored beverages; non-alcoholic beverages containing fruit juices; non-alcoholic beverages containing fruit extracts;”

⁷ Applicant’s March 16, 2018 Response to the Examining Attorney’s first Office Action at .pdf 17-34.

Applicant further submitted copies of seven third-party applications which are entitled to little, if any, probative value. *See, e.g., In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016) (third-party application is “evidence only that the application was filed on a certain date”); *Interpayment Services Ltd. v. Doctors & Thiede*, 66 USPQ2d 1463, 1468 n.6 (TTAB 2003).

Reg. No. 4488514 for the mark HULA DOG (DOG disclaimed), identifying “flavoring syrup; frozen confections; hot dog sandwiches; mustard; sandwich relish; sauces; shave ice confections;”

Reg. No. 4526527 for the mark HULA MATE (MATE disclaimed), identifying various herbal and non-herbal teas, beverages and concentrates;



Reg. No. 4382683 for the mark (WATER disclaimed), identifying “glacial water;”

Reg. No. 4190491 for the mark HULA LULA, identifying “cat treats;”

Reg. No. 4102111 for the mark LET YOUR TASTE BUDS DO THE HULA, identifying “hot sauce;”

Reg. No. 4021829 for the mark HULA BLEND (BLEND disclaimed), identifying “beverages made of coffee; coffee; ground coffee beans;”

Reg. No. 4013963 for the mark BORN TO HULA, identifying “barbeque sauce, hot sauce, relish, salad dressing, salsa, tomato sauce;”



Reg. No. 3638682 for the mark (AUTHENTIC and SAUCES disclaimed), identifying “barbeque sauce; salad sauces; teriyaki sauce;”



Reg. No. 3583072 for the mark identifying “shaved ice confections;”

Reg. No. 3367524 for the mark HULA HAWAIIAN (HAWAIIAN disclaimed), identifying “pizza;”



Reg. No. 3395453 for the mark (BEVERAGES disclaimed), identifying “alcoholic beverages, namely, rum and rum based beverages;”

Reg. No. 4266092 for the mark HULA GIRL, identifying “barbeque sauce; hot sauce;”

Reg. Nos. 4368862 and 4156157 for the mark HULA GIRL, respectively identifying “sauces;” and “coffee, coffee beans, crystal sugar pieces, ground coffee beans, pancake mixes, pancake syrup, roasted coffee beans, sugar, white sugar;”

Reg. No. 3050150 for the mark HULA DADDY, identifying “coffee beans roasted and unroasted;” and Reg. No. 2904861 for the mark



identifying “coffee beans;”

Reg. No. 2696175 for the mark HULA GRILL (GRILL disclaimed), identifying “sauces and dressings; desserts, namely, cakes, ice cream, and puddings;” and

Reg. No. 2818595 for the mark HAWAIIAN HULA, identifying “salad dressing.”

Of these third-party registrations, none identify nuts similar to the “shelled nuts and roasted nuts” identified in the cited registration or, for that matter, gift baskets similar to those identified in the involved application. As the Examining Attorney notes, the only reference to nut-related goods is in a third-party application that is entitled to little, if any, probative weight.⁸ *In re Mr. Recipe, LLC*, 118 USPQ2d at

⁸ 6 TTABVUE 9 (Examining Attorney’s brief).

1089. Rather, the marks in the third-party registrations all identify food products that are not as closely related to the goods identified in the cited registration or involved application, as discussed below. The marks differ from the registered mark to the extent that none include the term PRINCESS. Nonetheless, one consists solely of the term HULA, and fourteen others are formatives of HULA followed by a second term, e.g., HULA GIRL, HULA MATE, HULA DADDY and HULA BERRY, and thus follow the same convention as the registered mark HULA PRINCESS and applied-for mark HULA DELIGHTS.

As noted above, we find that the registered mark is arbitrary as applied to the identified goods. There is no evidence of third-party use; however, there is evidence of third-party registrations of assertedly similar marks for various food products or services. *Cf. Juice Generation, Inc. v. GS Enters LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015); *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135-36 (Fed. Cir. 2015). We therefore find that the registered mark is to be accorded a somewhat narrower scope of protection than that to which inherently distinctive marks are normally entitled due to the presence of the third-party registrations of HULA formative marks for food products. *See Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (stating that likelihood of confusion fame varies along a spectrum from very strong to very weak).

B. Similarity of the Marks

We next address the *du Pont* likelihood of confusion factor focusing on “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 Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “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) (quotation omitted). *See also Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d at 1089.

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on 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.”). 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 a consideration of the marks in their entireties. *Nat’l Data*, 224 USPQ at 751.

The Examining Attorney, citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, *supra* and *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed Cir. 1992), argues that the dominant feature of each mark is the term “HULA” because this term appears first in each mark and it is most likely to be impressed in purchasers’ memories.

We agree that the identical, leading term HULA in both marks creates a similarity between them. However, the evidence discussed above demonstrates that the term HULA common to both marks is somewhat weak due to the presence of twenty-six third-party registrations for various food products and services, of which fourteen consist of HULA followed by a second term and thus are arranged similarly to the marks at issue herein. Furthermore, there is no evidence that the terms DELIGHTS or PRINCESS are conceptually or commercially weak as applied to the goods at issue. Simply put, there is no evidence that either term describes or even suggests a feature or quality of the identified goods, or that third parties have made extensive use or registration of those terms. As a result, we find that DELIGHTS and PRINCESS in the marks at issue are distinctive, without any evidence of commercial weakness, and possess at least as much source-identifying significance as the term HULA.

Upon evaluating the mark HULA DELIGHTS and the registered mark HULA PRINCESS we find that while the common term HULA is identical, the following terms in the marks are completely dissimilar in appearance and sound. With regard to meaning, Applicant’s mark connotes tropical enjoyment while the registered mark suggests tropical royalty or an individual who is adept at hula dancing. These

connotations, while related, are somewhat different and, given the differences in the marks' appearance and sound, result in the marks having somewhat different commercial impressions.

In sum, we view the marks in their entireties and find them to be more dissimilar than similar in appearance, sound and meaning and, overall, to convey dissimilar commercial impressions. Thus, this *du Pont* factor weighs in favor of a finding of no likelihood of confusion.

C. Relatedness of the Goods, Channels of Trade and Classes of Consumers

With regard to the *du Pont* factors addressing the relatedness of the goods, channels of trade and classes of consumers, we must make our determinations based on the goods as they are identified in the application and cited registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). A proper comparison of the goods 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.” *Hewlett Packard*, 62 USPQ2d at 1004. Therefore, to support a finding of likelihood of confusion, it is not necessary that the goods be identical or even competitive. It is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such that they would be

encountered by the same persons in situations that would give rise, because of the marks, to a mistaken belief that they originate from the same source or that there is an association or connection between the sources of the goods. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009).

The cited registration identifies “shelled nuts and roasted nuts” and the involved application identifies “gift baskets featuring processed nuts.” There is no evidence of record regarding the nature of processed nuts versus shelled and roasted nuts. Because processed nuts, shelled nuts, and roasted nuts are specifically described and are categorized in different International Classes, we assume that there are significant differences such that the general term “nuts” is not sufficient or acceptable as a description of the goods. In other words, there must be a commercial reason that the goods are differentiated. Thus, we reject the Examining Attorney’s unsupported statement that “applicant’s goods are closely related to the goods provided by the cited registrant because they are all processed nuts”⁹ inasmuch as there is no evidence that the goods in the cited registration are processed nuts. Nonetheless, as identified, shelled and roasted nuts on the one hand and processed nuts on the other appear to be related to the extent that both are types of nuts.

In support of the position that the goods are related, the Examining Attorney introduced into the record with the December 21, 2017 first Office Action¹⁰ and April

⁹ 6 TTABVUE 11.

¹⁰ At .pdf 9-15.

5, 2018 final Office Action¹¹ evidence from the following commercial websites offering both nuts and gift baskets:

Berries.com offers assorted nuts and gift baskets that appear to include nuts;

Nuts.com offers assorted nuts and gift baskets;

Harry & David, a service of 1-800-flowers.com, offers nuts, including roasted almonds, in bags and as part of gift baskets;

Gourmetgiftbaskets.com offers nuts in bags and as part of gift baskets; and

Ohnuts.com offers mixed nuts, including raw and roasted nuts, in packages, bulk and as part of gift baskets.

As noted, two of the websites offer roasted nuts and one additionally offers raw nuts. While we cannot tell from three of the websites whether the nuts are shelled or roasted, nor can we tell to what extent any of the nuts are processed, this evidence establishes that nuts and gift baskets featuring nuts may emanate from at least a modest number of third parties.

Applicant argues:

Since there is no likelihood of confusion [between the marks] based on the sight, sound, and meaning test, there is no reason to compare the goods, since the Examiner would only get to this question if there were a likelihood of confusion. Notwithstanding, Applicant's gift baskets are specialized products for special occasions and are not comparable to the goods covered by the Cited Mark.¹²

We are not persuaded by Applicant's apparent argument that the marks are so dissimilar that confusion cannot occur in accordance with this tribunal's decision in

¹¹ At .pdf 8-32.

¹² 4 TTABVUE 15.

Kellog Co. v. Pack'em Enterprises, Inc., 14 USPQ2d 1545 (TTAB 1990), *aff'd* 951 F.3d 330 , 21 USPQ2d 1142 (Fed. Cir. 1991) (dissimilarity of marks FROOT LOOPS and FROOTIE ICE resulted in finding of no likelihood of confusion despite very close relationship between goods and trade channels). Rather, we consider the relatedness of the goods as one of the factors under *du Pont* in our likelihood of confusion determination.

The identifications of goods in the cited registration and involved application do not recite any limitations as to the channels of trade in which the goods are offered. In the absence of trade channel limitations on the goods under the registered and applied-for marks, we must presume that these goods are offered in all customary trade channels. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 98 USPQ2d at 1261; *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). The Examining Attorney did not offer any evidence regarding the channels of trade in which processed nuts, roasted nuts or shelled nuts are offered. Nor did the Examining Attorney offer any evidence regarding the consumers who purchase those products. Accordingly, we have only the five websites discussed above to consider. As discussed above, it is not clear whether three of the five websites offer roasted, shelled or processed nuts and two of the websites only specify that they offer roasted nuts.¹³

We find as a result that the *du Pont* factors of the relatedness of the goods, channels of trade and consumers weighs slightly in favor of likelihood of confusion.

¹³ One of those two websites also offers raw nuts which do not appear to be at issue herein.

II. Conclusion

We have carefully considered all of the evidence of record, including any evidence not specifically discussed herein. Evidence of record establishes that the goods are related, and may be marketed and sold by a modest number of third parties under the same marks on their websites. However, when viewed in their entirety, the marks are more dissimilar than similar, and the term HULA common to both marks is commercially weak compared to the terms DELIGHTS and PRINCESS that are quite dissimilar. As a result, we find that the marks are sufficiently dissimilar that when applied to somewhat related goods, confusion is unlikely as to the source of those goods.¹⁴

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

¹⁴ On a different record, such as may be adduced in an inter partes proceeding involving the owner of the cited registered mark, we may come to a different determination.