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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Ex parte appeal no.	90004393
Appellant	Panini America, Inc.
Applied for mark	CHOICE
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: Panini America, Inc.

Serial No.: 90/004,393

Filed: June 16, 2020

Mark: CHOICE

Examining Attorney:
Andrea R. Hack

Law Office: 108

APPLICANT'S BRIEF ON APPEAL

I. Introduction



This is an appeal from the Official Action of February 12, 2021, finally refusing registration of Applicant's mark CHOICE for "collectible trading cards; sports trading cards" in International Class 16.

II. Summary Of The Proceedings

On June 16, 2020, Applicant filed an application for CHOICE for "collectible trading cards; sports trading cards" which was assigned Application Serial No. 90/004,393 ("Applicant's Mark"). On September 18, 2020, the Examining Attorney initially refused registration of Applicant's Mark under § 2(d) of the Lanham Act, maintaining that there is a likelihood of confusion between Applicant's Mark and the following eight registrations:

Registrant	Reg. No.	Mark	Goods/Services
Major League Baseball Players Association	3884422	PLAYERS CHOICE CLUB	Video game cartridges, computer game programs; video game programs related to baseball, computer game programs related to baseball; trading cards, namely, paper and cardboard trading cards; photographs, namely, mounted and unmounted photographs; stickers,

Registrant	Reg. No.	Mark	Goods/Services
			posters, decals, calendars, paper pennants, and other printed matter, namely, playing cards; clothes, namely, t-shirts, tank tops, jerseys, sports shirts, and headgear, namely caps, and hats; toys and games depicting baseball players in the game of baseball, namely, action figures, dolls, board games sporting articles, namely, baseball bats, baseballs and card games related to baseball
President's Choice Trading Cards Inc.	5167943	PRESIDENT'S CHOICE	Trading cards
Major League Baseball Players Association	5728013	PLAYERS CHOICE ACADEMY	Computer game programs; video game programs related to baseball, computer game programs related to baseball; trading cards, namely, paper and cardboard trading cards; photographs, namely, mounted and un-mounted photographs; stickers, posters, decals, calendars, paper pennants; pen and pencil holders; toys and games depicting baseball players in the game of baseball, namely, action figures, dolls, stuffed toys, jigsaw puzzles
Major League Baseball Players Association	4432795	PLAYERS CHOICE DIAMOND CLUB	Computer game programs; video game programs related to baseball, computer game programs related to baseball; trading cards, namely, paper and cardboard trading cards; photographs, namely, mounted and unmounted photographs; stickers, posters, decals, calendars, paper pennants; clothes, namely, t-shirts, sweatshirts, jerseys, wrist bands, polo shirts, and headgear, namely, caps and hats; toys and games depicting baseball players in the game of baseball, namely, action figures, dolls, stuffed toys, board games sporting articles namely, baseballs

Registrant	Reg. No.	Mark	Goods/Services
Choice Marketing Inc.	2764342		Customized trading cards for organizations and individuals
The Upper Deck Company, Inc.	3754752	COLLECTOR'S CHOICE	Trading cards; greeting cards; blank cards; note cards; gift cards; business cards; occasion cards; stickers; albums for stickers; bumper stickers; sticker books; appliques in the form of decals; adhesive labels; printed paper labels; printed matter, namely, magazines in the fields of entertainment and sports; books in the field of entertainment and sports; comic books; comic strips; cartoon prints; newspaper cartoons; coloring books; children's books; children's activity books; notebooks; composition books; scrapbooks; photo albums; binders; stationery; writing journals; posters; packaging, namely, blister cards; postcards; desk calendars; desk pads and desk top organizers; bookmarks; calendars; pen cases; pencil cases; lunch bags; temporary body tattoos
Major League Baseball Players Association	2553756		Trading cards, stickers, posters, decals, post cards, calendars, mounted and unmounted photos, book covers, paper pennants, stationery-type portfolios, magazines in the field of sports and sports trading cards; t-shirts, sweatshirts, shorts, jerseys, caps, hats and sport shirts; baseballs, video game cartridges, computer game programs, board games, actions figures, dolls, stuffed toys, and hand held unit for playing video games
Major League Baseball Players Association	2537150	PLAYERS CHOICE	Trading cards, stickers, posters, decals, post cards, calendars, mounted and unmounted photographs, book covers, paper

Registrant	Reg. No.	Mark	Goods/Services
			pennants, stationary type portfolios, magazines in the field of sports and sports trading cards

The cited registrations are owned by four different, unrelated entities. The Examining Attorney concluded that “[t]he marks are confusingly similar because they all contain the word ‘CHOICE’” and that Applicant’s Mark “has no other elements besides the word ‘CHOICE’ to distinguish it from any of the cited registrations.” Non-Final Office Action dated Sep. 18, 2020 at p. 3. Moreover, the Examining Attorney further asserted that “[a]lthough [Applicant’s Mark] does not contain the entirety of the registered mark(s), [Applicant’s Mark] is likely to appear to prospective purchasers as the shortened form of registrants’ marks.” *Id.* However, the Examining Attorney provided no evidence that purchasers of trading cards tend to abbreviate the names of collectible card brands.

Applicant timely filed its response to the non-final office action on February 10, 2021 arguing that the differences in the marks are sufficient to preclude a finding of likelihood of confusion. On February 12, 2021, the Examining Attorney made final the refusal to register stating that “[i]ncorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d).” Final Office Action dated Feb. 12, 2021 at p. 2. On July 28, 2021, Applicant timely filed a Request for Reconsideration. In its Request for Reconsideration, Applicant asserted that the evidence of many active third-party registrations precludes a finding of likelihood of confusion since consumers are “able to distinguish these marks based on the slight differences between them.” Response to Office Action dated Jul. 28, 2021 at p. 4. As no decision

had been made on Applicant's Request for Reconsideration, on August 12, 2021, Applicant timely filed a Notice of Appeal to preserve its rights. On August 17, 2021, the Examining Attorney denied Applicant's Request for Reconsideration, and on August 23, 2021 the Board issued an Order resuming this appeal. Applicant filed its first Request for Extension to file its main brief on October 18, 2021. On October 21, 2021, the Board granted Applicant's Request for Extension allowing Applicant until November 21, 2021 to file its brief. On November 19, 2021, Applicant submitted a Request for Remand seeking suspension of the appeal so that Applicant could file a second Request for Reconsideration and submit additional evidence in support of registration. Applicant submitted its second Request for Reconsideration on November 22, 2021. On December 3, 2021, the Board denied Applicant's Request for Remand, stating that Applicant did not submit additional evidence with its request, so the Board was unable to grant the request for lack of good cause (*see* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 1209.04 (2021)). On December 3, 2021, Applicant resubmitted its Request for Remand including the materials it had already submitted in its second Request for Reconsideration. On December 14, 2021, the Board restored jurisdiction to the Examining Attorney. On December 15, 2021, the Examining Attorney denied Applicant's second Request for Reconsideration, and on December 28, 2021, the Board issued an Order resuming this appeal and granted Applicant until February 26, 2022 to file its brief.

III. Argument

The Examining Attorney concludes that Applicant's Mark is similar in appearance, sound, connotation, and commercial impression to the cited registrations

based solely on the fact that all of the marks at issue contain the term CHOICE. A refusal to register on the ground of likelihood of confusion requires that confusion as to the source of goods or services must not be merely possible, but likely. *See In re Massey-Ferguson, Inc.*, 222 USPQ 367, 368 (TTAB 1983). The Examining Attorney bears the burden of proving confusion. *See In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

The crowded field of CHOICE-containing marks registered and used in connection with trading cards is clear and convincing evidence that the formative “choice” is weak and at-most suggestive for collectible and sports trading cards. The Examining Attorney cited eight, live registrations including the word “choice” used for trading cards. These registrations are owned by four different, unrelated entities. *See* Non-Final Office Action dated Sep. 18, 2020 and Final Office Action dated Feb. 12, 2021. Evidence of these third-party registrations, coupled with the fact that the marks are clearly differentiable in terms of sight, sound, connotation, and commercial impression and the expensive nature of the goods, makes a finding of likelihood of confusion untenable. Applicant therefore submits that the Examining Attorney’s decision refusing registration of Applicant’s Mark based on a likelihood of confusion with the cited registrations should be reversed for the reasons set forth below.

A. “CHOICE” Is Weak And At-Most Suggestive When Used In Connection With Collectible And Sports Trading Cards

It is well established that the co-existence of marks containing a weak term demonstrates that consumers are able to distinguish between the marks based on the slight differences between them. *See, e.g., Gruner + Jahr USA Publishing v. Meredith Corp.*, 991 F.2d 1072, 26 USPQ2d 1583, 1587 (2d Cir. 1993) (no likely confusion

between PARENTS vs. PARENTS DIGEST for magazines because the “parents” portion “was extremely weak”). *See also Knight Textile Corporation v. Jones Investment Co., Inc.*, 75 USPQ2d 1313, 1316 (TTAB 2005) (finding no likelihood of confusion between NORTON MCNAUGHTON ESSENTIALS and ESSENTIALS, both for women’s clothing, because “purchasers are able to distinguish among various ESSENTIALS marks by looking to other elements of the marks” such as the presence of a house mark).

Evidence of active third-party registrations is relevant to show that a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods. *See, e.g., Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1033-34 (TTAB 2016); *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1152 (TTAB 2012). In other words, the Trademark Office can determine a mark is at-most suggestive given the presence of multiple other registrations with common elements used in connection with the same class of goods. *See, e.g., General Mills v. Health Valley Foods*, 24 USPQ2d 1270, 1278 (TTAB 1992).

Preliminarily, Applicant’s Mark is at-most suggestive. According to Merriam-Webster, “choice” can be defined as “the act of picking or deciding between two or more possibilities” or, alternatively, as “the best part” or “of high quality.” *See* Response to Non-Final Office Action dated Feb. 10, 2021, Exhibit A. Therefore, consumers would understand the cited registrations as meaning either the preferred option of two or more possibilities (as in PRESIDENT’S CHOICE or COLLECTOR’S CHOICE) or as connoting a higher quality, such as prime (as in PLAYERS CHOICE CLUB or PLAYERS CHOICE DIAMOND CLUB).

The highly suggestive significance of “CHOICE” when used for trading cards, as demonstrated by the dictionary definitions, is corroborated by the fact that the Examining Attorney cited eight variants of CHOICE-containing marks (owned by four different entities) used for similar goods. The co-existence of the cited marks on the Trademark Register establishes that consumers are able to distinguish these marks based on their slight differences. These active third-party registrations have so diluted the distinctiveness of the formative “choice” such that marks incorporating the term are entitled to a narrow scope of protection.

The number of third-party uses of CHOICE-formative marks is also instructional in this case. The Federal Circuit has characterized evidence of third-party use as “powerful on its face,” for demonstrating a term’s weakness. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (paw print design mark used for clothing found weak in light of 14 third-party registrations and uses of paw print marks on similar goods); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (PEACE and LOVE weak terms when used in connection with juice and restaurant services due to 26 third-party registrations and uses of marks containing the words “peace” and “love” used for similar goods and services). Here, the Examining Attorney cited to eight registrations containing the word “choice” for collectible and sports trading cards, and Applicant has submitted additional evidence of seven third-party uses of CHOICE-containing marks for collectible and sports trading cards. Request for Reconsideration dated Nov. 22, 2021, Exhibits A through G.

Similar to *Knight Textile*, the issue here is the weakness of the common element of the marks. The Board in *Knight Textile* concluded that ESSENTIALS is at-most suggestive when used in connection with women's clothing relying primarily on dictionary definitions for the term and "twenty-three extant ESSENTIAL registrations on the register in the clothing field registered, to twenty-one different owners." 75 USPQ2d at 1316.

The weight given to the relevant *du Pont* factors may vary, and one factor may play a more dominant role in the likelihood of confusion analysis. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). Here, the weakness of the alleged dominant element in the cited registrations warrants considerable weight in the analysis. Based on the evidence of record, it is respectfully contended that the consuming public is able to distinguish between the parties' marks by looking to other distinctive elements of the marks.

B. The Presence Of "CHOICE" In The Marks Does Not Render The Marks Confusingly Similar

Contrary to the Examining Attorney's assertions, there is no rule that confusion is likely merely because marks share common elements. *See Knight Textile*, 75 USPQ2d at 1315. *See also In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (finding GOLDEN CRUST for flour, and ADOLPH'S GOLD'N CRUST for coating and seasoning for food items, not likely to cause confusion since GOLDEN/GOLD'N CRUST is highly suggestive when applied to the respective goods). Indeed, in evaluating likelihood of confusion, marks should be compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *See Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1353-54 (Fed. Cir. 2000).

Additions to marks are sufficient to avoid a finding of likelihood of confusion if the marks convey significantly different commercial impressions or if the matter common to the marks is not likely to be perceived by purchasers as distinguishing source. *Knight Textile*, 75 USPQ2d at 1315-16. In *Knight Textile*, the Board found that the addition NORTON MCNAUGHTON to the opposer's mark "suffice[d] to distinguish the two marks when they are viewed in their entirety" as ESSENTIALS "is a highly suggestive term as applied to the articles of clothing." *Id.* at 1316.

Here, confusion is unlikely, especially considering the at-most suggestive nature of CHOICE, when the marks are compared in their entirety. The marks do not look or sound the same because Applicant's mark is the single one-word and one-syllable "CHOICE" while the registered marks all have additional words, and some include unique design elements and stylization. The specific differences in the marks are:

Reg. No. 3884422 is three words and four syllables with the first word "PLAYERS" and last word "CHOICE." Reg. No. 5167943 is two words and four syllables with the distinct first word "PRESIDENT'S." Reg. No. 5728013 is three words and seven syllables with the first word "PLAYERS" and last word "ACADEMY." Reg. No. 4432795 is four words and six syllables with the first word "PLAYERS" and final words "DIAMOND CLUB." Reg. No. 2764342 is even more distinguishable as it incorporates a one-of-a-kind design element, is three words and six syllables, and ends with "MARKETING SPORTSCARDS." Also, "SPORTSCARDS" is underlined in this registration putting additional emphasis on this term. Reg. No. 3754752 is two words and four syllables with the unique first word "COLLECTOR'S." Reg. No. 2553756 incorporates the distinct design of a baseball player, is three words and six syllables, and begins with the two words "MLB PLAYERS." Reg. No. 2537150 is two words and three syllables and begins with the first word "PLAYERS." Thus, as evidenced above, the visual and aural differences between the marks fail to support a finding of confusing similarity.

Response to Non-Final Office Action dated Feb. 10, 2021 at p. 4.

Indeed, marks must be considered in their entireties because it is the commercial impression that the mark (as a whole) instills with the consumer that is relevant in a likelihood of confusion analysis. *Shen Mfg. Co. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004).

Here, the Examining Attorney has concluded that “when comparing the marks as a whole, the overall impression is that of highly similar marks” since Applicant’s Mark “is likely to appear to prospective purchasers as a shortened form of registrants’ marks.” Final Office Action dated Feb. 12, 2021 at p. 2. However, the Examining Attorney has provided no relevant evidence or basis for such a contention. To the contrary, it is not common for consumers to abbreviate the brand names of collectible or sports trading cards.

The Examining Attorney cites to *In re Mighty Leaf Tea* (601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010)) as the proposition that the relevant consumers would abbreviate the cited registrations to Applicant’s Mark. Yet, *Mighty Leaf* is clearly distinguishable from this case. In *Mighty Leaf*, the Office refused to register the mark ML for personal care and skin products in light of a prior registration for ML MARK LESS for related goods. Specifically, it was “recognized that the[] initials [ML] comprise a dominant feature of the registered mark, and that a newcomer’s use of the same initials, in connection with the same goods, would likely lead consumers to view the goods as coming from the same source.” *Id.* at 1260.

In this case, the purported dominant element in the marks is not comprised of initials: it is a known word with particular meaning. Moreover, in *Mighty Leaf*, the common term appeared as the first word in the cited registration whereas here only one of

the registrations uses CHOICE as a first word. Indeed, the differences between the marks' beginning portions are critical in this matter since it is the first word that is most likely to leave a lasting impression in the minds of consumers. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“To be sure, CLICQUOT is an important term in the mark, but VEUVE nevertheless remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label.”).

When considering the marks at issue in their entireties, it is obvious that the marks are more dissimilar, rather than similar, in terms of appearance, sound, connotation, and overall commercial impression since the only similarity is that all of the marks contain the word CHOICE. The additional elements in the cited marks include significant and distinguishing features, and the nature with which they interact with the common term must be considered. *See e.g., Guerlain, Inc. v. Richardson-Merrell Inc.*, 189 USPQ 116, 119 (TTAB 1975) (“The fact that two marks have common letters does not mean that the marks as a whole project the same commercial impression. The nature and character of the remaining portion or portions and their reaction with the common initial letters must be considered.”).

In addition, the goods at issue are relatively pricey, often selling for several hundreds of dollars (*see* Request for Reconsideration dated Nov. 22, 2021, Exhibit D showing the 2021 Bowman Chrome Baseball HTA Choice Box retailing at \$345.00). Given the expensive nature of the goods, consumers are likely to exercise higher care when making purchasing decisions. The relevant purchasers certainly pay close attention

to the name of the goods and would be able to distinguish between two boxes of trading cards branded with the word “choice.”

The marks in this case are similar only to the extent that they contain the term CHOICE, a weak term when used in connection with the parties’ goods. Moreover, most of the cited marks contain the additional first word “PLAYERS” which creates a clearly different commercial impression in the minds of the relevant consumers since it likely refers to the “players” in Major League Baseball **Players** Association (the name of the registrant). Taking into consideration the at-most suggestive nature of the common element in the respective marks and the differences in appearance, sound, connotation and commercial impression, there is no likelihood of confusion. Contemporaneous use of the marks is not likely to cause confusion in the marketplace, based solely on the dissimilarity of the marks.

IV. Conclusion

Given the factors discussed above weigh in favor of a finding of no likelihood of confusion, Applicant respectfully requests that the Board reverse the final refusal to register Applicant’s Mark under § 2(d) of the Lanham Act and allow the application to proceed to publication.

Respectfully submitted,

Panini America, Inc.

Date: February 23, 2022

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