

**THIS OPINION
IS NOT A PRECEDENT OF
THE TTAB**

Hearing: September 23, 2010

Mailed: February 17, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Morinaga & Co., Ltd.
v.
Crown Confectionary, Co., Ltd.

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Opposition No. 91171726
to Application No. 78615145
filed on April 22, 2005
—————

Jess M. Collen and Jeffrey A. Lindenbaum of Collen IP for
Morinaga & Co., Ltd.

Steven M. Rabin of Rabin & Berdo for Crown Confectionary,
Co., Ltd.

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Before Walters, Kuhlke and Taylor, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Morinaga & Co., Ltd. filed its opposition to the
application of Crown Confectionary, Co., Ltd. to register
the mark shown below for "chewing gum; candy; caramels," in
International Class 30.¹ The application includes the

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¹ Application Serial No. 778615145, filed April 22, 2005, based upon an
allegation of a bona fide intention to use the mark in commerce in
connection with the identified goods.

statements that "[t]he color blue is claimed as a feature of the mark" and "[a]ll of the letters are in the color blue."

The logo for MYCHEW is written in a bold, blue, italicized sans-serif font.

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods so resembles opposer's previously used and registered mark shown below as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

Registration No. 2626396²

[Registered September 24, 2002; Sections 8 and 15 declarations accepted and acknowledged]

Goods: "Candy," in International Class 30

Mark:

The logo for HI-CHEW is written in a bold, black, stylized font with a white outline and a drop shadow effect.

Applicant, in its answer, denied the salient allegations of the claim.

² Opposer asserted in its pleading an additional trademark registration and two pending applications, which subsequently matured to registration. Applicant submitted a copy of opposer's pleaded registration no. 3097367 by notice of reliance and, therefore, we consider that this registration is properly of record and that applicant has conceded the status and ownership of that registration. However, opposer discussed only registration no. 2626396 at trial and in its brief. We consider opposer's reliance on its additional pleaded applications/registrations to be waived and we have given them no consideration. Moreover, had the additional registrations been of record, we would restrict our likelihood of confusion analysis to Registration No. 2626396 as it is the most relevant mark in this case.

Preliminary Issues

1. Applicant's Counterclaims

Applicant filed counterclaims to cancel the two registrations pleaded by opposer. On February 7, 2007, the Board granted opposer's motion to dismiss the counterclaims with prejudice. Thus, the counterclaims have not been addressed further herein.

2. Applicant's Affirmative Defenses

Applicant asserted in its answer that "international comity" requires the Board to recognize the registrability decisions in favor of applicant, vis-à-vis opposer, of the Korean Intellectual Property Office and the Japanese Patent Office; and the judgment against opposer on unfair competition in the Seoul Central District, Civil Division XI and the Intellectual Property Tribunal, Division 1. Applicant also asserts affirmatively that the opposition is barred by United States membership in the World Trade Organization, which "prohibits the U.S. from giving local preferences."

Opposer made of record applicant's answer to Opposer's Interrogatory No. 25, stating that applicant did not intend to rely on these affirmative defenses. Applicant did not dispute this statement, nor did applicant address these affirmative defenses in its brief. Therefore, we consider

these defenses to have been waived and we have given them no consideration.³

Moreover, even if we had considered applicant's affirmative defense regarding foreign decisions, it is not well taken. Foreign decisions regarding trademark registrability in the United States have no effect in the United States and are not relevant to this opposition proceeding. See *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609 (TTAB 1991) and cases cited therein. Trademark rights are territorial by their very nature. Applicant is well aware of this as evidenced by its contention in its brief that the Board should give no effect to the finding of the Japanese Patent Office regarding the alleged renown of opposer's mark.

Opposer objected to the admissibility of the noted foreign decisions by applicant's notice of reliance. This objection is moot, as we have already indicated that the documents have not been considered. Also, for the reasons stated, we have given no consideration to any assertion or reliance by opposer on its use, registration or litigation pertaining to its pleaded mark in countries other than the

³ Even if we were to consider applicant's WTO-based affirmative defense, it is not well taken. The trademark registration opposition system in the United States provides equal treatment for all opposers and applicants, regardless of their national origin or status in the United States.

United States, including any reference to the renown of its mark in Japan by the Japanese Patent Office.

3. *Opposer's Objections to Evidence*

Opposer objects to the lists of third-party registrations submitted by applicant by notice of reliance on the ground that the registrations listed thereon have not been properly introduced into evidence, have not been authenticated, and the lists are of no probative value.

Opposer contends that copies of search result lists from the USPTO's TESS database are not a proper way of making such registrations of record. Opposer also objects to (1) consideration of the third-party registrations submitted by applicant because applicant has submitted them to establish use of the registered marks; and (2) consideration of third-party applications and cancelled registrations because they are of no probative value.

Opposer's objection to the admissibility of the lists of registrations and applications is granted. As opposer correctly states, third-party registrations may not be made of record by a mere listing of the registrations; rather, a copy of each registration from the electronic records of the USPTO is required. Therefore, we have not considered the lists of registrations submitted by applicant. An application, even if properly of record, is evidence only of the fact that an application has been filed. *Interpayment*

Services Ltd. v. Docters & Thiede, 66 USPQ2d 1463, 1467 n.6 (TTAB 2003). Similarly, a cancelled registration, even if properly of record, is evidence only of the fact that the registration is cancelled.

Applicant has made several third-party registrations properly of record by submitting, by notice of reliance, copies of the registrations from the records of the USPTO TESS database. See, *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992). However, as opposer correctly states, third-party registrations are not evidence of use of the marks shown therein, nor are they proof that consumers are familiar with the marks. *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1992). Thus, the Board has not considered the third-party registrations for this purpose. On the other hand, third-party registrations may be relied on to show that a word common to each of the marks has a readily understood and well-known meaning and that it has been adopted by third parties to express that meaning. *Ritz Hotel Ltd. v. Ritz Closet Seat Corp.*, 17 USPQ2d 1467 (TTAB 1990). Whatever probative value the properly submitted third-party registrations may have is discussed in the Board's analysis *supra*.

Applicant has also submitted copies of the specimens of use from the registration files of a small number of the

third-party registrations. With respect to the use of these registered marks, we can not draw any conclusions about the use of these marks subsequent to submission of the specimens, the manner or nature of any use, the extent of any use, or consumer exposure to the marks. As such, these registrations are of very limited probative value.

In its reply brief, opposer has objected to consideration of applicant's trial brief on the ground that it exceeds the page limitations. The main portion of applicant's brief is 49 pages, not including the cover pages or certificate of service, but including the tables of contents and authorities. There is a seven-page appendix attached to the brief. The main text in the brief is double-spaced in 11-point Times New Roman; and the 53 footnotes and approximately six pages of tables in the main brief are single-spaced in 10-point Times New Roman.

Trademark Rule § 2.126(b), 37 CFR § 2.126(b), provides:

... Text in an electronic submission must be in at least 11-point type and double-spaced ...

Trademark Rule § 2.128(b), 37 CFR § 2.128(b), provides:

Briefs must be submitted in written form and must meet the requirements prescribed in § 2.126. Each brief shall contain an alphabetical index of cases cited. Without prior leave of the Trademark Trial and Appeal Board, a main brief on the case shall not exceed fifty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary; ...

Extensive single-spaced footnotes may not be used as a subterfuge to avoid the page limit. *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894, 1896 n.3 (TTAB 1992) (warned that single-spaced footnotes containing substantial discussion may be viewed as a subterfuge to avoid page limit). Exhibits or appendices to a brief are not part of the brief itself and are not included within the page limit. *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789 (TTAB 1998) (raising evidentiary objections in appendices was not viewed as subterfuge to avoid page limit; although extensive argument in appendices could be seen as subterfuge). In addition, evidentiary objections that may properly be raised in a party's brief on the case may instead be raised in an appendix or by way of a separate statement of objections. *Id.* See also, *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992).

Applicant's brief is within the noted page limitations. Applicant's brief has many single-spaced footnotes and a table in a type size that is ten-point and smaller. The footnotes include argument that could have been made in the body of the brief, although we are not troubled by their single-spacing, as this is usual in most briefs. However, rather than undertaking to determine which footnotes should have been in the body of the brief and whether applicant's

brief would then exceed the page limitations, we find, on balance, that applicant's brief is an acceptable length and we have considered it in its entirety.

We have also considered applicant's appendix to its brief as it properly contains corrections to its evidentiary record, a response to opposer's objections, and its own objections to opposer's evidence. Therefore, opposer's objection to consideration of applicant's brief is denied.

4. Applicant's Objections to Evidence

The testimony of opposer's witness, Mr. Shimada, was taken in the form of responses to written questions. Opposer objected to almost all of applicant's 79 questions on cross examination, although Mr. Shimada did respond to the questions. Opposer failed to renew its objections in its main brief and applicant, in the appendix to its brief, requests that opposer's objections be considered waived. In its reply brief, opposer states that "[o]pposer maintains (and does not waive) the objections it raised during the trial testimony cross-examination of its witness Mr. Shimada." (Reply, p. 12.)

Applicant's request is granted and none of opposer's objections to the cross examination questions during the testimony of Mr. Shimada has been considered. We have given Mr. Shimada's answers whatever probative value they merit. First, the renewal of these objections in opposer's reply

brief is too late. Such objections must be renewed in the main brief so that, in fairness, applicant has an opportunity to respond. Moreover, opposer's renewal of its objections must be specific. Opposer's general statement renewing all objections made to testimony is inadequate to preserve individual objections.

The Record

By operation of the Trademark Rules, the record includes the pleadings and the file of the involved application. Opposer submitted a copy of Registration No. 2626396 showing status and title; and the testimony deposition by opposer of Tetsuo Shimada, opposer's general manager of the business development division and head of the general affairs center of opposer, with accompanying exhibits. Each party submitted the other party's responses to interrogatories and admissions, along with supplemental responses, by notice of reliance. Applicant also submitted by notice of reliance, copies of third-party registrations and specimens of record for some of those registrations, as discussed *infra*. Both parties submitted excerpts from various dictionaries and texts.⁴ Both parties filed briefs on the case.

⁴ The Board has not identified in this section the evidence that is merely duplicative or that has been excluded or discounted as being of no probative value, as discussed *infra*.

Factual Findings

Opposer is a Japanese company that sells, *inter alia*, candy. Opposer sells candy in the United States under the mark HI-CHEW, shown in a stylized script in its trademark registration and on packaging. The type of candy currently sold under this mark is described by opposer's witness, Mr. Shimada, as fruit chews.

In 1994, opposer began using a stylized mark in Japanese Katakana characters in connection with sales of its fruit chews candy in the United States. A translator note accompanying the translation of Mr. Shimada's testimony explains that the Japanese language consists of Kanji characters (Chinese characters), Hiragana characters (characters used for Japanese language words), and Katakana characters (characters used for non-Japanese words that have become part of the Japanese language). This fact is confirmed in the Japanese/English dictionary and text excerpts of record. It appears from the various Japanese/English dictionaries submitted by the parties, that HI-CHEW is a close approximation of the pronunciation of opposer's Japanese Katakana character mark.

In April 2004, opposer began using its stylized HI-CHEW mark in connection with the sales of its fruit chews candy in the United States. It sells its HI-CHEW candy in candy displays at 7-11 convenience stores, Costco, Sam's Club, ABC

Store and Long's Drug. The candy is sold in packs costing from \$.63 to \$1.29. Opposer submitted as confidential, information and figures about its annual promotion and advertising efforts and sales of its HI-CHEW candy in the United States. These numbers are significant, but there is no evidence about what constitutes usual annual sales in this product field, nor is there information about the nature and extent of consumer awareness of this brand.

Applicant does not have a business presence in the United States; its does not sell any goods in the United States under the stylized MYCHEW design mark shown in its application; and it has done no advertising in the United States.

The record includes a definition from *Merriam-Webster's New Collegiate Dictionary* (11th ed. 2005) of "chew" as "vt 1. to crush, grind, or gnaw (as food) with or as if with the teeth: masticate" and "n 1. the act of chewing 2. something for chewing."

Analysis

Standing

Because opposer has properly made its pleaded registration of record, we find that opposer has established its standing to oppose registration of applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d

1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Priority

In view of opposer's ownership of the established valid and subsisting registration, there is no issue regarding opposer's priority. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Thus, the only issue to decide herein is likelihood of confusion.

Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in

the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein. The relevant *du Pont* factors in the proceeding now before us are discussed below.

The Goods

To support a holding of likelihood of confusion, it is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods and/or services, but rather whether there is a likelihood of confusion as to the source of the goods and/or services. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). The question of likelihood of confusion must be determined based on an analysis of the goods and/or services recited in applicant's

application vis-à-vis the goods and/or services identified in opposer's pleaded registration(s). *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992).

Applicant's identified goods are "chewing gum; candy; caramels." The goods identified in opposer's registration for the mark HI-CHEW are "candy." Thus, there is no question that the parties' goods are, in part, identical (i.e., "candy"). We do not need to consider applicant's remaining goods because the fact that one of the products listed in applicant's description of goods is identical is sufficient to support a finding that there is a likelihood of confusion. *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any items that come within the identification of goods in the application).

This *du Pont* factor strongly favors opposer.

Trade Channels, Purchasers and Conditions of Sale

As indicated above, opposer's and applicant's identified "candy" is legally identical. Thus, we must presume that they are rendered in identical trade channels and are purchased by the same consumers. The purchasers comprise the general public, and these ordinary consumers would use nothing more than ordinary care in making their

purchasing decisions, particularly in view of the modest price of the respective goods.

These *du Pont* factors also favor opposer.

The Marks

Considering, next, the marks, we note that in determining likelihood of confusion, a lesser degree of similarity between two marks is required when the marks are applied to identical goods or services. *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd* 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). See also *In re J.M. Originals*, 6 USPQ 1393 (1987).

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692.

We begin with opposer's contention that its mark is famous because fame, when found, is entitled to great weight in a likelihood of confusion analysis. *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). In determining whether a mark is famous, we may consider sales, advertising expenditures, and the length of time the mark has been used. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303,

1309 (Fed. Cir. 2002). This information, however, must be placed in context (e.g., a comparison of advertising figures with competitive products, market share, reputation of the product, etc.). *Bose Corp. v. QSC Audio Products Inc.*, *supra*. We find that opposer's evidence falls far short of establishing that its mark is famous. In particular, opposer has provided no context for its advertising and sales figures.

To compare the marks at issue, we reproduce them below:

Applicant's Mark:

Opposer's Mark:

MYCHEW

HI-CHEW

Applicant argues that CHEW is merely descriptive in connection with opposer's fruit chew candies and, therefore, the marks are easily distinguished by the initial syllables MY and HI. Applicant's third-party registrations, for several very different marks containing the word "chew" and other wording for a variety of goods, are split fairly evenly between those that contain disclaimers of "chew" and those that do not. Because of the differences among the third-party marks, the differences among the identified goods, including goods similar to candy, and the inconsistent entry of disclaimers, we draw no conclusions about the descriptiveness of "chew" from these third-party registrations.

Opposer's witness, Mr. Shimada, referred to the type of candy sold under the HI-CHEW mark as "fruit chews." Both applicant's and opposer's goods are identified as "candy," which for both applicant and opposer would encompass "fruit chews" candy. Obviously, a consumer may "chew" a candy as he or she would any food item. "Chew" is such a common word and such an obvious action in relation to any food that we do not find "chew" to merely describe a significant feature or purpose of the goods. For example, a main purpose of many dog toys is to provide an outlet for dogs to chew. In this context, "chew" may be merely descriptive of a significant feature of a dog toy. However, "chewing" food is merely incidental to the experience of eating the food. In this regard, we find that "chew" is suggestive in connection with candy, but it does not rise to the level of descriptiveness.

Even though the "chew" portion of the respective marks is suggestive and, thus, weak, it still remains part of the mark and we must consider the marks in their entirety. Moreover, ours is not a simple side-by-side comparison; rather, we must consider the recollection of the average purchaser, who is unlikely to see the marks side-by-side and who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

In this case, we find that the similarities between the marks outweigh their differences. The font used for the two marks is very similar, despite the fact that opposer's mark includes an outline around the word. Both marks are compound words consisting of the word CHEW preceded by two-letter words/syllables, MY and HI. While MY and HI are actual words in the English language, as modifiers of CHEW and in connection with candy, the terms are arbitrary. MY and HI rhyme, which consumers are likely to remember, especially since the "Y" and long "I" are phonetically interchangeable. Opposer's mark contains a hyphen between HI and CHEW, but this is of minimal significance, as is the blue color of the lettering in applicant's mark.

We find that, when considered in their entirety, the marks are substantially similar in sound, appearance, connotation and commercial impression. This *du Pont* factor favors opposer.

Conclusion

Having considered all of the evidence and all of the parties' arguments, including those not discussed herein, we find that the *du Pont* factors, on balance, weigh in favor of a finding of likelihood of confusion. We conclude that consumers familiar with opposer's candy sold under the stylized design mark HI-CHEW, would be likely to believe, upon encountering applicant's stylized design mark MYCHEW,

Opposition No. 91171726

that the goods originate from or are associated with or sponsored by the same entity.

Decision: The opposition is sustained on the ground of likelihood of confusion, and registration to applicant is refused.