

This Opinion is Not a
Precedent of the TTAB

Mailed: October 26, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Chef Sous LLC

v.

Heidi Webb, Inc.
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Opposition No. 91215638
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Charles M. Allen and Marth A. Weis of Goodman Allen Donnelly PLLC,
for Chef Sous LLC.

Nancy R. Frandsen and Lesley M. Grossberg of Baker & Hostetler LLP,
for Heidi Webb, Inc.

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Before Zervas, Ritchie and Kuczma,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Heidi Webb Inc. (“Applicant”) seeks to register the mark NOT SO SIMPLE SYRUP in standard characters for “syrops for making beverages; non-alcoholic drink and cocktail mixes” in International Class 32.¹

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¹ Application Serial No. 85915409, filed April 26, 2013, based on an assertion of a *bona fide* intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b). The application includes a disclaimer of SYRUP.

Chef Sous LLC (“Opposer”) opposes registration of Applicant’s mark on the ground of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), with its previously registered mark K.I.S.S. SIMPLE SYRUP KEEP IT SIMPLE SYRUP and Design (Registration No. 4178435, “the ‘435 registration”) in the following form



for “Flavoring syrup; Table syrup; Topping syrup” in International Class 30 and “Syrup for making lemonade; Syrups for beverages; Syrups for making beverages” in International Class 32. Opposer disclaimed the term SIMPLE SYRUP.²

Opposer also asserted in the notice of opposition Registration No. 3628573 (“the ‘573 registration”) for the mark KEEP IT SIMPLE SYRUP in standard characters, for “Flavoring syrup; Table syrup; Topping syrup” in International Class 30 and “Syrup for making lemonade; Syrups for beverages; Syrups for making beverages” in International Class 32. The Office cancelled this registration on January 1, 2016 for

² The description of the mark in the registration record states:

The mark consists of a white background that has pink dots interspersed with the letters “k”, “i”, “s”, “s”, and the words “simple syrup” in pink lower case block lettering encircling the image of pink lips in a kiss, which all appears in the upper left-hand corner of and overlapping the words “keep it” in black lower case block letters above the word simple in black lower case block letters above the word syrup in black lower case cursive letters.

failure to file a Section 8 declaration. We therefore give this registration no further consideration.³

Applicant, in its answer, denied the salient allegations of the notice of opposition.

The Record

In addition to Applicant's opposed application which is automatically of record pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the evidence of record consists of the following:

A. Testimony

Transcript of Susan Martinson, Opposer's owner, filed October 23, 2015, including Exhibits 1 – 43.

B. Opposer's Notices of Reliance

First and second notices of reliance, both filed September 30, 2015, and third notice of reliance, filed April 22, 2016, including the following exhibits submitted therewith:

- Applicant's Response to Opposer's first set of interrogatories;⁴
- Documents produced by Applicant in response to Opposer's Interrogatory No. 19;⁵

³ See discussion *infra*, regarding common law rights in the mark KEEP IT SIMPLE SYRUP.

⁴ Opposer states in its notice of reliance that it relies only on Applicant's answers to Interrogatory Nos. 5, 7, 8, 12, 19, 20, 21, 25 and 27. Opposer, however, introduced Applicant's answers to all of Opposer's interrogatories located in its first set of interrogatories, not just the ones listed in the actual notice of reliance. We consider all of these interrogatory answers, not only the ones listed in the notice of reliance.

⁵ Documents provided as all or part of an answer to an interrogatory under Fed. R. Civ. P. 33 may be made of record, as an interrogatory answer, by notice of reliance filed in accordance with 37 CFR § 2.120(j)(3)(i) and 37 CFR § 2.120(j)(5). See TBMP § 704.10 and 704.11.

- Papers from the prosecution file of the ‘573 registration for KEEP IT SIMPLE SYRUP;
- Papers from the prosecution file of the ‘435 registration for KEEP IT SIMPLE SYRUP;
- TESS record for the ‘435 registration showing status and title in Opposer; and
- Papers from the prosecution file for Opposer’s Application Ser. No. 86907803 filed February 15, 2016, after Applicant filed its application, for the standard character mark KEEP IT SIMPLE SYRUP (the ‘803 Application).

C. Applicant’s Notice of Reliance

Applicant submitted:

- File histories for Applicant’s involved application and the ‘573 and ‘435 registrations;
- Applicant’s Answers to Opposer’s First Set of Interrogatories No. 13 and 26, submitted pursuant to Trademark Rule 2.120(j)(5), 37 C.F.R. § 2.120(j)(5);
- Opposer’s Answers to Applicant’s First Set of Interrogatories;
- Webpage printouts; and
- Printout of the USPTO’s TARR record for Reg. No. 2108390 for SIMPLY SIMPLE SYRUP.

Standing and Priority

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. To establish standing in an opposition or cancellation proceeding, a plaintiff must show “both a ‘real interest’ in the proceedings as well as a ‘reasonable basis’ for its belief of damage.” *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (quoting *ShutEmDown Sports, Inc., v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012)); *Ritchie v. Simpson*, 170 F.3d

1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Applicant states at p. 8 of its brief:

Although Applicant agrees with Opposer that because the '573 registration for the word mark KEEP IT SIMPLE SYRUP has been cancelled, Opposer must rely on its common-law rights in that mark ... Applicant does not contest that Opposer has standing and priority to assert either the KEEP IT SIMPLE SYRUP word mark or the design mark shown in the subsisting '435 registration. Thus, likelihood of confusion is the sole issue requiring resolution by the Board.⁶

Applicant's statements are significant in four respects.

First, Applicant concedes Opposer's standing to bring this opposition; indeed, Opposer has established its standing through its submission of a copy of its pleaded registration for the K.I.S.S. SIMPLE SYRUP KEEP IT SIMPLE SYRUP and design mark, which shows that it is valid and subsisting, and owned by Opposer. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (party's ownership of pleaded registration establishes standing).

Second, Applicant concedes Opposer's priority in the registered mark. We note, though, that because Opposer's pleaded registration is of record, and because Applicant has not filed a counterclaim to cancel Opposer's pleaded registration, priority is not an issue with respect to the goods covered by Opposer's extant, pleaded registration. *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998)

⁶ 33 TTABVUE 14.

(citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

Third, and perhaps most significantly, Applicant concedes that Opposer's unpleaded common law mark KEEP IT SIMPLE SYRUP is in issue in this proceeding. An unpleaded claim may be tried by the consent of the parties. Fed. R. Civ. P. 15(b)(2). *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 314 (2016). In light of Applicant's concession of the claim based on common law rights, we find that the issue of likelihood of confusion based on the common law mark KEEP IT SIMPLE SYRUP was tried by the consent of the parties.

Fourth, Applicant concedes that Opposer has priority of use of the common law mark. Ms. Martinson testified that Opposer used its common law mark for simple syrup in March 2009, which is before the filing date of Applicant's involved application.⁷ "Simple syrup" is defined as "a thick, sweet liquid, usually prepared from water and sugar and used chiefly as a base for soda fountain flavors."⁸

Likelihood of Confusion

This proceeding involves two of Opposer's marks, its registered word and design mark and its common law word mark. We need only consider Opposer's mark which is closest to Applicant's mark, Opposer's common law mark KEEP IT SYMPLE

⁷ Martinson Test. at 7, 21 TTABVUE 8. Applicant response to Opposer's Interrog. No. 12 states that it first used its mark in October 2013, which is after the April 26, 2013 filing date of its application.

⁸ Dictionary.com definition based on the *Random House Dictionary* (2015) of "simple syrup," Exh. F, Applicant's notice of reliance, 22 TTABVUE 230-62.

SYRUP. If there is no likelihood of confusion between this mark and Applicant's mark, there will be no likelihood of confusion between Opposer's registered mark (which includes additional wording and a design element) and Applicant's mark.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Similarity of goods, trade channels and classes of purchasers, and consumer sophistication and care in purchasing.

Ms. Martinson, Opposer's owner, has characterized Opposer's goods sold in connection with the KEEP IT SIMPLE SYRUP mark as "simple syrup,"⁹ and Applicant's identification of goods is "syrups for making beverages; non-alcoholic drink and cocktail mixes." Inasmuch as Applicant's identification encompasses simple syrups, Applicant's goods are identical in part with Opposer's simple syrups.

Ms. Martinson has identified Opposer's trade channels as follows:

A. As far as the types of marketing, I've done extensive online promotion, as well as in-person promotion, and I've leveraged the media to the best of my abilities. It's a very

⁹ Martinson Test. at 7, 21 TTABVUE 8.

economical approach, leveraging the media, so I've been able to get my product into the news print media, I've been on television, the local ... CBS and NBC affiliates, and I've done trade shows, promotional trade shows for both trade audiences and consumer audiences.

Q. Do you use the Internet for marketing?

A. Yes.

Q. And what media on the Internet do you use?

A. Well, my own media use is I've got a Facebook site, Keep It Simple Syrup, I've got a Twitter account, a Pinterest account, an Instagram account. There are several -- the YouTube channel as well. There are videos of the television appearances that I've made.¹⁰

Opposer's goods can be found in the Virginia Alcoholic Beverage Control chain of state-run stores; and Opposer has participated in The Nightclub and Bar Trade Show in Las Vegas, Nevada.¹¹

Because Applicant's identification of goods is not restricted to any particular trade channels or purchasers, Applicant's trade channels encompass Opposer's trade channels.

As for classes of purchasers, both Opposer's and Applicant's purchasers comprise members of the general public.¹²

¹⁰ Martinson Test. at 10 – 11, 21 TTABVUE 11 – 12.

¹¹ Martinson Test. at 24 and 33, 21 TTABVUE 25 and 34.

¹² Ms. Martinson testified, "I would say my target market more than any other is the home cocktail maker, the non-professional bartender/mixologist, who is seeking to make high-quality cocktails at home." Martinson Test. at 9, 21 TTABVUE 10.

Further, simple syrups are relatively inexpensive, with Opposer's syrups selling for as little as \$10 per 375 milliliter bottle.¹³ There is no claim that purchasers are sophisticated. We therefore find that the goods are subject to impulse purchases.

Absence of Actual Confusion

The parties do not dispute that there have been no instances of actual confusion. The absence of any reported instances of confusion, however, is meaningful only if the record indicates appreciable and continuous use by the parties of their marks for a significant period of time in the same markets. *Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. North American Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) ("the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring"). The parties have coexisted only since 2013, a short period of time. Further, neither party has

¹³ Martinson Test. at 23, 21 TTABVUE 24.

shown significant sales during this time period. The *du Pont* factor concerning the absence of actual confusion is therefore neutral in our analysis.

Fame/strength of Opposer's mark.

Opposer maintains that its mark is “is suggestive in that it suggests that making complex mixed drinks will be facilitated by the product”; and that it is “famous in the beverage industry.”¹⁴ It suffices to say that we agree with Opposer that its mark is suggestive, but disagree with its contention that its mark is famous. It has been in use for a limited period, and its sales and advertising figures are moderate. It appears that Ms. Martinson is the only individual running Opposer’s business.¹⁵ We therefore accord Opposer’s mark the typical scope of protection to be accorded a suggestive mark.

Similarity of the marks.

We next consider the marks in their entirety as to appearance, sound, connotation and commercial impression, to determine the similarity or dissimilarity between them. *In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *du Pont*); *Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In comparing the

¹⁴ Applicant’s brief at 21, 32 TTABVUE 28.

¹⁵ Ms. Martinson testified at p. 6 of her testimony deposition, 21 TTABVUE 7:

Q. And since June of 2008, have you been engaged in advertising, marketing and selling products for Chef Sous?

A. Yes, quite heavily.

Q. And has anyone else been engaged in that project?

A. No. I’ve been running the endeavor myself.

marks, we are mindful that where, as here, the goods are identical in part, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *see also, In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010). “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.*, 101 USPQ2d at 1721 (citing *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, the analysis cannot be predicated on dissecting the marks into their various components. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). However, different features may be analyzed to determine whether the marks are similar. *Id.* (nothing improper in giving more or less weight to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety). The average purchaser normally retains a general rather than a specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

Opposer’s common law mark is KEEP IT SIMPLE SYRUP and Applicant’s standard character mark is NOT SO SIMPLE SYRUP. Turning first to the meaning

of these two marks, Applicant, in relevant part, states that NOT SO SIMPLE SYRUP “connotes complexity, or the absence of simplicity,” while “[t]he phrase KEEP IT SIMPLE SYRUP connotes a premium on simplicity, or ‘avoiding complication,’ and evokes ‘the familiar expression, Keep It Simple, Stupid’ (aka ‘KISS’).”¹⁶ Indeed, Opposer answered Applicant’s Interrogatory No. 2 as follows:

The suggestion of using the expression “Keep It Simple Syrup” came about during a conversation Ms. Martinson had with Stan and Nicole Schermerhorn of Lavender Fields Farm in Glen Allen, VA during late June 2008 about how to potentially commercialize an all-natural, herb-infused simple syrup. The theme of the conversation was avoiding complication. The idea for naming the product “Keep It Simple Syrup” was raised as a parody of the familiar expression, “Keep It Simple Stupid” (aka “KISS”). Following the conversation, Ms. Martinson searched the USPTO trademark database and subsequently filed an application for “Keep It Simple Syrup” on June 26, 2008.¹⁷

Opposer, however, maintains that:

In consideration of the purpose for which the products are principally offered, (i.e., to easily make complex mixed drinks at home) the connotation of each is similar, that is, the products are offered as tools to simplify a complicated task. Thus, KEEP IT SIMPLE SYRUP connotes making the task easy by using the product and NOT SO SIMPLE SYRUP connotes that the product is sufficient for the preparation of complex drinks. Even if a consumer concludes that the simplicity/non-simplicity suggested by the competing marks refers directly to the product, confusion is still likely because a consumer might reasonably conclude that one product is simply a higher

¹⁶ Applicant’s brief at 10, 33 TTABVUE 16, citing to 22 TTABVUE 211, Opposer’s Response to Applicant’s Interrogatory No. 2.

¹⁷ Applicant’s notice of reliance, Exh. E, 22 TTABVUE 208.

end version of the other, but both are from the same source.¹⁸

We agree with Applicant's interpretation of the marks, and that the two marks are antithetical in meaning. This is particularly true when Opposer encourages the consuming public to think of "keep it simple stupid" through its use of the term KISS, which appears throughout its webpages, labels and advertisements, in connection with its common law mark.¹⁹ As for Opposer's contention that a "consumer might reasonably conclude that one product is simply a higher end version of the other," neither party introduced evidence on this point.

We would be remiss to not comment on the fact that the term SIMPLE SYRUP appears in both marks, and, as discussed earlier in this decision, the term has a particular defined meaning relevant to the parties' goods. Applicant introduced evidence that various webpages for syrup products use the term SIMPLE SYRUP,²⁰ and the Examining Attorney asked for and obtained from Applicant a disclaimer of SIMPLE SYRUP on the ground that SIMPLE SYRUP is descriptive.²¹ Even if SIMPLE SYRUP is descriptive, and possibly generic, the mark must be considered as a whole.²² And, when SIMPLE SYRUP is considered in Applicant's and Opposer's marks, the marks take on very different meanings. Thus, despite the inclusion of

¹⁸ Opposer's brief at 17, 32 TTABVUE 24.

¹⁹ See, e.g., 21 TTABVUE 99, printout from Opposer's website ("[T]his unique product, appropriately named 'Keep It Simple Syrup®' (aka 'KISS'®)...Introducing KISS...").

²⁰ See Exhs. G – O to Applicant's notice of reliance, 22 TTABVUE 230-61.

²¹ 22 TTABVUE 74.

²² Opposer agrees with this contention, stating at page 18 of its brief, "But even if the term is generic and disclaimed, the mark must still be considered in its entirety and the Board may not ignore the presence or position of this term in competing marks." 32 TTABVUE 19.

SIMPLE SYRUP in the respective marks, when considered as a whole, the marks have different meanings and hence different commercial impressions. The differences in meaning and commercial impression of the marks outweigh any similarities in appearance or sound of the marks, including the “identical meter” noted by Opposer.

The parties both discuss *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435 (Fed. Cir. 2012) involving the marks “WAGGIN STRIPS” for pet treats and “BEGGIN’ STRIPS” for the same goods. There, the court did not agree with the applicant’s “attempts to distinguish the WAGGIN’ STRIPS and BEGGIN’ STRIPS marks by parsing their appearance, meaning, sound and impression.” *Id.* at 1440. The court remarked:

[T]he two marks have the same format, structure, and syntax. Both consist of two words. The second word in each mark is identical. The first word in each mark ends with GGIN’, the IN’ being the informal — IN’ suffix of the present participle form of the verb. While the two verbs are different, the verb in both marks consists of a single syllable, and the marks have generally similar pronunciations, cadences, and intonations. Beyond that, the verbs “wag” and “beg” both suggest dog behavior, and in particular both convey the excitement exhibited by dogs during feeding. Although the Board acknowledged that the mark BEGGIN’ STRIPS also suggests “bacon strips” to some consumers, the Board reasonably concluded that the implicit reference to “bacon” did not detract from the similarity of the two marks in both sound and meaning.

Id. The court’s decision was not limited to consideration of the format, structure and syntax of the marks, as Opposer would have us believe. Rather, the court also considered that “the verbs ‘wag’ and ‘beg’ both suggest dog behavior, and in particular both convey the excitement exhibited by dogs during feeding.” *Id.* Thus, *Midwestern*

Pet Foods is not persuasive of Opposer's position regarding the similarity of the marks factor.

Balancing the Factors

Having accorded due weight to the *du Pont* factors found in Opposer's favor, we find that the marks' dissimilarities are dispositive of a finding of no likelihood of confusion. That is, the dissimilarity in the meaning and commercial impressions conveyed by the marks outweighs our findings in favor of Opposer with respect to the other relevant *du Pont* factors. That one *du Pont* factor may be dispositive in a likelihood of confusion analysis is established, "especially when that single factor is the dissimilarity of the marks." *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998) (no likelihood of confusion between "Crystal Creek" mark for wine and "Cristal" marks for champagne). *See also Odom's Tennessee Pride Sausage, Inc. v. FF Acq., L.L.C.*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010) (Board did not err in basing its decision on the dissimilarity of the marks alone; "the visual distinctions between [the parties' differing 'farm boy' design trademarks] create unquestionably different commercial impressions"); *Kellogg Co. v. Pack-Em Enters., Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed.Cir.1991) ("We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive. ... 'each [of the thirteen elements] may from case to case play a dominant role.'").

Decision: The opposition is dismissed.