

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Shoichi Matsumoto¹
v.
David Beaulieu

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Opposition No. 91217806
to application Serial No. 86105136
—

Stephen L. Davis of Davis & Leonard LLP for Shoichi Matsumoto.

Jamie R. Shelden of Law Office of Jamie Shelden for David Beaulieu.

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Before Seeherman, Cataldo and Wolfson, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Shoichi Matsumoto (“Opposer”) has opposed the application of David Beaulieu (“Applicant”) to register NO RECIPE REQUIRED in standard characters as a mark for “providing an online website that provides cooking

¹ Opposer has been listed as “Shoichi (Marc) Matsumoto” in prior Board papers because this is the way he was listed in the cover sheet for the notice of opposition. However, in the notice of opposition itself he was identified as “Shoichi Matsumoto,” without any reference to what appears to be his nickname. Opposer also used “Shoichi Matsumoto” in the captions for various other filings, *see e.g.*, 11 TTABVUE, 13 TTABVUE. Opposer, in his declaration, refers to himself as “Shoichi Matsumoto.” In view thereof, we have amended Board records, including TTABVUE, to eliminate the reference to “Marc.”

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and culinary information.”² The ground is likelihood of confusion (Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d)). Opposer has alleged that he is the applicant for Application No. 86193477 for the mark NO RECIPES for “on-line journals, namely, blogs featuring recipes, cooking and travel information”; that Opposer has used this mark since as early as April 17, 2007; that action on his application has been suspended on the ground of likelihood of confusion with Applicant’s application; that Applicant’s mark is nearly identical to Opposer’s mark, and the parties’ services are offered to the same general class of customers; and that Applicant’s use of the mark NO RECIPE REQUIRED for his identified services is likely to cause confusion, mistake or deception that Applicant’s services are those of Opposer or are otherwise endorsed, sponsored or approved by Opposer. In his answer Applicant has admitted that Opposer is the owner of trademark Application No. 86193477 and that this application has been suspended in view of Applicant’s application, but has otherwise denied the salient allegations of the notice of opposition. Applicant also asserted what he characterized as affirmative defenses. Four of these defenses were stricken in the Board’s October 27, 2014 order, and will not be further addressed. The fifth defense, alleging there is no likelihood of confusion, is not in fact an affirmative defense. Because the Board viewed it as an amplification of Applicant’s denials, it was allowed to stand in that same Board order, and remains part of the pleading.

² Application Serial No. 86105136, filed October 30, 2013, asserting first use and first use in commerce on December 31, 2010.

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The parties stipulated that trial testimony could be submitted by affidavits or declarations, 11 TTABVUE, and to that end Opposer submitted his own declaration, with exhibits, at 13 TTABVUE, with Exhibit C to that declaration filed at both 14 TTABVUE and 15 TTABVUE. Applicant submitted his own declaration, with exhibits, at 16 TTABVUE, and Opposer submitted a declaration, with exhibits, in rebuttal, 17 TTABVUE. Thus, the record consists of the pleadings, the file of the opposed application, and the aforesaid declarations and exhibits.³ Both parties submitted briefs.⁴

Standing

In his answer, Applicant admitted that Opposer is the applicant for Application No. 86193477 for the mark NO RECIPES for “on-line journals, namely blogs featuring recipes, cooking and travel information,” and that Opposer has received a suspension notice for that application on the grounds of likelihood of confusion with Applicant’s application. ¶¶ 1 and 4, 4 TTABVUE. This is sufficient to show that Opposer has a real interest in this proceeding and a reasonable belief that Applicant’s application is causing Opposer damage. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270,

³ It is noted that both parties submitted portions of the file of the opposed application as exhibits to their testimony. This was unnecessary, since the application file is automatically of record by operation of Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a).

⁴ We note that in Opposer’s brief he listed the *du Pont* factors that he considered most relevant in terms of explaining why confusion was *not* likely. 18 TTABVUE 13. We can only assume that this was a typographical error by which this paragraph was copied from another brief, since the actual discussion of the factors consists of arguments as to why confusion *is* likely.

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111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953 (TTAB 2008) (standing found based on opposer's ownership of pending trademark application and Office action which raised defendant's application as a potential bar to registration).

Priority

There are two elements to proving the ground of likelihood of confusion: showing priority (unless the Opposer has an unchallenged registration, in which case priority is not in issue, *see King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974)), and likelihood of confusion. Opposer apparently believed that likelihood of confusion was not seriously in dispute, and concentrated the arguments in his brief on showing he has priority. However, Applicant did not even address whether Opposer had established prior rights in the mark; his brief was devoted to arguing the issue of likelihood of confusion:

In his brief, Opposer argues that the chief question presented in this action is which mark came first. However, the real issue is in fact, whether there is a likelihood of confusion between the parties' marks, particularly where the respective marks share only the single descriptive phrase 'no recipe(s).'

Applicant's brief, 19 TTABVUE 7. It would appear from Applicant's brief, and the fact that he did not challenge Opposer's claim of priority, that he has accepted that Opposer has prevailed in proving this element.

In any event, we find that Opposer has shown earlier use. In his application, Applicant asserted December 31, 2010 as his date of first use and first use of

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the mark in commerce for the services identified in his application. If Applicant wants to go behind this date, he must prove earlier use by clear and convincing evidence. *See Raintree Publishers, Inc. v. Berger*, 218 USPQ 272, 275 (TTAB 1983) (for a respondent to go behind its date of first use in the application for registration, its proofs must be clear and convincing). In his declaration Applicant states that in December 2009 he launched a YouTube channel to air cooking videos under the NO RECIPE REQUIRED trademark. ¶ 4, 16 TTABVUE 3, and the first video on his YouTube channel under the NO RECIPE REQUIRED trademark was uploaded on July 7, 2010. *Id.* However, Applicant is seeking to register his mark for the service of “providing an online website that provides cooking and culinary information,” not to register his mark for videos, so the date he uploaded his first video is not clear and convincing evidence of his use of the mark for the services identified in his application. Applicant further states that he purchased the NoRecipeRequired.com website in 2009. ¶ 2, *Id.* at 2. While Applicant testified that this website went “live” in mid-summer 2010, he also said that it was not officially launched until October 1, 2010. ¶ 7, *id.* at 3. Applicant submitted, as Exhibit D to his declaration, a copy of the home page as it appeared in October 2010. *Id.* at 11. This exhibit shows NO RECIPE REQUIRED in a straightforward type font, with the initial letters capitalized, at the top of a page that also shows a “Featured Recipe” and “Recent Recipes and Techniques,” both of which sections include Applicant’s comments. This is

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sufficient to show Applicant's use of his mark for the identified services, and we therefore consider Applicant to have shown first use of his mark for his services as of October 1, 2010.

In terms of Opposer's evidence of use of his mark prior to that date, Opposer has stated in his declaration that he has used his NO RECIPES mark conspicuously on an online blog that features recipes, and cooking and travel information (the services identified in his application) since April 17, 2007. ¶ 4, 13 TTABVUE 2. It was originally on a blogging platform called VOX, but in May 2007 he purchased the domain name norecipes.com. ¶ 6. *Id.* at 3. A page from the internet archive Wayback Machine shows the term "No Recipes" in a simple font with initial capital letters at the top of the page, and the website URL <http://www.norecipes.com>. Exhibit C, 14 TTABVUE 2. As with Applicant's mark, Opposer's mark has evolved over time, see Exhibit D, 13 TTABVUE at 16, showing the mark in all capital letters, with the "O" in "NO" being in the nature of a stylized plate with a spoon. Opposer has also submitted evidence supporting his declaration testimony of his first use. For example, Exhibit E, *id.* at 17, is a printout of the Google Analytics data for his website since May 2007, and Exhibit H to his rebuttal testimony declaration is a New York Daily News article from December 22, 2008 which reports on Opposer and his blog, norecipes.com. 17 TTABVUE 26-29.⁵

⁵ Opposer testified regarding this article in his testimony declaration for his case-in-chief.

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After reviewing the testimony and evidence, we find that Opposer has proved that he has priority with respect to his use of the mark NO RECIPES for on-line journals, namely, blogs featuring recipes, cooking and travel information.

This brings us to the second element of a likelihood of confusion claim, the issue of likelihood of confusion. Our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

The second factor enumerated in the *du Pont* case is the similarity or dissimilarity of the goods or services. In this case, during the parties' discovery conference, which was held in the presence of a Board interlocutory motions attorney, the parties stipulated that their services as currently identified in their respective applications are identical. *See* October 27, 2014 Board order, 6 TTABVUE 2. In addition, Opposer has testified that he uses his mark on an online blog that features recipes, and cooking and travel information, i.e., the same services identified in his application. Applicant's identified services of providing an "online website that provides cooking and culinary information" encompasses the services rendered by Opposer, and therefore the record shows that the parties' services are identical in part.

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The channels of trade and classes of customers are also the same. Both parties make their blogs available on the Internet, and their customers are anyone who is interested in cooking. These two *du Pont* factors favor a finding of likelihood of confusion.

The next *du Pont* factor we consider is the strength of Opposer's mark. In his brief, Applicant makes the argument that Opposer's mark is descriptive. 19 TTABVUE 16. However, Applicant never asserted this in his answer, or otherwise put Opposer on notice that he was attacking Opposer's mark on this basis. To assert that Opposer's mark is descriptive has serious repercussions in terms of Opposer's burden of proof, since Opposer would have had to prove that his mark is inherently distinctive, or prove the date when he acquired proprietary rights in an otherwise descriptive mark by showing that the claimed mark had acquired distinctiveness. *See Otto Roth & Company, Inc. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). Because Applicant did not timely raise this claim, we will not consider it. However, although we treat Opposer's mark as inherently distinctive, as discussed *infra*, we consider Applicant's evidence of third-party registrations and third-party use in determining the strength of Opposer's mark.

Opposer contends that his mark "has acquired some level of fame," and that "within its niche, the NO RECIPES mark appears to be famous." Brief, 18 TTABVUE 16. Opposer bases this rather tepidly asserted claim on the 27 million visits his website has received since 2007, as shown by the Google

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Analytics data in Exhibit E. Opposer has not explained how the Google Analytics data works, although we note that under “Sessions” is the number 26,180,787, which we presume is the basis for Opposer’s figure of 27 million visits. Opposer compares this to the Google Analytics’ statistic regarding Applicant’s website, which is that from October 1, 2010 through October 31, 2015, 2,013,855 individual people have visited Applicant’s website, many for multiple times, for a total of more than 2.5 million visits and more than 3.4 million page views. Exhibit F to Applicant’s testimony, 16 TTABVUE 4. Although Opposer’s website apparently had more views than Applicant’s, albeit over a longer period, merely comparing Opposer’s numbers with Applicant’s is not sufficient to give a context for these figures, or for us to determine whether the visits, particularly multiple visits by the same individuals, is extraordinarily large for a blog in this field, such that we could conclude that the mark is famous. *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002).

Moreover, these same Analytics show that only 55% of Opposer’s readers are from the United States, 13 TTABVUE 3, so that the raw numbers are not really indicative of the number of people in the United States who are familiar with Opposer’s mark. Opposer also testified that Google’s Search Console had, as of September 16, 2015, over 600,000 links back to his site. *Id.*⁶ Again, these

⁶ As with Google Analytics, Opposer has not given any information as to what “Google’s Search Console” is or how it works.

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raw numbers, without any context, do not prove that Opposer's mark is famous.

Nor are we persuaded by Opposer's evidence regarding the publicity his mark has received. Opposer has stated only that his blog was "mentioned" on the CBS Early Show on May 10, 2010 and on the Food Network's Chopped Program on June 28, 2011, and that his NO RECIPES blog was mentioned in six newspaper articles, only two of which he made of record.⁷

Fame, when it exists, plays a dominant role in determining likelihood of confusion. *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). It is the duty of a party asserting that its mark is famous to clearly prove it. *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). Opposer has not met that burden in this case.

The other side of the strength coin is Applicant's position that the third-party registrations and uses of RECIPE marks, including NO RECIPE marks, shows that Opposer has a weak mark that is entitled to a limited scope of protection, and that the differences in the marks are therefore sufficient to distinguish them. With respect to third-party registrations, Applicant has submitted as an exhibit to his testimony declaration eight third-party

⁷ Another article, submitted with his rebuttal testimony, is from a foreign publication and is in a foreign language; we cannot assume that U.S. consumers would have any familiarity with it.

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registration for marks that include the word RECIPES for services that may be generally characterized as providing online information in the field of cooking or food preparation.⁸ Exhibit I, 16 TTABVUE 25-36. *See*, for example, Registration No. 4497451 for SIMPLY RECIPES for on-line electronic newsletters delivered by e-mail in the field of recipes, ingredients and cooking information; on-line journals, namely, blogs featuring recipes, ingredients and cooking information; Registration No. 4596166 for COPYKAT RECIPES and Registration No. 3836073 for RECIPE BUZZ, owned by different entities, but both for on-line journals, namely, blogs featuring recipes and cooking advice; Registration No. 4396639 for STRESSFREE RECIPES and design for, *inter alia*, providing a website featuring educational and entertainment content in the fields of food, cooking, baking, entertaining, recipes, diet and nutrition. Third-party registrations may be used in the manner of dictionary definitions, to show that a term has a significance in a particular industry. *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006). In this case, the significance of RECIPES (or RECIPE) for such services is obvious. In addition, the registrations themselves show the descriptiveness of RECIPES because in all but one the word RECIPES has been disclaimed. Even in Registration No.

⁸ The exhibit also includes one application indicating that a notice of allowance issued on June 10, 2014; because it is a pending application it is evidence only of the fact that the application was filed.

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4596166, which issued under the provisions of Section 2(f), RECIPES was disclaimed.⁹

Certainly if the only similarity between Applicant's and Opposer's mark were the inclusion of the word RECIPES, it would be insufficient for us to find the marks to be confusingly similar. However, both marks include not just "recipe/recipes, but the phrase "no recipe(s)." To show that this phrase is itself weak, Applicant has also submitted with his testimony declaration evidence of third-party use of the entire phrase. Exhibit J, 16 TTABVUE 37-45. The webpage for Green Kitchen Stories has the caption "The No-Recipe Curry," and discusses the "favourite" dinner recipes in the author's family.¹⁰ *Id.* at 37. There is a cookbook offered through amazon.com called "The No Recipe Cookbook," with the subtitle, "A Beginner's Guide to the Art of Cooking," *id.* at 38, and a webpage advertising what appears to be a video series, "No Recipe Lifestyle." *Id.* at 39. A page on the Food Network website shows a recipe with the title, "No Recipe Recipe: Oven Fries." *Id.* at 40. And a page from the website of David Lebovitz has a listing for "No-Recipe Cherry Jam." *Id.* at 41. (Only a single page was submitted, so aside from four photographs, there is no information about this item.) There is a July 31, 2012 article entitled "No-Recipe Dishes: 20 Meals That Anyone Can Make," from an unidentified

⁹ The only exception is Registration No. 3573249 for the mark MYRECIPES; however, the Office does not require disclaimers of unitary terms.

¹⁰ The British spelling of "favourite" suggests that this website may originate from abroad. The date is given with the day first, i.e., "16 Mar '15," also suggesting a foreign publication. Because only the first page of the article was submitted, we cannot determine anything more about it.

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website; the article also has a slideshow of dishes which is captioned “No Recipe Recipes.” *Id.* at 42. The website for Y delicacies has a heading called “no recipe cooking,” *id.* at 43, and also of record is a blog with the name “The No Recipe Man.” *Id.* at 44.

The foregoing evidence shows that the term “no recipe” has a recognized meaning to those who are interested in cooking and recipes, and therefore we find that Opposer’s mark is highly suggestive for an online blog featuring recipes and cooking. As such, it is entitled to a very limited scope of protection. We recognize that there are similarities between Applicant’s mark and Opposer’s mark, in that Applicant’s mark begins with essentially the same two words that comprise Opposer’s mark (NO RECIPE REQUIRED and NO RECIPES), and we are certainly aware of the case law in which likelihood of confusion has been found when a junior user adopts the entirety of the senior user’s mark, and merely adds another word to it. However, given the very limited scope of protection to be accorded Opposer’s mark, we find that the addition of the word REQUIRED is sufficient in this case to distinguish the marks. While the inclusion of the additional term adds a small difference to the appearance and pronunciation of Applicant’s mark, that is not as significant to our finding as the difference in meaning and commercial impression. NO RECIPES, despite the evidence showing use of this term by many third parties, still has a small element of dissonance when used for a recipe blog. Applicant’s mark does not have this dissonance, it is a

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straightforward message to the consumers of his blog that he will provide culinary information that will not include or require the use of recipes. Although the differences are subtle, consumers who are aware of the various third-party uses of NO RECIPE/ NO RECIPES will distinguish the marks based on the additional word REQUIRED. Thus, given the limited scope of protection to be accorded Opposer's mark, we find that Applicant's mark, even for legally identical services, is not likely to cause confusion with Opposer's mark.

Decision: The opposition is dismissed.