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

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| Proceeding             | 91244593   |
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U.S. Trademark Application Serial No.: 87953971

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

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Cytozyme Laboratories, Inc.

Opposer,

v.

JH Biotech, Inc.

Applicant.

**CYTOZYME LABORATORIES, INC.'S  
REPLY BRIEF**

Opposition No. 91244593

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## INTRODUCTION

In its trial brief, JH Biotech, Inc. (“Applicant”), repeatedly, misconstrues evidence presented to the Board and failed to focus its analysis on the relevant and correct legal precedent. For example, Applicant claims in its argument related to similarity of the marks that dictionary definitions submitted by Cytozyme Laboratories, Inc. (“Opposer”) to the Board in support of the similarity of meaning of the SEED+ and SEEDUP marks at-issue in this dispute were “Kids” definitions. However, the submitted evidence clearly shows that this statement is incorrect. In its arguments regarding the similarity of trade channels and customers, Applicant largely fails to address the correct legal standard, i.e. whether the goods as listed in the SEED+ registration and SEEDUP applications contain any limitations as to the channels of trade or class of customer. Applicant claims that Opposer lacks an enforcement strategy because it refused to over-reach in its trademark enforcement or acted as a trademark bully. Applicant, repeatedly, attempts to claim that deposition testimony from a representative of Opposer is inconsistent with discovery evidence. However, a full review and analysis of such statements renders Applicant’s claims untrue. Finally, and perhaps most egregiously, Applicant improperly uses a claim of veracity of the testimony of a representative of Opposer to, minimally, imply that Opposer’s registration for SEED+ was maintained by fraud. However, such evidence is improper and the Board has previously refused to entertain such arguments when not properly pled (or, in this case, mentioned *at all*) in Defendant’s pleadings.

Rather than focus on the relevant case law and accurate facts specific to this case, Applicant chose to infect its brief with improper arguments and conclusions which all serve as attempts at red herrings and distractions for the Board. The Board should not entertain such efforts and should, instead, focus its analysis on the correct legal standards outlined by Opposer

in its opening brief and accord little, if any, weight to Applicant's improper arguments in its trial brief. Upon analysis, it is clear that the addressed *DuPont* factors either favor Opposer or are neutral. As such, the Board should sustain this Opposition in favor of Opposer.

## **I. ARGUMENT**

### **A. Response to Allegations in Statement of Facts**

In its Statement of Facts, Applicant JH Biotech alleges that Cytozyme's main brief "relies on multiple conclusory statements" and accuses Cytozyme of "embellish[ing]" the facts. 30 TTABVUE 9. However, it is JH Biotech that has taken the facts in this opposition out of context.

#### *1. Sales of Products Bearing the SEED+ Mark*

In its opening brief, Opposer stated that sales of products bearing the SEED+ mark "have steadily increased and have grown significantly in *recent* years." 29 TTABVUE 14 (emphasis added). Applicant disputes this claim by noting that products bearing the SEED+ mark were not sold in 2014, 2016, and 2017 and seemingly questioning the number of sales in 2015. 30 TTABVUE 9. However, Applicant ignores the facts presented by Opposer not convenient to it. Specifically, as noted in Opposer's response to ROG 10 propounded by Applicant, sales of products bearing the SEED+ mark in 2018 totaled \$25,280 and in 2019 at the time of the response to the ROG, sales totaled \$78,400. 21 TTABVUE 32. Such sales clearly show an increase in sales in recent years.

Applicant further attempts to allege that Opposer was misleading in its discovery responses regarding sales in "retail stores". 30 TTABVUE 11-12. In response to an Interrogatory asking if "SEED+ products [are] available in retail stores", Opposer objected to the terms "available" and "retail stores" as vague and undefined. 21 TTABVUE 47-48. Thus,

Cytozyme was unable to provide a “direct response” without further clarification on the Interrogatory as written by Applicant. 30 TTABVUE 11.

Moreover, during Mr. Baughman’s deposition, counsel for Applicant asked whether Mr. Baughman’s declaration contained evidence that products bearing the SEED+ mark were “sold in brick and mortar retail stores?” 19 TTABVUE 19:22-20:22. In response, Mr. Baughman stated that “Cytozyme sells to a distributor. We do not sell to brick and mortars directly. But I do know that the product is available in hundreds of retail locations.” *Id.* at 20. Applicant alleges that this answer is inconsistent with Opposer’s response to its interrogatory regarding “retail stores” above. 30 TTABVUE 12. However, that is untrue. Unlike in the interrogatory, Mr. Baughman understood what counsel for Applicant was questioning about when counsel asked about “brick and mortar retail stores” during Mr. Baughman’s deposition. Thus, Mr. Baughman as a representative of Opposer was able to give a more clear and detailed answer and should not be faulted for doing so.

## 2. *Advertising of Products Bearing the SEED+ Mark*

Applicant appears to question Opposer’s statement that Opposer advertises products bearing the SEED+ mark in multiple ways because Opposer provided one, exemplary year of advertising expenditures for products bearing the SEED+ mark in 2018. 30 TTABVUE 9. However, as explained in response to Applicant’s interrogatory on this issue, Cytozyme has not, *in the past*, regularly tracked advertising expenses from other expenses in the normal course of business. 21 TTABVUE 32-33. Moreover, Applicant sought advertising expenses for the past 18 years through this interrogatory. *Id.* at 32. Such a request was grossly overbroad and Opposer objected to the scope of the interrogatory and provided more recent advertising expenditures in an effort to cooperate during discovery. *Id.* at 32-33. Applicant did not question



this response, including when Applicant had an additional opportunity to do so in Applicant's failed motion to compel. 7 TTABVUE 2. Moreover, Applicant conveniently ignores that in 2018 Cytozyme *did* expend over \$450,000 on advertising for products bearing the SEED+ mark. 21 TTABVUE 32-33.

### 3. *Enforcement Efforts*

In its Opposition, Applicant alleges that Opposer has not “aggressively protect[ed]” its SEED+ mark because it has provided no previous evidence of other enforcement actions.<sup>1</sup> 30 TTABVUE 10. However, until this Opposition, there has not been a need for Opposer to enforce its SEED+ mark rights with the Board. Opposer responsibly enforces its trademark rights and the absence of SEED+ enforcement actions does not mean that Opposer has not “aggressively protected” its trademark rights. Opposer should not be faulted, as Applicant suggests, for not over-enforcing its rights in the SEED+ mark and overreaching its valid trademark rights with unnecessary or frivolous lawsuits to create the illusion of what Applicant perceives is “aggressive[] protect[ion]” of trademark rights.

Additionally, Applicant cites a list of third-party marks about which it questioned Cytozyme during discovery, including, SEED RANCH, SEEDMAXX, SEEDLINGERS, SEED BOOSTER, SEEDNET, SEEDWORX, and SEED COAT. 30 TTAB VUE 9. Applicant correctly notes that Opposer has provided no evidence it contacted any of these third-parties or filed an enforcement actions with the Board in relation to these registered marks during prosecution. *Id.* at 10. Applicant implies the absence of these action signals Opposer's failure to properly enforce its SEED+ mark. *Id.* However, that is untrue. Opposer has not contacted these third parties because Opposer simply does not believe that these third-party marks are

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<sup>1</sup> Opposer is actively involved in enforcement efforts and monitoring related to its trademarks. 22 TTABVUE 13:15-25.

confusingly similar to SEED+. Opposer admits that the referenced third-party marks contain the word SEED. However, the other words in the marks such as COAT and RANCH have no similarity of meaning to “+”. *Compare* 12 TTABVUE 114-115 with 25 TTABVUE 150 and 670. Thus, there has been no need for Opposer to contact these third parties.

As to the Agri Life BIOMANTRA SEED+ product that Applicant heavily relies on throughout its opposition, as clearly shown by the evidence submitted by Opposer, Agri Life has removed the “+” from the BIOMANTRA SEED+ product as shown through the advertisements on its own website. *See* 25 TTABVUE 12, for example. Further, Applicant claims that the “BIOMANTRA SEED+ product has been in use since at least as early as 2016 as evidenced by its listing on the OMRI . . . register.” 30 TTABVUE 10. However, at most, the registration from the OMRI shows that Agri Life had developed a product titled BIOMANTRA SEED+ by 2016. The registration from OMRI does not show actual use or sales in the market in 2016.

#### 4. *Mr. Baughman’s Testimony*

In a thinly veiled attempt to bring arguments before the Board that Applicant failed to allege in its defenses or in a counterclaim, Applicant alleges that “Mr. Baughman’s testimony declaration should be of concern to the Board” because Applicant alleges that “[t]he evidence establishes SEED+ was not used to sell a product for at least three of the five years” subject to a declaration of use signed by Mr. Baughman. 30 TTABVUE 12-13. In another space in its fact section, Applicant alleges that “the SEED+ brand was not used in 2014, 2016 and 2017”. *Id.* at 12. However, Applicant admits in other parts of its brief that products bearing the SEED+ mark were simply not sold during those years. *See id.* at 9, 15. Moreover, as explained by Mr. Baughman during his deposition and as shown on page 11 of Applicant’s brief (although not highlighted by Applicant for the Board’s attention), Opposer “was engaged in development

activities and using the mark with an eye towards developing and growing the business” when asked about the years without sales of products bearing the SEED+ mark. 30 TTABVUE 16.

In any case, such evidence is not properly submitted to the Board in the context of the claims and defenses listed in the complaint and answer. *See generally* 1 TTABVUE, 4 TTABVUE. Applicant has not alleged claims of fraud or invalidity of the SEED+ mark or asserted a counterclaim (unsupported as they would be). As such, Applicant may not attack the validity of the SEED+ mark through this thinly veiled “veracity” argument. *See* TMEP 311.02(b)(1) (“The Board will not entertain a defense that attacks the validity of a registration pleaded by a plaintiff unless the defendant timely files a counterclaim or a separate petition to cancel the registration.”). Because these arguments have not been properly submitted, these arguments should not be considered by the Board in its analysis.

#### **B. Opposer Has Met its Burden Under the DuPont Factors**

As detailed below and in Opposer’s opening brief, Opposer has shown that there is a strong likelihood of confusion between Opposer’s SEED+ mark and Applicant’s SEEDUP mark. None of the arguments propounded by Applicant change this result.

The Parties to this dispute agree that the factors outlined in *In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973) are considered by the Board in deciding whether there is a likelihood of confusion. However, Applicant ignores the legion of legal precedent noting that the two most important factors in an Opposition before the board are similarity of the marks and relatedness of the goods. *See Han Beauty Inc. v. Alberto Culver Co.*, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). This is

not surprising as Applicant has admitted that the relatedness of the goods factor weighs in favor of Opposer and Applicant relies on, minimally, misleading arguments in its analysis of the similarity of the marks. 30 TTABVUE 18-22. In any case, on balance, the *DuPont* factors favor a finding of a likelihood of confusion between Opposer's SEED+ and Applicant's SEEDUP mark.<sup>2</sup>

*1. The SEED+ and SEEDUP Marks Are Similar*

Throughout its argument, Applicant implies that Opposer focused its argument regarding similarity of the marks on the common term of SEED. However, Opposer's arguments in favor of similarity of the marks primarily focused on the similar meanings of the two marks and that both the SEED+ and SEEDUP marks mean an increase in seed growth. The Parties agree that the Board should consider the marks as a whole and, as shown in the evidence provided by Opposer, taken as a whole, both the similarity in appearance of SEED+ and SEEDUP as well as the similarity of meaning of the two marks prove that the marks are similar. Opposer does not, and has not, argued that the marks are confusingly similar *only* because of the common portion (SEED) in both marks.

Part of Applicant's brief focuses on the phonetic dissimilarity of pronunciation of SEED+ and SEEDUP. *See* 30 TTABVUE 20. However, a party need not show that the sound, appearance, *and* meaning of two marks are the same. Instead, any similarities in the sound, appearance, *or* meaning may be sufficient to indicate a likelihood of confusion. *See In re White Swan, Ltd.*, 8 USPQ2D 1534, 1535 (TTAB 1988). Thus, the fact that SEEDUP and SEED+ (including its phonetic equivalent SEEDPLUS) are not pronounced exactly the same is not

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<sup>2</sup> Applicant does not dispute that Opposer has standing or priority. Thus, there is no dispute as to these issues.

dispositive of this issue when there are similarities in appearance (*see* 29 TTABVUE 20) and meaning (*see id.* at 20-21) between the marks.

In showing the similarity of meaning between “+” and its phonetic equivalent “PLUS” and “UP”, Opposer submitted dictionary definitions of the terms PLUS and UP. In its brief, Applicant argued that

[a]n inspection of Opposer’s dictionary definition of ‘PLUS’ . . . includes a highlighted passage in a section having the heading entitled ‘Kids Definition of *plus*’. It is hard to imagine a ‘kid’ as an average reasonably prudent buyer of Opposer’s product given the nature of the product and its high purchase price and therefore how a ‘kid’ interprets the meaning of ‘PLUS’ as a part of Opposer’s mark is not relevant. Opposer’s use of dictionary terms without taking into account the commercial impression on an ordinary prospective buyer is precisely what the anti-dissection rule teach against.

*See* 30 TTABVUE 21. However, Applicant’s statement is, minimally, misleading to the Board. Specifically, Opposer’s submitted definition of “PLUS” includes references to “increase” three (3) different times: in the general (ostensibly “adult”) definition of PLUS (12 TTABVUE 115), in the list of synonyms (again, also ostensibly for “adults”) for PLUS (*id.*), and in the Kids definition of PLUS (*id.* at 117). If a person were to only read Applicant’s above argument, the reader would assume Opposer did not submit any additional definitions of the term PLUS other than the “kids” definition. That is simply incorrect.<sup>3</sup> Thus, Opposer did provide evidence of how an *adult* reasonably prudent purchaser may interpret the term “PLUS”.

Next, Applicant seems to argue that there is no evidence that the public equates the symbol “+” with the written term “PLUS”. 30 TTABVUE 21-22. Thus, Applicant claims that Opposer has not submitted any evidence “to equate the visual ‘+’ with ‘UP’” or that both terms

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<sup>3</sup> Even if Applicant’s argument was correct, if “increase” is a common enough interpretation of “plus” that a child would understand, it is reasonable to believe an adult can easily make that interpretation as well.

mean “increase” as alleged by Opposer in its opening brief. *Id.* at 22. Tellingly, Applicant cites no case authority which states that a party is unable to use dictionary definitions for the phonetic equivalents of symbols, such as “PLUS” for the “+” symbol. In fact, Courts and the Board regularly reviews definitions for phonetic equivalents in practice. *See In re Galbreath*, 34 Fed. Appx. 757, 758 (Fed. Cir. 2002) (“As an initial matter, SAFE-T-BUCKLE is the phonetic equivalent of ‘safety buckle,’ . . . The board found that the examining attorney properly consulted dictionary definitions of ‘safety’ and ‘buckle’ . . . .”); *Nightlight Sys. v. Nitelites Franchise Sys.*, 2007 U.S. Dist. LEXIS 111239, at \*26 (N.D. Ga. Jan. 4, 2007) (“The defendants, on the other hand, have presented evidence that dictionaries define the phonetic equivalent of ‘nite lite,’ ‘nightlight’ as . . . .”); *see also* Exhibit 1 attached hereto *Bernatello’s Pizza, Inc. v. Colmont Restaurant Group, LLC*, No. 91241107, 36 TTABVUE 22 (TTAB, Dec. 16, 2020) (“In other words, LOTZZA, the phonetic equivalent of ‘lotsa,’ also has the same meaning, which the Oxford University Press Online Dictionary defines as ‘lots of’”). Moreover, Applicant has repeatedly admitted *in its own brief* that the phonetic equivalent of the symbol “+” is “PLUS”.<sup>4</sup> *See* 30 TTABVUE 7 (“the symbol ‘+’ which has the phonetic equivalent ‘PLUS’”); at 8 (“‘+’ or its phonetic equivalent ‘PLUS’”); at 20 (“the phonetic equivalent of the symbol ‘+’ is PLUS . . . Opposer’s mark is pronounced SEED PLUS”). Accordingly, there is no dispute that the symbol “+” is interpreted to mean “PLUS” and, thus, Opposer *has* submitted competent evidence of how a reasonably prudent (adult) purchaser would be confused by the respective marks.

For these reasons and all the reasons outlined in Opposer’s opening brief (29 TTABVUE 19-21), Opposer has provided sufficient evidence showing that the SEED+ and SEEDUP marks are similar.

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<sup>4</sup> To the extent there is any question on this issue, the listed definitions of “plus” submitted by Opposer include a definition for “plus sign”. 12 TTABVUE 114.

2. *Applicant Admits that the Goods as Listed for the SEEDUP and SEED+ Marks are Similar*

In its brief, Applicant admits that the goods, as listed in the respective registration and application for the SEED+ and SEEDUP marks, “are similar, and this factor weighs in favor of Opposer.” 30 TTABVUE 22. However, the analysis of this factor does not end with Applicant’s concession. The extent and degree of similarity of the marks necessary to find a likelihood of confusion exists is lessened where the goods as listed in the relevant application and registration are overlapping or closely similar. *See* TMEP 1207.01(b) (“Where the goods or services are identical or virtually identical, the degree of similarity between the marks necessary to support a determination that confusion is likely declines.”).

Here, Applicant admits that the listed goods are similar, but does not state that the goods are highly similar as argued by Opposer in its opening brief. *See* 29 TTABVUE 21-23. Opposer provided clear evidence that the goods, as listed, are intended to achieve the same results (to improve plant growth), perform the same function (to help crops increase growth), and are, thus, likely to be encountered by the same customers. *Id.* at 22-23. As Applicant has provided no evidence to rebut these claims, Opposer requests that the Board find that not only does this factor weigh in favor of Opposer, but also that the degree of similarity necessary between the SEED+ and SEEDUP marks to find a likelihood of confusion is lessened since the goods, as listed in the respective registration and application, are highly similar.

3. *Applicant Fails to Address the Appropriate Standard When Discussing Trade Channels*

In its brief, Applicant does not address, let alone deny, that there are no limitations in trade channels in the listed goods for either the SEED+ or the SEEDUP marks. Instead, Applicant spends the entire section attempting to attack the veracity of Opposer’s declarant, Eric Baughman. 30 TTABVUE 23. For the reasons noted above in Opposer’s response to the

allegations contained in Applicant's fact section, there are no inconsistencies in Mr. Baughman's testimony and Opposer's discovery responses. *See supra* at \*9-10. Moreover, Applicant's unsupported and inflammatory statement that "Mr. Baughman signed a false statement under penalty of perjury" is not true and should not be considered by the Board for the reasons identified above. As Applicant has not disputed that there are no limitations on the channels of trade in the recitation of goods for either the SEED+ or the SEEDUP marks and for the reasons outlined in Opposer's opening brief (29 TTABVUE 23-24), this factor weighs in favor of Opposer.

4. *Applicant Improperly Attempts to Limit the Class of Customer*

As with the channels of trade above, Applicant fails to properly address whether there are any limitations as to the class of customer in the listed goods for the SEED+ and SEEDUP marks. In an attempt to bolster its arguments, Applicant attempts to define a typical purchaser in the agriculture, horticulture, and forestry markets as listed in the goods for the SEED+ mark. 30 TTABVUE 25. Initially, Applicant attempts to limit members of agriculture, horticulture, and forestry to only large-scale businesses. *Id.* However, Applicant has provided no evidence (other than its attempts to use Opposer's current sales below) to limit the size of customers in the agriculture, horticulture, and forestry markets. If Opposer intended to limit its sales of products bearing the SEED+ mark to only large-sized members of the agriculture, horticulture, and forestry sectors, Opposer would have added such a limitation in its description of goods. Instead, the list of goods for the products bearing the SEED+ mark do not contain any size limitations and a limitation to the agriculture, horticulture, and forestry market does not inherently create a size limitation.



In further support, Applicant cites to evidence submitted by and testimony from Mr. Baughman as to the current purchasers of Opposer's current formulation of products bearing the SEED+ mark. *Id.* at 25-26. However, this is not the appropriate test. As currently formulated, SEED+ products are likely purchased by larger members of the agriculture, horticulture, and forestry markets. However, as noted above, there is no limitation on size in the listed goods for the SEED+ mark. Moreover, there is no limitation in the listed goods prohibiting Opposer from reformulating the product and selling it in smaller sizes to other members of the agriculture, horticulture, and forestry markets.

Even if, for argument's sake, the current purchasers of products bearing the SEED+ mark are "sophisticated" there are no limitations in the list of goods prohibiting Opposer from selling to other less "sophisticated" members of the agriculture, horticulture, and forestry markets in the future. Additionally, for arguments sake, even if the goods as listed in the SEED+ mark registration *were* limited to sophisticated and/or large members of the agriculture, horticulture, and forestry markets, the listed goods for the SEEDUP mark contain no limitation excluding such purchasers.

For these reasons and the reasons outlined in Opposer's opening brief (29 TTABVue 23-25), there remains a high likelihood of confusion between products bearing the SEED+ and SEEDUP marks and this factor weighs in favor of Opposer.

5. *Third-Party Registrations and Sales Do Not Diminish the Strength of Opposer's Mark*

Applicant argues that the SEED+ mark is conceptually weak citing to various third-party use evidence. However, the Board should reject this argument because the cited third-party marks are not confusingly similar to the SEED+ mark. In particular, under the sixth *DuPont* factor, the Board may consider third-party use evidence of similar marks to determine if it

“show[s] that consumers have been educated to distinguish between different marks on the basis of *minute distinctions*.” *Juice Generation, Inc. v. GS Enters. LLC*, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (emphasis added). As explained below, the problem with Applicant’s evidence of third-party use is that the relied-upon marks are far afield from the SEED+ mark. *See Scarves by Vera, Inc. v. Todo Imps., Ltd.*, 192 USPQ 289, 294 (2d Cir. 1976) (“Moreover, all but one of the third-party registrations cited by the district court contained combinations of words, rather than the word ‘Vera’ alone, and several were registered for entirely unrelated products . . .”).

First, Applicant improperly dissects the SEED+ mark into component parts, an action Applicant faulted Opposer for in its argument related to similarity of the marks. Applicant spends large amounts of time and space detailing third-party marks that contain either “SEED” or “+” or its phonetic equivalent “PLUS”. 30 TTABVUE 27-32. However, other than one example which is addressed separately below, Applicant has failed to provide the Board with any evidence of third-party marks that contain both SEED and + (or PLUS) or that convey the same meaning as the SEED+ mark.

In regard to the term “SEED,” Applicant relies on the following registered third-party marks: SEEDLINGERS, SMART SEED, EZ SEED, SEEDCOAT, and SEEDMAXX. 30 TTABVUE 26-33. Contrary to showing that consumers have been educated to distinguish between different marks on the basis of “minute distinctions,” these registered “SEED” marks show just the opposite, namely, that consumers have not been educated in this regard. For example, the registered mark SMART SEED, cited by Applicant, when compared to Opposer’s SEED+ mark is vastly different, including the leading/dominant term SMART<sup>5</sup> and the complete

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<sup>5</sup> Compare 25 TTABVUE 714-721 (Merriam Webster definition for SMART) and 25 TTABVUE 23-30 (Merriam Webster definition for SEED). *See also* 25 TTABVUE 351-355

absence of the “+” after the term “SEED.” Critically, Applicant has submitted no evidence whatsoever to show that the differences between SMART SEED and SEED+ are “minute” because, in fact, they are not. Moreover, Applicant has not met its burden to show that that Opposer’s goods and the goods recited in the SMART SEED registration are similar. In fact, Opposer submits that they are not. The above analysis holds true for all the registered “SEED” marks cited by Applicant.

In regard to the term “+”, Applicant argues that “the ‘+’ or the phonetic sound ‘PLUS’, is also found in multiple applications *filed for class 001 goods*.” 30 TTABVUE 31 (emphasis added). However, Applicant’s argument is improper because the Board has long held that the International Classification of the goods at issue is irrelevant in determining whether the goods are related. *See Jean Patou Inc. v. Theon Inc.*, 29 USPQ2d 1771, 1773 (Fed. Cir. 1993) (finding that the classification of services by the USPTO is a purely administrative determination and has no bearing on the issue of likelihood of confusion.); *see also* Trademark Rule 2.85(f), 37 CFR § 2.85(f) (“Classification schedules shall not limit or extend the applicant’s rights.”). To be clear, Applicant has provided no evidence that the goods in the third party “+” marks are related. For example, the goods for HYDRATE PLUS NF are for

Surfactant in the nature of a non-foaming wetting agent that reduces surface tension of water and chemicals; Soil surfactant used to promote uniform movement of water in soil; Surfactant for use with fertilizers, herbicides, water, insecticides, fungicides, pesticides; Agricultural chemicals, namely, surfactants, wetting agents and drift control agents; Wetting agents sprayed on turf to help it absorb moisture; Wetting agent, penetrant and surfactant for use in connection with fertilizers, herbicides, water, insecticides, fungicides, pesticides; Soil wetting agents and penetrants; Soil drift control chemical agents, namely, soil penetrants.

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(Merriam Webster definition for LINGER), 25 TTABVUE 212-214 (Merriam Webster definition for EZ), 25 TTABVUE 149-154 (Merriam Webster definition for COAT).

23 TTABVUE 43. There is simply no evidence that the above goods are related to the Opposer's goods. Moreover, *Plus Prods. v. Natural Organics, Inc.*, 204 USPQ 773, 780 (TTAB 1979), cited by Applicant, is distinguishable because in that case the Board found the term "PLUS" was laudatory. There is no such allegation here. Accordingly, *Plus Prods.* is distinguishable.

In addition, Applicant was able to unearth one third-party use of a mark with SEED+, namely, the BIOMANTRA SEED+<sup>6</sup> mark. 30 TTABVUE 29-30. Putting aside Opposer's evidence that the manufacturer of the BIOMANTRA SEED product has removed the "+" from its product as shown on the face of the advertising materials submitted by Opposer (25 TTABVUE 12-21), there are several flaws in Applicant's arguments. First, at most, Applicant is able to show that it was able to purchase one (1) product bearing the BIOMANTRA SEED+ mark one (1) time. *See* 20 TTABVUE 41; *compare* Applicant's other submitted evidence related to the Biomantra product (20 TTABVUE 39 (Packing Slip listing product as "Bio Mantra Seed 10 oz Bag"); 20 TTABVUE 28, 31 (advertising the product as "10 oz BioMantra+ Seed")). Applicant has not submitted any evidence regarding the market share of this product. *See Scarves by Vera*, 192 USPQ at 294 ("The significance of third-party trademarks depends wholly upon their usage. Defendant introduced no evidence that these trademarks . . . were well promoted or that they were recognized by consumers . . . The record does not contain any evidence to support the claim that plaintiff's trademark was weakened by uses of similar marks by third parties."); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 73 USPQ2d 1689 (Fed. Cir. 2005) (stating similar). Moreover, the BIOMANTRA SEED+ mark itself is not similar to the SEED+ mark primarily due to the use of the highly fanciful and coined

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<sup>6</sup> As used by Applicant in its briefing, this product appears to be always referenced using BIOMANTRA SEED+ and not as merely SEED+.

term BIOMANTRA. Thus, any weight accorded by the Board to Applicant's arguments related to the BIOMANTRA SEED+ mark should be minimal.

Based upon the above, Applicant has not shown that the SEED+ mark is weak. Accordingly, there exists a likelihood of confusion. However, even if the Board were to make a finding that the SEED+ mark is weak, the SEED+ mark is still entitled to protection against the registration of a similar mark for closely related goods or services. *See* T.M.E.P. § 1207.01(b)(ix); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 USPQ 108, 109 (CCPA 1974); *see also* Exhibit 2 attached hereto, *In re Livetrands Design Group, LLC*, No. 88320133, 11 TTABVUE 8 (TTAB Feb. 8, 2021) (citing *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010)) (not precedential) (refusing to register applicant's mark and holding that opposer's mark is "suggestive and somewhat inherently weak and there is some evidence of commercial weakness. Nonetheless, [opposer's] mark is registered on the Principal Register without resort to a claim of acquired distinctiveness . . . and thus is presumed inherently distinctive. Taken together, we find the cited mark is entitled to a somewhat narrower scope of protection than that accorded to a strong and arbitrary mark. Nonetheless, even weak marks are entitled to protection against confusion.").

6. *The Actual Confusion Factor is Neutral*

While actual confusion is a listed *DuPont* factor, the actual test remains whether there is a *likelihood* of confusion. In particular, evidence of actual confusion is many times difficult to obtain, especially when the timeframe for concurrent use of marks is short. *See In re i.am.symbolic, llc*, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007); *see also* Exhibit 3 attached hereto, *Hale v. Go Pro Workouts, LLC*, No. 91211810, 15 TTABVUE 16 (TTAB Nov. 18, 2014) (not

precedential) (three years is a relatively short period of time to provide a meaningful opportunity for confusion to occur, even where the parties both offer their goods via the Internet).

Accordingly, the lack of evidence of actual confusion is not determinative of whether there is a likelihood of confusion.

7. *The Extent of Potential Confusion is Not De Minimis*

Here, Applicant claims that any confusion is de minimis as Opposer uses a third-party to market its product and provides technical information to customers about its product. 30 TTABVUE 33. However, as discussed extensively above in response to the third and fourth factors (*supra* at \*14-16), the recitation of goods for the SEED+ mark does not limit Opposer's methods of sales. Thus, the ability of Opposer to potentially negate any confusion as the product is currently sold does not mean that the risk of confusion is de minimis.

8. *Opposer Does Not Lack an Enforcement Strategy*

Lastly, Applicant argues that Opposer lacks an enforcement strategy because it has not filed proceedings against third-parties. As noted above (*supra* at \*8), Opposer should not be penalized for not over-reaching and filing unnecessary litigation. Moreover, as shown on the advertisements and webpages for Agri Life, the manufacturer of the BIOMANTRA SEED product, the "+" has been removed from that product. *See also J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition*, (5th Ed. 2020), § 11:91 ("In general a trademark owner has no obligation to sue until 'the likelihood of confusion looms large.' The trademark owner is entirely justified in waiting to charge ahead with expensive litigation until it is seen if an infringing fledgling business or product line will survive, let alone significantly impact on plaintiff's trademark strength."); 19 TTABVUE 23:15-24:2 ("Are you aware that Agri Life LLC markets a product called BioMantra SEED+ for crop fertilizers and soil amendments? A. I've

become aware of it through this process and through some of the interrogatories, and we have had direct discussions on taking similar steps and actions to protect our registered trademark with that entity. Q. So you've had discussions with the owners of Agri Life LLC regarding – A. We have not had direct discussions with them; we've had direct discussions internally with our counsel on the matter.”).

## **II. CONCLUSION**

Pursuant to the above arguments and those contained in Opposer's opening trial brief, Opposer has shown that the *DuPont* factors clearly weigh in favor of Opposer and that there is a strong likelihood of confusion between the SEED+ and SEEDUP marks. Accordingly, the Board should not allow the SEEDUP application to mature to registration.

DATED this 11th day of March, 2021.

THORPE NORTH & WESTERN, LLP

/s/ Peter M. de Jonge  
Peter M. de Jonge  
Attorney for Opposer, Cytozyme Laboratories, Inc.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing  
**CYTOZYME LABORATORIES, INC.'S REPLY BRIEF** was served upon the  
following party by the methods indicated below:

Ralph D. Chabot Law Office of  
Ralph D. Chabot  
3210 E. Ponderosa Dr., Ste. 4  
Camarillo, CA 93010  
rdc@chabotlaw.com

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| <input checked="" type="checkbox"/> | Electronic Mail                 |
| <input checked="" type="checkbox"/> | United States Mail, First Class |
| <input type="checkbox"/>            | Overnight Delivery              |
| <input type="checkbox"/>            | USPTO Filing                    |

DATED this 11th day of March, 2021.

/s/ Kaelynn Moultrie  
Kaelynn Moultrie



Peter M. de Jonge  
THORPE NORTH & WESTERN, LLP  
175 South Main Street, Suite 900  
Salt Lake City, UT 84111  
Telephone: (801) 566-6633  
Facsimile: (801) 566-0750

Attorney for Cytozyme Laboratories, Inc.  
Opposed Mark: SEEDUP  
U.S. Trademark Application Serial No.: 87953971

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

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| <p>Cytozyme Laboratories, Inc.</p> <p>Opposer,</p> <p>v.</p> <p>JH Biotech, Inc.</p> <p>Applicant.</p> | <p><b>APPENDIX TO CYTOZYME<br/>LABORATORIES, INC.'S REPLY<br/>BRIEF – RESPONSE TO<br/>APPLICANT'S STATEMENT OF<br/>OBJECTIONS</b></p> <p>Opposition No. 91244593</p> |
|--|--|

Opposer Cytozyme Laboratories, Inc. ("Opposer") responds to Applicant JH Biotech, Inc.'s ("Applicant") appended Statement of Objections.

Applicant previously filed a Motion to Strike Opposer's Notice of Reliance. *See generally* 26 TTABVUE. Opposer responded to Applicant's motion to strike (*see generally* 27 TTABVUE) and the Board deferred decision on the motion until review of the final trial briefs. 28 TTABVUE 2. Accordingly, Opposer renews and incorporates its Opposition to Applicant's Motion to Strike its Rebuttal Notice of Reliance.

In general, “[a]s to the testimony itself, the Board generally does not strike testimony taken in accordance with the applicable rules on the basis of substantive objections; rather, the Board considers such objections when evaluating the probative value of the testimony at final hearing.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1047 (TTAB 2017) (internal quotations removed). “[T]he Board is capable of assessing the proper evidentiary weight to be accorded the testimony and evidence, taking into account the imperfections surrounding the admissibility of such testimony and evidence.” *Id.* (quoting *United States Playing Card Co. v. Harbro, LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006)).

Moreover, “[p]arties are discouraged from filing objections that are not outcome-determinative or that do not have an effect on either their own or their adversary’s position.” TBMP § 707.03(a). Throughout its objections, Applicant failed to explain how or why the statements or evidence it objected to are outcome determinative.<sup>7</sup> Opposer submits that Applicant cannot do so. For example, Applicant objects to Paragraphs 12, 14, 15, 17, and 18 of Mr. Baughman’s Declaration as well as Exhibits 4-6 attached to Opposer’s Notice of Reliance. *See* 30 TTABVUE 40-46. However, this testimony and these exhibits were offered in support of Opposer’s argument that the goods as listed in the SEED+ and SEEDUP applications were related. Applicant conceded that the goods were “similar” in its trial brief and that the relatedness of the goods factor weighs in favor of Opposer. 30 TTABVUE 22. Thus, the outcome of that factor in the likelihood of confusion analysis has already been determined.

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<sup>7</sup> In contrast, Opposer submitted *one* objection as to the sufficiency of a Wikipedia dictionary definition. 29 TTABVUE 30-31. As the only dictionary evidence submitted by Applicant to rebut dictionary evidence from Merriam Webster submitted by Opposer, if Opposer is successful in its objection and the Board does not consider Applicant’s Wikipedia dictionary definition, such action *could* be outcome determinative of the meaning of the SEED+ and SEEDUP marks under the similarity of the marks factor.

Applicant further objects to Paragraphs 18-22 of Mr. Baughman's Declaration. When used by Opposer in its briefs, the statements or arguments made which were supported by these paragraphs were also supported by other evidence which Applicant did *not* object to. As Applicant has failed to explain how any of its objections will be outcome determinative, the Board should dedicate little consideration or weight to these objections.

Applicant also lodged objections to certain evidence submitted by Opposer that was not relied upon by Opposer in its opening or reply trial briefs. As such, Opposer submits that the Board need not address Applicant's objections to that evidence. *See* TBMP § 707.01 ("The Board is entitled to weigh the evidence and has the discretion on how it considers evidentiary objections, especially in cases where numerous objections have been lodged or the objections are not outcome determinative."). Nevertheless, Opposer has provided responsive arguments to each of Applicant's objections below, including as to evidence ultimately not relied upon by Opposer in its arguments.

## **I. BAUGHMAN DECLARATION**

### **A. Paragraphs 5-6, 20-23**

In the section titled "[s]tatements of opinion, improper expert opinion, lacking foundation, speculation, assumes facts not in evidence", Applicant quotes six (6) paragraphs from Mr. Baughman's Declaration (Paragraphs 5-6, 20-23). However, other than a feeble and insufficient attempt under the quotation of Paragraph 5<sup>8</sup>, Applicant fails to actually make any arguments or explain why any of these paragraphs are improper or objectionable. Opposer and the Board are left guessing as to why Applicant believes each of these paragraphs are objectionable or what relief Applicant seeks by objecting to these paragraphs. Accordingly,

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<sup>8</sup> Under its quotation of Paragraph 5, Applicant states that "Mr. Baughman has not been disclosed to JHB as an expert witness" with no other explanation or analysis. 30 TTABVUE 38.

Opposer submits that it should not be required to guess as to Applicant's arguments and is unable to fully and accurately respond to Applicant's "objections".

Nevertheless, Fed. R. Evid. 602 states that "[a] witness may testify to a matter only if evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter." Here, Mr. Baughman disclosed in his declaration that he is the Chief Executive Officer of Opposer, has worked for Opposer in various roles for 21 years, and has vast knowledge of Opposer's business and of the agriculture industry as learned through his multiple roles and numerous years of work with Opposer. 13 TTABVUE 2, ¶¶ 1-2. Paragraphs 5-6 and 20-23 of Mr. Baughman's Declaration discuss general background regarding products that increase plant growth and nutrition, product registrations for products bearing the SEED+ mark, strategic marketing agreements with third parties, sales of products bearing the SEED+ mark, his own review of an offer for sale of a product bearing Applicant's SEEDUP mark on a third-party website, and explain why Opposer was concerned about confusion between the SEED+ and SEEDUP marks. *Id.* at 6. Mr. Baughman learned information related to all but one of these topics through his numerous years of work with Opposer and in his role as CEO. Mr. Baughman learned information regarding sales of products bearing the SEEDUP mark from the website listed in Paragraph 22 of his Declaration. Mr. Baughman has personal knowledge regarding each of these matters. Thus, the Board should consider these statements as used in Opposer's arguments.

#### **B. Paragraph 10**

In Paragraph 10 of his Declaration, Mr. Baughman describes Exhibit 6 as copies of webpages from Opposer's own website. 13 TTABVUE 4. In total, Exhibit 6 contains approximately 28 pages of excerpts from certain websites. *Id.* at 21-48. As shown by URL

listings in the bottom corner of each page, approximately ten (10) of these pages are from the website vlsci.com and approximately 18 of the pages are from the website cytozymeag.com. *Id.* As noted by Mr. Baughman during his deposition, Opposer is the owner of the cytozymeag.com website. 16 TTABVUE 10. However, Mr. Baughman mistakenly included several webpages from the vlsci.com website in this exhibit. Nevertheless, the Board should not exclude consideration of the vlsci.com webpages of the exhibit, if needed, as the webpages are self-authenticating documents.

### **C. Paragraphs 12-13**

Paragraphs 12 and 13 of the Baughman declaration attach documents produced by *Applicant* during discovery.<sup>9</sup> As Opposer does not rely on Paragraph 13 in its opening trial brief or in its reply brief, the Board need not address Applicant's objections to this Paragraph.

Paragraph 12 of Mr. Baughman's Declaration and the attached exhibits were offered to support Opposer's claim that the goods as listed in the SEED+ and SEEDUP registration and application, respectively, are related. As Applicant has conceded that the goods are similar, the Board need not address Opposer's objection to evidence that will not be outcome determinative. Nevertheless, as the documents were produced by Applicant during discovery, there is little, if any, doubt as to whether they are authentic. Applicant's arguments suggesting that the documents it produced during discovery are somehow not authentic are not well taken.

### **D. Paragraphs 14-16 and 19**

Applicant objects that Mr. Baughman is testifying as an expert witness rather than as a fact witness in paragraphs 14-16 and 19. 30 TTABVUE 42-43, 45. However, instead of expert

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<sup>9</sup> As these exhibits in the Baughman declaration overlap with the exhibits Applicant objects to in Opposer's Notice of Reliance (12 TTABVUE 60-79), Opposer incorporates its response here in response to Applicant's objections to the Notice of Reliance. 30 TTABVUE 46-47.

testimony, Mr. Baughman is providing an explanation of why Opposer chose to file this Opposition against Applicant. Such analysis is not improper expert testimony. Moreover, even if the Board finds Applicant's bare bones assertions of expert testimony persuasive, as noted above, the Board generally does not strike such testimony and, instead, considers the objection when assigning value to the testimony. *See Tao Licensing*, 125 USPQ2d at 1047.

#### **E. Paragraphs 17 and 18**

Applicant made similar arguments in its trial brief to the objections to Paragraphs 17-18 it submits to the Board. Opposer responded to those arguments above in its reply brief and incorporates similar arguments below.

Through its objections to Paragraphs 17 and 18 of Mr. Baughman's Declaration, Applicant attempts to paint Mr. Baughman's testimony as inconsistent with Opposer's discovery responses. *See* 30 TTABVue 43-45. In Interrogatory 17 directed to Opposer regarding "channels of trade", Applicant failed to define "channels of trade" either in its Interrogatory or after receiving an objection from Opposer that "channels of trade" was vague and undefined as used by Applicant in its Interrogatory. Opposer responded to the Interrogatory to the best of its ability without a definition for the term. In fact, Opposer provided a list of "channels" through which it sells and advertises products bearing the SEED+ mark.

Now, Applicant seeks to fault Mr. Baughman for using the same or similar term in his own language. Mr. Baughman understands what *he* means by "channels of trade" as used in his Declaration. In contrast, neither Opposer nor Mr. Baughman are required to insert their own interpretation of a vague or undefined term used in Applicant's discovery requests.

Additionally, Applicant's Interrogatory 17 is directed to the "channels of trade" currently used by Opposer to sell products bearing the SEED+ mark. In contrast, Paragraph 17 of Mr.

Baughman's Declaration discusses channels listed in the SEED+ registration and those generally used by participants in the market. Applicant makes an apples-to-oranges comparison and Mr. Baughman should not be prohibited from using his own language in his testimony because Applicant failed to define the terms in its Interrogatories appropriately.

Similarly, in Interrogatory 18, Applicant overreaches with this objection. As detailed in Opposer's Reply Brief above (*see supra* at \*6-7), in response to an Interrogatory asking if "SEED+ products [are] available in retail stores", Opposer objected to the terms "available" and "retail stores" as vague and undefined. 21 TTABVUE 47-48. After objecting, Opposer provided the best response it could without further clarification on the Interrogatory as written by Applicant. Through this objection, Applicant attempts to prevent Mr. Baughman from using his own language and the term "brick and mortar retail stores" which he *does* have an understanding of. *See* 19 TTABVUE 16. Mr. Baughman should not be prevented from presenting a list of "channels" through which Opposer sells products because Applicant failed to provide a definition for a vague and undefined term in its own Interrogatories.

## **II. CONCLUSION**

For all the reasons cited above, the Board should not strike any of the evidence objected to by Applicant and should, instead, review each piece of evidence and give consideration and weight to each piece of evidence as the Board sees fit.

# **Exhibit 1**



This Opinion is not a  
Precedent of the TTAB

Mailed: December 16, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

—  
Trademark Trial and Appeal Board  
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*Bernatello's Pizza, Inc.*  
*v.*  
*Colmont Restaurant Group, LLC*  
—

Opposition No. 91241107  
—

Laura M. Davis of DeWitt LLP and Anthony J. Bourget of Bourget Law, S.C.  
for Bernatello's Pizza, Inc.

Eric R. Harlan and William E. Carlson of Shapiro Sher Guinot & Sandler, P.A.  
for Colmont Restaurant Group, LLC.

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Before Kuhlke, Adlin and Dunn,  
Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Colmont Restaurant Group, LLC seeks registration of LOTSA STONE FIRED PIZZA, in standard characters (STONE FIRED PIZZA disclaimed), for “restaurant services; restaurant carry out services; restaurants featuring delivery services; fast casual restaurants” in International Class 43.<sup>1</sup> In its notice of

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<sup>1</sup> Application Serial No. 87435377, filed May 3, 2017 under Section 1(a) of the Trademark Act based on first use dates of May 5, 2016.

opposition, Opposer Bernatello's Pizza, Inc. alleges prior use and registration of LOTZZA MOTZZA for "frozen pizza"<sup>2</sup> and LOTZZA HOTZZA for "pizza."<sup>3</sup> Opposer's LOTZZA MOTZZA registration is over five years old. Opposer also alleges prior common law use of, and ownership of a pending application to register, LOTZZA MOTZZA in standard characters for "restaurant services; restaurant services, namely, providing of food and beverages for consumption on and off the premises; quick service restaurant services; restaurant services provided by mobile food kiosks; concession stands."<sup>4</sup> As grounds for opposition, Opposer alleges that use of Applicant's mark would be likely to cause confusion with Opposer's marks. In its answer, Applicant denies the salient allegations in the notice of opposition, and asserts affirmative defenses which it did not pursue or prove at trial, and which are therefore waived. *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. Am. Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012).

## **I. The Record and Evidentiary Objections**

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant's involved application. In addition, Opposer introduced:

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<sup>2</sup> Registration No. 4225275, issued October 16, 2012; Section 8 Affidavit accepted, Section 15 Affidavit acknowledged.

<sup>3</sup> Registration No. 5073411, issued November 1, 2016.

<sup>4</sup> Application Serial No. 87916171, filed May 10, 2018 under Section 1(a) of the Act, based on first use dates of November 1, 2013.

Notice of Reliance on third-party registrations, several of Applicant's uninvolved applications and Internet printouts ("Opp. NOR 1"). 15 TTABVUE.<sup>5</sup>

NOR on portions of its discovery depositions of: Applicant under Fed. R. Civ. P. 30(b)(6) ("DiGangi Disc. Tr."), Michael Salandra, Applicant's founder ("Salandra Disc. Tr.") and Deborah Billings ("Billings Disc. Tr."), and the exhibits thereto; and portions of Applicant's responses to Opposer's discovery requests ("Opp. NOR 2").<sup>6</sup> 16 TTABVUE.

Testimony declaration of Chad D. Schultz, its Chief Operating Officer ("COO"), and the exhibits thereto ("Schultz Dec."). 18 TTABVUE.

Rebuttal NOR on portions of Mr. Schultz's discovery deposition<sup>7</sup> and an Internet printout ("Opp. Reb. NOR"). 28 TTABVUE.

Applicant introduced:

NOR on third-party registrations, Opposer's and its predecessor's registrations, both pleaded and unpleaded, and Internet printouts ("App. NOR 1"). 22 TTABVUE.

NOR on portions of its discovery deposition of Mr. Schultz ("Schultz Disc. Tr."), and portions of Opposer's responses to Applicant's discovery requests ("App. NOR 2"). 23 TTABVUE.

Testimony declaration of Anthony DiGangi, Applicant's Chief Operating Officer, and the exhibits thereto ("DiGangi Dec."). 25 TTABVUE.

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<sup>5</sup> Citations to the record reference TTABVUE, the Board's online docketing system. The number preceding "TTABVUE" corresponds to the docket entry number(s), and any number(s) following "TTABVUE" refer to the page number(s) of the docket entry where the cited materials appear.

<sup>6</sup> Opp. NOR 2 includes documents Applicant produced in response to Opposer's interrogatories. *See* Trademark Rule 2.120(k)(3)(i).

<sup>7</sup> Opposer introduced these portions of Mr. Schultz's deposition "so that Applicant's designations [of other portions of the deposition] are not misleading." 28 TTABVUE 2.

Testimony declaration of Mr. Salandra, and the exhibits thereto (“Salandra Dec.”). 27 TTABVUE.

Opposer’s hearsay objections to paragraphs 5-7 and 9 of Mr. Salandra’s declaration are overruled. As Opposer acknowledges, under Fed. R. Civ. P. 801(c), hearsay is a statement “the declarant does not make while testifying at the current trial or hearing.” Here, while Mr. Salandra mentions “discussions” he had with Mr. Manarelli in paragraph 5, Mr. Salandra is the declarant, not Mr. Manarelli. Mr. Salandra does not specify or quote any particular statements by Mr. Manarelli. Elsewhere in paragraph 5 and the other passages Opposer objects to, Mr. Salandra testifies about knowledge he acquired, and about Mr. Manarelli, Victor Corbi and Mr. Corbi’s grandfather, but nowhere does Mr. Salandra state that he acquired the knowledge from any particular statement(s) made by Manarelli or the Corbis. We hasten to add that even if we had sustained Opposer’s hearsay objections, our ultimate decision in this case would not change.

Opposer’s objection to a portion of paragraph 29 in Mr. DiGangi’s declaration is also overruled, as Mr. DiGangi has the requisite “personal knowledge” under Fed. R. Evid. 602. Indeed, in paragraph 1 of his declaration, Mr. DiGangi testifies that the entire declaration is “based on my personal knowledge,” and in paragraph 2 Mr. DiGangi testifies that he is Applicant’s Chief Operating Officer, and thus obviously well-situated to personally know the origins of Applicant’s former name. For example, Mr. DiGangi specifically testifies that he recalled “seeing a photograph of a young Victor Corbi wearing a T-shirt with the phrase ‘Lotsa Mozza’ printed on it.” 25

TTABVUE 7 (DiGangi Dec. ¶ 29). Again, even if we had sustained this objection, our ultimate decision in this case would not change.

## II. Relevant Facts

Opposer “is a family owned and operated business that manufacturers and distributes frozen pizza brands ....” 18 TTABVUE 3 (Schultz Dec. ¶ 2). Its frozen pizza is sold to “grocery stores, convenience stores, taverns, schools, club stores, food service providers [and] fundraising organizations.” *Id.* at 4 (Schultz Dec. ¶ 5).

Opposer acquired Five Star Foods, Inc. (“Five Star”) in 2011 or 2012, “including the business, goodwill and branding of LOTZZA MOTZZA frozen pizza.” *Id.* (Schultz Dec. ¶ 7); 23 TTABVUE 135 (Opposer’s Response to Interrogatory No. 2).<sup>8</sup> In 2012, Opposer “launched a new variety of frozen pizza branded as LOTZA MOTZZA BREW PUB. This product was designed with unique ingredients and packaging distinct from its competitors to target consumers in the marketplace for a ‘super-premium’ frozen pizza”:



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<sup>8</sup> Mr. Schultz testified that Opposer acquired Five Star in 2011, but Opposer’s interrogatory response indicates that the acquisition was in 2012.

18 TTABVUE 4, 17 (Schultz Dec. ¶ 10 and Ex. A).

One of LOTZA MOTZZA frozen pizza's "features" is "over ½ lb. of award winning real premium Wisconsin Mozzarella cheese." *Id.* at 5 (Schultz Dec. ¶ 13). As Mr. Schultz put it during his discovery deposition, "**LOTZZA MOTZZA is our brand that screams what it is, lots of Wisconsin cheese** because we put over a half pound of cheese on that product. So that's positioned as our heavy premium, heavy cheese branded pizza." 23 TTABVUE 17 (Schultz Disc. Tr. at 11) (emphasis added). Mr. Schultz described BREW PUB as one of Opposer's "umbrella brands." *Id.*

The product is successful, as production increased from 9.3 million units in 2016 to 14.7 million in 2019, leading to Opposer expanding its pizza manufacturing facility, increasing capacity to approximately 35 million units (presumably per year). 18 TTABVUE 5-6 (Schultz Dec. ¶¶ 14-15). Opposer "launched its LOTZZA HOTZZA brand of frozen pizza" in February 2016. *Id.* at 5 (Schultz Dec. ¶ 17).

Opposer's promotional expenses for the LOTZZA MOTZZA brand are fairly significant, totaling more than \$9 million since 2012. 18 TTABVUE 13-14 (Schultz Dec. ¶ 31). Perhaps not surprisingly, its sales are also fairly significant, increasing steadily from \$12.8 million in 2013 to \$64.7 million in 2019, and totaling "approximately \$305 million." *Id.* at 14 (Schultz Dec. ¶ 33).

Opposer has also provided what it refers to as "restaurant services" since October 2012.<sup>9</sup> *Id.* at 7 (Schultz Dec. ¶ 20). However, Opposer does not operate a traditional

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<sup>9</sup> Mr. Schultz testified that Five Star began using LOTZZA MOTZZA for restaurant services in 1996, and recalled "seeing cooked LOTZZA MOTZZA pizza on the menu at a tavern in

restaurant and its “restaurant services” are at best atypical. Specifically, while Opposer claims to provide “restaurant services” at stadiums, bars, fairs, festivals, charity events and elsewhere, these locations offer LOTZZA MOTZZA pizzas “cooked from frozen.” *Id.* at 8, 16 (Schultz Dec. ¶¶ 23, 37). For example, during his discovery deposition Mr. Schultz testified that LOTZZA MOTZZA frozen pizzas are delivered to bars and taverns frozen, and the bars and taverns heat the pizzas before serving them. 23 TTABVUE 22 (Schultz Disc. Tr. 34) (stating “[t]hey always serve it fresh and hot ....”). The following photos showing Opposer’s “restaurant services” at Target Center in Minneapolis are typical of other venues where Opposer claims to provide “restaurant services”:



Green Bay, Wisconsin, in approximately 2011.” 18 TTABVUE 7 (Schultz Dec. ¶ 21). The record does not reveal whether Five Star continuously used the mark between 1996 and 2011, or establish that the mark was not abandoned for “restaurant services” sometime before 2011. The specific nature of Five Star’s “restaurant services” is unclear from the record, other than Mr. Schultz’s testimony about seeing “cooked from frozen” pizza on a tavern’s menu.

18 TTABVUE 53, 56 (Schultz Dec. Ex. F-1, F-4). The Target Center or its food service contractor provides the kiosk, not Opposer. 23 TTABVUE 40 (Schultz Disc. Tr. 59). In describing one of Opposer’s “restaurants” in a stadium, perhaps the one depicted above on the right or one like it, Mr. Schultz testified: “And we had a restaurant kiosk looking decked out, you know, LOTZZA MOTZZA with the BREW PUB sub-brand to it. You know, those are restaurants to us, also, so – To me, it’s a gray area a little bit on – If you are serving fresh pizza hot, you know, is that a restaurant?” 23 TTABVUE 27 (Schultz Disc. Tr. 44).<sup>10</sup>

Sometimes, these types of venues may provide tables and chairs for customers eating Opposer’s frozen pizza after it is heated:



18 TTABVUE 62 (Schultz Dec. Ex. G-6); 23 TTABVUE 30 (Schultz Disc. Tr. 47) (“The tables are provided by the Resch Center. The logo’ing is provided by us.”). The pizza is not heated by Opposer’s employees, however. Rather, “[t]he food service company

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<sup>10</sup> While Mr. Schultz sometimes uses the word “fresh,” his testimony and the record as a whole make clear that he is using the term to describe Opposer’s frozen pizzas which are heated before being served.



would provide the people and operate it.” 23 TTABVUE 29 (Schultz Disc. Tr. 46). Opposer believes that these types of “restaurants” are not open every day, or on a set schedule, but rather only when there is an event at the venue. *Id.* at 30-32 (Schultz Disc. Tr. 47-49). Sometimes tables and chairs are also provided for customers of Opposer’s “restaurant trailers,” though it is not clear who provides the tables or chairs:



*Id.* at 71 (Schultz Dec. Ex. L-2). Mr. Schultz conceded that Opposer does not operate restaurants, but rather sells pizza to what it refers to as “restaurants”:

Q With respect to the restaurants and taverns and bars and so forth where Bernatello's ships and sells frozen pizza, does it consider that aspect of its business providing restaurant services under the LOTZZA MOTZZA brand?

A Yes.

Q Why is that?

A Because they serve pizza hot and fresh, you know, under the LOTZZA MOTZZA brand as restaurants do.

*Id.* at 41-43 (Schultz Disc. Tr. 63-65).

Mr. Schultz explained that Opposer acquired the LOTZZA MOTZZA brand in part because of “the way it rolls off your tongue. That’s why our owners in the acquisition of Five Star loved that brand, really wanted to take it to another level, which we did.” 23 TTABVUE 24 (Schultz Disc. Tr. 41). Mr. Schultz continued: “LOTZZA HOTZZA was just a little bit of a takeoff of that in a variety of offering of, just like it says – **LOTZZA HOTZZA means hot pizza ... spicy hot.**” *Id.* (emphasis added). All LOTZZA HOTZZA pizza packages also bear the LOTZZA MOTZZA mark, and all LOTZZA MOTZZA pizza packages also bear the BREW PUB mark. *Id.* at 25 (Schultz Disc. Tr. 42).

Applicant was formed in early 2015, following years of discussions between its founder Mr. Salandra, whose prior work experience was in professional staffing, and Joe Manarelli, whose prior experience was in restaurants and food trucks. 27 TTABVUE 2 (Salandra Dec. ¶¶ 3-4). Mr. Manarelli owned an Italian restaurant, as well as food trucks “outfitted to rapidly cook wood fired pizza,” and suggested that Mr. Salandra consider “a restaurant venture that prepared and served fast-cooked

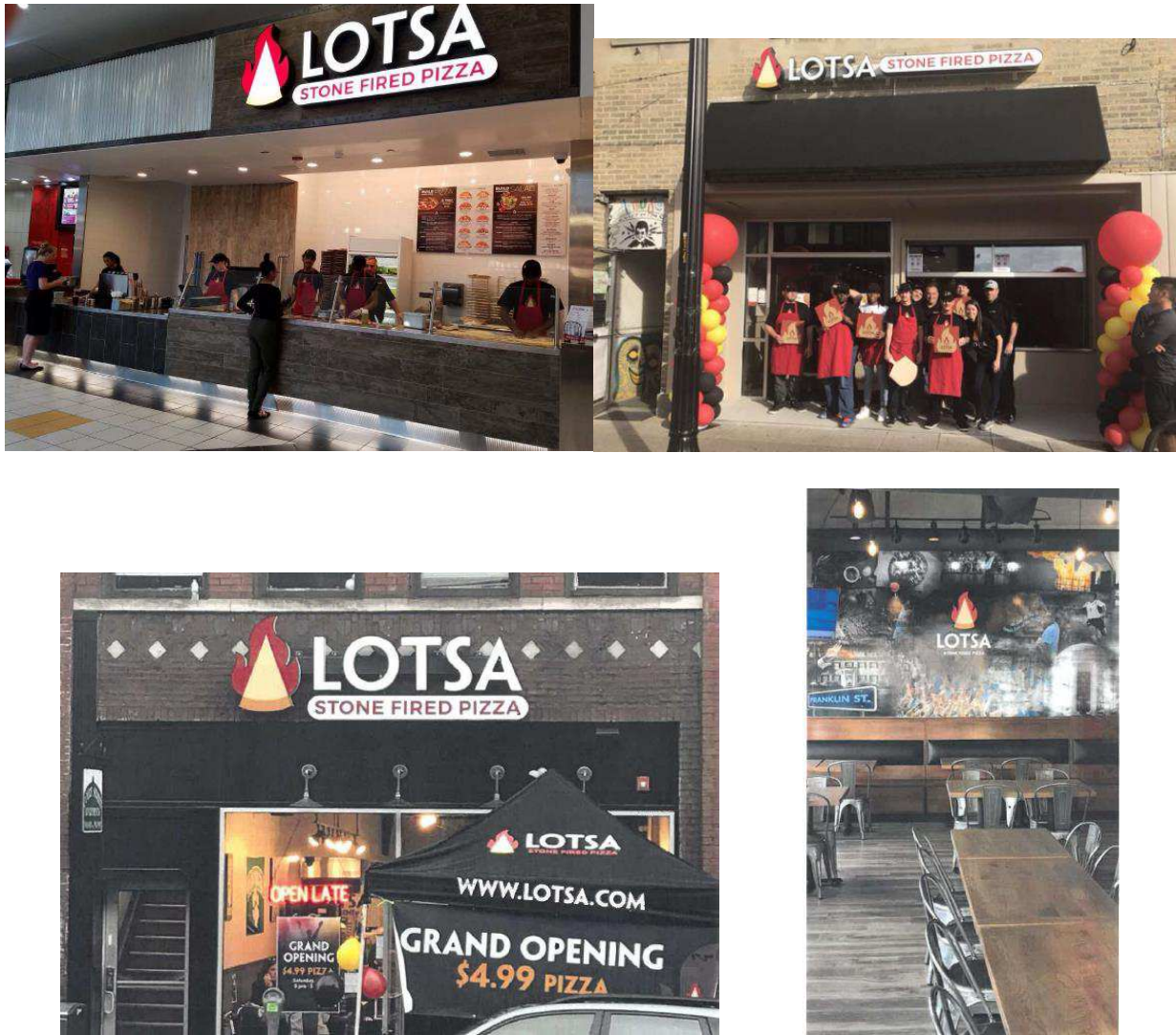
fresh pizzas to its customers in a restaurant setting.” *Id.* at 2-3 (Salandra Dec. ¶¶ 4-5). Mr. Manarelli also suggested that the business be called Lotsa Mozza, which was an expression his friend Victor Corbi’s grandfather used “when describing how much cheese the Corbi family business used.” *Id.* at 3 (Salandra Dec. ¶ 5).

In May 2015 Victor Corbi assigned to Applicant: the LOTSA MOZZA mark; the domain name “lotsamozza.com;” social media accounts named LOTSA MOZZA with Facebook, Twitter, Instagram, Pinterest, Tumblr and Vine; and several LOTSA/LOTSAMOZZA hashtags. *Id.* at 3-4, 10-12 (Salandra Dec. ¶ 9 and Ex. B). Applicant filed applications to register the LOTSA MOZZA mark about two months later. *Id.* at 3 (Salandra Dec. ¶ 8). However, after the applications were opposed by a third-party and Opposer objected to Applicant’s use of the mark, Mr. Salandra “decided to abandon the use of the name ‘Lotsa Mozza.’” *Id.* at 4 (Salandra Dec. ¶ 11). According to Mr. Salandra, “only the Morgantown, West Virginia location was ever branded as ‘Lotsa Mozza,’ which branding was discontinued.” *Id.* (Salandra Dec. ¶ 12).

Applicant then began using its new, involved mark LOTSA STONE FIRED PIZZA at its Morgantown restaurant in May 2016. 25 TTABVue 5 (DiGangi Dec. ¶ 19). Applicant currently operates a number of pizza restaurants under that name, most or all of which are in “college towns” or locations, including: Annapolis and College Park, Maryland; Pittsburgh (Oakland and Southside), Pennsylvania; Morgantown, West Virginia; West Lafayette, Indiana; and Tallahassee, Florida. *Id.* at 2 (DiGangi Dec. ¶ 5); 32 TTABVue. Applicant previously operated several additional

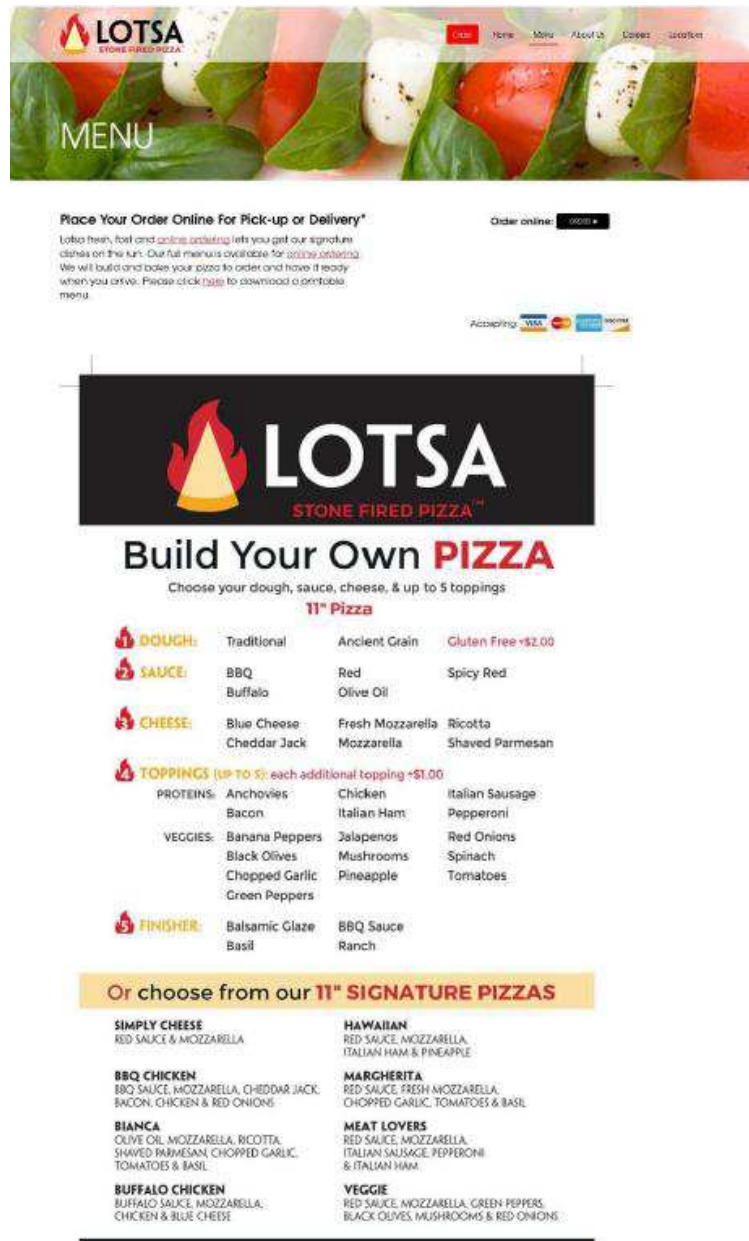


restaurants, including in the Midwest where Opposer is based, such as the Madison, Wisconsin location. Some of Applicant's restaurants are depicted below:



*Id.* at 20, 22, 23, 26 (DiGangi Dec. Exs. A, B).

Applicant's restaurants offer both "signature pizzas" and "build-your-own" pizzas, as shown in its menu:



*Id.* at 17 (DiGangi Dec. Ex. A). LOTSA STONE FIRED PIZZA is a “fast casual” concept – “build-your-own” customers line up at a counter, choose from among types of dough, cheese and sauce, and pick toppings, and then wait while their pizza is “fast cooked on a flame-heated rotating pizza stone,” in two and one-half minutes. 25 TTABVUE 3-5 (DiGangi Dec. ¶¶ 8-12, 20). Applicant’s pizza is only available at its

restaurants (dine-in or carryout); it is not available through grocery stores or third-parties, and is not sold frozen. *Id.* at 4 (DiGangi Dec. ¶¶ 14-15).

Like Opposer, Applicant has been fairly successful. It has spent over \$700,000 promoting its restaurant services since May 2016, and its sales have exceeded \$19 million since that time. *Id.* at 8 (DiGangi Dec. ¶¶ 33-34).

As indicated, Applicant's predecessor used the mark LOTSA MOZZA, and Applicant still owns the "lotsamozza.com" domain name, which currently redirects to Applicant's website at "lotsa.com." *Id.* at 7 (DiGangi Dec. ¶¶ 29-30).

Opposer became aware of Applicant when Applicant opened its Madison location "under Lotsa Motsa (sic)."<sup>11</sup> 23 TTABVue 50 (Schultz Disc. Tr. 89). After Opposer objected to Applicant's use of the term, Applicant began using LOTSA alone or LOTSA STONE FIRED PIZZA rather than LOTSA MOZZA. *Id.*

However, Opposer also objects to these uses of LOTSA. According to Mr. Schultz, "[e]verything that we have seen in our dispute is because of the use of the word *lotsa*. And the l-o-t-s-a versus the L-O-T-Z-Z-A – lotsa, l-o-t-s-a, LOTZZA, L-O-T-Z-Z-A, the phonetics are identical, and that's the issue we have." *Id.*

### III. Opposer's Section 2(d) Claim

Before addressing whether the parties' marks are likely to be confused, we must first consider whether Opposer is entitled to bring this proceeding. If it is we must

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<sup>11</sup> While the transcript of Mr. Schultz's deposition spells the name "Lotsa Motsa," we assume this is a mistaken reference to the LOTSA MOZZA mark used by Applicant's predecessor and Applicant itself for a period of time. To the extent Mr. Schultz's testimony that the Madison location was "under Lotsa Motsa (sic)" may be inconsistent with Mr. Salandra's testimony that the Morgantown location was the only location "branded" as LOTSA MOZZA, that is irrelevant to our ultimate decision.

then consider whether priority is at issue and if it is which party has it. *See* 15 U.S.C. §§ 1052(d) and 1063.

**A. Opposer's Entitlement to Bring a Statutory Cause of Action<sup>12</sup>**

Entitlement to a statutory cause of action is a threshold issue in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at \*3 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)). A party in the position of plaintiff may oppose registration of a mark when such opposition is within its zone of interests and the plaintiff has a belief in damage that is proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*6-7 (Fed. Cir. 2020) (holding that the test in *Lexmark* is met by demonstrating a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark, which demonstrates damage proximately caused by registration of the mark). Here, Opposer's pleaded registrations, which it properly introduced into the record, 1 TTABVue 8-12, establish that Opposer is entitled to oppose registration of Applicant's mark on the ground of likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

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<sup>12</sup> Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable.

## **B. Priority**

Because Applicant has not counterclaimed to cancel Opposer's pleaded registrations, priority is not at issue with respect to the marks and goods identified therein. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Furthermore, to the extent that Opposer's distribution of frozen pizza to stadiums, taverns and other venues for resale, and its pizza sales from trailers, may constitute "restaurant services," Opposer has established prior common law use of its mark for those services. In fact, it has provided these services since 2012, and Applicant does not claim first use of its involved mark until 2016. 18 TTABVue 7 (Schultz Dec. ¶ 20). Applicant does not dispute Opposer's priority.

## **C. Will the Marks and Sources of the Goods Be Confused?**

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. We consider the likelihood of confusion factors about which there



is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

We focus here on Opposer's pleaded registration for the mark LOTZZA MOTZZA in standard characters for frozen pizza, as well as Opposer's common law rights in LOTZZA MOTZZA for its "restaurant services." If we find confusion likely between Applicant's involved mark and Opposer's LOTZZA MOTZZA mark, we need not consider the likelihood of confusion between Applicant's mark and Opposer's LOTZZA HOTZZA mark. On the other hand, if we find no likelihood of confusion between Applicant's mark and LOTZZA MOTZZA, we would not find confusion likely between Applicant's mark and LOTZZA HOTZZA. *In re Max Capital Grp.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

**1. The Goods and Services, Channels of Trade and Classes of Consumers**

Turning first to Opposer's frozen pizza and Applicant's restaurants, Opposer "must show something more than that similar or even identical marks are used for food products and for restaurant services." *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982). Opposer has met this burden and therefore we find that there is a clear relationship between these goods and services.

In fact, the requirement for "something more" is satisfied because Opposer's goods, pizza, are the same type of food offered at Applicant's restaurants, as announced by Applicant's involved mark LOTSA STONE FIRED PIZZA. Moreover, and as explained in more detail below, Opposer's mark is highly suggestive of pizza, or at least pizza or other foods featuring lots of mozzarella. *See e.g. In re Azteca Restaurant*

*Enterprises Inc.*, 50 USPQ2d 1209, 1211 (TTAB 1999) (in affirming refusal to register AZTECA MEXICAN RESTAURANT for restaurant services due to prior registration of AZTECA for prepared Mexican foods, “something more” was found because “Mexican food items are often principal items of entrees served by restaurants, certainly by Mexican restaurants. The average consumer, therefore, would be likely to view Mexican food items and Mexican restaurant services as emanating from or sponsored by the same source if such goods and services are sold under the same or substantially similar marks”); *In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074, 1075 (TTAB 1990) (affirming refusal to register GOLDEN GRIDDLE PANCAKE HOUSE for restaurant services based on registration of GOLDEN GRIDDLE for table syrup, finding that “Applicant’s mark makes it clear that its restaurant serves pancakes and, no doubt, pancake (or table) syrup, as well. There is an undeniable connection between the goods of the registrant and the services of applicant.”). Similarly, in this case the evidence reveals an “undeniable connection” between the pizza which Opposer offers in frozen form and the signature and build-your-own stone fired pizzas offered fresh in Applicant’s restaurants. *Cf. In re Opus One, Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001) (affirming refusal to register OPUS ONE for restaurant services based on a likelihood of confusion with the same mark for wine, and stating “[t]he fact that applicant’s restaurant serves the type of goods (indeed the actual goods) identified in the cited registration is certainly probative evidence which supports a finding under the second *du Pont* factor that applicant’s services and opposer’s goods are related”).

Furthermore, Opposer has established that the same sources use and have registered identical marks for frozen pizza on the one hand and restaurant services on the other. In fact, Opposer introduced more than 30 use-based third-party registrations showing that the same marks are registered in connection with both pizza/frozen pizza and restaurant services. 15 TTABVue 13-88. “Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source.” *See In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1998).<sup>13</sup> Opposer also introduced evidence that many third parties use identical marks for frozen pizza and restaurant services, including, California Pizza Kitchen, Uno, Gino’s East, Sbarro and Mystic Pizza, among many others. *Id.* at 98-237. Thus, Opposer’s frozen pizza is related to Applicant’s restaurant services.

As for Opposer’s “restaurant services,” the situation is less clear-cut. We take judicial notice that a restaurant is “a place where meals are prepared and served to customers.”<sup>14</sup> Apparently, that does not describe Opposer’s services.

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<sup>13</sup> Opposer should be aware, however, that pending applications, cancelled registrations and registrations which are not use-based are not probative on this question.

<sup>14</sup> [dictionary.cambridge.org/us/dictionary/english/restaurant](http://dictionary.cambridge.org/us/dictionary/english/restaurant). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010).

Opposer does not own or even operate the places where it provides its services, stadiums and other third parties do. Nor does it appear accurate to say that Opposer's pizza is "prepared" in these places. Opposer "prepares" the pizzas in its manufacturing facility, and Opposer's customers merely reheat the pizza for their customers. In any event, we need not decide whether Opposer in fact provides "restaurant services," because, as explained in more detail below, even if it did, that would not change our ultimate decision about the likelihood of confusion.<sup>15</sup>

As for the channels of trade and classes of consumers, Opposer's evidence makes clear that they overlap. Consumers buy lots of pizza, some frozen, some hot or "fresh," in stores, restaurants and at kiosks and other outlets such as "restaurant trailers." The record makes clear that the same pizza consumers sometimes buy frozen or cooked pizza to eat at home or elsewhere, and at other times buy pizza in restaurants. For example:

Uno's website lists its many restaurants, and offers frozen pizza, stating "Now you can get our original, legendary pizza shipped straight to your home in 2 packs, 4 packs, and 6 packs. We carefully freeze and ship our 10-inch deep dish pizzas anywhere in the continental U.S." 15 TTABVUE 98-103.

Gino's East's website lists its restaurant locations and offers "nationwide shipping" of a variety of its pizzas. *Id.* at 104-108.

California Pizza Kitchen's website lists its pizza restaurants and Walmart's website offers many different

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<sup>15</sup> Applicant argues that "[c]haracterizing [Opposer's] bar, tavern and small format sales as 'restaurant services' is similar to claiming that Anheuser-Busch's sales of beer to a bar which then serves it cold to bar patrons constitutes 'bar and taproom services.'" 31 TTABVUE 28 (Applicant's Trial Brief at 20).

types of frozen California Pizza Kitchen pizzas for sale. *Id.* at 109-112.

Sbarro's website lists its many restaurants and depicts boxes of its frozen pizza. *Id.* at 113-130.

Opposer introduced a large number of additional similar or analogous examples. *Id.* at 131-237.

In short, the goods and services are at least related, and travel in the same channels of trade to the same consumers. These factors weigh in favor of finding a likelihood of confusion.

## **2. The Strength of Opposer's Mark**

Before comparing the marks, we consider the strength of Opposer's mark, as that impacts the scope of protection to which it is entitled. There are two types of strength: conceptual and commercial. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).").



Turning first to conceptual strength, because Opposer's mark is registered, we must presume that it is inherently distinctive, i.e. that it is at worst suggestive of Opposer's services. 15 U.S.C. § 1057(b) (registration is "prima facie evidence of the validity of the registered mark"); *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007) (when mark is registered on the Principal Register, "we must assume that it is at least suggestive"). While Opposer's mark is valid and inherently distinctive, the record reveals that it is highly suggestive.

Opposer itself effectively conceded the point when Mr. Schultz testified that “**LOTZZA MOTZZA is our brand that screams what it is, lots of Wisconsin cheese** because we put over a half pound of cheese on that product.” 23 TTABVUE 17 (Schultz Disc. Tr. at 11) (emphasis added). In other words, LOTZZA, the phonetic equivalent of “lotsa,” also has the same meaning, which the Oxford University Press Online Dictionary defines as “lots of”:



22 TTABVUE 110 (<https://www.lexico.com/en/definition/lotsa>). Thus, LOTZZA is highly suggestive of the quantity of “Wisconsin cheese” in Opposer’s frozen pizza (there is “lots of” it).

Applicant also relies on the following third-party registrations, only one of which is used for clearly related goods:

| <u>Mark/Reg. No.</u>   | <u>Goods/Services</u>   |
|--|---|
| LOTSA BUBBLES (BUBBLES dis-claimed)<br>Reg. No. 5979344  | bubble making wand and solution sets; novelty toy items in the nature of toys that produce soap-film bubbles  |
| LOTSA CHICKEN (CHICKEN dis-claimed)<br>Reg. No. 4485374  | cat food; consumable pet chews; dog food; edible food for animals for chewing; food for animals; pet food; pet treats   |
| <br>Reg. No. 1659958  | Candies   |
| LOTSA HEART ELEPHANT (ELEPHANT disclaimed)<br>Reg. No. 5291119   | Plush toys  |
| <br>Reg. No. 3290334 | organizing community members through online calendar services, namely, providing calendar services for others via a global computer network for the purpose of assisting those in need<br><br>providing online electronic bulletin boards for transmission of messages among computer users for the purpose of organizing community members to assist those in need |
| LOTSA LOVE<br>Reg. No. 3113413   | live flower floral arrangements and bouquets sold with or without plush toy, balloons, or candy   |
| LOTSA MEAT PIZZA (MEAT PIZZA disclaimed)<br>Reg. No. 4559789   | Pizza   |
| LOTSA' NOODLES (NOODLES disclaimed)  | Soup  |

|                                 |   |
|---------------------------------|---|
| Reg. No. 3400163                |   |
| LOTS A SLOTS (SLOTS disclaimed) | ... downloadable computer software for providing casino games, slot games ...                 |
| Reg. No. 5855613                | entertainment in the nature of providing, though any computerized platform ... slot games ... |

22 TTABVUE 11-95.<sup>16</sup> Sometimes, third-party registrations may function as a dictionary, by showing “the sense in which a mark is used in ordinary parlance.” *Juice Generation, Inc. v. GS Enterprises, LLC*, 794 F.2d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015). Here, however, only the third-party registration for LOTSA MEAT PIZZA is directly probative, because it is used for goods which are on their face related to those at issue here. At the same time, it is perhaps not surprising, given the definition of LOTSA, that third parties have registered marks such as LOTSA CHICKEN for pet food and LOTSA NOODLES for soup.

In any event, based on the dictionary definition of LOTSA and Mr. Schultz’s testimony that the term “screams” that Opposer’s pizza has “lots of” Wisconsin cheese,” we find that LOTSA strongly suggests that Opposer’s frozen pizza features “lots of” Wisconsin mozzarella cheese. Indeed, MOTZZA sounds the same as the first two syllables of the word “mozzarella.”<sup>17</sup> In the context of Opposer’s frozen pizza

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<sup>16</sup> Applicant should be aware that cancelled registrations and pending applications are not probative, and we have only listed active registrations here.

<sup>17</sup> By the same token, LOTZZA HOTZZA refers to Opposer’s pizza being “spicy hot.” 23 TTABVUE 24 (Schultz Disc. Tr. 41)



goods, the meaning of MOTZZA is obvious, and reinforced by Opposer's see-through packaging which draws attention to how much mozzarella Opposer puts on its pizza:



18 TTABVUE 4, 17 (Schultz Dec. ¶ 10 and Ex. A).<sup>18</sup>

Third-party uses of similar terms further reveal that LOTZZA MOTZZA is highly suggestive.<sup>19</sup> Indeed, a Utah pizza restaurant uses an essentially identical mark and trade name, also for pizza:

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<sup>18</sup> When a mark identifies a product's ingredient(s), it may be considered merely descriptive. *In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1576 (Fed. Cir. 2015) (“The Board found that the relevant consumer, knowing that the goods are supplements containing nopal cactus juice, would understand the mark NOPALEA to convey information that the goods contain ingredients from the *Nopalea* cactus ...Substantial evidence supports the Board's findings, and its conclusion that ‘nopalea’ is merely descriptive of TriVita's goods.”).

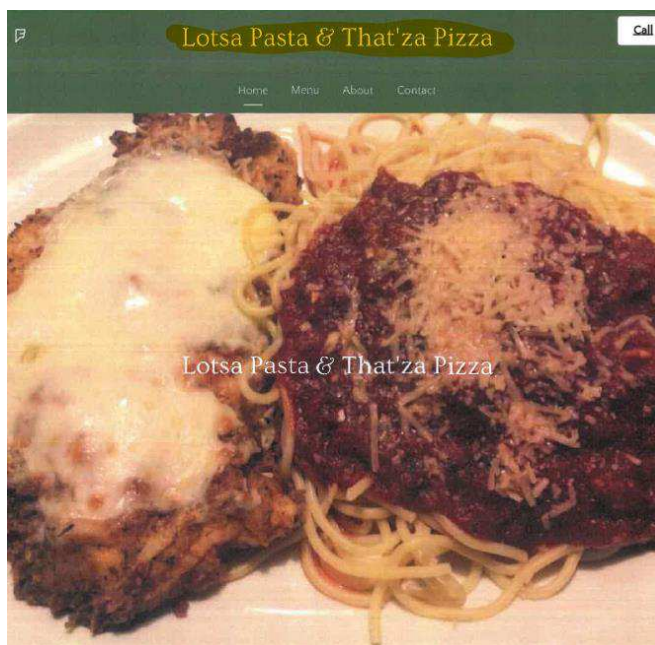
<sup>19</sup> While third-party uses of similar marks for similar goods or services are typically considered in evaluating a term's commercial weakness, as discussed *infra*, in this case we also find them probative of conceptual weakness.



22 TTABVUE 111. While this mark, LOTSA MOTSA PIZZA, differs slightly from Opposer’s mark by replacing the “zz”s in Opposer’s LOTZZA MOTZZA with “s”s, this mark conveys the same exact meaning as Opposer’s mark for the same exact goods, and thus is highly probative in further establishing the strongly suggestive nature of LOTZZA MOTZZA.

In addition, Mr. Schultz admitted that there is a separate, unrelated company using the mark LOTSA MEAT PIZZA, which is reflected in the table of third-party registrations above. 28 TTABVUE 16. Thus, Opposer’s marks coexist with LOTSA MOTSA PIZZA and LOTSA MEAT PIZZA, among other similar marks.

We also find the trade name/service mark LOTSA PASTA & THAT’ZA PIZZA for a Colorado restaurant to be probative of the suggestiveness of Opposer’s mark:



22 TTABVUE 113. This restaurant uses LOTSA in the exact same way as Opposer, to suggest a large quantity of food, in this case pasta. Furthermore, this mark includes THAT'ZA PIZZA, which reveals another way in which Opposer's mark is suggestive – it is used for Italian food. That is, combining LOTSA (or LOTZZA) with generic terms for types of Italian food that also end with “A” and rhyme with the “A” sound in LOTSA/LOTZZA results in a composite that calls to mind an Italian accent, perhaps that of the chef or a consumer who is particularly appreciative of good pizza or pasta. In other words, it is not just the meaning of the word LOTSA which strongly suggests a large quantity of Italian food, but also the term's pronunciation, at least when, as here, it is used in conjunction with rhyming words which also call to mind (or are generic for) Italian food. Another third-party uses LOTSA PASTA in the exact same way, for a Kentucky international food shop which offers pizza and other Italian food:



*Id.* at 126-127. And another third-party uses LOTSA BALLS for meatballs intended to call to mind meatballs made by “Jersey Italians” based on family recipes:

## **Lotsa Balls Is A Local Classic Serving Meatballs & More**


To New Jersey Italians, meatballs are considered to be THE heirloom of all recipes. Every family has their own version; a family famous pie, a secret casserole with one mysterious ingredient. To us, meatballs are that timeless staple in all Italian-American expat kitchens.

We as Jersey Italians, have our meatballs, our pasta and our sauce that our wives and grandmothers have been canning for decades. The smell of your grandmothers kitchen, the fresh herbs perfuming the air, and the company you and your family have always kept. At Lotsa Balls our goal is to tug at those heart strings and become that sense of home for anyone who walks in.

**PHONE**  
732.662.5999

**LOCATION**  
25 NEW STREET  
METUCHEN, NEW JERSEY

**HOURS**  
4PM - 8PM DAILY



*Id.* at 133-139. These examples further reinforce that LOTSA is highly suggestive when used in connection with food, especially Italian food, including pizza. Of course, while LOTSA may be particularly appropriate for and suggestive of Italian food, it may also be used more generally by restaurants and food providers to signify a large

quantity of any type of food, such as the trade name/service mark LOTSA LOBSTER for a seafood market. *Id.* at 130.

Turning to the evidence of commercial strength, Opposer has shown that its pizza is successful, based on sales totaling “approximately \$305 million,” and promotional expenses totaling more than \$9 million 18 TTABVIE 13-14 (Schultz Dec. ¶¶ 31, 33). In addition, the LOTZZA MOTZZA mark is displayed in venues which host sports and other events, such as Target Center, where we would expect relatively large numbers of potential consumers to encounter the mark. On the other hand, there is no direct evidence that consumers recognize the mark or that it has received significant media attention. “Opposer does not contend that Opposer’s Marks are famous.” 23 TTABVUE 141 (Opposer’s response to Interrogatory No. 17). Overall, we find that Opposer’s mark is commercially somewhat strong.

We must balance this evidence of commercial success and a moderate level of advertising against the third-party uses of LOTSA MOTSA PIZZA, LOTSA MEAT PIZZA, LOTSA PASTA INTERNATIONAL FOOD SHOP and LOTSA BALLS meatballs. Four third-party uses is not quantitatively sufficient to establish that a significant portion of United States pizza consumers have been conditioned to distinguish between LOTSA marks for food or even Italian food. However, these third-party uses do show consumer exposure to use of the term LOTSA by third party food providers.

All of the evidence of conceptual weakness, including the dictionary definition and Mr. Schultz’s testimony discussed above highlights the conceptual weakness of

LOTSAs and highly similar terms such as LOTZZAs. We keep all of this evidence in mind as we turn to comparing the parties' marks.

### 3. The Marks

Opposer argues that "LOTSAs/LOTZZAs is the dominant term of the parties' marks." 30 TTABVue 43. We agree at least with respect to Applicant's mark, for two reasons. First, LOTSA appears and will be read and spoken first. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) ("The identity of the marks' initial two words is particularly significant because consumers typically notice those words first."); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"). Second, the rest of Applicant's mark, STONE FIRED PIZZA, is at best descriptive of Applicant's restaurants, and disclaimed, so it is entitled to less weight in our analysis. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'") (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *see also In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (DELTA, not the disclaimed term CAFÉ, is the dominant portion of the mark THE DELTA CAFÉ).

This is not enough to find confusion, however, even if we agreed that LOTZZA is the dominant portion of Opposer's mark. In fact, while STONE FIRED PIZZA is entitled to less weight in our analysis of Applicant's mark, we may not ignore it, even



though it is disclaimed. *Shen Mfg. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1355 (Fed. Cir. 2004) (“The disclaimed elements of a mark, however, are relevant to the assessment of similarity ... This is so because confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been disclaimed.”); *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (CCPA 1965). Similarly, even if we considered LOTZZA to be the dominant portion of Opposer’s mark, we could not ignore MOTZZA. Stated differently, we must consider the marks “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567).

When we do so, we find that the marks are different in appearance and sound. To state the obvious, Applicant’s mark does not contain MOTZZA, MOTSA, MOZZA, MOZZARELLA or any similar words or terms, and Opposer’s mark does not contain STONE, FIRED or PIZZA. The differences in how LOTZZA, MOTZZA and LOTSA, STONE, FIRED, PIZZA look and sound are thus readily apparent.<sup>20</sup>

The marks convey somewhat similar meanings, however, because Opposer’s mark is highly suggestive of pizza and perhaps Italian food generally, while Applicant’s mark itself makes clear that it is for pizza that is stone fired. On the other hand, the

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<sup>20</sup> To the extent Opposer argues that confusion is unlikely because Applicant often displays the term LOTSA in much larger font than STONE FIRED PIZZA, this is irrelevant. Applicant seeks registration in standard characters, and therefore could display the mark in any font or size. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012).

meanings are dissimilar because Opposer's mark focuses on the quantity of a particular ingredient, while Applicant's focuses on the quantity of pizza itself.

Ultimately, we find that even though the marks convey somewhat similar meanings, and begin with terms which sound the same and look somewhat similar, they are not likely to result in consumer confusion due to the conceptual weakness of Opposer's mark and the shared term LOTSA/LOTZZA. That term is simply too weak to result in a finding of confusing similarity here, even when the marks are used for pizza on the one hand and pizza restaurants on the other, and even if we assume that Opposer's alleged "restaurant services" are in fact identical to Applicant's traditional restaurant services. In fact, consumers will perceive the marks' first terms as merely laudatory, strongly suggesting that Opposer provides lots of mozzarella with its pizza and that Applicant's restaurants serve lots of pizza. Some consumers are also aware that LOTSA and variations thereof is used by unrelated food providers, perhaps especially those which offer Italian food, including pizza.

The bottom line is that because the only thing the marks have in common is the demonstrably weak term LOTZZA/LOTS, confusion is unlikely. *See e.g. Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958) (finding no likelihood of confusion between SURE-FIT and RITE-FIT, both for slip covers, because the term "fit" is "eminently suitable for use in connection with goods such as ready-made slip covers ... [u]nder these circumstances, we do not feel that appellant is entitled to the broad protection which it seeks"); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476-78 (TTAB 2014) (finding



“that the mark PERKSPOT is sufficiently different from the marks PERKS and PERKSCARD to avoid a likelihood of confusion” even though the marks were used for legally identical services); *Plus Prods. v. Natural Organics, Inc.*, 204 USPQ 773, 779-80 (TTAB 1979) (allowing registration of NATURE’S PLUS for vitamins despite prior registration of PLUS for vitamins given coexistence of a number of registrations containing PLUS for similar goods).

The involved mark is LOTSA STONE FIRED PIZZA, not LOTSA MOZZA (or LOTSA MOTSA). Opposer should not be able to prevent others from registering marks which share with Opposer’s mark only the term LOTSA or variations thereof, even for pizza. Indeed, as the record demonstrates, companies which offer large quantities of pizza or its ingredients, or other food products, may have a need or desire to use the same highly suggestive term. As the Federal Circuit’s predecessor court stated in *Sure-Fit*:

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

*Sure-Fit Prods.*, 117 USPQ at 297.

#### **4. Actual Confusion**

Opposer alleges that there have been “at least two examples of actual confusion.” 30 TTABVUE 48 (Opposer’s Trial Brief at 39-40). The supporting evidence is quantitatively and qualitatively insufficient to support a finding of actual confusion.

In the first “example,” Twitter user Mac Wilson was poking fun at Opposer in a tweet, but misspelled Opposer’s mark as LOTSA MOZZA, thereby mistakenly “tagging” Applicant. 25 TTABVUE 6-7, 76 (DiGangi Dec. ¶ 28 and Ex. O). This was not actual confusion between the sources of the parties’ goods, the goods themselves or the parties’ marks. It was a spelling or tweeting error. Moreover, it was a short-lived error, because three days later Mr. Wilson e-mailed Applicant explaining that “[m]y intended (and non-serious!) target was Lotzza Motzza ... As it turns out, this wound up tagging you ....” 16 TTABVUE 169. In any event, in the absence of Mr. Wilson’s testimony, this evidence is not probative of actual confusion. *See Corporate Fitness Programs, Inc. v. Weider Health and Fitness, Inc.*, 2 USPQ2d 1682, 1691 (TTAB 1987) (“we agree with applicant’s contention that the testimony is of little probative value in the absence of testimony from the third persons themselves as to whether they were confused and, if so, what caused their confusion”) and *Toys “R” Us, Inc. v. Lamps R Us*, 219 USPQ 340, 346 (TTAB 1983) (“One important defect, which might have been revealed had the involved customers been available for cross-examination, is that there is nothing to indicate whether the reason for the question as to affiliation was the result of the similarity of the marks.”).

In the second “example,” Jodi Koepp e-mailed Applicant with a complaint about Opposer’s pizza fries. 25 TTABVUE 7-8 (DiGangi Dec. ¶¶ 31-32); 16 TTABVUE 548. The mistake appears to be the result of Ms. Koepp contacting Applicant through its “lotsa.com” website. While this contact may tend to suggest that Ms. Koepp could have been confused in some manner about the parties or their products, Applicant

quickly dispelled any confusion. 16 TTABVUE 548. Furthermore, to the extent Ms. Koepp was confused, that confusion does not appear to be the result of the involved mark LOTSA STONE FIRED PIZZA, but rather the domain name “lotsa.com.” This proceeding is not about the domain name, and the Board is not the proper venue for domain name disputes. In any event, even if this incident qualified as actual confusion based on the parties’ marks and goods or the sources thereof, it is de minimis. *Syndicat Des Proprietaires Viticulteurs De Chateaneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1942 (TTAB 2012); *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007). This factor is neutral.

#### **5. Whether the Goods and Services are Subject to Impulse Purchase**

We accept Opposer’s argument that “[s]ince pizza is a relatively inexpensive product frequently purchased by consumers without detailed scrutiny of the goods, an average frozen pizza consumer will not exercise a high degree of care when purchasing frozen pizza.” 30 TTABVUE 51-52 (Opposer’s Trial Brief at 42-43). The same is true of dining on pizza at a “fast casual” restaurant, kiosk or “restaurant trailer.” This factor weighs in favor of finding of likelihood of confusion.

#### **6. Applicant’s Intent**

Opposer points out that Applicant was aware of Opposer and its goods and services prior to applying for registration of LOTSA STONE FIRED PIZZA. 30 TTABVUE 52-53 (Opposer’s Trial Brief at 43-44). This is not sufficient to establish bad faith and therefore this factor is neutral. *Action Temporary Services, Inc. v. Labor Force, Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1310 (Fed. Cir. 1989) (“mere knowledge of the existence of the prior user should not, by itself, constitute bad faith”).

#### **IV. Conclusion**

Even if we assume that the parties' goods and services are identical and that all channels of trade and classes of consumers overlap, confusion is unlikely despite those goods and services being subject to impulse purchase. The parties' marks are simply too different, given that their shared component is conceptually weak and used by third-parties for the same or similar goods, for confusion to be likely. *See 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 *duPont* factor may not be dispositive.").

**Decision:** The opposition is dismissed.

## **Exhibit 2**

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| <p>This Opinion is Not a<br/>Precedent of the TTAB</p> |
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Mailed: February 8, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Livetrends Design Group, LLC*

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Serial Nos. 88320133

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Christopher M. Ramsey of Gray Robinson, P.A.  
for Livetrends Design Group, LLC.

J. Ian Dible, Trademark Examining Attorney, Law Office 111,  
Chris Doninger, Managing Attorney.

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Before Cataldo, Wellington, and Kuczma,  
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Livetrends Design Group, LLC (“Applicant”) seeks registration on the Principal  
Register of the standard character mark URBAN JUNGLE DESIGN (with DESIGN

disclaimed) for use on “live plants, namely, indoor house plants sold to plant retailers for resale to consumers” in International Class 31.<sup>1</sup>

The Examining Attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the registered standard character mark URBAN JUNGLE for “rental of potted plants and floral arrangement to the public and commercial customers” in International Class 44.<sup>2</sup>

After the Examining Attorney made the refusal final, Applicant concurrently filed a request for reconsideration and appealed. When the Examining Attorney denied the request for reconsideration, this appeal resumed and it has been briefed by Applicant and the Examining Attorney.

For the reasons set forth below, we affirm the refusal.

### **Likelihood of Confusion**

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We must consider each *DuPont* factor for

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<sup>1</sup> Application Serial No. 88320133 filed February 28, 2019, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intent to use the mark in commerce.

<sup>2</sup> Registration No. 5850189 issued on the Principal Register on September 3, 2019.

which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

#### **A. Similarity of the Marks**

We first compare the marks “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). We assess not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods and services offered under the respective marks is likely to result. *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (quoting *Coach Servs.*).

In this case, the first two words of each mark – URBAN JUNGLE and URBAN JUNGLE DESIGN – are identical. The “identity of the marks’ initial two words is particularly significant because consumers typically notice those words first.” *In re*



*Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018). The marks are thus, aurally and visually, very close.

We do not ignore the single difference between the marks, namely, the addition of the term DESIGN at the end of Applicant's mark. However, this disclaimed term has very little source-identifying value because it is merely descriptive of Applicant's goods. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (in comparing THE DELTA CAFÉ to DELTA, the generic term CAFÉ lacks sufficient distinctiveness to create a different commercial impression); *In re Detroit Ath. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (“[N]on-source identifying nature of the words and the disclaimers thereof constitute rational reasons for giving those terms less weight in the analysis.”). It is highly unlikely consumers will rely on this term for purposes of distinguishing the marks.

In terms of meaning, the marks convey the same, or nearly the same, commercial impression. Each mark, when viewed in the context of the involved goods and services, may be understood as suggestive of tropical plants placed in an urban environment and a play on the idiom “urban jungle.” These connotations are expressed in the Internet evidence submitted by Applicant and discussed more fully, *infra*.<sup>3</sup> For example, a blog article titled “Urban Jungle – House Full of Plants” begins with “As the world's population is becoming more and more urbanized – people are looking for ways to cope in the sterile concrete environment. . . . One popular solution

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<sup>3</sup> See exhibits attached to Applicant's request for reconsideration filed June 22, 2020, TSDR pp. 9-19.

is bringing more plants and greenery inside, transforming your home into a green oasis.”<sup>4</sup> Use of the term URBAN JUNGLE, by either Applicant on its indoor house plants or by Registrant in connection with potted plant rental services, has the same suggestive meaning -- that the plants will help create a lush or greener décor inside the consumer’s property.

Based on their strong resemblance in sound, appearance, connotation and commercial impression, we find Applicant’s mark, URBAN JUNGLE DESIGN, is very similar to the registered mark, URBAN JUNGLE.

### **B. Weakness of Registered Mark**

Applicant argues that “[b]ecause URBAN JUNGLE is a weak mark, the additional term DESIGN distinguishes Applicant’s mark from the registered mark.”<sup>5</sup> In support of its contention that URBAN JUNGLE is weak, Applicant relies on the following evidence: copies of online articles or reviews from 7 different websites describing an “urban jungle” home décor concept of having plants in your home; printouts from 4 different websites showing use of term URBAN JUNGLE in connection with the wholesale and retail sale, rental or leasing of plants; and copies of 13 third-party, use-based registrations for marks comprised, in part, of either the term URBAN or the term JUNGLE, but not both.<sup>6</sup>

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<sup>4</sup> *Id.*, TSDR p. 9.

<sup>5</sup> 7 TTABVUE 12.

<sup>6</sup> Attached to Applicant’s response filed December 6, 2019, and request for reconsideration filed June 22, 2020.

With respect to the third-party registrations, Applicant submitted “hard” copies and they do not show their current status and title information. “[T]o make a third-party registration of record, or a registration owned by the applicant or registrant not the subject of the appeal, a

In terms of the strength or weakness of the cited mark, we consider both its conceptual strength based on the nature of the mark and its commercial strength based on the marketplace recognition of the mark, if any. *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”) A mark may be inherently or conceptually weak due to its strongly suggestive meaning in the context of the involved goods or services.

As to commercial weakness, the sixth *DuPont* factor “considers ‘[t]he number and nature of similar marks in use on similar goods’” or services. *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). This factor potentially relates to the impact of our analysis of the similarity or dissimilarity of the marks under the first *DuPont* factor because the “purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Id.* (quoting *Palm Bay Imps. v. Veuve*

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copy of the registration (from either the electronic records of the Office or the paper USPTO record) showing the current status and title of the registration must be submitted.” TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208.02 (June 2020). However, “if the examining attorney discusses the registrations in an Office action or brief, without objecting to them, the registrations will be treated as stipulated into the record.” *Id.* Because the Examining Attorney did not object to the otherwise improperly-submitted registrations, we have treated them as of record. We do note that, in his brief, the Examining Attorney did point out that two of the third-party registrations have been cancelled (Reg. Nos. 3653534 and 4304657), and the third mark URBANATURE (Reg. No. 4576115) was mischaracterized by Applicant as “URBAN NATURE.”

*Cliquot Ponsardin Maison Fondée en 1772*, 73 USPQ2d at 1694 (internal quotation and quotation marks omitted)).

The evidence submitted by Applicant demonstrates that the wording “urban jungle” is strongly suggestive of a type of interior design concept involving plants. For example, one article describes “Five houseplants for a stylish Urban Jungle Interior.”<sup>7</sup> There is also evidence of a book titled “Urban Jungle: Living and Styling with Plants,” which is touted as “a manual for anyone looking to bring more plants into their living space.”<sup>8</sup> Because the goods and services involve houseplants, we find the term URBAN JUNGLE has some inherent weakness as a source-identifier.

With regard to any commercial weakness, Applicant’s evidence shows the term URBAN JUNGLE used on four different websites in connection with the sale or rental of plants. While this evidence is probative, it does not come close to matching the amount of third-party use that courts have previously relied upon for purposes of finding a mark, or element of a mark, to be so commercially weak to avoid a likelihood of confusion with another mark based on the same term. *See, e.g., Jack Wolfskin Austrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (discussing “voluminous evidence” of registration and use of paw print design elements); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (referring to evidence of 26 third-party marks as “a considerable number”).

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<sup>7</sup> Applicant’s request for reconsideration, filed June 22, 2020, TSDR p. 12.

<sup>8</sup> *Id.*, p. 10.

The third-party registrations submitted by Applicant also have little, if any, probative value for purposes of showing URBAN JUNGLE is weak. As the Examining Attorney points out, the registrations are for marks that have either the term URBAN or the term JUNGLE, but not both. There is no evidence of anyone, other than Registrant, with a registration for a mark containing the term URBAN JUNGLE. Indeed, many of the third-party registered marks convey very different meanings, e.g., URBAN SUNSET, THE URBAN BLOSSOM, URBAN LEGEND, JUNGLE ALL THE WAY, JUNGLE ELF, etc.

In sum, we find that the cited URBAN JUNGLE mark is suggestive and somewhat inherently weak and there is some evidence of commercial weakness. Nonetheless, the URBAN JUNGLE mark is registered on the Principal Register without resort to a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), and thus is presumed inherently distinctive. Taken together, we find the cited mark is entitled to a somewhat narrower scope of protection than that accorded to a strong and arbitrary mark. Nonetheless, even weak marks are entitled to protection against confusion. *See Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010); *see also King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974).

### **C. Relatedness of the Goods and Services**

“[L]ikelihood of confusion can be found ‘if the respective goods [and services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same

source.” *Coach Servs.*, 101 USPQ2d at 1722 (internal citations omitted). In analyzing the second *DuPont* factor, we look to the identifications in the application and cited registration. See *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

At the outset, we note a general or inherent relationship between Applicant’s goods and Registrant’s services inasmuch as they involve live houseplants. We also take into consideration the provision in Applicant’s identification of goods that it offers its house plants for sale “to plant retailers for resale to consumers.” This provision, however, does not eliminate the possibility that the same consumer may encounter Applicant’s houseplants, bearing the mark URBAN JUNGLE DESIGNS, as well as Registrant’s rental of potted houseplants services. That is, the involved application is for use of the mark on Applicant’s live houseplants and we must therefore construe this to mean that these houseplants will be encountered by the end consumers bearing Applicant’s mark. The same consumer, whether it is a homeowner or commercial business, may also choose Registrant’s URBAN JUNGLE houseplant rental services to decorate their property with house plants.

The Examining Attorney submitted Internet evidence showing that there are third parties who provide plant rental services as well as the retail sale of house plants.<sup>9</sup> For example, the website for Beneva Landscapes offers “residential plant

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<sup>9</sup> See evidence attached to Office Action issued November 12, 2019, TSDR 4-10,

sales & rentals.”<sup>10</sup> Another website, Foliage Unlimited, offers “plant rental for special occasions and events,” as well as “plant sales.”<sup>11</sup> The Examining Attorney also submitted printouts from other websites showing several different other entities that provide wholesale and rental services involving plants.<sup>12</sup>

It is well established that a “relatedness” which bespeaks likelihood of confusion may occur from the use of the same or similar marks for goods, on the one hand, and for services dealing with or related to those goods, on the other hand. *See e.g., In re Detroit Athletic*, 128 USPQ2d at 1052 (“[W]e have held that confusion is likely where one party engages in retail services that sell goods of the type produced by the other party . . . .”); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG’S (stylized) for retail grocery and general merchandise store services and BIGGS and design for furniture likely to cause confusion); *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1339, 186 USPQ 476, 480 (CCPA 1975) (“lacking merit is [applicant’s] contention that services [leasing, maintenance and servicing of apparatus for cleaning mechanical parts] and products [cleaning equipment] marketed under substantially the same mark cannot be found likely to cause confusion”); *In re H.J. Seiler Co.*, 289 F.2d 674, 129 USPQ 347, 347-48 (CCPA 1961) (finding that caterers were likely to sell specialty food products as well as to offer catering services supported conclusion that SEILER’S for catering services and

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<sup>10</sup> Office Action issued November 12, 2019, TSDR p. 4.

<sup>11</sup> *Id.*, pp. 5-6.

<sup>12</sup> See evidence attached to Office Action issued December 23, 2019, TSDR pp. 2-4, and Office Action issued July 7, 2020, TSDR pp. 2-13.

SEILER'S for smoked and cured meats were related); *In re United Serv. Distribs., Inc.*, 229 USPQ 237, 239 (TTAB 1986) (design featuring silhouettes of man and woman for distributorship services in the field of health and beauty aids likely to cause confusion with design featuring silhouettes of a man and woman used in connection with skin cream).

Here, too, we find that there is a close relationship between the Applicant's indoor house plants that are sold to plant retailers and for resale to consumers, and Registrant's rental of potted plants. Not only is there an inherent relationship based on the goods and services involving houseplants, but there is persuasive evidence showing that these are the type of goods and services that may be offered by a single entity. The same consumer for these goods and services, namely, a person or business seeking to furnish a home or business with plants, is likely to encounter them. For example, a consumer seeking to have house plants for a special event or interior design project, may encounter Applicant's URBAN JUNGLE DESIGN plants, albeit being sold indirectly from an unrelated retailer, and also encounter Registrant's URBAN JUNGLE house plant rental services.

Accordingly, the second *DuPont* factor weighs in favor of likely confusion.

#### **D. Conclusion**

Given the strong similarity of the marks and our finding that the goods and services are closely related and will be offered to the same classes of purchasers, we find that confusion is likely. We make this ultimate finding despite our finding of some weakness of the registered mark, URBAN JUNGLE, in connection with



house plants. That is, in spite of any narrowing of the scope of protection for Registrant's mark, we find it is still entitled to protection against registration of a highly similar mark for goods that are closely related to Registrant's services. *King Candy Co., Inc.*, 182 USPQ 109; *see also In re i.am.symbolic*, 127 USPQ2d 1627, 1636 n.13 (TTAB 2018).

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

# **Exhibit 3**

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: November 18, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*Gary Hale*

*v.*

*Go Pro Workouts, LLC*

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Opposition No. 91211810

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Wesley W. Whitmyer Jr., Andy I. Corea and Lori L. Benavente of St. Onge Steward  
Johnston & Reens LLC, for Gary Hale

Brendan M. Shortell, Esq. of Lambert & Associates for Go Pro Workouts, LLC.

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Before Kuhlke, Mermelstein and Kuczma,  
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Applicant, Go Pro Workouts, LLC, (“Applicant”), filed a use-based application to  
register the mark GO PRO OR GO HOME with a standard character claim for:

Clothing, namely, shirts, pants, sweatshirts, hats, socks,  
shorts, jackets, headbands, warmup suits and footwear in  
Class 25.<sup>1</sup>

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<sup>1</sup> Application Serial No. 85756704 was filed on October 17, 2012, alleging first use of the mark at least as early as March 4, 2011 and first use in commerce at least as early as March 15, 2011. The application also includes goods and services in International Classes 5 and 41 which are not at issue in this proceeding. See Opposer’s Opening ACR Brief at p. 2

Opposer, Gary Hale (“Opposer”), opposes the registration of Applicant’s mark on the ground of priority and likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d). Opposer alleges that his rights in the similar mark GO PRO for clothing items commenced as of his November 15, 1995 constructive use date which is prior in time to Applicant’s filing date as well as any date of use of the mark claimed by Applicant.

Opposer is the owner of Registration No. 2,086,424 for the mark GO PRO with a standard character claim for:

Clothing, namely, T-shirts, hats, caps, jerseys, shorts, tank shirts, socks, warm-up suits, jackets, pants, sweat shirts, sweat pants, coats, sneakers, boots, and sandals, in International Class 25,

and alleges dates of first use and first use in commerce on November 20, 1995, and March 16, 1996, respectively.<sup>2</sup>

In its answer, Applicant denied the salient allegations and alleged several defenses, identified as affirmative defenses, including lack of likelihood of confusion as to source, sponsorship, association or approval, unclean hands, laches, estoppel, and acquiescence.<sup>3</sup>

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(9 TTABVUE 3).

<sup>2</sup> Registration No. 2086424 issued on the Principal Register on August 5, 1997, based on an intent to use application filed on November 15, 1995, and has been renewed.

<sup>3</sup> Applicant’s defenses as to unclean hands, laches, estoppel and acquiescence were not argued in its briefs, so we consider them waived. *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011).

The parties agreed to resolve this proceeding by Accelerated Case Resolution (“ACR”) in lieu of a trial.<sup>4</sup> The Board’s Order of March 19, 2014, approved the parties’ agreement regarding the ACR procedure for this case as set forth in the parties’ March 12, 2014 Stipulation to Elect the Accelerated Case Resolution Procedure namely, that in lieu of trial, the Board can resolve any issues of material fact in making the final determination on the merits; included a proposed schedule for the close of discovery and the submission of briefs and evidence; and provided for the submission of testimony by written declarations and affidavits.

## **I. The Record**

### **A. Opposer’s Evidence**

Opposer introduced Declarations of the following:

Declaration of Gary Hale (9 TTABVUE 68-98)

Declaration of Andy I. Corea (9 TTABVUE 10-67)

Declaration of Andy I. Corea (12 TTABVUE 10-13)

### **B. Applicant’s Evidence**

Applicant introduced Declarations of the following:

Declaration of Joseph Lamourex (11 TTABVUE 18-33)

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<sup>4</sup> ACR is a procedure akin to summary judgment in which parties can receive a prompt determination of the claims and defenses in their case, but without the uncertainty and delay typically presented by standard summary judgment practice. To take advantage of ACR, the parties must stipulate that, in lieu of trial, the Board can resolve any material issues of fact. After the briefs are filed, the Board will issue a decision within fifty days, which will be judicially reviewable as set out in 37 CFR §2.145. *Ballet Tech Foundation, Inc. v. Joyce Theater Foundation, Inc.*, 89 USPQ2d 1262, 1266 n. 9 (TTAB 2008).

Declaration of Brendan M. Shortell (11 TTABVUE 34-408)

Declaration of Joseph Lamourex (14 TTABVUE 10-14)

## **II. Standing and Priority**

Opposer bears the burden of proving both standing to oppose and at least one valid ground for refusal of registration. *Ritchie v. Simpson*, 170 F.3d 1092, 1095, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999) and *Sanyo Watch Co., Inc. v. Sanyo Electric Co., Ltd.*, 691 F.2d 1019, 1021, 215 USPQ 833, 834 (Fed. Cir. 1982). Because Opposer has properly made his pleaded Registration for the GO PRO mark of record, he has established standing to oppose registration of Applicant's mark and his priority is not an issue as to those goods covered by the registration. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1402, 182 USPQ 108, 110 (CCPA 1974). Additionally, we note that Applicant expressly concedes Opposer's priority.<sup>5</sup>

## **III. Likelihood of Confusion**

In determining the likelihood of confusion, we must analyze 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 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 1314-15, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). Two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort*

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<sup>5</sup> Applicant's ACR Brief on the Merits at pp. 6-7 (11 TTABVUE 7-8).

*Howard Paper Co.* 544 F.2d 1098, 1103, 192 USPQ 24, 29 (CCPA 1976). We have considered these and any other *du Pont* factors on which the parties have submitted evidence or argument.

**A. Similarity of the Goods, Trade Channels and Conditions of Purchase**

1. Similarity of Goods

There is no question that the parties' goods are identical in part, as both Opposer's Registration and Applicant's application include pants, sweatshirts, hats, socks, shorts, jackets, and warmup suits. Additionally, the "footwear" items in the application encompass the boots and sandals in Opposer's Registration.

2. Similarity of Trade Channels

Because the goods are in large part identical and otherwise overlapping and closely related, and because neither Applicant's identification of goods nor the identification of goods contained in Opposer's Registration contain a limitation of any kind with respect to consumers or channels of trade, we must presume that the goods move in the same channels of trade and are sold to the same classes of consumers. *See American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). *See also In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

### 3. Class of Purchasers

Although Applicant admits that the parties sell similar goods in similar trade channels, it contends that the class of purchasers and conditions under which the goods are purchased are so different as to avoid any potential confusion.<sup>6</sup> According to Applicant, Opposer sells only clothing items on his website, while Applicant's website offers clothing items as an ancillary product to its workout training and nutritional programs.<sup>7</sup> Specifically, Applicant sells dietary and nutritional supplements; and provides a website featuring online sports training and training advice, and recordings of training and workouts.<sup>8</sup> Thus, Applicant argues that its clothing items are just one part of its overall GO PRO OR GO HOME brand and these other goods and services offered by Applicant which feature professional athletes wearing such clothing items, ensure a unique and distinct condition of purchase and consumers.<sup>9</sup> Based on the foregoing, Applicant maintains that the purchasers of its goods and services, unlike those of Opposer's goods, are athletes who train with Applicant or with professional sports teams and associations with which Applicant has partnered.<sup>10</sup>

Applicant's argument has little merit. First, the other products and services offered by Applicant are not relevant. It is well-settled that the issue of likelihood of

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<sup>6</sup> Applicant's ACR Brief on the Merits (hereafter "Applicant's ACR Brief") at p. 11 (11 TTABVUE 12).

<sup>7</sup> Applicant's ACR Brief at p. 11 (11 TTABVUE 12).

<sup>8</sup> Applicant's ACR Brief at p. 9 (11 TTABVUE 10).

<sup>9</sup> Applicant's ACR Brief at p. 11 (11 TTABVUE 12).

<sup>10</sup> Applicant's ACR Brief at p. 11 (11 TTABVUE 12); Lamourex Decl. ¶ 10 (11 TTABVUE 20).



confusion between applied-for and registered marks must be determined on the basis of the goods and services as they are identified in the involved application and registration. *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (CCPA 1973). Moreover, each Class stands on its own, for all practical purposes like a separate application, and we must make determinations for each separate Class. *General Mills v. Fage*, 100 USPQ2d at 1588 n.1, *citing G&W Laboratories, Inc. v. G W Pharma Ltd.*, 89 USPQ2d 1571, 1573-74 (TTAB 2009)). Thus, the goods listed in the other Classes in the application do not serve to restrict the trade channels for the goods in the opposed class. There are no restrictions in the identifications of goods which differentiate potential purchasers and given the identity of the goods, we must presume that the purchasers are the same. Even if this presumption did not apply, Applicant has “been developing apparel using the GO PRO OR GO HOME mark targeted at the *general purchaser of athletic apparel*” (emphasis added),<sup>11</sup> and Opposer likewise targets his apparel and footwear to the general purchaser of athletic apparel.<sup>12</sup> Because there are no restrictions in the description of goods in Applicant’s application or in Opposer’s Registration, we must consider the parties’ identical goods to move in all the normal and usual channels of trade and methods of distribution to all potential purchasers, and these customers would include the general public. *Octocom Systems, Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811

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<sup>11</sup> Lamourex Decl. at ¶¶ 6, 11 (11 TTABVUE 19, 21).

<sup>12</sup> Hale Decl. ¶ 5 (9 TTABVUE 69).

F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Thus, we find that Applicant's products and the products in Opposer's registration move in the same channels of trade and are sold to the same classes of customers which include the general public including, but not limited to "general purchaser[s] of athletic apparel."

#### 4. Conditions Under Which and Buyers to Whom Sales Are Made

The fourth *du Pont* factor is the conditions under which and buyers to whom sales are made, i.e., "impulse versus careful, sophisticated purchasing." In order to purchase Applicant's goods, visitors to its website are required to register and create an account for either a free trial session or a paid plan for its workout training programs or nutritional plans. Based on this requirement, Applicant argues that an enhanced degree of care not required to purchase Opposer's goods, is necessary to the purchase of its goods.<sup>13</sup>

The registrability of an application must be considered with respect to the goods identified in it. Thus, Applicant's goods are not limited to those sold to purchasers who have previously registered on Applicant's website or those sold in conjunction with its training or nutritional plans. But even if they were, and even if such purchasers are presumed to use a reasonable amount or possibly even a high amount of care when making a purchase, there is no evidence that purchasers of Opposer's goods exercise a greater degree of care in purchasing his products. Opposer's clothing products are everyday clothing items of the type purchased on

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<sup>13</sup> Applicant's ACR Rebuttal Brief at 6 (14 TTABVUE 7).

impulse and without much care or deliberation. Thus, purchasers who are not likely to exercise great care in their purchasing decisions may be confused by the marks. In view of the foregoing, purchasers for the goods exercise an ordinary degree of care, i.e., neither especially careful nor careless, in selecting the goods.

### **B. Similarity of Marks**

We next consider the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) and *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

To the extent that Applicant's GO PRO OR GO HOME mark begins with the same two words that comprise Opposer's GO PRO mark, they are similar overall in sound, appearance and meaning. This is particularly so because consumers are generally more inclined to focus on the first word in any trademark or service mark. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions).

Although we must determine likelihood of confusion on the basis of the facts and context of each case, it is significant that Opposer's GO PRO mark is contained in

its entirety within Applicant's GO PRO OR GO HOME mark; in such cases, confusing similarity has often been found. *See Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (BENGAL LANCER similar to BENGAL); *In re El Torito Restaurants, Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO COMBO likely to cause confusion with registered MACHO mark); *In re Christian Dior, S.A.*, 225 USPQ 533, 535 (TTAB 1985) (addition of house mark in LE CACHET De DIOR does not avoid likelihood of confusion with registered CACHET mark).

In considering the commercial impressions of the marks, we find that they are similar. According to Opposer, the GO PRO brand targets to a wide range of consumers, including athletes looking to go pro, who want to strive to go a step beyond the norm in everything they do across all aspects of life.<sup>14</sup>

Applicant's GO PRO OR GO HOME mark is a play on the "commonly used expression among athletes GO BIG OR GO HOME."<sup>15</sup> The purpose of the mark is to motivate people to give it their all when they are reminded of two choices, *i.e.*, going pro or going home, they are likely to choose the one that ends up in victory (going "pro") instead of defeat (going "home").<sup>16</sup> Applicant maintains that the "GO HOME" portion of its mark is significant because it represents the consequence of failure

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<sup>14</sup> Hale Decl. ¶ 2 (9 TTABVUE 68).

<sup>15</sup> Applicant's ACR Brief at p. 9 (11 TTABVUE 10).

<sup>16</sup> Applicant's ACR Brief at p. 9 (11 TTABVUE 10).

and thus, the additional term “OR GO HOME” in its mark creates a distinct commercial impression regarding the consequences of failure.<sup>17</sup>

In attempting to distinguish the meaning and commercial impression of its mark from Opposer’s mark, Applicant points to the additional dietary and nutritional supplements and online sports training and training advice services it provides in connection with its clothing items arguing that they create a distinct commercial impression “of professional athlete training programs and lifestyles on consumers.”<sup>18</sup> However, in determining the commercial impressions or connotations created by the marks we must consider the marks in relation to the parties’ identified goods. *See Coach Services, Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600 (TTAB 2010), *aff’d*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012) (COACH for educational software does not dilute or create likelihood of confusion with COACH for handbags, luggage, etc.); *Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013).

Inasmuch as Applicant’s supplements and training services are not the subject of this proceeding, the marks have the same meaning and commercial impression when used on the identical and otherwise related clothing items recited in Opposer’s Registration and Applicant’s application. This is particularly so where the marks begin with the identical phrase GO PRO and the additional phrase OR GO HOME in Applicant’s mark does not impart a different meaning or commercial impression to Applicant’s mark.

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<sup>17</sup> Applicant’s ACR Brief at pp. 9-10 (11 TTABVUE 10-11).

<sup>18</sup> Applicant’s ACR Brief at p. 9 (11 TTABVUE 10).

For the reasons set forth above, when considering the marks in their entirety, we find that the similarities outweigh any differences between the marks and that the marks are similar in sound, appearance, meaning and commercial impression.

### **C. Nature and Number of Similar Marks in Use on Similar Goods**

The parties agree that there is only one other registered mark that incorporates the shared GO PRO term for goods in Class 25, namely, Registration No. 4219155 for the mark KEY WEST WHERE THE WEIRD GO PRO for various clothing items.<sup>19</sup> Inasmuch as the GO PRO term is not a dominant part of the mark, this Registration is not relevant. Nor are the three trademark applications for marks containing the term GO PRO cited by Applicant as such applications evidence only that the applications were filed on a certain date, they are not evidence of use or that the marks, in fact, co-existed in the marketplace with Opposer's mark.<sup>20</sup> *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007); *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1468 n.6 (TTAB 2003); *In re Juleigh Jeans Sportswear, Inc.*, 24 USPQ2d 1694, 1699 (TTAB 1992).

In arguing the weakness of Opposer's mark, Applicant contends the USPTO has already determined that a number of marks containing the term "Go Pro," including

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<sup>19</sup> Opposer's ACR Brief at p. 7 (9 TTABVUE 8) and Hale Decl. ¶ 18, Ex. I (9 TTABVUE 71, 98); Applicant's ACR Brief at pp. 12-13 (11 TTABVUE 13-14). Although the listing of the Registration in the TESS summary search report submitted by Opposer as Ex. I to the Hale Decl. is not sufficient to make the Registration of record, Applicant expressly addressed this Registration in its Brief so we have treated it as of record. *See Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1829 n.8 (TTAB 2012) (summary of search results from USPTO's electronic database is not an official record of the Office).

<sup>20</sup> Opposer's ACR Brief at p. 7 (9 TTABVUE 8) and Applicant's ACR Brief at pp. 12-13 (11 TTABVUE 13-14).

Applicant's mark, are not likely to cause confusion with Opposer's mark. In support of its position, Applicant points to the issued Registration and three applications.<sup>21</sup> The fact that the trademark examining attorneys, in the *ex parte* examination of Applicant's and third parties' applications, did not cite Opposer's previously registered mark is irrelevant and is not a binding determination that there is no likelihood of confusion between Opposer's and Applicant's marks. In any event, the Board is not bound by the prior decisions of examining attorneys in allowing the Applicant's mark for registration. It has been noted many times that each case must be decided on its own facts. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."); and *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987).

In addition to the foregoing, Applicant maintains that any likelihood of confusion between the parties' marks will be reduced by the fact that the shared term "GO PRO" is in common use by many others in the market. According to Applicant, the dilution of "GO PRO" in the marketplace makes it impossible for the term to distinguish the parties' goods and the addition of the words "OR GO HOME" in Applicant's mark alleviates any likelihood of confusion.<sup>22</sup> In support of its position, Applicant submitted Internet search result summaries generated by the *Google* search engine based on searches for the terms "go pro" and "go pro clothing." The

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<sup>21</sup> Applicant's ACR Brief at. pp. 12-13 (9 TTABVUE 13-14).

<sup>22</sup> Applicant's ACR Brief at p. 10 (9 TTABVUE 11).

“go pro” and “go pro clothing” search summaries yielded 22 and 27 pages of results respectively.

Generally, search result summaries generated by Internet search engines have limited probative value because they do not show the context in which the term or phrase is used on the listed web pages and may not include sufficient surrounding text to show the context within which the term or phrase is used. *See In re Bayer Aktiengesellschaft*, 488 F.3d 960, 967, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (because the *Google* search report provides very little context of the use of ASPIRINA on the webpages linked to the search report, it is of little value in assessing the consumer public perception of the ASPIRINA mark); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011); *In re Thomas*, 79 USPQ2d 1021, 1026 (TTAB 2006).

The search results in this case provide little context to discern how the term is actually used on the webpage that can be accessed through the search result links as such, they are insufficient to determine the nature of the use of a term or the relevance of the search results to registration considerations. Web-based information that includes greater context for the use of a term, such as a complete webpage that is accessible as a link within the search engine results, will have greater probative value in determining how a term will be perceived. *See In re King Koil*, 79 USPQ2d 1048, 1050 (TTAB 2006) (list of internet search results is “not given much weight” because “[t]hese web page excerpts do little to show the context within which a term is used on the web page that could be accessed by the link).



Even if, as Applicant contends, none of the listings in the search reports are for Opposer's products, the *Google* summary search reports provide little context as to the manner in which the term "Go Pro" is used on the webpages linked to the search report listings and is of little value in assessing the consumer public perception of the GO PRO mark. A large number of the entries appear to relate to dissimilar products and services, such as cameras, tax consulting, and plumbing and heating services.<sup>23</sup> Even if the referenced pages had been provided in full, they would fail to demonstrate the weakness of the GO PRO mark for clothing items and accordingly, are not probative. Furthermore, many of the entries in the "go pro clothing" report contain no mention of the term "go pro" and there is no indication that the entries link to pages evidencing use of marks comprising GO PRO.<sup>24</sup>

Similarly, while Applicant argues that the term "go pro" has been made famous by a third party, Go Pro, Inc.,<sup>25</sup> nothing in evidence establishes that Go Pro, Inc. uses "Go Pro" as a trademark for identical or related goods or services, or even that the name "Go Pro" was used first by Go Pro, Inc. In view of the foregoing, this evidence does not affect Opposer's rights.

#### **D. ACTUAL OR POTENTIAL CONFUSION**

According to Applicant, there is no evidence of actual confusion. Applicant argues that both parties sell exclusively on websites. In over 3 years of ongoing concurrent use, according to Applicant, neither party is aware of a single instance of

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<sup>23</sup> See for example, 11 TTABVUE 118, 124, 126.

<sup>24</sup> See for example, 11 TTABVUE 207, 209, 211, 213, 215.

<sup>25</sup> Applicant's ACR Brief at p. 13 (14 TTABVUE 14).

confusion.<sup>26</sup> Applicant contends these circumstances present a situation where the parties have coexisted in the marketplace “for many years,” and the absence of a single instance of actual confusion suggests strongly that confusion is unlikely citing *G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.*, 16 USPQ2d 1635, 1638 (Fed. 1990) and McCarthy on Trademarks § 23.18.<sup>27</sup>

On the other hand, Opposer contends that a newcomer does not gain the right to register a substantially identical mark simply because the number of persons exposed to the registrant’s mark may be small in relation to the newcomer’s volume of use. According to Opposer, Applicant, a company likely with greater resources than Opposer, has the ability to promote its confusingly similar mark in such a way that purchasers may come to associate Opposer’s mark with Applicant. Specifically, the ability of a second comer to overwhelm the use of the prior user has the potential for reverse confusion.<sup>28</sup>

We first observe that three years is a relatively short period of time and simply because both parties offer goods on the Internet is not sufficient to establish that there has been a meaningful opportunity for confusion to occur. Moreover, the reported lack of an occurrence of actual confusion is not dispositive inasmuch as such evidence is notoriously difficult to come by, in particular here, given Opposer’s small sales presence. While evidence of actual confusion is “highly probative, if not conclusive” of the issue, its absence is not, unless it is accompanied by evidence

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<sup>26</sup> Applicant’s ACR Rebuttal Brief at p. 6 (14 TTABVUE 7).

<sup>27</sup> Applicant’s ACR Rebuttal Brief at p. 6 (14 TTABVUE 7).

<sup>28</sup> Opposer’s Rebuttal Brief pp. 4-5 (12 TTABVUE 5-6).

demonstrating that in light of the parties' actual business activities, confusion, if likely, would have occurred. *General Mills v. Fage*, 100 USPQ2d at 1603 (quoting *Majestic*, 65 USPQ2d at 1205).

To the extent Applicant's argument goes to the premise that there would be *de minimis* confusion, we again disagree. The fact that the number of consumers who may use Opposer's services is small does not mean that confusion caused by Applicant's mark sought to be registered would therefore be *de minimis* since rights flowing from federal registration do not vary with the size of registrants. Applicant as the newcomer does not gain rights to register its very similar mark simply because the number of persons exposed to Opposer's registered mark may be small in relation to Applicant's volume of use. *In re Shell Oil Co.*, 992 F.2d 1204, 1207-08, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

#### **IV. Conclusion**

Applicant's mark includes Opposer's entire mark. Moreover, where the goods of an applicant and cited registrant are highly similar or closely related as they are in this case, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with less similar goods. *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) and *Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1173 (TTAB 2011). Additionally, based on the identical and highly related nature of the goods set forth in the application and Opposer's registration, and the identical or similar trade channels and classes of customers, the *du Pont* factors of the

similarity of the goods, trade channels and customers also favor a finding of likelihood of confusion. Even if we assume that GO PRO is a weak mark, “[l]ikelihood of confusion is to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and ‘strong’ mark.” *King Candy v. Eunice King’s Kitchen*, 182 USPQ at 109.

**Decision:** In view of the foregoing, the opposition is sustained.