

This Opinion is not a
Precedent of the TTAB

Mailed: May 11, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Jack Q. Drake Revocable Trust

v.

Susan DeFuria.

—
Cancellation No. 92059646
—

Paul D. Supnik, Esq., for Jack Q. Drake Revocable Trust.

Susan DeFuria, *pro se.*

—
Before Kuhlke, Ritchie, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Jack Q. Drake, as trustee for the Jack Q. Drake Revocable Trust (“Petitioner”) has filed a petition to cancel Registration No. 4564746 for the trademark ZEN DELITES in standard characters,¹ owned by Susan DeFuria (“Respondent”). Respondent’s mark is registered for “cookies,” in International Class 30.

¹ Issued on the Principal Register on July 8, 2014, based on an application filed July 7, 2012 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b). Respondent subsequently filed a statement of use alleging first use as of March 15, 2008 and first use in commerce as of May 23, 2009.

As grounds for cancellation, Petitioner alleged priority of use and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Petitioner asserted that it owned common law rights in the mark ZEN BAKERY for bakery products, and pleaded ownership of the following U.S. registrations:

<u>Reg. No.</u>	<u>Mark</u>	<u>Goods / Services</u>
1529901		Muffins, cookies, rolls, pastry, in International Class 30. ²
4101859	ZEN BAKERY	Café, in International Class 43. ³
4104964	ZEN BAKERY	Bakery goods; muffins, cookies, rolls, pastry; bakery goods for retail and wholesale distribution and consumption on or off the premises, in International Class 30. ⁴

Each pleaded registration includes a disclaimer of the exclusive right to use BAKERY apart from the mark as shown.

² Issued on the Principal Register on March 14, 1989, based on an application filed January 15, 1988 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), with a claim of first use as of January 1, 1980 and first use in commerce as of April 27, 1987. Section 8 affidavit accepted; Section 15 affidavit acknowledged; renewed.

³ Issued on the Principal Register on February 21, 2012, based on an application filed June 17, 2011 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), with a claim of first use and first use in commerce as of June 30, 1978.

⁴ Issued on the Principal Register on February 28, 2012, based on an application filed June 17, 2011 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), with a claim of first use as of June 30, 1978 and first use in commerce as of December 31, 1995.

Respondent, in her answer to the petition for cancellation, admitted that “[P]etitioner has owned the trademark *Zen Bakery* and has used it in trade since 1978.”⁵ The answer also establishes that Respondent makes no claim to using her mark earlier than 2008.⁶ Otherwise, Respondent has denied the salient allegations of the petition. The case is fully briefed. For the reasons explained in this decision, we dismiss Petitioner’s claim.

I. The record.

The record includes the pleadings and, by operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the registration history of Respondent’s registration. In addition, Petitioner has made of record the following evidence:

- Printouts of information from the electronic database records of the USPTO showing the current status and title of Petitioner’s three pleaded registrations (1 TTABVUE 8-15; 15 TTABVUE 25-39).
- Respondent’s responses to select requests for admission and interrogatories (15 TTABVUE 8-20).
- Letter of Protest Memorandum issued by the Office of the Deputy Commissioner for Trademark Examination Policy (15 TTABVUE 41).
- Preliminary injunction issued by U.S. District Court for the Southern District of New York against Zen Bakeries LLC *et al.* (15 TTABVUE 43-46).
- Stipulated final judgment of U.S. District Court for the Southern District of New York in action between Petitioner and Zen Bakeries *et al.* (15 TTABVUE 48-49).

⁵ Answer, 6 TTABVUE 1.

⁶ *Id.*

Respondent did not make any testimony or evidence of record. Respondent attached evidence to her brief on the case,⁷ but we have given it no consideration because it was not made of record during her assigned time for taking testimony. *See* TBMP § 704.05(b) (2015).

II. Standing.

Petitioner has made of record its pleaded U.S. registrations. Petitioner has thereby shown that it is not a mere intermeddler and has established its standing to bring this proceeding. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

III. Petitioner's claim under Section 2(d).

Under Section 2(d) of the Trademark Act, the USPTO may refuse registration of a mark that “so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d).

Respondent’s mark, being registered on the Principal Register, is presumed to be valid. 15 U.S.C. § 1057(b). “Due to this presumption of validity, the burden of persuasion in a cancellation proceeding rests on the party seeking to cancel the registration.” *Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352,

⁷ Petitioner objected to admission of this evidence in its reply brief. 23 TTABVUE 6-8.

92 USPQ2d 1626, 1628 (Fed. Cir. 2009). Petitioner must overcome the registration's presumption of validity by a preponderance of the evidence. *Id.*

A. Priority.

In a cancellation proceeding in which both plaintiff and defendant own registrations, priority is in issue and the plaintiff has the burden of proving its priority. *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281 (TTAB 1998).

Under Section 7 of the Trademark Act, each party is entitled to rely upon the filing date of the application underlying its registration for purposes of establishing a date of first use of its registered mark. 15 U.S.C. § 1057(c); *Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1140 (TTAB 2013); *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840 (TTAB 1995). All of the three applications underlying Petitioner's pleaded registrations were filed earlier than the filing date underlying Respondent's registration.

Each party is also entitled to demonstrate *actual* use of its mark prior to the filing date of its application in order to demonstrate priority. However, Respondent indicated in her pleadings that she would not contest Petitioner's priority. In her answer to the petition for cancellation, she made the following two statements:

I do not contest that the petitioner has owned the trademark *Zen Bakery* and has used it in trade since 1978.

... It is a fact that I, the registrant, have only used *Zen Delites* in trade since 2008.⁸

⁸ Answer, 6 TTABVUE 1.

Petitioner argues in its brief that “Petitioner claims first use of ZEN BAKERY since at least as early as June 30, 1978.”⁹ However, we find no persuasive evidence that Petitioner actually used its mark at any time earlier than the filing dates of its applications. All of Petitioner’s evidence of an earlier date of first use of its mark is in the form of statements elicited from Respondent, who clearly had no first-hand knowledge of Petitioner’s operations. In her response to Petitioner’s Request for Admission No. 3, Respondent stated:

I have never been in a Zen Bakery so I do not know if they even offer cookies for sale. If the Petitioner can provide validation as to when the bakery commenced the sale of cookies, I will accept this date as factual.¹⁰

When Respondent was asked to admit that “Petitioner used the mark ZEN BAKERY since at least as early as 1978 in connection with BAKERY GOODS,”¹¹ Respondent stated:

Inasmuch as the petitioner’s attorney has consistently reiterated this fact, it is not up to me to deny its validity.¹²

There is little reason to believe, on this record, that Respondent knows anything at all about when Petitioner actually used its mark on any goods. Although Respondent has conceded priority to Petitioner, Petitioner has not proven actual use of its mark at any time earlier than the filing dates of its applications. Accordingly, we rely on

⁹ Petitioner’s brief at 4, 20 TTABVUE 10.

¹⁰ Petitioner’s notice of reliance, 15 TTABVUE 12.

¹¹ Request for admission No. 4, Petitioner’s notice of reliance, 15 TTABVUE 8.

¹² 15 TTABVUE 12.

Petitioner's constructive dates of first use under Section 7(b) in finding that Petitioner has demonstrated its priority.

B. Likelihood of confusion.

Our determination of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). For the sake of economy, we will confine our analysis to the issue of likelihood of confusion between Respondent's mark and the mark in Petitioner's Reg. No. 4104964. That mark is registered in standard character form; therefore, of all the pleaded marks, it is the most similar to Respondent's mark. Also, this registration of Petitioner covers, among other goods, "cookies," which are the only goods covered by Respondent's registration. If the petition to cancel cannot be sustained on the basis of this registration, it could not be sustained on the basis of the other pleaded registrations. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

1. The goods; channels of trade.

We turn first to the similarity or dissimilarity of the goods at issue, as identified in the two registrations. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-1162 (Fed. Cir. 2014); *Octocom Syst. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). We find that the parties' goods are identical, inasmuch as Respondent's goods are "cookies" and Petitioner's registration covers, among other goods, "cookies."

Accordingly, the *du Pont* factor regarding the similarity or dissimilarity of the goods weighs in favor of a finding of likelihood of confusion.

Because the parties' goods are identical, we must presume that they move through the same channels of trade and are sold to the same classes of purchasers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). As there are no limitations as to channels of trade in the identifications of goods in the two registrations, we presume that the parties' goods move in all channels of trade that are normal for such goods. *See Octocom*, 16 USPQ2d at 1787; *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). Accordingly, the *du Pont* factor of trade channels weighs in favor of a finding of likelihood of confusion.

2. The marks.

Next we consider the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). "The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks omitted). While we consider each mark in its entirety, there is nothing improper in stating that, for rational reasons, more or less weight has been given to

a particular feature of a mark, provided that our ultimate conclusion rests upon a comparison of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). “Indeed, this type of analysis appears to be unavoidable.” *Id.*

In appearance and sound the two marks are similar to the extent that the first word of each mark is ZEN. The marks differ in appearance and sound by virtue of their other terms, which are BAKERY and DELITES, respectively.

With respect to meaning, Petitioner argues that Respondent has “admitted” that the connotation and commercial impression of the marks are identical,¹³ quoting the following statement from Respondent’s answer:

The fact is, “Zen” is almost a generic name, well known in our society as a Buddhist philosophy implying a superior way of being and state of mind. Its use is widespread, not applicable to any specific business or product.¹⁴

It is not clear whether Petitioner, in quoting this statement and characterizing it as an admission, wished to endorse all or only part of the above statement. In any event, we find unpersuasive the contention that ZEN is generic with respect to cookies. Moreover, we do not find the above statement to be an admission that the marks have identical connotation and commercial impression.

Neither party has provided any evidence of the meaning of DELITES, but it is obviously a recognizable variant of “delights.” BAKERY is a generic or highly descriptive term in the field of baked goods.

¹³ Petitioner’s brief at 18, 20 TTABVUE 24.

¹⁴ Answer, 6 TTABVUE 2.

Considering the meanings of the marks in their entireties, ZEN BAKERY might suggest a baking establishment that follows or is in some way guided by Zen principles. ZEN DELITES might suggest the pleasures (“delights”) of practicing Zen philosophy, or good things derived from the principles or practice of Zen. These meanings and connotations are distinguishable from those of Petitioner’s mark.

Turning to the overall commercial impression of the marks, Petitioner contends:

In both Petitioner and Respondent’s marks, ZEN is the first word in the mark and an adjective and carries the trademark significance. When comparing ZEN BAKERY and ZEN DELITES, must one must [*sic*] discount BAKERY in comparing similarity, and the word DELITES.¹⁵

The most significant comparison to make is the words ZEN and ZEN DELITES.¹⁶

The additional wording DELITES simply provide [*sic*] more information as to the nature of the goods.¹⁷

The word DELITES makes it appear as if the goods are a particular form of ZEN BAKERY goods, in this case cookies sold under the ZEN BAKERY brand.¹⁸

We must decline Petitioner’s suggestion that “the most significant comparison to make” is between ZEN and ZEN DELITES. To ignore the word BAKERY in

¹⁵ Petitioner’s brief at 11, 20 TTABVUE 17.

¹⁶ *Id.* at 13, 20 TTABVUE 19.

¹⁷ *Id.* at 10, 20 TTABVUE 16.

¹⁸ *Id.* at 14, 20 TTABVUE 20.

Petitioner's mark would violate the rule that marks must be considered in their entireties. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1676 (Fed. Cir. 2015) (inadequate consideration given to the word JUICE in mark for juice bar services). We do give less weight to (but do not wholly ignore) the term BAKERY in Petitioner's mark, because it has been disclaimed and is at least highly descriptive of Petitioner's goods. However, we have no cause to treat any other component of the two marks as strong or weak.

The marks before us have some similarities in appearance and sound, but they also have obvious differences as well as distinguishable meanings. Respondent's mark is presumed to be valid and distinctive under Section 7, and there is no evidence to suggest that any part of it is weak or nondistinctive, nor any other evidence regarding the impression that the marks would likely make upon relevant customers. Keeping in mind that Petitioner bears the burden of persuasion, we find that the *du Pont* factor of the similarity or dissimilarity of the marks weighs against a finding of likelihood of confusion.

3. Letter of protest.

Petitioner has shown that it filed a letter of protest against the registration of Respondent's mark during the prosecution of Respondent's application, and that the Office of the Deputy Commissioner for Trademark Examination Policy granted it.¹⁹

¹⁹ Letter of Protest Memorandum, Petitioner's notice of reliance, 15 TTABVue 41

Petitioner argues that this shows that “The Trademark Office Found Prima Facie evidence of Confusing Similarity.”²⁰

A letter of protest is an informal procedure whereby third parties may bring to the attention of the USPTO evidence bearing on the registrability of a mark. TMEP § 1715. “Under the standard for accepting a pre-publication letter of protest, the examining attorney is not required to issue a refusal as a result of the acceptance. The examining attorney is required only to consider the evidence and make an independent determination whether to issue the requirement or refusal requested in the letter of protest.” TMEP § 1715.02(b).

The Deputy Commissioner, in granting the letter of protest, did not make any finding as to likelihood of confusion, other than to say that Petitioner’s Reg. Nos. 1529901 and 4104964 were relevant to the Examining Attorney’s ultimate decision. In following letter of protest procedure, the Deputy Director did not instruct the Examining Attorney to do any more than “consider the following [registrations] and make an independent determination whether to issue a requirement or refusal ...” Accordingly, it is clear that the Deputy Director’s action is not a *prima facie* demonstration of confusing similarity.

4. Petitioner’s right to exclude others.

Petitioner has shown that, in an infringement action before the U.S. District Court for the Southern District of New York against an entity called Zen Bakeries LLC and

²⁰ Petitioner’s brief at 14, 20 TTABVUE 20.

others,²¹ Petitioner was granted, upon the failure of the defendants to appear, a preliminary injunction against those defendants' use of "Zen Bakeries." Thereafter the parties agreed to a stipulated final judgment that made the injunction permanent and "expanded [the injunction] to enjoin the use of the word 'Zen' by Defendants in connection with any trade or business involving the manufacture, sale or offer for sale of baked goods, including without limitation, 'Zen Bread & Kitchen.'" Petitioner, in return, forever waived any claim for profits and attorney fees.²² Petitioner argues that this evidence is relevant to the *du Pont* factor of "the extent to which [Petitioner] has a right to exclude others from use of its mark..." 177 USPQ at 567.

Considering that the mark against which Petitioner obtained a preliminary injunction (ZEN BAKERIES) is virtually identical to Petitioner's registered mark (ZEN BAKERY), the preliminary injunction merely illustrates the same right that Petitioner derives from its registrations, *i.e.*, Petitioner's "exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate ..." 15 U.S.C. § 1057(b). The preliminary injunction does not show that a court would issue a similar injunction against a different mark, such as Respondent's mark. We are not persuaded that the "expanded" injunction, which was entered by stipulation in connection with a settlement of the case and which broadly prohibited use of ZEN for baked goods, necessarily reflects the extent of Petitioner's rights against competitors other than those that stipulated to it.

²¹ *Drake v. Zen Bakeries LLC et al.*, 14 Civ. 999 (SHS), *see* Petitioner's notice of reliance, 15 TTABVUE 42-49.

²² 15 TTABVUE 48-49.

5. Other *du Pont* factors.

Petitioner refers in its brief to a number of other *du Pont* factors, as to which there is no evidence of record. With respect to the conditions upon which sales are made, Petitioner argues that cookies are inexpensive, impulse purchases. Common sense indicates that many types of cookies are inexpensive consumer items; it follows that customers may not exercise an elevated degree of care in selecting them. However, without evidence we would not assume that they are purchased carelessly or without discrimination.

With respect to fame, Petitioner argues that its registrations demonstrate the length of time over which it has continuously used its mark, suggesting that its mark is therefore well known. We do not agree that the presumption of validity created by Section 7(b) can be stretched to the extent proposed by Petitioner: *i.e.*, that long-standing registration of a mark implies that the registered mark is famous or even well known. The bare presumption that a mark has been used since the filing date of a registrant's application does not mean that such use has been the kind of vigorous use that results in fame. A demonstration of fame requires a showing that mark *actually has* "extensive public recognition and renown." *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, the Board requires that fame be proven clearly. *Leading Jewelers Guild Inc.*

v. LJOW Holdings LLC, 82 USPQ2d 1901, 1904 (TTAB 2007). In the case before us, there is no evidence that Petitioner's mark has actually become famous or even well known.

Regarding the extent of potential confusion, Petitioner argues that it "could be substantial." In the absence of relevant evidence, this is speculation.

IV. Conclusion.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *du Pont* factors. Although the parties' goods, channels of trade, and classes of customers are identical, Plaintiff has failed to show that the marks are sufficiently similar in sight, sound, meaning, and commercial impression as to be likely to cause confusion. *See Kellogg Co. v. Pack'em Enterprises 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 petition for cancellation is dismissed.