

THIS OPINION IS NOT A
PRECEDENT OF THE
TTAB

Mailed: November 26, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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The Icelandic Milk and Skyr Corporation

v.

Saga Dairy, Inc.
—

Cancellation No. 92062423
—

Susan M. Kayser of K & L Gates LLP
for The Icelandic Milk and Skyr Corporation.

Therese R. Meers for Saga Dairy, Inc.
—

Before Wolfson, Heasley and Pologeorgis,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Petitioner, The Icelandic Milk and Skyr Corporation, filed a petition to cancel Respondent, Saga Dairy, Inc.'s, registrations for the standard character mark MORE PROTEIN THAN SUGAR¹ and for the mark depicted below,

¹ Supplemental Register Reg. No. 4792255, issued August 11, 2015.



2

both for “yogurt” in International Class 29 under Trademark Act Section 24, 15 U.S.C. § 1092. Petitioner alleged that the asserted marks are merely informational and incapable of functioning as marks; that they are “so highly descriptive as to be incapable”; and that a likelihood of confusion exists with Petitioner’s pleaded mark MORE PROTEIN THAN SUGAR, which it asserts it used first. Respondent denied the salient allegations in the complaint.

On October 26, 2017, Petitioner filed a motion for summary judgment seeking to cancel Respondent’s registrations on all pleaded grounds. 21 TTABVUE. The Board found that Petitioner has standing to bring this cancellation action, and that the phrase MORE PROTEIN THAN SUGAR is incapable of serving a trademark function. In view thereof, the Board granted Petitioner summary judgment with respect to Reg. No. 4792255 (the standard character word mark). As to Reg. No. 4824104, the Board found the existence of a genuine dispute of material fact as to whether the curved lines in Respondent’s word and design mark rendered the mark capable and thus registrable on the Supplemental Register. The Board held Petitioner’s “so highly descriptive” and likelihood of confusion claims to be moot.³

² Supplemental Register Reg. No. 4824104, issued September 29, 2015.

³ 30 TTABVUE 18: “[W]e need not reach Petitioner’s claim that Respondent’s marks are ‘so highly descriptive’ that they must be cancelled, or Petitioner’s claim that it has priority of

Because Reg. No. 4792255 will be cancelled in due course, the sole issue remaining in this case is whether the design features of Respondent's mark  render the mark capable and thus registrable on the Supplemental Register.

I. The Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), the file of Respondent's challenged registration. In addition, Petitioner introduced, under the testimony declaration of Petitioner's Chief Executive Officer and founder, Sigurður Hilmarsson, a cease and desist letter from Respondent to Petitioner (Exhibit A); copies of webpages from Petitioner's website (Exhibit B); and materials used by Petitioner at the Fall 2014 Food and Nutrition Conference and Expo (Exhibit C).⁴

Under the testimony declaration of its counsel, Susan M. Kayser, Petitioner introduced proof of service of its First Requests for Admission propounded to Respondent.⁵ Ms. Kayser testified that Respondent did not respond to Petitioner's admission requests.⁶ Under the testimony declaration of Petitioner's Chief Financial Officer, Jennifer Dong, Petitioner introduced examples showing Respondent's use of

use and that there is a likelihood of confusion between the marks. Indeed, these claims are moot." Petitioner has not pursued these claims in its brief.

⁴ 32 TTABVUE.

⁵ 33-34 TTABVUE.

⁶ 34 TTABVUE 3. At 33 TTABVUE 64, there is a marker page that reads: "Exhibit 2 to Kayser Declaration Part B." It is followed by several pages marked Exhibits 1-6 (33 TTABVUE 65-80). However, Ms. Kayser does not identify an "Exhibit 2" in her declaration, or refer to a "Part B" (or Part A). Thus, we have not considered the unverified documents forming "Exhibit 2 to Kayser Declaration Part B." (33 TTABVUE 64-81).

its mark (Exhibit A); examples of third-party use of design elements that allegedly emphasize or separate informational text from other elements (Exhibits B and C); and an excerpt from a third-party presentation entitled “Dairy Global Marketing Trends from Nutritional Angles” (Exhibit D).⁷

Petitioner filed a Notice of Reliance on:

- TSDR printouts for Respondent’s registration (Exhibit 1);⁸
- TEAS Plus application, drawing, and specimens for Respondent’s registration (Exhibit 2);⁹
- Petitioner’s First Requests for Admissions (Exhibit 3);¹⁰
- Respondent’s responses to Petitioner’s First Set of Interrogatories and Requests for the Production of Documents and Things (Exhibit 4).¹¹

Respondent did not introduce any testimony or evidence. Only Petitioner filed a brief.

II. Standing

The Board has already determined that Petitioner has standing to bring this action.¹²

⁷ 35 TTABVUE.

⁸ 33 TTABVUE 24.

⁹ 33 TTABVUE 28-35. It was unnecessary to submit copies of the TSDR printout or file history of Respondent’s registration as the file is automatically of record. Trademark Rule 2.122(b).

¹⁰ 33 TTABVUE 36-63.

¹¹ 33 TTABVUE 83-118.

¹² 30 TTABVUE 6: “There is no genuine dispute that Petitioner has standing to bring this cancellation action.”

III. Whether Respondent's Word and Design Mark is Capable of Distinguishing Its Goods.

Respondent's purported word and design mark is the phrase MORE PROTEIN THAN SUGAR! surrounded by two curved lines. The Board has already found that the words themselves merely constitute informational matter,¹³ and that the addition of the exclamation point does not transform the wording into a trademark.¹⁴ The remaining design features are the font style, the arrangement of the words in a stacked format, and the two curved lines surrounding the words. If those design features are capable of becoming distinctive and could combine to create a commercial impression apart from the words themselves, the registration can be maintained on the Supplemental Register with a disclaimer of MORE PROTEIN THAN SUGAR! See, e.g., *In re The Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (CCPA 1977) (BALSAM in stylized lettering was registered on the Supplemental Register with the word "Balsam" disclaimed; nothing capable of distinguishing the goods except type style); *In re School Book Fairs, Inc.*, 229 USPQ 556 (TTAB 1986) (interlocking consecutive letters "O" in the words "School" and "Book" and stylized letter "A" in the word "Fairs" justified registration on the Supplemental Register of SCHOOL BOOK FAIRS, INC.;

¹³ 30 TTABVUE 14: "[T]here are no genuine disputes of material fact that Respondent's mark MORE PROTEIN THAN SUGAR is commonly used to describe the nutritional content of yogurt and will be perceived as merely an informational slogan and not as a trademark by the relevant consumer class."

¹⁴ 30 TTABVUE 17, n.27: "The final punctuation mark (!) at the end of the phrase is inseparable from the wording, does not change the impact of the wording or imbue it with source-identifying significance, and [if the mark were otherwise found registrable] must be included in the disclaimer." Cf. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1209.03(u) ("The use of a common punctuation mark is not sufficient to negate the mere descriptiveness of a term.").

all words disclaimed); *In re Carolyn's Candies, Inc.*, 206 USPQ 356 (TTAB 1980) (highly distinctive “art deco typography” renders the mark YOGURT BAR capable of Supplemental Register registration; “applicant has no proprietary rights whatsoever in the words per se.”).

Petitioner argues that Respondent’s word and design mark is incapable of indicating the origin of Respondent’s goods because the wording is generic and the design “is comprised of simple lines around ordinary, stacked, informational text [that] is not capable of indicating origin of the goods.” 37 TTABVUE 11. Respondent has not submitted any testimony or evidence to support the registration of its mark.

We find the design insufficiently distinctive to be capable of serving as an indicator of origin. The font style and stacked format in Respondent’s purported mark are “nothing but ordinary in nature and do[] not create a commercial impression separate and apart from the unregistrable components.” *In re Am. Academy*, 64 USPQ2d 1748, 1755 (TTAB 2002) (display of mark in cascading staircase manner held “natural result” of using left justification when words are stacked one on top of the other). The curved lines are also not separately registrable because their commercial impact is similar to a background “carrier” and acts as a “frame” for the word portion of the designation. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (“the design is an ordinary geometric shape that serves as a background for the word mark”); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1267 (TTAB 2011)(“the oval designs in the marks are merely background or ‘carrier’ elements, and do not make a strong commercial impression”); *In re Benetton Grp. S.p.A.*, 48

USPQ2d 1214, 1215-16 (TTAB 1998) (“In particular, common geometric shapes such as circles, squares, rectangles, triangles and ovals, when used as backgrounds for the display of word marks, are not regarded as trademarks for the goods to which they are applied absent evidence of distinctiveness of the background design alone.”).

Petitioner’s CFO, Jennifer Dong, testified that the “[u]se of lines, common shapes, or other minimal design features, including centered, stacked text in a sans serif (or similar) font is widespread in the yogurt industry to communicate informational text, such as the comparative protein-to-sugar content or other nutritional content.”¹⁵ Petitioner’s CEO and founder, Sigurður Hilmarsson, also testified that “font, centered and stacked text, and the use of lines to call attention to a product feature[] are very common on packaging in the yogurt and food industry.”¹⁶

The credible testimony of both witnesses is based on personal knowledge, is clear and convincing, and has not be contradicted. *Cf. Powermatics, Inc. v. Glebe Roofing Prods. Co.*, 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965) (testimony alone of a single, credible witness is enough to establish common law use of a mark for the identified goods or services); *Nat’l Bank Book Co. v. Leather Crafted Prods., Inc.*, 218 USPQ 826, 828 (TTAB 1993) (oral testimony may be sufficient to prove the first use of a party’s mark when it is based on personal knowledge, is clear and convincing, and has not be contradicted); *Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468 (TTAB 1976) (testimony that car wash operators sell

¹⁵ ¶ 6, 35 TTABVUE 3.

¹⁶ ¶ 9, 32 TTABVUE 4.

hot wax product identified by opposer’s mark supports finding of likelihood of confusion).

“[O]ral testimony is obviously strengthened by documentary evidence which corroborates use.” *Nationstar Mortg. LLC v. Ahmad*, 112 USPQ2d 1361, 1372 (TTAB 2014) (citing *Elder Mfg. Co. v. Int’l Shoe Co.*, 194 F.2d 114, 92 USPQ 330, 333 (CCPA 1952)). Petitioner has shown that geometric shapes and lines are used on yogurt containers and food products to emphasize or separate generic wording from the rest of the packaging. Respondent’s purported mark is displayed on its labels side-by-side with other marks; the curved lines surrounding the wording MORE PROTEIN THAN SUGAR! emphasize or call out the phrase and separate it from other wording on the label:¹⁷



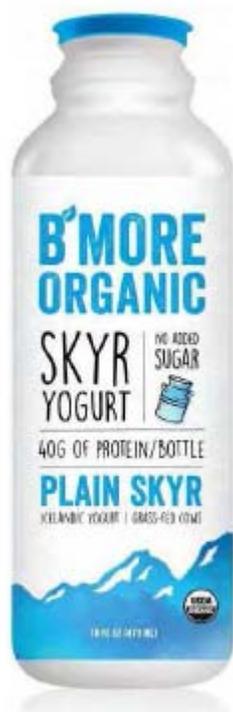
Petitioner also uses a sans serif font, stacked text, and lines on its product packaging to set apart various phrases from each other. On its yogurt containers, Petitioner uses two straight lines to separate stacked text:¹⁸

¹⁷ 33 TTABVUE 8.

¹⁸ 32 TTABVUE 11 and 22.



Regarding third-party use, Jennifer Dong testified that she is personally aware of brands in the yogurt industry that use lines to emphasize text, and attached representative samples to her declaration:¹⁹



¹⁹ 35 TTABVUE 31 and 33.

Moreover, Ms. Dong testified that other food packaging uses “lines (horizontal, vertical, curved, or ‘wavy’), stacked and centered text, and common sans serif (or similar) font, as a common way to separate out, and communicate to the consumer, information about the quality or ingredients of the food product.”²⁰ In support, she attached four examples of other food products where various lines or background carriers, including curved lines, were used to separate generic wording from other text on packaging:²¹



“In order for a term which is otherwise unregistrable to be capable of distinguishing the goods or services in connection with which it is used, the presentation thereof must be so striking, unique or distinctive in character as to

²⁰ 35 TTABVUE 6.

²¹ 35 TTABVUE 40-45.

overcome its inherent incapacity and render the mark capable of serving as an indicium of origin.” *Carolyn’s Candies*, 206 USPQ at 361. The evidence of record, while not extensive, supports the witnesses’ testimony that the use of lines, including curved lines, is an ordinary and commonplace means to separate generic text on a product label, and that the additional design features in Respondent’s purported mark are not so striking, unique or distinctive as to have overcome the inherent incapacity of the mark as a whole.

IV. Conclusion

Considering that the words MORE PROTEIN THAN SUGAR are informational, and incapable of distinguishing the goods, we are not persuaded, particularly in the absence of any evidentiary showing, that the design features of Respondent’s purported mark engender a distinctive and registrable commercial impression capable of serving a trademark function separate and apart from the wording.

Decision: The petition to cancel Registration No. 4824104 for Respondent’s

purported mark  is granted.