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Paper No. 15

10/13/00

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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In re William E. Berner  
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Serial No. 75/434,577  
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John F. Learman for William E. Berner

Carol A. Spils, Trademark Examining Attorney, Law Office  
101 (Jerry Price, Managing Attorney)

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Before Seeherman, Bottorff and Rogers, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

William E. Berner has appealed from the final refusal of the Trademark Examining Attorney to register GRANDMA BERNER'S as a trademark for "hams, namely, gourmet hams."<sup>1</sup> It is noted that applicant, presumably in light of the likelihood of confusion refusal, has disclaimed exclusive rights to the term BERNER'S, although the Examining Attorney has stated that such a disclaimer is not

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<sup>1</sup> Application Serial No. 75/434,577, filed February 16, 1998, asserting a bona fide intention to use the mark in commerce.

necessary. However, because an applicant may disclaim even registrable matter, the disclaimer has been accepted. See **In re MCI Communications Corp.**, 21 USPQ2d 1534 (Comm'r Pats. 1991); TBMP § 1213.01(c). Such a disclaimer, of course, does not avoid a finding of likelihood of confusion and thereby render registrable a mark which is otherwise unregistrable under Section 2(d). See TMEP § 1213.01(c). Applicant has also, in response to the Examining Attorney's requirement, submitted a consent from his mother, who asserts she is known as Grandma Berner by many people, to use and register the mark.<sup>2</sup>

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark, if used on his identified goods, so resembles the mark BERNER CHEESE and design, shown below, and registered for "processed cheese and processed cheese spread sold in plastic bottles and jars"<sup>3</sup> so as to be likely to cause confusion or mistake or to deceive. The

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<sup>2</sup> Certain notations appear in the file which have presumably been made by personnel in the Office. On the consent document appears the direction to "PRINT" the phrase "The name GRANDMA BERNER'S does not identify a living individual" while a memo to the R&A Clerk requests that a "Living Individual Statement" be added to the data base. Although neither of these statements now appears in the data base, it is obvious, in light of the consent, that the "Living Individual Statement" is the appropriate one. Accordingly, the Office records will be corrected to reflect this.

<sup>3</sup> Registration No. 2,008,009, issued October 15, 1996.

**Ser. No.** 75/434,577

registration indicates that the lining is a feature of the mark and does not indicate color; further, the word CHEESE has been disclaimed.

The appeal has been fully briefed. Applicant had originally requested an oral hearing, but later withdrew that request.<sup>4</sup>

Our determination 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). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. **Federated Food, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to the goods, applicant's goods are identified as gourmet hams, while the goods identified in the registration are "processed cheese and processed cheese

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<sup>4</sup> It is noted that applicant made his request for an oral hearing as the last sentence of his appeal brief. Applicant is reminded that a request for an oral hearing should be made by a separate notice. See Trademark Rule 2.142(e)(1).

spread sold in plastic bottles and jars." Although the Examining Attorney, in her brief, states that "the wording in the identification of goods in the registration is not clear as to whether the wording 'sold in plastic bottles and jars' modifies both the processed cheese and the processed cheese spread," p. 11, we think it is obvious, under rules of grammatical construction as well as a practical knowledge of what processed cheese and processed cheese spreads are, that it is the cheese spread which is sold in plastic bottles and jars, and not the processed cheese per se.

It is equally obvious that processed cheese and gourmet ham are different and non-competitive products. However, it is well established that it is not necessary that the goods of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient if the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarities of the marks, give rise to the mistaken belief that they

originate from the same producer. **In re International Telephone & Telegraph Corp.**, 197 USPQ 910, 911 (TTAB 1978).

It is common knowledge that ham and cheese are complementary products. One basic type of sandwich is a "ham and cheese sandwich," in which these two foods form the main ingredients. It is also common knowledge that ham and cheese may be purchased in the same store, such as a grocery store or delicatessen (where goods of this nature are often displayed in close proximity to one another) during the course of a single shopping trip, for a subsequent complementary use. See **In re Vienna Sausage Manufacturing Co.**, 230 USPQ 799, 800 (TTAB 1986) where this statement was made in connection with cheese and sausage.

We see no reason to depart from this view because applicant's goods are identified as "gourmet ham" and the registration is for "processed cheese." These more specific products are also complementary, can be used in ham and cheese sandwiches and the like, and can be sold in the same stores in close proximity to each other. Applicant has not submitted any evidence to the contrary.

The Examining Attorney has also made of record numerous registrations showing that entities have registered their marks both for cheese and for ham. Third-party registrations which individually cover a number of

different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See **In re Albert Trostel & Sons Co.**, 29 USPQ2d 1783 (TTAB 1993). We recognize that in many of the submitted registrations the goods are identified as "cheese", rather than "processed cheese", and as "ham", rather than "gourmet ham." However, because "ham" and "cheese" are acceptable identifications, we would not expect registrations to include the more limiting language of "processed cheese" and "gourmet ham". Even so, we note that two of the third-party registrations do, in fact, include in their identifications both "processed cheese" and "ham." See Registration Nos. 1,433,099 (hams, cheese, processed cheese); and 1,283,524 (cheese, pasteurized process cheese food, and processed meat products, namely, ham...).

Because ham and cheese, including processed cheese, may be sold by a single entity under the same mark; because ham and cheese are complementary products which are commonly used together; and because consumers may purchase the products in the same stores, where they may, because of the conjoint use, be sold or displayed near each other, we find that the Examining Attorney has met her burden in demonstrating that applicant's and the registrant's

identified goods are sufficiently related that, if sold under similar marks, confusion is likely to result. Thus, the factors of the similarity of the marks, and the similarity of trade channels, weigh in favor of a finding of likelihood of confusion.

This brings us to a consideration of the marks. Applicant and the Examining Attorney have engaged in an extensive discussion as to which element of each mark is dominant. The Examining Attorney asserts that the word BERNER dominates both marks, while applicant asserts that, in his mark, it is the word GRANDMA and, in the cited mark, it is the design. The one point on which applicant and the Examining Attorney appear to agree is that 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 the ultimate conclusion rests on a consideration of the marks in their entireties. **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Turning to the cited mark, we find that the dominant element is the term BERNER. The disclaimed word CHEESE is the generic term for the goods, and has no source-identifying significance. As for the design, it is a fairly spare grouping of lines which do not form a

readily-identifiable image, and which appear to be more of a background for the words. In general, when a mark comprises both words and a design, the word portion is normally accorded greater weight because it would be used by purchasers to request the goods or services. See **In re Appetito Provisions Co.**, 3 USPQ2d 1553 (TTAB 1987). We find that general rule to be applicable to the present case because the involved goods can be called for by name at, for example, deli counters. Consumers are more likely to note and remember the words of the cited mark both because they would ask for or refer to the product by the words, and because the abstract design cannot be articulated. Further, we do not accept applicant's reasoning that because BERNER is a surname and CHEESE is a generic term, we are left, by default as it were, to find that the design is the dominant part of the mark. Consumers are used to seeing surnames as trademarks, and will not, simply because a mark contains a surname, look to other elements of the mark for their source-identifying significance.

We think that BERNER also plays a dominant role in applicant's mark, GRANDMA BERNER'S. GRANDMA is a relatively common relationship title, and modifies the surname BERNER, such that the mark projects the image of an

**Ser. No.** 75/434,577

older woman with the surname BERNER. Thus, it is the surname BERNER which makes a strong commercial impression.

Comparing the marks in their entireties, we find that they have strong similarities in appearance, pronunciation and meaning. Both, obviously, contain the name BERNER['S], and the appearance and pronunciation of this word is unaffected by the other elements in the marks. In particular, the word CHEESE and the design element in the registered mark, and the word GRANDMA'S in applicant's mark, do not serve to distinguish the marks. As applicant has pointed out, no one would use the mark BERNER CHEESE and design on ham. Therefore, consumers familiar with the BERNER CHEESE and design mark, and seeing the mark GRANDMA BERNER'S on ham, would ascribe the absence of the word CHEESE to the fact that the product is ham, and assume that GRANDMA BERNER'S is a variant of the BERNER CHEESE and design mark. Both marks convey the same meaning, namely, that they identify products emanating from the Berner family. The BERNER CHEESE mark indicates that the cheese on which the mark is used comes from the Berner family, while the GRANDMA BERNER'S mark suggests that the ham is

made from an old Berner family recipe.<sup>5</sup> All told, the marks convey the same commercial impression.

Applicant argues that because BERNER is a surname, the cited registration, which includes that name, is a weak mark which is entitled to a limited scope of protection. It is essentially applicant's view that the cited mark has not acquired secondary meaning, and therefore must be treated as a weak mark.

Applicant apparently would have us view the cited mark as a weak mark because it does not contain a claim of acquired distinctiveness. However, the presence or absence of a Section 2(f) claim is irrelevant. Regardless of whether the cited registration was issued pursuant to the provisions of Section 2(f) or not, it is still a valid registration which must be given full effect.<sup>6</sup>

Moreover, we cannot conclude, from the 5,636 listings of Berner reported in PhoneDisc,<sup>7</sup> or Mrs. Berner's statement

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<sup>5</sup> In fact, applicant states that his hams are prepared according to a family recipe.

<sup>6</sup> As an aside, we note that the cited registration claims a date of first use of July 1995, and therefore presumably would qualify for Section 2(f) acquired distinctiveness if it were being examined today.

<sup>7</sup> Applicant makes reference to a PhoneDisc search reporting 5,636 listings for the name BENNER which was the last page of the attachments to the Examining Attorney's first Office action. That page does not appear to be in the application file, and in her brief the Examining Attorney states that "any inclusion of a surname search for the term BENNER was inadvertent and is not relevant in the current case concerning the term BERNER." p. 4.

that she believes "Berner to be a well known surname in this and other countries," that Berner is such a common surname that consumers will assume that the two marks at issue herein which contain that surname identify separate sources, when used on the related products of ham and processed cheese. In this connection, we note that there is no evidence in the record of third-party use or registration of any marks containing the surname BERNER. Thus, even if we were to accept, arguendo, applicant's argument that the cited registration is entitled to a more limited scope of protection, that protection would still extend to applicant's use of such a similar mark as GRANDMA BERNER'S for such related goods as "gourmet ham."

Applicant further asserts that "Grandma Berner" is entitled to use her surname on a product with which she is associated, and may, through her consent, grant the asserted right to the use of her name to her son, the applicant herein.

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However, because applicant made repeated references to it, and indeed requested that the Examining Attorney acknowledge this surname evidence and confirm that BENNER was a misspelling, and because the Examining Attorney made no objection during the examination of the application, we deem that the Examining Attorney has stipulated to the surname evidence for the name BERNER. In any event, the Examining Attorney has made clear in her brief that she does not dispute that BERNER is a surname.

It is well established that the interest in allowing an entrepreneur to use his own surname as a trademark on his goods must give way to the more compelling public and private interests involved in avoiding a likelihood of confusion or mistake as to source where use of the surname leads to such confusion or mistake. **Ford Motor Company v. Ford**, 462 F.2d 1405, 174 USPQ 456, 458 (CCPA 1972).

Finally, we have considered applicant's argument that gourmet hams are not casually purchased. Applicant has not provided any evidence as to the selling price of "gourmet hams" which might indicate that an extraordinary degree of care goes into their selection. What is clear, however, is that both applicant's and the registrant's products are purchased by the public at large. Even though consumers may note the specific differences in the marks, as stated above, they will attribute these differences to the differences in the goods, rather than to differences in the source of the goods.

Accordingly, after considering all of the relevant duPont factors, we find that applicant's mark GRANDMA BERNER'S for gourmet hams is likely to cause confusion with the mark in the cited registration.

**Ser. No.** 75/434,577

Decision: The refusal of registration is affirmed.

E. J. Seeherman

C. M. Bottorff

G. F. Rogers  
Administrative Trademark Judges  
Trademark Trial and Appeal Board