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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re World Wide Food Products, Inc.

Serial No. 76457962

Myron Amer, Esq. for World Wide Food Products, Inc.

Tanya Amos, Trademark Examining Attorney, Law Office 113
(Odette Bonnet, Managing Attorney).

Before Seeherman, Quinn and Hairston, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

On October 7, 2002, World Wide Food Products, Inc.
filed an application to register the design and words
reproduced below as a trademark for "salad shrimp."¹

¹ Application Serial No. 76457962, claiming a date of first use
and date of first use in commerce of June 7, 1997.



The design is essentially the front of the package for the goods. The drawing does not reproduce well. The words "A Tradition of Quality Since 1907" and "Salad Shrimp Raw" appear beneath the word GEISHA. About half-way down on the left appears "Low in Fat"; "Peeled & Cleaned"; and "Individually Frozen." At the bottom on the right appears "Enlarged to Show Quality Serving Suggestion"; "Keep Frozen"; "Net. Wt. 1 lb (454g)".

The examining attorney,² inter alia, refused registration of applicant's mark under Section 2(d) of the Trademark Act in view of several previously registered

² The present examining attorney was not the original examining attorney assigned to this application.

GEISHA and "Geisha design" marks, and advised applicant that the drawing of the mark was unacceptable because the details in the drawing page are not clear. In addition, the examining attorney advised applicant that informational matter in the nature of net weight and volume statements, lists of contents, addresses and similar matter must be deleted from the drawing. Further, the examining attorney advised applicant that it must disclaim "A Tradition of Quality Since 1907"; "Salad Shrimp Raw"; and the shrimp design apart from the mark as shown.

Applicant argued against the Section 2(d) refusals, and submitted a substitute drawing with the mark reproduced below.



In addition, applicant submitted a disclaimer of "A Tradition of Quality Since 1907";³ "Salad Shrimp Raw"; and the shrimp design apart from the mark as shown.

After many office actions and responses,⁴ the examining attorney finally refused registration of applicant's mark under Section 2(d) of the Trademark Act in view of the previously registered marks shown below, all owned by Kawasho Foods Corporation:

- (1) GEISHA (in standard character form) for "canned fruits and vegetables and canned and frozen fish and shell fish" (Registration No. 991,554 issued August 20, 1974; first renewal);

- (2)

GEISHA

for "canned crabs, canned tuna, canned clams and canned mandarin oranges" (Registration No. 306,862 issued October 3, 1933; third renewal)

³ Applicant submitted a disclaimer of this phrase despite the fact that its substitute drawing no longer contains the phrase.

⁴ Suffice it to say that this case has a tortured examination/prosecution history.

(3)



for "canned fish and shellfish-namely, canned crabmeat, shrimp, oysters, clams, tuna, sardines, kippers, mackerel, salmon; canned fruits and vegetables-namely, canned mandarin oranges, pineapple, mushrooms, water chestnuts, bamboo shoots, asparagus, and frozen fish (Registration No. 1,162,935 issued July 28, 1981 with the statement that "The drawing is lined for the colors blue, green, red, orange and yellow"; first renewal); and

(4)

GEISHA

for "canned fish and shellfish-namely, canned crabmeat, shrimp, oysters, clams, tuna, sardines, kippers, mackerel, salmon; canned fruits and vegetables-namely, canned mandarin oranges, pineapple, mushrooms, water chestnuts, bamboo shoots, asparagus, and frozen fish (Registration No. 1,162,936 issued July 28, 1981; first renewal).

With respect to applicant's substitute drawing, the examining attorney found that it was unacceptable. She

made final a requirement for a new substitute drawing that includes the phrase "A Tradition of Quality Since 1907" and deletes the picture of the shrimp on a platter. The examining attorney maintains that the current substitute drawing is a material alteration of the mark because it deletes the phrase "A Tradition of Quality Since 1907." Also, the examining attorney maintains that the picture of the shrimp on a platter in the substitute drawing is informational in nature, that is, it simply provides a suggestion for serving. As to the original drawing, the examining attorney continues to maintain that it is unacceptable because it is an illegible photocopy and contains extraneous information.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. An oral hearing was not requested.

Substitute Drawing Requirement

We turn first to the requirement for a new substitute drawing that (a) includes the phrase "A Tradition of Quality Since 1907" and (b) deletes the design of the shrimp on a platter. The examining attorney maintains that applicant's failure to include the phrase "A Tradition of Quality Since 1907" on the substitute drawing is a material alteration. According to the examining attorney:

In the instant case, the applicant's amended drawing page is not acceptable because [on the specimen] the phrase "A Tradition of Quality Since 1907" appears directly below the term GEISHA, and the phrase would be read with the term GEISHA. Moreover, the applicant's specimen shows the term GEISHA and the phrase "A Tradition of Quality Since 1907" in the same color lettering and thus the two phrases appear unitary. (Examining Attorney's Brief at 14).

Applicant has made no argument, in either its brief or reply brief, with respect to the examining attorney's requirement in this regard.

Trademark Rule 2.72 prohibits any amendment of the mark that materially alters the mark on the drawing filed with the original application. The test for determining whether an amendment is a material alteration is as follows:

The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application. TMEP Section 807.14.

In this case, we find that the deletion of the phrase "A Tradition of Quality Since 1907" is not a material alteration of the mark. This phrase is in the nature of "puffery" and has no source-indicating function. Also, we

note that the phrase differs from the word GEISHA in terms of size and type of lettering such that it is not unitary with the word GEISHA.

Insofar as the design of the shrimp on a platter is concerned, the examining attorney maintains that:

The background photograph of the suggested manner of displaying the shrimp on a platter must be deleted because it will not be perceived as a trademark. The shrimp on a platter design simply provides information about how to serve the goods. The most damning piece of evidence supporting the finding that the design of the plate of shrimp is informational is the applicant's own specimen of record. The specimen of record states that the photograph of the shrimp on a platter has been "enlarged to show quality serving suggestion." (Examining Attorney's Brief at 11).

Applicant, on the other hand, argues that "the graphics of the plastic bag [in which applicant's goods are sold] are the source-identifying content" of the mark, and that the picture of the shrimp on a platter is an essential part of the mark. (Brief at 2).

TMEP Section 807.14(a) provides, in pertinent part, that "[i]f a specimen shows that matter included on a drawing is not part of the mark, the examining attorney may require that such matter be deleted from the mark on the drawing, if the deletion would not materially alter the mark." (citation omitted). In this case, the deletion of the design of the shrimp on a platter would be a material

alteration of the mark. Notwithstanding that the design of the shrimp on a platter is a mere representation of the goods (and has been disclaimed), and it is not integrated with the word GEISHA or the design of a geisha, it nonetheless forms part of the mark as shown on the drawing as originally filed.

In view of the foregoing, we find that the examining attorney's requirement for a new substitute drawing is not proper. Thus, applicant's current substitute drawing is acceptable.

Section 2(d) Refusals

We turn next to the refusals to register under Section 2(d) of the Trademark Act. In any likelihood of confusion analysis, we look to the factors set forth in *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), giving particular attention to the factors most relevant to the case at hand, including the similarity of the marks and the relatedness of the goods. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Insofar as the goods are concerned, the examining attorney argues that they are identical in part and otherwise closely related. Applicant, however, argues that its salad shrimp is "a frozen seafood product" which is

different from the goods in the cited registration which are all "canned." (Applicant's Brief at 3). Apart from the fact that not all the goods in the cited registrations are "canned," it is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods recited in the registration, rather than what the evidence shows the goods actually are.

Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); and The Chicago Corp. v. North American Chicago Corp., 20 USPQ2d 1715 (TTAB 1991).

Where the goods in the application at issue and in the cited registrations are broadly described as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). Further, it is a general rule that goods need not be identical or even competitive in order to support a finding of likelihood of

confusion. Rather, it is enough that goods are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used or intended to be used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods. In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

Applicant's goods are identified as salad shrimp, without any limitation as to being sold in frozen form. The goods listed in cited Registration Nos. 1,162,935 and 1,162,936 include canned shrimp; and the goods listed in cited Registration No. 991,554 include canned and frozen shell fish. Because the identifications "canned shrimp" and "canned and frozen shell fish" are broad enough to encompass salad shrimp, applicant's salad shrimp and the registrant's canned shrimp and canned and frozen shell fish are legally identical goods.⁵

⁵ In view thereof, we need not discuss whether the other goods set forth in these cited registrations are related to those listed in the application. See, e.g., Tuxedo Monopoly, Inc. v. General Mills Fun Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) and Shunk Mfg. Co. v. Tarrant Mfg. Co., 318 F.2d 328, 137 USPQ 881, 883 (CCPA 1963).

The goods listed in cited Registration No. 306,862 include canned crabs, canned tuna and canned clams. To establish a relationship between applicant's salad shrimp and registrant's canned crabs, canned tuna and canned clams, the examining attorney has submitted copies of nineteen use-based third-party registrations for marks that cover, inter alia, shrimp, on the one hand, and crabs, tuna, and/or clams, on the other hand.⁶ Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source." See *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n. 6 (TTAB 1988). See also *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993). Under the facts of this case, we find that applicant's salad shrimp, on the one hand, and registrant's canned crabs, canned tuna

⁶ As representative examples, we note: Reg. No. 2,618,409 for the mark VAN DE KAMP'S for "frozen entrees consisting primarily of fish, shrimp, or crab"; Reg. No. 2,482,531 for the mark CAJUN ROYALE for "seafood, namely fish, shrimp, and shellfish"; Reg. No. 2,658,226 for the mark CELEBESEA for "seafood and fresh fish for food purposes, namely, fish, clams, oysters, snails, prawns, lobster and shrimp"; and Reg. No. 2,588,134 for the mark GLOUCESTER PIER for "fish, shellfish, seafood, seafood salads, crab cakes, seafood dips, seafood spreads, cream herring, shrimp cocktails and fried fish fillets."

and canned clams, on the other hand, are closely related goods. Obviously, applicant's salad shrimp and registrant's canned crabs, canned tuna and canned clams are all seafood items. Moreover, all of these seafood items as well as registrant's canned shrimp and canned and frozen shell fish are sold in the same channels of trade (such as grocery stores, and the grocery sections of mass merchandisers) to the same class of purchasers (the general public). Applicant's and registrant's goods are, in part, legally identical, and otherwise so closely related that, if sold under the same or similar marks, confusion as the source or sponsorship thereof would be likely to occur.

Turning, therefore, to a consideration of the respective marks, the examining attorney argues that the dominant portion of applicant's mark is the word GEISHA, and that this term is very similar to each of the marks in the cited registrations. Applicant, however, argues that the word GEISHA is not the dominant or source-identifying portion of its mark. In particular, applicant argues that the word GEISHA "is descriptive of the 'oriental figure with fan'" and has offered to disclaim the word. Applicant maintains that the "special form front panel of the plastic bag" is the dominant portion of its mark and that applicant's mark and the marks in the cited registrations

are sufficiently distinguishable to avoid a likelihood of confusion. (Applicant's Brief at 2).

With respect to the marks, we must determine whether applicant's mark and registrant's marks, when compared in their entireties, are similar or dissimilar, viewing them in terms of sound, appearance, connotation and commercial impression. Although the marks must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Furthermore, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

With the above principles in mind, we agree with the examining attorney that, when considered in their

entireties, applicant's mark and each of the registered marks are substantially similar in sound, appearance, connotation and commercial impression. First, although applicant has characterized the word GEISHA as being descriptive and has offered to disclaim it, the word GEISHA is not descriptive of the goods in applicant's application. While, as discussed infra, the word GEISHA is the legal equivalent of the design of a geisha, GEISHA is not descriptive of salad shrimp. Rather, the word GEISHA is arbitrary as applied to such goods. In view thereof, and due to its prominent display, it is the word GEISHA that is the dominant portion of applicant's mark. It is this portion of applicant's mark which is most likely to be impressed upon a customer's memory, and the portion of the mark that a customer will use to refer to and call for the goods. The geisha design in applicant's mark reinforces the impression of the word GEISHA. As for the disclaimed phrase "Salad Shrimp Raw," it is descriptive, and thus entitled to less weight in our likelihood of confusion analysis. The picture of the shrimp on a platter and the other background designs add little, if any, impact to the overall commercial impression created by the mark.

In short, the phrase "Salad Shrimp Raw" and the background designs do not change the overall commercial

impression projected by applicant's mark, which is dominated by the presence therein of the arbitrary term GEISHA and reinforced by the geisha design.

The dominant portion of applicant's mark is virtually identical to registrant's GEISHA word marks in standard character and stylized forms, and the addition of the geisha design in applicant's mark does not distinguish its mark from these cited marks, but actually reinforces the similarity of the marks. We note that insofar as registrant's mark GEISHA in standard character form is concerned, because it is not limited to any particular depiction, it may be displayed in the same stylized form as the word GEISHA in applicant's mark. Further, the word GEISHA in applicant's mark is depicted in the same stylized lettering as registrant's mark GEISHA in Registration No. 306,862 and in similar stylized lettering to registrant's mark GEISHA in Registration No. 1,162,936. Thus, when we consider applicant's mark and registrant's GEISHA word marks in their entirety, we find that they are very similar in sound, appearance, connotation and commercial impression.

Insofar as registrant's geisha design mark is concerned, as the examining attorney correctly notes, the doctrine of legal equivalents holds that a pictorial

representation and its literal equivalent impress the same mental image on purchasers. See *Izod, Ltd. v. Zip Hosiery Co., Inc.*, 405 F.2d 575, 160 USPQ 202, 204 (CCPA 1969) [mark TIGER HEAD for men's work socks is likely to be confused with registered tiger-head design for men's and ladies' shirts] and *Clover Farm Stores Corp. v. James G. Gill Co., Inc.*, 142 USPQ 233, 234 (TTAB 1964) [mark "RED BAG" for coffee is likely to cause confusion with a red bag used as a container for coffee]. Thus, applicant's mark, which includes the dominant word GEISHA as well as a geisha design, conveys the same connotation and commercial impression as registrant's geisha design mark, and the marks are very similar in appearance notwithstanding that the geisha designs themselves are slightly different.

In this case, purchasers familiar with any of registrant's GEISHA word or "geisha design" marks for, in particular, canned shrimp, canned and frozen shell fish, canned crabs, canned tuna, or canned clams, upon encountering applicant's GEISHA and design mark for salad shrimp, would be likely to believe that the goods originated with or were somehow sponsored by the same source.

In support of its position that there is no likelihood of confusion, applicant has submitted a document entitled

"Trademarks Sublicense Agreement." This agreement was executed February 25, 2005 between applicant (as "Sublicensee") and JFE Shoji Trade America Inc. (as "Sublicensor"). In the agreement, JFE Shoji Trade America Inc. is identified as the "Master Licensee" of the mark GEISHA in standard character form (Registration No. 991,554) and the mark shown below,



(Registration No. 1,162,935)(two of the registrations cited herein). Applicant claims that this agreement reflects a "consent agreement" between it and the registrant. Applicant points to paragraph 12 of the agreement (reproduced below) as evidence of registrant's consent:

Advertising, Promotion, Approvals: Sublicensee agrees that it will cause to appear on or within each Product sold by it under this sublicense and on or within all advertising, promotional or display material relating to the Trademarks, Sublicensor's logos (including the name "GEISHA" and the drawing of the GEISHA character)(which are the subject of United States Registration Nos. [991,554 and 1,162,935] along with the registered trademark symbol and, on the

packaging, a legend stating that "GEISHA" and Sublicensor's logo comprise a registered trademark of Master Licensor. In the event that any Product is marketed in a carton, container and/or packaging or wrapping material, each and every tag, label, imprint or other device shall contain Sublicensor's logo, and copyright and advertising, promotional or display material bearing the Trademarks shall be submitted by Sublicensee to Sublicensor for express written approval prior to use by Sublicensee. Sublicensee shall cooperate fully and in good faith with Sublicensor for the purpose of securing and preserving Sublicensor's rights in and to the Trademarks. In the event there has been no previous registration of the Trademarks and/or Products and/or any material relating thereto, Sublicensor shall be entitled to register such as a copyright, trademark and/or service mark in the appropriate class in such name as Sublicensor or Master Licensor may designate, at Sublicensor's sole cost and expense. It is agreed that nothing contained in this Agreement shall be construed as an assignment or grant to Sublicensee of any right, title or interest in or to the Trademarks, it being understood that all rights relating thereto are reserved by Sublicensor and Master Licensor except for the sublicense hereunder to Sublicensee of parties hereto. No waiver by either party of a breach or a default hereunder shall be deemed a waiver by such party of a subsequent breach or default of like or similar nature.

Obviously, in appropriate circumstances, consent agreements are entitled to substantial weight in determining likelihood of confusion. See *Bongrain International (America) Corp. v. Delice De France, Inc.*, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987). Here, however, we do not have a consent agreement between

applicant and registrant. What we have is a license by JFE Shoji Trade America Inc., as the Master Licensor of registrant's marks, authorizing applicant to use the marks which are the subject of Registration Nos. 991,554 and 1,162,935. While the license provides that applicant shall submit any packaging it intends to use to JFE Shoji Trade America Inc. for approval, and thus presumably JFE has "approved" applicant's packaging, this is not a consent by the owner of the cited registrations, namely, Kawasho Foods Corporation, to registration of applicant's involved mark. Even if we were to consider JFE Shoji Trade America Inc. as the registrant's agent, the license provides applicant only the right to use the packaging, not to register it. As case law recognizes, there is a difference between granting a party the right to use a mark, and the right to register it. See *In re Wilson Jones Company*, 337 F.2d 747, 143 USPQ 238 (CCPA 1964). [A license to use a mark is not the equivalent of a consent by the owner of the cited mark to permit registration of the mark by the licensee]. To be clear, neither paragraph 12 nor any of the other paragraphs in the agreement evidence registrant's consent to applicant's registration of the involved mark.

In view of the foregoing, we conclude that applicant's use of the mark GEISHA and design in connection with salad

Ser No. 76457962

shrimp is likely to cause confusion with registrant's GEISHA word and "geisha design" marks for canned shrimp, canned and frozen shell fish, canned crabs, canned tuna, and canned clams.

Decision: The refusals to register under Section 2(d) of the Trademark Act in view of each of the cited registrations are affirmed. The requirement for a new substitute drawing is reversed. In view of our finding that the current substitute drawing is acceptable, if applicant were to appeal from our decision and were to ultimately prevail, it must submit a new disclaimer which deletes reference to "A Tradition of Quality Since 1907."