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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dona Stiles

Serial No. 76493965

Dona Stiles, pro se.

Andrew Benzmilller, Trademark Examining Attorney, Law Office
116 (M. L. Hershkowitz, Managing Attorney).

Before Hanak, Bucher and Zervas, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Dona Stiles (applicant) seeks to register in standard character form ISLAND NUTRITION for "vitamins, mineral supplements, nutritional supplements and herbal supplements containing amino acids, enzymes, phytonutrients, marine extracts and herbal extracts." The application was filed on February 28, 2003 with a claimed first use date of August 11, 1995. In her application, applicant voluntarily disclaimed

the exclusive right to use NUTRITION apart from the mark in its entirety.

Citing Section 2(d) of the Trademark Act, the Examining Attorney refused registration on the basis that applicant's mark, as applied to applicant's goods, is likely to cause confusion with the mark ISLAND BERRIES, previously registered in standard character form for "dietary supplement smoothie." Registration No. 2,712,051. This registration contains a disclaimer of the exclusive right to use BERRIES apart from the mark in its entirety.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Considering first the goods, we find that registrant's goods (dietary supplement smoothie) are extremely similar to

at least certain of applicant's goods, and in particular, "nutritional supplements." As is obvious, registrant's goods are not just a "smoothie," but rather are a particular type of smoothie, namely a "dietary supplement smoothie." In her Request for Reconsideration dated October 8, 2004, applicant attached a number of advertisements placed by registrant for its dietary supplement smoothies. These advertisements demonstrate that registrant's dietary supplement smoothies can also be described as nutritional supplement smoothies. One of registrant's advertisements touts the fact that its smoothies "serve as a meal replacement" and are "custom blended with a choice of eighteen different nutritional supplements." All of registrant's advertisements, made of record by applicant, demonstrate that dietary supplement smoothies contain various nutritional supplements. In other words, the evidence selected by applicant shows that the term "dietary supplement smoothie" and the term "nutritional supplement smoothie" are, if not identical, almost so.

In an effort to distinguish her particular nutritional supplements from registrant's dietary supplement smoothies, applicant makes the mistake of focusing on her actual goods and registrant's actual goods, as opposed to considering the goods as described in the application and registration. At

page 5 of her brief, applicant notes that her nutritional supplements are "pre-packaged vitamin-like goods," whereas registrant's goods are "made-to-order smoothies" sold on premises. It is fundamental that in Board proceedings, "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis a the goods and/or services recited in [the cited registration], rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). To be blunt, applicant seeks to register her mark ISLAND NUTRITION for, among other goods, "nutritional supplements." The term "nutritional supplements" is a very broad term which, as the evidence of record demonstrates, can include a "smoothie." In sum, as noted before, we find that registrant's goods (dietary supplement smoothie) are encompassed by the broad term "nutritional supplements," one of applicant's goods. Thus, as described in the application and registration, certain of applicant's goods (nutritional supplements) are virtually legally identical, if not legally identical, to registrant's "dietary supplement smoothie."

Turning to a consideration of the marks, we are obligated to compare the marks "in their entirety." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 750 (Fed. Cir. 1985). However, in comparing marks in their entirety, it is completely appropriate to give less weight to a portion of a mark that is merely descriptive of the relevant goods or services. National Data, 224 USPQ at 751 ("That a particular feature is descriptive ... with respect to the relevant goods or services is one commonly accepted rationale for giving less weight to a portion of the mark.").

Both two word marks begin with the entirely arbitrary word ISLAND. Applicant has not made of record any evidence whatsoever showing that ISLAND is in any way descriptive of either her goods or registrant's goods. The record does not reflect that any third party is using as its mark (or as part of its mark) the term ISLAND for nutritional supplements or any other products that are related to either applicant's goods or registrant's goods.

The words NUTRITION (part of applicant's mark) and BERRIES (part of registrant's mark) are merely descriptive of the goods of applicant and registrant and have quite properly been disclaimed. Clearly, as applied to nutritional supplements and applicant's other goods, the word NUTRITION

is descriptive. Likewise, as applied to "dietary supplement smoothies" (registrant's goods), the term BERRIES merely describes the content and/or flavor of the smoothie.

Not only is the word ISLAND the dominant portion of both marks, but in addition, it is "the first word" in both marks, an additional factor which makes "the marks similar." Palm Bay Imports, Inc. v. Veuve Clicquot, 396 F.3d 1396, 73 USPQ2d 1689, 1690 (Fed. Cir. 2005). See also Presto Products v. Nice-Pak Products, 9 USPQ2d 1895, 1897 (TTAB 1998) (The fact that two marks share the same word is generally "a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.")

Finally, it must be remembered that both applicant's mark and registrant's mark are depicted in standard form character (typed drawing form). This means that the two marks are not limited to being "depicted in any special form," and hence we are mandated to "visualize what other forms the mark[s] might appear in." Phillips Petroleum Co. v. C. J. Webb Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). See also INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992). One reasonable manner of presentation for both marks would be to depict the entirely

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arbitrary portion ISLAND in large lettering on one line, and then depict the subordinate elements (NUTRITION or BERRIES) in decidedly smaller lettering on a second line. When so depicted, the two marks would be extremely similar, and their use on virtually identical goods would result in not a mere likelihood of confusion, but rather in an extremely high probability of confusion.

Decision: The refusal to register is affirmed.