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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re L. Perrigo Company

Serial No. 76495506

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LLP for L. Perrigo Company.

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Before Holtzman, Drost and Zervas, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On March 7, 2003, applicant, L. Perrigo Company,
applied to register the mark DIET SMART, originally
depicted in a typed drawing, on the Principal Register for
goods identified as "dietary supplements" in Class 5.¹
Applicant has disclaimed the term "Diet." Subsequently,

¹ Serial No. 76495506. The application was originally based on an allegation of a bona fide intention to use the mark in commerce. Applicant filed an amendment to allege use that set out July 21, 2003, as the date of first use anywhere and in commerce.

applicant amended the drawing to depict the mark in the stylized form shown below.



Diet
Smart

The examining attorney has refused to register applicant's mark on the ground that it is confusingly similar under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) to a prior registration for the mark DIETSMART (in typed or standard form) for "providing information in the fields of fitness, food, dieting and exercise by means of a website on a global computer network" in Class 42.²

The examining attorney argues that the differences between the marks are minimal and that "the average purchaser will not remember lettering style or whether identical wording was spaced. What consumers are likely to recall is the sound and meaning of the mark." Brief at unnumbered p. 3. Regarding the goods and services, the examining attorney maintains that the "evidence of record also demonstrates that dietary supplements and providers of information about fitness, food, dieting and exercise are likely to be encountered by the same consumer, possibly at a single web site." Brief at unnumbered p. 4.

² Registration No. 2,493,454, issued September 25, 2001.

Applicant responds by pointing to registrant's actual website and arguing that "the DIETSMART program is a membership program which is personalized for each individual and covers personalized meal plans, depending upon the desired weight loss and time period." Brief at 6. "The cited mark 'DIETSMART,' when used in connection with the services, connotes to the consumer that the services ... relate to a daily meal plan and counseling regimen for weight loss." Brief at 8. Applicant, on the other hand, contends that its mark "connotes to the consumer that taking vitamins may be smart for one's overall diet and health." Id. Furthermore, vitamins "are typically consumed on a daily basis by many consumers, regardless of their weight, as a preventive medicine and as a proactive health measure.... [Registrant's services] are directed to individuals desiring to lose weight and the services are ... customized diet plans for members who must specifically sign up for such services." Brief at 9.

After the examining attorney made the refusal final, this appeal followed.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I.

du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor that we will consider is the similarities and dissimilarities of applicant's and registrant's marks. The marks are for the same words DIETSMART. There are two differences between the marks. First, registrant spells the words DIETSMART without a space while applicant's mark is spelled in the more traditional way with a space. The presence or absence of a space between identical words does not significantly change the appearance of the marks. Stockpot, Inc. v. Stock Pot Restaurant, Inc., 220 USPQ 52, 54 (TTAB 1983), aff'd, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) ("There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical"); In re Best Western Family Steak House, Inc., 222 USPQ 827, 827

(TTAB 1984) ("There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical"). Also, depicting the words in the mark on two lines instead of one is a difference that many consumers are unlikely to remember or to attach any trademark significance.

The second difference is the fact that applicant's mark is in stylized form while registrant's mark is in typed form. A typed drawing indicates that the party is not limiting its mark to any particular style. "[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a *difference* cannot legally be asserted by that party. [Applicant] asserts rights in [its mark] regardless of type styles, proportions, or other possible variations. Thus, apart from the background design, the displays must be considered the same." Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). See also Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) ("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce"); Phillips Petroleum Co. v. C. J. Webb, Inc., 442 F.2d 1376, 1378, 170 USPQ 35, 36 (CCPA

1971) (The drawing in the application "shows the mark typed in capital letters, and ... this means that [the] application is not limited to the mark depicted in any special form"). Therefore, registrant's mark must be considered to include a stylization that is similar to applicant's.

Regarding the marks' similarities, we note that the pronunciation of the marks is identical. As explained above, there are minor differences in the appearances of the marks but these differences are overwhelmed by the fact that both marks consist of the identical words in the identical order, DIET SMART. Furthermore, inasmuch as the words are the same, we are unable to discern any significant differences in the meanings of the marks. It is not clear why registrant's mark when used in association with its website would not mean that it is "smart for one's overall diet and health" as applicant suggests is the meaning of its mark on its goods. Finally, the commercial impression of the identical words would also be at least very similar. "Without doubt the word portions of the two marks are identical, have the same connotation, and give the same commercial impression." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). Therefore, we conclude that this factor favors the examining attorney's position. See In re Dixie Restaurants

Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Federal Circuit held that, despite the addition of the words "The" and "Cafe" and a diamond-shaped design to registrant's DELTA mark, there still was a likelihood of confusion). See also In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (BIGG'S (stylized) for grocery and general merchandise store services found likely to be confused with BIGGS and design for furniture). Not only does this factor favor a determination of likelihood of confusion, but the "identity of words, connotation, and commercial impression weighs heavily against the applicant." Id.

The next factor we discuss is whether the goods and services of applicant and registrant are related. Applicant's goods are dietary supplements while registrant's services involve providing information in the fields of fitness, food, dieting and exercise by means of an Internet website. Clearly, inasmuch as applicant is using its mark on goods and the registered mark is for services, the goods and services are not identical.

It is a well settled principle of trademark law 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 for purposes herein that 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 similarity of the marks used therewith, give rise to the mistaken belief that they originate from or are in some way associated with the same producer.

In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

The record contains evidence that supports the relationship between dietary supplements and providing information about dieting. This evidence includes a description of the Atkins diet that points out that in "order to avoid health problems caused by vitamin deficiencies during this period [of the Atkins diet], vitamin and mineral supplements form an essential part of this phase of the diet."³ There are also several web pages for "Atkins Diet Nutritional Products." These products include: Atkins Basic #3 (90 tablets) - "a comprehensive vitamin, mineral, herbal and antioxidant supplement specifically designed to support low-carb weight loss."⁴ Another website, www.diet-i.com, provides diet information about the Atkins diet online. The site also contains information about dietary supplements. This site also

³ www.wikipedia.org.

⁴ Applicant points out that the "pages of the Atkins plan, however, do not use the term 'diet smart.'" Brief at 5. The evidence was not submitted to show use of the mark but rather the relationship between the goods and services.

offers diet information including "free information on diets, weight loss diet programs like Weight Watchers, Atkins, Zone, South Beach, diet pills, fad diets, and general diet advice on weight reduction and good diet nutrition." This information indicates that there is a relationship between website diet plans and nutritional supplements and that a diet plan provider, such as Atkins, may also be the source of dietary supplements.

While applicant points to some specific characteristics of registrant's website, to the extent that these limitations are not contained in the identification of goods, they do not limit our consideration of registrant's services. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed"). See also Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of

likelihood of confusion must be decided on the basis of the respective descriptions of goods" or services).

Furthermore, applicant points out that dietary supplements "are packaged for sale on retail store shelves" (Brief at 9). However, it has not limited its channels of trade to retail store sales and we must consider that applicant's channels of trade include the Internet and other reasonable trade channels for its goods. Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989) ("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages"). We also add that there is no evidence that purchasers of these goods and services are sophisticated purchasers. Rather, purchasers or users of these goods and services are likely to overlap and they would include ordinary purchasers who are simply interested in better nutrition and losing weight. While these purchases may not be impulse purchases, they would include purchasers simply exercising ordinary care in buying vitamins and searching for diet, exercise, food, or fitness information.

We find that prospective purchasers are likely to believe that the sources of dietary supplements and an Internet website that provides information in the fields of fitness, exercise, food and dieting are likely to be related or associated in some way.

One additional point that applicant makes (brief at 10-11) is that:

the number of marks employing the exact word "diet" as part of a mark in Class 5 for dietary supplements at the time of filing Applicant's first response on March 1, 2004, equaled or exceeded 107. The number of marks which included the exact term "smart" as part of the mark in Class 5 for dietary supplements equaled or exceeded 40. Thus, no fewer than 147 marks were pending or registered for dietary supplements which include these commonly employed exact terms.

The examining attorney has objected to this "evidence." In its reply brief (p.2), applicant acknowledges that it did not provide copies of the registrations and applications⁵ but applicant maintains that "it seems counterproductive to burden the file with 200 to 300 copies of registrations and applications for search results that a few keystrokes will provide." We reject applicant's argument. We do not consider new evidence submitted with appeal briefs. 37 CFR 2.142(d). Furthermore, we do "not take judicial notice of third-party registrations, and the mere listing of them is

insufficient to make them of record." In re Carolina Apparel, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998). See also In re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983) ("[W]e do not consider a copy of a search report to be credible evidence of the existence of the registrations and the uses listed therein"). Third, pending applications are not probative evidence of others' uses of a mark. Olin Corp. v. Hydrotreat, Inc., 210 USPQ 62, 65 n.5 (TTAB 1981) ("Introduction of the record of a pending application is competent to prove only the filing thereof"). See also Zappia-Paradiso, S.A. v. Cojeva Inc., 144 USPQ 101, 102 n.4 (TTAB 1964). Fourth, it is applicant's responsibility to submit the evidence that it believes supports its arguments. "If an applicant has relevant information, it is incumbent on applicant to make this information of record." In re Planalytics Inc., 70 USPQ2d 1453, 1457 (TTAB 2004) ("Applicant's only response to this requirement was to refer the examining attorney to its website. Applicant's curt dismissal of the requirement for information by telling the examining attorney, in effect, 'to look it up herself,' is inappropriate"). Finally, even

⁵ It also did not provide any basic information about these applications or registrations, such as the complete mark, the goods, or the status.

if these registrations were properly of record, as "to the strength of a mark, however, registration evidence may not be given *any* weight." Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (emphasis in original). See also AMF Inc. v. American Leisure Prods., Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ("The existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them").

We have taken into consideration that the term "Diet" is at least descriptive of dietary supplements and providing information about diets and that "Smart" may have a suggestive connotation. However, the marks DIET SMART (stylized) and DIETSMART contain identical words and the goods and services are related. Users of registrant's DIETSMART website concerning fitness, food, dieting, and exercise who encounter the identical words used on dietary supplements that are associated with dieting are likely to believe that there is some association with the registrant. Therefore, we conclude that there is a likelihood of confusion in this case.

Decision: The examining attorney's refusal to register applicant's mark DIET SMART (stylized) for "dietary supplements" on the ground that it is likely to

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cause confusion with the cited registered mark used in connection with the identified services under Section 2(d) of the Trademark Act is affirmed.