

**THIS OPINION  
IS NOT A PRECEDENT OF  
THE TTAB**

Mailed: September 27, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Chocolates A La Carte, Inc.

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Serial No. 76510408

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Michael A. Painter of Isaacman, Kaufman & Painter for  
Chocolates A La Carte, Inc.

Chris Wells, Trademark Examining Attorney, Law Office 106  
(Mary I. Sparrow, Managing Attorney).

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Before Walters, Grendel and Zervas, Administrative Trademark  
Judges.

Opinion by Walters, Administrative Trademark Judge:

Chocolates A La Carte, Inc. has filed an application to register the mark SIGNATURE CHOCOLATES BY RENA in standard character form on the Principal Register for "chocolate and desserts, namely, pastries and frozen confections," in International Class 30.<sup>1</sup> The application includes a disclaimer of CHOCOLATES apart from the mark as a whole.<sup>2</sup>

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<sup>1</sup> Serial No. 76510408, filed April 11, 2003, based on use of the mark in commerce, alleging first use and use in commerce as of January 1, 2003.

<sup>2</sup> During examination, the examining attorney withdrew an earlier requirement for a disclaimer of the term SIGNATURE. The electronic

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark SIGNATURE CHOCOLATES, previously registered for "chocolate and fudge candy,"<sup>3</sup> that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We reverse the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by

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records of the USPTO incorrectly indicate that the application includes a disclaimer of SIGNATURE CHOCOLATES.

<sup>3</sup> Registration No. 3052948 issued January 31, 2006, to Signature Fundraising, Inc. The registration includes a disclaimer of CHOCOLATES apart from the mark as a whole.

Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Considering, first, the goods involved in this case, we must limit our analysis to the goods recited in the application vis-à-vis the goods recited in the registration. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, the goods need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that the 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 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; and

*Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

Both applicant's goods, "chocolate and desserts, namely, pastries and frozen confections," and registrant's goods, "chocolate and fudge candy," include "chocolate." Registrant's "fudge candy" is also closely related thereto. The examining attorney submitted six third-party registrations including in the identifications of goods chocolate, fudge, pastries and ice cream to demonstrate that the public may be accustomed to seeing these goods identified by the same mark emanating from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). Moreover, applicant does not argue that the goods are unrelated. Therefore, we find the goods to be the same in part and otherwise closely related. This *du Pont* factor favors a likelihood of confusion.

Because the goods are identical, in part, and otherwise closely related, the channels of trade and purchasers, i.e., all those normal for these types of goods, are essentially the same. Thus, the *du Pont* factors of similarity of trade channels and purchasers also favor a likelihood of confusion.

Considering next the marks, the examining attorney contends that the BY RENA portion of applicant's mark is

essentially a house mark and that applicant's mark encompasses the registered mark in its entirety with the mere addition of a house mark<sup>4</sup>; that the SIGNATURE CHOCOLATES portion of applicant's mark is a primary element in applicant's mark; and that SIGNATURE is a strong term as applied to chocolate confections.

Regarding registrant's mark, applicant argues that CHOCOLATES is merely descriptive and SIGNATURE is a laudatory, and, thus, a weak term; and that the BY RENA portion of its mark is sufficient to distinguish the marks. Applicant contends that the Register contains numerous marks containing the term SIGNATURE registered to third parties in International Class 30 for candy or related food products. In support of this statement, in its April 12, 2004 response, applicant listed fourteen marks, noting the registration numbers and goods. This is not the proper means for introducing third-party registrations into the record. However, the examining attorney did not object to the form of the evidence and, in fact, discussed the registrations. Therefore, we have considered this list as part of the record; although we note that it is of limited probative value because we do not have all of the relevant information about these registrations, e.g., the names of

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<sup>4</sup> The application includes a claim of ownership of two registrations, both for the mark RENA - No. 2225715 for "catering services featuring

the registrants to determine whether several registrations are owned by one party. We also note that each mark includes, in addition to the word SIGNATURE, other words quite different from the marks in this case<sup>5</sup>; and only three of the listed registrations are for the goods involved herein, i.e., candy, chocolate and/or frozen confections.<sup>6</sup>

While the application as filed included a disclaimer of CHOCOLATE, the examining attorney initially also required a disclaimer of SIGNATURE and made of record numerous references from Internet websites showing use of "signature chocolate(s)" by retailers and hotels, e.g., "These Marshall Field's signature Frango chocolates are the perfect fit for any occasion..."; "They've been a Marshall Field's signature item for 75 years."; and "From fresh inroom flowers, the hint of paperwhites on your luxurious sheets or your brandy or port ... and of course, our signature chocolates." The examining attorney later withdrew the disclaimer requirement for SIGNATURE; however, the evidence remains of record and is relevant to our determination of the strength or weakness of the registered mark.

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custom designed chocolate desserts"; and No. 2598690 for "chocolate and desserts, namely, bakery goods, pastries and frozen confections."

<sup>5</sup> One of the listed third-party registrations, No. 2405167, also for candy and chocolate, is for the mark KIRKLAND SIGNATURE CHOCOLATES OF THE WORLD.

<sup>6</sup> Two of these three registrations are likely to be owned by the same entity - No. 1405167 for the mark KIRKLAND SIGNATURE CHOCOLATES OF THE WORLD and No. 2309500 for the mark KIRKLAND SIGNATURE.

The issue is whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. 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 overall commercial impressions that confusion as to the source of the goods 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).

In this case, there is sufficient evidence of the use and registration<sup>7</sup> of the term SIGNATURE in connection with candy and chocolates to warrant the conclusion that SIGNATURE CHOCOLATE is a weak, highly suggestive term in connection with these goods.

Even if we were to conclude that BY RENA is a house mark or trade name, which we do not do on this record, the presence of a trade name may or may not eliminate a likelihood of confusion between the entire marks. Contrary to the examining attorney's contention, there is no flat

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<sup>7</sup> The third-party registrations are not evidence of use; rather, they function in the manner of a dictionary and, thus, are indicative of the

rule that the presence of a "house mark" in combination with a similar product mark will never prevent a likelihood of confusion. See 3 J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §23:43 (4<sup>th</sup> ed. 2007). In *In re S. D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984), the Board stated the following (at pp. 55-56):

Although it has often been said that the addition of a trade name, house mark, or surname to one of two otherwise confusingly similar marks will not generally serve to avoid a likelihood of confusion between them, exceptions to this general rule are made (1) when there are recognizable differences between the assertedly conflicting product marks, or (2) when the alleged product marks are highly suggestive or merely descriptive or play upon commonly used or registered terms. [citations omitted]

See also *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *Rockwood Chocolate Co. v. Hoffman Candy Co.*, 372 F.2d 552, 152 USPQ 599 (CCPA 1967); and *In re Merchandising Motivation, Inc.*, 184 USPQ 364 (TTAB 1974).

In the present case, the presence of the phrase BY RENA in applicant's mark alleviates the likelihood of confusion with registrant's mark. The factor of the marks overwhelmingly weighs against a finding of likelihood of confusion.

Therefore, we conclude that, despite the identity, in part, and otherwise close relationship between applicant's

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laudatory nature of the term SIGNATURE CHOCOLATE in connection with the

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identified goods and the goods in the cited registration, the examining attorney has not established that the marks are sufficiently similar that the contemporaneous use of these marks on the identified goods is likely to cause confusion as to the source or sponsorship of such goods.

*Decision:* The refusal under Section 2(d) of the Act is reversed.

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goods.