THIS DECISION
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Mailed:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Upper Crust Ltd.

Serial No. 78320666

Mark Kushner of Kushner & Jaffee for Upper Crust Ltd.

Won T. Oh, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Seeherman, Zervas and Kuhlke, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On October 30, 2003, Upper Crust Ltd. ("applicant") filed an application (application Serial No. 78320666) for registration on the Principal Register of the mark

for goods ultimately identified as

fully baked, par-baked, proof-and-bake and frozen bakery products, namely - bread; baguettes; puff

> pastry, namely, turnovers, strudel, puff pastry squares, puff pastry slabs, puff pastry sticks, puff pastry formed in the shape of fans and palm leaves, puff pastry rolls with sausage filling, and puff pastry rolls with ground beef filling; danish pastry, namely, twisted danish pastry, rolled danish butter horns, cheese and fruit filled danish pastry, danish dough slabs, and coffee cake; cinnamon rolls; and croissants, all for wholesale distribution[,]

in International Class 30. Applicant claims first use anywhere and first use in commerce in 1982.

The examining attorney has finally refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles two previously registered marks, owned by the same entity. First, the examining attorney has refused registration in view of Registration No. 2038106 for the mark

for "cookies, namely, Italian dipping cookies," in International Class 30.[1] Registrant has disclaimed the term BISCOTTI in this mark. Second, the examining attorney has

[1] Registration No. 2038106, issued February 18, 1997; section 8 accepted, section 15 acknowledged.

refused registration in view of Registration No. 2424360 for the mark

for "cookies, namely chocolate-covered pieces of Italian dipping cookies" in International Class 30.[2] Registrant has disclaimed the terms BISCOTTI and ITTI-BITTIES in this mark.

Applicant has appealed the final refusal of its application. Both applicant and the examining attorney have filed briefs. As discussed below, the refusal to register is affirmed.

Our determination of the issue of likelihood of confusion 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). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations

[2] Registration No. 2424360, issued January 30, 2001.

are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first consider the similarities of the marks viewed in their entireties. Specifically, we consider whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We do not consider whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar that confusion as to the source of the goods or services offered under the respective marks is likely to result.[3]

Both applicant's and registrant’s marks contain a word component and a design component. We agree with the examining attorney that the word portion of the marks

[3] In this regard, we do not accept applicant’s contention at p. 10 of its brief that professional buyers with grocery stores would make a side-by-side comparison of applicant's and registrant’s goods and marks. Applicant has not supported its contention with any evidence showing that professional buyers with grocery stores would compare marks on a side-by-side basis when they order various products, or that they would order all bakery and cookie products at the same time, including items for their bakery cases and packaged items.

dominates over the design portions of both applicant's and registrant's marks.[4] Applicant's design functions as a border or carrier which has minimal, if any impact in forming the commercial impression of applicant's mark. The design components of registrant's marks give the effect of a background for the words. Certainly, they are not so distinctive as to draw the attention of purchasers to the design and away from the word portions of the marks. Further, to the extent that purchasers will refer to the goods such as when making purchases of the goods by telephone, they will use the wording in the marks and not refer to the designs.

When we consider the wording of the marks, we find them to be similar in sound, connotation and commercial impression. The only wording in applicant's mark is UPPER CRUST, which also appears on the top portions of both of registrant's marks along with BISCOTTI in Registration No. 2038106 and BISCOTTI and ITTI-BITTIES in Registration No. 2424360. BISCOTTI, of course, is a generic term for registrant's goods, which has been disclaimed in each registration. In view of the generic

[4] Although the marks must be considered in their entireties, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

significance of BISCOTTI in connection with registrant's identified goods, it has no source-identifying value, and it is the arbitrary term UPPER CRUST that creates the commercial impression of registrant's mark UPPER CRUST BISCOTTI and design.

With respect to the second cited mark, we acknowledge that ITTI-BITTIES is prominently displayed in this mark, but its impact is as a product mark, with UPPER CRUST appearing to be the house mark. Thus, the fact that this mark includes this additional term and applicant's mark does not does not serve to distinguish the marks; consumers will not view ITTI-BITTIES as indicating a separate source of the goods, but will still view UPPER CRUST as the source-indicating portion.

Applicant has argued that UPPER CRUST is not the dominant portion of the cited registrations but "the overall design and the wording 'BISCOTTI' and the wording 'ITTI-BITTIES' form the dominant portion of the cited registrations. … The marks set forth in the cited registrations when considered in light of the goods on which they are used, clearly convey the impression of an Italian cookie. Indeed, the overall shape of the cited registrations, i.e., the circular configuration with the swirled portion of the mark, conveys the impression of a

cookie." Brief at pp. 7 – 8. We disagree. As noted above, the word BISCOTTI would not be perceived as the source indicator for the goods, while the inclusion of ITTI-BITTIES in the manner of a product mark does not take away from the house mark significance of the UPPER CRUST portion. Although applicant's suggestion that the cited marks resemble an Italian cookie is an interesting one, the design of a cookie is not so readily discernible. We therefore find it unlikely that consumers, even the professional buyers who would be the common customer for the goods, will undertake the kind of analysis that would allow them to conclude that the design portion of the marks are such a representation.

Thus, when we consider the marks as a whole, in view of the common dominant element UPPER CRUST in the marks, we find them to be similar in meaning, sound and commercial impression, and any differences in appearance are outweighed by such similarities. We therefore resolve the *du Pont* factor of the similarity of the marks against applicant.

With regard to the *du Pont* factor regarding the similarities of the goods, we note that applicant has not discussed this in its briefs, which may indicate that it does not contest that the goods are similar. In any event,

because both applicant's and registrant's goods are bakery goods, including dessert items, we find them to be closely related. This *du Pont* factor is therefore resolved against applicant.

We next consider the *du Pont* factor involving the similarity of established, likely-to-continue trade channels. Although registrant's identifications of goods do not include any trade channel limitations, applicant has limited its identification of goods to wholesale distribution. Applicant states that "a restriction in the channels of trade will tend to avoid likelihood of confusion," relying on the Board's opinion in *In re The Shoe Works Inc.*, 6 USPQ2d 1890 (TTAB 1988). Brief at p. 10. We are not persuaded by applicant's argument and its reliance on *Shoe Works*. First, because there are no trade channel limitations in registrant's identifications of goods, registrant's goods must be presumed to travel in all trade channels normal for such goods. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Such trade channels necessarily include the trade channels of applicant's goods, i.e., those that are normal for bakery goods sold

for wholesale distribution.[5] Second, the Board in *Shoe Works* did not state that <u>any</u> trade channel restriction will avoid likelihood of confusion. Rather, the Board stated that "[w]e agree with applicant in this case that the restriction of its channels of trade will tend to avoid likelihood of confusion." *Id.* at 1891. The restriction in *Shoe Works* was to sales of applicant's goods, i.e., women's shoes, "solely through applicant's retail shoe store outlets," and the goods of the conflicting registration were "men's, women's and children's shorts and pants." The Board recognized that retail shoe store outlets were not within the normal channels of trade for "men's, women's and children's shorts and pants." In contrast, in this case,

[5] Applicant argues inter alia that registrant's goods are used on packaged cookies for sale to the general public. Applicant has attached with its appeal brief several pages from registrant's website to support its argument. Because the web pages were not made of record prior to the filing of the appeal and because the examining attorney has objected to applicant's evidence, we do not further consider the web pages submitted with applicant's brief. See Trademark Rule 2.142(d). Even if this evidence were of record, it would not be persuasive because in this ex parte proceeding, we consider the goods as described in registrant's identification of goods, rather than the goods on which registrant actually uses its mark. See *In re Dixie Restaurants Inc.*, 105 F.2d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997), quoting *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 1 USPQ2d 1813 (Fed. Cir. 1987). Moreover, even if the registrant used its mark only on packaged cookies, the relevant consumers could still assume, because of the similarity of the marks, that the purveyor of fresh, frozen and par-baked bakery items had expanded its bakery products to include packaged specialty cookies.

"wholesale distribution" of goods is within the normal channels of trade for registrant's goods.

Thus, because the trade channels for applicant's and registrant's goods overlap, the third *du Pont* factor is resolved against applicant.

In regard to the *du Pont* factor regarding the conditions under which and buyers to whom sales are made - "impulse" vs. careful, sophisticated purchasing - applicant has argued at p. 3 of its reply brief:

> Assuming arguendo that Registrant's goods travel in the same channels of trade as Applicant's goods, Registrant's goods would be purchased by the same professional buyers from bakeries, restaurants and hotels. … it is Applicant's position that sophisticated buyers from grocery stores, department stores or bakeries are less likely than the general public to be confused when confronted with the respective marks at issue here.

We have recognized earlier in this decision that the common purchaser for applicant's and registrant's goods is the professional buyer. Thus, we accept that such purchasers are more discriminating than the general public. However, professional buyers - in view of the shared term UPPER CRUST in the marks and the descriptive or generic wording in registrant's marks - would likely view applicant's and registrant's closely related goods as coming from a common source. Specifically, such purchasers would likely view

both applicant's mark and the registrant’s marks as variations of each other, rather than as indicating that the goods come from different sources. Thus, if a retailer that is supplied with fresh bakery products from applicant sees that biscotti are being offered under the registrant's marks, the retailer is likely to believe that applicant has expanded its product line to include Italian dipping cookies. We therefore disagree with applicant that the *du Pont* factor regarding the sophistication of the consuming public favors applicant, but rather find this factor to be neutral.

Applicant has also argued that registrant’s marks are not entitled to a broad scope of protection in view of two registrations containing the terms UPPER CRUST. Inasmuch as the registrations are not of record, and the examining attorney in his brief has objected to consideration of these registrations, applicant's argument and the registrations have been given no consideration. We add that, based on the record before us, we consider the registered marks to be strong, with UPPER CRUST creating a distinctive impression because of the double entendre relating to CRUST with respect to bakery items, and the meaning of this term of “the highest social class or

group." *The American Heritage Dictionary of the English Language* (4d ed. 2000).[6]

Additionally, applicant states that it "has experienced no instances of any actual confusion between the respective marks and has received no communication from the owner of the cited registrations." Brief at p. 11. It is not necessary to show actual confusion in order to establish likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc*. 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). On the record before us there is no evidence as to whether there has been any opportunity for confusion to occur, i.e., we have no information as to the extent of applicant's use, or that of the registrant. Applicant's argument regarding actual confusion therefore is unpersuasive, and the *du Pont* factor regarding actual confusion is neutral.

Further, applicant argues that it has been using its mark since at least as early as 1982, well before the date of first use of the cited registrations. Brief at p. 11. To the extent that applicant is asserting that it has superior rights, applicant's argument is irrelevant in this

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[6] The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

ex parte proceeding. Section 2(d) prohibits the registration of a mark which so resembles a mark registered by another as to be likely, when applied to applicant's goods, to cause confusion, mistake or to deceive. In view of the express language of the statute, the question of priority of use is not germane to applicant's right to register. See *In re Shoemaker's Candies, Inc.*, 222 USPQ 326 (TTAB 1984).

Thus, when we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, we conclude that, when potential purchasers of applicant's and registrant's goods encounter the applied-for and registered marks for their respective goods, they are likely to believe that the sources of these goods are in some way related or associated with one another. As a result, there is a likelihood of confusion.

DECISION: The refusal to register applicant's mark under Section 2(d) of the Trademark Act in view of Registration Nos. 2038106 and 2424360 is affirmed.