

THIS OPINION IS NOT
A PRECEDENT OF THE
TTAB

Hearing:
25 September 2007

Mailed:
19 December 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hansen Beverage Company

Serial No. 78529821

Alina Morris of Knobbe, Martens, Olson & Bear, LLP for
Hansen Beverage Company.

Tasneem Hussain, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Hohein, Rogers, and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 9, 2004, Hansen Beverage Company
(applicant) filed an intent-to-use application (Serial No.
78529821) to register the mark JOKER MAD ENERGY in standard
character form on the Principal Register for goods
ultimately identified as "beverages, namely, carbonated and
non-carbonated energy drinks, excluding fruit drinks and
fruit juices" in Class 32. Applicant has disclaimed the
term "Energy."

Ser Nos. 78529821

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of the three registrations, owned by the same party, set out below.

I.

Reg. No. 2521457

JOKER (typed)

For: beers, mineral and aerated waters, and soft drinks; fruit drinks and fruit juices, nectar, juices with pulp, fruit concentrate, fruit juices based on concentrate and powders for making beverages

Class 32¹

Issued: 25 December 2001

II.

Reg. No. 1554967



For: fruit drinks and fruit juices

Class 32²

Issued: 05 September 1989

Partial Section 8 affidavit accepted

III.

Reg. No. 1248571

JOKER (typed)

For: fruit juices

Class 32

Issued: 16 August 1983

Renewed

¹ The registration also lists goods in Class 33 that are not relevant to this appeal.

² Other goods and classes have been deleted.

After the examining attorney made the refusal final, this appeal followed. An oral hearing was held on September 25, 2007.

In cases where likelihood of confusion is the issue, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) 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 and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We start by comparing applicant's and registrant's marks in their entirety as to their similarity or dissimilarity in appearance, sound, connotation, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). When we compare marks, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular

Ser Nos. 78529821

feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Here, all three registrations contain a single word: JOKER. In two registrations, the mark is depicted without any stylization. In the third registration, the term JOKER is combined with a design of a joker. Applicant's mark, JOKER MAD ENERGY, is in typed or standard form, with the term "energy" disclaimed. All the marks contain the same word "joker." Therefore, the marks are identical insofar as they contain the same word but they differ because applicant adds the words "mad energy" and one of the registrations contains a design of a joker. We note that one word in applicant's mark has been disclaimed and disclaimed matter is often "less significant in creating the mark's commercial impression." *In re Code Consultants Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001). Inasmuch as applicant's goods include "energy drinks," it is much less likely that consumers will rely on the word "energy" to distinguish the goods of the parties. *See also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), *quoting, In re National Data Corp.*, 753

Ser Nos. 78529821

F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion'").

The term "mad" would most likely be understood as a word that modifies the term "energy." Consumers are likely to view the word "joker" as the word that identifies the brand name of the product and the subsequent terms would suggest a feature of the product. The term "joker" is the first term in the mark and it is an arbitrary term as applied to applicant's and registrant's goods. These features make the term more prominent. As the Federal Circuit has noted: "To be sure, CLICQUOT is an important term in the mark, but VEUVE nevertheless remains a 'prominent feature' as the first word in the mark and the first word to appear on the label. Not only is VEUVE prominent in the commercial impression created by VCP's marks, it also constitutes 'the dominant feature' in the commercial impression created by Palm Bay's mark." *Palm Bay Imports*, 73 USPQ2d at 1692. See also *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985) (If "the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences"). Similarly, we

Ser Nos. 78529821

find that applicant's mark is dominated by the term "joker."

Regarding registrant's marks, they consist either of the word "joker" as the only element or a combination of that word and a design of a joker. In two registrations, JOKER is the entire mark. To the extent that registrant's other mark adds a design of a joker, it merely reinforces the "joker" term.

When we compare registrant's JOKER and JOKER with joker design marks with applicant's JOKER MAD ENERGY mark, we find that they are similar in sound, appearance, meaning, and commercial impression. Obviously, they are not identical, but the presence of the identical, arbitrary term JOKER in both marks results in their similarities outweighing their differences. Applicant argues that "JOKER MAD ENERGY suggests a wild, crazy, energetic prankster. With respect to Registrant's goods, ... the term JOKER suggests a lighthearted clown." Brief at 7. It is not apparent that many consumers would make such a fine distinction between the two marks. The differences created by applicant's addition of "mad energy" are not likely to make consumers differentiate the source of the goods. The words "mad energy" are likely to be viewed as terms that further identify the specific goods from the JOKER source.

Ser Nos. 78529821

See, e.g., In re Chatam International Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ("With respect to JOSE, the Board correctly observed that the term simply reinforces the impression that GASPAR is an individual's name. Thus, in accord with considerable case law, the JOSE term does not alter the commercial impression of the mark." The marks JOSE GASPAR GOLD and GASPAR'S ALE were determined to be similar). Many consumers will give the shared identical term "joker" the same meaning in both marks and their commercial impressions would be very similar.

The next, often critical factor, is the factor concerning whether applicant's and registrant's goods are related. Applicant's goods are carbonated and non-carbonated energy drinks, excluding fruit drinks and fruit juices. Registrant's goods include fruit juices in all three registrations and fruit drinks in the '457 and '967 registrations. In addition, in the most recent '457 registration, the identification of goods adds beers, mineral and aerated waters, and soft drinks, nectar, juices with pulp, fruit concentrate, fruit juices based on concentrate and powders for making beverages. The case law has long emphasized that we must consider the goods as they are described in the application and registrations. *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177

Ser Nos. 78529821

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"). See also *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 set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

Applying these principles, we must conclude that applicant's goods and registrant's goods in its '457 registration are identical to the extent that applicant's carbonated and non-carbonated energy drinks, excluding fruit drinks and fruit juices, are included within the scope of registrant's soft drinks. The term "soft drink" would include both carbonated and non-carbonated non-alcoholic drinks. The examining attorney has submitted a definition of "soft drink" as "a usually carbonated nonalcoholic beverage." *Merriam-Webster's Online Dictionary*. To this we add the *Webster's English Dictionary for Home, School or Office* (2003) ("soft drink -

a nonalcoholic drink").³ Therefore, applicant's energy drinks would overlap with registrant's soft drinks inasmuch as the term "soft drinks" would include applicant's identified energy drinks. Because these goods must be considered at least in part identical, their channels of trade and purchasers must likewise be considered to be identical. *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

Furthermore, applicant's goods are also related to registrant's fruit juices or fruit drinks. The examining attorney included several use-based, third-party registrations that show that the same entity has obtained a registration for goods that include fruit juices and energy drinks. See e.g., Registration No. 2855717 ("non-carbonated fruit juice drinks and energy drinks enhanced with vitamins, minerals, caffeine, nutrients, amino acids and/or herbs"); No. 3032757 ("fruit juice drinks" and "energy drinks, namely sport drinks, enhanced with vitamins[,] minerals, caffeine, nutrients, amino acids, or

³ We take judicial notice of these definitions as well as the others submitted by the examining attorney (brief at 6 and n.2) and applicant (brief at 5). *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Ser Nos. 78529821

herbs"); No. 3016085 ("fruit flavored drinks, juice-based drinks, namely, fruit juice; mineral waters, energy drinks"); and No. 3056503 ("energy drinks; flavored waters; fruit drinks... fruit juices"). These registrations suggest that the same entity is likely to be the source of both energy drinks and fruit juices and fruit drinks. *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001) ("The registrations show that entities have registered their marks for both television and radio broadcasting services. Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the services listed therein, including television and radio broadcasting, are of a kind which may emanate from a single source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988)").

In addition, the examining attorney has pointed out that applicant itself is the source of energy drinks and fruit juices. Examining Attorney's Brief at 8. See also Office Action dated July 19, 2005, Registration No. 2593887 (ENERGY HANSENS for "fruit juice drinks, soft drinks,

carbonated soft drinks and soft drinks enhanced with vitamins, minerals, nutrients, amino acids and herbs") and www.hansens.com/scripts/html/products:

<u>Energy</u>	<u>Juices & Non Carbonated</u>	<u>Soda</u>	<u>Specialty & Nutrition</u>
Hansen's Energy	Hansen's Smoothie	Hansen's Original Soda	Hansen's Soy

The evidence of record convinces us that energy drinks and fruit juices and fruit drinks are related products.

Applicant also makes an argument (Brief at 9) that:

Applicant's and Registrant's goods are targeted to different consumers and through different marketing channels. The primary demographic for Applicant's energy drinks is 18 to 39 year-old males. Applicant's energy drinks are shelf-stable beverages that are not promoted as being "healthy" and do not contain perishable fruit juice. To reach the 10 to 30 year-old male demographic, Applicant's energy drinks are sold primarily in convenience stores and gas stations. Although you will find energy drinks in the soda aisles of grocery stores, that is not where most 18-30 year old males shop. Further, Applicant's energy drinks would not be sold in the juice section of stores, nor stored in the refrigerated section of groceries.

We start by noting that, as identified in the application, applicant does not limit its goods to any particular demographic group or to any specific channels of trade. Therefore, we must assume that the goods of applicant and registrant pass through all the normal channels of trade and to all the normal types of

Ser Nos. 78529821

purchasers. See *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006):

Where the goods in the application at issue and/or in the cited registration are broadly identified 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.

See also *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983) (Absent restrictions in the identification, we must assume that the goods travel in "the normal and usual channels of trade and methods of distribution").

Furthermore, we cannot compartmentalize the channels of trade and purchasers as applicant argues. For example, there is no evidence in the record that supports applicant's argument that "the soda aisle of grocery stores ... is not where 18 - 30 year old males shop." Even if energy drink purchasers are limited to young males, there is simply no reason to assume that they would not also purchase fruit juice and fruit drinks. Indeed, we also cannot conclude that energy drink purchasers are limited to applicant's suggested demographic category.

Moreover, even if there were evidence on this point with respect to applicant's goods, we do not read limitations into the identifications of goods. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"). Similarly, we cannot limit registrant's fruit juice to "perishable beverages ... sold in refrigerated aisles" (Brief at 9). There is no evidence that limits the identification "fruit juice" to refrigerated beverages. Indeed, because we must assume that fruit juices, fruit drinks, and energy drinks are sold through all normal channels of trade, these goods would be sold in overlapping channels of trade. Therefore, we cannot agree with applicant that the "goods are targeted to different consumers through different marketing channels." Instead, our analysis leads to the conclusion that these factors favor a finding of likelihood of confusion.

Here, the marks JOKER MAD ENERGY and JOKER with or without a joker design are used on energy drinks and soft drinks, fruit juice and fruit drinks. The marks are dominated by the identical term "joker" and the goods are

Ser Nos. 78529821

either overlapping or related. These factors cause us to hold that there is a likelihood of confusion in this case.

Decision: The examining attorney's refusal to register applicant's mark under Section 2(d) of the Trademark Act is affirmed.