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THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cheezwhse.com, Inc.

Serial Nos. 78711311 and 78730624

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Inc.

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105 (Thomas G. Howell, Managing Attorney).

Before Walters, Taylor and Mermelstein, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Cheezwhse.com, Inc. has filed applications to register
the mark NAPOLEON BRIE¹ and the design mark shown below² on

¹ Serial No. 78711311, filed September 12, 2005, based on an allegation
of a bona fide intention to use the mark in commerce.

² Serial No. 78730624, filed October 11, 2005, based on an allegation of
a bona fide intention to use the mark in commerce. The application
includes the following statements:

The mark consists of a figure of Napoleon, wearing a red
cape, gold leggings and a blue and gold hat, on horseback on
a yellow circular background, surrounded by a white circle
with a red border containing the words NAPOLEON BRIE in blue
with a cream fleur de lis on a blue background on both sides
of the inner circle.

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the Principal Register for "cheese," in International Class 29. Each application includes a disclaimer of BRIE apart from the mark as shown.



In each application, 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 respective mark so resembles the mark NAPOLEON, previously registered for the goods shown below,³ that, if used on or in connection with applicant's respective goods, it would be likely to cause confusion or mistake or to deceive.

Registration No. 2302248:
edible oils, namely, salad oil, olive oil;
processed vegetables, namely, cocktail onions,

The color(s) red, blue, yellow, gold and cream is/are claimed as a feature of the mark.

The color red appears in the cape, boots, and border; the color gold appears in the leggings and hat and the horse's mane and tail; the color blue appears in the clothing, the text "NAPOLEON BRIE," and the background of the fleur de lis design; the color brown appears on the horse; the color white appears in the outer circle design and in the clothing and design of the horse; the color yellow appears in the innermost circular background; the color cream appears in the fleur de lis.

³ Both registrations are owned by the same entity, The Napoleon Co., Inc.; and both registrations have had affidavits under Sections 8 (six-year) and 15 of the Act accepted and acknowledged, respectively.

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baby corn, stir-fry vegetables, hearts of palm, artichokes; processed seafood, namely, anchovies, oysters, mussels and sardines; and processed olives, in International Class 29.

Registration No. 2296196:
vinegar, capers and pasta, in International Class 30.

In each application, applicant has appealed and both applicant and the examining attorney have filed briefs. Because of the similarities in the facts and issues involved in these two applications and their respective appeals, we have considered these cases together and issue, herein, a single opinion.

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 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*

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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.

The examining attorney argues that the marks and goods involved herein are substantially similar and confusion as to source is likely. The examining attorney contends that the word element of applicant's design mark is dominant because the word portion is the feature likely to be used by consumers in calling for the goods. Also regarding the design element, the examining attorney argues that the picture of Napoleon on a horse merely reinforces the dominant wording NAPOLEON in applicant's design mark. With respect to the wording in both of applicant's marks, the examining attorney contends that NAPOLEON is the dominant term and it is an arbitrary term for the goods of applicant and registrant. The examining attorney argues that applicant has adopted registrant's mark in its entirety and merely added the highly descriptive word BRIE thereto.

The examining attorney contends that third-party registrations and excerpted Internet web pages in the record support the conclusion that the respective goods are related and travel in the same trade channels to the same purchasers. The examining attorney contends, further, that the recipes in the record establish that the respective

goods may be used together; and that applicant's goods are within registrant's normal and logical zone of expansion.⁴

The evidence submitted by the examining attorney consists of ten third-party registrations for marks for goods that include cheese and many or all of the registrant's identified goods.⁵

The evidence also includes excerpts from several Internet websites. Two of the websites, www.shopsafeway.com and www.peapod.com, are for retailers offering a wide variety of foods, including the identified products. However, the products are all identified by different trademarks and, thus, these sites are not particularly significant evidence. Two additional websites, www.wholefoodsmarket.com and www.foodnetwork.com, contain recipes that include both cheese and one or more of the goods in the cited registrations to show, according to the examining attorney, that the products are used together. A final website, www.shopoccasionsaplenty.com, offers gift tins, with the featured tin including "brie cheese" and

⁴ In addition to providing no evidence in this regard, the examining attorney's argument about expansion of trade is not well taken in this ex parte context. See *In re First Realty Professionals, Inc.*, ___ USPQ2d ___, Serial No. 78553715 (TTAB, August 7, 2007) ["The concept of expansion of trade is generally addressed in the context of the issue of priority in an inter partes proceeding."]

⁵ Of these registrations, two of the registrations are analogous to house marks because the identifications of goods encompasses a broad range of food products. Therefore, the inclusion in the identifications of goods of cheese and many of the registrant's products is not particularly significant.

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"gourmet olives." There is no indication of what, if any, trademarks are used on the cheese and olives.

Applicant contends that its marks and goods are distinctly different from the mark and goods in the cited registrations; that the trade channels are different; that purchasers of processed food items are more likely to make impulse purchases than purchasers of brie; that purchasers of brie are sophisticated purchasers; and that registrant's mark is weak and entitled to limited protection. Regarding the marks, applicant argues that the word BRIE sufficiently distinguishes its marks from the registered marks and that the design element in its application serial no. 78730624 further distinguishes this mark from the registered marks. Regarding the goods, applicant argues that, even if sold in the same stores, the respective goods would not be sold in proximity to each other.

We turn, first, to a determination of whether applicant's marks 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

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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).

Although we must compare the marks in their entireties, one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) ["There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular 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."]

Based on the record before us, we find, with regard to the wording in both of applicant's marks, NAPOLEON BRIE, that NAPOLEON is an arbitrary term in connection with cheese; and that the additional word, BRIE, is highly descriptive in connection with cheese. Applicant has disclaimed the term BRIE in apparent recognition of its descriptive character. Therefore, we find NAPOLEON to be the dominant word in both of applicant's marks.

With respect to applicant's design mark, we find the wording clearly predominates over the design elements in

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creating the commercial impression of the mark. It is the wording NAPOLEON BRIE that would be used by purchasers to call for applicant's goods. Thus, the wording would make a greater impression on purchasers and is the portion that is more likely to be remembered as the dominant and source-signifying portion of the registered mark. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593 (TTAB 2001) ("words are normally accorded greater weight because they would be used by purchasers to request the goods"). See also, e.g., *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (1987). The circle element of the design is merely a common carrier for the wording and the horse and rider; and the fleur de lis is also a fairly common design suggesting the French origin of Brie cheese. The horse with the rider Napoleon thereon clearly reinforces the wording NAPOLEON in the mark.

Registrant's mark is registered in standard character format and, thus, registrant could conceivably display its mark in any lettering style, including that used by applicant, and located in a circular carrier, such as the one in applicant's mark. 37 C.F.R. § 2.52(a); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988) (when registering a mark in block letters, registrant remains free to change the display of its mark at any time); and *Sunnen Products Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744 (TTAB 1987) (styling of letters is irrelevant to the issue of confusion

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where applicant seeks to register mark without any special form of lettering or design).

Therefore, while there are differences between applicant's marks and the registered mark, we find that the commercial impressions of applicant's word mark and registrant's marks to be substantially similar. Similarly, we find the commercial impressions of applicant's design mark and registrant's mark to be more similar than dissimilar. This factor weighs against applicant in both applications.

Next, we compare applicant's proposed goods with those of registrant. In making our determination under the second *du Pont* factor, we look to the goods as identified in the involved application and cited registrations. See *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.") 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.”)

Applicant’s identification of goods is not limited to Brie cheese, but encompasses all kinds of cheese. At least eight of the third-party registrations of record are for marks registered for cheese or specific types of cheese and some or all of the goods in the cited registrations.

Although third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, such registrations nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate 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). Additionally, the recipes in evidence show that several of the goods in the cited registrations are ingredients which can be used together with cheese in cooking; and the website offering gift tins shows that brie cheese and olives are sold together and we assume they may be served together.

It is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods

or services 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 or services. *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). In this case, there is no question that, as applicant argues, the goods are different. However, we find the evidence supports the conclusion that applicant's cheese is sufficiently related to the goods in both of the cited registrations such that the aforementioned confusion as to source is likely to arise if the respective products are identified by confusingly similar marks. This factor also weighs against applicant.

We turn now to the *du Pont* factor regarding trade channels and the conditions under which and buyers to whom sales are made. Because there are no restrictions in the identifications of goods, the goods would be offered in all ordinary trade channels for these goods and to all normal classes of purchasers, in this case, the general public. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

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Applicant argues that registrant's goods are more likely to be the subject of impulse purchases than applicant's cheese; and that the purchasers of its cheese are sophisticated purchasers. There is absolutely no evidence to support either of these statements. The involved goods are likely to be purchased in the same food markets and specialty stores by purchasers encompassing all levels of sophistication.

When we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that in view of the substantial similarity in the commercial impressions of applicant's marks, NAPOLEON BRIE, in standard characters and with a design, and registrant's mark, NAPOLEON, their contemporaneous use on the goods involved in this case 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 affirmed as to both cited registrations in both applications.