

THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.

Mailed: September 29, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Yong O'Connor

Serial No. 78793021

Yong O'Connor appearing pro se.

D. Beryl Gardner, Trademark Examining Attorney, Law Office
112 (Angela Wilson, Managing Attorney).

Before Kuhlke, Cataldo and Ritchie de Larena,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Yong O'Connor seeks registration on the Principal Register of the mark shown below for goods identified as "protein based, nutrient dense snack bars, veggi burger patties," in International Class 29; "cakes, ice cream cakes, processed cereals, processed granola cereal, breads, breakfast cereal derived food bars, vegetable burger sandwiches, cookies, tea, ice cream" in International Class 30; and "unprocessed cereal, unprocessed granola cereal" in

Serial No. 78793021

International Class 31.¹ The application includes the following description of the mark: "The mark consists of the stylized letters Y's."



Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used with its identified goods, so resembles the following registered mark for "bakery products," in International Class 30, and "wholesale and retail stores featuring bakery products" in International Class 35, as to be likely to cause confusion, mistake or deception:



When the refusals were made final, applicant appealed and filed a request for reconsideration. The examining attorney denied the request and the appeal was resumed and fully briefed.

¹ Application Serial No. 78793021, filed January 17, 2006, alleging a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b).

² Registration No. 3198497, issued January 16, 2007, based on an application filed on January 31, 2006.

Serial No. 78793021

We first address applicant's argument regarding the filing date of the cited registration. By way of background, the subject application was filed on January 17, 2006, whereas the cited registration was filed on January 31, 2006. During prosecution, applicant's application was abandoned for failure to respond to an Office Action. In the meantime, the later-filed application issued into a registration; thereafter, applicant's request to revive the application was granted. The protocol for handling these situations is set forth in The Trademark Manual of Examining Procedure Section 718.08 (5th ed.) which provides as follows:

When an abandoned application is revived or reinstated, the examining attorney must conduct a new search of USPTO records for conflicting marks...if a later-filed conflicting application is already registered, the USPTO is without authority to cancel the registration. The examining attorney must refuse registration of the earlier-filed (revived) application under 15 U.S.C. 1052(d). In this situation, an applicant has the option of filing a petition to cancel the registration under Section 14 of the Trademark Act, 15 U.S.C. 1064.

In view thereof, it was appropriate for the examining attorney to make the refusal despite applicant's earlier filing date.

We turn now to the question of likelihood of confusion between the marks. Our determination of the issue of

Serial No. 78793021

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, two key considerations are the similarities between the marks and the similarities between the goods and services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to a consideration of whether the respective marks are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. The analysis is not whether the marks can be distinguished when compared side-by-side. Rather, we must determine whether the marks are sufficiently similar that there is a likelihood of confusion as to source and, in making this determination, we must consider the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

The examining attorney argues:

Consumers, upon seeing the marks, will find that the marks are similar in appearance because the featured portion of the marks is the Y in the oval. Furthermore, consumers will call for the goods by the sole letter name, Y. The literal portions are the dominant and most significant features of marks because consumers will call for the goods or services in the marketplace by that portion. [citations omitted]. For this reason, the examining attorney must give greater weight to the literal portions of the marks in determining whether there is a likelihood of confusion. A consumer in the market place for baked goods may recommend another consumer to Y's, thus calling the goods and services by the literal portion of the mark. However, the source of the baked goods from "Y's" may be a reference to the registrant's source of baked goods. Overall, the marks are similar in appearance as they both depict a very similar stylized Y inside of an oval.

Br. pp. 9-10.

As stated by our principal reviewing court:

There is no general rule as to whether letters or design will dominate in composite marks ... the spoken or vocalized element of a design mark, taken without the design, need not of itself serve to distinguish the goods. The nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur. ... "It must be remembered that [registrant's] trademark consists of highly stylized letters and is therefore in the gray region between pure design marks which cannot be vocalized and word marks which are clearly intended to be." In Georgia-Pacific the court observed that even if the letter portion of a design mark could be vocalized, that was not dispositive of whether there would be likelihood of confusion. A design is viewed, not spoken, and a stylized letter design can not be treated simply as a word mark.

Serial No. 78793021

In re Electrolyte Laboratories Inc., 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) quoting Georgia-Pacific Corp. v. Great Plains Bag Co., 614 F.2d 757, 760, 204 USPQ 697, 699 (CCPA 1980).

In this case, the degree of stylization in registrant's mark which includes a face, integrating the design with the letter such that the Y forms part of the outside circle and the face, is so high that it is more akin to a design mark rather than simply stylized displays of word marks as the examining attorney argues. See In re TSI Brands Inc., 67 USPQ2d 1657 (TTAB 2002). Considering the marks in their entireties we find that registrant's mark is so highly stylized that it projects the image of a design mark and the letter takes on its significance only by reference to registrant's trade name Yummy Foods, Inc. Id. at 1663. In contrast, the significance of applicant's mark is focused on the letter Y, in particular by the inclusion of the possessive "s." Thus, we find that the marks are not so similar in sound, appearance, connotation or commercial impression, that, merely because such marks share the letter Y, confusion as to origin or association is likely. Id.

In view thereof, even considering the relatedness of the goods and services, at least as to applicant's goods

Serial No. 78793021

listed in International Class 30,³ we believe that applicant's Y'S mark is not so similar to registrant's Y and face design mark that the contemporaneous use of the respective marks in connection with closely related goods or services is likely to cause confusion.

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

³ In that regard we note that the examining attorney only submitted evidence in the form of use-based third-party registrations that establish the relatedness of applicant's goods in International Class 30, but none of the third-party registrations include applicant's goods listed in International Classes 29 or 31. See *In re Albert Trostel & Sons CO.*, 29 USPQ2d 1783 (TTAB 1993).