

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
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9/20/01

Hearing: June 7, 2001

Paper No. 25

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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Precision Foods, Inc.  
v.  
Major Products Co., Inc.

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Opposition No. 109,500  
to application Serial No. 75/252,641  
filed on March 6, 1997  
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Thomas P. Arden of McBride Baker & Coles for Precision Foods, Inc.

James C. Simmons of The Law Office of James C. Simmons for Major Products Co., Inc.

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Before Walters, Bottorff and Holtzman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Major Products Co., Inc. to register the mark MAKE IT THICK for a "food thickeners."<sup>1</sup>

Registration has been opposed by Precision Foods, Inc. As its ground for opposition, opposer asserts that applicant's

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<sup>1</sup> Application Serial No. 75/252,641, filed March 6, 1997, alleging a bona fide intention to use the mark in commerce.

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mark when applied to applicant's goods so resembles opposer's previously used and registered mark THICK-IT for "food thickener" as to be likely to cause confusion under Section 2(d) of the Trademark Act.

Applicant, in its answer, has denied the salient allegations in the opposition.

The record includes the pleadings; the file of the involved application; and opposer's notice of reliance on evidence including a status and title copy of its pleaded registration, opposer's unanswered admission requests including an admission that the goods are competitive, and applicant's responses to interrogatories and document requests. Opposer also submitted the testimony (with exhibits) of opposer's vice-president Ronald M. Kirshbaum.<sup>2</sup> Applicant did not take any testimony or introduce any other evidence.

Both parties filed briefs and an oral hearing was held on June 7, 2001.

Opposer, Precision Foods, Inc., manufactures a "health care" food thickener under the mark THICK-IT which is designed for people who have a swallowing impairment called dysphagia. (Kirshbaum dep. p. 10). Opposer estimates that there are somewhere between ten and fifteen million people in the United

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<sup>2</sup> Applicant did not attend this deposition.

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States with this condition. The THICK-IT product was first introduced in the market in 1985 and at that time, it was the first of its type in any market, that is, an instant food thickener in powdered form where the consistency of the food could be easily controlled. Mr. Kirshbaum states that the product "revolutionized" the health care industry with regard to dysphagia and received "great acceptance" in the market. (Dep. pp. 23-24).

Mr. Kirshbaum explains that there are two primary markets for its food thickener, the food service market and the retail market. The food service market includes food service distributors and food service operator accounts. The operator accounts include hospitals, nursing homes, and convalescent centers. In this market, the product can be sold to distributors for subsequent sale to the health care facilities or directly to the facilities themselves. On the retail side, the product is sold either to national drug wholesalers who in turn sell to their branch drug stores, or directly to drug stores by telephone, or by telephone directly to consumers. While some drugstores may sell the product off the shelf, that manner of sale, according to Mr. Kirshbaum, "is not the predominant situation." (Dep. p. 35). Mr. Kirshbaum states that it is more likely that the product would be recommended to the consumer by a pharmacist or health care professional

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and that the pharmacist would then place a special order for the product from his wholesaler. The product is sold in a variety of container sizes. When it is sold off the retail shelf to consumers, it usually appears in an eight-ounce container costing \$6.

During its first couple of months on the market, the product was promoted with "a lot of word-of-mouth advertising through [health care professionals] personal letters and trade letters and trade journals...." (Kirshbaum dep. p. 24). Opposer has subsequently advertised the THICK-IT product to both the food service and retail markets by print advertisements in consumer and trade magazines, and promotional literature. Opposer has also been promoting the THICK-IT product at trade shows two to five times a year since 1985 and, for an unspecified period of time, has promoted the product on the Internet. Opposer has submitted reports of two university or hospital studies determining the effectiveness of certain food thickeners including THICK-IT food thickener.

Following two years of exclusivity, competitive products were introduced in the food service market. Mr. Kirshbaum estimates that there are now twelve such competitors in that market and he has identified Sysco, Diamond Crystal, and Thicken Up, as the main competitive products. According to

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Mr. Kirshbaum, opposer's product has no competitors in the retail market.

Mr. Kirshbaum testified that sales of THICK-IT food thickener experienced "triple-digit increases" the first couple of years on the market followed by "strong double-digit increases" in subsequent years. (Dep. p. 24). Opposer has submitted, subject to a protective order, sales figures for the years 1995 to 1999, advertising figures for 1999, and proposed expenditures for the year 2000. Mr. Kirshbaum estimates additional expenditures which are not reflected in those figures and media expenses for the "five to ten" years preceding 1999. (Kirshbaum dep. p. 58).

The discovery responses made of record by opposer indicate that applicant manufactures food products, including food thickener for dysphagia conditions. Applicant decided in late 1996 or early 1997 to "check on the feasibility of using the mark" and became aware of opposer's registration in February, 1997. (Rev. ans. int. 3). Applicant then filed its intent-to-use application for the mark MAKE IT THICK on March 6, 1997 and began using the mark on food thickener on or about May 22, 1998. Applicant has not yet advertised or promoted its food thickener but applicant intends to sell the product through food distributors to hospitals and nursing homes. Applicant, in fact, has already made one sale of its product consisting

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of 12 eight ounce cans totaling \$6,490 to a potential customer of opposer.

As indicated above, opposer has made of record a status and title copy of its pleaded registration. Thus, there is no issue with respect to opposer's priority. *King Candy co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

We turn then to a consideration of likelihood of confusion. 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, including the similarity of the marks and the similarity of the goods. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding are discussed below.

The parties' goods are both identified as food thickeners. In view of the directly competitive nature of the goods, the channels of trade and classes of purchasers for the respective goods are deemed to be the same. See *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). Indeed applicant has admitted that the products are competitive (adm. req. ans. 5) and the evidence shows that the products are in fact identical, that they are used for the same purpose, and that they are sold in the same food service market.

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We turn then to the marks. Opposer argues that the marks are similar in sound, appearance and connotation in that applicant's mark MAKE IT THICK comprises the same words in opposer's mark THICK-IT arranged differently. Applicant, however, maintains that the different arrangement of the shared words plus the additional word MAKE in its mark results in significant differences in the sound and appearance of the marks. Applicant further argues that the marks' shared elements are "such common words" (brief, p. 12) and that opposer's mark is suggestive and entitled to only a narrow scope of protection.

The mere fact that applicant's mark incorporates the component words of opposer's mark does not necessarily mean that the two marks are similar. In determining the similarity or dissimilarity of the marks, we must consider the marks in their entireties, as to appearance, sound, connotation and commercial impression. *Cunningham v. Laser Golf Corp.*, 55 USPQ2d 1842 (Fed. Cir. 2000). We find that the marks THICK-IT and MAKE IT THICK when considered in their entireties, are not similar in sound, appearance or commercial impression. The marks are visually different. Opposer's mark consists of two words either joined or separated by a hyphen with the word THICK preceding the word IT. Applicant's mark includes the additional word MAKE and the order of THICK and IT are

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reversed in its three-word mark. The differences in the two marks are even more pronounced when the words are spoken. The marks do not have the same cadence or number of words.

Moreover, the term THICK-IT is virtually identical in sound to the familiar dictionary word "thicket" whereas MAKE IT THICK would be articulated as three separate words sounding nothing like "thicket."

The transposition of THICK and IT also changes the commercial impressions conveyed by the marks. The word THICK in opposer's mark THICK-IT is used in the uncharacteristic manner of a verb, resulting in a somewhat unusual overall expression. The mark MAKE IT THICK, on the other hand, is an ordinary sentence where the words, including THICK, are used in their traditional, ordinary sense. In addition, because THICK-IT is an unfamiliar expression, it may call to mind the more familiar term "thicket," thereby further distinguishing the commercial impressions created by the two marks.

The marks have a similar overall meaning, but that meaning is highly suggestive of food thickener. The term "IT," common to both marks, is a suggestive reference to the food product to be thickened. The other shared word "THICK" is highly descriptive of one of the most important characteristics of food thickener and there is no doubt that the word is intended to convey this descriptive meaning in both marks.

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It is settled that highly suggestive marks are weak and are generally accorded a more limited scope of protection than an arbitrary mark. See *The Drackett Company v. H. Kohnstamm & Co., Inc.*, 160 USPQ 407 (CCPA 1969) ["The scope of protection afforded such highly suggestive marks is necessarily narrow and confusion is not likely to result from the use of two marks carrying the same suggestion as to the use of closely similar goods."]; and *Sure-Fit Products Company v. Saltzson Drapery Company*, 117 USPQ 295 (CCPA 1958).

While, as opposer points out, there is no evidence of other third parties using the words THICK or IT on food thickeners, a primary competitor of opposer is using a variation of THICK in its mark, THICKEN UP, further indicating the relative weakness of opposer's own mark in relation to its goods.

In view of the weakness of THICK-IT and MAKE IT THICK, we find that the distinct differences in the marks, particularly in sound and appearance, are sufficient to distinguish one mark from another.

Opposer contends, however, that its mark is strong "due to opposer's dominance in the health care food thickening market and general market acceptance" of the product. (Brief, p. 11). The evidence shows that THICK-IT has been used on food thickener for approximately fifteen years and at least steady

increases in sales volume since the introduction of the product on the market, nearly doubling in volume over the period 1995 to 1999. However, there is no information as to, for example, opposer's relative share of the food service market or opposer's proportionate number of operator accounts, and the sales figures themselves, including number of units sold, do not seem particularly impressive on their face considering the vast number of people who, according to opposer, have this disorder. Nevertheless, Mr. Kirshbaum has testified essentially that THICK-IT food thickener is a leading brand in the food service market (dep. p. 25) and applicant admits that the product is successful in the marketplace.<sup>3</sup> (Brief, p. 10). Opposer also points to the unsolicited use of THICK-IT food thickener in two professional studies and it appears that, according to Mr. Kirshbaum, such studies tend to focus on leading brands.<sup>4</sup>

The evidence demonstrates that opposer's mark has attained some, but not necessarily a tremendous degree of recognition in the field. Under the circumstances, and considering the

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<sup>3</sup> Because opposer has no competitors in the retail industry, it is understandable that the THICK-IT product would be, as described by opposer, *the* leading brand in the retail field. However, there is no indication as to, for example, what portion of opposer's sales relate to that market.

<sup>4</sup> One other article relied on by opposer mentions opposer's company and the fact that it offers "various products for people with dysphagia, including...thickeners...." However, there is no mention of opposer's mark in this article.

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highly suggestive nature of opposer's mark in connection with its goods, we remain convinced that opposer's mark is entitled to a more limited scope of protection. This scope of protection should not, in any event, extend to applicant's mark which, in all important respects, is dissimilar to opposer's mark.

Opposer also argues that "food products sold at retail" and "less expensive items" are not purchased with great care. (Brief, p. 16). The primary customers for the parties' goods, including operators of nursing homes and other health care facilities, are sophisticated professionals who would exercise a high degree of care in purchasing these products. Nevertheless, there is no restriction in the respective identifications as to purchasers, and it seems that at least some of opposer's customers are ordinary members of the public. While food thickener is a relatively low cost product, it is not an impulse product such as shampoo or a package of chewing gum. Given the seriousness of the disorder for which the food thickener is used and the fact that it would probably be recommended by a doctor or pharmacist rather than purchased off the shelf, the purchase of this product by the consumer would involve a more informed and thoughtful decision.

Finally, opposer maintains that applicant adopted its MAKE IT THICK mark in bad faith. In particular, opposer claims that applicant adopted a mark comprising opposer's mark with knowledge of opposer's incontestable registration, thereby raising an inference that applicant intended to trade on opposer's good will. Opposer claims that the inference is made stronger because opposer's mark "is the leading brand in the market." Opposer points to the mixing instructions on applicant's product label which use the same consistency designations, i.e., "nectar," "honey," and "pudding," as opposer uses on its own labels.<sup>5</sup> Mr. Kirshbaum claims that opposer "invented" these designations and has long used these terms to designate the three levels of consistency for its products. (Dep. p. 72).

Applicant, aside from misconstruing the issue as one of trade dress violation, admits that it knew of opposer's registration at the time of filing its application, denies that

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<sup>5</sup> Opposer, based on Mr. Kirshbaum's testimony, refers generally in its brief to applicant's adoption of "verbiage and instructions long used by opposer" in its packaging. (Brief, p. 14). However, opposer specifically addresses only applicant's alleged appropriation of the above consistency designations. In any event, opposer has failed to establish, and we do not find, that the other alleged similarities in packaging mentioned by Mr. Kirshbaum such as package size and generic language including "instant food thickener," "desired consistency," and "do not overmix" (which does not even appear on opposer's label as far as we can determine) are persuasive of wrongful intent. In fact, the labels are otherwise strikingly different.

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the mark was adopted in bad faith, and maintains further that regardless of its intent, there is no likelihood of confusion in this case. Applicant contends that it is entitled to use those consistency designations arguing that the words are standard in the industry and are "functional characteristics which Applicant should now be free to use." (App. brief, p. 7).

The Board in *Roger & Gallet S.A. v. Venice Trading Co. Inc.*, 1 USPQ2d 1829 (TTAB 1987), stated that intent may, and ought to, be taken into account when resolving the issue of likelihood of confusion when that issue is not free from doubt. If confusion is not likely to result from the use of the marks, the motive of applicant cannot affect its right to the registrations sought. *Steak N Shake, Inc. v. Steak and Ale, Inc.*, 171 USPQ 175 (TTAB 1971).

In this case, we have no doubt concerning the likelihood of confusion. Even if we did have doubt, the evidence submitted by opposer would not assist us in resolving this issue. Establishing bad faith requires a showing that applicant intentionally sought to trade on opposer's good will or reputation. See *Big Blue Products Inc. v. International Business Machines Corp.*, 19 USPQ2d 1072 (TTAB 1991). While such intent may be inferred from surrounding circumstances such as the copying of a competitor's product packaging,

opposer is under the heavy burden to prove by clear and convincing evidence that applicant is guilty of bad faith. See, for example, LaBounty Manufacturing Inc. v. United States International Trade Commission, 958 F.2d 1066, 22 USPQ2d 1025 (Fed. Cir. 1992) and Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

The evidence relied on by opposer in this case is far from sufficient to meet that burden.<sup>6</sup> In fact, a visual comparison of both labels makes it hard to believe that this is the part of opposer's label that applicant would choose to copy if applicant intended to create confusion or deception. Moreover, applicant has offered a very plausible "good faith" explanation for its use of those designations. We note that this identical wording is used generically in the hospital study report. The study, appearing on (unnumbered) page 2 of opposer's exhibit no. 33, is entitled *Using A Multidisciplinary Monitor To Assess Accuracy of Thickened Liquids For Hospital Patients With Dysphagia*. The report

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<sup>6</sup> The question of intent is heavily dependant on the particular facts and the facts in this case are distinguishable from those in cases such *Broadway Catering Corp. v. Carla Inc.*, 215 USPQ 462 (TTAB 1982) and *Roger & Gallet S.A. v. Venice Trading Co., Inc.*, 1 USPQ2d 1829 (TTAB 1987) on which opposer has relied. In *Broadway Catering*, for example, the finding of wrongful intent was not based on an allegation of similar trade dress copying but rather applicant's failure to provide any credible explanation for its adoption of a mark which was identical to opposer's mark of "notoriety and renown."

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describes the protocol for the study as follows (emphasis added):

Our initial protocol for thickening liquids included the following: 1) Adhering to recommendations by the speech-language pathologists regarding thickness level (**nectar, honey, pudding**)...

For the foregoing reasons, we conclude that notwithstanding the identity of the products in this case, the sophistication and/or care taken by purchasers of opposer's product together with the dissimilarities in the marks as well as the relative weakness of opposer's mark and the narrow scope of protection to which it is entitled **makes confusion unlikely.**

**Decision:** The opposition is dismissed.