

Mailed: September 29, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In-N-Out Burgers

v.

Peak Harvest Foods, LLC

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Opposition No. 91161044  
to Application No. 78287067  
filed August 13, 2003

Oral Hearing May 28, 2008

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Edward O. Ansell, Law Office of Edward O. Ansell, for  
opposer.

Peak Harvest Foods, LLC, *pro se*.

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Before Seeherman, Hairston, and Mermelstein, Administrative  
Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

Applicant seeks registration of the following stylized  
mark:

Quality you can crunch.

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for "dried fruit" in International Class 29.<sup>1</sup>

In-N-Out Burgers filed an opposition to registration, alleging that applicant's mark, when used in connection with the identified goods, is likely to cause confusion in light of opposer's mark, QUALITY YOU CAN TASTE, previously used and registered for restaurant services, hamburgers, french fries, and computer services. Trademark Act § 2(d); 15 U.S.C. § 1052(d). Opposer further alleged that "[a]pplicant's mark so resembles [o]pposer's previously used, registered, and famous marks ... as to be likely, when used in connection with the goods set forth in [a]pplicant's application, to lessen the capacity of [o]pposer's ... marks to identify and distinguish opposer's services and goods, regardless of the presence or absence of competition between Opposer and Applicant, or likelihood of confusion, mistake or deception." See Trademark Act § 43(c); 15 U.S.C. § 1125(c).

By its answer, applicant denied the salient allegations of the notice of opposition. Following a trial on the merits, the parties submitted briefs on the case,<sup>2</sup> and an

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<sup>1</sup> Serial No. 78287067, filed August 13, 2003, based on an allegation of use of the mark in commerce. First use, November 9, 2002; in commerce, April 1, 2003.

<sup>2</sup> Opposer filed its reply brief December 3, 2007. On December 6, 2007, applicant filed a paper styled an "answer" to opposer's "December 03, 2007 motion...." The Trademark Rules permit the filing of a brief by the opposer, a brief by the applicant, and a reply brief by the opposer, but do not provide for the filing of

oral hearing was held.

For the sake of brevity, this opinion assumes familiarity with the record, all of which has been carefully considered. We have not attempted to discuss every argument or objection to evidence; we focus instead on the evidence and arguments most relevant to the ultimate issues in this case.

**I. The Record**

**A. Parties' Submissions**

The record consists of the pleadings, the file of the subject application, and the following evidence submitted during trial:

- Opposer's first notice of reliance, filed 6/2/2005;
- Testimony of Arnold Wensinger, opposer's general counsel, taken July 29, 2005;
- Applicant's notice of reliance, filed January 16, 2007;
- Testimony of John Rarick, Executive Manager of applicant Peak Harvest Foods, LLC, taken January 8, 2007;
- Testimony of Edward Lilly, a food-packager to applicant, taken January 9, 2007;
- Opposer's second notice of reliance, filed August 30, 2007 as part of opposer's rebuttal evidence; and
- Rebuttal testimony of Arnold Wensinger, taken August 23, 2007.

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further briefs. Trademark Rule 2.128(a)(1). Accordingly, applicant's December 6, 2007, filing has not been considered.

**B. Evidentiary Objections**

**1. Opposer's Motion to Strike**

Now pending is opposer's October 22, 2007, renewed motion to strike Mr. Rarick's testimony and parts of applicant's notice of reliance. On February 26, 2007, opposer had filed a motion to strike the same material, on the grounds that (1) opposer allegedly "was not given a *full opportunity* to cross examine the witness";<sup>3</sup> (2) Mr. Rarick's testimony was not taken in question and answer form; and (3) certain documents submitted under applicant's notice of reliance are not appropriate for such submission. Pursuant to an interlocutory order, opposer's motion was denied as to the first ground. As to the second and third grounds, ruling on opposer's motion was deferred, since a ruling on those grounds would require an examination of the evidence itself, and the Board will generally not examine the evidence prior to final decision. The motion now before the Board is opposer's renewed objection to applicant's testimony and notice of reliance. The motion has been fully briefed.

Opposer complains that Mr. Rarick's testimony was not presented in question and answer form. As opposer notes,

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<sup>3</sup> Due to circumstances we need not recount here, opposer did not attend Mr. Rarick's testimonial deposition in person or by telephone. Opposer alleged that its inability to attend deprived it of its right to participate in Mr. Rarick's testimony.

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the Trademark Rules provide that testimony in a Board proceeding "shall be taken in answer to questions, with the questions and answers recorded in their regular order by the" officer before whom the testimony is given. Trademark Rule 2.123(e)(2). Our reading of Mr. Rarick's testimony confirms that little, if any of it, could be characterized as a question and answer exchange as is typical during testimony.

The purpose of requiring testimony to be taken in a question-and-answer format is not an empty formality. Presenting testimony in this manner prevents counsel from essentially testifying or telling a witness what he should say, and provides the opposing party the opportunity to object before an answer is given. But neither factor is relevant here. No one "led" Mr. Rarick's testimony or suggested his answers. His testimony would not have changed even if he had first stated proper questions and then answered them himself. Moreover, the form of the testimony did not deprive opposer of its right to object to Mr. Rarick's testimony, because opposer was not present.

But more importantly, the objection opposer raises to Mr. Rarick's testimony is an objection to the form of the proffered testimony, and could have been easily remedied, had the objection been made at the time. It is well-established that such an objection is waived if "it is not

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timely made during the deposition." Fed. R. Civ. P. 32(d)(3)(B)(ii); see Trademark Rule 2.123(k). Opposer did not attend the deposition and therefore did not raise the objection at the time.

We are cognizant of opposer's position - set out in its original motion to strike - that its absence from the Rarick deposition was not voluntary. Nonetheless, we see no error in the Board's June 15, 2007, order denying opposer's motion to strike, finding that opposer had the opportunity to attend Mr. Rarick's deposition, but did not do so. Accordingly, we find that opposer's objections as to the form of the Rarick testimony were waived.<sup>4</sup>

Next, opposer argues that applicant inappropriately submitted many documents under its notice of reliance. The categories of materials which may be submitted under a notice of reliance are limited, consisting only of (1) an adverse party's discovery deposition, answer to an interrogatory, or admission to a request for admission, Trademark Rule 2.120(j)(3)(i); (2) printed publications, Trademark Rule 2.122(e); and (3) official records, *id.* We

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<sup>4</sup> Opposer argues that the "format [of applicant's testimony] has tended to obscure operative facts relating to the ultimate issues in this proceeding which opposer needs to address," but offers no specifics. Mot. to Strike at 2. Further, opposer was able to (and did) offer rebuttal testimony to clarify the facts. "Notice will not be taken of merely formal or technical objections which shall not appear to have wrought a substantial injury to the party raising them...." Trademark Rule 2.123(j).

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have considered applicant's notice of reliance and we agree that many of applicant's submissions are inadmissible under a notice of reliance.

Although applicant may have intended a number of the proffered documents to be admissible as "printed publications," that term has a specific meaning as used in Trademark Rule 2.122 with respect to evidence submitted in a Board proceeding. "Printed publications" are generally defined as "books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding..." TBMP § 704.08 (2d ed. rev. 2004) (and cases cited therein). Accordingly, documents such as letters, e-mail correspondence, web pages, photographs, and the like, are all inadmissible under a notice of reliance.

Likewise, pursuant to Trademark Rule 2.120(j)(3)(i), certain discovery materials may be admissible under a notice of reliance. That provision is limited, however, to the adverse party's depositions, and responses to interrogatories, and responses to requests for admission. Documents produced during discovery or a party's own interrogatory responses are generally not admissible under this provision.

Finally, at the time of trial in this case, a party

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could make its own registration of record by notice of reliance only by filing a copy of the registration prepared by the Patent and Trademark Office showing both current status and title.

Accordingly, opposer's motion is granted with respect to the following exhibits to applicant's notice of reliance:<sup>5</sup> E2, Q, T, V, W, X, Z, DD, EE, FF, GG, HH, II, JJ, KK, PP, QQ, RR, TT, UU, VV, YY, ZZ, BBB, CCC, DDD, EEE, FFF, GGG, HHH, III, LLL, MMM, and NNN.

**2. Opposer's Objections to Lilly Testimony**

Opposer also objected to the testimony of applicant's witness Edward Lilly. Mr. Lilly testified that he has been in the food packaging business for 20-22 years, Lilly Test. at 15, and has packaged applicant's foods for 3-3½ years, *id.* at 17. During cross-examination, however, applicant objected to questions about Mr. Lilly's business and its relationship to applicant. Specifically, applicant objected to opposer's request that Mr. Lilly state the name of his business, Lilly Test. at 76, and that Mr. Lilly disclose in

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<sup>5</sup> Opposer also objected to a number of proffered items consisting of excerpts from opposer's own testimony and first notice of reliance. While it was not necessary for applicant to submit these items into evidence (as opposer had already done so), applicant is entitled to rely on opposer's evidence for any purpose. Opposer has also objected to applicant's submission of previous motions and orders already in the file of this proceeding. While these items are not evidence (and should not have been submitted under a notice of reliance), they are part of

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round numbers, "the annual amount [applicant] paid you for the past three years," Lilly Test. at 77. The basis for the first objection was that the name of Mr. Lilly's business is "proprietary information." The basis for the second objection was stated by Mr. Lilly: "I protect the confidentiality of our customers." *Id.* Rather than answer the questions under objection, the witness refused to provide the information.

We find that both questions were relevant, and that neither objection was justified. Mr. Lilly testified in part about his business relationship with applicant, and how applicant's products are packaged. It was reasonable, on cross-examination, for opposer to explore that relationship, including the name of Mr. Lilly's company and whether Mr. Lilly was biased as a result of his business with applicant. While we do not suggest that any business relationship implies bias, opposer was within its rights to raise the question. Further, it is difficult to see what legitimate proprietary interest would have been violated by the witness's response to either question.<sup>6</sup> Applicant cannot rely on testimony about a business relationship and at the

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the file of this proceeding and may be referred to as appropriate in discussing the procedural history of the case.

<sup>6</sup> To the extent that applicant was genuinely concerned about the confidentiality of proprietary information, it could have agreed to submit those portions of the Lilly testimony under seal, as provided for by the Board's rules. See Trademark Rule 2.126(c).

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same time foreclose opposer's exploration of it.

[U]nlike the practice in Federal district courts, where testimony is given before a judge who can immediately rule on objections, in Board proceedings testimony is submitted in the form of a deposition transcript, and the Board panel does not review the testimony until final hearing. It is therefore the general, and as far as the Board is concerned, favored practice that questions are answered subject to any objection which has been made. Although a party's witness may refuse to answer a question or, as in the present case, be instructed by the party's attorney not to answer, a refusal to answer may, if the objection is not well taken, be construed against the non-answering party.

*See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993). "Because we find [applicant's] objections to be not well taken, we must presume that the answers would have been adverse to opposer's position." *Id.* Accordingly, we presume that Mr. Lilly's testimony was to some extent influenced by his business relationship with applicant.

Opposer objects to much of the rest of Mr. Lilly's testimony because the witness did not testify from personal knowledge, nor was he qualified as an expert. In this regard, Mr. Lilly testified about the predilections of vegetarians and vegans, but admitted that he is neither; he testified about opposer's business, but admitted that he has never visited one of opposer's establishments; and he testified about the meaning and commercial impression of the parties' marks, although he is not an expert in language or

trademarks or the businesses of the respective parties.

We again agree with opposer. It is clear that much of Mr. Lilly's testimony was not based on personal knowledge, nor was he qualified as an expert witness in these fields. Accordingly, his testimony about such matters has no probative value. Fed. R. Evid. 701.

**3. Applicant's Objections**

In its brief, applicant interposed numerous objections to opposer's testimony, exhibits, and notices of reliance. See App. Br. at 30-43 ("All of Mr. Wensinger's testimony is objectionable as hearsay, incompetent, irrelevant or otherwise objectionable"). Applicant further objected to most or all of Mr. Wensinger's rebuttal testimony and the associated exhibits as being improper rebuttal. *Id.* at 31.

We have read opposer's testimony applying the same rules set out above with respect to applicant's evidence. Again, we will not discuss each objection.

We reject applicant's characterization of all of opposer's testimony as hearsay, lacking in foundation, or consisting of "altered" documents. See App. Br. at 32. While some of applicant's objections have merit, others do not.

We reject applicant's objection to Mr. Wensinger's initial testimony as lacking in foundation. Applicant did not attend Mr. Wensinger's first deposition, and thus did

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not raise its objections when the testimony was offered. Had an objection been made on this basis when the testimony was offered, counsel could have adduced additional facts supplying a foundation for Mr. Wensinger's testimony. But having not timely objected, applicant has waived this objection. Fed. R. Civ. P. 32(d)(3)(B)(ii); see Trademark Rule 2.123(k).

On the other hand, Mr. Wensinger's testimony regarding events which occurred prior to his employment was clearly not made on the basis of his first-hand knowledge. To the extent it was not supported by documents regularly kept as a part of opposer's records, this testimony is hearsay, and has not been considered.<sup>7</sup> We have nonetheless considered the documents introduced during Mr. Wensinger's testimony because they are corporate records, regardless of their date of creation.

Applicant also complains that Mr. Wensinger's testimony is suspect because he is "biased." We reject applicant's contention that Mr. Wensinger's testimony "is suspect" because he is employed by opposer. There is a distinction between testimony regarding facts and opinion, and with respect to the fact testimony, Mr. Wensinger's testimony is no more biased in this regard than is applicant's.

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<sup>7</sup> We hasten to add that consideration of Mr. Wensinger's historical testimony would not change our ultimate decision.

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Likewise, we emphatically reject applicant's contention that Mr. Wensinger violated Patent and Trademark Rule 10.63 because he is a practitioner who has offered testimony on behalf of his client. While Mr. Wensinger is opposer's general counsel, he has not appeared in this case as opposer's lawyer. The cited rule is part of Canon 5, which states that "[a] practitioner should exercise independent professional judgment on behalf of a client." Patent and Trademark Rule 10.61. Because Mr. Wensinger is not representing his client before the Board, there is no legitimate concern about the independence of his judgment.

Finally, applicant complains that Mr. Wensinger's rebuttal testimony exceeded the scope of applicant's testimony. As discussed above, there were numerous problems with the Lilly testimony and applicant's notice of reliance. And while we have denied opposer's motion to strike Mr. Rarick's testimony because opposer did not timely object to it, the Rarick testimony was unfocused and in many cases of questionable relevance.

We find that opposer's rebuttal testimony and evidence were a reasonable attempt to "deny, explain or otherwise discredit the facts and witnesses of applicant." *The Ritz Hotel Ltd. v. Ritz Closet Seat Corp.*, 17 USPQ2d 1466, 1469 (TTAB 1990). Given the state of this record, we will not attempt to precisely limn the scope of each fact introduced

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during opposer's rebuttal period and compare it strictly with the scope of applicant's evidence.

We have likewise considered applicant's cross-examination of Mr. Wensinger on rebuttal, for whatever probative value it may be entitled to.

**II. Applicable Law**

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 Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *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 Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Rest. Enterp., Inc.*, 50 USPQ2d 1209 (TTAB 1999), and cases cited therein.

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We have made specific rulings on other items of evidence below, as necessary.

**III. Discussion**

**A. Background**

**1. Opposer**

Opposer owns a chain of approximately 180 IN-N-OUT BURGER restaurants which operate primarily on the West coast.<sup>8</sup> The restaurants serve hamburgers, cheeseburgers, french fries, and soft drinks for consumption on or off the premises. In addition to its IN-N-OUT BURGER mark, opposer uses the trademark QUALITY YOU CAN TASTE in connection with its restaurant services, and pleaded ownership of the following trademark registrations<sup>9</sup> (in typed format) for this mark:

<b>Reg. No.</b>	<b>Goods/Services</b>	<b>Date Issued</b>
1090096	Restaurant Services (Class 42)	Apr. 25, 1978
2604277	French fried potatoes for consumption on or off the premises (Class 29)	Aug. 6, 2002
2634516	Computer services, namely, providing online databases in the field of mail order merchandising services (Class 35); and Computer services, namely, providing online databases in the fields of restaurant services and nutrition (Class 42)	Oct. 15, 2002

<sup>8</sup> Opposer did not offer clear testimony as to the number of restaurants it operates. Applicant refers to opposer as having 177 to 200 locations, *e.g.*, App. Br. at 28, which opposer did not dispute, and opposer's witness made mention of a "Store Number 178," in discussing another matter, Wensinger Test. at 37.

<sup>9</sup> Opposer submitted copies of these registrations, prepared by the USPTO, showing status and title, with its notice of reliance. See Trademark Rule 2.122(d)(2). In each registration, post-registration filings under Trademark Act §§ 8, 9, and/or 15 have been accepted, granted, and acknowledged at the appropriate times.

We note that the '096 Registration, claiming dates of use and use in commerce as of April 30, 1950, was assigned to opposer on August 11, 1999. The original registrant appears not to have been related to opposer.

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2839431	Hamburger and cheeseburger sandwiches made-to-order for consumption on or off the premises (Class 30)	May 11, 2004
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In addition to its pleaded registrations, during testimony opposer introduced Registration No. 2614730, for the mark QUALITY YOU CAN TASTE for "clothing, namely, shirts, caps and jackets," in International Class 25. Wensinger Test. at 14; Exh. 5. However, applicant objected to consideration of this registration because it was not pleaded in the notice of opposition. App. Br. at 1, 13.

We agree that this registration was neither pleaded as a bar to registration nor was likelihood of confusion with this mark tried by consent. See App. Br. at 17; Fed. R. Civ. P. 15(b). Accordingly, we will not consider likelihood of confusion as it specifically relates to the '730 Registration.

**2. Applicant**

On August 13, 2003, John C. Rarick filed the subject application for registration of the mark QUALITY YOU CAN CRUNCH for "dried fruits." On October 15, 2003, Mr. Rarick assigned the application to Peak Harvest Foods, LLC.<sup>10</sup> Mr.

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<sup>10</sup> The assignment of the subject application to Peak Harvest predated the commencement of this proceeding, and opposer correctly named Peak Harvest as the defendant in its notice of opposition. However, for reasons which are not clear, this proceeding was instituted by the Board naming Mr. Rarick as the sole defendant. The Board referred to Mr. Rarick as the defendant until April 18, 2006, when an order was issued noting the assignment and joining Peak Harvest as a party defendant. This appears to have been an error. Because Peak Harvest was the owner of the application at the time the opposition was filed and

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Rarick is and has been the Executive Manager of Peak Harvest.

Peak Harvest produces packaged dried apples. A package of applicant's product in the record displays the QUALITY YOU CAN CRUNCH™ mark along with the designations PEAK HARVEST™ FOODS, and CRUNCHY APPLE STIX™. Applicant sells its products in natural food stores and convenience stores. Rarick Test. at 45-46.

**B. Standing and Priority**

Opposer made its pleaded registrations of record, thus establishing its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, because opposer's pleaded registrations are of record, priority is not an issue. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Further, as noted below, opposer has established use of its mark at least as early as December 30, 1967, well prior to any date upon which applicant may rely.

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at all times thereafter, it should have been substituted for Mr. Rarick as the sole defendant herein. See TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 512.01 (2d ed rev. 2001). The caption of this case has been corrected to indicate that Mr. Rarick is not a party in his personal capacity.

**D. Likelihood of Confusion**

**1. The Similarity or Dissimilarity of the Marks  
in Their Entireties**

In comparing two marks to ascertain whether confusion is likely, we consider the marks' appearance, sound, meaning and commercial impression. *Palm Bay*, 73 USPQ2d at 1692.

[T]he 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 impression so that confusion as to the source of the goods offered under the respective marks is likely to result." *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1727 (TTAB 2008).

The mark in the subject application is QUALITY YOU CAN CRUNCH (stylized), while the mark in the pleaded registrations is QUALITY YOU CAN TASTE (typed). We begin by noting that although applicant seeks registration of its mark in stylized format, opposer's marks are registered as words only, without respect to "font style, size or color." Trademark Rule 2.52(a). Thus, opposer's registrations provide protection for its registered word mark without limitation as to font, size, or color, including those similar to applicant's mark. Contrary to applicant's argument, any attempt to distinguish the respective marks on the basis of their "typefaces [or] colors" or the fact that

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"[o]pposer's mark is displayed in neon," App. Br. at 7-8, is simply incorrect as a matter of law. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) ("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce.")

The marks bear obvious similarities in appearance, sound, and connotation in that they both start with the words "quality you can...", although they differ in their last word. Applicant emphasizes that the final words of the marks differ, creating a different commercial impression. App. Br. at 6-7. On the other hand, opposer argues that this difference is insignificant because "[t]he term 'crunch' shares an inseparable association with the word 'taste.'" Opp. Br. at 8. Opposer makes much of its contention that its foods "crunch," going so far as to introduce a patent that it holds for a toaster which is asserted to make its hamburger buns crunchy.

"Crunch" (or the lack of it) and "taste" are clearly sensations one encounters while eating. However, the words do not look or sound identical, and - contrary to opposer's arguments - they do not mean the same thing. While opposer's dictionary definition supports the notion that "touch" - along with taste and smell - is a component of

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"taste,"<sup>11</sup> it is a considerable leap to the notion that consumers would understand the words "crunch" and "taste" to mean essentially the same thing.

The marks are somewhat similar in connotation, in that they imply that the relevant goods or services are of (high) quality. Viewing the marks as a whole, opposer's mark implies that this quality is evident in the taste of opposer's food, while applicant's mark implies that one can judge the quality of its dried fruit by its crunch.

The marks at issue share the common words "quality you can . . .," and are therefore similar. However, as discussed more fully below, the marks are both suggestive to the extent that they convey a laudatory message about the nature and quality of the associated goods and services. When the marks involved are weak, small differences may be sufficient to distinguish them. While it is sometimes said that the first word or words in a mark create the strongest impression, e.g., *Presto Prod., Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988), that is not necessarily true when, as here, these words are highly suggestive.

Because the marks share some similarities, in this

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<sup>11</sup> "taste n ... **5a**: a sensation obtained from a substance in the mouth that is typically produced by the stimulation of the sense of taste combined with those of touch and smell...." MERRIAM-

respect this factor favors opposer. However, because the marks are weak, we also find that the differences in the marks are significant.

**2. The Similarity or Dissimilarity and Nature of the Goods or Services**

Although opposer has introduced a registration covering various computer services,<sup>12</sup> for purposes of this factor, we concentrate on opposer's registrations for food and restaurant services, as they are the most relevant. Opposer's goods and services primarily relate to its restaurants, and the food it serves there, namely, hamburgers, cheeseburgers, and french fries, while applicant's goods are identified as dried fruit. The evidence of record indicates that applicant sells its product through food stores and through direct sales.

In arguing that the goods are related, opposer states that "[i]t is common for fruit to be served as part of a menu item featuring hamburgers, cheeseburgers, and french fries. Opposer serves tomatoes in association with its hamburgers and cheeseburgers.... Tomatoes are a fruit...." Opp. Br. at 8 (citations omitted). Applicant disagrees,

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WEBSTER'S COLLEGIATE DICTIONARY (11<sup>th</sup> ed.) (no year provided). Opp. First Not. of Rel., Exh. 6.

<sup>12</sup> Registration No. 2634516. Opposer's testimony made clear that these services essentially provide information about opposer's restaurants and the food served therein, and provide for the online ordering of promotional items. Wensinger Test. at 11-12, 13, 32-33.

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citing *Nix v. Hedden*, 149 U.S. 304 (1893), for the proposition that tomatoes are a vegetable - at least so far as the Tariff Act of 1883 was concerned. Opposer testified that it also provides "cookout trailers" to serve its food at special events. When it does so, it serves "a selection of fresh fruit, including apples, bananas, grapes, sometimes nectarines, et cetera." Wensinger Test. at 29-31; Opp. Br. at 9.

Both parties miss the point. The question is not whether tomatoes are classified as a fruit or vegetable, but whether and to what extent "dried fruit" is related to restaurant services, and prepared hamburgers, cheeseburgers, and french fries.

Opposer introduced evidence that some other similar food establishments (e.g., McDonald's, Wendy's, Orange Julius, and Friendly's) serve fruit-based menu items, such as "apple dippers and some type of fruit parfait," and argues that these items are within its logical zone of expansion. Nonetheless, opposer has not introduced any evidence showing that it or any other restaurant serves dried fruit, or that there is any other reason why potential purchasers would associate applicant's packaged dried fruit with opposer's restaurant services and prepared food.

Our precedent has often noted that there is no rule that food and restaurant services are related. To the

contrary, our cases have long cautioned that "something more" is needed to prove an association between such goods and services. *E.g.*, *Jacobs v. Int'l Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982) ("To establish likelihood of confusion a party must show something more than that similar or even identical marks are used for food products and for restaurant services."); *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003); *In re Opus One Inc.*, 60 USPQ2d 1812, 1813 (TTAB 2001).

We conclude that although the goods and services at issue here are all food or food-related services, opposer has not demonstrated that they are related in such a way that consumers encountering them under the same or similar marks would be likely to believe that they share a common source.

**3. The Similarity or Dissimilarity of Established, Likely-to-Continue Trade Channels**

Opposer argues that because there are no limitations in the application or the pleaded registrations, we must assume that the parties' "products are sold through all customary trade channels for their respective services and products...." Opp. Br. at 10. Therefore, opposer concludes, "the products should be treated as though they are sold in juxtaposition." *Id.* Opposer's statement of the law is correct, but its conclusion is not.

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When an application or registration is not limited as to its trade channels or customers, the identified goods or services are legally construed to move in all usual channels of trade, and to all of the usual customers for those goods or services. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958). But it does not follow that non-identical goods or services move in identical channels of trade merely because neither of them is explicitly limited in its channels of trade.

Opposer's hamburgers and french fries for consumption on or off the premises are presumed to be sold in all usual channels of trade for hamburgers and french fries for consumption on or off the premises. Goods such as opposer's, which are prepared food items, are normally sold to customers in restaurants and take-out places including, but not limited to, fast food restaurants. Likewise, applicant's dried fruit is presumed to be sold in the usual channels of trade for dried fruit. Such items are typically sold in grocery stores, convenience stores and other such retail food outlets.

Contrary to opposer's contention, the lack of limitations in applicant's and opposer's channels of trade does not raise a presumption that such goods or services are rendered through identical channels of trade. There is no

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evidence that goods such as applicant's are typically sold in restaurants or that opposer's goods are normally found in grocery stores. Without such evidence, we cannot agree with opposer's assertion that one would normally expect to find such products being sold "in juxtaposition."

Finally, opposer points out that both parties' goods and services are advertised and sold "on the internet." Opp. Br. at 10. But given the vast array of goods and services available online, the mere fact that two products or services can be found in cyberspace is no more meaningful than saying that both products are sold in "brick-and-mortar" stores. *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1021 (TTAB 2007).

We conclude that the channels of trade for the relevant goods and services are not similar.

**4. The Conditions Under Which and Buyers to Whom Sales are Made**

The parties have spent considerable effort arguing about the price of their respective goods and services and whether their customers overlap in fact. Without discussing these arguments in great detail, we conclude that neither parties' goods and services are particularly expensive, and that they are all of a type which are typically purchased without the kind of extensive investigation that would mitigate any confusion which might otherwise occur.

Applicant stresses the healthful qualities of its product, and argues that its customers are sophisticated about their food choices and "would not eat at the [o]pposer's restaurants." App. Br. at 22. Nonetheless, applicant's goods are identified simply as "dried fruit." In an opposition proceeding, our analysis is limited to consideration of the goods as recited in the application or registration, and not what the goods may actually be in the marketplace. See *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). Thus, regardless of the nature of applicant's actual products and customers, we cannot presume that the purchasers of applicant's identified goods are limited to vegetarians, people with concerns (or particular knowledge) about nutrition and health, or persons who are more sophisticated or discerning than are ordinary purchasers of "dried fruit." And since there is no evidence that consumers of dried fruit in general exercise unusual caution, we consider such purchasing decisions to be made with no more than ordinary care.

**5. The Fame of the Prior Mark (Sales, Advertising, Length of Use)**

We consider next opposer's evidence that its mark is famous. Fame, when found, is entitled to great weight in a likelihood of confusion analysis. *Recot Inc. v. M.C. Becton*, 54 USPQ2d 1894, 1897-98 (Fed. Cir. 2000). Opposer

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argues that by the nature and extent of its use of QUALITY YOU CAN TASTE, the mark has become famous. As noted in the seminal *du Pont* decision, the primary factors in assessing fame are "sales, advertising, [and] length of use." *du Pont*, 177 USPQ at 567.

Opposer testified that it sold gift certificates bearing the QUALITY YOU CAN TASTE mark in the amounts of "almost \$4,000,000 in 2002, over \$5,000,000 in 2003 and short of \$5,000,000 in 2004," Opp. Br. at 13, Wensinger Test. 40; Exh. 40A, and that it "has advertised on radio, television, the internet, newspapers, newsletters, magazines, lapmats, billboards ..., mobile cookout trailers and handbills...." *Id.* According to an internal e-mail, in 2005, the sum of \$235,329 was spent on radio advertisements, slightly less than the sum spent in the years 2002-2004. Wensinger Test. 46-47; Exh. 40. In addition, opposer maintains a web site which promotes its goods and services. Opposer sells shirts bearing the mark as promotion. *Id.* at 14. Opposer also points to five articles about its business in widely-circulated newspapers,<sup>13</sup> favorable mentions in the

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<sup>13</sup> The San Francisco Chronicle, The Boston Globe, The New York Times (two articles) and The Dallas Morning News.

In addition, opposer submitted two other items: a web article, Brian Vance, [In-N-Out Burger: "Quality You Can Taste,"](http://www.jour.unr.edu/outpost/Dining/din.vance.in-n-out.html) [www.jour.unr.edu/outpost/Dining/din.vance.in-n-out.html](http://www.jour.unr.edu/outpost/Dining/din.vance.in-n-out.html). (Feb. 17, 2005) (apparently posted on April 1, 2000); and what appears to be a press release: [In-N-Out Burger Orders up to 100 ZAPPY Electric Scooters to be Given Away in New Sweepstakes, Prime](#)

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book *Fast Food Nation*, and one instance of opposer's business being discussed on national television. *Id.* at 15-16. Nonetheless, only one of these items mentions opposer's QUALITY YOU CAN TASTE trademark. See *Wensinger Test.*, Exh. 37, (Leslie Earnest, Chain is Not Only In-N-Out, It Lands On Top In A Survey, *Los Angeles Times*, Part C, p.3 (Mar. 6, 2001)).

The relevant question is not whether opposer or its IN-N-OUT BURGER mark is famous, but whether opposer's QUALITY YOU CAN TASTE mark is famous. Articles, books, and television stories which make no mention of that mark cannot contribute to its fame or renown, no matter how favorable they may be to opposer in other respects. While we have taken the *Los Angeles Times* article into account, as well as the web article and press release, they provide - at best - only scant evidence of public recognition for opposer's QUALITY YOU CAN TASTE mark.

Opposer asserts that its "sales for 2001 were estimated at \$160,000,000," citing a *New York Times* article introduced during Mr. Wensinger's testimony. *Wensinger Test.* at 48-49; Exh. 42. While the article does include this estimate, we cannot view the article as evidence of opposer's actual 2001

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Media Network (October 11, 2000). Although both of these items include the QUALITY YOU CAN TASTE mark, we find them to be entitled to relatively little weight because it is not clear

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sales or even as an estimate of them because the statement made in the article is hearsay. *Life Zone, Inc. v. Middleman Group, Inc.*, \_\_ USPQ2d \_\_, Slip. Op. at 4, n.5 (TTAB July 15, 2008) ("a printed publication is only admissible for what it shows on its face; unless it falls within an exception to the hearsay rule it will not be considered to prove the truth of any matter stated in the publication." *Citing 7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.2 (TTAB 2007)).

The level of opposer's sales was a matter which could have been introduced by testimony and by the introduction of appropriate business records. However, Mr. Wensinger did not specifically discuss this or any other annual sales figures, nor was any other evidence introduced on the volume of opposer's sales, and we must therefore consider the record silent on this issue.

Mr. Wensinger also testified that part of opposer's advertising is its gift certificate program. According to a spreadsheet identified by the witness, applicant's sale of gift certificates amounted to between approximately \$4 Million and \$6 Million for the years 2002 - 2005.<sup>14</sup>

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whether the public has been exposed to them (particularly the press release), and if so, to what extent.

<sup>14</sup> The 2005 figures were estimated.

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Wensinger Test. at 45; Exh. 40A.<sup>15</sup>

The biggest problem with all of these figures is the lack of context: "Raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, but raw numbers alone in today's world may be misleading." *Bose Corp. v. QSC Audio Prod. Inc.*, 293 F.2d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002). Applicant does not provide the market share represented by its receipts and expenditures, so it is difficult to determine whether they are substantial for the purpose of proving fame.

As to how long opposer has been using its QUALITY YOU CAN TASTE mark, we note some uncertainty in the record.<sup>16</sup>

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<sup>15</sup> Mr. Wensinger did not discuss Exhibit 40A in detail, see Wensinger Test. at 45, and we find it rather unclear. This small spreadsheet apparently itemizes certain receipts and expenditures (although the two are not differentiated) for the years 2002-2004, and estimates for 2005. The first row in the spreadsheet is "Radio/Traffic," and lists \$118,657 for 2003 and an estimated \$310,570 for 2005, with nothing under 2002 or 2004. (The 2005 figure seems to conflict with Exhibit 40, which shows traffic sponsorships for 2005 in the amount of \$235,329.) The next row shows figures for "Gift Certificates Sold," followed by rows for "G.C. Radio," "G.C. TV," "G.C. Lapmats," "G.C. In-Store POP."

It is not clear from Mr. Wensinger's testimony or from the exhibit itself just what information appears on this spreadsheet. For instance, "Radio/Traffic" may refer to some sort of radio advertisement, but the spreadsheet also includes a line item for "G.C. Radio." It is not clear what the latter item is and how it differs from the "Radio/Traffic" item. That said, even regarding this evidence in a light most favorable to opposer, we do not find these advertising expenditures to be of a level sufficient to prove the fame of opposer's mark.

<sup>16</sup> Opposer argues that it is entitled to a date of first use of the mark of April 30, 1950, the date of first use set out in the '096 Registration. In support of that date, opposer has submitted the declaration of Harvey Gough, who assigned the

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Mr. Wensinger testified "I know it's been at least as early as 1968, 1967, somewhere in that time frame. And for some reason, 1963 comes to mind, but I could be confusing it with another mark. I know for sure at least as early as 1968." Wensinger Test. at 17.

As discussed above, to the extent Mr. Wensinger's statements were not supported by documents from opposer's records, they are hearsay. In this regard, Mr. Wensinger identified a newspaper advertisement dated December 30, 1967, using the mark. We find that this evidence establishes that opposer has been using the QUALITY YOU CAN TASTE mark since at least as early as December 30, 1967.

Although we agree that opposer has used its mark for a substantial length of time, it is important to note that the geographic extent of opposer's business is limited. The record establishes that opposer operates approximately 180 restaurants in Southern California, Nevada, and Arizona.

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registration to opposer in 1999. Wensinger Test. at 18; Exh. 8. Mr. Gough did not offer testimony and was not subject to cross-examination. While the parties may stipulate to the submission of evidence by affidavit, Trademark Rule 2.123(b); *Boyd's Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2020 (TTAB 2003), they have not done so in this case. The statements in Mr. Gough's declaration are accordingly hearsay, and have not been considered.

We further note that because an allegation of a date of first use in a registration is not itself evidence, Trademark Rule 2.122(b)(2), the earliest date upon which opposer is entitled to rely by virtue of the '096 Registration itself is the filing date of the application which matured into that registration, *i.e.*, July 29, 1976. See *Henry Siegel Co. v. M&R Int'l Mfg. Co.*, 4 USPQ2d 1154, 1160 (TTAB 1987).

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Wensinger Test. at 44, 54. While opposer's newspaper articles, the excerpt from Fast Food Nation, and mention on one national television program indicate that opposer has received some mention outside this area, we cannot conclude that the QUALITY YOU CAN TASTE mark has achieved any significant recognition outside opposer's area of operation. As we noted in a case with some similarities (but a better-developed record on fame):

Opposer certainly has enjoyed considerable success with its restaurants. Opposer's sales in the period 1986-1992 exceed \$3.3 billion, with 1992 sales of over \$614 million. Opposer traditionally spends 4% of its gross sales revenues on advertising. Opposer's figures for the period 1983-1990 show that opposer spent almost \$247.5 million on advertising, with expenditures in 1990 of \$39.2 million.

The evidence of record, when taken as a whole, indicates that opposer's star marks are well known in its specific area of operation, namely California, Arizona, Oregon and Nevada. In other words, the evidence does not establish that opposer's marks are nationally famous. Rather, opposer has established local notoriety in its trading area. See, *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 394 (Fed. Cir. 1983); and *Berghoff Rest. Co. v. Washington Forge, Inc.*, 225 USPQ 603 (TTAB 1985).

*Carl Karcher Enters. Inc. v. Stars Rests. Corp.*, 35 USPQ2d 1125, 1130 (TTAB 1995).

In that perspective, opposer's evidence falls far short of convincing us that QUALITY YOU CAN TASTE is a famous mark. While opposer is undoubtedly well-known, at least within its area of operation, it has not clearly shown a

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level of recognition for its mark which would justify the heightened scope of protection afforded truly famous marks. In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, we think that it is the duty of a plaintiff asserting that its mark is famous to clearly prove it. Accordingly, we cannot conclude applicant's mark is "famous" for purposes of a likelihood of confusion analysis.

In addition to the fame or renown of a mark, we also consider the inherent distinctiveness of the mark, *i.e.*, where it fits in the continuum described as ranging from generic through fanciful. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ2d 759, 764 (2d Cir. 1976). While "the lines of demarcation ... are not always bright," *id.*, it is axiomatic that those marks which are highly distinctive are usually entitled to a broader scope of protection, while marks falling towards the other end of the spectrum typically enjoy little or no protection.

We find in this case that both opposer's and applicant's marks are suggestive in that they both convey a somewhat laudatory message about the quality of the goods,

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opposer's mark more so than applicant's.<sup>17</sup> As noted above, the marks both directly indicate to the prospective customer that the vendor's goods or services are of high quality, and that this quality can be judged by the product's "crunch" or "taste." In this respect, both marks are less distinctive than purely arbitrary or fanciful marks. As a result of this inherent weakness, any similarity of the marks is less likely to cause confusion than would be the case if the marks were arbitrary or fanciful. *Sure-Fit Prod. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958) ("Where a party chooses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.").

**6. Balancing the Factors**

We have carefully considered opposer's evidence and arguments regarding the remaining *du Pont* factors. We will not belabor this opinion with a detailed analysis of them, however, because we find them to be essentially neutral.

As noted above, applicant's mark, QUALITY YOU CAN CRUNCH, is somewhat similar to opposer's QUALITY YOU CAN

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<sup>17</sup> Applicant contends that opposer's mark is descriptive and unregistrable. App. Br. at 12-13, 15. While applicant may appropriately argue that opposer's mark is weak, in the absence of a counterclaim applicant may not attack the validity of opposer's registration. Trademark Rule 2.106(b)(2)(ii); *Contour Chair-Lounge Co. v. The Englander Co.*, 324 F.2d 186, 139 USPQ 285, 287 (CCPA 1963); *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718, 1735 (TTAB 1998).

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TASTE marks, in that they both begin with the same words. However, because these words, as well as the marks as a whole, are both suggestive, the impact that we would normally accord to the similarity of the initial words is undercut. When considering the parties' goods and services, the evidence does not establish that they are related in any meaningful way, beyond the fact that they are all food or food-related services. Moreover, while neither party's goods and services are of a type purchased only after a careful investigation, opposer has not established that the parties' goods and services are sold or offered in the same channels of trade, or that potential purchasers would see (or expect to see) goods and services of this type sold or offered in close proximity. Finally, we do not find opposer's mark to be famous and thus entitled to very broad protection.

After careful consideration of the evidence and arguments of the parties, we conclude that confusion is not likely.

**E. Dilution by Blurring**

Opposer claims that use of applicant's mark would be likely to "lessen the capacity of [o]pposer's ... marks to identify and distinguish opposer's services and goods."

In order to prevail on a claim of dilution, opposer must prove, as a threshold matter, that its mark became

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famous prior to applicant's first use. Trademark Act § 43(c)(1). As we have noted in other cases, "[f]ame for dilution purposes is difficult to prove. ... The party claiming dilution must demonstrate by the evidence that its mark is truly famous." *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001). In other words, the requirement for proving "fame" for dilution purposes under Trademark Act § 43(c) is considerably more stringent than the proof of "fame" in a likelihood of confusion analysis. Moreover, while proof of the fame or renown of the plaintiff's mark is optional in a likelihood of confusion case, it is a statutory requirement in a dilution analysis.

As noted, we do not find opposer's mark famous for likelihood of confusion purposes. Since it is even harder to prove fame for dilution purposes, we need go no further; because opposer has not established that its mark is famous, it cannot prevail in its dilution claim.

**Decision:** The opposition to the registration of applicant's mark is dismissed.