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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

7-Eleven, Inc.
v.
HEB Grocery Company, LP

Opposition No. 91162178
to application Serial No. 75800994
filed on September 16, 1999

Diane G. Elder of Foley & Lardner, LLP for 7-Eleven, Inc.

Kirt S. O'Neill of Akin, Gump, Strauss, Hauer & Feld, L.L.P.
for HEB Grocery Company, LP.

Before Quinn, Hairston and Kuhlke, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, HEB Grocery Company, LP, seeks registration
of the mark **CLASSIC SELECTIONS** (in typed form)¹ for goods
identified in the application as "frozen entrees consisting

¹ Prior to November 2, 2003, standard character drawings were known as typed drawings and typed drawings that are still pending after November 2, 2003 are acceptable under the old rules. See TMEP § 807.03(i).

primarily of meat, fish, poultry or vegetables" in International Class 29.²

Opposer, 7-Eleven, Inc., opposed registration of applicant's mark, on the grounds that, as applied to applicant's frozen entrees, the mark **CLASSIC SELECTIONS** so resembles opposer's previously used and registered mark



for drinking water, as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant filed an answer by which it denied the salient allegations of the notice of opposition.

The evidence of record includes the pleadings; the file of the opposed application; trial testimony, with related exhibits, taken by each party; a status and title copy of opposer's pleaded Registration No. 1950904, status and title copies of opposer's other registrations, copies of opposer's trademark applications, copies of third-party registrations and applicant's registration, copies of articles from various printed publications, and applicant's responses to discovery requests, all introduced by way of opposer's notices of reliance; and copies of applicant's and third-

² Serial No. 75800994, filed September 16, 1999 based on a bona fide intention to use the mark in commerce under Trademark Act Section 1(b). 15 U.S.C. §1051(b).

party registrations, made of record by way of applicant's notice of reliance.³

Opposer's pleaded registration is summarized as follows:

Registration No. 1950904 for the mark



for "drinking water" in International Class 32, filed December 30, 1994, issued January 23, 1996, renewed, QUALITY disclaimed.

Because opposer has made its pleaded registration of record and its claim is not frivolous, opposer has established its standing to oppose registration of applicant's mark, and its priority is not in issue. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000) and *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) 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 and 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).

We begin our analysis with the first du Pont factor, i.e., whether applicant's mark **CLASSIC SELECTIONS** and

³ Opposer's motion, filed February 7, 2006, to substitute trial exhibit labels is granted.



opposer's mark  are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under this du Pont factor, 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 offered under the respective marks is likely to 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).

We find that due to its visual prominence, the dominant and distinguishing portion of opposer's mark is the phrase CLASSIC SELECTION which is essentially identical in sound, appearance, connotation and commercial impression to applicant's CLASSIC SELECTIONS mark. The only difference is the pluralization of the word SELECTIONS in applicant's mark and we do not find this to be a significant difference. See *Wilson v. Delauney*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957). The fact that marks differ in appearance and sound to the extent that one is the plural form of the other "does

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not amount to a material difference" in the marks. In re Belgrade Shoe, 411 F.2d 1352, 162 USPQ 227, 227 (CCPA 1969); and In re Pix of America, Inc., 225 USPQ 691, 692 (TTAB 1985) (the fact that one mark is in plural form is "almost totally insignificant in terms of the likelihood of confusion of purchasers.").

Further, while we are mindful that the respective marks must be considered in their entireties and that any descriptive or other disclaimed matter therein cannot be ignored, our principal reviewing court has indicated that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "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 [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). According to the court, "[t]hat a particular feature is descriptive [or otherwise lacking in distinctiveness]...with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark..." Id. Here, the word "QUALITY" in opposer's mark has been disclaimed as descriptive and, as such, is less significant than the dominant and distinguishing phrase CLASSIC SELECTION when the mark is considered as a whole. See In re

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Code Consultants, Inc., 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the marks' commercial impression.").⁴ In addition, the term "QUALITY" appears in the mark in a much smaller size font, which adds to the subordinate nature of the term in the mark. Thus, while opposer's mark includes additional matter, consisting of the laudatory word "QUALITY" and the design element of a banner and a rectangular outline, overall the marks at issue are similar in sound, appearance, connotation and commercial impression. Moreover, although opposer's mark depicts the identical wording with one word on top of the other, applicant's mark in typed form could appear in any reasonable form of stylization and, in fact, as shown by the evidence of record is presented in such a format.

As to connotation, citing to the deposition of Robert Kailing, one of applicant's Business Unit Directors, applicant argues as follows:

The term CLASSIC SELECTIONS on [applicant's] frozen food products means that the goods consist of a variety or assortment of "classic" foods - food items that consumers are familiar with - that

⁴ Applicant argues that the case In re Sunmarks, Inc., 32 USPQ2d 1470 (TTAB 1994) supports its position that the word QUALITY should not be given less weight in this analysis, because QUALITY is not generic as was the case with LUBE in the Sunmarks case and QUALITY is "close in meaning to ULTRA, the term that the Board gave the most weight to in the cited case." Br. p. 10. Applicant's argument is not persuasive; we must look at the relative prominence of the various elements of the marks before us, and the relative importance of various elements of marks in other cases is not relevant.

are selected for a meal. [citing to Kailing Dep. pp. 57-58]. Specifically, CLASSIC is "intended to relay the meaning of something that is time tested, and that you're familiar with, and comfortable with, and is important to you, and is of high quality" [citing to Kailing Dep. p. 79] and SELECTIONS is intended to convey the variety of classic entrees that are available for selection as a meal. [citing to Kailing Dep. p. 58].

The frozen entrees that are actually sold under the mark CLASSIC SELECTIONS support this interpretation. HEB's CLASSIC SELECTIONS brand includes classic food items such as lasagna, chicken fettuccini alfredo, beef tips, macaroni and cheese, pizza, and pork chops. These are all classic food items because they are familiar to consumers and remind them of their pasts...

While it is unclear what the terms CLASSIC and SELECTION mean when they are used on bottled water, it is clear that consumers will not interpret [opposer's] mark to mean that it sells an assortment of time-tested, and familiar water.

Br. pp. 8-9.

Opposer in response argues that applicant's "primary basis for its position is that one of its business personnel testified what 'CLASSIC' and 'SELECTIONS' individually were intended to mean by applicant with respect to its products" but "this self-serving testimony is insufficient to establish what is conveyed to consumers by applicant's use of the combination of the two word term CLASSIC SELECTIONS" and "regardless of applicant's supposed intent, there is no basis for concluding that consumers will understand applicant's mark to have any meaning other than that of the English language term CLASSIC followed by SELECTIONS. In other words, the same meaning as opposer's mark." Br. p. 4.

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While it may be that certain consumers will grasp applicant's intended effect when purchasing their macaroni and cheese, it is not clear from this record that that is actually the case and there is nothing in the record to discount the possibility that applicant's intended connotation may be lost on at least some consumers. In such circumstances, the connotation of the parties' marks would be identical.

Thus, we find that the similarities in the sound, appearance, connotation and overall commercial impressions of the parties' marks outweigh their differences.

In arguing that no likelihood of confusion would result by the concurrent use of these marks applicant contends that the CLASSIC SELECTION portion of opposer's mark is weak and should be accorded very narrow protection. In support of this argument applicant submitted examples of third-party use and registrations of the terms CLASSIC, CLASSICS, CLASSICO, SELECT, SELECTS, and SELECTIONS, in connection with a variety of food items (the examples of use include soup, cereal, sauces, spices, bread mix, frozen entrees, sodas, olive oil, snack bars, cocoa, chocolate bars, guacamole mix, cheese, sliced meats, pet food, cookie dough, canned seafood; the registrations include mineral and aerated waters, frozen prepared foods, bottled water, etc.)

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The existence of widespread third-party use under the du Pont factors may serve to indicate the weakness of a term in the context of its source identifying significance. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). In addition, the existence of a term in several third-party registrations may indicate that a term has a descriptive or suggestive significance which could minimize its impact when the mark is viewed in its entirety. *AMF Inc. v. American League Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (CCPA 1973). As opposer points out, there are many duplicative examples in the record (e.g., the Campbell Select soups), very few examples of the word SELECTION(S), and most of the examples are for food products other than the ones in issue here; all of which lessens the probative value of the evidence. That being said, we cannot disagree that the phrase CLASSIC SELECTION is composed of commonly used terms on food and beverage products and that individually these terms may have a suggestive meaning and, thus, are weak. We take judicial notice of the following dictionary definitions of CLASSIC and SELECTION:⁵

CLASSIC: adj. 1. c. Having lasting significance or worth; enduring. e. Of a well-known type; typical
f. Formal, refined, and restrained in style;

⁵ *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

SELECTION: n. 1. a. The act or an instance of selecting or the fact of having been selected. B. One that is selected. 2. A carefully chosen or representative collection of people or things.

The American Heritage Dictionary of the English Language
(4th ed. 2000).

Thus, the phrase CLASSIC SELECTION consists of a term, CLASSIC, that has a laudatory attribute, and a term, SELECTION, that indicates a product to be selected or a "representative collection" of offerings. Therefore, even when used together CLASSIC SELECTION is not a strong, arbitrary mark, but rather is clearly in the category of laudatory/suggestive.

However, there is no evidence of the terms used together beginning with the word CLASSIC. Moreover, although opposer's evidence does not support a finding that its mark is well known, there is nothing in the record to rebut opposer's evidence of substantial sales under its mark during a period of over 12 years.⁶ Therefore, although the individual terms may be weak in connection with food and beverage products generally, in view of the third-party uses and suggestive meanings, we find that the differences in the parties' marks are not sufficient to avoid a likelihood of

⁶ Opposer's evidence consisting of excerpts from trade journals that include references to its mark is of little probative value as to the strength of opposer's mark in the consumer's mind. Further, while opposer has enjoyed substantial sales over a period of twelve years, these sales alone do not support a

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confusion when used on sufficiently related goods, where the terms are similarly combined as they are in this case, and there is no evidence of use of the combined terms. However, we do not accord opposer's mark the broad scope of protection that would be given to a stronger, more arbitrary mark.

We turn next to the second, third and fourth du Pont factors, i.e., the similarities between opposer's and applicant's goods, and the similarities between opposer's and applicant's trade channels and classes of purchasers of these goods. We must make our determinations under these factors based on the goods as they are recited in the application and registration, respectively. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

The goods need not be identical or directly competitive in order for there to be a likelihood of confusion. Rather, the respective goods need only be related in some manner or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

finding that opposer's mark is strong and deserving of broad protection.

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Opposer's Registration No. 1950904 is for "drinking water." Applicant's goods are "frozen food entrees consisting primarily of meat, fish, poultry or vegetables." These goods are obviously different in character; opposer's goods are a non-perishable beverage and applicant's goods are perishable frozen food items. The differences in the goods are also reflected in how they are managed in the retail food industry, specifically, they are separated into different categories of goods and handled by different personnel in view of the different functionality of the goods and consumer's shopping habits. See Douglas Woodward (opposer's Director of Package Beverage and Ice Cream) Dep. pp. 5, 47; Kailing Dep. pp. 7, 47-48; and Kurt Schumacher (opposer's National Category Manager for dairy, frozen and refrigerated products) Dep. pp. 40-42.

Opposer argues that they are related in that they are complementary because they can be consumed together and are both in the category of "convenience products." Further, opposer argues that the many examples of third-party use and third-party registrations of frozen food and drinking water under the same mark support a finding that consumers are accustomed to purchasing drinking water and frozen foods under the same mark and this relationship is further strengthened by the close proximity of the parties' goods in stores and grocery store advertisements. Finally, opposer

argues that frozen food entrees are within its zone of expansion.

Opposer's proposition that products that can be consumed at the same time and are "convenience products" are related is far too broad of an analysis upon which to determine consumer perception. The facts of this case are distinguished from *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984), where bread and cheese were considered complementary inasmuch as they are often used in combination. While drinking water may be consumed at the same time a heated frozen food entree is eaten, it is not used in combination with the entree in the same way bread and cheese are used together to complement each other.

Third-party registrations may have some probative value to the extent that they serve to suggest that the goods listed therein are of the kinds which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). However, all but three of the third-party uses and registrations presented in this record are store brands⁷ and thus are of little probative

⁷ Applicant provided the following testimony regarding "store brands":

Q. And tell us what's meant by store brand or private label.

A. It is a brand which is [sic] a retailer develops to serve primarily three purposes in the business motto. One of them is they - the product provides

value inasmuch as, in addition to drinking water and frozen entrees, they include a wide variety of goods, including, for example, marshmallows, minced garlic, lemon juice, rubber household gloves, baby shampoo, coffee filters, push pins, canned seafood and carbonated soft drinks. See, e.g., Tr. Ex. Nos. 189, 20, and 19. These uses and registrations cover a broad array of goods, many of which are wholly unrelated, and, therefore, no conclusion can be drawn as to the relationship between the goods in issue in this case. See *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n. 6 (TTAB 1988) ("two of the four registrations which were based on use were issued to Saks & Company and to Knott's Berry Farm, owners of a large department store and an amusement or theme center, respectively, where a wide variety of goods and services are sold"). As argued by applicant "[b]ecause nearly every type of product sold in modern grocery stores has a store brand alternative available for purchase" giving such evidence probative value would in effect create "a per se rule that all goods

better profitability than the national brand does. That's one of them. The second one would be unique items that are proprietary to a particular retailer, provide loyalty because you can only get it at that store. And then kind of the third leg of the stool would be that it allows you to have a retail that is lower than the national brand or lower than someone you compete with who doesn't have that item.

Q. Is that often called value pricing?

A. In the tier for - in the tier of products that's designed to be lower retail, that's - value pricing is a good way to describe it.

available in modern supermarkets are related." Br. p. 16. While opposer and applicant are both retail stores and there are examples in the record of their own store brands used on a variety of goods, including frozen food and drinking water, this does not transform the probative value of the third-party uses or alter our analysis; we must determine if consumers would believe that goods as diverse as drinking water and frozen food entrees would emanate from a single source. We further note that the record shows that store brands are sold only in the brand owner's stores or affiliated stores. Opposer's registration and the subject application, however, are not so limited and are more in the nature of a "national brand," a brand sold in unaffiliated stores, thus the third-party uses and registrations of store brands do not serve to resolve the question of whether consumers would believe that a purveyor of drinking water also sells frozen food entrees.

As to the three examples of national brands, two do not show use on frozen entrees (Dannon for drinking water and yogurt and ODWALLA for drinking water and snack bars) and the third, NESTLE, is of little probative value inasmuch as, while NESTLE is used as the primary mark on the drinking water, the use of NESTLE on the frozen entree is secondary, appearing on the side of the packaging with the primary mark

Kailing Dep. pp. 13-14.

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STOUFFER'S displayed prominently on the front. In fact, opposer's corporate representative Kurt Schumacher testified that he was not aware of any national brand that is used on both frozen entrees and bottled water. Schumacher Dep. pp. 62-63.

As to opposer's zone of expansion argument, the doctrine of natural expansion was clearly set out in *Mason Engineering and Design Corporation v. Mateson Chemical Corporation*, 225 USPQ 956, 962 (TTAB 1985), as follows (footnotes omitted):

Under the doctrine of natural expansion, the first user of a mark in connection with particular goods or services possesses superior rights in the mark not only as against subsequent users of the same or similar mark for the same or similar goods or services, but also as against subsequent users of the same or similar mark for any goods or services which purchasers might reasonably expect to emanate from it in the normal expansion of its business under the mark. See the *May Department Stores Co. v. Prince*, 200 USPQ 803 (TTAB 1978). This is so whether or not the first user of the mark has actually expanded its use of its mark, after the commencement of the subsequent user's use, to goods or services which are the same as or closely related to those of the subsequent user. See *Sheller-Glob Co. v. Scott Paper Co.*, 204 USPQ 329 (TTAB 1979). The application of the doctrine is strictly limited to those cases where the expansion, whether actual or potential, is "natural," that is, where the goods or services of the subsequent user on the one hand and the goods or services as to which the first user has prior use, on the other, are of such nature that purchasers would generally expect them to emanate from the same source. See *J. Wiss & Sons Co. v. The W.E. Bassett Co.*, 462 F2d 567, 174 USPQ 331 (CCPA 1972). The reason for the limitation is that the prior user of a mark on particular goods or services cannot extend its use of the mark to

distinctly different goods or services if the result could be a conflict with valuable intervening rights established by another through extensive use and/or registration of the same or similar mark for the same or closely related goods or services in the new sphere of trade.

[citations omitted] Among the factors to be considered in determining whether an expansion, either actual or potential, is natural are: (1) whether the second area of business (that is, the subsequent user's area of business, into which the first user has or potentially may expand) is a distinct departure from the first area of business (of the prior user), thereby requiring a new technology or know-how, or whether it is merely an extension of the technology involved in the first area of business; (2) the nature and purpose of the goods or services in each area; (3) whether the channels of trade and classes of customers for the two areas of business are the same, so that the goodwill established by the prior user in its first area of business would carry over into the second area; and (4) whether other companies have expanded from one area to the other. See *Central Soya Co., Inc. v. North American Plant Breeders*, 212 USPQ 37 (TTAB 1981), and *Porta-Tool, Inc. v. DND Corp.*, 196 USPQ 643 (TTAB 1977). Finally, the determination of whether an expansion is or would be natural must be made on the basis of the circumstances prevailing at the time when the subsequent user first began to do business under its mark, i.e., what was "natural" in the relevant trade at that time. See *Viking Boat Co., Inc. v. Viking Camper Supply, Inc.*, 191 USPQ 297 (TTAB 1976).

Under these guidelines opposer's expansion of its use of another of its marks from ready-to-eat taquitos to frozen taquitos or its use of the QUALITY CLASSIC SELECTION mark on other items (soft drinks, processed nuts, cookies, bathroom tissue, paper napkins and paper towels) does not support a finding that frozen food entrees would be perceived by

consumers as falling within the natural zone of expansion of drinking water.

In view of the above, we cannot say that on this record frozen food entrees are related to or within the natural expansion of drinking water in the consumer's mind.

With regard to the channels of trade and potential purchasers, because the registration and application are not limited we presume these goods travel in all ordinary channels of trade and the record establishes that drinking water and frozen food entrees are found in the same stores, including grocery stores and convenience stores. However, as has long been held, the presence of goods in the same store does not necessarily lead to the conclusion that confusion would arise under such conditions. *Interstate Brands Corp. v. Celestial Seasonings Inc.*, 576 F.2d 926, 198 USPQ 151, 153 (CCPA 1978); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169 (TTAB 1981). As the Court stated in *Federated Foods, Inc. v. Fort Howard Paper Company*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976):

A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. The mere existence of such an environment would not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on any goods so displayed. [citation omitted] The means of distribution and sale, although certainly relevant, are areas of peripheral inquiry. The fundamental inquiry mandated by §2(d) goes to the

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cumulative effect of differences in the essential characteristics of the goods and differences in the marks.

The record shows that frozen foods and drinking water are sometimes sold in close proximity; however, as applicant points out, charcoal and anti-freeze are also sold in close proximity to drinking water and frozen foods in many convenience stores which is simply due to a matter of limited space. Moreover, there is also testimony that unrefrigerated drinking water and frozen foods are positioned separately in grocery stores because water is not a perishable item in contrast to frozen food and does not have to be refrigerated. See Kailing Dep. pp. 49-50. We find that the marketing conditions do not compel a finding of likelihood of confusion given the inherent differences between these goods. In a similar manner, opposer's evidence of drinking water and frozen foods depicted on the same newspaper advertising pages is not compelling given that candy and laundry detergent are also advertised on the same pages.

While the consumers of the parties' respective goods are the same and these are relatively inexpensive ordinary consumer items, which would be purchased with a lesser degree of care, this factor does not outweigh the inherent differences in the goods.

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Finally, applicant argues that there has been no actual confusion, however, the evidence does not show whether the goods here have been sold under the marks in issue in the parties' overlapping territories. Moreover, the parties' respective goods have only been sold in their respective stores. Thus, we find this factor neutral.

After a careful analysis of the relevant du Pont factors we conclude that in view of the disparity in the parties' goods and the relative weakness of the marks, no confusion is likely with the contemporaneous use of these marks on these goods.

Decision: The opposition is dismissed.