

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MAY 19, 0

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Chock Full O' Nuts Corp.
v.
Chock-A-Block, Inc.

Opposition No. 107,742
to application Serial No. 75/196,013
filed on November 12, 1996

Gail E. Nickols of Temko & Temko for Chock Full O' Nuts
Corp.

John R. Garber of Cooper & Dunham LLP for Chock-A-Block,
Inc.

Before Simms, Bottorff and McLeod, Administrative Trademark
Judges.

Opinion by Bottorff, Administrative Trademark Judge:

On November 12, 1996, applicant filed an intent-to-use
application to register the mark depicted below for
"cookies":

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In its Amendment to Allege Use filed on January 28, 1997, applicant alleged use of the mark in commerce since November 1996.

Opposer, in its amended notice of opposition, alleged various grounds of opposition to registration of applicant's mark. First, opposer alleged that applicant's mark is likely to cause confusion vis-à-vis opposer's previously-used and registered mark CHOCK FULL O' NUTS for various food and beverage products, restaurant services, and clothing items, and thus is unregistrable under Trademark Act Section 2(d), 15 U.S.C. §1052(d). Second, opposer alleged that applicant has not used the subject mark in commerce, and that applicant's claim of such use in the application was fraudulent. Third, and in the alternative to its fraud claim, opposer alleged that applicant has abandoned the subject mark by virtue of its nonuse thereof. Applicant has denied those allegations of opposer's which are essential to opposer's pleaded claims.

The evidence of record in this case includes status and title copies of nine registrations which are shown to be extant and owned by opposer;¹ status and title copies of two

¹ The nine registrations owned by opposer are:

Registration No. 632,806, of the mark CHOCK FULL O' NUTS THE HEAVENLY COFFEE (in typed form) for "coffee." Issued August 14, 1956; Section 8 and 15 affidavits accepted and acknowledged; Section 9 renewal for ten years from August 14, 1996.

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additional registrations which are shown to be extant but owned by a third party, i.e., Quikava, Inc., whose

Registration No. 784,094, of the mark CHOCK FULL O' NUTS (stylized), for "cakes, pie and doughnuts." Registered pursuant to Trademark Act Section 2(f). Issued January 26, 1965; Section 8 and 15 affidavits accepted and acknowledged; Section 9 renewal for twenty years from January 26, 1985.

Registration No. 894,796, of the mark CHOCK FULL O' NUTS (in typed form) for "restaurant services." Issued July 14, 1970; Section 8 and 15 affidavits accepted and acknowledged; Section 9 renewal for ten years from July 14, 1990.

Registration No. 1,800,967, of the mark CHOCK FULL O' NUTS (stylized) for "coffee, tea and cocoa." Issued October 26, 1993; Section 8 and 15 affidavits accepted and acknowledged (according to the Office's automated database).

Registration No. 1,968,858, of the mark CHOCK FULL O' NUTS (stylized, with coffee cup design) for "clothing, namely aprons, T-shirts, uniforms and caps," and "restaurant services." Issued April 16, 1996.

Registration No. 1,682,460, of the mark CHOCK O'CCINO for "iced coffee with milk and sugar." Issued April 7, 1992; Section 8 and 15 affidavits accepted and acknowledged.

Registration No. 2,006,514, of the mark CHOCK FULL O' NUTS (in typed form) for "hats, aprons, T-shirts, tops, shorts, scarves, ties and bibs." Issued October 8, 1996.

Registration No. 2,037,521, of the mark CHOCK FULL O' BEANS for "coffee tea and cocoa," and "restaurant services." Issued February 11, 1997.

Registration No. 2,045,731, of the mark CHOCK FULL O' NUTS CAFÉ BLEND (CAFÉ BLEND disclaimed) for "coffee." Issued March 18, 1997.

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relationship to opposer is not apparent from the record;² and applicant's answers to opposer's Interrogatory Nos. 1-23. All of this evidence was submitted by opposer during its testimony period, under notice of reliance. Of the eleven registrations for which opposer submitted status and title copies, only five were specifically pleaded by opposer in the notice of opposition or amended notice of opposition. However, applicant has not objected to our consideration of the six non-pleaded registrations, and we accordingly deem the pleadings to have been amended to include those registrations, pursuant to Fed. R. Civ. P. 15(b). See *Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 USPQ2d 1390, fn. 7 (TTAB 1991).

In its brief, applicant has cited to and relied on certain evidence which applicant had previously submitted in connection with its response to opposer's motion for summary judgment, i.e., the affidavit of its president and various documents including samples of applicant's stationery.

² These two registrations are:

Registration No. 2,021,302, of the mark QUIKAVA SPECIALTY COFFEES BY CHOCK FULL O' NUTS (in stylized form; SPECIALTY COFFEES disclaimed) for "coffee" and "restaurant services." Issued December 3, 1996. The owner of record is Quikava, Inc.

Registration No. 2,195,984 of the mark QUIKAVA COFFEES BY CHOCK FULL O' NUTS (in stylized form; COFFEES disclaimed) for "coffee." Issued October 13, 1998. The owner of record is Quikava, Inc.

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However, applicant failed to properly make this evidence of record during its testimony period, and we accordingly have given it no consideration. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Iodent Chemical Company v. Dart Drug Corporation*, 207 USPQ 602 (TTAB 1980); TBMP §528.05(a).

Opposer and applicant filed main briefs, but opposer did not file a reply brief. No oral hearing was requested.

Initially, it is necessary to determine which of the grounds of opposition pleaded in the amended notice of opposition remain to be decided. In its brief, opposer identified the issues to be decided in this case as (a) likelihood of confusion, and (b) "whether Applicant has essentially abandoned its trademark since no sales have been made since November 1996." (Opposer's Brief, p. 4.) Indeed, throughout its brief, opposer has framed the grounds of opposition at issue in this case as likelihood of confusion and abandonment. See, e.g., opposer's brief at page 4: "Very simply, Applicant has abandoned the CHOCK-A-BLOCK trademark ..."; "Applicant's attempt to rebut its abandonment of CHOCK-A-BLOCK ..."; see also *id.* at page 5: "This almost three years of non-use after token sales and probably promotional in nature, at that, [sic] gives every sign of abandonment."

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In view thereof, opposer is deemed to have waived its alternatively-pleaded claim, asserted at Paragraphs 2-4 of the amended notice of opposition, that applicant committed fraud by including in its application papers an allegation of use of the mark in interstate commerce. Opposer has presented no evidence from which we might conclude that applicant's allegations in connection with its application were made with the requisite fraudulent intent, nor has opposer even argued for that conclusion. Thus, the only grounds of opposition at issue in this case are Section 2(d) priority and likelihood of confusion, and abandonment.³

³ We note that opposer, in Paragraph 3 of the amended notice of opposition, alleged that "applicant has not used the applied for mark in interstate commerce." However, we do not construe this allegation as constituting an additional, separate ground of opposition in this case. It is apparent from the paragraph structure of the amended notice of opposition that the allegation of "nonuse" is part of, and indeed forms the basis of, the fraud claim pleaded by opposer in Paragraphs 2-4 of the amended notice of opposition. That is, opposer essentially alleged that applicant's fraud consisted of applicant's filing of an application (actually, an Amendment to Allege Use) in which applicant falsely claimed use of the mark in interstate commerce since November 1996. Further supporting this construction of the pleading is the fact that, in opposer's motion under Fed. R. Civ. P. 15(a) for leave to file its amended notice of opposition, opposer did not identify "nonuse," per se, as one of the new grounds of opposition opposer was seeking to assert. Rather, at p. 2 of the motion, opposer expressly identified as the new grounds of opposition "that Applicant has abandoned its mark and/or fraudulently alleged commercial use as grounds to obtain a trademark registration."

Moreover, even assuming *arguendo* that opposer intended to assert "nonuse" as a separate ground of opposition, and assuming that this "nonuse" ground was actually tried by the express or implied consent of the parties and that the pleadings accordingly should be amended under Fed. R. Civ. P. 15(b), we would dismiss the ground for lack of proof. Applicant denied the allegation of nonuse in Paragraph 3 of the amended notice of opposition, thereby placing upon opposer the burden of proving at trial that

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We turn first to opposer's Section 2(d) claim. Because opposer has made status and title copies of its pleaded registrations of record, there is no dispute as to opposer's priority. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Our likelihood of confusion determination is based on an analysis of all of the probative facts in evidence pertaining 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).

With respect to the similarity or dissimilarity between the parties' respective goods and services, the established and likely-to-continue trade channels for those goods and

applicant has not used the subject mark in commerce as of the filing date of the Amendment to Allege Use, and/or that applicant's use of the mark in 1996 was not a bona fide commercial use. Opposer argues in its brief that applicant has no invoices or other documents to support applicant's claim of use of the mark in November 1996, but opposer has presented no evidence to support that assertion. We cannot conclude on this record that opposer ever even requested production of such invoices or other documents in discovery. Likewise, applicant's statement, in response to opposer's Interrogatory No. 13, that the amount of its sales under the mark are "unknown" is not evidence that no such sales ever occurred. It does not appear that opposer conducted any additional or follow-up discovery with respect to that interrogatory response; certainly, no evidence pertaining to any such discovery has been made of record.

Indeed, the only evidence of record on the issue of "nonuse" is applicant's uncontroverted assertion, in its answer to opposer's Interrogatory No. 23, that applicant had made a bona fide sale of goods in commerce under its mark in November 1996. In view thereof, and assuming that "nonuse" was actually tried as a ground of opposition which is separate from and independent of opposer's fraud and abandonment grounds, opposer has failed to meet its burden of proof on that ground, and dismissal of that ground would be warranted.

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services, and the classes of customers for those goods and services, we note that applicant's goods are identified in the application simply as "cookies." The identification of goods contains no restrictions or limitations as to the trade channels in which the cookies are sold, or the classes of customers to whom they are sold, and we accordingly presume that the cookies are sold in all normal trade channels and to all normal classes of customers for such goods. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Moreover, despite applicant's argument that its cookies are relatively expensive "niche" or specialty items, we must presume from applicant's identification of goods that its cookies are, like most cookies, relatively inexpensive items which may be purchased on impulse.

The only evidence of record as to opposer's goods and services are the identifications of goods and services in opposer's various registrations, which include coffee, tea and cocoa; cakes, pie and doughnuts; clothing, namely aprons, T-shirts, uniforms, caps, tops, shorts, scarves, ties and bibs; and restaurant and coffee bar services. Opposer's identifications of goods and services are not restricted or limited as to trade channels or classes of customers. Opposer has argued in its brief that it also uses and licenses use of its mark in connection with various

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other products, but has presented no evidence to support that assertion.

Comparing applicant's goods to opposer's various goods and services, we find that applicant's "cookies" are most similar or closely related to the bakery items, i.e., "cakes, pie and doughnuts," identified in opposer's Registration No. 784,094. Opposer has presented no evidence pertaining to the commercial relationship, if any, between applicant's "cookies" and opposer's other various goods and services. Cookies certainly have not been shown by opposer to be related to the various clothing items identified in two of opposer's registrations, nor has opposer established that cookies are particularly commercially related to restaurant and coffee bar services.

Opposer has requested that we take judicial notice that cookies "are often consumed with coffee." (Opposer's brief, page 2.) Applicant has disputed this assertion and has objected to our taking judicial notice thereof. We agree with applicant that this assertion is more properly a matter of proof than a matter of which we may take judicial notice. The complementary relationship between cookies and milk, e.g., would likely be a proper matter for judicial notice, but the purported complementary relationship between cookies and coffee is not necessarily a "generally known" fact which is "not subject to reasonable dispute." See Fed. R. Evid.

201(b). Accordingly, in our discretion, we decline to take the judicial notice requested by opposer. See *United States National Bank of Oregon v. Midwest Savings and Loan Association*, 194 USPQ 233 (TTAB 1977); *Flowline Corporation v. Flo-Line Filters, Inc.*, 150 USPQ 69 (TTAB 1966).⁴

Turning next to the marks, we note that applicant's mark, like opposer's marks, begins with the word "chock," which appears in applicant's mark as part of the unitary expression "chock-a-block" and in opposer's marks as part of the expression "chock full." These two expressions are essentially identical in meaning, denoting "very full; crowded; crammed." See Webster's Third New International Dictionary (1993) at 395.⁵ However, opposer's mark is not

⁴ We hasten to add, however, that even if we had granted opposer's request that we take judicial notice of the existence of a complementary relationship between coffee and cookies, such a finding would not alter the outcome of our decision in this case. For purposes of the second *du Pont* evidentiary factor, i.e., the similarity or dissimilarity of the parties' goods, the similarity between applicant's "cookies" and opposer's "cakes, pie and doughnuts," all of which are bakery goods, is clearly more direct and thus more supportive of opposer's claim than any relationship between cookies and coffee might be.

⁵ The relevant dictionary entries are:

chock *adv*: as close as possible <~ aft> <~ up against the wall>: as nearly or as completely as possible <a wagon ~ full of chunks of wood> - usu. used with another adverb or an adjective

chockablock *adj* [*chock* + *a-* + *block*; fr. the position of a tackle when hoisting has reached its limit, with both blocks touching] **1** : brought close together <the two blocks of a tackle in hoisting or hauling are ~> : fully hoisted : hauled tight **2** : very full : crowded, crammed <exhibition floors were ~ with racing and sports cars - *New Yorker*>

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CHOCK FULL, per se; rather, opposer's marks are the unitary constructions CHOCK FULL O' NUTS, CHOCK FULL O' BEANS, and CHOCK O'CCINO, all of which are completely different from applicant's mark CHOCK-A-BLOCK in terms of appearance, sound, connotation and commercial impression.

Applicant's mark looks completely different from opposer's marks as a result of its use of a highly distinctive design element, i.e., the fanciful depiction of a clown-like face in the center of the mark. In applicant's mark, the face and the wording CHOCK-A-BLOCK together form an inextricably integrated unitary composite, wherein the "A" of CHOCK-A-BLOCK also serves as the nose on the face. None of opposer's marks include a face as a design feature. Applicant's mark also is readily distinguishable from opposer's marks in terms of sound, in that CHOCK-A-BLOCK has a rhythm and rhyme scheme which is not shared by opposer's marks. Likewise in terms of connotation, although CHOCK-A-BLOCK and CHOCK FULL have similar meanings, the parties' marks are dissimilar when viewed in their entireties in that applicant's mark, unlike opposer's marks, includes nothing

chockablock *adv* : in a crowded or overflowing manner
<families living ~>

chock-full or **chockful** *adj* : full to the extreme limit :
crammed <the hotels were *chock-full*>

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that would connote beans, nuts, cappuccino or anything else having to do with coffee.

Thus, we find that the parties' respective marks are not confusingly similar in terms of their overall commercial impressions. This is so, notwithstanding the fact that applicant and opposer appear, on this record, to be the only users of marks which include the word CHOCK. The presence of that word in both marks and the similarity in meaning of the wording of applicant's mark, CHOCK-A-BLOCK, and a portion of the wording of opposer's marks, CHOCK FULL, are the only points of similarity between the parties' respective marks, and we find that those points of similarity are greatly outweighed by the differences between the marks discussed above.

In short, after carefully considering and weighing all of the evidence of record pertaining to the relevant *du Pont* likelihood of confusion factors,⁶ we conclude that applicant's mark does not so resemble opposer's marks that confusion is likely to result from the parties' contemporaneous use of their marks on or in connection with their respective goods and services. Although applicant's

⁶ In this regard, we note that there is absolutely no evidence in the record to support opposer's mere arguments pertaining to certain of the other *du Pont* evidentiary factors, e.g., that opposer uses its marks in the manner of a "family" of marks, that its marks are famous and well-known, or that it uses its mark as a house mark on a wide variety of goods and services other than those identified in its registrations.

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goods are somewhat related to certain of the opposer's goods, and although the parties' respective goods are presumed to be relatively inexpensive items which are marketed in the same trade channels and to the same classes of customers, we find that applicant's mark and opposer's marks are simply too dissimilar for there to be any likelihood of confusion. This dissimilarity of the parties' respective marks, under the first *du Pont* evidentiary factor, outweighs the evidence of record pertaining to the other *du Pont* evidentiary factors which would favor opposer in this case. See *Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). Opposer's Section 2(d) ground of opposition is dismissed.

We turn next to opposer's abandonment claim. Initially, applicant argues that our dismissal of opposer's likelihood of confusion claim deprives opposer of its standing to assert an abandonment claim, inasmuch as opposer now cannot show that it would be damaged by issuance of the registration applicant seeks. However, the case cited by applicant for that proposition, *Foremost Dairies, Inc. v. Foremost Sales Promotions, Inc.*, 158 USPQ 360 (TTAB 1968), is no longer good law on the issue of standing, having been superseded by our reviewing court's decisions in *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2

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USPQ2d 2021 (Fed. Cir. 1987), and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Although we have decided against opposer on its Section 2(d) likelihood of confusion claim, opposer's claim was not wholly without merit. Opposer proved that it has a real commercial interest in its own marks, and a reasonable basis for its *belief* that it would be damaged. No more is required to establish opposer's standing. *Lipton Industries, Inc.*, *supra*, 213 USPQ at 189. Moreover, having established its real interest in the outcome of this proceeding, and thus its standing, opposer is entitled to assert any statutory ground of opposition which would negate applicant's right to registration. *Jewelers Vigilance*, *supra*, 2 USPQ2d at 2023. In short, our dismissal of opposer's likelihood of confusion claim has no effect on its standing to assert its abandonment claim. *See Lipton Industries, Inc.*, *supra*, 213 USPQ at 188.

We turn next to the merits of opposer's abandonment claim. In relevant part, the Trademark Act provides as follows:

Abandonment of mark. A mark shall be deemed to be "abandoned"...:

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for three consecutive years shall be prima facie evidence of abandonment. "Use" of

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a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

Trademark Act Section 45, 15 U.S.C. §1127. The only evidence of record which is pertinent to the issue of abandonment is the file of applicant's application and applicant's answers to opposer's interrogatories.⁷ That evidence reveals the following relevant facts.

Applicant's last bona fide sale of goods under the mark was "late in 1996." (Applicant's answer to Interrogatory No. 23.) We presume, more specifically, that applicant's last use of the mark in commerce was in November 1996, the date identified in the application and in applicant's answer to opposer's Interrogatory No. 6 as the date of first use of the mark, or thereafter.

Approximately one year later, on November 28, 1997, applicant signed its answers to opposer's interrogatories, stating therein (in relevant part): that applicant has not "continued to make sales of its goods under the mark up to the present time" (Interrogatory No. 10); that applicant has no distributors for the goods (Interrogatory No. 11); that applicant's amount of gross sales for 1996 and the first nine months of 1997 is "unknown" (Interrogatory No. 13);

⁷ As discussed supra at pp.4-5, applicant's president's summary judgment affidavit and its stationery samples were not properly made of record during trial, and we accordingly have given them no consideration.

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that applicant has not advertised the mark in the United States (Interrogatory No. 14); that applicant has never licensed use of the mark to anyone (Interrogatory No. 16); that applicant has no listing in the Manhattan telephone directory because "[w]hile Chock-A-Block, Inc. is still an active corporation it is not currently doing any business" (Interrogatory No. 17); that applicant is not currently using the mark (Interrogatory No. 22); and that the date of applicant's last bona fide sale was "late in 1996" (Interrogatory No. 23).

The evidence of record establishes, at most, that applicant had not used the mark between November 1996 and November 28, 1997, the date on which it signed the interrogatory answers upon which opposer relies. That period of nonuse falls far short of three years and thus is insufficient to support a prima facie case of abandonment under the statute. Moreover, there is no basis in the record for us to *infer* that applicant's nonuse of the mark continued beyond November 28, 1997, the date it signed its interrogatory answers, up to November 1999, the third anniversary of its date of last use. See *P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini*, 570 F.2d 328, 196 USPQ 801 (CCPA 1978).

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The burden of proving three consecutive years of nonuse is on the opposer. *P.A.B. Produits, supra*, 196 USPQ at 804-805. Opposer has failed to do so in this case.

Accordingly, opposer is not entitled to rely on or assert the statutory prima facie presumption of abandonment arising from three consecutive years of nonuse of the mark.

Because there is no presumption of abandonment in this case, the burden is on opposer to prove the underlying elements of its abandonment claim, i.e., that applicant's use of the mark has been discontinued, with the intent not to resume use. The evidence of record establishes that applicant has discontinued use of the mark. See, e.g., applicant's answers to Interrogatory Nos. 10, 22 and 23, discussed *supra*. Thus, the first element of opposer's abandonment claim has been proven.

However, we find that opposer has failed to prove the second element of its abandonment claim, i.e., that applicant intends not to resume use of the mark. First, there are no admissions by applicant or other direct evidence of record which establishes that applicant intends not to resume use of the mark. *Distinguish, e.g., Fruit of the Loom Inc. v. Fruit of the Earth Inc.*, 3 USPQ2d 1531 (TTAB 1987)(defendant's testimony expressly demonstrated that discontinuance of use was accompanied by an intent not to resume use).

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Moreover, and contrary to opposer's arguments, we cannot reasonably infer, from the evidence of record concerning the circumstances surrounding applicant's nonuse of the mark, that applicant has no intent to resume use of the mark. The record shows that, as of November 28, 1997, applicant was not currently doing business, had no telephone directory listing, was not selling goods under the mark, had not advertised under the mark, had no distributors for its goods, and had never licensed use of the mark to anyone. However, we cannot reasonably infer from those admissions that applicant has no prospective good faith plans to resume doing business, to obtain a directory listing once business is resumed, to resume use of the mark, to advertise under the mark, to hire distributors for its goods, or to license use of its mark by others. Certainly, the fact that applicant has retained its status as an active New York corporation named Chock-A-Block, Inc. does not support opposer's contention that applicant has no intention to resume use of the mark.

Opposer has argued this case as though the burden were on applicant to rebut a presumption of abandonment by presenting evidence of excusable nonuse or its intent to resume use. However, as noted above, no such presumption is in operation in this case, and the burden accordingly was on opposer to present evidence regarding applicant's plans, or

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absence of plans, for resumption of use of the mark. See, e.g., *Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp.* 6 USPQ2d 1610 (TTAB 1988). Opposer has failed to carry that burden. We simply cannot conclude, on this record, that applicant has no intent to resume use of the mark. In view thereof, opposer's abandonment claim fails.

In summary, opposer has failed to prove its pleaded Section 2(d) and abandonment grounds of opposition.

Decision: The opposition is dismissed.

R. L. Simms

C. M. Bottorff

L. K. McLeod

Administrative Trademark Judges
Trademark Trial and Appeal Board