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Paper No. 9
RFC

2/9/01

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Chelsea Market Baskets, Ltd.

Serial No. 75/601,518

Alan D. Darden of Phelps Dunbar, LLP for Chelsea Market Baskets, Ltd.

Teresa A. Lee, Trademark Examining Attorney, Law Office 111
(Craig Taylor, Managing Attorney).

Before **Cissel**, Walters and Hairston, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 6, 1998, the above-referenced application was filed to register the mark "CHELSEA MARKET BASKETS" on the Principal Register for "mail-order food catalog and retail food store services," in Class 42. The basis for filing the application was applicant's claim that it had used the mark in connection with the specified services in commerce since April 10, 1997.

The Examining Attorney refused registration under Section 2(d) of Lanham Act on the ground that applicant's mark, as used in connection with the services set forth in the application, so resembles the mark "MARKET BASKET," which is registered¹ for "retail grocery services," in Class 42, that confusion is likely. The Examining Attorney also required applicant to disclaim the descriptive term "MARKET BASKETS" apart from the mark as shown because the specimens submitted with the application show that applicant sells food products in market baskets. Additionally, applicant was advised that the proper classification for the services set forth in the application was Class 35.

Applicant did not respond to the refusal to register, but applicant did submit amendments to enter the requested disclaimer and to amend the classification to Class 35.

The Examining Attorney accepted the amendments, but made final the refusal to register under Section 2(d) of the Act. Attached to the final refusal were copies of a number of third-party registrations wherein the services listed include both retail food store services and mail-order catalog services featuring food.

¹ Reg. No. 2,122,759 issued on the Principal Register to M & E Food Mart, Inc. on December 23, 1997.

Applicant timely filed a Notice of Appeal. Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing before the Board.

The sole issue before us in this appeal is whether confusion is likely between applicant's mark, "CHELSEA MARKET BASKETS," as used in connection with mail order food catalogue services, and registrant's mark, "MARKET BASKET," in connection with retail grocery services. After careful consideration of the record and arguments before us in this appeal, we find that the refusal to register under Section 2(d) of the Lanham Act is well taken.

The predecessor of our primary reviewing court set forth the factors to be considered in resolving the issue of likelihood of confusion in *In re E. I duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). We must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression, and then we must compare the services set forth in the application to the services specified in the cited registration to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely if similar marks are used in connection with both. *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

In the case at hand, when it is considered in its entirety, applicant's mark is similar to the cited registered mark. Applicant has essentially appropriated the entire registered mark (although applicant has used the plural form of the word "BASKET") and prefaced it with the name "CHELSEA." The addition of a name or another term to a registered mark is generally insufficient to overcome a likelihood of confusion. *Coca-Cola Bottling Co. v. Joseph Seagram & Sons, Inc.* 526 F.2d 556, 188 USPQ 105 (CCPA 1975). By adding the name "CHELSEA" to the wording "MARKET BASKETS," applicant has failed to meet its burden of selecting a mark that is not likely to cause confusion with a mark which is already registered.

Further, applicant's disclaimer of what is in essence the registered mark does not overcome the refusal to register. As the Examining Attorney points out, it is contrary to the fundamental principles of trademark law to allow an applicant to register a mark which is already registered by simply disclaiming the registered mark and adding another word to it. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applicant's contention that confusion is not likely because the disclaimed portion of its mark is "weak" is not well taken. It is not supported by the record. To the

contrary, "MARKET BASKET" is registered on the Principal Register with no disclaimer or claim of distinctiveness under Section 2(f) of the Act. This hardly constitutes evidence of any "weakness" of the words in source-identifying significance.

In summary on this point, these two marks create similar commercial impressions in connection with the services with which they are used because applicant's mark is essentially the registered mark prefaced by the name "CHELSEA." When marks as similar as these are used in connection with related services, confusion is plainly likely.

Notwithstanding applicant's arguments to the contrary, the services set forth in the application are closely related to those specified in the cited registration. As amended, the application identifies applicant's services as "mail-order food catalogue services." The cited registration lists registrant's services as "retail grocery store services." The third-party registration information made of record by the Examining Attorney shows that other businesses have registered their trademarks for both of these services. This evidence provides us with a basis upon which to conclude that consumers have reason to expect that the use of similar marks in connection with both of

these services relating to the sale of food is an indication that one entity is responsible for both. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993); and In re Mucky Duck Co., 6 USPQ2d 1467 (TTAB 1988). Indeed, the application as originally filed indicated that applicant itself sells food both at retail and by means of mail order catalogues.

Applicant argues that its services are not related to the services specified in the cited registration, contending that registrant provides ordinary food items which are purchased by consumers in a fixed location, whereas applicant provides gift baskets by mail to a higher-end market niche, "providing consumers with an opportunity to purchase luxury items (rather than staple goods) for guests from the convenience of their homes." (Brief, p. 4).

The problem with this argument is that neither the recitation of services in the cited registration nor the recitation in the application is restricted in the ways asserted by applicant. It is well settled that in determining whether confusion is likely, we must base our decision on the way the services are identified in the application and registration, respectively, without limitations or restrictions that are not reflected therein.

Toys "R" Us, Inc. v. Lamps R Us, 219 USPQ 340 (TTAB 1983) and cases cited therein. When we adopt this approach, we cannot restrict or limit the items sold in registrant's retail grocery store, nor can we do so with respect to the products provided by means of applicant's mail order food catalogue services. As identified in the application and registration, respectively, both services could include the sale of ordinary food items as well as food products directed to gourmets or items intended to be used as gifts for others.

Contrary to the arguments presented by applicant, the services, as identified, are not restricted as to purchasers. Both services, as identified, are typically provided to ordinary consumers. Also contrary to applicant's arguments, we have no basis upon which to conclude that the consumers to which applicant's services are directed are more discerning or have any particular level of sophistication that would reduce or eliminate the likelihood of confusion in this case.

In summary, the record before us in this appeal establishes that applicant's mark is similar to the cited registered mark and that the services set forth in the application are commercially related to those specified in

Ser No. 75/601, 518

the registration. Under the circumstances, it is clear that confusion is likely.

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

Ser No. 75/601, 518