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Paper No. 10
EJS

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Reser's Fine Foods, Inc.**

Serial No. 75/621,312

**Burton A. Amernick of Pollock, Vande Sande & Amernick,
R.L.L.P for Reser's Fine Foods, Inc.**

Samuel E. Sharper, Jr., Trademark Examining Attorney, Law
Office 101 (Christopher Wells, Managing Attorney)

Before Seeherman, Quinn and Hairston, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Reser's Fine Foods, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register POTATO EXPRESS as a trademark for "precut and precooked potato products, namely, sliced, diced and chopped precooked potatoes."¹ The word POTATO has been disclaimed. Registration has been refused pursuant to Section 2(d) of

¹ Application Serial No. 75/621,312, filed January 15, 1999, and asserting a bona fide intention to use the mark in commerce.

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the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark POTATOES EXPRESS (with the word POTATOES disclaimed), and previously registered for "dehydrated potatoes,"² as to be likely to cause confusion or mistake or to deceive.

Both applicant and the Examining Attorney filed briefs; an oral hearing was not requested.

In determining whether there is a likelihood of confusion between two marks, we must consider all relevant factors as set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis under Section 2(d), two of the most important considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The marks in this case are virtually identical. They differ only in that applicant's mark uses the singular form of POTATO, while the cited mark contains the plural form. However, this slight difference is not sufficient to distinguish the marks because consumers are not likely to

² Registration No. 1,751,429, issued March 17, 1993; Section 8 affidavit accepted.

note or remember this minor difference. Under actual marketing conditions consumers do not have the luxury to make side-by-side comparison between marks, and instead they must rely on hazy past recollections. **Dassler KG v. Roller Derby Skate Corporation**, 206 USPQ 255 (TTAB 1980). Moreover, given that the products in question are relatively low-cost items, consumers are not going to exercise a great deal of care in examining the marks in order to ascertain whether the word POTATO is shown in singular or plural form.

With respect to the goods, they are both potato products. Applicant points out that there are specific differences between the goods, since the registrant's are dehydrated potatoes while applicant's are "pre-cooked, precut, real potatoes ready for consumption right out of the package." Brief, p. 1. Applicant also asserts that the goods would be packaged differently--registrant's in a cardboard box, while applicant's is intended to be packaged in a clear propylene bag--and because of their nature, they would be sold in different sections of a grocery store--registrant's in the dry grocery section with other shelf-stable boxed products, while applicant's would require refrigeration in order to prevent spoilage.

We have no doubt that applicant is correct when it states that "due to the different nature of the products, consumers seeking one product would not be likely to mistake one product for the other." Brief, p. 1. However, the question we must consider is not whether consumers are likely to confuse the products, but whether they are likely to confuse the source of the products. We find that such confusion is likely. Although there are specific differences in how the potatoes are prepared, and how they are intended to be packaged and sold, they are still potato products which are offered to the general public in the same channels of trade. A consumer is likely to encounter both products in the same grocery store. Although there may be differences in the packaging and the section of the store in which such products are sold, consumers are more likely to attribute these differences to the different nature of the products, e.g., one needing refrigeration and the other not, than to differences in the source of the products.

Some of the third-party registrations made of record by the Examining Attorney show that registrants have registered their marks for different types of potato products. See, e.g., Registration No. 832,620 for frozen and dehydrated potatoes; Registration No. 921,623 for,

inter alia, canned potatoes and dehydrated potatoes. Although these registrations are not evidence that the marks are in use on these goods, or that the public is familiar with them, they do indicate that a party may adopt a particular mark for use on different forms of potatoes. A consumer familiar with a particular mark used on dehydrated potatoes is likely, when seeing the virtually identical mark on pre-cooked, precut refrigerated potatoes, to believe that the producer of the dehydrated potatoes is simply selling its potatoes in a refrigerated form.

Applicant has also argued that the word EXPRESS is "highly diluted as it has been used in numerous marks related to food products." Brief, p. 3. There has been some confusion in the prosecution of this application with respect to third-party marks supporting this position. In its response to the first Office action, applicant made this same argument, and listed what it asserted to be third-party registrations by mark, goods, and registration number. In the next, and final Office action, the Examining Attorney stated that "while the examining attorney acknowledges that numerous registrations for both food services and food products contain the term 'Express,' no other registration of record, other than the cited registration, combine both the terms EXPRESS and a

derivation of POTATO(es).” Later in the Office action, however, the Examining Attorney stated that because applicant had not provided copies of the registrations mentioned in the list, they were not part of the record and were not considered. Applicant apparently recognized that the registrations were not of record because, at the same time it filed its appeal brief, it filed a request for remand “because the examining attorney has stated that the registrations cited in applicant’s response to Office Action are not part of the record and were not considered.” (The request for remand was denied because applicant had provided no reason why it could not have submitted the registrations prior to filing the appeal.)

The Examining Attorney was correct that merely listing third-party registrations is not sufficient to make them of record, and that copies of the registrations must be submitted. However, the Examining Attorney also acknowledged in the Office action that there are numerous registrations for marks containing the word EXPRESS. This acknowledgement, in effect, is a recognition of what the third-party registrations show: EXPRESS is a suggestive term for food products and food services, and this word is not entitled to a broad scope of protection. However, our finding of likelihood of confusion is not based on the

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presence of just the word EXPRESS in both marks; it is based on the fact that the marks consist of the word POTATO in either singular or plural form, followed by the word EXPRESS. Thus, the marks as a whole, compared in their entireties, are virtually identical. The fact that the initial word in each mark is disclaimed does not affect the similarity of the marks as a whole. Although the scope of protection for POTATOES EXPRESS may be limited, we have no doubt that it extends to prevent the registration of the virtually identical mark POTATO EXPRESS for very closely related goods, i.e., goods which are the same product, potatoes, in different forms. We would also point out that applicant's mark is much closer to the cited mark than the third-party EXPRESS marks referred to by applicant are to each other.

Decision: The refusal of registration is affirmed.