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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Oriental Foodbank, Inc.

Serial No. 76/297,947

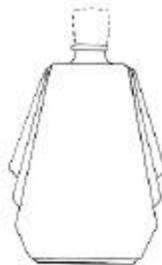
Louis J. Bovasso of Oppenheimer Wolff & Donnelly LLP for
Oriental Foodbank, Inc.

Shaunia P. Wallace, Trademark Examining Attorney, Law
Office 107 (Thomas Lamone, Managing Attorney).

Before Cissel, Chapman and Drost, Administrative Trademark
Judges.

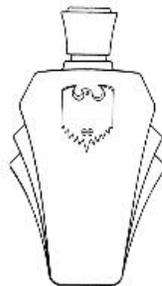
Opinion by Chapman, Administrative Trademark Judge:

An application has been filed by Oriental Foodbank,
Inc. to register on the Principal Register the product
container configuration shown below



as a trademark for "menthol oil" in International Class 5. Such mark is described in the application as follows: "The mark consists of a bottle having a generally trapezoidal shape, the wide side at top and the longer side at bottom, with two tapered portions on opposite sides of the bottle tapering from the top downwardly and outwardly."¹ The application was filed on August 9, 2001, based on applicant's assertion of a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark shown below



which is registered on the Principal Register for "medicated oil for use in relief of bodily aches and pains" in International Class 5, (to Borden Co. (Pte) Ltd., a

¹ Because of sometimes imprecise photocopy capabilities, we note that applicant's mark is depicted in solid black lines except for the bottle cap, which is dotted lines.

Singapore corporation), as to be likely to cause confusion, mistake or deception. The mark is described in the cited registration as follows: "The mark consists of a bottle having a generally elongated hexagonal shape with two steps on each side and an embossed bird design on the face."²

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

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 likelihood of confusion 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 Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §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).

² Registration No. 1,262,191, issued December 27, 1983, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed date of first use in commerce is November 27, 1973. Again because of sometimes imprecise photocopy capabilities, we note that registrant's mark is depicted in all solid black lines.

Turning first to a consideration of the involved goods, applicant's goods are identified as "menthol oil" and registrant's goods are identified as "medicated oil for use in relief of bodily aches and pains." As identified, these goods are essentially the same or at least overlapping in nature. We find the respective goods are closely related. In view of the closely related respective goods, we also find that they are offered in the same or similar channels of trade to the same classes of purchasers (general public). See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). Applicant did not argue to the contrary.

Turning then to a consideration of the marks, inasmuch as the respective marks are product container configurations and hence, like pure design marks, cannot be pronounced, the issue of likelihood of confusion must be decided primarily on the basis of the overall visual similarity of the marks. Cf. *In re ATV Network Ltd.*, 522 F.2d 925, 193 USPQ 331, 332 (CCPA 1977); *In re Burndy Corp.*, 300 F.2d 938, 133 USPQ 196, 197 (CCPA 1962); and *Daimler-Benz AG v. Chrysler Corp.*, 169 USPQ 686, 688 (TTAB 1971). Such an "eyeball analysis" is of course an inherently subjective test. See, e.g., *Daimler-Benz AG v.*

Ford Motor Co., 143 USPQ 453, 456 (TTAB 1964). See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:25 (4th ed. 2000).

But it is still subject to the familiar rule that a side-by-side comparison of the marks is improper. See *Diamond Alkali Co. v. Dundee Cement Co.*, 343 F.2d 781, 145 USPQ 211 (CCPA 1965). Instead, because consumers ordinarily will not be exposed to the respective marks in such a manner, it is the similarity of the general overall commercial impression engendered by the appearance of each of the marks which must determine, due to the fallibility of memory and the consequent lack of perfect recall, whether confusion as to source or sponsorship is likely. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988). The proper emphasis is thus on the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of trademarks or service marks. See *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986); *In re Solar Energy Corp.*, 217 USPQ 743 (TTAB 1983);

and Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980).

Although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Moreover, while product container configuration marks, unlike most other design marks, are three dimensional rather than two dimensional, it is still the case that, for purposes of determining whether there is a likelihood of confusion, it is the perspective views shown by the reproductions of the marks in the application and cited registration which must be considered. See, e.g., *Daimler-Benz AG v. Ford Motor Co.*, supra at 455 (marks used as three-dimensional hood ornaments and/or insignias on automobiles).

In this case, both applicant's and the cited registrant's marks are product container configuration marks, but with the added aspect that registrant's mark also includes a bird design feature.

Applicant argues that, in terms of appearance, there are significant differences between these involved marks. Specifically, the neck and cap are different in each mark; the side flared portion of applicant's mark goes outward from the top down, while that portion of the registrant's mark is a more angled flare and goes from the bottom up; applicant's bottle is somewhat wider at the bottom and angles into a narrower top, while registrant's mark is narrow at the bottom and angles into a wider top; and that the registrant's mark includes a prominent design of a bird. Thus, when encountered in the marketplace, applicant maintains that because these different shapes, with one including a bird design, give consumers different overall visual impressions, there is no likelihood of confusion.

Applicant submitted a photograph of its product as well as a product package and a package insert to illustrate the differences in the overall marks.³

The Examining Attorney contends that the registered design is the reverse of applicant's design, both being

³ The Examining Attorney referred to this material as "applicant's specimen" (brief, unnumbered p. 2). However, for clarity of the record this material was not offered as specimens (and was not supported by applicant's declaration as required by Trademark Rule 2.56 if it had been offered as specimens). The application remains based on applicant's assertion of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act.

tapered bottles with two "steps" on each side (and "if one of the bottles were placed on a shelf upside-down they would look almost identical" (brief, unnumbered p. 2); that "the marks have a unique, yet similar, commercial impression" (Final Office action, p. 2); and that the fallible memories of consumers results in only a general impression or recollection of trademarks. Given the identical nature of the goods, the Examining Attorney argues, these similarities between the marks are sufficient to cause a likelihood of confusion.

Considering the application and registration drawings, we find that the bird design is a distinguishing and memorable part of registrant's mark. That is, we consider the bird design a significant source-identifying difference between the marks, as it would be how the product is described by the purchasing public, and this difference is likely to be recalled by purchasers seeing the marks at separate times. (The Examining Attorney did not address the question of the bird design in registrant's mark.) In comparing applicant's mark with the previously registered mark, in their entirety (taking into account particularly the bird design as well as the specific differences between the two product container configurations), we are of the opinion that the overall commercial impression created by

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applicant's mark, when compared with that of the cited registered mark, is not similar.

Based on this ex parte record, we find that the marks are sufficiently dissimilar that confusion is not likely to result from their use in connection with these involved goods.

Decision: The refusal to register under Section 2(d) is reversed.