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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: December 17, 2003

Cancellation No. 92031423

H.E. BUTT GROCERY COMPANY

v.

INNOVATIVE FOODS L.L.C.

Before Hairston, Bucher and Rogers, Administrative
Trademark Judges.

By the Board:

This case is now before the Board for consideration of respondent's motion (filed July 17, 2003) for summary judgment on the ground that there is no likelihood of confusion between the marks at issue. The motion has been fully briefed.¹

In the petition to cancel, petitioner has pleaded ownership of a registration for the mark HILL COUNTRY FARE;² common law rights in the mark TASTE OF THE HILL

¹ We have considered respondent's reply brief because it clarifies the issues before us. See Trademark Rule 2.127(a).

² Reg. No. 2,623,441; filed November 14, 2000; registered on September 24, 2002; asserts first use of the mark in commerce as of November 1994.

COUNTRY;³ and a likelihood of confusion between its marks and respondent's registered mark TASTE OF THE HILL.⁴ The involved marks are registered or allegedly used (in whole or in part) in connection with "coffee." The issues in dispute in this case are whether respondent has shown that, as a matter of law, it is entitled to a judgment that a likelihood of confusion does not exist; and whether petitioner is entitled to tack its use of the mark HILL COUNTRY FARE onto its later-adopted mark TASTE OF THE HILL COUNTRY.

WHETHER A LIKELIHOOD OF CONFUSION EXISTS WITH RESPECT TO PETITIONER'S REGISTERED MARK "HILL COUNTRY FARE"

As a threshold matter, we address the issue of priority.⁵ Although neither party has directly addressed the question, the issue arises in this case because both petitioner's pleaded mark HILL COUNTRY FARE and respondent's mark TASTE OF THE HILL are registered. As petitioner filed for registration of its mark HILL COUNTRY FARE after respondent obtained its registration

³ Petitioner asserts first use of this mark as of October 1998. *Amended Petition For Cancellation*, paragraph 4.

⁴ Reg. No. 2,091,047; filed July 30, 1996; registered on September 26, 1997; asserts first use of the mark in commerce as of February 21, 1996.

⁵ Priority with respect to petitioner's pleaded unregistered mark, TASTE OF THE HILL COUNTRY, is discussed *infra*.

for the mark TASTE OF THE HILL, petitioner must prove its claim to the earliest first use date.⁶ Thus, a genuine issue of material fact seemingly exists regarding priority. However, a reading of respondent's brief shows that respondent essentially takes the position that irrespective of priority, there can be no likelihood of confusion, and that petitioner's priority of use of the mark HILL COUNTRY FARE can be conceded. We have thus treated petitioner's priority as conceded by respondent for purposes of deciding respondent's motion for summary judgment.

Respondent's central argument that there is no likelihood of confusion is based on the alleged dissimilarity of the marks themselves. Respondent contends that "the dissimilarity [between respondent's mark TASTE OF THE HILL and petitioner's mark HILL COUNTRY FARE] alone is dispositive of the Section 2(d) claim, even where the parties' respective goods apparently

⁶ In a cancellation proceeding where both petitioner and respondent own registrations, the parties start on equal footing and must prove priority, although the introduction of a status and title copy of one party's registration will yield that party priority if it has an earlier filing date and its adversary cannot support an earlier date of first use. See *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1283-84 (TTAB 1998); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1428-29 n. 13 (TTAB 1993); *American Standard Inc. v. AQM Corporation*, 208 USPQ 840, 841 (TTAB 1980).

overlap." *Registrant's Motion For Summary Judgment And Memorandum In Support Thereof*, p. 7.

It is well-established that a single *du Pont*⁷ factor may be dispositive in a likelihood of confusion analysis, and that where the marks are sufficiently dissimilar, there may be no likelihood of confusion despite the presence of overlapping goods and trade channels. See *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998); and *Kellogg Co. v. Pack'em Enterprises*, 951 F.2d 330, 333, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive.")

In comparing petitioner's mark HILL COUNTRY FARE with respondent's mark TASTE OF THE HILL, we note that

⁷ In determining whether there is a likelihood of confusion between marks, there are thirteen evidentiary factors, which the Board must consider when relevant evidence is made of record. See, *E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In this case, the only factors for which evidence is of record are the marks themselves and the goods for which the marks have been registered.

We decline to construe petitioner's assertion that respondent has failed to provide discovery regarding respondent's use of its mark, channels of trade and goods upon which respondent has used its mark as a request to allow petitioner to take additional discovery under Fed. R. Civ. P. 56(f). Further, to the extent petitioner's brief can be construed as including a motion to conduct a survey to determine whether there has been actual confusion, the motion is denied. Petitioner has presented no reason to believe that any such survey would develop evidence of actual confusion.

there is no visual or aural similarity beyond the word "hill" in both marks. The marks in their entireties do not look or sound alike. Addressing the connotations of the marks, petitioner's mark depicts a fanciful "hill country" (as petitioner has asserted), while respondent's mark evokes no such response. The marks are substantially different and this single *du Pont* factor weighs heavily in favor of respondent. Despite the fact that both party's marks are used on "coffee," likelihood of confusion does not arise as a matter of law.

Accordingly, respondent's motion for summary judgment with respect to petitioner's mark HILL COUNTRY FARE is hereby granted.

WHETHER PETITIONER CAN OBTAIN PRIORITY OF ITS MARK "TASTE OF THE HILL COUNTRY" THROUGH TACKING

Petitioner has also pleaded that a likelihood of confusion exists with respect to another of its marks, TASTE OF THE HILL COUNTRY. However, petitioner cannot prevail on this claim unless it can also show priority. There is no dispute that respondent used its mark TASTE OF THE HILL before petitioner used its mark TASTE OF THE HILL COUNTRY. The parties also agree that petitioner used its mark HILL COUNTRY FARE before respondent used

its claimed mark, as we have discussed *supra*. Thus, petitioner seeks to establish its priority by tacking its earlier use of HILL COUNTRY FARE onto its later-adopted mark TASTE OF THE HILL COUNTRY.⁸

A party seeking to "tack" its use of an earlier mark onto its later mark for the same goods may do so only if the earlier and later marks are legal equivalents, or are indistinguishable from one another. "The previously used mark must be the legal equivalent of the mark in question or indistinguishable therefrom, and the consumer should consider both as the same mark. [T]he later mark should not materially differ from or alter the character of the mark attempted to be 'tacked.'" *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159, 17 USPQ2d 1866 (Fed. Cir. 1991). To meet the legal equivalents test, the marks must be indistinguishable from one another or create the same, continuing commercial impression such that the consumer would consider both as the same mark. "[O]ur inquiry must focus on both marks *in their entirety*

⁸ In essence, petitioner is attempting to prevail on the issue of likelihood of confusion by relying on its unregistered mark, which is arguably more similar to respondent's mark than is petitioner's registered mark; and to prevail on the issue of priority by tacking the less-similar registered mark onto the more-similar unregistered mark. While this approach may raise a number of interesting questions, we limit our discussion to the issue of whether tacking is appropriate.

to determine whether each conveys the same commercial impression...." *Van Dyne-Crotty*, at 1160 (emphasis in the original); see also *Pro-Cuts v. Schilz-Price Enterprises, Inc.*, 27 USPQ2d 1224 (TTAB 1993); and *American Paging, Inc. v. American Mobilphone, Inc.*, 13 USPQ2d 2036 (TTAB 1989), aff'd, 17 USPQ2d 1726 (Fed. Cir. 1990).

Our primary reviewing court has instructed that the question whether two marks "constitute legal equivalents is a legal determination...." *Van Dyne-Crotty*, at 1159; see also *In re Dial-a-Mattress Operating Corporation*, 240 F. 3d 1341, 1347, 57 USPQ2d 1806 (Fed. Cir. 2001) ("Whether marks are legal equivalents is a question of law subject to our *de novo* review"). To determine the question, a comparison of the visual or aural appearance of the marks themselves is sufficient, see *Van Dyne-Crotty* at 1159, keeping in mind that "the standard of legal equivalence used in reviewing efforts to 'tack' the prior use of one mark onto that of another is higher than that used in evaluating two competing marks." *Van Dyne-Crotty* at 1159.

Petitioner's marks do not look alike nor do they sound alike. The only element common to each are the words "hill country." Petitioner contends that the mark

TASTE OF THE HILL COUNTRY is simply a modernized version of the mark HILL COUNTRY FARE and that the common element "hill country" "creates and dominates the commercial impression in both the old and the new marks." Thus, petitioner asserts, its two marks create the same, continuing commercial impression, namely, "a sense of farm life" and "an impression of food and beverages that have some relationship to a fanciful 'HILL COUNTRY'." *Petitioner's Brief In Opposition To Registrant's Motion For Summary Judgment*, pp. 2-3.

While it may be considered more contemporary to advertise a fanciful "hill country" by using what is arguably a more modern phrase ("taste of the...") than the earlier term ("fare"), the meaning of the phrase "taste of the hill country" clearly carries with it particular connotations that "hill country fare" does not. *Compare Ilco Corp. v. Ideal Security Hardware Corp.*, 527 F.2d 1221, 188 USPQ 485 (CCPA 1976) (HOME PROTECTION CENTER and HOME PROTECTION HARDWARE conveyed different commercial impressions) and *Humble Oil & Refining Company v. Sekisui Chemical Company Ltd. of Japan*, 165 USPQ 597, 603 (TTAB 1970) (S-LON and ESLON considered legal equivalents on basis of pronunciation and appearance; "The only requirement in these instances is that the mark

be modified in such a fashion as to retain its trademark impact and symbolize a single and continuing commercial impression.") Moreover, petitioner has not cited to any case law that supports its essential argument that similarity of two marks in connotation alone, when they otherwise are clearly different in sight and sound, is sufficient to allow tacking.

Accordingly, petitioner cannot tack its marks because the differences between them are too substantial to support petitioner's claim that they are essentially the same mark. In view thereof, petitioner cannot base its claim of priority, essential to prevailing under Section 2(d) of the Trademark Act, by tacking its mark HILL COUNTRY FARE to its later use of the mark TASTE OF THE HILL COUNTRY. Because petitioner does not have priority of use of TASTE OF THE HILL COUNTRY, vis a vis respondent's mark, its claim under Section 2(d) based on that mark must fail.

SUMMARY

Respondent has shown that there are no genuine issues of material fact regarding the dissimilarity of petitioner's mark HILL COUNTRY FARE and respondent's mark TASTE OF THE HILL and that it is entitled to a judgment

of no likelihood of confusion between these marks. Moreover, we find as a matter of law that petitioner may not tack its two pleaded marks in an attempt to rely on the priority of one of its marks, vis a vis respondent's mark, and the similarity of petitioner's other mark, vis a vis respondent's mark. Accordingly, respondent is entitled to judgment dismissing the petition for cancellation in its entirety.

Respondent's motion for summary judgment is hereby granted and the petition to cancel is hereby denied.

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