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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Northland Organic Foods Corp.

Serial No. 75980413

Jana L. France of Fish & Richardson for applicant.

Christopher S. Adkins, Trademark Examining Attorney, Law Office 101 (Odette Bonnet, Managing Attorney).

Before Seeherman, Quinn and Holtzman, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Northland Organic Foods Corp. to register the mark NORTHLAND ORGANIC FOODS ("ORGANIC FOODS" disclaimed) for services ultimately identified as "transportation by freight, train and truck and storage of seeds and grain."¹

¹ Application Serial No. 75980413, filed February 17, 1999, alleging first use and first use in commerce on June 1, 1998. The application originally included services in International Classes 31 and 35. Pursuant to two divisional requests, the only services remaining in the present application are as set forth above in International Class 39.

The trademark examining attorney refused registration under Section 2(d) on the ground that applicant's mark, when used in connection with applicant's services, so resembles the previously registered mark NORTHLAND EXPRESS TRANSPORT and the mark shown below



both for "freight transportation of goods by truck and freight brokerage services,"² as to be likely to cause confusion. Both registrations are owned by the same entity.

When the refusals were made final, applicant appealed. Applicant and the examining attorney have filed briefs.³ An oral hearing was not requested.

Applicant contends that the marks are not similar because they share only one common element and convey

² Registration Nos. 1,994,991 and 1,976,425, respectively; combined Sections 8 and 15 affidavit filed in both registrations. In each registration, the words "Express Transport" are disclaimed apart from the mark.

³ The examining attorney, in his brief, objected to certain evidence attached to applicant's brief. To the extent that any of applicant's evidence was not previously submitted, this evidence is untimely and, thus, has not been considered. Trademark Rule 2.142(d).

different connotations and commercial impressions; that the term "Northland" is geographically suggestive, and therefore weak and entitled to only a narrow scope of protection; that applicant offers its services to sophisticated purchasers; and that applicant's and registrant's services are offered through different channels of trade and to different classes of purchasers. In urging that the refusal to register be reversed, applicant submitted a dictionary definition of the term "northland"; excerpts retrieved from the NEXIS database showing uses of the term "northland"; thirty-one third-party registrations of marks comprising, in part, the term "NORTHLAND"; and the declaration of applicant's president.

The examining attorney maintains that the dominant portion of applicant's mark is identical to the dominant portion of registrant's marks; that the dominant portion "NORTHLAND" is not a weak term; and that the services are identical and are provided in the same channels of trade.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind

that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We first turn to compare applicant’s services of “transportation by freight, train and truck and storage of seeds and grain” with registrant’s “freight transportation of goods by truck and freight brokerage services.” Although applicant contends that there are distinctions in the trade channels and classes of purchasers, applicant is silent regarding any differences between the services themselves. Indeed, the services are legally identical insofar as freight transportation by truck is listed in the involved application and both cited registrations. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987) [“[T]he question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant’s application vis-à-vis the goods and/or services recited in [the] registration, rather than what the evidence shows the goods and/or services to be.”]. Registrant’s services of transportation of goods by

truck are not limited as to any particular types of freight, so it is broad enough to encompass transportation by truck of seeds and grains. Thus, contrary to applicant's arguments, for purposes of the legal analysis of likelihood of confusion herein, it is presumed that all of these types of services are rendered in the same channels of trade and are purchased by the same classes of purchasers.⁴ In re Elbaum, 211 USPQ 639 (TTAB 1981).

To the extent that it is presumed that the classes of purchasers overlap to a degree, namely, with respect to farmers and food producers, we tend to agree with applicant that these purchasers would be relatively sophisticated and knowledgeable about the market. Further, applicant asserts that its services are expensive and "are typically sold only after much information has been conveyed to the purchaser and usually after a face-to-face meeting between Applicant and the purchaser." Although this factor weighs

⁴ Applicant argues that its original identification of goods accurately reflected the limited trade channels through which applicant operates and the finite classes of purchasers of applicant's services. Essentially, applicant asserts that its services are not offered to ordinary consumers, but rather are offered exclusively to those who have a need for transporting and storing seed and grain, namely, farmers and food producers.

The problem with applicant's argument is that registrant's services are broadly identified in the cited registration. There are no limitations with respect to trade channels or classes of purchasers, so it is presumed that the transportation services are offered to, among others, those who have a need to transport seed and grain.

in applicant's favor, it is outweighed by the similarities between the marks and the legally identical services rendered thereunder.

We next turn to consider the marks, keeping in mind that if the services are legally identical, as they are here, at least in part, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

With respect to a comparison of applicant's typed mark NORTHLAND ORGANIC FOODS with registrant's typed mark NORTHLAND EXPRESS TRANSPORT, we must consider the marks in their entireties. Nevertheless, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.3d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For example, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted

rationale for giving less weight to a portion of a mark...." Id. at 751.

In the case at hand, when comparing the two typed marks, the highly descriptive/generic words "ORGANIC FOODS" and "EXPRESS TRANSPORT," which have been disclaimed, clearly are subordinate to the word "NORTHLAND" in the respective marks.⁵ In each mark, the word "NORTHLAND" is the first portion of the mark, and clearly dominates over the other two words. Further, we agree with the examining attorney that the word "NORTHLAND" would be used to call for the respective services.

⁵ Applicant contends that the words "ORGANIC FOODS" in its mark are not descriptive as used in connection with transportation services, but rather comprise the dominant portion of the mark. Applicant further argues that "extending the disclaimer entered into the "Parent Application" to the present Application is improper and the disclaimer should be given no consideration." According to applicant, the disclaimer applied to the goods identified in the application as originally filed, and the examining attorney did not assert that the words "ORGANIC FOODS" were descriptive of the transportation services which remain in the present application. The applicant concludes that this application "does not rightly contain the disclaimer and the existence of the disclaimer should be given no weight." At the point that a file is divided, the papers that were part of the "Parent" file become part of the "Child" file. If applicant had wished to withdraw its disclaimer after the file was divided, it should have done so. Nevertheless, we also note applicant's statement that it "is in the business of distributing and storing a variety of non-genetically modified organic food commodities" and that it "offers its services to organic food producers interested in organic ingredients." (brief, p. 14). Indeed, applicant is in the business of transporting organic foods and, thus, the words "ORGANIC FOODS" would appear to be descriptive of such services. Whether disclaimed or not, the words "ORGANIC FOODS," as used in connection with applicant's services, are subordinate to the term "NORTHLAND" in applicant's mark.

Thus, inasmuch as the two marks are dominated by the identical word "NORTHLAND," the marks are similar in sound and appearance. Although the descriptive portions of the marks cannot be ignored, "NORTHLAND" clearly stands out.

With respect to connotation, applicant asserts that the marks convey different meanings. Applicant's mark does not refer to transportation services, but rather to products (organic foods) and, according to applicant, its mark "suggests the nature of the goods Applicant transports and stores, but Applicant's mark certainly does not emphasize or hone in on the fact that Applicant offers transportation and storage services." Applicant states that "[u]nlike the cited marks, Applicant's mark does not impart in consumers' minds that 'we offer express transportation services' message." (brief, p. 8). To the extent that different meanings are conveyed by the marks, it is only because of the highly descriptive/generic portions thereof. On the other hand, the common element, "NORTHLAND," would convey the same idea, namely, that the services are rendered in or come from the northern part of the country. In any event, we find that any difference in connotation is outweighed by the similarities in sound and appearance.

Applicant contends that the only shared component of the marks is the geographically suggestive term "northland" and that registrant's marks are entitled to only a narrow scope of protection. In this connection, applicant asserts that "northland" is a common word in the English language meaning "land in the north" or "the north of a country." Merriam-Webster's Collegiate Dictionary (10th ed. 1998). Applicant also submitted excerpts retrieved from the NEXIS database showing uses of "northland" as a geographical term. Applicant points out that it is located in Minnesota and registrant is located in Michigan, so that the "NORTHLAND" component in the marks is intended to evoke the geographic regions in which these entities are located. Applicant also points to the third-party registrations it submitted. The thirty-one registrations show marks which include, in whole or in part, the term "NORTHLAND."

Applicant's evidence and arguments based thereon do not persuade us to make a contrary finding as to the similarity of the marks. Although the term "northland" may have some geographical meaning, it is only slightly suggestive when used in connection with the involved services. Further, the third-party registration evidence does not convince us that the term is, in applicant's characterization, "weak." At most, the evidence only tends

to confirm the suggestiveness of the term "northland," the meaning of which is already established by the dictionary definition of the term. The registrations relied upon by applicant cover a wide range of goods and services, some far removed from the transportation services involved herein. In point of fact, not a single registration covers the service of freight transportation of goods by truck. Purchasers familiar with registrant's transportation of goods by truck under the mark NORTHLAND EXPRESS TRANSPORT, upon seeing applicant's mark for the same type of services, are likely to believe that registrant is concentrating its services on the transportation of organic foods.

We next turn to compare applicant's mark with registrant's logo mark. When it comes to registrant's logo mark, the issue of likelihood of confusion is not as clear. The "N" design is clearly a prominent feature of registrant's mark. However, as often stated, when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). Here, the words "NORTHLAND EXPRESS TRANSPORT" would be the way in which customers would refer to and call for registrant's services, and therefore these words are likely

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to be noted and remembered. Because, as stated previously, when marks are used on legally identical services, the degree of similarity between them necessary to support a conclusion of likely confusion declines, the similarities between applicant's mark and the cited design mark are sufficient to support a finding of likelihood of confusion. See, e.g., *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997).

We conclude that purchasers familiar with registrant's freight transportation of goods by truck rendered under the NORTHLAND EXPRESS TRANSPORT marks would be likely to believe, upon encountering applicant's mark NORTHLAND ORGANIC FOODS for transportation by freight, train and truck and storage of seeds and grains, that the services originate with or are somehow associated with or sponsored by the same entity.

To the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decisions: The refusals to register are affirmed.