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This Opinion is Not Citable as Precedent of the TTAB

File Entry:
No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Aurora Foods, Inc.
v.
J.S.B. Industries, Inc.

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Opposition No. 91118729
to application Serial No. 75683081
filed on April 14, 1999

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Michael R. Annis, Robert J. Lewis and Eric G. Enlow of Blackwell Sanders Peper Martin LLP for Aurora Foods, Inc.

George E. Kersey, Esq. for J.S.B. Industries, Inc.

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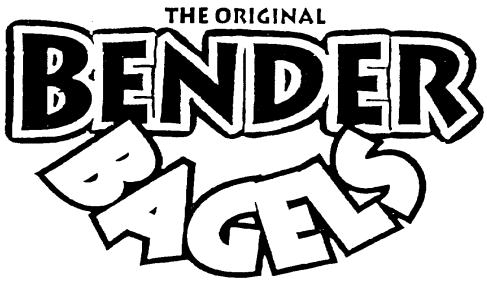
Before Hanak, Chapman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

J.S.B. Industries, Inc. (applicant) has applied to register the mark shown below for goods identified as "bakery products," in International Class 30.



The application is based on applicant's statement of its bona fide intention to use the mark in commerce for the identified goods. Applicant has entered a disclaimer of exclusive rights to use of the words "THE ORIGINAL" and "BAGELS."

Aurora Foods, Inc. (opposer) has opposed registration of applicant's mark, essentially asserting that it has used LENDER'S as a trade name and trademark in interstate commerce "since 1927," and continues to so use the designation; that it is the owner of three valid and subsisting registrations of, respectively, LENDER'S, LENDER'S BAGELS and LENDER'S SOFT BAGELS, all for "bagels"; that it is also the owner of valid and subsisting registrations for LENDER'S NEW YORK STYLE BAGELS and for LENDER'S, both for "bagels."[1] Opposer also asserts that it believes that its goods and those of applicant travel in the same channels of trade to the same classes of purchasers; that applicant's mark is "confusingly similar in appearance, meaning, and trade dress to Opposer's marks"; and that any eventual use by applicant of its mark will lead to confusion or mistake among consumers, or that they will be deceived

[1] We note that the first of the two registrations for LENDER'S alone is in typed form and was registered on the Principal Register under Section 2(f) of the Trademark Act, while the second of the two LENDER'S marks is in stylized form and was registered on the Supplemental Register. We discuss the status of the various registrations, infra.

and misled into concluding that there is a relationship between opposer and applicant. Finally, opposer asserts that its marks are famous and applicant's use and registration of the applied-for mark would dilute the value of opposer's marks.

Applicant expressly or effectively denied almost all allegations of the notice of opposition. It did, however, admit that the LENDER'S registration on the Principal Register, Registration No. 1,172,496 is "valid, subsisting and incontestable" (though it denied opposer's ownership of that registration); and it admitted that it seeks to register the mark shown in its involved application.

At trial, opposer filed a notice of reliance on four of its five pleaded registrations.[2] When a registration is properly made of record by notice of reliance, but the status of the registration changes between the time it was made of record and the time the case is decided, the Board will take judicial notice of the current status of the registration. See TBMP Section 704.03(b)(1)(a) (2d ed. June 2003) and authorities cited therein. Accordingly, we note that two of the four registrations, Registration No. 932,754 for LENDER'S (in stylized lettering) and Registration No.

[2] According to Office records, the fifth, Registration No. 1,823,029 for LENDER'S NEW YORK STYLE BAGELS, was cancelled shortly before the notice of reliance was filed, for opposer's failure to file the necessary affidavit or declaration under Section 8 of the Trademark Act, 15 U.S.C. § 1058.

1,661,865 for LENDER'S SOFT BAGELS (in a label design), have not been renewed by opposer and are now expired. As a result, only two of opposer's five pleaded registrations remain at issue in this case: Registration No. 1,172,496 for the mark LENDER'S in typed form, and Registration No. 1,531,083 for LENDER'S BAGELS and a bag design (with BAGELS disclaimed), as illustrated below.

By its notice of reliance, opposer has proven that these two pleaded registrations are subsisting and owned by opposer.[3] Therefore, we find that opposer has established its standing to oppose. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Also, Section 2(d) priority is not in issue as to the goods identified in opposer’s registrations, i.e.,

[3] We note, too, that the testimony of opposer's witness and employee Donald Hayes, the vice-president and general manager for opposer of Lender's Bagels, establishes opposer's acquisition of the registrations and current use of the registered marks. Coupled with applicant's admission in its answer that Registration No. 1,172,496 for the mark LENDER'S in typed form is valid and subsisting, the status and title of that registration has been established independent of opposer's notice of reliance.

bagels. *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

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). In considering any evidence of record bearing on these factors, we are guided by the principle 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).

In regard to the goods identified in applicant's application and in opposer's two registration(s), we note that each of opposer's registrations covers one item, "bagels"; that this is an item within the scope of the broader identification listed in applicant's application ("bakery products"); and that applicant, on page one of its brief, essentially concedes that its intention is to use the applied for mark for bagels ("[applicant] has sought registration for bagels under the Stylized Mark 'The Original Bender Bagels'").

As for the parties' target classes of consumers and channels of trade, there are no restrictions or limitations

in the identifications and, therefore, we must presume that the identified goods move in all customary channels of trade to all potential consumers for such items. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Specifically, we conclude that both parties could market their bagels to wholesalers or retailers, through grocery stores, convenience stores, and any other venue that typically would sell bagels. The classes of prospective purchasers for each would include the general public. As opposer correctly observes, when marks will be used on identical goods and will presumptively travel in the same channels of trade and be marketed to the same classes of consumers, the involved marks need not be as similar, to support a finding of likelihood of confusion, as they would have to be if the products and/or channels of trade and classes of consumers were different. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Turning to the similarity of the marks, we note again that opposer's Registration No. 1,172,496 covers the mark LENDER'S in typed form. Accordingly, because opposer is free to change the typeface of its mark, we must consider that it could appear in the same or similar typeface as that employed by applicant, and may be used at any time without

any design elements that might otherwise serve to distinguish opposer's mark from applicant's mark. *See INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992), *citing Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). In addition, numerous exhibits to the Hayes testimony show that opposer uses LENDER'S in conjunction with the generic term for its goods, i.e., bagels.

It is a well established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, while the marks are compared in their entireties, including descriptive or disclaimed portions thereof, "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 the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.,* 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also, Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000), and Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983).* In this case, the words THE ORIGINAL in applicant's mark are overwhelmed by the larger words BENDER BAGELS. Moreover, the words THE ORIGINAL are laudatory and have been disclaimed, as has the word BAGELS, which is

generic for bagels. *In re Ervin*, 1 USPQ2d 1665 (TTAB 1986) (THE "ORIGINAL" held laudatory for game equipment and refused registration). Accordingly, the dominant and source-indicating portion of applicant's mark clearly is BENDER; and our comparison of opposer's LENDER'S mark and applicant's mark necessarily focuses on the similarity of LENDER'S and BENDER.

These two terms sound alike and, because opposer is free to display this typed mark in the same or a similar font as that employed by applicant, we must consider that they could look alike in actual use. We do not find the possessive form of opposer's mark to be a significant difference between it and applicant's mark. *Georgia-Southern Oil Inc. v. Richardson*, 16 USPQ2d 1723, 1725 (TTAB 1990) ("As to likelihood of confusion, we have no problem concluding that confusion would be likely to occur if the parties were to use their respective marks to identify their respective services in the same geographic area. The marks are virtually identical, differing by only a possessive letter "s" in user's mark.").

Turning to a comparison of opposer's mark LENDER'S BAGEL and a bag design with applicant's mark. Again, we note that the words THE ORIGINAL in applicant's mark are so small and laudatory as to be overlooked by many consumers. While applicant's terms BENDER and BAGELS would be,

according to the drawing of the mark, set forth in contrasting colors or in a contrasting black and white display, while the registration for opposer's mark LENDER'S BAGELS and bag design does not show any contrast between LENDER'S and BAGELS. Nonetheless, the record reveals that opposer actually uses its LENDER'S BAGELS mark with contrasting colors for each of those two words, a form of use we find encompassed by its registration, which does not claim that the words are limited to any particular color. See Hayes exh. 35. In addition, both marks set forth the words in outline form. Overall, while we find visual differences between opposer's LENDER'S BAGELS mark and applicant's mark, there also are similarities. More importantly, LENDER'S BAGELS and BENDER BAGELS sound very similar.

As to the connotations of the involved marks of opposer and applicant, they each have the connotation of the name of a bagel baker. This is so notwithstanding that applicant does not use the possessive form BENDER'S.[4]

In assessing the involved marks, we have been careful to keep in mind the normal fallibility of human memory and the fact that consumers retain a general, rather than a

[4] We take judicial notice that "bender" is defined as "a person or thing that bends, as a pair of pliers" and as "*U.S. slang.* a drinking spree." The Random House College Dictionary 125 (rev. ed. 1982). We do not believe it likely that consumers of bagels would ascribe either connotation to applicant's goods.

specific, impression of trademarks/service marks encountered in the marketplace. *See Sakrete, Inc. v. Slag Processors, Inc.*, 305 F.2d 482, 134 USPQ 245, 247 (CCPA 1962).

In sum, we find the involved marks are sufficiently similar in sight, sound and connotation that confusion is likely, given contemporary use of the marks on bagels.

Other significant factors in this case are the fame of opposer's marks and the low cost of the involved items, such that they may be purchased without a great deal of thought or deliberation by any member of the general public.

As to the fame of opposer's marks, applicant has essentially acknowledged the sufficiency of opposer's evidence and we need not recite it. See applicant's brief, pages 6-7. Applicant, however, argues that any fame attributable to opposer's marks by virtue of its very significant sales, advertising and superior market share, can be given considerable weight only if it is first determined that the involved marks are confusingly similar. To be sure, there can be no likelihood of confusion when a famous mark and one with which it is compared are entirely dissimilar. However, applicant misapprehends the import of the law on fame as a *du Pont* factor. *See Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) ("Thus, the Lanham Act's tolerance for similarity between competing marks varies

inversely with the fame of the prior mark. As a mark's fame increases, the Act's tolerance for similarities in competing marks falls."). For reasons we have outlined, the marks involved in this case are very similar in sound, appearance and connotation. Further they are or will be used on identical goods. Under these circumstances the additional fact that opposer's marks are famous heavily tilts the balancing of the *du Pont* factors in opposer's favor.[5]

We add that even if opposer's marks were not famous, the similarities of the involved marks and use on identical goods would give rise to a likelihood of confusion, given the low cost of the goods and the fact that they would be purchased by members of the general public in routine shopping in grocery stores, convenience stores and the like. *Kenner Parker*, 22 USPQ2d at 1458; see *also, Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669 223 USPQ 1281, 1285 (Fed. Cir. 1984), *quoting from Planters Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 924-25, 134 USPQ 504, 511 (CCPA 1962) ("The law has clearly been well settled for a longer time than this court has been dealing with the problem to the effect that the field from

[5] Applicant also argues that the unusual degree of brand recognition of opposer's marks, brief, p. 7, means consumers could not be confused by applicant's mark. Again, applicant misapprehends the law, which holds that consumers that have been exposed to a famous mark may actually exercise less care in making their purchases. *Kenner Parker*, 22 USPQ2d at 1456.

which trademarks can be selected is unlimited, that there is therefore no excuse for even approaching the well-known trademark of a competitor, that to do so raises 'but one inference - that of gaining advantage from the wide reputation established by appellant in the goods bearing its mark,' and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous and applied to an inexpensive product bought by all kinds of people without much care.")

Decision: The opposition is sustained and registration to applicant is refused.