

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
August 24, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

St. Nicholas Music Inc.
v.
Lolly-Jolly, Inc.

Opposition No. 91155371
to application Serial No. 76222927
filed on March 12, 2001

Michael Chiappetta of Fross Zelnick Lehrman & Zissu for St.
Nicholas Music Inc.

Edgar W. Averill, Jr. of Averill & Varn for Lolly-Jolly,
Inc.

Before Walters, Grendel and Kuhlke, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Lolly-Jolly, Inc., seeks registration of the
mark LOLLY-JOLLY (standard character form) for goods
identified in the application as "candy" in International
Class 30.¹

¹ Serial No. 76222927, filed March 12, 2001. The application is
a use based application under Trademark Act Section 1(a), 15
U.S.C. §1051(a) and alleges a first use date of January, 2000.

Opposition No. 91155371

Opposer, St. Nicholas Music Inc., opposed registration of applicant's mark, on the grounds that, as applied to applicant's goods, the mark so resembles opposer's previously used and registered mark HOLLY JOLLY² for a wide variety of goods and services, including fruit-based snacks, as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d).³

Applicant filed an answer by which it denied the salient allegations of the notice of opposition.⁴

The evidence of record includes the pleadings herein, the file of the opposed application and the declaration of Emily Dowdall, with accompanying exhibits submitted by opposer, to which applicant stipulated its consent, pursuant to Trademark Rule 2.123(b). In addition, opposer submitted, under a notice of reliance and pursuant to applicant's stipulation of admissibility and authenticity of evidence, applicant's responses to opposer's first set of

² Opposer pleaded two registrations, Registration Nos. 2282905 and 26131194.

³ The notice of opposition also includes a claim of dilution under Trademark Act Section 43(c). However, this claim was not pursued in opposer's brief and was essentially withdrawn in its reply brief. In view thereof, the Board considers the dilution claim to have been deleted from the opposition.

⁴ We note applicant's reference in its brief to a petition to cancel opposer's pleaded Registration No. 22282905. This cancellation proceeding, Cancellation No. 92043127, was dismissed based on a motion filed under Fed. R. Civ. P. 12(b)(6), and, therefore, has no bearing on this proceeding.

Opposition No. 91155371

interrogatories and requests for admission, opposer's copyright registration for the song "A Holly Jolly Christmas," printouts from the USPTO TESS database of several third-party registrations, various documents produced by applicant including photographic representations of applicant's packaging, advertising and product catalogues, photographic representations of packaging used by opposer's predecessor in interest, and status and title copies of opposer's pleaded registrations.⁵ The pleaded registrations, both of which are in full force and effect and owned by opposer St. Nicholas Music Inc.,⁶ are summarized as follows:

- Registration No. 2282905, which is of the mark HOLLY JOLLY (in typeset form) for "fruit-based snacks" in International Class 29 filed April 10, 1998, issued on October 5, 1999;

- Registration No. 2613194, which is of the mark HOLLY JOLLY (in typeset form) for "song books" in International Class 16, for "plush dolls, musical toys" in International Class 28, and "entertainment, namely, production of musical projects" in International Class 41, filed on February 24, 1999 issued on August 27, 2002.

⁵ Applicant did not take any testimony or submit any evidence.

⁶ The Board notes that opposer also submitted status and title copies of Registration Nos. 2767167 and 2806762. However, these registrations were not pleaded in the notice of opposition nor does the record support a finding that likelihood of confusion as to these two registrations was tried by the implied or express consent of the parties. We therefore have given no consideration to these unpleaded registrations.

Opposition No. 91155371

Because opposer has made its two pleaded registrations of record, and because its likelihood of confusion claim is not frivolous, we find that opposer has established its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Additionally, because opposer has made its two pleaded registrations of record, priority is not an issue in this proceeding. 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 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 Co., 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). Moreover the goods need not be identical or directly competitive in order for there to be a likelihood of confusion. Rather, the

Opposition No. 91155371

respective goods need only be related in some manner or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

We turn to the first *du Pont* factor, i.e., whether applicant's mark and opposer's mark are similar or dissimilar when compared in their entirety in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, 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

Opposition No. 91155371

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).

The parties' marks are depicted in standard character form. The marks are substantially similar visually, differing by one letter, the first letter in the first word of each two-word mark. The marks also sound substantially similar because they both consist of two rhyming words with the word JOLLY in the second position. The marks have the same rhyme and cadence. The connotations of the two marks differ only to the extent that the meaning of the first word in applicant's mark, LOLLY,⁷ differs from the meaning of the first word in opposer's mark, HOLLY.⁸ As used in each mark, the connotation of JOLLY is likely to be the same and applicant has not argued otherwise.

Further, we find the overall commercial impressions of the two marks are substantially similar because the

⁷ We take judicial notice of the following definition: Lolly: chiefly British, 1. a. A piece of candy especially hard candy. b. lollipop. The American Heritage® Dictionary of the English Language, (4th ed. 2000). *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). From this definition it is clear that LOLLY is, at a minimum, highly suggestive of a type of candy.

⁸ We take judicial notice of the following definition: Holly: 1. a. Any of numerous trees or shrubs of the genus *Ilex*, usually having bright red berries and glossy evergreen leaves with spiny margins. b. Branches of these plants, traditionally used for Christmas decoration. The American Heritage® Dictionary of the English Language, (4th ed. 2000).

Opposition No. 91155371

difference in meaning of the first word in the parties' marks is overshadowed by the visual and phonetic similarities, particularly the similar rhyming qualities of two words within each of the respective marks. We find, on balance, that the similarities in appearance, sound and commercial impression of the respective marks outweighs the dissimilarity which results from the different first letter and, thus, first word in each mark. We conclude that the parties' marks are substantially similar.

In cases such as this, where the applicant's mark is so similar to the mark in the cited registration, the degree of relationship between the goods and services that is required to support a finding of likelihood of confusion is less than it would be if the marks were not so similar. *In re Concordia International Forwarding Corp.*, 222 USPQ 352 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Turning, now, to consider the goods and services, we find that "candy," as identified in applicant's application, is related to "fruit-based snacks," as identified in opposer's Registration No. 2282905. As shown by applicant's packaging and catalogues its candies include fruit-flavored jelly lollipops which could be considered to be a fruit-based snack. The packaging of opposer's fruit-based snack sold under the HOLLY JOLLY mark depicts little gummy-type

Opposition No. 91155371

pieces that look similar to candy. In addition, several USPTO TESS printouts of third-party registrations submitted by opposer include candy or gummy products and fruit-based snacks or fruit snacks. While these third-party registrations are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, they may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source. See *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n. 6 (TTAB 1988). Given the absence of any restrictions or limitations in the parties' respective identifications of goods, we also find that the parties' respective goods, candy and fruit-based snacks, would be marketed in the same trade channels and to the same classes of purchasers. We also find that the parties' respective goods, candy and fruit-based snacks, are ordinary consumer items which would be purchased without a great deal of care, by ordinary consumers. These findings under the second, third and fourth *du Pont* factors all weigh significantly in opposer's favor in our likelihood of confusion analysis.

With regard to the goods and services identified in opposer's other pleaded registration, Registration No. 2613194, we find that the record does not establish that

Opposition No. 91155371

such goods and services are sufficiently similar or related to applicant's identified goods that, if used on or in connection with confusingly similar marks, confusion as to source is likely. There is no evidence of record regarding any possible relationship between applicant's candy and opposer's song books or musical project production services. Although opposer did submit USPTO TESS printouts of third-party registrations that include both candy and toys, and a handful of printouts of third-party internet websites marketing both candy and toys, several of these examples include a wide variety of goods (e.g., Knott's, Atlantis the Lost Empire) and, as such, are of limited probative value as regards candy and toys specifically.⁹

With regard to applicant's argument that there is no evidence of actual confusion, it is not clear from the record if there has been any meaningful opportunity for actual confusion to occur, i.e., the extent to which the parties' sales have overlapped. Moreover, a lack of evidence of actual confusion does not mean that there is no likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed.

⁹ Evidence of opposer's copyright in, and the fame of, the song titled "A Holly Jolly Christmas" is of little probative value in determining likelihood of confusion in this case. Opposer has not established any trademark rights in the title of the song or a link between the song and any derivative fame from the song and opposer's HOLLY JOLLY trademark for the identified goods and services.

Opposition No. 91155371

Cir. 1983); *J&J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991).

Finally, we note opposer's argument regarding applicant's possible intent in adopting the mark. To the extent opposer is arguing that applicant acted in bad faith, applicant's prior knowledge of the existence of opposer's marks is not, in itself, sufficient to constitute bad faith. See *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307 (Fed. Cir. 1989). Establishing bad faith requires a showing that applicant intentionally sought to trade on opposer's good will or reputation. See *Big Blue Products Inc. v. International Business Machines Corp.*, 19 USPQ2d 1072 (TTAB 1991). There has been no such showing made in this case.

We conclude that the evidence of record as it pertains to the relevant *du Pont* factors clearly supports a finding of likelihood of confusion as to opposer's Registration No. 2282905 only, and that registration of applicant's mark, therefore, is barred under Trademark Act Section 2(d). While we do not find a likelihood of confusion with respect to opposer's Registration No. 2613194, such a determination is not necessary in this case.

Decision: The opposition is sustained.