

Hearing:
February 17, 1999

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BAC

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 9/10/99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

My Own Meals, Inc.

v.

My Own Mail, Inc.

Opposition No. 106,022
to application Serial No. 75/112,617
filed on May 31, 1996

John A. Franczyk of Butler, Rubin, Saltarelli & Boyd for My Own Meals, Inc.

Steven G. Mahon of Ryan Mahon & Brown P.A. for My Own Mail, Inc.

Before Cissel, Quinn and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

An intent-to-use application was filed by My Own Mail, Inc. on May 31, 1996 to register the mark MY OWN MAIL on the Principal Register for services described as "mail order services featuring children's merchandise and children's gift packages."

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My Own Meals, Inc. has opposed registration of the mark alleging that opposer has continuously used the mark MY OWN MEAL since April 2, 1987; that opposer currently uses the mark on "shelf-stable, prepackaged, prepared children's meals and adult meals" (Notice of Opposition, paragraph 3); that since 1987 opposer has sold its products through retail grocery stores and by mail order directly to consumers; that the target market for opposer's goods and applicant's services, is the same, "namely consumers of children's products" (Notice of Opposition, paragraph 5); and that applicant's mark, if used in connection with its services, would so resemble opposer's previously used and registered well-known trademark MY OWN MEAL¹, as to be likely to cause confusion, mistake, or deception.

Applicant denied the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of the opposed application; the testimony, with exhibits, of Mary Anne Jackson, opposer's president and founder (taken February 10, 1998 by opposer and April 2, 1998 by

¹ Opposer pleaded ownership of two registrations, both for the mark, MY OWN MEAL. Reg. No. 1,470,809, issued December 29, 1987, Section 8 affidavit accepted, Section 15 affidavit acknowledged, for "prepackaged prepared meals, namely, meat and vegetable entrees." The claimed dates of first use and first use in commerce are April 2, 1987.

Reg. No. 1,548,528, issued July 18, 1989, Section 8 affidavit accepted, Section 15 affidavit acknowledged, for "prepackaged, prepared pasta dinners." The claimed date of first use and first use in commerce is January 9, 1988.

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applicant); the testimony, with exhibits, of Deirdre McDonald, applicant's president and founder; the affidavit testimony of Ms. McDonald; and the rebuttal affidavit testimony of Ms. Jackson.² Both parties filed briefs on the case. An oral hearing was held before this Board on February 17, 1999.

Opposer was founded in 1986 by Mary Anne Jackson. Opposer has used the mark MY OWN MEAL for prepackaged prepared meals, namely meat and vegetable entrees, continuously since April 1987, and for prepackaged prepared pasta dinners since January 1988. Opposer's products are shelf-stable prepared meals, and were originally developed for children ages three through ten. Today opposer produces these products for such children as well as for adults. In 1990 opposer shifted its product direction to kosher meals for children and adults.

Opposer first sold its products under the mark MY OWN MEAL through mail order, and later added a retail market through grocery store chains, day care institutions, military commissaries, and through Toys "R" Us stores. Today, opposer sells directly to consumers, to institutions,

² In letters accompanying the two affidavits, the attorneys referred to the "parties' agreement." The Board presumes the parties agreed that certain testimony could be presented by affidavit. Note that Trademark Rule 2.123(b) now requires that such agreements be in writing.

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and to the military; the former two of which are through mail order, while the military is by contract.

Approximately 60-70% of opposer's sales of these products are to the military, with 10-15% to institutions, and the remainder are direct mail order sales. The minimum order is six meals of any variety, and the shipments to institutions are generally 48 meals to a case.

In 1986 opposer advertised through newspapers and later added national magazines and couponing. Today, opposer's advertising is through newsletters, direct mail, and ethnic magazines. Opposer has spent approximately \$2 million for advertising, marketing and promotion from 1986 to date.

Ms. Deirdre McDonald, applicant's founder and president, testified that applicant was incorporated in 1996; and that she selected the trademark MY OWN MAIL as part of the idea behind the corporation, which was "the idea of doing a club for kids where they receive their own mail and get a package with a craft activity, et cetera, in it." (Dep., p. 9).

Applicant's services are intended for children ages four to ten. The children's products included in the mail order craft package include a complete craft project (e.g., materials from which to create a book made from pages, yarn and glue), a recipe (related to the craft activity), a gift-wrapped surprise (e.g., snow globe, inflatable dinosaur),

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and a brochure for the adults. Applicant's mail order children's merchandise and gift packages cost \$14.95 plus \$3.50 shipping for the first child in the household and \$10.00 plus \$3.50 shipping for the second child in the household.

Applicant sent out a mailing of about 2000 brochures for the holiday mailing of December 1996,³ and applicant has continuously marketed and rendered these mail order services under its mark. In the last two years applicant's mark has been exposed to approximately 150,000 households in 34 states and its mail order services were ordered by customers in 13 states. Applicant advertises through direct mailings, and through magazines, newspapers and journals. Applicant sponsored an arts and crafts festival and followed up with a coupon mailing to those who signed up at the festival.

In the December 1996 holiday mailing, there is a reference to a "free bonus" birthday party pack "sponsored by Betty Crocker®." Ms. McDonald explained that this birthday package includes six craft projects to do with friends, a Betty Crocker cake decorating item and a dessert mix coupon, the latter two of which were provided through a contract with General Mills, Inc.

³ This mailing brochure includes the following opening statement: "MY OWN MAIL (tm) Craft Pack Club is a great new program in which a child receives his or her own exciting package in the mail every other month. Each shipment has a craft project complete

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Mary Anne Jackson, opposer's president and founder, testified at her February 10, 1998 deposition as to the status and ownership of opposer's two pleaded registrations, and copies of the pleaded registrations were included as exhibits to this testimony. See Trademark Rule 2.122(d)(2).

Because opposer owns valid and subsisting registrations of its pleaded mark, the issue of priority does not arise. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995). Moreover, the evidence clearly shows that opposer's first use preceded the filing date of applicant's intent-to-use application.

The only issue to be determined, therefore, is whether applicant's MY OWN MAIL mark, when used in connection with "mail order services featuring children's merchandise and children's gift packages," so resembles opposer's MY OWN MEAL mark for its "prepackaged prepared meals, namely, meat and vegetable entrees" and "prepackaged, prepared pasta dinners," that confusion is likely as to the origin or affiliation of the parties' goods and services. Upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563

with all necessary materials, plus stickers and a gift-wrapped surprise...."

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(CCPA 1973), for determining whether a likelihood of confusion exists, we find that confusion is not likely.

Regarding the parties' respective goods and services, applicant's mail order services featuring children's merchandise and gift packages are obviously very different from opposer's prepackaged prepared meat, vegetable and pasta meals. It is true that applicant's packages include a recipe card, and that when a child is signed up for applicant's mail order services, on the child's birthday applicant provides a free bonus party pack sponsored by Betty Crocker. But, there are no food items of any type included in applicant's packages.⁴ The inclusion of a recipe card and/or a coupon for a dessert mix does not sufficiently tie applicant's services to foods for purposes of our likelihood of confusion analysis. Applicant's services and opposer's goods are dissimilar.

The channels of trade may overlap in that opposer sells its prepackaged food products through, inter alia, mail order, and applicant's services are mail order services. There are no limitations in opposer's identifications of goods, and the record shows that a percentage of opposer's prepackaged prepared dinners are in fact sold by mail order. The fact that opposer sells some of its goods through mail

⁴ When asked if she was aware of whether there is food contained in applicant's craft packs, Ms. Jackson answered that she was

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order does not establish a likelihood of confusion with applicant's (and all other) mail order services. That is, purchasers of opposer's prepackaged foods are not likely to believe that applicant's mail order services emanate from or are in some way associated with the same entity solely because both are available through mail order.

Opposer argued in its brief that children's food products are frequently marketed in conjunction with toys and playthings, citing the examples of at fast-food restaurants, with breakfast cereals, and crayons and coloring mats given to children in sit-down restaurants (brief, pp. 13-14). However, the record is devoid of any evidence on this point.

Turning to a consideration of the marks, obviously both share the words MY OWN. However, when considered in their entireties, the marks are dissimilar in appearance and connotation. See *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992). The terms MEAL and MAIL are common words with different readily understood meanings. Opposer's mark connotes or signifies that the person has his or her own food or meal; whereas, applicant's mark connotes receiving something in the mail in one's own name.⁵

aware of a "connection to food through Betty Crocker. Other than that, no." (April 2, 1998 Dep. p. 11).

⁵ Opposer's argument that the acronym for both marks is MOM is not relevant herein as it is the involved marks which we must

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Both Ms. Jackson and Ms. McDonald testified that they were aware of no instances of actual confusion. The absence of any actual confusion is not a crucial factor to our decision, but it is not surprising, given the differences between applicant's mark and opposer's mark, the dissimilar products and services, and the disparate actual trade channels.

The Trademark Act does not speak in terms of remote possibilities of confusion, but rather, the likelihood of such confusion occurring in the marketplace. Our primary reviewing court has stated that more than a mere possibility of confusion must be shown; instead, there must be demonstrated a probability or likelihood of confusion. See *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), quoting from *Witco Chemical Company, Inc. v. Whitfield Chemical Company, Inc.*, 418 F.2d 1403, 164 USPQ 43 (CCPA 1969) as follows: "We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal." See also, *Triumph Machinery Company v. Kentmaster Manufacturing Company Inc.*, 1 USPQ2d 1826 (TTAB 1987).

consider. Further, Ms. McDonald testified that applicant does

not use any acronym for its mail order services.'

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Decision: The opposition is dismissed.

R. F. Cissel

T. J. Quinn

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board