

**IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE**

IN THE MATTER OF:

Serial No. 86860062
Trademark: Yummies
Applicant: Advanced Total Marketing
Systems, Inc.
Office Action of: August 17, 2016

January 25, 2017

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RESPONSE TO SECOND OFFICE ACTION

The following is Applicant's Advanced Total Marketing Systems, Inc. (hereinafter "Applicant" or "ATM") response to the Second-Office Action dated August 17, 2016 by Examining Attorney Samuel R. Paquin (hereinafter the "Examiner") whereby registration of Applicant's design mark "YUMMIES" with Serial No. 86860062, for "snacks, namely, fried plantain slices with different flavors, fried yucca chips with different flavors, fried pork with salt and chili, potato flakes of different flavors" under Class 29, and "peanuts, flavored peanuts, roasted peanuts, and mixed seeds, excluding nuts and roasted nuts; fried corn-based tortilla snack foods with different flavors; corn-based snack foods, namely, extruded corn with different flavors; popcorn of different flavors" under class 30 (hereinafter the "Mark" or the "Application") was partially refused on the basis of purported likelihood of confusion with prior registrations, while requesting a clarification of the goods and services covered by the Application (hereinafter the "Refusal").

APPLICANT'S SUBSTANTIVE RESPONSES TO THE EXAMINER'S REMARKS

I. RESPONSE TO SECTION ENTITLED "SECTION 2(D) REFUSAL-LIKELIHOOD OF CONFUSION"

The Examiner has refused registration of the Mark pursuant to Section 2(d) of the Lanham Act, 15 USC § 1052(d), on the grounds of a purported likelihood of confusion with the mark in U.S. Registration No. 1458548, "YUMMIES" for "roasted nuts and dried fruits for consumption on and off the premises", under Class 29 (the "Reference Mark No. 1"), with the mark in U.S. Registration No. 4025559, "YUMMYS CHOICE" for "vegetable-based snack foods", under class 29 (the "Reference Mark No. 2"), and with U.S. Registration No. 4957659, "SUPER YUMMYS", for "Vegetable-based snack foods; Fruit-based snack foods; Vegetable chips; Fruit chips; Milk products excluding ice cream, ice milk and frozen yogurt", under class 29 (the "Reference Mark No. 3") (collectively, the "Reference Marks"). For the reasons stated herein, Applicant respectfully requests that the Examiner reconsiders the partial statutory refusal and allows the registration of the Mark in its entirety.

A. There is No Likelihood of Confusion Between the Mark and the Reference Marks.

In the United States Patent and Trademark Office ("USPTO"), likelihood of confusion between two marks is determined by the review of the relevant factors under the *Dupont* test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). The two key considerations in *ex parte* likelihood of confusion analysis are the similarity of the marks and the similarity or relatedness of the goods and/or services. *Syndicat Des Proprietaires Viticulteurs De Chateaufneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1938 (TTAB 2013) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29

(C.C.P.A. 1976)); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see* TMEP §1207.01. Essentially, there is a two-step process for determining likelihood of confusion.

First, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Second, the goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01(a)(vi).

As Applicant establishes below, an analysis of these factors support the conclusion that there is no likelihood of confusion between the Mark and the Reference Marks.

- a. The products for which the Reference Marks are registered are distinguishable from Applicant's products and there is thus no likelihood of confusion between the Mark and the Reference Marks.**

In *In Re Thor Tech, Inc.*, 2015 WL 496133 (TTAB 2015), the TTAB very recently reversed a decision from the examining attorney who denied registration of the trademark "TERRAIN" in Class 12 for "recreational vehicles, namely, towable trailers" on the basis that it was likely confused with the homonymous trademark "TERRAIN", also in Class 12 for "motor land vehicles, namely, trucks".

The TTAB's reversal in *In Re Thor Tech* arose in response to evidence proffered by the applicant, which demonstrated the existence of multiple trademarks, registered for "towable trailers", which coexisted with third-parties trademarks, registered for "trucks". The aforementioned evidence was found to be sufficient to establish that the parties' goods were

different and distinguishable from each other, and that there was thus no likelihood of confusion.

In Re Thor Tech, Inc., 2015 WL 496133 at *5.

The TTAB has held that the existence of substantially identical marks on the federal Trademark Register suggests that businesses within the relevant industries believe that their respective goods are distinct enough that confusion between even identical marks is unlikely. *In Re Thor Tech, Inc.*, 2015 WL 496133 at *4.

Indeed, if the TTAB found that the two identical “TERRAIN” trademarks in *In Re Thor* could coexist without confusion within the same class (i.e. Class 12) and both for motor vehicles, even more can the Mark coexist with the Reference Marks without likelihood of confusion in different classes and for different goods and services, as it happens to be the case. *See, also, e.g. Amstar Corp. v. Domino’s Pizza, Inc.*, 615 F.2d 252, 260 (5th Cir. 1980) (finding that there was no likelihood of confusion between pizza and sugar as the only identifiable similarity between both products was that they were are edible). In view of the foregoing, and in conformity with the precedential and binding precedent of *In Re Thor*, Applicant submits that the Mark should be allowed for registration.

a. Examiner’s own evidence precludes a finding of likelihood of confusion.

More tellingly, the Reference Marks cited by the Examiner peacefully coexist notwithstanding that they **all** carry the trademark “Yummy” or “Yummies”; that they are both registered **under the same class** (i.e. 29); and they are all registered and reportedly used for **the same line of products** (i.e. snacks). In contrast, the Mark is sought to be registered for class 29 and 30 and for products which are related, but distinguishable (i.e. “fried plantain slices with different flavors, fried yucca chips with different flavors” in class 29 and “flavored peanuts, roasted peanuts, and mixed seeds, excluding nuts and roasted nuts” in class 30). The fact that the Reference



Marks are currently coexisting without confusion on the register provides additional grounds to conclude that the Mark will likewise not cause confusion.

a. There Is No Likelihood Of Confusion Between The Mark and the Reference Marks Because They All Convey Different Commercial Impressions.

The Mark and the Reference Marks are inherently distinctive from each other and convey different overall impressions and appearance.

- **The Mark v. Reference Mark No. 1**

The Mark and Reference Mark No. 1 instill different commercial impressions. Reference Mark No. 1 consists of the word “yummies” in a particular script with a heart shape on top of the letter “i”, as shown below:

<u>Reference Mark No. 1</u>	<u>The Mark</u>
	

See Reference Mark No. 1. In contrast, the Mark consists of consists of a face with a crown design in the colors red and blue next to the word “YUMMIES” in a white bold font against a blue bandeau background. The blue background is lined in the colors red and turquoise. See the Mark. Under applicable law, these stark differences suffice to defeat a finding of likelihood of confusion.



As it has been noted, in cases like this one “comparison of the *labels* rather than simply the trademarks is appropriate”. *Henri’s Food Products Co., Inc. v. Kraft, Inc.*, 717 F.2d 352, 355 (7th Cir. 1983) (emphasis in the original). In adherence to this principle, the Federal Circuit has instructed that “[t]he spoken or vocalizable element of a design mark, taken without the design, need not of itself serve to distinguish the goods. The nature of stylized letter marks is that they

partake of both visual and oral indicia, and both must be weighed in the context.” *See In re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990). A design is viewed, not spoken and in a composite mark —like Reference Mark No. 1 here —the design is a significant feature thereof. *Id.* Weighing in analogous differences as those found between the Mark and Reference Mark No. 1 here, the Federal Circuit determined in *In re Electrolyte* that, despite similarities in the vocalizable features of a mark (the word part), the design of a composite mark serves to distinguish its owner’s goods and services from those of others. *Id.* at 648. In that case, the Federal Circuit reversed the TTAB’s finding of likelihood of confusion. *Id.* *See also, Amstar Corp.*, 615 F.2d at 261 (“Defendant’s mark, far from suggesting plaintiff’s mark, is stylistically and typographically distinguishable. We must consider the commercial impression created by the mark as a whole”).

In view of the foregoing, the Examiner should find that Reference Mark No. 1 has sufficient elements to preclude a finding of likelihood of confusion with the Mark.

- **The Mark v. Reference Mark No. 2.**

The Mark and Reference Mark No. 2 instill different commercial impressions. Reference Mark No. 2 consists of the words “Yummy’s Choice” in a particular script. The word “Yummy’s” appears in a turquoise color and the word “Choice” appears beneath the word “Yummy’s” in a red color. The words appear against distinct beige colored oval background. Next to the words “Yummy’s Choice”, towards the bottom right corner, there appears to be a ribbon rosette figure in turquoise. *See* Reference Mark No. 2. Conversely, and as stated before, the Mark consists of a face with a crown design in the colors red and blue next to the word “YUMMIES” in a white bold font against a blue bandeau background. The blue background is lined in the colors red and turquoise. *See* the Mark.

<u>Reference Mark No. 2</u>	<u>The Mark</u>
	

Again, these differences have been found to preclude a finding of likelihood of confusion. *See e.g., Keebler Company v. Associated Biscuits Limited*, 207 U.S.P.Q. 1034, 1980 WL 30162 at *6 (TTAB 1980) (“Respondent’s mark is not “CLUB” per se but is “JACOB’S CLUB”. Based on the status of “CLUB” marks for foods and beverages on the Register and the correspondingly limited stature of any one “CLUB” mark, the presence of “JACOB’S” in respondent’s mark creates a sufficient difference, certainly as significant as the differences between the other registered “CLUB” marks described above, to avoid a likelihood of confusion, mistake or deception”).

Furthermore, the Mark and Reference Mark No. 2 have different number of syllables and words which further operates against a finding of likelihood of confusion. *See, e.g. Fuji Jyukogyo Kabushiki Kaisha v. Toyota Jidosha*, 228 U.S.P.Q. 672, 1985 WL 71979 at *3 (TTAB 1985)(weighing the differences in the number of syllables and/or words between the marks in conflict to conclude that there was no likelihood of confusion); *Harp v. Rahme*, 984 F.Supp.2d 398, 414 (E.D. Penn. 2013) (same); *A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 217 (3d Cir.2000) (same).


As previously discussed, the “comparison of the *labels* rather than simply the trademarks is appropriate”. *Henri’s Food Products Co., Inc.*, 717 F.2d at 355 (emphasis in the original). In adherence to this principle, the Federal Circuit has instructed that “[t]he spoken or vocalizable element of a design mark, taken without the design, need not of itself serve to distinguish the goods. The nature of stylized letter marks is that they partake of both visual and oral indicia, and

both must be weighed in the context.” See *In re Electrolyte Laboratories, Inc.*, 929 F.2d at 647. A design is viewed, not spoken and in a composite mark —like Reference Mark No. 2 here —the design is a significant feature thereof. *Id.* Weighing in analogous differences as those found between the Mark and Reference Mark No. 2 here, the Federal Circuit determined in *In re Electrolyte* that, despite similarities in the vocalizable features of a mark (the word part), the design of a composite mark serves to distinguish its owner’s goods and services from those of others. *Id.* at 648. In that case, the Federal Circuit reversed the TTAB’s finding of likelihood of confusion. *Id.* See also, *Amstar Corp.*, 615 F.2d at 261 (“Defendant’s mark, far from suggesting plaintiff’s mark, is stylistically and typographically distinguishable. We must consider the commercial impression created by the mark as a whole”).

Considering the aforementioned, it thus follows that there is no likelihood of confusion between the Mark and Reference Mark No. 2.

- **The Mark v. Reference Mark No. 3.**

The Mark and Reference Mark No. 3 instill different commercial impressions. Reference Mark No. 3 consists of consists of the **two (2)** standard characters “SUPER” and “YUMMYS”. See Reference Mark No. 3. The Mark consists of a face with a crown design in the colors red and blue next to the word “YUMMIES” in a white bold font against a blue bandeau background. The blue background is lined in the colors red and turquoise. See the Mark.

<u>Reference Mark No. 3</u>	<u>The Mark</u>
SUPER YUMMYS	

As with Reference Mark No. 1 and Reference Mark No. 2, we reiterate that these differences have been found to preclude a finding of likelihood of confusion. *See e.g., Keebler Company v. Associated Biscuits Limited*, 207 U.S.P.Q. 1034, 1980 WL 30162 at *6 (TTAB 1980) (“Respondent’s mark is not “CLUB” per se but is “JACOB’S CLUB”. Based on the status of “CLUB” marks for foods and beverages on the Register and the correspondingly limited stature of any one “CLUB” mark, the presence of “JACOB’S” in respondent’s mark creates a sufficient difference, certainly as significant as the differences between the other registered “CLUB” marks described above, to avoid a likelihood of confusion, mistake or deception”).

Furthermore, the Mark and Reference Mark No. 3 have different number of syllables and words which further operates against a finding of likelihood of confusion. *See, e.g. Fuji Jyukogyo Kabushiki Kaisha v. Toyota Jidosha*, 228 U.S.P.Q. 672, 1985 WL 71979 at *3 (TTAB 1985)(weighing the differences in the number of syllables and/or words between the marks in conflict to conclude that there was no likelihood of confusion); *Harp v. Rahme*, 984 F.Supp.2d 398, 414 (E.D. Penn. 2013) (same); *A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 217 (3d Cir.2000) (same).

Considering the aforementioned, it thus follows that there is no likelihood of confusion between the Mark and Reference Mark No. 3.

a. There Is No Likelihood Of Confusion Between The Marks Because They Travel In Different Channels Of Trade.

The Mark is restricted to “Snacks, namely, fried plantain slices with different flavors, fried yucca chips with different flavors, fried pork with salt and chili, potato flakes of different flavors” under Class 29 and “Peanuts, flavored peanuts, roasted peanuts, and mixed seeds, excluding nuts and roasted nuts; fried corn-based tortilla snack foods with different flavors; corn-based snack

foods, namely, extruded corn with different flavors; popcorn of different flavors” under Class 30. See the Mark. Conversely, Reference Mark No. 1 is restricted to “roasted nuts and dried fruits for consumption on and off the premises” under Class 29. Reference Mark No. 2, on the other hand, is restricted to “dairy-based snack foods excluding ice cream, ice milk and frozen yogurt; Fruit-based food beverage; Oils and fats for food; Snack food dips; Vegetable-based snack foods”, under Class 29. Finally, Reference Mark No. 3 is limited to “vegetable-based snack foods; Fruit-based snack foods; Vegetable chips; Fruit chips; Milk products excluding ice cream, ice milk and frozen yogurt.”

The Mark	Reference Mark No. 1	Reference Mark No. 2	Reference Mark No. 3
Peanuts, flavored peanuts, roasted peanuts, and mixed seeds, excluding nuts and roasted nuts; fried corn-based tortilla snack foods with different flavors; corn-based snack foods, namely, extruded corn with different flavors; popcorn of different flavors.	Roasted nuts and dried fruits for consumption on and off the premises.	Dairy-based snack foods excluding ice cream, ice milk and frozen yogurt; Fruit-based food beverage; Oils and fats for food; Snack food dips; Vegetable-based snack foods.	Vegetable-based snack foods; Fruit-based snack foods; Vegetable chips; Fruit chips; Milk products excluding ice cream, ice milk and frozen yogurt.

From a comparison of the products included in the Mark and the Reference Marks it is evident that the products included in the Mark are not identified by any of the Reference Marks. Moreover, the Reference Marks do have identical products amongst their descriptions, such as “vegetable chips and/or vegetable snack foods and fruit based snack foods and fruit based food beverages.” In addition, as proposed below, Applicant is requesting its product descriptions be limited to the identified snacks in the “Latin American” market so as to achieve clarity that the

Mark and the Reference Marks will not travel in the same channels of trade. That the Mark is being amended so as to be filed restrictively to identify particular end products operate against a presumption that they travel in the same channels of trade or that they target the same class of purchasers. *Cf. CBS Inc. v. Morrow*, 708 F.2d 1579, 1581 (Fed. Cir. 1983) (finding that the fact that the goods were not limited to any particular channels of trade or methods of distribution, nor to any particular end products, and were identified broadly raised a presumption that they traveled in the same channels of trade).

This factor provides additional support to conclude that there is no likelihood of confusion between the Marks.

II. RESPONSE TO SECTION ENTITLED “IDENTIFICATION OF GOODS”

Applicant has considered Examiner’s remarks and adopts Examiner’s proposed wording for the identification of goods and/or services as follows:

Class 29

“Latin American style food products, namely, processed flavored plantains, processed flavored yucca (“cassava”), fried pork with salt and chili, potato flakes of different flavors.”

Class 30

“Latin American style food products, namely fried flavored peanuts and baked flavored peanuts; fried corn-based tortilla snack foods with different flavors; corn-based snack foods, namely, extruded corn with different flavors; popcorn of different flavors.”

CONCLUSION

In light of the foregoing, we ask that upon your review, you withdraw the partial Refusal and grant Applicant’s application for the registration of the trademark “Yummies” for the goods and services sought.

Response to Second Office Action

Serial No. 86860062

Trademark: YUMMIES

The Applicant has responded to all issues raised in the partial Refusal. If any further information or response is required, please contact Applicant's attorneys.

Dated: January 25, 2017.

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DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his own knowledge are true; and all statements made on information and belief are believed to be true.

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