

## Likelihood of Confusion

The Examiner cites Registration No. 3679595 for **EggGenie** as blocking the application to register GENIE due to a likelihood of confusion. The possibility of also citing POM GENIE, HEALTH GENIE and POM HEALTH GENIE, if they are registered, is noted.

In considering the issue of likelihood of confusion, the courts have said, “[w]hile it must consider each factor for which it has evidence, the Board may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods.” *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001). See also *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1357, 192 USPQ 24 (CCPA 1976) (“[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks”); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein. It is not necessary that the respective goods and services be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. That is, the issue is not whether consumers would confuse the goods and services themselves, but rather whether they would be confused as to the source of the goods and services. See *Miss Universe L.P. v. Community Marketing Inc.*, 82 USPQ2d 1562, 1568 (TTAB 2007); *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984).

In order to refuse registration under Section 2(d), there must be shown more than a mere possibility of confusion; 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). The Trademark Act does not speak in terms of remote possibilities of confusion, but rather, the likelihood of such confusion occurring in the marketplace.

As the Court of Customs and Patent Appeals stated in the *duPont* case, there is no litmus test for assessing confusion.

[T]rademark law must necessarily be flexible responding to particular circumstances disclosed by particular fact situations thereby making a hard and fast rule in these cases anathema to its concept and application. That is, this is contrary to the principle of trademark law that each case must be decided on the basis of all relevant facts which include the marks and the goods as well as the marketing environment in which in which a purchaser normally encounters them and the experience generated as a result of their use in the marketplace providing such use has been of sufficient length and depth to make an impact in the market. *Interstate Brands Corporation v. Celestial Seasonings, Inc.* 196 USPQ 321, 324 (TTAB 1977).

In this case, the marks are not confusingly similar because the applicant's mark has a different commercial impression from the cited marks. The applicant notes the court's statement in *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003), that "similarity is not a binary factor but is a matter of degree." Similarity is judged by examining the so-called "triumvirate" of comparison of trademarks – appearance, sound and meaning. See *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973).

Here, the applicant's mark is spelled differently from the cited marks, has a different sound and has a different meaning.

The registered mark begins with the word EGG. As a general rule, consumers are more inclined to focus on the first word, prefix, or syllable in any trademark or services mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also *Presto Prods. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895,

1897 (TTAB 1998) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions). Thus, it is more likely than not that consumers will focus on the word EGG in looking for this product, especially since the goods are related to eggs. The same rationale applies to the pending applications for POM GENIE, HEALTH GENIE and POM HEALTH GENIE.

By contrast, the applicant's mark is GENIE. While this is identical to the second part of the cited marks, similarity must be judged by the appearance of the **entire** mark. *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973)

Here, the appearance is quite different and most importantly, the meaning conveyed by EGGGENIE, POM GENIE, HEALTH GENIE and POM HEALTH GENIE is not conveyed by GENIE alone. These differences are enough to signal a difference in source to consumers, particularly in a case like this one where the word GENIE is commonly found in trademarks. Because the mark is widely used, consumers have no reason to suppose that all GENIE marks come from the same source.

The applicant submits that the term GENIE is diluted and accordingly the senior marks should be given limited protection. As of this writing, there are 411 *active registered* marks containing the term GENIE and registered to many different parties. There are 21 GENIE marks registered with class 11 goods. These include the following, all registered to different owners:

GENIE – Reg. No. 5385822 – for "oil lamps"

GENIE – Reg. No. 5082846 – for "electric scent dispensing units"

GENIE – Reg. No. 0871197 – for "radio signal transmitters"

SINK GENIE – Reg. No. 5380928 – for "plumbing fittings, namely, traps"

LAWN GENIE – Reg. No. 3388967 – for "water valves"

MOSQUITO GENIE – Reg. No. 3805637 for "insect control devices"

These marks all can co-exist in the marketplace and on the registry because the GENIE mark is given protection limited to competitive goods.

Third-party registrations may be probative of a lack of distinctiveness of a mark or an element of a mark. See *Tektronic, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976) and *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 140, 184 USPQ 422 (CCPA 1975). The Federal Circuit has stated that “evidence of third-party use of similar marks on similar goods ‘can show that customers have been educated to distinguish between different marks on the basis of minute distinctions.’” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015), quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). Such evidence is “powerful on its face, even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin v. New Millennium Sports*, 116 USPQ2d at 1136 (internal quotes omitted). “The weaker an opposer’s mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Juice Generation v. GS Enters.*, 115 USPQ2d at 1674.

The large number of GENIE marks on the registry simply means that each of them is given a narrow ambit of protection. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015). The Board in *In re Broadway Chicken Inc.*, 38 USPQ2d 1565-66 (TTAB 1996), citing *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986), stated:

Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to other elements of the marks as a means of distinguishing the source of goods or services in the field.

In these cases, buyers differentiate between the various marks by looking at the mark as a whole. Buyers do not assume that the provider of one GENIE product also provides a different product.

Likelihood of confusion is reduced when the common element of conflicting marks is a word or phrase that is "weak," *In re America's Best Chocolate, Inc.*, 169 USPQ 53 (TTAB 1971), i.e., "when it is descriptive, highly suggestive, or in common use by many other sellers in the market." [Emphasis added.] *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 USPQ 529 (CCPA 1970). For this reason, the Applicant's GENIE mark should be able to co-exist in this crowded field just as the marks cited above already do.

As stated by the Board in *Keebler Company v. Associated Biscuits Ltd.*, 207 USPQ 1034, 1039 (TTAB 1980), in such circumstances: "[I]t is now far too late for any one party to claim a right to exclusive use extending beyond a specific mark for specific goods." The cited marks are clearly subject to this rule and the rights to which these marks are entitled do not extend to bar the registration of applicant's mark for the services identified in its application.

Beyond the difference in the marks, there are significant differences in the goods. The registered mark is used to identify "electric egg cookers; electric food steamers" and "egg poachers." The applicant's goods as amended do not include any similar goods. The applicant's goods are a unique system for quickly preparing food (see evidence attached). The amended identification is:

Class 11: Multi-purpose, computer-controlled electric countertop food preparation apparatus for cooking, baking, broiling, roasting, toasting, searing, browning, barbecuing and grilling food

Class 29: A full line of freeze-dried foods sold in single-serving or portion-controlled containers for use in an electric countertop food preparation apparatus; Freeze-dried food products, namely, pods and cartridges containing freeze-dried foods for use in an electric countertop food preparation apparatus for quickly making ready-to-eat servings

These are cutting edge goods that travel in an entirely different commerce stream than the registrant's egg cookers. There are large differences in cost and different customers as well.

In the case of the senior applications, the goods are fruits. These are quite different from the food pods sold by the applicant. The applicant's class 29 goods are unique and consumers will not assume they come from a conventional source of fruit.

Many cases have held that the PTO must show "something more" than a mere possibility that the goods and/or services are related. See *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003)(small number of third-party registrations for both restaurant services and beer suggests the degree of overlap is de minimis); *Jacobs v. International Multifoods Corporation*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982)(relatedness between food and restaurant services requires "something more" than the fact that restaurants serve food).

Combined with the differences in the marks, the applicant's revised identification of goods contains no goods that would lead the public to believe that they come from the same source as the marks cited by the Examiner. The differences in the marks and the goods assure that there will be no likelihood of confusion as to the source of the Applicant's goods and services. Accordingly, there should be no refusal to register under Section 2(d).