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DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jake's Finer Foods Inc.

Serial Nos. 75/492,089, 75/492,090 and 75/492,091

Kurt J. Brown for Jake's Finer Foods Inc.

Raul F. Cordova, Trademark Examining Attorney, Law Office 114
(Margaret Le, Managing Attorney).

Before Hanak, Bucher and Rogers, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

On May 27, 1998, Jake's Finer Foods Inc. filed three
separate applications to register its composite service marks,
as shown below, JAKE'S (and chicken design), JAKE'S FINER FOODS
(and chicken design), and JAKES FINER FOODS (stylized):



SN 75/492,089



SN 75/492,090



SN 75/492,091

for wholesale distributorship services in International Class 35
and for a variety of services which applicant argues are
properly classified in International Class 42, although the

exact recital of these particular services is still in dispute. Application Ser. No. 75/492,089, for the JAKE'S and chicken design mark, claims use dates of December 1958, while the applications for the latter two marks claim use dates of December 1978.

The Trademark Examining Attorney made final a refusal of registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's marks, when used on its identified services, will create a likelihood of confusion with the service mark JAKE'S previously registered in connection with "distributorship services in the field of seafood."¹ The Trademark Examining Attorney has also gone final as to the requirement for applicant to amend the current recital of services in International Class 42, arguing that it is indefinite and overbroad.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but applicant did not request an oral hearing. The prosecution histories of these three applications are substantially identical, as are the issues before us in connection with each application. Accordingly, the

¹ Reg. No. 1,610,827, issued on August 21, 1990; §8 affidavit accepted and §15 affidavit acknowledged.

three cases have been consolidated and this single opinion has been issued for all three cases.

We affirm both of the bases for refusal to register with regard to all three applications.

We turn first to the requirement for amendment of the recital of services in International Class 42. The current recitation as submitted by applicant reads as follows: "food services, namely for procurement and preparation of packaged bulk poultry, frozen and canned vegetables, eggs, and dairy products, in large and small quantities, to include food service paper goods and disposables," in International Class 42.

The Trademark Examining Attorney states the position of the Office as follows:

[The above] recitation of services ... is deemed unacceptable as overbroad and indefinite. The services listed are not clearly stated and include activities that are properly classified in Class 35. Food preparation and packaging for others is classified in Class 40, and providing food for consumption at the premises is set in Class 42. The applicant's recitation of services in Class 42 fails to inform [sic] the exact nature of its services that is for the benefit of others. Trademark Act Section 3. Acceptable identifications are necessary for scope, classification and specimen issues. The public relies on this information for determination of its own rights... The Office requires clearly stated identifications for classification purposes which is solely within the discretion of the Patent and Trademark Office... Whether applicant's activities belong in Class 42 cannot be determined without further specificity. The current language delineates services that can be

classified in Classes 35, 40 or 42. (appeal brief, p. 3).

The Trademark Examining Attorney has accepted applicant's wholesale distributorship services in International Class 35, but been unable to obtain clarification of the confusing recital in International Class 42. This recital begins with the vague words "Food services," and then is further muddled by the words "procurement" and "preparation." This is followed by a listing of food items of indeterminate quantity (i.e., possibly ranging from an entire tractor-trailer load of foodstuffs to a single sandwich), which are also combined with serving and packaging items. Unfortunately, even if one is knowledgeable about this country's food services industries, when one gets to the end of this recital, it is still unclear precisely which activities applicant is claiming to be involved with.

If, for example, applicant is actually placing its mark on poultry products sold to institutions, this may involve goods in International Class 29. On the other hand, distributorship services in the field of commercial food equipment would be placed in International Class 35, along with applicant's other correctly recited services. In the event that applicant is involved in food canning, food packaging and food processing, these services would be classified in International Class 40. Finally, it is entirely possible that applicant indeed provides

services correctly placed in International Class 42, provided that it is involved in: providing contract food services for institutional customers; food management consulting services rendered to institutions and enterprises; research and development of recipes and/or food and beverage products; menu evaluation, development and design; providing layout and design for commercial kitchens; providing programming, consultation, software design and computer diagnostic services to its customers in the food service industry; and/or catering services (or restaurant services) providing food for consumption on and off the premises.²

The record reflects multiple attempts by the Trademark Examining Attorney to make suggestions for acceptable amendments to the recital of services. However, applicant was unwilling or unable to comply with the repeated requirements for more specificity. Given the uncertainty in the record about exactly what applicant intended this recital to encompass, we find the requirements of the Trademark Examining Attorney to be valid for all the reasons stated in his brief. Accordingly, we affirm the refusal to register this mark as to International Class 42 in

² The examples in this paragraph demonstrate the indefinite nature of the current recital of services. However, we hasten to add that some of these possibilities, even if they may reflect applicant's actual business activities, might well be precluded if deemed to be beyond the scope of earlier amended recitals. See 37 C.F.R. §2.71.

light of the unmet requirement that applicant submit a more definite recital of services.

We turn next to the refusal to register based upon a likelihood of confusion for each of these three marks with the prior, cited registration. Our determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E. I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, key considerations are the similarities of the marks and the relatedness of the services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The cited mark is used on food distributorship services in the field of seafood. Applicant's food distributorship services list poultry, vegetables, eggs and dairy products. The Trademark Examining Attorney has submitted third-party registrations and stories from the LEXIS/NEXIS database showing that wholesale distributors to food service customers routinely supply both poultry and seafood. Applicant has not countered this probative evidence placed in the record by the Trademark Examining Attorney. Hence, we have to conclude that from the perspective of food service customers and retail food buyers, these two services are closely related.

We turn then to the respective marks. Registrant's mark consists solely of the word JAKE'S. Similarly, the dominant feature of each of applicant's marks is JAKE'S (or JAKES). To the extent that two of applicant's marks contain additional wording ("Finer Foods"), these descriptive words are disclaimed and are much smaller in size than the prominent word JAKE'S (or JAKES).

Two of the applied-for marks also contain a drawing of a chicken. Clearly, that creates imagery not present in registrant's mark. However, if someone acquainted with the registered JAKE'S mark for seafood - indeed, even a sophisticated buyer for a large institution - were to see the composite mark that is the subject of Serial Number 75/492,089, such a prospective customer may well view this as registrant's having extended its product line from seafood into poultry. The even less prominent chicken in the composite mark that is the subject of Serial Number 75/492,090 may well cause the same reaction on the part of such a prospective purchaser.

Accordingly, focusing on the distributorship services of the cited registration and the class 35 distributorship services herein, with highly similar marks being used on closely related services, we find that there is a clear likelihood of confusion. Moreover, precisely because of the indefinite nature of applicant's services in International Class 42, as discussed

above, it is impractical to attempt to compare these with registrant's services.

As to the du Pont factor dealing with the length of time during and conditions under which there has been concurrent use without evidence of actual confusion, applicant points to twenty years of coexistence without any actual confusion. However, we have no evidence that these respective JAKE'S marks have ever been used contemporaneously in the same geographical area. As to whether there has been sufficient opportunity for confusion to occur, in addition to the geographical divide between registrant's base in Oregon and applicant's operations in Texas, the record contains no indication of the level of sales or advertising by applicant. The absence of any instances of actual confusion is a meaningful factor only where the record indicates that, for a significant period of time, an applicant's sales and advertising activities have been so appreciable and continuous that, if confusion were likely to happen, any actual incidents thereof would be expected to have occurred and would have come to the attention of one or both of these trademark owners. Similarly, we have no information concerning the nature and extent of registrant's use, and thus we cannot tell whether there has been sufficient opportunity for confusion to occur as we have not had opportunity to hear from the registrant on this point. All of these factors materially reduce the probative

value of applicant's argument regarding asserted lack of actual confusion. Therefore, applicant's claim that no instances of actual confusion have been brought to applicant's attention is not indicative of an absence of a likelihood of confusion. See Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). In any event, we are mindful of the fact that the test under Section 2(d) of the Act is likelihood of confusion, not actual confusion.

Finally, applicant repeatedly points out that its first use of the JAKE'S mark occurred decades before the date claimed in the cited registration. While we are not unsympathetic to the notion of basic equity raised by applicant herein, priority is not an issue in the context of an *ex parte* appeal. In the context of this *ex parte* appeal, applicant cannot attack the validity of the cited registration. Rather, the appropriate forum for applicant to have raised such an issue was in the form of a timely petition to cancel the cited registration, or in a concurrent use proceeding based upon applicant's claim of actual use in commerce of its marks prior to the filing date of the application which resulted in the cited registration.

Decision: The refusal to register is affirmed as to both bases therefor.