

This Opinion is Not a Precedent of the TTAB
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Hearing: October 14, 2021

Mailed: January 5, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Del Monte International GmbH

Serial No. 88614478

Serial No. 88696297

Nicole M. Meyer of Dickinson Wright PLC,
for Del Monte International GmbH.

Susan K. Lawrence, Trademark Examining Attorney, Law Office 116,
Matthew Cuccias, Managing Attorney (Acting).

Before Taylor, Coggins and English,
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Del Monte International GmbH (“Applicant”) seeks registration on the Principal Register of the two marks below, both for “food and beverage kiosk services; retail store services featuring fresh fruits and vegetables, sandwiches, wraps, baked goods, salads, snacks, entrees, prepared meals, dips, hummus, soups and yogurts; all of the foregoing excluding supermarkets” in International Class 35:

FRSHST₁

and



The Examining Attorney refused registration of each mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the standard character mark FRESH STREET SQUARE (“FRESH” disclaimed) for “supermarkets” in International Class 35.³

When the refusals were made final, Applicant appealed and requested reconsideration in each application. The Examining Attorney denied Applicant’s

¹ Application Serial No. 88614478 (“478 Appl.”); filed September 12, 2019 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intent to use the mark in commerce. The application includes the following description of the mark: “The mark consists of the lettering ‘FRSHST’ wherein the ‘ST’ appears in superscript.” Color is not claimed as a feature of the mark.

² Application Serial No. 88696297 (“297” Appl.); filed November 18, 2019 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s allegation of a bona fide intent to use the mark in commerce. The application includes the following description of the mark: “The mark consists of ‘FRSHST’ wherein the ‘ST’ is underlined and in superscript with a 3 leaf design appearing on the left and right sides of ‘FRSHST’ and all of the foregoing appearing inside of a street sign design.” Color is not claimed as a feature of the mark.

³ Registration No. 4727929; issued April 28, 2015.

The Examining Attorney did not attach a copy of the cited registration to the Office actions as required. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPE) § 705.03 (July 2021). Applicant did not raise this issue and argued the merits of the refusals. Accordingly, we consider the registration as of record. *Cf. See In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) (although the Board does not take judicial notice of registrations, because applicant discussed one of its registrations that was not in the record in its appeal brief and the examining attorney addressed that registration and another of applicant’s registrations, which was also not of record in her brief, and neither objected to the discussion of the other, the Board treated both registrations as though they were of record).

requests for reconsideration, and the appeals resumed. The appeals are fully briefed and were consolidated on September 10, 2021. An oral hearing was held on October 14, 2021.⁴

We affirm the refusals to register.

I. Analysis

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. DuPont de Nemours & Co*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co. Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor for which there is argument and evidence. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc’ns., Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences

⁴ The records on appeal are substantially similar. Unless otherwise indicated, we cite to the record in the ’478 Appl. Page references to the application record are to the downloadable .pdf version of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board’s TTABVUE docket system.

in the essential characteristics of the goods and differences in the marks.”). We address these and other relevant *DuPont* factors below.

A. Similarity or Dissimilarity of the Marks

We start with the first *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

The issue 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 impression such that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). Because the involved services are the type marketed to the general public, our focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Chutter, Inc. v. Great Mgmt. Grp.*, 2021 USPQ2d 1001, *35 (TTAB 2021) (citing, inter alia, *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975)).

We do not predicate our analysis on a dissection of the involved marks; we consider the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1160; *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). But one feature of a mark may be more significant than another, and it is not improper, for rational reasons, to give more weight to a dominant feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1161 (finding that the Board did not err in reasoning that the term LION was dominant in both applicant’s mark STONE LION CAPITAL and opposer’s marks LION CAPITAL and LION); *In re Chatam Int’l*, 71 USPQ2d at 1946.

The Examining Attorney argues that the literal element of Applicant’s marks are “the equivalent both in sound and meaning to the wording ‘FRESH STREET,’” which are the first two words in the cited mark.⁵ Applicant argues that “while that is one way that consumers may perceive [Applicant’s] Mark[s] that may not be the only way. ... [I]t is presumable that at least some consumers will pronounce [Applicant’s marks] as one word rather than two, i.e., “freshst” rather than “fresh street.”⁶ The basis for Applicant’s assertion is that:⁷

The letters “FRSH” and “ST” in [Applicant’s] Mark[s] are not separated by a space as might indicate two words. Also, there is no period after the letters “ST” as might indicate to consumers that it is intended to be an

⁵ Examining Attorney’s Brief, 10 TTABVUE 6.

⁶ Appeal Brief, 8 TTABVUE 10-11.

⁷ *Id.* at 10.

abbreviation of the word “street”. Rather, the literal element in [Applicant’s] mark[s] is unitary and ends in the suffix “ST” as one would see in the ordinal number “1st”. ... That consumers might perceive the letters “ST” as a suffix rather than a separate word is underscored by the fact that these letters appear in superscript font which is a format used in writing ordinals such as: “1st”, “2nd”, “3rd”, “4th”, etc.

Because the superscript “st” in Applicant’s marks is not preceded by an ordinal, we find it unlikely that consumers would treat it similar to an ordinal suffix and therefore are unlikely to pronounce Applicant’s marks as “freshest.” But even if this were the perception of a few consumers, this would not obviate a likelihood of confusion with the cited mark.

“[T]he fact that a word mark [or literal portion of a composite mark] will be understood by some individuals in a manner such that confusion with a prior mark is likely and by other individuals in a manner such that confusion is unlikely, will generally still result in a finding of likelihood of confusion, provided that the size of the group of individuals who are likely to be confused is not inconsequential.” *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988). We find that an appreciable number of consumers are likely to perceive and pronounce Applicant’s marks as “fresh street.”

Consumers may not notice the absence of the middle letter “e” in the FRSH portion of Applicant’s mark. *See, e.g. In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909-11 (Fed. Cir. 2012) (XCEED and X-SEED & design found to be confusingly similar); *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214, 1217 (TTAB 2001) (finding KYNG confusingly similar to KING FM and KING-TV for the same and highly related services) (TTAB 2001); *Centraz Indus. Inc. v. Spartan Chem. Co. Inc.*,

77 USPQ2d 1698, 1701 (TTAB 2006) (ISHINE stylized and ICE SHINE are confusingly similar). Those who do notice are likely to readily recognize FRSH as a misspelling of “fresh” or the disemvoweled⁸ version of the word given the nature of Applicant’s retail store services featuring “**fresh** fruits and vegetables” and the high tech, fast-paced environment in which many consumers live. Indeed, Applicant acknowledges that its marks are “written in a modern, text-like way without vowels.”⁹

Similarly, many consumers are likely to view the “st” superscript as an abbreviation for “street.”¹⁰ Indeed, Applicant recognizes that “[t]he stylization of the text in Applicant’s Mark[s], specifically as to the modern, sans-serif font and the last two letters ‘ST’ appearing in superscript, reinforces the commercial impression of Applicant’s Mark[s] as a street sign for a fast thoroughfare.”¹¹ This is particularly



true with respect to Applicant’s mark as the literal element is encompassed within a “street sign design.”

For these reasons, we find that Applicant’s mark is likely to be perceived as equivalent to the first two words in the cited mark. This is significant because “it is

⁸ “Disemvoweling” is the practice of “remov[ing] the vowels from (a word in a text message, email, etc) in order to abbreviate it.” June 19, 2020 Final Office Action, TSDR 6 (definition of “disemvowel” from Dictionary.com, <https://www.dictionary.com/browse/disemvowel>).

⁹ ’478 Appl., May 26, 2020 Office Action Response, TSDR 11; ’297 Appl., May 26, 2020 Office Action Response, TSDR 11.

¹⁰ June 19, 2020 Final Office Action, TSDR 8 (American Heritage Dictionary definition of “St.”, <https://www.ahdictionary.com/word/search/html?Q=ST>); *see also id.* at TSDR 9-13.

¹¹ ’478 Appl., May 26, 2020 Office Action Response, TSDR 11; ’297 Appl., May 26, 2020 Office Action Response, TSDR 11.

often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered[.]” *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895 (TTAB 1988). Moreover, a likelihood of confusion is often found where, as here, the entirety of one mark, or its phonetic equivalent, is incorporated within another. *See, e.g. In re South Bend Toy Mfg. Co.*, 218 USPQ 479, 480 (TTAB 1983) (LIL’ LADY BUGGY for toy doll carriages and LITTLE LADY for doll clothing); *Johnson Publ’g Co. v. Int’l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); *In re Strathmore Prods., Inc.*, 136 USPQ 81, 82 (TTAB 1962) (GLISTEN and GLISS’N phonetic equivalents with the same meaning since GLISS’N is a contraction of GLISTEN).

With respect to the appearance of the marks, Applicant argues: (1) “[t]he unique, abbreviated spelling of [Applicant’s] Mark[s] is what consumers are likely to remember and easily distinguishes [Applicant’s marks] from the cited mark; (2) that because Applicant’s marks are “missing vowels,” the marks are “shorter by eleven (11) letters” than the cited mark; (3) the cited mark is comprised of three words while Applicant’s marks are one word; and (4) Applicant’s marks “visually are strikingly different” because of the superscript letters “st” in Applicant’s mark.

We do not find the spelling of Applicant’s marks particularly unique. Applicant has merely dropped the vowel from the word “fresh” and deleted the space between “fresh” and the abbreviation “st”. As explained above, a substantial group of consumers are likely to readily perceive Applicant’s marks as “FRESH STREET” and will not focus on the differences between the number of letters in the marks. *See Fuji*

Jyukogyo K.K v. Toyota Jidosha K.K., 228 USPQ 672, 674 (TTAB 1985) (“Purchasers do not count letters when reacting to trademarks in the marketplace.”); *Am. B.D. Co. v. N.P. Beverages, Inc.*, 213 USPQ 387, 388 (TTAB 1981) (“Purchasers are not expected to, and do not, count the number of letters which marks have in common.”).

We do not ignore the final word SQUARE in the cited mark when comparing the marks as a whole, but note that “the presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical,” particularly where, as here, one mark incorporates the phonetic equivalent of the other. *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (finding a likelihood of confusion between the marks ML and ML MARK LEES both for personal care products); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE for women’s clothing stores and women’s clothing likely to cause confusion with CREST CAREER IMAGES for uniforms including items of women’s clothing). We also keep in mind that consumers have a propensity to shorten marks and so may drop the word “square” when calling for or referring to the registrant’s services. *See, e.g. In re Aquitaine Wine*, 126 USPQ2d 1181, 1188 (TTAB 2018) (“[C]onsumers often have a propensity to shorten marks”); *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1961 (TTAB 2016) (consumers may drop the highly descriptive term ‘Blonde’ when calling for TIME TRAVELER BLONDE beer) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring) (“[T]he users of language have a universal habit of shortening full names—from haste or laziness or just economy of words[.]”)); *Spoons Rests. Inc. v.*

Morrison Inc., 23 USPQ2d 1735, 1740-41 (TTAB 1991) (customers have a propensity to shorten trademarks); *Big M. Inc. v. U.S. Shoe Corp.*, 228 USPQ 614, 616 (TTAB 1985) (“[W]e cannot ignore the propensity of consumers to often shorten trademarks[.]”). Indeed, a purchaser who sees Applicant’s marks and later encounters the cited mark, or vice versa, is likely to think that Applicant’s marks are an abbreviated version of the cited mark, especially because the marks identify overlapping and highly related services, as discussed below. *See Mighty Leaf Tea*, 94 USPQ2d at 1260 (“ML is likely to be perceived as a shortened version of ML MARK LEES when used on the same or closely related skin care products.”).

We further note that the cited mark is in standard characters so it is not limited in manner of display or font. *See, e.g., In re Viterro Inc.*, 101 USPQ2d at 1909 (“[T]o the extent the Board simply held that a standard character mark is not limited to any particular font, size, style or color, it is entirely consistent with our case law, the relevant regulations, and the TMEP.”). Accordingly, we must presume that the registrant could display its mark in a stylization similar to the literal portions of Applicant’s mark, including setting out the word “street” in superscript similar to the letters “st” in Applicant’s marks. *Aquitaine Wine USA*, 126 USPQ2d at 1186 (“Since Registrant’s mark is a standard character mark, we must consider that the literal elements of the mark (the words and the letters) may be presented in any font style, size or color, including the same font, size and color as the literal portions of Applicant’s mark. This is because the rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color.”)

(citing *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011)).

Applicant also argues that the additional word “square” in the cited mark creates a different connotation evoking “imagery of a fresh farmer’s market in a town square.”¹² The word “square,” however, is defined as “an open place or area formed at the meeting of two or more streets,”¹³ and therefore, reinforces the word “street” in the cited mark. Accordingly, we find that the marks engender similar overall commercial impressions.

In view of the foregoing, we find that the marks are overall very similar in sound, connotation, and commercial impression, and these similarities outweigh any differences between the marks in appearance. Accordingly, the first *DuPont* factor weighs in favor of finding a likelihood of confusion.

B. Relatedness of the Services, Trade Channels and Classes of Consumers

Under the second *DuPont* factor we consider “[t]he similarity or dissimilarity and nature of the goods or services” and under the third *DuPont* factor we consider “the similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018). We must base our comparison of the services and trade

¹² Appeal Brief, 8 TTABVue 11.

¹³ We take judicial notice of this definition, Merriam-Webster Dictionary, <https://www.merriam-webster.com/dictionary/square> (last visited January 3, 2022). *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006) (“As a general rule, the Board may take judicial notice of dictionary evidence.”).

channels on the identifications of services in the involved applications and cited registration. *See Stone Lion Capital*, 110 USPQ2d at 1162 (Fed. Cir. 2014); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The services need not be identical or directly competitive for there to be a likelihood of confusion, but the evidence must establish that the services are related in some manner, or the conditions surrounding their marketing are such, that they would be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the services come from a common source. *Coach Servs.*, 101 USPQ2d at 1722; *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re Rexel, Inc.*, 223 USPQ 830, 831 (TTAB 1984). The issue is not whether consumers would confuse the services, but rather whether there is a likelihood of confusion as to the source of the services. *See, e.g., Giersch*, 90 USPQ2d at 1026. It is sufficient for a finding of likelihood of confusion if relatedness is established for any good or service encompassed within the identification in a particular class. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *6 (TTAB 2019); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126, n.5 (TTAB 2015).

Applicant argues that because it “has expressly excluded ‘supermarkets’ from the description of its services ... there expressly is ***no overlap*** between the described

services.”¹⁴ More specifically, Applicant contends that a supermarket is a large-scale store featuring “a wide variety of both food and household items,” and therefore, “does not encompass the small-scale convenience food and beverage kiosk or retail services of [Applicant.]”¹⁵ We disagree. Applicant’s “retail store services featuring fresh fruits and vegetables, sandwiches, wraps, baked goods, salads, snacks, entrees, prepared meals, dips, hummus, soups and yogurts” are a subset of the registrant’s broader “supermarkets,” which are “large self-service retail market[s] that sell[] food and household goods.”¹⁶ *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”). Accordingly, even though Applicant has excluded “supermarket” services per se from its identifications, Applicant’s services overlap with the registrant’s services to the extent both encompass the retail sale of food. That Applicant offers more limited food items in a smaller retail space than a traditional supermarket does not negate the overlap in the services.

¹⁴ Reply Brief, 11 TTABVUE 8-9.

¹⁵ Appeal Brief, 8 TTABVUE 13-14.

¹⁶ November 26, 2019 Office Action, TSDR 5, THE AMERICAN HERITAGE DICTIONARY definition for “supermarket.” *See also id.* at TSDR 6-7, definitions for “supermarket” in MERRIAM-WEBSTER DICTIONARY and COLLINS DICTIONARY.

In addition to the overlap, the services are highly related. The Examining Attorney submitted eight third-party use-based registrations for marks covering both “supermarkets”¹⁷ and food kiosk services:¹⁸

- Reg. No. 3616756 – ANYTHING FRESHER STILL SWIMS for “food kiosk services” and “supermarkets”;
- Reg. No. 3862905 – GOOD FOOD FOR ALL for “food kiosk service” and retail grocery stores”;



- Reg. No. 4878188 –  for “supermarket ... store services” and “food kiosk services”;
- Reg. No. 5418504 – PIER A for “supermarket ... store services” and “food kiosk services”;
- Reg. No. 5028243 – GRISINI MARKET for “retail grocery services” and “food kiosk stall services”;
- Reg. No. 5026213 – EAGLE MOBILE GROCERY for “mobile food kiosk services” and “retail grocery stores”;

¹⁷ Some registrations cover “grocery stores,” which are “supermarkets.” MERRIAM-WEBSTER DICTIONARY, <https://www.merriam-webster.com/dictionary/grocery%20store> (last visited January 3, 2022).

¹⁸ January 19, 2021 Denial of Request for Reconsideration, TSDR 36-58.



- Reg. No. 5297423 – for “food kiosk services” and “retail grocery stores; supermarkets”; and
- Reg. No. 5830903 – IMPERO ITALIANO for “food kiosk services” and “supermarkets.”

A ninth third party registration, Reg. No. 2429626 for the mark JAVA STREET and design, covers “retail kiosk services, namely, a section within a retail supermarket[.]”¹⁹

While the third-party registrations are not evidence that the registered marks are in use or that the public is familiar with them, they support the Examining Attorney’s position that Applicant’s and the registrant’s services are likely to emanate from a common source.²⁰ *See, e.g., In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018) (citing *In re Infinity Broad. Corp.*, 60 USPQ2d at 1217-18); *In re Anderson*, 101 USPQ2d 1912, 1919-20 (TTAB 2012) (third-party registrations covering goods or services of both applicant and registrant probative of relatedness); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (same); *In re Albert Trostel*, 29 USPQ2d at 1785-86 (same).

¹⁹ June 19, 2020 Final Office Action, TSDR at 34-35.

²⁰ Applicant asserts that some of the third-party registrations should not be considered because they include a “laundry list of goods and/or services.” Appeal Brief, 8 TTABVUE 15-16. Although third-party registrations covering disparate goods or services may be diminished in probative value, here, nearly all of the services covered by the registrations relate to providing and distributing food, beverages and household items, and therefore, are persuasive.

In an effort to demonstrate that Applicant's and the registrant's services are not related, Applicant submitted forty-seven use-based registrations for marks that identify "registrant's 'supermarket' services, but do not include [Applicant's] kiosk services."²¹ This evidence, however, has limited probative value. As the Board has explained:

There is no requirement for goods [or services] to be found related that all or even a majority of the sources of one product [or service] must also be sources of the other product [or service]. Therefore, evidence showing only that the source of one product [or service] may not be the source of another product [or service] does not aid applicant in its attempt to rebut the evidence of the examining attorney. [In addition], the mere fact that some goods [or services] are not included in a registration's identification of goods [or services] does not establish that *the owner of the mark* has not registered the mark for those goods [or services] in another registration since, for example, the registrant may have begun using the mark on those goods [or services] at a later date.

In re G.B.I. Tile & Stone, Inc., 92 USPQ2d 1366, 1369-70 (TTAB 2009) (distinguishing between third-party registrations that cover the products or services of only an applicant or registrant from evidence showing that the Office has registered the same mark to different parties for the goods or services at issue). Applicant's evidence simply does not rebut the third-party registrations the Examining Attorney submitted or the fact that Applicant's and the registrant's services are inherently related as both involve the retail sale of food.

As further evidence of relatedness, the Examining Attorney submitted a number of articles suggesting that consumers are likely to encounter food and beverage kiosks

²¹ Appeal Brief, 8 TTABVUE 15 (citing May 26, 2020 Response to Office Action, TSDR 20-115).

in supermarkets such that consumers may mistakenly believe that Applicant's food and beverage kiosks are somehow related to or are an extension of the registrant's supermarket business. Pertinent excerpts from these articles are below:

- KIOSK MARKETPLACE: *Amazon's Whole Foods Market acquisition points to a changing role for physical stores; millennials hold the key* (June 20, 2017): "Amazon and others have recognized that technology has enabled an 'endless aisle' that integrates warehoused goods that consumers can access online and at stores and pickup kiosks.... [Whole Foods] has even harnessed self-serve kiosks in merchandising specialty food ingredients in pursuit of millennial shoppers. A kiosk provided by Baldor Specialty Goods, a fresh produce distributor in the Northeast and Mid Atlantic makes the selection of unique culinary items available to home cooks. ... [Amazon] has since invested in grocery pickup kiosks in Seattle[.]”²²
- MARKETPLACE, *Deal between sushi giants highlights grocerant trend* (July 3, 2019): "The London-based sushi chain, YO! Sushi, is planning to buy [SnowFox] one of the largest operators of sushi kiosks in the U.S.... SnowFox ... operates around 700 mini sushi joints, typically in grocery stores. The deal offers further evidence that the market for prepared foods in grocery stores is heating up.... Just take a trip to the Fresno Y Más supermarket in Orlando, Florida, which sells your standard grocery items. On a recent weekday, however, Shannon Velez was walking out with two big bags of hot empanadas from the prepared food section.”²³
- EAT THIS, NOT THAT!: *5 Surprising New Things You'll See at Popular Grocery Stores Soon* (June 22, 2020): "Self-serve food bars have become a somewhat ubiquitous feature at most large-scale and high-end supermarkets. According to a CNBC Report, offering up pre-made coleslaw or a full rotisserie chicken became a regular grocery store staple in the early 1990s.... Yes, grocery stores are going to start employing robots! Or, automated food preparation kiosks.”²⁴
- Ailatech.com/blog/deli-kiosks-supermarkets-slicing-lines/ (August 20, 2019) promoting Aila deli kiosk solutions: "[G]rocers can offset long lines with self-checkout kiosks during peak times of the day. ... Deli ordering kiosks are deceptively simple from a shopper's perspective. ... In just

²² June 19, 2020 Final Office Action, TSDR at 22-25.

²³ January 19, 2021 Denial of Request for Reconsideration, TSDR at 11-12.

²⁴ *Id.* at 13-18.

seconds, the customer places their order, receives personalized offers and/or recommendations and can continue shopping.”²⁵

- CStoreDecisions.com, *Kiosks Enhance C-Store Offerings* (April 9 2018): “Big box and grocery chains are experimenting with kiosk technology too.”²⁶
- MassLive.com, *Big Y reintroduces self-service kiosks at Western Mass. supermarkets* (October 3, 2019): “The shopper-operated kiosks are not a staple of the retail experience, commonly seen in competitors like Walmart and Stop & Shop, which increased the number of self-service checkouts following a lengthy strike earlier this spring.”²⁷
- SN Supermarket News, *A mini-mart in a vending machine* (August 13, 2019): “The Choice Mini-Market vending program combines quick services, fresh quality food from local vendors and the latest technology in a machines that is kept at the perfect temperature and is stocked with fresh, local snacks, fruit, sandwiches, salads, jerky and more. ... Customers slide a credit card to unlock the door and access the food and drinks inside.”²⁸

The evidence also supports that it is common for supermarkets to offer prepared foods:

- CNN.com, *The rise of ‘grocerants’: Grocery stores that cook you dinner* (December 20, 2019): “For decades, grocery stores have included hot food and salad bars, delis and sandwich stations.”²⁹
- EATER: *The Rise of Grocerant*, (February 17, 2017): And when dining out, more consumers are choosing their local grocery stores over traditional fast food restaurants, the firm showed. As a result, grocers are seeing value in beefing up their prepared food experiences.... Representatives for Whole Foods were quick to clarify to Eater that Whole Foods Market locations have been offering salad bars, hot food and casual dining spaces almost since the store’s inception more than 30 years ago. But [analyst] Lempert distinguishes the traditional kinds of prepared food offerings from the ‘grocerant experience shoppers are seeing more of today.... Essentially the grab-and-go salad bars and prepared food counters are evolving and looking

²⁵ June 19, 2020 Final Office Action, TSDR at 26-28.

²⁶ *Id.* at 29-31.

²⁷ *Id.* at 32-33.

²⁸ *Id.* at 37-40.

²⁹ January 19, 2021 Denial of Request for Reconsideration, TSDR at 24-27.

more like fast-casual restaurant spaces, designed to keep shoppers in the store..... [M]illennials have developed higher expectations for prepared foods at supermarkets.”³⁰

- SN SUPERMARKET NEWS, *16 Trends, innovations and launches in deli and prepared food in 2020* (December 15, 2020): “Swirling from the impact of COVID-10, deli and foodservice departments of supermarkets were forced to pivot in 2020 and find new ways to attract customers. Grab-and-go prepacked meals dominated the deli area[.]”³¹
- PREPARED FOODS: *Prepared Food Trends at Grocery Stores* (December 29, 2017): “Supermarkets embracing prepared foods are experiencing significant growth.”³²
- GE CURRENT, *How is the Grocery Store Footprint Changing?* (undated): “[W]hereas the majority of customers used to make one big trip to the supermarket per week, todays shoppers don’t mind stopping in multiple times a week to pick up fresh ingredients or ready-made food. ... Even traditionally larger grocers like Whole Foods are testing new concepts centered around the smaller store footprint.... The idea is to appeal to those customers who are making several quick shopping trips per week to pick up fresh prepared foods.”³³
- RETAILWIRE, *Giant Food expects big things from a new, mini-grocery store concept* (October 8, 2018): “Giant Food announced plans to introduce a mini-grocery concept for urban markets – Giant Heirloom Market.... Giant Heirloom Market will play up ‘high-quality, fresh, seasonal, and flavor-focused foods and everyday essentials. Features include a produce chef who will prepare veggies and fruit on demand, as well as a focus on local artisanal breads and other local food purveyors, a variety of plant-based foods, sampling and demonstrations.”³⁴
- GROCERY DIVE, *Grocers thinking big with more small format stores* (December 14, 2018): “Stop & Shop announced Friday the opening of a ... small concept store [that] will focus on fresh items, in-store experiences like

³⁰ *Id.* at 5-10.

³¹ *Id.* at 28-29.

³² *Id.* at 31-33.

³³ June 19, 2020 Final Office Action, TSDR at 41-44.

³⁴ *Id.* at 45-48.

brisket, baby back ribs and growlers that can be filled up at a kombucha fountain, and more grab-and-go items.”³⁵

Applicant argues that the articles are “impermissible hearsay” because they “are being offered to prove the truth of the matters asserted within them or to prove the truth of matters asserted by other declarants who are cited within the articles.”³⁶ While the Federal Rules of Evidence apply in inter partes proceedings before the Board, “there is no corresponding evidence rule for ex parte proceedings.” *In re Embiid*, 2021 USPQ2d 577, at *5 n.19 (TTAB 2021) (citing *In re Epstein*, 32 F.2d 1559, 31 USPQ2d 1817, 1821 (Fed. Cir. 1994) (hearsay rule inapplicable in ex parte examination)). The Board generally takes a more permissive stance with respect to the admissibility of evidence in an ex parte proceeding because it is difficult for an Examining Attorney to establish facts without reliance on the type of evidence submitted here. *In re Hudson News Co.*, 39 USPQ2d 1915, 1920 n.10, 1924 n.18 (TTAB 1996), *aff’d mem.*, 114 F.3d 1207 (Fed. Cir. 1997) (recognizing the USPTO’s limited resources and the difficulty for examining attorneys to establish some facts without relying on LexisNexis database evidence); *see also In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996). Although there is a hearsay element to the articles, there is no bias in the evidence which was not prepared for purposes of this case. *Hudson News*, 39 USPQ2d at 1920 n.10 (allowing NEXIS evidence despite hearsay nature); *Broadway Chicken*, 38 USPQ2d at 1565 (considering telephone directory listings, search of the American Business Directory compiled from

³⁵ *Id.* at 49-51.

³⁶ Reply Brief, 11 TTABVUE 10.

telephone directory listings and supplemented by telephone interviews, and Dun & Bradstreet report, despite the hearsay element of the evidence). Even if we consider the articles only for what they say and show on their face, the articles are relevant because they show some degree of consumer exposure to their contents, particularly the article on CNN.com, a mainstream media outlet.

With respect to the third *DuPont* factor, Applicant argues that its kiosks are “standalone” and are not located in supermarkets. As stated, we are bound by the identification of services in the involved application which does not limit Applicant’s kiosks to those that are “standalone.” Applicant has excluded “supermarkets” from its recitations of services but the cited registration does not include any restrictions and the evidence supports that ordinary consumers encounter food and beverage kiosk services in supermarkets.

Applicant attempts to distinguish the class of consumers arguing that its “potential customers are ‘on-the-go’ consumers who are using their kiosk services because they are hungry, while registrant’s customers are typically making a planned trip to the supermarket to purchase provisions that will last an extended period of time.”³⁷ There is, however, no limitation on the class of purchasers in the identifications. Both Applicant’s and the registrant’s services are offered to consumers seeking to purchase food. Moreover, the articles discussed above support that some of these consumers, particularly those living in more urban areas, may

³⁷ Appeal Brief, 8 TTABVue 18.

make frequent and short trips to supermarkets for prepared foods and other food items featured in Applicant's retail store services.

For all of the foregoing reasons, the second and third *DuPont* factors weigh in favor of finding a likelihood of confusion.

II. Conclusion

Applicant's marks **FRSHST** and  are overall very similar to the cited standard character mark FRESH STREET SQUARE, particularly in sound, connotation and commercial impression, and cover overlapping and highly related services offered through highly related trade channels to overlapping classes of consumers. Accordingly, we find that Applicant's marks are likely to cause confusion with the cited mark.

Decision: The refusals to register Applicant's marks under Section 2(d) of the Trademark Act are affirmed.