

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/432463
APPLICANT: ARAMARK Corporation

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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: AVENTURA

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

This is an appeal from the Trademark Examining Attorney's final refusal to register the applicant's intended mark, AVENTURA, because the mark when used in connection with the applicant's services, so resembles the mark AVENTURA PALACE in U.S. Registration No. 2660207 as to be likely to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d).

FACTS

The applicant has applied for registration on the Principal Register of the mark AVENTURA in typed form for "Catering services; restaurants and restaurant services" in International Class 43. The application, filed on July 19, 2002, is based on applicant's use of the mark in commerce under Trademark Act Section 1(a). Registration was refused under Trademark Act Section 2(d) because of Registration No. 2660207 for the mark AVENTURA PALACE for "hotels; resort hotels; boarding houses; tourist homes; restaurants; bar services; night clubs," in International Class 42.^[1] The refusal based on Section 2(d) for Registration No. 2660207 was repeated in a final action (Trademark R. 2.64)

issued February 20, 2004. The applicant filed a timely Notice of Appeal and Request for Reconsideration to the final refusal. The Request for Reconsideration was denied on January 12, 2005. The file was forwarded to the examining attorney for an appeal brief on April 23, 2005.

ISSUE

The sole issue in this appeal is whether the applicant's intended mark, when used in connection with the applicant's services, so resembles the mark shown in U.S. Registration No. 2660207 as to be likely to cause confusion, to cause mistake, or to deceive within the meaning of Section 2(d) of the Trademark Act.

ARGUMENT

1. **Applicant's mark, AVENTURA, and the registered mark, AVENTURA PALACE, are confusingly similar because they contain common word elements and cast the same commercial impression.**

In determining likelihood of confusion, the examining attorney must compare the marks for similarity in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). In this case, the following factors are the most relevant: similarity of the marks, similarity of the services, and similarity of trade channels of the services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999); *In re L.C. Licensing Inc.*, 49 USPQ2d 1379 (TTAB 1998); TMEP §§1207.01 *et seq.*

The marks are very similar. While marks must be considered in their entireties, at the same time it is proper to recognize one feature of a mark as more dominant in creating a commercial impression. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709

(TTAB 1986). While the two marks in the present case are not identical, enough similarity exists between AVENTURA, and the registered mark, AVENTURA PALACE, to cause confusion. The term "AVENTURA" meaning, "adventure" is dominant in both marks, and causes the marks to cast the same commercial impression. [2]

Essentially the applicant has deleted the term "PALACE" from the registered mark. The term "palace" means, "A large, often gaudily ornate building used for entertainment or exhibitions." [3] The term is descriptive in relation to hotels, restaurants and similar services, which can be ornate buildings offering entertainment and exhibitions. The Board has repeatedly found that the deletion or addition of a descriptive or highly suggestive term will not obviate a finding that the marks are confusingly similar. Thus, if the dominant portion of both marks is the same, then confusion may be likely notwithstanding tangential differences. The mere deletion of wording from a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). See *In re Optical Int'l*, 196 USPQ 775 (TTAB 1977) (where applicant filed to register the mark OPTIQUE for optical wear, deletion of the term BOUTIQUE is insufficient to distinguish the mark, *per se*, from the registered mark OPTIQUE BOUTIQUE when used in connection with competing optical wear). In the present case, applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrant's mark.

Both marks contain the terms "AVENTURA" which in its distinct foreign wording makes it especially likely the marks will be confused. When the applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956).

Furthermore, the test of likelihood of confusion is not a side-by-side comparison of the marks. The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not

whether the marks can be distinguished when viewed side-by-side. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

Applicant has also argued that “the crux of the likelihood of confusion inquiry is whether consumers and potential consumers are confused.” (Appl’s Brief at 3). As pointed out in the denial of the Request for Reconsideration, the test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990), and cases cited therein. *See also In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984), wherein the Board stated as follows:

[A]pplicant’s assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and registrant has no chance to be heard (at least in the absence of a consent agreement, which applicant has not submitted in this case). *Id.* at 1026-1027.

2. The services are related such that consumers would believe they originate from the same source.

The second step in determining whether there is a likelihood of confusion is to compare the services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

The applicant insists that the services are different because the registrant operates a “single-location

adult only resort in Cancun, Mexico.” (Appl’s Brief at 1.) As noted in the Final Office action, the recitation of services in the cited registration does not contain any such limiting language, and the examining attorney is constrained by the services as they are described in that registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Since the identification of the registrant’s services is broader than that attributed to it by the applicant, it is presumed that the registration encompasses all services of the type described. It is also noted that the applicant has not in any way narrowed its own services, which also include restaurants. Thus it must be assumed that applicant’s services move in all normal channels of trade and that they are available to all potential customers including those of the registrant. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re Optica International*, 196 USPQ 775 (TTAB 1977); TMEP §1207.01(a)(iii).

Both the applicant and the registrant offer restaurant services, and those services are identical. If the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980); TMEP §1207.01(b).

The applicant also appears to rely heavily on the idea that it provides its catering and restaurant services to stadiums, arenas, and convention centers. But applicant has not noted this limitation in its own recitation of services. ^[4]

Applicant’s catering services are closely related to registrant’s restaurant, hotel, bar and nightclub

services. As the examining attorney pointed out in the final action and the denial of the Request for Reconsideration, catering and restaurant services are closely related and catering services are often offered as an adjunct to restaurant and hotel services.

The examining attorney has provided 14 third party registrations that show the relatedness of these services. While third-party registrations are entitled to little weight on the question of likelihood of confusion, *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983), they can provide evidence that similar goods and services are often offered by the same companies. See, *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 (TTAB 2001), citing *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988).

In addition the examining attorney has provided printouts of advertisements and websites that show that the services are frequently offered to the public by the same entity. Printouts of articles downloaded from the Internet are admissible as evidence of information available to the general public. TMEP §710.01(b). *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1475-76 (TTAB 1999); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370-1 (TTAB 1998). The applicant has not refuted the examining attorney's evidence that the services are likely to be offered in the same channels of trade or encountered by the same consumers other than to assert that its own trade channels are different from those of the registrant, even though the registrant has not limited its trade channels.

It is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the services as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973).

Applicant argues that the purchasers of its services are sophisticated food service providers, and not the general public. The fact that purchasers are sophisticated or knowledgeable in a particular field does not

necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii). An individual food service provider who encountered the registrant's services while on vacation may still associate those services with those of the registrant and confuse them with those of the applicant.

CONCLUSION

Potential consumers familiar with the registrant's AVENTURA PALACE mark for "hotels; resort hotels; boarding houses; tourist homes; restaurants; bar services; night clubs," in International Class 42, who then encounter applicant's AVENTURA mark for "Catering services; restaurants and restaurant services" in International Class 43, are likely to believe that the services originate from the same source. Therefore, the examining attorney respectfully requests that the refusal to register the intended mark on the Principal Register under Trademark Act Section 2(d); 15 U.S.C. Section 1052(d) be affirmed.

Respectfully submitted,

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[1] Several other registrations were cited in the first action, but these citations were withdrawn in the final action and are not at issue in this appeal.

[2] Both the applicant and the registrant have translated this term as "adventure."

[3] *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSCO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved. The examining attorney asks that the Board take judicial notice of the dictionary meaning of the term "PALACE." The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

[4] In the appeal brief applicant stated that it "is willing to amend its identification of services to specify that they are provided to stadiums, arenas and convention centers." (Appl's Brief at 2). Applicant did not actually make such an amendment of record and the examining attorney cannot treat this "offer" as anything other than speculative. Even if applicant were to make such an amendment the examining attorney believes it would not overcome the refusal since the registrant has not limited its own channel of services, and the registrant's services would still encompass those of the applicant.