

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re SKP and Associates, Inc.

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Serial No. 77040558

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John E. Russell of Allmark Trademark for SKP and Associates, Inc.

Leigh A. Lowry<sup>1</sup>, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

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Before Hairston, Cataldo, and Wellington,  
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

On November 9, 2006, SKP and Associates, Inc., applicant, filed an application to register the mark BLACK HORSE (in standard character form) for "sauces, spice blends, dry rubs for meats and fish, marinades, dipping sauces, and glazes for meats and fish" in International Class 30.<sup>2</sup>

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<sup>1</sup> The application was re-assigned to the identified examining attorney after an appeal had been filed.

<sup>2</sup> Application Serial No. 77040558 was filed under Section 1(b) based on an allegation of a bona fide intent to use the mark in commerce.

The examining attorney refused to register the mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a registration for the following mark:



for "bar services; cocktail lounges; restaurants; snack bars" in International Class 42.<sup>3</sup>

After the examining attorney made the refusal final, this appeal followed.<sup>4</sup>

Before we begin our likelihood of confusion analysis, we address the examining attorney's objection to applicant's submission of a list of third-party registrations.<sup>5</sup> Specifically, the examining attorney objects to the lists because of their source (Lexis

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<sup>3</sup> Registration No. 2948345, issued May 10, 2005.

<sup>4</sup> Because the application was re-assigned to the examining attorney identified above after the appeal was filed, the Board granted the examining attorney's request to remand the application file to her for purposes of introducing additional evidence. In an office action (dated May 28, 2009), the examining attorney maintained the refusal to register and attached evidence thereto. The Board then resumed the appeal and allowed applicant time to respond to the office action and the newly-submitted evidence. When that time expired without any word from applicant, the Board reset the examining attorney's time to file her brief.

<sup>5</sup> Attached as exhibits to applicant's response (dated September 24, 2007) to office action and its appeal brief.

commercial database), the format in which they were submitted (by listing them rather than providing USPTO database copies thereof), and their lack of probative value due to several of the identified registrations being based solely on either Section 44 or 66(a) of the Act, i.e., not having any allegations of use in commerce in the United States.

While the examining attorney's objections are normally well-taken, we note that the lists of registrations were first submitted by applicant with its response (dated September 24, 2007) to an office action and then resubmitted with its appeal brief. When first addressing the lists of third-party registrations, the then-assigned examining attorney did not object to the lists at all, but responded by stating:

As to applicant's claim that there are only 22 marks on the Register that list both restaurants and sauces/marinades, the examining attorney respectfully disagrees and notes that applicant's search was too restrictive.

[from office action dated August 5, 2008].

The TBMP provides that "...if the examining attorney discusses the registrations in an Office action or brief, without objecting to them, the registrations will be treated as stipulated into the record." TBMP § 1208.02 (2d ed. rev. 2004), including citation to, *In re Total Quality*

*Group Inc.*, 51 USPQ2d 1474, 1477 n.6 (TTAB 1999) (examining attorney did not object to listing of third-party registrations, and considered registrations as if they were of record) and *In re Dos Padres Inc.*, supra (listings from a commercial trademark search report submitted by applicant during prosecution).

Based on the then-assigned examining attorney's initial treatment of the lists of third-party registrations submitted by applicant, we find them to have been treated as stipulated into the record. Moreover, we find any subsequent objection by the current examining attorney to these lists to have been waived. Accordingly, the objection to the lists of third party registrations is overruled.

Despite our overruling the examining attorney's objection, it is noted that "the Board will not consider more than the information provided by applicant. Thus, if applicant has provided only a list of registrations numbers and/or marks, the list will have very limited probative value." TBMP § 1208.02. In this regard and for the reasons identified by the examining attorney in her brief, we note that there are several shortcomings to the evidentiary value of the lists submitted by applicant. Moreover, whatever probative value there is to applicant's

lists of registrations is weighed in conjunction with the evidence of additional third-party registrations submitted by the examining attorney.

We turn now to the merits of this case.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973).

However, as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods/services at issue and the similarity or dissimilarity of the respective marks in their entireties.

We first consider the marks at issue and, in doing so, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Here, the literal portions of the marks are nearly identical inasmuch as applicant's mark is BLACK HORSE and registrant's mark is the compound term BLACKHORSE. The addition of a black horse design in

registrant's mark does very little to distinguish the two marks because it is merely a pictorial of the literal portions of both marks, i.e., a black horse. Thus the design does not create a different commercial impression or connotation. Furthermore, as has often been stated, the word portions of the marks are more likely to be impressed upon a purchaser's memory and, as such, should be accorded greater weight in determining likelihood of confusion, citing *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); and TMEP §1207.01(c)(ii). Consumers, when calling for or otherwise speaking of either party's goods or services, are very likely to just reference the goods or services by simply "black horse."

In sum, we conclude that the literal portions of the marks are phonetically equivalent and nearly identical in appearance. And, in spite of the horse design in registrant's mark, the marks create the same commercial impression and have the same connotation. Indeed, and as discussed above, because the design of a black horse in registrant's mark is a pictorial representation of the wording in both marks, such design further reinforces the

similarities between them. Accordingly, this *du Pont* factor favors a finding of likelihood of confusion.

We turn now to the relatedness, if any, of registrant's restaurant services<sup>6</sup> to applicant's goods. The goods and services need not be identical, and they obviously are not, to find likelihood of confusion under Section 2(d) of the Trademark Act. Rather, they need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods and services originate from or are associated with the same source. See *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). Furthermore, we must view the goods and services as they are identified in the registration and application. *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods").

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<sup>6</sup> Although registrant's services also include bar, snack bar and cocktail lounge services, our likelihood of confusion analysis focuses on registrant's restaurant services vis-à-vis applicant's goods inasmuch as the evidence and arguments were directed to a connection or lack thereof with respect to these specific services and goods.

Again, the registered mark is for, *inter alia*, restaurant services whereas applicant seeks to register its mark for "sauces, spice blends, dry rubs for meats and fish, marinades, dipping sauces, and glazes for meats and fish."

In deciding how we are to analyze the relatedness of restaurant services and food items, we keep in mind the "something more" precedent that has been set forth by the Board and our primary reviewing court (and its predecessor); that is, in order "[t]o establish likelihood of confusion a party must show *something more* than that similar or even identical marks are used for food products and for restaurant services." *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982) (emphasis added). In other words, we must consider the particular facts of each case and there is no per se rule dictating that restaurant services and food products are related; rather, the case law indicates that "something more" must be present to establish that confusion is likely. *In re Comexa Ltda.*, 60 USPQ2d 1118, 1120 (TTAB 2001) (AMAZON and design for chili sauce and pepper sauce held likely to be confused with AMAZON for restaurant services); see also, *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999) (AZTECA MEXICAN RESTAURANT



for restaurant services held likely to be confused with AZTECA for partially prepared Mexican foods, namely tortillas). *Cf.*, *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003) (Court reversed Board decision finding likelihood of confusion between BLUE MOON with a naturalistic design of woods at night for beer, and BLUE MOON with an art deco design and a moon with a cartoon face for restaurant services); and *Jacobs*, 668 F.2d 1234 (BOSTON TEA PARTY for tea held not likely to be confused with BOSTON SEA PARTY for restaurant services).

In this case, the evidence submitted by the examining attorney demonstrates the required "something more" to show that applicant's goods and registrant's restaurant services are related. Specifically, there are numerous (over forty-five) third-party registrations of record showing that a single entity has registered its mark for both restaurant services and the relevant specific type of goods, e.g., sauces, spice rubs, seasonings and marinades. While these registrations are not evidence that the marks are in use or that consumers are familiar with them, they do suggest that the listed goods and services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

In addition, the examining attorney submitted ample

website evidence of advertisements for restaurant services and food items such as sauces, spice rubs, seasonings, etc. under the same mark by a single entity. The website evidence shows that food items bearing the same mark as the restaurant may be sold either directly by the restaurant or through retail food stores. For example, there is a website for the Taco Bell restaurant, [www.tacobell.com](http://www.tacobell.com), advertising their tacos and other Mexican food items and then the website for Safeway food stores, [www.safeway.com](http://www.safeway.com), shows that the supermarket offers "Taco Bell" taco seasoning and sauces. The website for Emeril's restaurants, [www.emerils.com](http://www.emerils.com), not only touts the restaurant services, but also advertises "Emeril's spices" for sale, including burger seasoning, turkey rub, rib rub, barbeque sauces, etc. Another website for the restaurant K-Paul's, [www.kpauls.com](http://www.kpauls.com), does the same thing, i.e., advertises its restaurant services and offers various seasonings and barbeque sauces for sale. The evidence further shows that several other restaurants that may not be so well-known also advertise their "own special" sauces or rubs.

Taken together, the evidence satisfies the "something more" requirement by not only showing that restaurants also sell individual food items under the same mark, but that the specific food items identified in the application are

of the type, e.g., spices, seasonings, rubs, sauces, etc., that restaurants sell.

We therefore find that applicant's goods and registrant's restaurant services are related, and that this *du Pont* factor favors a finding of likelihood of confusion.

As to the channels of trade and classes of purchasers, applicant asserts that the registered mark and registrant's services "solely target the members of the 'Blackhorse Golf Club.'" Brief, p. 7. In essence, applicant argues that registrant's use of its mark is limited to the members of a golf club. With respect to its own goods, applicant argues that their "advertising and marketing efforts are solely directed to...high end retailers." *Id.* at 8. Applicant submitted evidence in support of these assertions.

The problem with applicant's aforementioned arguments and supporting evidence is that neither registrant's recitation of services nor applicant's identification goods are limited to any certain trade channels or classes of purchasers. It is also well-established and oft-stated that the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the services recited in the cited registration, rather than what the evidence shows the goods and/or services to be. See *Canadian Imperial*

*Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *In re William Hodges & Co., Inc.*, 190 USPQ 47 (TTAB 1976). This is because the presumptions afforded a registration under Section 7(b) of the Trademark Act extend to the goods or services as disclosed therein, and include a presumption of use on all goods or services encompassed by said description. See *Burger Chef Systems, Inc. v. Sandwich Chef, Inc.*, 201 USPQ 611 (TTAB 1978), *aff'd* 608 F.2d 895, 203 USPQ 733 (CCPA 1979).

We must therefore deem that applicant's goods can be sold and registrant's restaurant services will be offered in all appropriate channels for goods and services of those types. See *In re Davis-Cleaver Produce Company*, 197 USPQ 248 (TTAB 1977). This would mean that applicant's goods may be sold in regular retail supermarkets and other food stores, but, as shown by the evidence, such goods may also be sold directly by restaurants. Likewise, although restaurant services would be offered through different venues from the goods, the registration's restaurant services are not restricted to a country club environment or being offered to only club members. Rather, the same classes of consumers will encounter both the goods and the services. That is, the identified food items and

restaurant services are consumer goods and services, and will be offered to the general public. Moreover, applicant's identified goods are sauces, spice rubs and seasonings which can be relatively inexpensive, and purchased on impulse and without care. Likewise, restaurant services may reasonably include fast food and other inexpensive restaurants.

For these reasons, the *du Pont* factors involving channels of trade and classes of purchasers favor a finding of likelihood of confusion.

Applicant also argues that "no one has mistakenly contacted applicant seeking registrant's 'restaurant services'" and that "there exists no evidence of actual confusion." Brief, p. 10. The fact that an applicant in an *ex parte* case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred. See, e.g., *In re Jeep Corporation*, 222 USPQ 333 (TTAB 1984). There is no evidence in the record regarding the extent of use of

either applicant's or registrant's marks; thus we are unable to determine if there has been any meaningful opportunity for confusion to occur in the marketplace. In any event, the test is likelihood of confusion, not actual confusion, and, as often stated, it is unnecessary to show actual confusion in establishing likelihood of confusion. See e.g., *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

Accordingly, the *du Pont* factor involving instances of actual confusion is neutral.

Upon consideration of all the *du Pont* factors on which there is evidence or argument, we find that applicant's use of the mark BLACK HORSE for "sauces, spice blends, dry rubs for meats and fish, marinades, dipping sauces, and glazes for meats and fish" is likely to cause confusion with the registered mark BLACKHORSE (and design) for restaurant services.

**Decision:** The examining attorney's refusal to register under Section 2(d) is affirmed.