

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

Mailed:
November 3, 2011
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gabriel Miller & Jason Miller

Serial No. 77855808

Neal E. Friedman of Davis & Bujold PLLC for Gabriel Miller & Jason Miller.

Meghan Reinhart, Trademark Examining Attorney, Law Office
108 (Andrew Lawrence, Managing Attorney).

Before Bucher, Zervas and Taylor, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Gabriel Miller and Jason Miller, both U.S. citizens and residents of York, Maine, seek registration on the Principal Register of the mark **ST. JOE'S COFFEE** (*in standard character format*) for goods identified in the application, as amended, as follows:

"coffee; tea; tea blends; decaffeinated coffee; hot chocolate; coffee-based beverages, namely, café mochas and café au laits; prepared espresso and espresso-based beverages, namely, lattes, mochas, Americanos and cappuccinos; iced drinks, namely, iced coffee; frozen drinks, namely, frozen mochas, frozen lattes, frozen coffee; frozen drinks, namely, ice blended drinks, namely, iced coffee; hot drinks, namely, coffee based beverages; baked goods, namely, bakery goods; bakery goods, namely, buttermilk bars, muffins, scones, biscuits, donuts, biscotti;

fried dough with powdered sugar, namely, beignet, zeppola" in International Class 30; and

"smoothies; iced drinks, namely, iced fruit beverages; Italian sodas; frozen drinks, namely, ice blended fruit drinks" in Int. Class 32.¹

The Trademark Examining Attorney issued a final refusal to register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has taken the position that applicant's mark, when used in connection with the identified goods, so resembles the mark, **ST JOE**, registered for services recited as "concierge services; resort hotels; hotels; hotel services for preferred customers; hotel concierge services; and restaurant and dining services" in International Class 42,² as to be likely to cause confusion, to cause mistake or to deceive.

After the Trademark Examining Attorney made the refusal final, applicant appealed to this Board. Applicant and the Trademark Examining Attorney have fully briefed the issues in this appeal.

We affirm the refusal to register.

¹ Application Serial No. 77855808 was filed on October 23, 2009 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. No claim is made to the exclusive right to use the word "Coffee" apart from the mark as shown.

² Registration No. 2709617 issued on April 22, 2003; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

Arguments of applicant and the Trademark Examining Attorney

In urging registrability, applicant contends that the cited mark is weak, that the respective marks are sufficiently distinguishable to avoid confusion, and that the evidence made of record by the Trademark Examining Attorney is insufficient to show the "something more" required in this case because, especially in light of the weak marks, the Office has failed to demonstrate a special relationship between restaurant/dining services, on the one hand, and beverages, pastries, etc., on the other hand.

By contrast, the Trademark Examining Attorney argues that the marks are highly similar, that the cited mark has not been shown to be weak, and that the weight of the evidence in this record supports the relatedness of applicant's types of food products to registrant's types of restaurant and dining services to meet the stated test of "something more" required of the Office.

Likelihood of Confusion

We turn then to a consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on this issue. See *In re E. I. du Pont de Nemours & Co.*,

476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the relationship between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The Similarity of the Marks

As to the first *du Pont* factor in any likelihood of confusion determination, we compare the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Because the similarity or dissimilarity of the marks is determined based upon a comparison of the marks in their entireties, applicant is correct that the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based upon the entire marks, not just select parts of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed.

Cir. 1985); see also *Franklin Mint Corp. V. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 23, 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"]. On the other hand, different features may be analyzed to determine whether the marks are similar. *Price Candy Company v. Gold Medal Candy Corporation*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). In fact, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 224 USPQ at 751.

In the case at hand, we find specifically that the leading term in applicant's mark ("St. Joe's") and the sole term in registrant's mark ("St. Joe") comprise the dominant elements of both marks because most consumers would use "St. Joe's"/ "St. Joe" to call for the respective goods and services. The word "Coffee" in applicant's mark is a generic or highly-descriptive term containing informational matter that has been correctly disclaimed apart from the marks as shown. Hence, we accord less weight to this particular feature, although our ultimate conclusion rests upon a consideration of the marks in their entireties.

Hence, we find that this critical *du Pont* factor supports a likelihood of confusion herein.

Strength of the cited mark

Applicant argues that "Joe and Joe formatives are in sufficiently common use for restaurant and dining services and the like that the 'purchasing public is able to distinguish between those businesses on small distinctions among the marks.'" Applicant's appeal brief at 7-8. However, we agree with the Trademark Examining Attorney that most of the evidence of restaurant trade names that applicant drew from an Internet search engine contained only the term "JOE," not "ST JOE." In fact, based upon this record, we cannot find that "St. Joe" is weak for restaurants or dining services. To the extent that the term "Joe" is construed to mean "coffee" within the "St. Joe" term, we presume it will be equally likely with either mark. Accordingly, at best for applicant, this is a neutral factor.

Relationship of the Services/Goods

We turn next to the *du Pont* factor focused on the relationship of the services and goods involved herein. The Trademark Examining Attorney correctly points to a series of decisions where the Board and our primary reviewing Court

have found a relationship between food and beverage products and food-related services. However, applicant argues that the Trademark Examining Attorney has failed to show "something more" than that similar or even identical marks are used for food products and for restaurant services in order to establish the relatedness of food and beverage items to restaurant services. See *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1064 (Fed. Cir. 2003). While there clearly is no *per se* rule that food and beverage items are related to restaurant services, we find that the Trademark Examining Attorney has carefully established *something more* in this record. For example, she has shown a close relationship between coffee and restaurant services with some of the largest franchise operations in the country:



► Shop Online

Coffee

Tea

DD Merchandise

Coffee Equipment

Fill & Bake

Dunkin' Donuts is the world's leading baked goods and coffee chain, serving more than 3 million customers per day. Dunkin' Donuts sells 52 varieties of donuts and more than a dozen coffee beverages as well as an array of bagels, breakfast sandwiches and other baked goods.

³ <http://www.dunkindonuts.com/>



COFFEE
Beans Blends Brewing

MENU
Drinks Food Nutrition

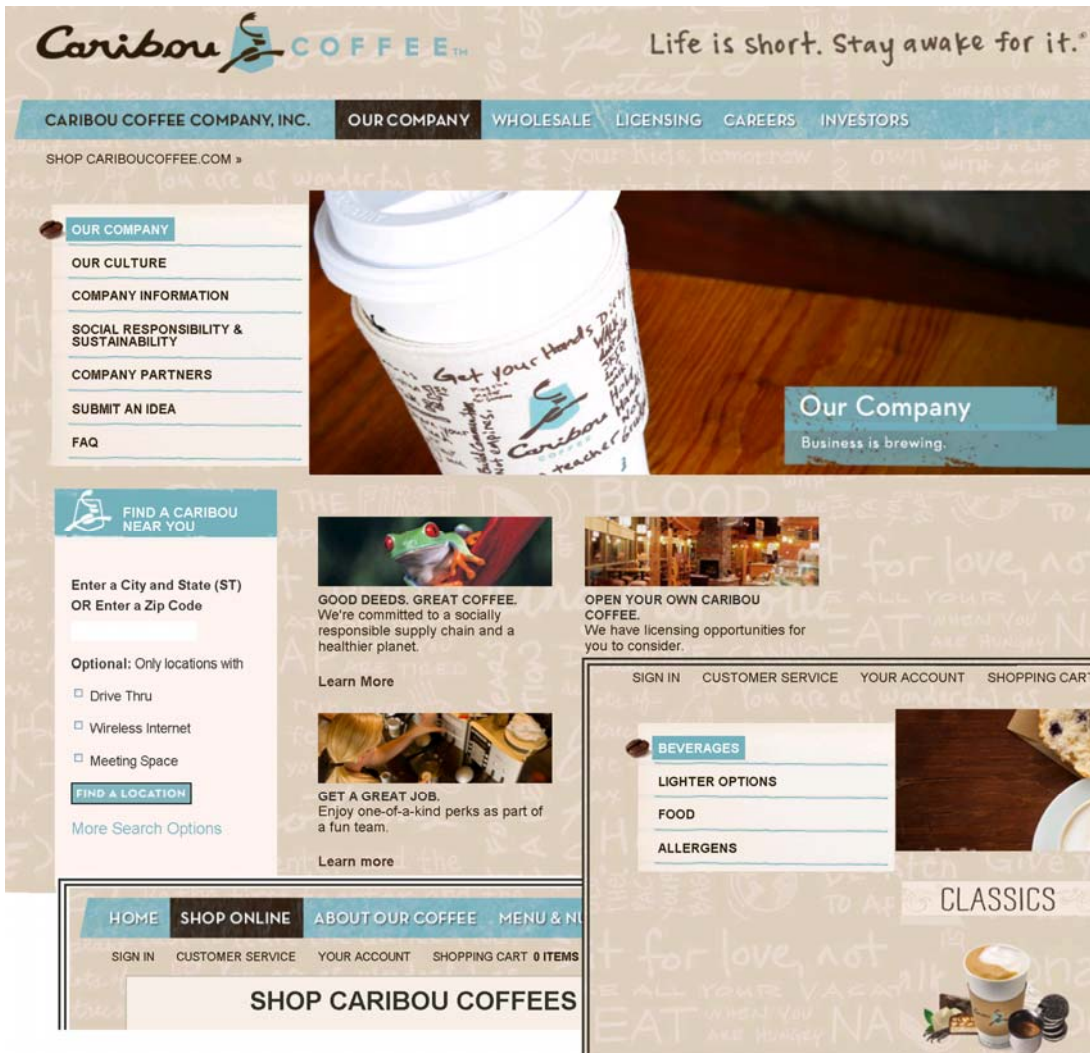
COFFEEHOUSE
Music Wi-Fi Community

RESPONSIBILITY
Ethical Local Global

CARD
Register Reload Rewards

SHOP
Search Compare Buy

4



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This same relationship is shown between other beverages and food items, and restaurant services:

4 <http://www.starbucks.com/>

5 <http://www.cariboucoffee.com/>



BUSINESS MODELS

Check out our stunning variety of business models!

Retail Stores

- Stand Alone
- Drive Through
- In Line...

Kiosks (Boxed, 3-4 Wall Buildout)

- Shopping Malls
- Multi-tenant office buildings
- Hospitals
- College campus
- Health Clubs
- Airports...

Ka'anapali Carts & Event Trailers (Mobile Units)

- Ballparks / Stadiums
- Convention Centers
- Zoo / Theme Parks
- Race Tracks
- Air Shows
- Fairs and Festivals
- High School sporting events
- Street Festivals

6

Become a College Hill Coffee Co. Frequent Buyer!



Buy 10 lbs. of whole bean coffee and get one lb. FREE!

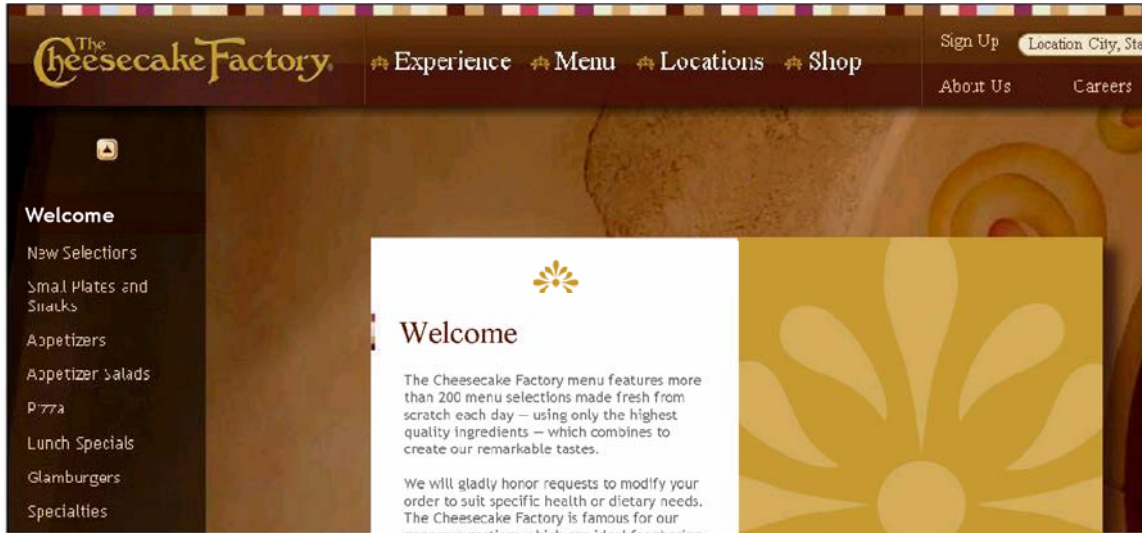


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6 <http://www.mauiwowi.com/>

7 <http://www.collegehillcoffeeco.com/>

The Trademark Examining Attorney also demonstrated the relationship between various pastries / bakery items and restaurant services:



8 <http://www.thecheesecakefactory.com/>

9 <http://www.cocosbakery.com/>



The Cupcakery Dallas website features a pink and white color scheme. The logo is a circular emblem with a cupcake and the text 'The Cupcakery' and 'www.thecupcakery.com'. The navigation menu includes Home, Locations, Favorites, Ordering, Our Story, Press, and Contact Us. The main content area has several paragraphs of text describing the bakery's offerings and services. A large image of a red velvet cupcake with white frosting and orange sprinkles is featured on the right. A small inset image shows the interior of the bakery. A 'facebook' button is visible. A banner at the bottom right says 'on.line ordering.g' and 'The Cupcakery Does Not Deliver On Sundays.'.

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- The Menu
- Our Grilled Stickies
- The Diner's History
- Home



THE DINER

State College, PA

126. W. College Ave.
814-238-5590

Home of the Grilled Sticky!

A Penn State Tradition Since 1929

We're glad you could stop by. How many in your party? Fine. Smoking or Non-Smoking? Frames or No-Frames?

Feel free to look over our menu, and your waitress will be right with you. We're having a special today. Grilled Sticky cinnamon roll a la mode and a cup of coffee for \$1.99. Just print out the coupon you see below.



[BUY Stickies On-Line at shop.statecollege.com.](http://shop.statecollege.com)

How to Grill Stickies

Spread about a half a teaspoon of butter on each "cut" side of the sticky.
Place in a preheated skillet over medium heat (275 degrees) and cook about 2-3 minutes on a side or until golden brown.
Caution: Do NOT put "sticky" side down as it will burn the sugar.

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<http://www.thecupcakery.com/>



Minnesota's Famous
HALF WAY STOP!



Caramel Rolls

Call (320) 384-7394 to Order!



Caramel Rolls

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In addition, the Trademark Examining Attorney placed into the record copies of printouts showing third-party registrations of marks listing both hotel, dining and/or restaurant services and coffee, coffee-based beverages, hot chocolate, espresso, bakery goods, fruit drinks, smoothies and/or Italian sodas. *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP § 1207.01(d)(iii).

A KEY WEST TRADITION¹³



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¹¹ <http://www.thediner.statecollege.com/>




¹² <http://www.tobies.com/>

¹³ Registration No. 2613989 issued on September 3, 2002; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

¹⁴ Registration No. 3150464 issued on October 3, 2006.

JAVA JOHNNY'S MIDTOWNE CAFE ¹⁵		
 ¹⁶	 ¹⁷	 ¹⁸
MIRAVAL ¹⁹	THE CITY BAKERY ²⁰	
 ²¹	 ²²	
 ²³	 ²⁴	

¹⁵ Registration No. 3410318 issued on April 8, 2008.
¹⁶ Registration No. 3338390 issued on November 20, 2007.
¹⁷ Registration No. 2716503 issued on May 13, 2003; Section 8 affidavit accepted and Section 15 affidavit acknowledged.
¹⁸ Registration No. 3673494 issued on August 25, 2009.
¹⁹ Registration No. 3091643 issued on May 9, 2006.
²⁰ Registration No. 3134672 issued on August 29, 2006.
²¹ Registration No. 2671187 issued on January 7, 2003. Section 8 affidavit accepted and Section 15 affidavit acknowledged.
²² Registration No. 3219326 issued on March 20, 2007.
²³ Registration No. 3460864 issued on July 8, 2008.
²⁴ Registration No. 3009247 issued on October 25, 2005.

 <p>25</p>	 <p>26</p>	 <p>27</p>
<p>BERIYO²⁸</p>	 <p>29</p>	<p>YOVANA³⁰</p>
<p>Juice Box³¹</p>		<p>TOLL HOUSE³²</p>

Accordingly, in the case at hand, we find that applicant's types of food and beverage items are closely related to registrant's type of restaurant and dining services. We find that there is a significant overlap in the respective channels of trade, and that they would be marketed to the same classes of ordinary consumers. These several related *du Pont* factors all favor the position of the Trademark Examining Attorney.

²⁵ Registration No. 3747429 issued on February 9, 2010.

²⁶ Registration No. 3327212 issued on October 30, 2007.

²⁷ Registration No. 3672070 issued on August 25, 2009.

²⁸ Registration No. 3243072 issued on May 15, 2007.

²⁹ Registration No. 3782811 issued on April 27, 2010.

³⁰ Registration No. 3230950 issued on April 17, 2007.

³¹ Registration No. 3141266 issued on September 12, 2006.

³² Registration No. 3234139 issued on April 24, 2007.

In conclusion, when we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that, when potential purchasers of registrant's "restaurant and dining services" encounter applicant's various enumerated food products and beverage items, they are likely to believe that the sources of these services and goods are the same or in some way related or associated. As a result, there is a likelihood of confusion herein.

Decision: The refusal of the Trademark Examining Attorney to register the applied-for mark under Section 2(d) of the Lanham Act is hereby affirmed.