

**THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.**

Mailed: August 29, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fourth Wall Restaurants, LLC

Serial No. 77930437

Alan M. Sack and Scott Greenberg of Locke Lord LLP for
Fourth Wall Restaurants, LLC.

Nicholas K.D. Altree, Trademark Examining Attorney, Law
Office 107 (J. Leslie Bishop, Managing Attorney).

Before Zervas, Wellington, and Kuczma
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Fourth Wall Restaurants, LLC ("applicant") filed an
intent-to-use application under § 1(b) of the Trademark
Act, 15 U.S.C. § 1051(b), for the mark **THE HURRICANE CLUB**,
in standard character form, for "bar and restaurant
services provided in the style and motif of a Polynesian
supper club," as amended, in Class 43. Applicant has
disclaimed the exclusive right to use the word "CLUB."

The examining attorney issued a final refusal to
register the mark pursuant to § 2(d) of the Trademark Act
of 1946, 15 U.S.C. §1052(d), citing Registration Nos.

Serial No. 77930437

3470017 and 3629146, owned by Hurricane AMT, LLC, as a bar to registration.

Registration No. 3470017 is for the mark HURRICANE GRILL and WINGS and Design,¹ shown below, for "restaurant and cocktail lounge services," in Class 43:



The terms "GRILL" and "WINGS" have been disclaimed.

Registration No. 3629146 is for the mark HURRICANE GRILL· WINGS and Design,² shown below, for "restaurant services, cocktail lounges, take-out restaurant services and catering," in Class 43:



¹ Registration No. 3470017, issued July 22, 2008. The Registration contains the following description of the mark: "The color red appears in the design of the flags forming the letter "I" in the word HURRICANE. The color red appears in the outer portions of the two hurricane warning signs; the color black appears in the words 'HURR' and 'CANE', in the inner portions of the two hurricane warning signs, and in the wording 'GRILL and WINGS'." The colors red and black are claimed as a feature of the mark.

² Registration No. 3629146, issued June 2, 2009. The Registration contains the following description of the mark: "The color red appears in the wording 'HURRICANE' and the flag design; the color black appear[s] in the border design element under th[e] term 'HURRICANE', in the palm tree design and in the squares of the flag design; the color white appears in the wording 'WINGS' and 'GRILL' and the outline of the palm tree design." The colors red, white and black are claimed as a feature of the mark.

The terms "GRILL" and "WINGS" have been disclaimed.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. For the reasons set forth below, we affirm the refusal to register.

Likelihood of Confusion

Our determination of likelihood of confusion under § 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In this case, other factors, including the similarity or dissimilarity of trade channels and the number of similar marks in use for similar services, were also argued and considered.

A. The similarity or dissimilarity and nature of the
services, channels of trade and classes of consumers

It is well-settled that the issue of likelihood of confusion between applied for and registered marks must be determined on the basis of the services as they are identified in the involved application and registrations. *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where the recitation of services is broadly constructed as in the cited registrations, we must allow for all possible services that may fall within the recitation, keeping in mind that a likelihood of confusion may be found with respect to a particular class based on any service within the recitation of services for that class. *See In re Wacker Neuson SE*, 97 USPQ2d 1408, 1409 (TTAB 2010) citing *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Registrant's unrestricted "restaurant services" encompass all types of restaurant services, including applicant's "restaurant services provided in the style and motif of a Polynesian supper club." Because applicant's and registrant's services overlap, they are legally identical, and we can presume that they are provided in the same channels of trade and to the same classes of

purchasers at least to the extent they overlap. See *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). See also *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

In view of the foregoing, the *du Pont* factors of the similarity of the services, trade channels and customers favor a finding of likelihood of confusion.

B. The similarity or dissimilarity of the marks as to appearance/sound/connotation and commercial impression

We now turn to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) and *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

In evaluating similarities of marks, if one of the marks comprises both a word and a design, the word is

normally accorded greater weight in determining whether the marks are similar because it would be more likely to be impressed upon a purchaser's memory and used by purchasers to request the services. *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). This principle is especially important in cases involving restaurant services due to the propensity of persons to try restaurants based on word-of-mouth recommendations. *Appetito*, 3 USPQ2d at 1554.

The words "Hurricane," "Grill" and "Wings" present in both of the cited marks are accorded greater weight than the design elements in the cited marks. Although the design portion of the mark shown in Registration No. 3470017 is situated between the terms "Hurr" and "Cane," as explained in the registration, the design functions as the letter "I" to complete the spelling of the word "Hurricane." The design elements in Registration No. 3629146 include an image of a wind-blown palm tree bearing a hurricane warning flag which reinforces the commercial impression of the word "hurricane" contained in the mark. Thus, the design elements of the cited marks reinforce the

word "Hurricane," which is the common element to applicant's mark.

Additionally, the relative size of the word HURRICANE dominates the other words and features in the cited marks. Similarly, the word HURRICANE is prominent in applicant's mark. Although applicant's mark begins with the word "The," the definitive article "the" at the beginning of mark does not generally affect or otherwise diminish the overall similarity between the marks. *See Thor Tech*, 90 USPQ2d at 1635 (the addition of the word "the" at the beginning of the registered mark does not have any trademark significance); and *In re The Place Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005) (the definite article THE and the generic term BAR are not distinctive terms, and add no source-indicating significance to the mark as a whole). The inclusion of the word "THE" in applicant's mark therefore, does not serve to distinguish its mark from the cited marks.

In support of the differences in appearance between applicant's mark and the cited marks, applicant points to arguments made by the registrant's predecessor-in-interest during the prosecution of the applications which matured into the cited registrations.

In overcoming the citation of three third party registrations (for the word marks HURRICANES SPORTS BAR & GRILL and HURRICANE HARRY'S, and a HURRICANES and Design mark), the predecessor-in-interest argued that the red flag design portion in the cited marks were visibly distinctive, forming a "dominate" design.³

The predecessor's arguments are not determinative, and do not "relieve the [Board] of the burden of reaching [its] own ultimate conclusion on the entire record." *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978). In view of the placement and relative size of the red flags in the cited marks, we find them to be subordinate to the dominant word HURRICANE in the cited marks and accordingly, the flags do not serve as a distinguishing feature from applicant's mark.

Given the prominence of the word HURRICANE in the cited marks and applicant's mark, they are similar in appearance and commercial impression. The fact that applicant's mark is presented in standard character form does not avoid likelihood of confusion with the cited

³ See the 11/17/2008 Response "A" to Office Action submitted in connection with Serial No. 76686198 (which matured into cited Registration No. 3629146) attached to applicant's 11/10/2010 Response to Office Action, and the 6/28/2007 Response "A" to Office Action submitted in connection with Serial No. 76663522 (which matured into cited Registration No. 3470017) attached as Exhibit 2 to applicant's Request Upon Remand for Reconsideration.

design marks because applicant's mark could be presented in the same manner of display. *See In re Mighty Tea Leaf*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) and *In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991).

The marks are also similar in sound as the word "hurricane" is located at or near the beginning of the cited marks and applicant's mark.

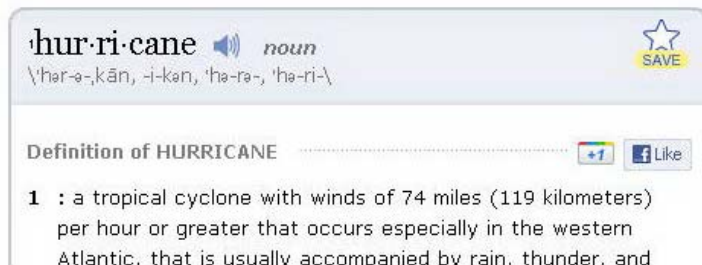
Relying on *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1257 (Fed. Cir. 2011), applicant contends that the word "Hurricane" has different connotations in applicant's mark and the cited marks. In the cited marks, "Hurricane" "connotes the fact that the company [registrant] originates from and is based in the state of Florida, which is strongly associated with Hurricanes and is referred to as 'The Hurricane State.'"⁴ On the other hand according to applicant, because neither applicant nor its services have any connection to Florida, the use of "Hurricane" in conjunction with the other words in applicant's mark, and the identified services, contribute to the connotation of applicant's Polynesian supper club motif.⁵

⁴ See Appeal Brief for Applicant p. 13.

⁵ See Appeal Brief for Applicant p. 14.

Applicant's reliance on *Citigroup* to support its analysis of the different connotations of HURRICANE is misplaced. Contrary to applicant's argument, *Citigroup* does not stand for the proposition that a given term can have a different connotation with respect to one party based on that party's geographic location. Rather, the *Citigroup* court, in considering the impact of a descriptive term on the determination of similarity of marks, observed that the allegedly descriptive term was not a merely descriptive term as it also had geographic connotations ("capital" is not just a financial term, it has geographic connotations and in this case refers to Tallahassee, the capital of Florida).

Unlike the word "capital" in the *Citigroup* case, "hurricane" does not have different connotations. The definition of "Hurricane" submitted by the examining attorney states:



Atlantic, that is usually accompanied by rain, thunder, and lightning, and that sometimes moves into temperate latitudes
— see [BEAUFORT SCALE TABLE](#)

2 : something resembling a [hurricane](#) especially in its turmoil

[See hurricane](#) defined for English-language learners »
[See hurricane](#) defined for kids »

Examples of HURRICANE

- <economic news that unleashed a *hurricane* on the trading floor>

Origin of HURRICANE

Spanish *huracán*, from Taino *huracán*
First Known Use: 1555

<http://www.merriam-webster.com/dictionary/hurricane> 12/06/2011 02:34:50 PM 6

Not surprisingly, the foregoing definition makes no mention of Florida as “The Hurricane State” or otherwise.

In furtherance of its attempt to show the association of the cited marks with Florida, applicant submitted a 2004 online article about Florida’s hurricane season published on the *BBC News* website (news.bbc.co.uk/2/hi/Americas/3695518.stm) entitled “Hurricane state fears more storms,” and the first page of the summary *Google* search results for the phrase

⁶ The examining attorney submitted this definition as an attachment to his Appeal Brief requesting that the Board take judicial notice of the definition. The Board may take judicial notice of online dictionary definitions submitted with an examining attorney’s appeal brief including online dictionaries that exist in printed format or have regular fixed editions. See *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) and *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

"the hurricane state."⁷ A single article referring to Florida as "the hurricane state" carries little weight.

The summary Google search results also have little probative value because they do not show the context in which the term is used on the listed web pages. See *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 967, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) and *In re Thomas Nelson Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011). Additionally, 3 of the 10 listings in the search results do not show use of the term "the hurricane state" and one of the listings appears to be for the *BBC News* article. This meager evidence falls far short of establishing that word "Hurricane" in the cited marks connotes the State of Florida.

In any event, applicant's geographic significance argument fails to account for the possibility that consumers would likewise associate applicant's mark with the State of Florida. That is, any connotation the cited marks may have with the State of Florida due to the inclusion of the word "hurricane" in the marks, could necessarily and equally be attributed to applicant's mark because it also contains the word "hurricane."

When considering the similarity of the marks, the test is not whether the marks can be distinguished when

⁷ See Exhibit C attached to 11/10/2010 Response to Office Action.

subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of overall commercial impression so that confusion as to the source of the services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992).

Applicant contends that when viewed in their entirety, the marks convey two different commercial impressions. The inclusion of the words GRILL and WINGS in the cited marks conveys that the restaurant services provided in connection with these marks feature grilled foods and chicken wings, which conveys a more casual impression. On the other hand, when viewed in conjunction with the description of applicant's services, applicant's THE HURRICANE CLUB mark conveys the impression of a Polynesian "supper club," defined as a luxurious, expensive nightclub.⁸

Applicant's argument overlooks that "Hurricane" is an arbitrary term for restaurants in addition to being the

dominant feature in each mark. The word "Hurricane" used in connection with restaurant services imparts the same commercial impression in each mark i.e., a weather phenomenon involving high winds and rain. In view of the foregoing, that applicant's restaurant services are restricted to those "provided in the style and motif of a Polynesian supper club" is not persuasive. Registrant's restaurant services are unrestricted and consumers encountering the marks will undoubtedly recall the "Hurricane" name based on the marks' commercial impressions of the marks.

In comparing the marks, we are mindful that where, as here, applicant's services are legally identical to registrant's services, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) and *Real Estate One, Inc. v. Real Estate 100 Enterprises Corp.*, 212 USPQ 957, 959 (TTAB 1981). For the reasons set forth above, when considering the marks in their entireties, we find that the similarities outweigh

⁸ Applicant's Reply Brief pp. 3-4. Applicant submitted a dictionary definition of "supper club" with its Reply Brief of

the differences between the marks and that the marks are similar in sound, appearance, meaning and commercial impression.

C. The number and nature of similar marks in use in connection with similar services

Third-party use of the cited mark is evidence of the weakness of the mark and is a separate *du Pont* factor to be considered in determining likelihood of confusion.

du Pont, 177 USPQ at 567. Applicant urges that "Hurricane" is a widely used name in connection with restaurant services and is therefore a weak mark for such services.⁹

In support of its position, applicant submitted a copy of a report from *Dun & Bradstreet's "Dun's Electronic Business Directory"* listing restaurant-type businesses using the term "Hurricane" in the name of the business.¹⁰

which we take judicial notice. See footnote 6 *supra*.

⁹ Appeal Brief for Applicant pp. 9-10.

¹⁰ See Exhibit B to 11/10/2010 Response to Office Action. The entities listed in the *Dun & Bradstreet* report were identified as at least one of the following types of businesses: eating place, fast-food restaurant chain, seafood restaurant, restaurant or sandwiches/submarines.

In response to the examining attorney's criticism of the *Dun & Bradstreet* report raised for the first time in his appeal brief, applicant submitted explanatory pages from *Dun & Bradstreet* regarding the data appearing in its database as Exhibit 2 to its Reply Brief. While the explanatory pages in Exhibit 2 are not timely and have not been considered, the examining attorney's failure to advise applicant of his criticism of that evidence when it was proffered during examination constitutes a waiver of any objection to consideration of the *Dun & Bradstreet* report. Moreover, the Board has recognized the admissibility of *Dun & Bradstreet* reports. See *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996) ("Although there is, of course, a hearsay

After eliminating those entities that are not doing business under a name containing "Hurricane," applicant's *Dun & Bradstreet* report indicates that there are 50 eating establishments that utilize "Hurricane" in their names. Although the search report is clearly not determinative, it is likely that these businesses are more local in nature as the search report identifies many of these as businesses having a "single location."

Assuming the business names shown in the *Dun & Bradstreet* report evidence use of "Hurricane," their probative value is limited because they do not show the public's awareness of the respective businesses, see *Anthony's Pizza & Pasta Int'l Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1278 (TTAB 2009) *aff'd* 415 Fed. Appx. 222 (Fed. Cir. 2010), and fall far short of the persuasive evidence of "numerous" third party uses such as those involved in *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477, 1479 (TTAB 1987); and *In re Broadway*

element to this evidence, there is no bias in the databases, which were not prepared for purposes of this case, but rather are maintained on an ongoing basis for general business use."). Accordingly, we have considered the report for whatever probative value such evidence may have. See *In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012); 37 C.F.R. § 2.142(d).

Chicken Inc., 38 USPQ2d 1559, 1560-62 (TTAB 1996), cited by applicant.¹¹

In *Broadway Chicken*, no likelihood of confusion was found between BROADWAY CHICKEN and BROADWAY PIZZA both for restaurant services, (as well as BROADWAY BAR & PIZZA for restaurant and bar services), largely because of third-party use evidenced by more than 500 "BROADWAY" entities in the *Dun & Bradstreet* database, as well as 80 listings in white/yellow pages, and 575 entities in the American Business Directory, all indicating that they offered restaurant services and/or related goods and services. The evidence in *Steve's Ice Cream* included 226 businesses identified in electronic classified phone directories, 100 of which were verified uses of the name.

Applicant's evidence of third party use falls far short of the level of evidence relied on in the foregoing cases. Accordingly, we are unable to conclude that there is significant third-party use of "Hurricane" marks or trade names in connection with restaurant services such

¹¹ At p. 10 of its Brief, applicant also cites to the Board's decision *In re Rock Creek Cattle Company, Ltd.*, 2009 TTAB LEXIS 419 at *2-*3 and *9-*10, (TTAB 2009) involving Serial No. 77044838, which was designated as "Not a Precedent of the TTAB." While practitioners may cite to such decisions, they are not binding on the Board. Because such cases have no precedential effect, the Board will generally not discuss them in other decisions and we see no reason to do so here. *In re Luxuria*

that the cited marks are weak and entitled to a narrow scope of protection. Therefore, the *du Pont* factor involving the number and nature of similar marks in use in connection with similar services does not favor applicant.

D. Balancing the factors

In view of the fact that the services are legally identical and we may presume they move in the same channels of trade and are provided to the same consumers, and that the marks are similar in appearance, sound, meaning and commercial impression, applicant's mark is likely to cause confusion with the marks shown in Registration Nos. 3470017 and 3629146.

To the extent that there is any doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Binion*, 93 USPQ2d 1531, 1536-37 (TTAB 2009).

Accordingly, the refusal to register under § 2(d) on the ground of likelihood of confusion is affirmed.

Decision: The refusal to register is affirmed.