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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79138995
Applicant	KABUSHIKI KAISHA LAWSON
Applied for Mark	UCHI CAFĀ# SWEETS
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
TRADEMARK TRIAL AND APPEAL BOARD**

APPLICANT:	KABUSHIKI KAISHA LAWSON)	EXAMING	
)	ATTORNEY:	Darryl M. Spruill
)		
SERIAL NO.:	79/138,995)	LAW OFFICE:	112
)		
FILING DATE:	August 30, 2013)	DATE:	March 18, 2015
)		
TRADEMARK:	UCHI CAFÉ SWEETS and Logo)		

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

APPEAL BRIEF

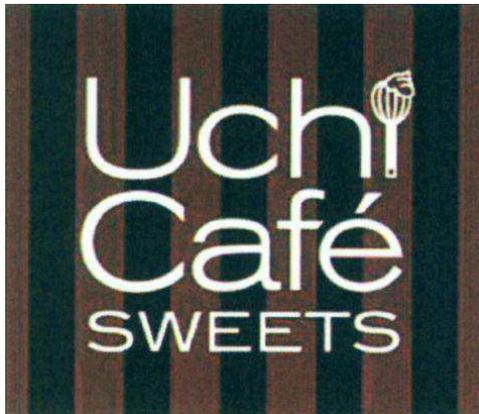
INTRODUCTION

Applicant hereby appeals from the Examiner's final refusal to register the above-identified mark in International Classes 30, 32 and 43, and a portion of the services in International Class 35, dated August 11, 2014, and respectfully requests the Trademark Trial and Appeal Board reverse the Examiner's decision. Accordingly, this Brief is submitted herewith. The Trademark Examining Attorney has found no conflicting marks that would bar registration of the applied for the mark in a portion of the services in International Class 35.

TTAB 1983), (opis Appeal is taken for the Trademark Act Section 2(d) refusal of the applied for mark in International Classes 30, 32 and 43, and the services indicated below in International Class 35.

APPLICANT'S TRADEMARK

Applicant seeks registration on the Principal Register of its mark:



The description of the mark is as follows:

The mark consists of the stylized wording UCHI CAFÉ SWEETS in white colored against a striped background consisting alternating brown and black vertical stripes. The letter "I" in Uchi depicts a whisk with whipped cream on the top and appears above Café, which appears above SWEETS.

The translation of foreign wording is as follows:

The English translation of UCHI in the mark is HOME or HOUSE.

Applicant has submitted the disclaimer:

No claim is made to the exclusive right to use "CAFE" and "SWEETS" apart from the mark as shown.

Applicant's goods and services are as follows:

International Class 30 for "black tea, English tea; coffee; cocoa; confectionery, namely, ice candies, ice cream, frozen confectionery, castilla sponge cakes, tarts, caramels, candies, crackers, sherbets, cream puffs, sponge cakes, chewing gums, chocolate, doughnuts, nougat, biscuits, popcorn and rice crackers; bread; buns; unroasted coffee beans."

International Class 32 for "non-alcoholic carbonated beverages; fruit juices; whey beverages; vegetable juices and beverages."

International Class 35 for (*on appeal*) "retail store services and wholesale store services featuring a variety of goods in each field of clothing, foods and beverages, and living ware, carrying all goods together; retail store services and wholesale store services featuring foods and beverages; retail store services and wholesale store services featuring liquor. retail store services and wholesale store services featuring meat; retail store services and wholesale store services featuring sea food; retail store services and wholesale store services featuring vegetables and fruits; retail store services and wholesale store services featuring confectionery; retail services store services and wholesale store services featuring bread and buns; retail store services and wholesale store services featuring rice and cereals; retail store services and wholesale store services featuring milk; retail store services and wholesale store services featuring carbonated drinks, non-alcoholic and non-alcoholic fruit juice beverages; retail store services and wholesale store services featuring tea, coffee and cocoa; retail store services and wholesale store services featuring processed food,"

and (*not on appeal*) "advertisement and publicity services by television, internet, radio, mail, posters, hanging displays, banners, monitors inside and outside of shops; retail store services and wholesale store services featuring woven fabrics and beddings; retail store services and wholesale store services featuring clothing; retail store services and wholesale store services featuring footwear; retail store services and wholesale store services featuring bags and pouches; retail store services and wholesale store services featuring personal articles in the nature of false nails, false eyelashes, ferrules of metal for canes and walking sticks, shaving cases, pedicure sets, eyelash curlers, manicure sets, ear picks, personal ornaments, jewelry, vanity cases sold empty, umbrellas, walking sticks, canes, metal parts of canes and walking sticks, cane handles, hand fans, pocket mirrors, pocket mirror bags, cosmetic and toilet utensils (other than electric

tooth brushes), woven textile goods for personal use, garters, sock suspenders, braces for clothing (suspenders), waistbands, belts (clothing), armband for holding sleeves, insignias for wear (not of precious metal), buckles for clothing, badges for wear (not of precious metal), brooches for clothing, special sash clips for obi obi-dome, bonnet pins (not of precious metal), ornamental adhesive patches for jackets, brassards, hair ornaments, buttons, false beards, false moustaches, hair curlers (non-electric)."

International Class 43 for "providing foods and beverages."

PRIOR REGISTRATION CITED BY THE EXAMINER

U.S. Registration No. 3,722,422 for the mark "uchi" (stylized) owned by Enso, Ltd., 701 S. Lamar Blvd., Ste. C, Austin, Texas 78704, registered December 8, 2009 in International Class 43 for "cafe-restaurants; carry-out restaurants; hotel, bar and restaurant services; restaurant and bar services; restaurant services; restaurants; self-service restaurants; take-out restaurant services."

RECITATION OF THE FACTS

The instant application was filed August 30, 2013. In a non-final Office Action dated December 25, 2013 applicant was refused registration under Section 2(d) on the basis of U.S. Registration No. 3,722,422, and was required to make amendments to the description of goods and services for clarification, amend the description of the mark, submit an English translation of the word "UCHI" and disclaim the words "CAFÉ" and "SWEETS." Applicant filed a response on June 30, 2014 arguing against the Section 2(d) refusal and making amendments to the description of goods and services for clarification, amending the description of the mark, submitting an English translation of the word "UCHI" as HOME or HOUSE and disclaiming the

words "CAFÉ" and "SWEETS." In the response, applicant submitted in exhibits numerous third party registrations containing the formative HOME and HOUSE in Classes 30, 32, 35 and 43.

The Examining Attorney found applicant's arguments and third-party registrations unpersuasive and issued another Office Action dated August 11, 2014. In this second, final Office Action the Examining Attorney stated with respect to the third-party registrations that previous decisions of examiners allowing other marks are without evidentiary value and are not binding upon the Agency or the Board, and each case must be decided on its own merits, citing *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 639 (TTAB 1984).

Applicant is appealing this Final Refusal Office Action, and filed a Notice of Appeal on January 21, 2015. Applicant submits this Appeal Brief in response to the Final Refusal Office Action dated August 11, 2014.

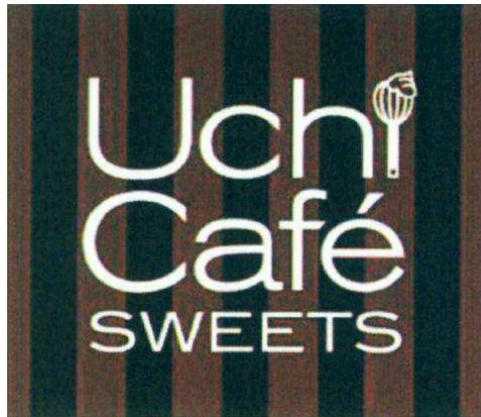
STATEMENT OF THE ISSUES

The issues presented by this appeal are whether applicant's mark is likely to cause confusion under Trademark Act Section 2(d) with U.S. Registration No. 3,722,422 for the mark "uchi" (stylized) for "cafe-restaurants; carry-out restaurants; hotel, bar and restaurant services; restaurant and bar services; restaurant services; restaurants; self-service restaurants; take-out restaurant services" in Class 43.

ARGUMENT

The Trademark Examining Attorney has rejected the application under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) on the grounds that there is a likelihood of confusion with the marks in U.S. Registration No. 3,722,422. Applicant disagrees.

Applicant's application is for the following mark:

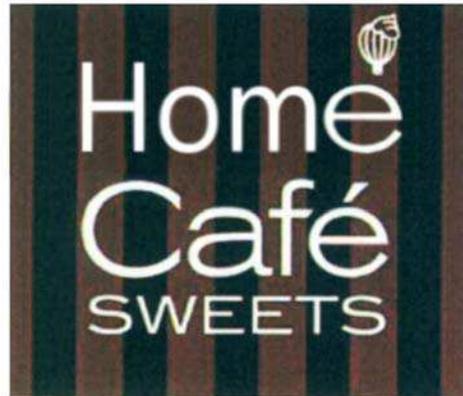


As shown, applicants mark uses white colored letters against a striped background consisting alternating brown and black vertical stripes. The letter "I" in Uchi depicts a whisk with whipped cream on the top and appears above "Café," which appears above "SWEETS."

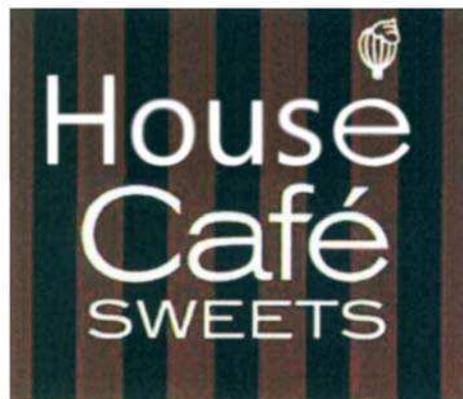
Applicant's recited goods are various foods and beverages in Classes 30 and 32 and services of various food and beverage store services and providing foods and beverages in Classes 35 and 43.

The term "UCHI" in applicant's mark is a Japanese word, and the English translation is "HOME" or "HOUSE." "Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine ... similarity of connotation in order to ascertain confusing similarity with English word marks." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005).

Pursuant to the Doctrine of Foreign Equivalents, applicant's mark is equivalent to:



or



Applicant's mark combines Japanese, French and English words, with a distinctive background logo, to suggest enjoying a relaxing time to enjoy coffee and sweets inside of a home or house.

Applicant's mark stands rejected as being confusingly similar to U.S. Registration No. 3,722,422 for the following stylized mark presented in all lower case letters:

uchi

The services recited in this registration are various restaurant services in Class 43.

Again under the Doctrine of Foreign Equivalents, the cited mark is equivalent to the stylized marks:

home

or

house

The Trademark Examining Attorney's rejection improperly treats "UCHI" as if it were a coined word, instead of the equivalent of "HOME" or "HOUSE." Under the logic of the rejection of applicant's mark, the cited registration for "uchi" (stylized) would appear to foreclose any subsequent applicant from ever obtaining a registration containing the Japanese word "UCHI" for food or beverage related goods or services. Moreover, applying the Doctrine of Foreign Equivalents, no additional registration would ever issue with the English word "home" or "house" for food or beverage related goods or services.

The instant rejection should not be sustained in view of the dissimilarity of the marks in their entireties, the differences in the goods and services, and the dozens of marks registered and

in use that contain the English formative "home" or "house" for food or beverage related goods or services.

Applicant submits that there is no likelihood of confusion under Section 2(d) after taking into account the factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Applicant analyzes relevant *du Pont* factors below:

Similarity or dissimilarity of the marks in their entireties

The *du Pont* case identified this factor to be considered as the "similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *Id.*, 476 F.2d at 1361, 177 USPQ at 567. "That marks must be considered in their entireties in determining whether there is likelihood of confusion or mistake is a basic rule in comparison of marks." *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402, 181 USPQ 272, 273-74 (CCPA 1974) (reversing Board and holding that F.I.T. (stylized) not confusingly similar to FIA and design). In this case, applicant's and registrant's marks are not identical.

In the final office action, the Trademark Examining Attorney has focused only on the common formative "UCHI" and has cited several cases in support. However, in all those cases the similar formatives comprised a much larger portion of both parties' marks. Here, the formative "Uchi" in applicant's mark is only a minor portion of the mark in its entirety, and the formative "UCHI" is a common term meaning "home" or "house" in English.

The Court of Appeals for the Federal Circuit and its predecessor have held that marks must be considered in the way they are perceived by the relevant public, in determining likelihood of confusion. *Opryland USA Inc. v. The Great American Music Show Inc.* 23 USPQ2d 1471, 1473 (Fed. Cir. 1992). Although it is often helpful to analyze marks by

separating them into their component words in order to ascertain which aspects are more or less dominant, such analysis must not contravene law and reason. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). While there are often discrete terms in marks that are more dominant and, thus, more significant to the assessment of similarity, see, e.g., *Opryland USA Inc. v. The Great American Music Show Inc.* 23 USPQ2d 1471, 1473 (Fed. Cir. 1992), the law forbids the type of dissection proposed by the Trademark Examining Attorney as in the instant application. See, *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1358, 56 USPQ2d 1351, 1354 (Fed. Cir. 2000) ("The ultimate conclusion of similarity or dissimilarity of the marks must rest on consideration of the marks in their entirety.")

The Trademark Examining Attorney cited in the December 25, 2013 Office Action the Merriam-Webster Dictionary for the definition of "café" as a "small restaurant where you can get simple meals and drinks (such as coffee)." In the instant case, the Trademark Examining Attorney has improperly given less significance to the disclaimed terms "CAFÉ" and "SWEETS," which clearly contribute to the commercial impression of applicant's mark. See, *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004) ("The disclaimed elements of a mark, however, are relevant to the assessment of similarity.") (*citing In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687).

Although the words "UCHI," "CAFÉ" and "SWEETS" are on different lines in the subject mark, they together make a coined term combining Japanese, French and English words to suggest enjoying a relaxing time to enjoy coffee and sweets inside of a home or house. Thus, the terms "CAFÉ" and "SWEETS" are important and distinctive parts of the mark, and the term "UCHI" cannot be isolated from these terms and the distinctive logo portions of the mark. Applicant's commercial impression is to be contrasted with the stark simplicity of registrant's

mark "uchi" in all lower case. As will be discussed further below, there are numerous third party registrations in use that also include "HOME" or "HOUSE" (the English translation of "UCHI") with other terms for various foods and beverages and services relating thereto.

When it is the entirety of the marks that is perceived by the public, it is the entirety of the marks that must be compared. *Packard Press*, 56 USPQ2d at 1354. It is not dispositive whether generic or descriptive words are included as part of the marks; that is simply a factor to be considered when viewing the mark as a whole. *Opryland USA*, 23 USPQ2d at 1474. In this case the Japanese term "UCHI" that translates to "HOME" or "HOUSE" is the only similar term in the two marks.

Moreover, applicant disagrees with the Trademark Examining Attorney's characterization that the registrant's mark is "UCHI" in "Standard Character Form." In fact, the registrant's mark is of a particular style in that the entirety of the mark "uchi" is in stylized lower case form. If it were in "Standard Character Form" the mark would have been published in all capital letters, per the usual USPTO practice. No other stylization of logo is included in the registrant's mark.

Applicant's mark is quite different, as the Trademark Examining Attorney should recognize in the amended description of the mark:

The mark consists of the stylized wording UCHI CAFÉ SWEETS in white colored against a striped background consisting alternating brown and black vertical stripes. The letter "I" in Uchi depicts a whisk and whipped cream and appears above Café, which appears above SWEETS.

Applicant's mark does not employ "uchi" in all lowercase letters, as in registrant's mark. Instead, the term "UCHI CAFÉ SWEETS" is a coined term, the "I" in "Uchi" depicts a whisk and whipped cream, and the overall logo forms the dominant portion of the mark. The Federal Circuit has cautioned that "No element of a mark is ignored simple because it is less dominant,

or would not have trademark significance if used alone. *In re Electrolyte Laboratories, Inc.*, 913 F.2d 930, 16 USPQ2d 1239, (Fed. Cir. 1990), corrected, 929 F.2d 645 (Fed. Cir. 1990).

Applicant's mark is very different in sound, appearance, connotation and commercial impression as compared to the registrant's mark. Moreover, as the Court stated in the case of *In re P. Ferrero & C.S.p.A.*, 479 F.2d 1395, 178 USPQ 167 (CCPA 1973), "The fact that one mark may bring another mark to mind does not in itself establish likelihood of confusion as to source." That is, even if an applicant's mark might bring to mind the [cited registration], this does not necessarily mean that consumers will be confused into believing that the two marks indicate the same source of origin. *See also, Viacom International Inc. v. Komm*, 46 USPQ2d 1233 (TTAB 1998); and *Nestle Foods Corp. v. Kellogg Co.*, 6 USPQ2d 1145 (TTAB 1988).

When the word "UCHI" is given fair weight, along with "CAFÉ SWEETS" and the distinctive logo, confusion with the stylized word "uchi" in lower case becomes less likely. *In re Hearst Corp.*, 982 F.2d 493, 494 (Fed.Cir.1992) (no likelihood of confusion between the marks VARGA GIRL and VARGAS both for calendars. The Court stated that appearance, sound, sight, and commercial impression of VARGA GIRL derive significant contribution from the component "girl," and by stressing the portion "varga" and diminishing the portion "girl", the Board inappropriately changed the mark.) *See also, Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 1407 (CCPA 1975) (No likelihood of confusion between COUNTRY VOGUES for women's dresses and VOGUE for a magazine since the marks COUNTRY VOGUES and VOGUE do not look or sound alike. The only similarity between marks is word VOGUE, and the dissimilarities between the marks, viewed in their entireties, outweigh this similarity sufficiently.)

In view of the well-established case law in this area, applicant submits that the Trademark Examining Attorney should have determined what the 'relevant public' would think when confronted with the instant mark as a whole, i.e., UCHI CAFÉ SWEETS (stylized) and Logo, and not merely what the 'relevant public' would think when confronted with the single word "UCHI" apart from the remainder of the mark. *In re Hutchinson Technology*, 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988). The mere fact that two marks share words in common, such as the word "UCHI" in the case at hand, is not determinative. See, *The Murray Corp. of America v. Red Spot Paint and Varnish Co., Inc.*, 126 USPQ 390 (TTAB, 1960) (opposition of mark EASY against the mark EASY TINT for identical goods dismissed since Board found no likelihood of confusion), *See also, Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945 (TTAB 1983), (opposition of mark BOND-PLUS against WONDER BOND PLUS for similar goods dismissed ...Board determined that the addition of the term WONDER to the expression BOND PLUS served to impart a distinctive commercial impression that precluded likelihood of confusion.) Again, "[t]he ultimate conclusion of similarity or dissimilarity of the marks must rest on consideration of the marks in their entirety." *In re Nat'l Data Corp.*, 753 F.2d 1056, 1059 [224 USPQ 749] (Fed. Cir. 1985).

The Doctrine of Foreign Equivalents as cited above from the *Palm Bay Imports* case is applicable here, because of the number of Japanese speakers in the U.S., and the relevant American purchaser would be able to translate applicant's and registrant's marks to understand and appreciate the meaning the word "UCHI." *In re Tokutake Industry Co., Ltd.*, 87 USPQ2d 1697, 1699-1700 (TTAB 2008) (Board noted "Japanese is a modern language spoken worldwide by more than 100 million people and by hundreds of thousands in the United States" and "there is no evidence that the relevant American purchaser who speaks Japanese would not stop and

translate the mark ... "). The English translation of words in trademarks should be considered when both marks use non-English words from the same language. *In re Lar Mor International, Inc.*, 221 USPQ 180, 183 (TTAB 1983) (Board found no likelihood of confusion between "BIEN JOLIE" (stylized) and "TRES JOLIE" (stylized) for women's clothing.). Likewise, no likelihood of confusion was found between two marks employing the same French formative, "L'AIRE DU TEMPS" and "L'AIR D'OR," despite both being expensive high quality perfumes. *Ricci v. Gemcraft, Ltd.*, 612 F.Supp. 1520, 226 USPQ 575, 584 (SDNY 1985).

In a nonprecedential case quite similar to the instant case, where both marks used a foreign word meaning "country house" or "estate" (in Spanish), and where food goods and food store service were involved, no likelihood of confusion was found. *In re La Estancia Argentina, Corp.*, 79 USPQ2d 1531, 1534 (TTAB 2005) (nonprecedential). There, the Board found that the registration for the word mark "DE LA ESTANCIA" for cornmeal and polenta, and applicant's mark "LA ESTANCIA ARGENTINA" and Logo for retail grocery store services presented different commercial impressions, among other things. Likewise, here the starkness of registrant's all lower case "uchi" mark presents a significantly different commercial impression as compared to applicant's mark, in which the words "UCHI," "CAFÉ" and "SWEETS" create a coined term combining Japanese, French and English words which along with the distinctive logo elements suggests a relaxing time to enjoy coffee and sweets inside of a home or house.

The English translation of "UCHI" as "HOME" or "HOUSE" was recognized in the prosecution of the cited U.S. Registration No. 3,722,422 for the mark "uchi," wherein the application was rejected for confusing similarity with the prior U.S. Trademark Application No. 78/608,781 for the mark "HOME (stylized) and Logo," now U.S. Registration No. 3,669,417, for essentially identical restaurant services. The registrant for the mark "uchi" was forced to obtain

and file a consent agreement from the owner of the "HOME (stylized) and Logo" mark.¹ The existence and nature of this consent demonstrates that differences such as stylization and logos in marks in the same restaurant services will suffice to ensure that there is no likelihood of confusion among the purchasing public. The more considerable differences in stylization and logo between registrant's and applicant's mark here serves to demonstrate even more that confusion is not likely between applicant and registrant's mark.

Thus, the dissimilarities of the marks in their entireties as to appearance, sound, connotation and commercial impression heavily favor applicant in a finding of no likelihood of confusion.

Similarity or dissimilarity of the goods

The Trademark Examining Attorney has stated that the goods of applicant and registrant need not be identical and need only be related in some manner. The Trademark Examining Attorney relies on third-party registrations and web site excerpts.

While applicant agrees that it and registrant both exist in the foods and beverages industry, such goods and/or services are not necessarily related simply because they "coexist in the same broad industry." *Therma-Scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623, 633 (Fed. Cir. 2002), citing, *Homeowners Group Inc. v. Home Marketing Specialist Inc.*, 931 F.2d 1100, 1109 (Fed. Cir. 1991).

Registrant appears to have a Japanese restaurant which it operates under the "uchi" (stylized) mark. As indicated above, applicant's food and beverage goods include teas, coffee

¹ This consent may be seen in the file history of U.S. Registration No. 3,722,422, Exhibits A-a and A-b in applicant's Response of June 30, 2014.

and coffee beans, cocoa, bread, various confectioneries, e.g., ice cream, castilla sponge cakes, tarts, cream puffs and doughnuts, and various juices and beverages, and its retail and wholesale store services feature these same items. There is no evidence that the registrant sells applicant's food and beverage goods in the course of rendering its take-out restaurant services. Applicant submits that the Examiner's notations to some third-party registrations and websites do not amount to substantial evidence upon which to support a finding of relatedness of the respective goods and services in this instance. *In re La Estancia Argentina, Corp.*, 79 USPQ2d at 1534. ("[T]here is no evidence of record to support the conclusion that the same mark, or even similar marks, have been used in conjunction with both the goods of registrant [cornmeal and polenta] and the services of applicant [retail grocery store services]."). *See, also, In re Coors Brewing Co.*, 343 F.3d 1348, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) ("Board's finding that beer and restaurant services are related is not supported by substantial evidence."); *In re Mars, Inc.*, 741 F.2d 395, 222 USPQ 938, 938 (Fed. Cir. 1984) (There was no evidence that applicant's candy bars and registrant's fresh citrus fruits bear a close relationship.); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence).

Registrant's services would be related to applicant's goods identified in Classes 30, 32 and 35 only if the registrant expanded its business to sell and offer the goods as in the present application. There is no evidence that the registrant has done so, or is planning to do so. If registrant had rights to expand its goods and services to include food and beverage goods and services not listed at the time the mark was registered, then the registrant would have rights to

any and all food and beverage goods and services, regardless of those listed at the time of registration. This is contrary to the fundamentals of trademark law.

Accordingly, there are clear differences between applicant's Class 30 and 32 goods and Class 35 store services on one hand, and registrant's Class 43 restaurant services on the other. These differences also favor applicant in a finding of no likelihood of confusion.

Number and nature of similar marks for similar goods

The weakness of cited marks should not afford a registrant so broad a scope of protection as to preclude registration of Applicant's applied for mark. The number and nature of similar marks for similar goods and services goes to the strength of the common formative in applicant's and registrant's mark, here "UCHI," which translates to "HOME" or "HOUSE."

A review of the sheer number of registered marks having the equivalent "UCHI," "HOME" and "HOUSE" formative for similar goods and services immediately shows that the use of "UCHI," "HOME" and "HOUSE" in the food products and restaurant services does not by itself convey distinctiveness. Applicant previously filed the following Exhibits with its response of June 30, 2014, which Exhibits show third party registered marks in applicant's classes 30, 32, 35 and 43:

- Exhibit B1 shows a third party registered mark having the formative "UCHI" in applicant's class 30, and a copy of the registration is attached.
- Exhibit C1 shows 53 third party registered marks having the formative "HOME" in applicant's class 30, and copies of the registrations are attached as Exhibits C1-a, C1-b and C1-c.
- Exhibit C2 shows 8 third party registered marks having the formative "HOME" in applicant's class 32, and copies of the registrations are attached.
- Exhibit C3 shows 3 third party registered marks having the formative "HOME" in applicant's class 35, and copies of the registrations are attached.

- Exhibit C4 shows 53 third party registered marks having the formative "HOME" in applicant's class 43, and copies of the registrations are attached as Exhibits C4-a and C4-b.
- Exhibit D1 shows 43 third party registered marks having the formative "HOUSE" in applicant's class 30, and copies of the registrations are attached as Exhibits D1-a, D1-b and D1-c.
- Exhibit D2 shows 9 third party registered marks having the formative "HOUSE" in applicant's class 32, and copies of the registrations are attached as Exhibits D2-a and D2-b.
- Exhibit D3 shows 8 third party registered marks having the formative "HOUSE" in applicant's class 35, and copies of the registrations are attached.
- Exhibit D4 shows 14 third party registered marks having the formative "HOUSE" in applicant's class 43, and copies of the registrations are attached.

Just as examining attorneys may use third-party registrations to show relatedness, "applicants may submit sets of third-party registrations to suggest the opposite, i.e., that the Office has registered the same mark to different parties for the goods at issue." *In re G.B. I. Tile and Stone, Inc.* 92 USPQ2d 1366, 1369-70 (TTAB 2009).²

The evidence of dozens of these third-party registrations using the equivalent "UCHI," "HOME" and "HOUSE" formative for similar goods and services illustrate that these respective goods cannot be understood by the purchasing public to emanate from a single source. Further, the fact that there are third-party registrations using the formatives the equivalent "UCHI,"

² Applicant moves for consideration in this appeal Exhibits corresponding to Exhibits B1-D4 of its June 30, 2014 response, which include where available a copy of a registrant's web page showing how the third party registered marks are used. While the Trademark Examining Attorney did not comment in the August 11, 2014 Office Action on the actual use of such third party registrations, applicant believes that they may be helpful to the Board.

"HOME" and "HOUSE" formative for similar goods and services owned by different entities is consistent with the conclusion that such trademark owners and their consumers do not and would not believe there is a likelihood of confusion between such marks. *See, e.g., In re Hyundai Motor Am.*, Serial No. 78889340 (TTAB 2009) (non-precedential).

Just as with the cited registration, none of these third party registrations employ the additional term "CAFÉ SWEETS," nor do any have a similar logo.

Since the only commonality between applicant's mark and the cited registration is the presence of the formative "UCHI" used in Japanese or the English equivalent in numerous other registration for similar goods and services, which demonstrates that the "UCHI" or equivalent "HOME" or "HOUSE" portion of the registrant's mark is weak. Consequently, this factor points away from a likelihood of confusion between the marks, and heavily favors applicant.

The similarity or dissimilarity of established, likely-to-continue trade channels

Applicant submits that there is no overlap or similarity of trade channels between applicant's food and beverage goods and services in Classes 30 and 32 and its retail food store services in Class 35, and registrant's restaurant services in Class 43, as discussed above. This factor favors applicant.

Variety of goods ("family" mark)

This factor involves "the variety of goods on which a mark is or is not used (house mark, "family" mark, product mark)." *du Pont*, 476 F.2d at 1361, 177 USPQ at 567. In this case, the registrant has only a single registration for the mark "uchi", and no rights for other goods or services are conveyed.

Fame of the prior mark

There is no evidence that the registrant's mark is either well known or well recognized. This factor therefore favors applicant.

Extent to which applicant may exclude others from use of its mark

As indicated by the other registrations using the words "UCHI," "HOME" and "HOUSE," the registrant's right to exclude others from use marks inclusive of the word "UCHI," "HOME" or "HOUSE" is limited. Accordingly, this factor favors applicant.

Condition of sales and buyers

Purchasers of foods and restaurant services are used to seeing marks with the similar equivalent formatives "UCHI," "HOME" and "HOUSE" in these goods and services, so this factor favors applicant.

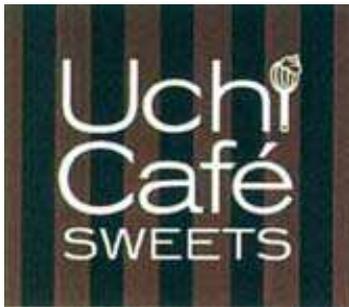
Extent of potential confusion

In view of the dissimilarity of the goods, buyers and channels of trade, and the actual difference in the marks themselves, the potential for confusion is de minimus. As such, this factor favors applicant.

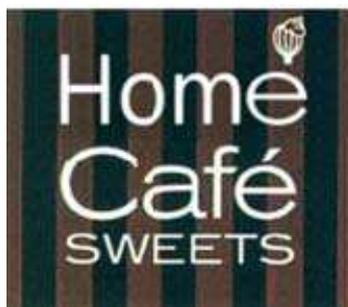
All of the foregoing weighs in favor of a finding of no likelihood of confusion. It is for these reasons that applicant respectfully requests that the instant application be allowed and passed to publication pursuant to the Trade Marks Act of 1946.

SUMMARY

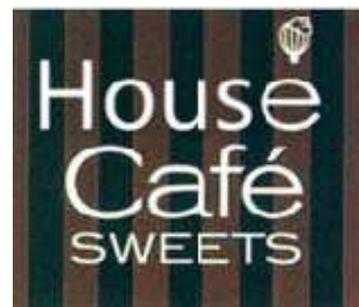
The comparison between applicant's and registrant's marks in their entirety are shown below, for both their actual Japanese language usage of "UCHI," and for their English language equivalents:



uchi



home



house

The commercial impressions of each are distinctly different, particularly in view of the weak protection accorded the formative "HOME" or "HOUSE" in food and beverage related goods and services, as evidenced by numerous third party registrations and uses. Although applicant claims restaurant services in the same Class 43 as registrant, applicant's food and beverage goods in Classes 30 and 32, and its food and beverage store service in Class 35, which are not demonstrated to be part of registrant's restaurant services, further distinguish applicant's mark in these latter classes.

For these and the other reasons set forth hereinabove, Applicant submits that its mark is not likely to cause confusion under Trademark Act Section 2(d) with U.S. Registration Nos. 3,278,053; 4,270,203 and 4,315,211. Accordingly, Applicant's mark is entitled to registration.

The Board is therefore respectfully requested to reverse the Examiner's decision refusing registration.

Respectfully submitted,

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