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EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79138995

MARK: UCHI CAFÉ SWEETS



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: KABUSHIKI KAISHA LAWSON

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

LAWS40000800

**CORRESPONDENT E-MAIL ADDRESS:**

## EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1183027

## I. INTRODUCTION

This is an appeal from the Trademark Examining Attorney's final refusal to register applicant's mark, **UCHI CAFÉ SWEETS in Stylized and Design Form**, for:

**CL. 30**-“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”; **CL. 32**-“Non-alcoholic carbonated beverages; fruit juices; whey beverages; vegetable juices and beverages”; **CL.35**-“ Retail services or wholesale services for a variety of goods in each field of foods and beverages, and carrying all goods together; retail services or wholesale services for foods and beverages; retail services or wholesale services for liquor; retail services or wholesale services for meat; retail services or wholesale services for sea food; retail services or wholesale services for vegetables and fruits; retail services or wholesale services for confectionery; retail services or wholesale services for bread and buns; retail services or wholesale services for rice and cereals; retail services or wholesale services for milk; retail services or wholesale services for carbonated drinks, non-alcoholic and non-alcoholic fruit juice beverages; retail services or wholesale services for tea, coffee and cocoa; retail services or wholesale services for processed food”; and **CL. 43**-“Providing foods and beverages.”

on the Principal Register pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) on the ground that the applicant's mark was likely to be confused with the prior registered mark **UCHI in Standard Character Form**, under U.S. Registration No. **3722422** for:

CL. 43-“Cafe-restaurants; Carry-out restaurants; Hotel, bar and restaurant services; Restaurant and bar services; Restaurant services; Restaurants; Self-service restaurants; Take-out restaurant services.”

## II. FACTS

On November 28, 2013, applicant, KABUSHIKI KAISHA LAWSON (hereinafter "applicant"), filed an application to register the stylized and design form mark **UCHI CAFÉ SWEETS**, under §66(a) of the Act, 15 U.S.C. §1141(h), on the Principal Register for:

CL. 30-“Black tea English tea; coffee; cocoa; confectionery; bread; buns; unroasted coffee beans”; CL. 32-“Carbonated beverages, non-alcoholic; fruit juices; whey beverages; vegetable juices beverages”; CL. 35-“Advertisement and publicity services; retail services or wholesale services for a variety of goods in each field of clothing, foods and beverages, and living ware, carrying all goods together; retail services or wholesale services for woven fabrics and beddings; retail services or wholesale services for clothing; retail services or wholesale services for footwear; retail services or wholesale services for bags and pouches; retail services or wholesale services for personal articles; retail services or wholesale services for foods and beverages; retail services or wholesale services for liquor; retail services or wholesale services for meat; retail services or wholesale services for sea food; retail services or wholesale services for vegetables and fruits; retail services or wholesale services for confectionery; retail services or wholesale services for bread and buns; retail services or wholesale services for rice and cereals; retail services or wholesale services for milk; retail services or wholesale services for carbonated drinks, non-alcoholic and non-alcoholic fruit juice beverages; retail services or wholesale services for tea, coffee and cocoa; retail services or wholesale services for processed food”; CL. 43-“Providing foods and beverages.”

On December 25, 2013, examining attorney refused registration of the proposed mark, **UCHI CAFÉ SWEETS in Stylized and Design Form**, pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), because the mark was likely to be confused with the mark **UCHI in Standard Character Form** in U.S. Registration No. 3722422. The refusal under Section 2(d) was limited to specific goods, services, and classes.<sup>1</sup> The following goods and services were excluded from the refusal:

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<sup>1</sup> The stated refusal was limited to the following goods, services, and classes:

1) All of Class 30, 32, and 43;

2) All of the services involving the provision of food and beverages in Class 35: Retail services or wholesale services for a variety of goods in each field of foods and beverages, and carrying all goods together; retail services or wholesale services for foods and beverages; retail services or wholesale services for liquor; retail services or wholesale services for meat; retail services or wholesale services for sea food; retail services or wholesale services for vegetables and fruits; retail services or wholesale services for confectionery; retail services or wholesale services for bread and buns; retail services or wholesale services for rice

**CL.35**-“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 a variety of goods in each field of clothing, and living ware, carrying all goods together; 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).”

Additionally, registration was refused because of procedural informalities concerning (1) the identification of goods and services being unacceptable, (2) the description of the mark being inaccurate, (3) possible translation, and (4) a disclaimer of descriptive/generic wording in the mark.

Applicant in its response filed June 30, 2014, argued against the refusal stating: (1) the marks in their entireties were dissimilar; (2) there exists multiple registrations encompassing the term HOUSE or HOME coexisting on the register, and thus the term should be afforded limited protection; and (3) the goods and services of the parties were dissimilar. Also, applicant satisfactorily responded to all of procedural informalities outlined in the December 25, 2013 office action. *See* TMEP §§713.02, 714.04.

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and cereals; retail services or wholesale services for milk; retail services or wholesale services for carbonated drinks, non-alcoholic and non-alcoholic fruit juice beverages; retail services or wholesale services for tea, coffee and cocoa; retail services or wholesale services for processed food.

On August 10, 2014, examining attorney issued a Final refusal under Section 2(d). Examining attorney maintained that a likelihood of confusion existed as to the source of the goods and services because (1) the literal portions of the parties' marks encompassed identical unique wording namely, **UCHI**; (2) applicant's reference of third-party registrations of marks encompassing the wording HOUSE or HOME was unpersuasive; and (3) the identical marks are used on overlapping services, and the parties' goods and services were closely related based on third-party registrations featuring goods and services of the parties', namely, "breads, buns, confectionery, coffee, tea, cocoa, carbonated beverages, whey beverages, juices, wholesale and retail store services, restaurants, providing foods and beverages."

On January 21, 2015, the applicant filed a Notice of Appeal. The case was forwarded to examining attorney for briefing on March 19, 2015.

For the reasons to follow, examining attorney requests that the Board AFFIRM the refusal under Section 2(d) of the Trademark Act.

### **III. ISSUE ON APPEAL**

Whether applicant's mark UCHI CAFÉ SWEETS and design for the service of providing food and beverages, Coffee, tea and baked goods and confectionery, juices and carbonated beverages, and retail stores featuring the same, is likely to cause confusion with the registered mark UCHI for restaurant related services that may feature the same and/or related goods as applicant.

### **V. ARGUMENT**

**THE PARTIES' MARKS ARE CONFUSINGLY SIMILAR IN SIGHT, SOUND, CONNOTATION, AND COMMERCIAL IMPRESSION, AND THE GOODS AND SERVICES ARE CLOSELY RELATED SUCH THAT A LIKELIHOOD OF CONFUSION EXISTS AS TO THE SOURCE OF THE GOODS AND SERVICES UNDER TRADEMARK ACT SECTION 2(d), 15 U.S.C. SECTION 1052(d).**

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01.

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361-62, 177 USPQ 563, 567 (C.C.P.A. 1973); *In re 1st USA Realty Prof'ls Inc.*, 84 USPQ2d 1581, 1584 (TTAB 2007); *see also In re Dixie Rests. Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

However, not all the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177

USPQ at 567. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); TMEP §§1207.01 *et seq.*

**A. The parties' UCHI marks are confusingly similar in appearance, sound, connotation and commercial impression.**

In analyzing whether a likelihood of confusion exists between marks the examining attorney must compare the marks in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). Also, when comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered under applicant's and registrant's marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

The parties' UCHI marks are very similar in sound, appearance, connotation and overall commercial impression because the applied-for mark incorporates the registered mark. It should be noted that adding a term to a registered mark, which in this case the wording Café Sweets, generally

does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (finding MACHO and MACHO COMBOS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part. Although there are some differences in the marks, they are insufficient to overcome this similarity when the marks are considered in their entireties. Specifically, - the words CAFÉ SWEETS are disclaimed; the remaining additional features (alternating brown and black bars, and a whisk) are design features that do very little, if any to distinguish the parties' marks.

Applicant asserts that a likelihood of confusion does not exist and that the parties' marks are distinguishable from one another because (1) the applicant's mark in its entirety is different from the registrant's mark in sound, appearance, and meaning based on the Doctrine of Foreign Equivalents; and (2) there exists multiple registrations encompassing the term UCHI, HOUSE or HOME coexisting on the register, and thus the term should be afforded limited protection. (See applicant's Appeal Brief at pgs. 10-17).

Examining attorney respectfully disagrees with applicant's assertions, and maintains that a likelihood of confusion exists as to the goods and services emanating from a common source. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for an applicant's goods and/or services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests.*,

*Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752 ; TMEP §1207.01(b)(viii), (c)(ii). Here, applicant's mark encompasses highly descriptive and/or generic disclaimed wording, which is less significant (CAFÉ and SWEETS), and results in UCHI being the dominant term. Thus, in comparing the parties' marks in their entireties, more emphasis is placed on the dominant term UCHI in applicant's mark, which is the registrant's mark in its entirety.

Also, for a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *See Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (*citing In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); *see In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (*citing CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, in the herein case the word portion, namely, UCHI, is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (*citing Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

The crux of applicant's argument is its belief that under the Doctrine of Foreign Equivalents the parties' marks are distinguishable to such a degree that a likelihood of confusion as to the source of the goods and services would not result. (*See applicant's Appeal Brief at pgs. 6-17*). Applicant spends a great deal of analysis unduly placing extreme emphasis on the translation of the term UCHI as both "HOUSE" and "HOME," also suggesting that consumers would view its mark as evoking a feeling of enjoying coffee and sweets inside a home or house. (*See applicant's Appeal Brief at pg. 10*). Applicant

further incorrectly argues that consumers would be knowledgeable and go through the following analysis by equating and translating - (1) the Japanese term UCHI as both "HOUSE" and "HOME"; (2) the French term "CAFÉ"; and (3) the English term "SWEET" all suggesting that the average consumer goes through a multilingual decision-making process when purchasing the parties' goods and services. (See applicant's Appeal Brief at pgs. 6-17).

Applicant's invocation of the Doctrine of Foreign Equivalents is peculiar, and misplaced because the term UCHI is the same in both parties' marks, and has the same translation. There have been no arguments set forth by either party to suggest otherwise. Also, applicant has provided no evidence, surveys, affidavits, and/or declarations demonstrating that consumers would perceive its mark to evoke a feeling of enjoying coffee and sweets inside a home or house. Nevertheless, in viewing the mark as presented in the application it is clear that the goods and/or related services involve a Café, and that the related goods may be sold through the Café. Thus, the logical conclusion would be that the goods and services are provided and enjoyed through a retail establishment, namely a Café.

Additionally, applicant's attempt to suggest that a proposed mark encompassing the combination of a Japanese origin term (UCHI), a French origin term (CAFÉ), and an English term (SWEET), creates a different commercial impression from simply a registered mark encompassing in its entirety solely of the Japanese origin term (UCHI) is unpersuasive. Although the term CAFÉ may have a French origin, it has a clear cut English definition, which was provided by examining attorney as "": a small restaurant where you can get simple meals and drinks (such as coffee); 1: a usually small and informal establishment serving various refreshments (as coffee); broadly: restaurant; 2: barroom; 3: cabaret, nightclub." Also, examining attorney has afforded the proper weight and analysis to the terms CAFÉ and SWEETS, because they are highly descriptive and/or generic in connection with the goods and services as demonstrated by the dictionary evidence of record. (See examining attorney's 12/25/13

Office Action). Thus, reliance on the term UCHI being most likely used when calling for the goods, and not “CAFÉ and/or SWEETS”, or “design mark” is appropriate.

Additionally, the examining attorney disagrees with the applicant that a likelihood of confusion does not exist because there are other registered marks encompassing the wording HOUSE or HOME. (See applicant’s Appeal Brief at pg. 11). Applicant should note that some of the other registered marks may encompass additional wording, refer to dissimilar goods and services, and may have different trade channels. Thus, a likelihood of confusion may not exist between applicant’s mark, registrant’s mark, or other registered marks. On the other hand, the applicant’s mark encompasses identical wording UCHI, has the same translation (HOUSE or HOME and not simply one of the terms), and features goods and services closely related and/or identical to the cited registered mark, particularly services featuring the provision of food and beverages.

It should be further noted that even if there were many HOME or HOUSE formative marks in the same market, the marks at issue feature the Japanese term UCHI. In that sense the applied-for mark and registered marks are similar not only in meaning, but also in appearance and sound. Additionally, the marks at issue are the only UCHI marks used with the relevant goods and services. Moreover, even if the registered mark were considered weak, weak marks are entitled to some protection. The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); see, e.g., *In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975). Further, the

applicant's assertion basically suggests that the registrant's mark should be diluted and afforded no protection of a registered mark.

Applicant raises an argument concerning registrant's mark not actually being a standard character mark in attempt to further distinguish the parties' marks. (See applicant's Appeal Brief at pg. 11). Examining attorney disagrees with applicant's argument and maintains that registrant's mark is in standard character form based on the certificate of registration, which states that the registered mark is a standard character mark. Also, a mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. See *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. See, e.g., *In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "the argument concerning a difference in type style is not viable where one party asserts rights in no particular display"). Therefore applicant's attempt to distinguish the marks based on the stylization and/or form of the mark is unpersuasive.

Applicant posits the argument that there has been no evidence of actual confusion between the parties. It should be noted that the test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. Thus, it is not necessary to show that actual confusion exists here between the parties' marks. See *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); TMEP §1207.01(d)(ii). The Trademark Trial and Appeal Board stated as follows:

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

*In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).

Last, consumer confusion has been held likely for marks that do not physically sound or look alike but that convey the same idea, stimulate the same mental reaction, or may have the same overall meaning. *Proctor & Gamble Co. v. Conway*, 419 F.2d 1332, 1336, 164 USPQ 301, 304 (C.C.P.A. 1970) (holding MISTER STAIN likely to be confused with MR. CLEAN on competing cleaning products); see *Ralston Purina Co. v. Old Ranchers Canning Co.*, 199 USPQ 125 (TTAB 1978) (holding TUNA O' THE FARM for canned chicken likely to be confused with CHICKEN OF THE SEA for canned tuna); *Downtown Corp. v. Uptowner Inns, Inc.*, 178 USPQ 105 (TTAB 1973) (holding UPTOWNER for motor inn and restaurant services likely to be confused with DOWNTOWNER for the same services); TMEP §1207.01(b). Although the parties marks do not physically sound or look alike in every aspect (based on the disclaimed descriptive wording and design), they nonetheless convey the same idea, stimulate the same mental reaction, or may have the same overall meaning based on the wording **UCHI** encompassed in the marks.

Thus, the proposed marks create the same overall impression, and the marks would confuse consumers into believing that the goods and services would emanate from the same source.

**B. Applicant's Goods and Services and Registrant's Services Are Related, such that a Likelihood of Confusion Exists as to the Source of the Goods and Services.**

The second step in the likelihood of confusion test is a comparison of the parties' goods and services. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). The goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The application and registration list overlapping goods. Specifically, the application lists providing food and drink, which encompasses the various restaurant services listed in the registration. As such the unique marks will be used on the same services, marketed through the same trade channels to the same consumers.

Although not identical to those in the registration, the remaining goods and services listed in the application are nonetheless related to the services listed in the registration. Also, the respective goods and/or services need only be related in some manner or the conditions surrounding their marketing be such that they will be encountered by the same consumers under circumstances that would lead to the mistaken belief that the goods and/or services originate from the same source. *Gen. Mills Inc. v. Fage Dairy Processing Indus.*, 100 USPQ2d 1584, 1597 (TTAB 2012); TMEP §1207.01(a)(i); *see On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d at 1086, 56 USPQ2d at 1475; *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Examining attorney has provided third-party registrations demonstrating that parties use the same brand on both the goods and services at

issue, namely, “breads, buns, confectionery, coffee, tea, cocoa, carbonated beverages, whey beverages, juices, wholesale and retail store services, restaurants, providing foods and beverages.”

Applicant argues that a likelihood of confusion does not exist as to the source of the parties goods and services because (1) the goods and services are dissimilar (see applicant’s Appeal Brief at pgs. 17-19); and (2) the channels of trade are dissimilar (see applicant’s Appeal Brief at pg. 19) .

Examining attorney finds applicant’s arguments unpersuasive and maintains that a likelihood of confusion does exist as to the source of the parties’ goods and services. In support of the determination that the goods and services are related, examining attorney provided third-party registrations of marks used in connection with the same or similar goods and/or services as those of applicant and registrant in this case, namely, **breads, buns, confectionery, coffee, tea, cocoa, carbonated beverages, whey beverages, juices, wholesale and retail store services, restaurants, providing foods and beverages.** (See examining attorney’s 12/25/13 Office Action). The third-party registrations included:

**CALIFORNIA PIZZA KITCHEN ASAP (Reg. No. 3569680)** – Goods and services consisting of **Cl. 29**-meat; poultry; processed vegetables; vegetable salads; garden salads; salads consisting of meat and poultry; soups; milk; chocolate milk; snack dips; processed tomato checca; potato chips; and hummus, for consumption on or off the premises”; **Cl.30**-pizza; breakfast pizza; bakery goods; pizza bread; bread; foccacia bread; panini bread; ciabatta bread; sandwiches; breakfast sandwiches; desserts, namely, brownies, cookies, and cheesecake; salad dressings; coffee; tea; iced teas; tortilla chips; pastas; and macaroni and cheese, for consumption on or off the premises; **Cl. 32**-beverages, namely, sparkling water, still water, fruit juice, lemonade, carbonated soft drinks, soda pop, fruit punch, and beer, for consumption on or off the premises; **Cl. 43**-restaurant services; carry-out and take-out restaurant services; beverage services, namely, preparation and serving of beverages; catering services; restaurants featuring home and office delivery services; and restaurants featuring curb-side delivery service.

**PORTLAND COFFEE HOUSE (Reg. No. 3642861)** – Good and services consisting of **Cl. 35- Retail store services featuring ground and whole bean coffee; espresso; cocoa; tea; beverages made with a base of coffee and/or espresso; tea-based beverages; prepared coffee and tea; baked goods, namely, muffins, scones, biscuits, bagels, cookies and pastries; sandwiches; granola; chocolate, candy and confections; bottled water and other non-alcoholic drinks, namely, soft drinks, fruit drinks and fruit juices; flavoring syrups for making beverages; Cl. 43-Café, coffee bar, coffee house, and carry out restaurant services; preparation of carry out foods and beverages.**

**TIM HORTONS CAFE & BAKE SHOP (Reg. No. 4415127)** – Good and services consisting of **Cl. 29- Soups and chili; Cl. 30-Prepared foods, namely, donuts, donut holes, muffins, cookies, pastries, cakes, tea biscuits, croissants, bagels, sandwiches, hash brown potatoes; non-alcoholic beverages, namely, coffee, espresso, cappuccino, tea, hot chocolate; milk-based hot and cold beverages, namely, café latte, shakes, iced shakes, and ice cream floats; coffee-based hot and cold beverages, namely, café mocha, iced cappuccino, iced mocha cappuccino and iced coffee; coffee beans and ground coffee beans; Cl. 32-Fruit juices, vegetable juices, soft drinks, bottled water, iced lemonade, fruit smoothies, and slush type soft drinks; Cl. 43-Café featuring coffees and baked goods; coffee shop services; sit-down and take-out restaurant services; food and beverage catering services.**

**YOUR NEIGHBORHOOD GATHERING PLACE (Reg. No. 4170195)** - Goods and services consisting of **Cl. 21-Beverage glassware, mugs; Cl. 25-Clothing, namely, shirts, hooded sweatshirts, jackets and sweatshirts; Cl. 29-Soups, potato skins, appetizers consisting primarily of vegetables, cheese, milk meat, chicken or fish; dairy-based dips; meat, chicken; vegetable salads; fish, salmon, steaks, baby back ribs; calamari; shrimp; crab cakes; Cl. 30- Sandwiches, appetizers consisting primarily of bread, pasta or rice; pizza; hamburgers; nachos; chicken wing sauce; fajitas; pasta; salad dressing; desserts, namely, cookies, cake, pastries and ice cream; Cl. 32-Beer; non-alcoholic beverages, namely, soft drinks and fruit juices; Cl. 33-Alcoholic beverages, namely, wine and alcoholic cocktails; Cl. 35-Franchise services, namely, offering business management assistance in the establishment and operation of restaurants; Cl 43-Restaurant services.**

**TOM N TOMS T COFFEE (Reg. No. 4305946)** - Goods and services consisting of **Cl. 21-Mugs; Insulated coffee cups; Insulated beverage cups; Cups; Dishes; Paper plates; Reusable non-paper coffee filters; Non-paper coasters; Thermal insulated bottles; Insulated vacuum bottles; Non-electric coffee makers; Hand-operated coffee grinders**

and coffee mills; Cup holders for use on car; Coffeepots; Teapots; Beverage glassware; Plates and bowls; Storage canisters; Cl. 29-Milk; Chocolate flavored milk; Strawberry flavored milk; Coffee flavored milk; Milk-based food beverages containing coffee; Milk shakes; Flavoring syrups; Liquid and powdered beverage mixes used to make milk-based food beverages, namely, milk-based beverages containing coffee; Dairy-based food beverages; Soy-based food beverage used as a milk substitute; Crystallized fruits; Fermented vegetable foods, namely, kimchi; Potato flakes; Fruit chips; Soya milk; all the aforesaid goods for sale only in the mark owner's franchised or licensed coffee shops; **Cl. 30-Coffee; Artificial coffee; Coffee substitutes; Coffee beverages with milk; Unroasted coffee; Coffee-based beverages; Cocoa; Cocoa-based beverages; Cocoa products; Cocoa beverages with milk; Chocolate; Chocolate beverages with milk; Chocolate-based beverages; Tea; Tea-based beverages; Iced tea; Sherbets ices; Ice cream; Honey; Pastries; Pies; Coffee flavorings; Sugar; Pasta; Pancakes; Noodles; Puddings; Pizzas; Popcorn; Crackers; Custard; Cookies; Corn flakes; Biscuits; Bread; Buns; Cakes; Sandwiches; Spaghetti; Tacos; Candy; Spices; Waffles; Aromatic preparations for food; Dressings for salad; Pretzels; Bagels; Cl. 32-Aerated water; Fruit juices; Isotonic beverages; Lemonades; Mineral water; Flavored mineral water; Non-alcoholic beverages containing fruit juices; Non-alcoholic cider; Non-alcoholic beverages, namely, Carbonated beverages; Non-alcoholic Cocktails; Non-alcoholic fruit extracts used in the preparation of beverages; Non-alcoholic fruit juice beverages; Non-alcoholic honey-based beverages; Sherbets; Soft drinks, namely, non-carbonated milk-based soft drinks flavoring coffee; Cl 35-retail store services featuring mugs, insulated coffee cups, insulated beverage, cups, cups, dishes, paper plates, reusable non-paper coffee filters, non-paper, coasters, thermal insulated bottles, insulated vacuum bottles, non-electric, coffee makers, hand-operated coffee grinders and coffee mills, cup holders for use on car, coffeepots, teapots, beverage glassware, plates and bowls, and storage canisters; retail store services featuring milk, flavored milk, milk-based food beverages, milkshakes, non-carbonated milk-based soft drinks, flavoring syrups, liquid and powdered beverage mixes used to make milk-based food beverages dairy-based food beverages, soy-based food beverage used as a milk substitute, crystallized fruits, fermented vegetable foods, potato flakes, fruit chips, and soya milk; retail store services featuring coffee, artificial coffee, coffee substitutes, coffee beverages with milk, unroasted coffee, coffee-based beverages, cocoa, cocoa-based beverages, cocoa products, cocoa beverages with milk, chocolate, chocolate beverages with milk, chocolate-based beverages, tea, tea-based beverages, iced tea, sherbets ices, ice cream, honey, pastries, pies, coffee flavorings, sugar, pasta, pancakes, noodles, puddings, pizzas, popcorn, crackers, custard, cookies, corn flakes, biscuits, bread, buns, cakes, sandwiches, spaghetti, tacos, candy, spices, waffles, aromatic preparations for food, dressings for salad, Pretzels and Bagels; Business administration; Business management; Provision of business assistance in the establishment and/or operation of restaurants, cafes, coffee houses and snack bars; Commercial management assistance; Commercial**

information agencies; Advisory services for business management; Marketing research; Presentation of goods on communication media for retail purposes; Administrative processing of purchase orders; Sales promotion for others. Cafes franchise management services, namely, offering technical assistance in the establishment and operation of a chain of cafes specifically featuring coffee, artificial coffee, coffee substitutes, coffee beverages with milk, unroasted coffee, coffee-based beverages, cocoa, cocoa-based beverages, cocoa products, cocoa beverages with milk, chocolate, chocolate beverages with milk, chocolate-based beverages, tea, tea-based beverages, iced tea, ice cream, pastries, pies, coffee flavorings, pasta, noodles, puddings, popcorn, crackers, custard, cookies, biscuits, bread, cakes, sandwiches, tacos, candy, spices, waffles, Pretzels and Bagels; Presentation of goods on communication media for retail purposes.

**TAPIOCA EXPRESS (Reg. No. 4442188)** - Goods and services consisting of Cl. 16-Plastic bags for packaging, paper bags, packaging containers of paper, adhesive labels, paper containers, storage containers made of paper, packaging containers comprised of paperboard for food and beverages; Cl. 20-Plastic containers for foods and drinks, namely, plastic containers and covers sold as a unit to the fast food industry for made to order food products; packaging containers of plastic, plastic containers and covers for the food industry, plastic containers for commercial use, namely, for storing and dispensing bulk foods, plastic storage containers for commercial or industrial use; Cl. 21-Drinking straws, disposable cups and lids made of paper or plastic, plastic beverage carriers, namely, cups, portable beverage container holder; insulating sleeve for beverage cups, tea canister; Cl. 25-Hats, shirts, aprons; Cl. 29-Prepared meat, prepared poultry, prepared seafood, cooked vegetables, meat based snack food, corn dogs, vegetable based snack foods, tofu-based snacks, potato-based snack foods, beverages, namely, dairy-based beverages, yogurt-based beverages, non-dairy creamer, jellies, aloe vera prepared for human consumption, combination meals consisting primarily of a meat or vegetable-based entree and starch; processed red beans; **Cl. 30-Coffee, espresso, prepared coffee and coffee based beverages, tea, tea bags, tea leaves, green tea, oolong tea (Chinese tea), tea-based beverages, mixes in the nature of concentrates, syrups or powders used in the preparation of tea based beverages, cocoa, cocoa powder, flavoring syrups, flavorings for beverages, tapioca, puddings, dessert puddings, fructose for food, non-dairy frozen confections, seasoned coating mixtures for food, seasoning mixes, grain based-snack foods, dumplings, egg rolls, sandwiches, noodles, bread crumbs, food starch, frozen desserts consisting of fruit and cream or cream substitutes, frozen desserts consisting of flavored ice blocks with toppings, cookies, candy; frozen yogurt confections;** Cl. 32-Concentrates, syrups or powders for making soft drinks or tea-flavored beverages, fruit juices and fruit drinks, frozen fruit drinks, syrups for making beverages, fruit beverages, soda pops,

**bottled water; Cl. 35-Wholesale distributorships featuring food, beverages, disposable containers, and packaging materials for food or beverages; Cl. 43-Restaurant services, take-out restaurant services, café services, snack bar services.**

**PHILZ COFFEE ONE CUP AT A TIME (Reg. No. 4404663)** - Goods and services consisting of Cl. 9-Magnetically encoded gift cards; computer software for accessing information related to coffee, coffee drinking, and coffee house locations, services, and menus for a mobile device; Cl. 16-Publications and printed materials, namely, newsletters and magazines featuring information about coffee, coffee drinkers, coffee houses, communal retail environments, recipes; Cl. 21-Coffee cups, mugs and tumblers; coffee stirrers; Cl. 25-T-Shirts; hat; **Cl. 30-Coffee beans; coffee; coffee based beverages; tea; tea leaves; tea based beverages; Cl. 35-Wholesale distributorships, retail outlets and mail order services featuring ground and whole bean coffee, tea, cocoa, coffee beverages, beverages made with a base of coffee, powdered flavorings, flavoring syrups, baked goods, namely, muffins, scones, biscuits, cookies, pastries, cakes breads, and ready-to-make mixes of the same, packaged foods, sandwiches and prepared foods, chocolate and confectionery items, ready-to-eat food stuffs, dried fruits, juices, soft drinks,** electric appliances, namely, kettles, coffee makers, and coffee grinders, housewares, namely, insulated coffee and beverage cups, collapsible cup carriers and caddies, non-paper coasters, insulated vacuum bottles, coffee cups, tea cups and mugs, glassware, dishes, plates and bowls, trivets, storage canisters, non-electric drip coffee makers and non-electric plunger-style coffee makers, paper and non-paper coffee filters, T-shirts, caps, sweatshirts, jackets, aprons and other clothing items; Cl. 41-On-line journals, namely, blogs featuring information about coffee, coffee drinkers, coffee houses, communal retail environments, recipes; **Cl. 43-Coffee houses, shops and cafes;** providing an online database in the field of recipes.

**SEATTLE'S BEST COFFEE (Reg. No. 4180905)** - Goods and services consisting of Cl. 7-Electric coffee grinders for commercial use; Cl. 9-Vending machines; Cl. 11-Electrical appliances, namely, espresso makers and coffee makers for commercial use; Cl. 16-Paper bags; Cl. 21-Coffee cups; tea cups and mugs; dishes; cups; cup sleeves; Cl. 29-

Flavored milk and milk based beverages; liquid beverage mixes used to make milk-based food beverages excluding milk shakes; **Cl. 30-Ground and whole bean coffee; cocoa; herbal and non-herbal tea; coffee, tea, cocoa and espresso beverages, and beverages made with a base of coffee and/or espresso; beverages made with a base of tea; sauces to add to beverages; chocolate syrup; flavoring syrups to add to beverages; baked goods including muffins, scones, biscuits, cookies, pastries and breads; ready-to-drink coffee; chocolate; candy; fruit sauces excluding cranberry**

**sauce and applesauce; Cl. 32-Non-alcoholic drinks, namely, fruit juice based beverages; fruit drinks; fruit drinks containing fruit juices; sauces for making beverages; flavoring syrups for making beverages; frozen fruit beverages and frozen fruit-based beverages; Cl. 35-Business administration; business management; franchising, namely, providing business management assistance in the establishment and or operation of restaurants, cafes, coffee houses and snack bars; retail store services in the field of coffee, tea, cocoa, packaged and prepared foods, non-electric appliances, housewares, kitchenware, books, musical recordings; wholesale distributorships, and wholesale ordering services all in the field of coffee, tea, and cocoa; computerized on-line ordering services, computerized on-line retail store services, on-line ordering services and on-line retail store services all in the field of coffee, tea, cocoa, electric appliances, housewares, and kitchenware; retail store services featuring carry out foods and beverages; Cl. 43-Restaurant, cafe, cafeteria, snack bar, coffee bar and coffee house, carry out restaurant, and take out restaurant services; catering services; coffee supply services for offices; contract food services; food preparation; preparation of carry out foods and beverages.**

This evidence establishes that the same entity commonly provides the Classes 30, 32, 35, and 43 goods and services of both parties. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Applicant raises the argument that the channels of trade are different because registrant uses the mark with Japanese restaurants. First applicant offers no evidence to that affect. Second, in analyzing the applicant's and registrant's goods and/or services for similarity and relatedness is based on the description of the goods and/or services set forth in the application and registration at issue, not on extrinsic evidence of actual use. *See Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp. Inc.*, 648 F.2d 1335, 1337, 209 USPQ 986, 988 (C.C.P.A. 1981). Absent restrictions in an application and/or registration, the identified goods and/or services are presumed to travel in the same channels of trade

to the same class of purchasers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d at 1268, 62 USPQ2d at 1005. Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identifications set forth in the application and cited registration uses broad wording to describe the type of goods and services being provided, and does not contain any limitations as to nature, type, channels of trade or classes of purchasers of the goods and services. Specifically, the applicant's providing "foods and beverages, retail store services featuring foods and beverages, the specific food goods, and beverages," are stated broadly, and have been demonstrated through the use of third-party registrations to emanate from the same source providing various types of restaurant, hotel and bar services. Therefore, it is presumed that the goods and/or services move in all normal channels of trade, and that they are available to each other's potential customers. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii).

Finally, the overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

## CONCLUSION

The evidence and arguments of record strongly support the examiner's position that refusal under Trademark Act Section 2(d) is proper. Applicant's mark is confusingly similar to the cited registration when used in connection with related goods and services. Therefore, it is respectfully submitted that the Section 2(d) refusal should be affirmed.

Respectfully submitted,

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