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0600-2-3005 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85636673

MARK: OCEANA GUMBO STEAKS SEAFOOD POBOYS



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GENERAL TRADEMARK INFORMATION:

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APPLICANT: Cajun Conti, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

0600-2-3005

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EXAMINING ATTORNEY'S APPEAL BRIEF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Cajun Conti, LLC : BEFORE THE

Trademark: OCEANA GUMBO STEAKS SEAFOOD : TRADEMARK TRIAL
POBOYS OYSTER BAR (AND DESIGN)

Serial No.: 85636673 : AND

Attorney: Mark N. Melasky : APPEAL BOARD

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the trademark OCEANA GUMBO STEAKS SEAFOOD POBOYS OYSTER BAR and design for "Restaurant services, including sit-down service of food and take-out restaurant services" in International Class 43 on the ground of likelihood of confusion, mistake, or deception under Trademark Act Section 2(d), 15 U.S.C. §1052(d), with the mark in Registration No. 3928634, OCEANANA, for "Hotel, motel, restaurant, bar and catering services" in International Class 43.

FACTS

Applicant filed its application on May 28, 2012, applying to register on the Principal Register the mark OCEANA GUMBO STEAKS SEAFOOD POBOYS OYSTER BAR and design for “Restaurant services, including sit-down service of food and take-out restaurant services”.

The examining attorney initially refused registration under Section 2(d) on the ground that the mark, when used in connection with the identified services, resembles the marks in Registration No. 2937731 OCEAN GRILL and Registration No. 3928634 OCEANANA for similar services. Registration was also refused based on the requirement for a mark description amendment and a disclaimer requirement. The examining attorney has since withdrawn the refusal under Section 2(d) based on Registration No. 2937731, and the applicant has satisfied the mark description and disclaimer requirements. The examining attorney then issued a final office action on April 1, 2013 continuing the Section 2(d) refusal against Registration No. 3928634 OCEANANA. The applicant then filed its Notice of Appeal with respect to the Section 2(d) refusal.

ISSUE

The sole issue presented on appeal is whether the proposed mark, when used on or in connection with the identified services, so resembles the mark in U.S. Registration No. 3928634 as to be likely to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Trademark Act.

ARGUMENT

THE MARKS ARE CONFUSINGLY SIMILAR AND THE SERVICES ARE RELATED SUCH THAT CONSUMERS ARE LIKELY TO BE CONFUSED, MISTAKEN OR DECEIVED AS TO THE SOURCE OF THE RESPECTIVE SERVICES.

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, mistaken, or deceived as

to the source of the services of the applicant and registrant. See 15 U.S.C. §1052(d). In the seminal decision *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the court listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). See TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one of the factors may control 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 this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the services, and similarity of the trade channels of the services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

The overriding concern is not only to prevent buyer confusion as to the source of the 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).

I. THE MARKS ARE HIGHLY SIMILAR BECAUSE THEY SHARE THE SIMILAR DOMINANT AND UNIQUE TERMS "OCEANA" AND "OCEANANA."

Applicant's mark OCEANA GUMBO STEAKS SEAFOOD POBOYS OYSTER BAR and design and the registrant's mark OCEANANA are similar because they contain the similar and unique terms of "OCEANA" and "OCEANANA" as the dominant terms in the marks.

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). Descriptive or generic matter is typically less significant or less dominant in relation to other wording in a mark. See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009). The applicant's mark contains the word "OCEANA" in large dominant font at the top of its mark. The wording "GUMBO STEAKS SEAFOOD POBOYS OYSTER BAR" appears in smaller font below the design element in the applied-for mark. The wording "GUMBO STEAKS SEAFOOD POBOYS OYSTER BAR" is disclaimed as it is merely descriptive language that serves only to inform a consumer as to the type or style of food served in the applicant's restaurants. Therefore, when referring to the applicant's services, consumers are likely to recall and therefore utilize the wording "OCEANA" as opposed to the applicant's entire mark, since consumers are likely to focus on the first or most prominent word in a mark. The registrant's mark consists of only the term OCEANANA. The applicant's term "OCEANA" is significantly similar to the registrant's mark aside from the fact that the registered mark contains an additional ending of "NA". The applicant's mere deletion of the lettering "NA" from the registered mark is not sufficient to overcome a likelihood of confusion. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010); *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii).

Therefore, the marks are similar when used in connection with the services in this comparison because of the presence of the terms "OCEANA" and "OCEANANA" in both marks, which are the dominant and source-indicating elements in the marks.

Furthermore, the fact that the applicant's mark features a design element does not obviate the similarity of the marks in this case. In this case, the applicant's mark contains the large and prominently

placed wording of "OCEANA" at the top of the mark and then below it, a design of a boat on water, a stylized crawfish, and a banner design containing the disclaimed wording, which appears in smaller sized font than the wording "OCEANA". 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 services. *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, the word portion 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)). Therefore, in this case the wording of "OCEANA" in the applicant's mark is most likely to be impressed upon the memory of the relevant consumer, and the applicant's inclusion of a design element does not obviate a finding of likelihood of confusion in this case.

In addition, the applicant and registrant's marks sound similar because of the presence of the word "OCEANA" in the applicant's mark. The term "OCEANA" in the applicant's mark and the registrant's mark OCEANANA sound similar because of the common prefix of "OCEANA" in both marks. Slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983). There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. See *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *Centraz Indus. Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006); TMEP §1207.01(b)(iv). For example, the registrant's mark OCEANANA could be pronounced as "OHSHEN-ANA", "OH-SHE-ANN-A", "OH-SHE-ANN-AH", "OH-SHEN-ANA", or "OH-SHUN-ANA", etc. which is similar to the pronunciation of the applicant's mark OCEANA as "OH-SHE-

ANA", "OH-SEE-AH-NA", "OH-SHUN-A", etc. The marks in question could clearly be pronounced in a similar manner and such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Lastly, the marks appear to connote similar commercial impressions when used in connection with the services in this comparison, i.e. a connotation of a connection to the ocean and/or a seafood restaurant. Both marks impress upon the minds of the consumers the idea of the ocean or sea because of the wording "OCEANA" and "OCEANANA." It is likely that consumers will assume that both marks are being used in connection with seafood restaurants when viewing the marks in this comparison. 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); TMEP §1207.01(b). Given the overall similarities in the mental connotations conveyed by both marks, it is likely that a consumer will be confused as to the source or origin of the marks.

Therefore, the marks are confusingly similar in regards to sound, appearance, and meaning.

APPLICANT'S ARGUMENTS

The applicant argues that the applied-for mark and the registered mark are not similar because the case law cited by the examining attorney reference marks that are not analogous to the marks in this comparison. *See Applicant's Appeal Brief, Page 4*. The applicant argues that because the marks, or some portion of the marks are not identical, the case law cited by the examining attorney is irrelevant.

The examining attorney disagrees. For example, the applicant notes that in *In re Vieterra Inc.*, the marks “X-Seed” and “XCEED” are pronounced identically, and that in *In re Nat’l Data Corp.*, the marks “The Cash Management Exchange” and “Cash Management Account” contained identical terms. *See Id.* The applicant argues that because the marks in this comparison do not share any identical terms that therefore the cases cited by the examining attorney are inappropriate. However, the examining attorney notes that the registrant’s mark OCEANANA begins with the identical prefix or initial lettering of “O-C-E-A-N-A”, which is identical to the applicant’s term “OCEANA”. Therefore, the cited case law by the examining attorney is relevant.

In addition, the applicant argues that the case law cited by the examining attorney in regards to disclaimed matter being viewed as less dominant wording is also inappropriate. *See Applicant’s Appeal Brief, Page 5.* Again, the examining attorney disagrees. As noted above, the placement of the disclaimed wording “GUMBO STEAKS SEAFOOD POBOYS OYSTER BAR” in the applicant’s mark is separate from the wording “OCEANA” in the applicant’s mark. This disclaimed wording appears separate from and below from the word “OCEANA.” The disclaimed wording also appears in smaller and less pronounced font than the word “OCEANA.” Lastly, the applicant’s design element in the mark separates the word “OCEANA” from the disclaimed wording. Therefore, it is appropriate in this case to view the applicant’s disclaimed matter as the less dominant wording in the applied-for mark, and it is likely that a consumer will focus on the wording “OCEANA” in the applicant’s mark, which is substantially similar to the registrant’s mark OCEANANA.

Furthermore, the applicant argues that the differences in pronunciation of the marks differentiate the marks in this comparison. The applicant notes that the cases cited by the examining attorney to show that slight differences in the sound of marks will not avoid a likelihood of confusion are not appropriate as the marks included in the cited cases were identical in either spelling or

pronunciation. *See Applicant's Appeal Brief, Pages 5-6.* For example, the applicant states that "[i]n further support of the rejection based on similarity of sounds, the Examiner also cites *In re Viterra Inc.*, where the confusingly similar marks were "X-Seed" and "XCEED." 671 F.3d at 1362. These two marks were identical in pronunciation and only different in a change in spelling to achieve the same sound." *See Applicant's Appeal Brief, Page 7 (sic).* Again, as the examining attorney noted above, there is no way to accurately predict how consumers will pronounce trademarks. Therefore, just as the marks "X-Seed" and "XCEED" are not identical in appearance or in spelling, neither are the marks in this current comparison, but yet, it is foreseeable that both marks could be pronounced similarly.

Therefore, the marks are substantially similar in regards to sound, appearance, and meaning.

II. THE SERVICES OF THE PARTIES ARE SUBSTANTIALLY SIMILAR

In addition to the marks being similar in sound, appearance, and meaning, the marks are also used in connection with substantially similar services. The applicant's mark is used in connection with "Restaurant services, including sit-down service of food and take-out restaurant services" and the registrant's mark is used in connection with "Hotel, motel, restaurant, bar and catering services." Therefore, the services are highly related because both the applicant and registrant feature "restaurant services." Lastly, the applicant does not dispute that the services are similar in this comparison. *See Applicant's Appeal Brief, Page 8.*

Therefore, the services of the applicant and registrant are substantially similar.

CONCLUSION

In conclusion, because the marks are confusingly similar and the services of the applicant and registrant are substantially similar, purchasers are likely to be confused or mistaken or deceived as to

the source of the services. For the foregoing reasons, the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d) should be affirmed.

Respectfully submitted,

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