

This Opinion is not a
Precedent of the TTAB

Mailed: June 22, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re G2D Management, LLC
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Serial No. 85703129
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Michael A. Cornman of Ladas & Parry LLP,
for G2D Management, LLC.

Tracy Cross, Trademark Examining Attorney, Law Office 109,
Dan Vavonese, Managing Attorney.

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Before Bucher, Ritchie and Wolfson,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

G2D Management, LLC (“Applicant”) seeks registration on the Principal
Register of the mark depicted below:



for “restaurant and bar services” in International Class 43.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), contending that Applicant’s use of its mark for its identified services is likely to cause confusion with the mark BACARO (in standard characters), registered for “restaurant and bar services” in International Class 43.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm.

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry

¹ Application Serial No. 85703129 was filed on August 14, 2012, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. The description of the mark reads: “The mark consists of the numbers ‘041’ in white on a red field, with ‘BACARO’ in white on a black field directly below.” The colors red, white and black are claimed as features of the mark. The term “Bacaro” has been disclaimed.

² Reg. No. 3443592, registered June 10, 2008; Sections 8 and 15 combined declaration accepted and acknowledged.

mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see also In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

A. The Services, Trade Channels and Relevant Consumers

The services as they are identified in Applicant’s application are identical to those identified in the cited registration, namely, “restaurant and bar services.” Because the services are identical, we must presume that the channels of trade and classes of purchasers are the same. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). Accordingly, the *du Pont* factors relating to the relatedness of the goods, channels of trade and classes of consumers strongly favor a finding of likelihood of confusion.

B. The Marks

Turning to the marks, we consider them in their entirety as to appearance, sound, connotation and commercial impression, to determine the similarity or dissimilarity between them. *Viterra*, 101 USPQ2d at 1908 (quoting *du Pont*); *Palm*

Bay, 73 USPQ2d at 1692. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather “whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). On the other hand, one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *National Data*, 224 USPQ at 751 (“There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.”). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014).

Applicant’s primary argument in favor of registration is that BACARO will be perceived by relevant consumers as meaning a “Venetian bar,” and therefore the

term is unregistrable as merely descriptive, or generic, for restaurants or bars that emulate those types of establishments in Venice, Italy. However, this argument is unavailable to Applicant because Applicant has not sought to cancel the cited registration. Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in connection with the goods or services identified in the certificate. Because of the presumption of validity, an applicant will not be heard on matters that constitute a collateral attack on the cited registration during *ex parte* prosecution, including an *ex parte* appeal. To properly challenge the validity of a registration cited by an examining attorney, a petition to cancel must be brought. *See, e.g., In re Dixie Rests.*, 41 USPQ2d at 1531 ("It is true that a *prima facie* presumption of validity may be rebutted. However, the present *ex parte* proceeding is not the proper forum for such a challenge.") (internal citations omitted); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992) ("Applicant's suggestion that registrant's mark is descriptive may not be considered inasmuch as that allegation comprises an attack on the validity of registrant's registration which is not permitted in an *ex parte* appeal proceeding."). *Cf.* 37 C.F.R. § 2.106(b)(2) ("An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.").

Applicant further argues that the cited mark is weak, in that consumers have become so accustomed to marks containing the term BACARO that they look to other components in such marks to distinguish among them. In support of this argument, Applicant submits the results of two Google searches (for the term “bacaro” and the phrase “bacaro meaning”) and copies of pages that appear to be from a tour company’s website, offering tours of Venice “bacari.”³

The Google search results have little probative value as evidence, as they are merely truncated listings and not full search results. They do not show the context in which the term “bacaro” is used or provide a clear definition of the term. While many of the listings appear to be for a restaurant, given the paucity of information identifying each establishment, they could easily all refer to a single restaurant or a group of commonly owned restaurants; in this regard we note the majority of the listings identify New York City as such establishment’s location. Some references are ambiguous or irrelevant: one listing appears to refer to an apartment complex, one to a tour of Venice, one to a Groupon offering. One entry refers to Applicant, and a few are for establishments outside the United States. Accordingly, the references do not demonstrate such widespread use of the term “bacaro” for restaurants or bars that consumers would be accustomed to distinguishing marks using the term on the basis of other components in the marks. *See In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (deeming list of Google search

³ The Google searches are attached to Applicant’s request for reconsideration; the description of the tour facilities is attached to Applicant’s response to the Office Action dated October 5, 2012.

result summaries to be “of little value in assessing the consumer public perception of the ASPIRINA mark” because they provide “very little context of the use of ASPIRINA”); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011) (“search summary of results from the Google search engine” given no consideration); *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008) (finding truncated Google search results entitled to little probative weight). Accordingly, while we have considered the evidence, it is of little value in assessing consumer public perception of BACARO as applied to restaurant or bar services.

As for the tour guide webpages, described by Applicant as a “description of a tour of such facilities in Venice including a definition of ‘bacaro’ and a list of the bacari on the tour,” the evidence is problematic because all of the eateries named in the article are located in Venice, Italy. Thus, although the article is in English, U.S. consumers are likely to view the use of “bacaro” in the article as simply providing general information about restaurants or bars located in Venice, Italy, and that the term refers only to these overseas establishments. Moreover, while we presume the website is available to U.S. customers, the record does not show the extent of U.S. consumer exposure to the website or that the term “bacaro” applies to bars in the United States. *See In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1265 n.9 (TTAB 2011) (no basis to conclude U.S. consumers exposed to website for Australian brewery; those webpages not considered); *cf. In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1050 (TTAB 2006) (while consumers may visit foreign websites for

informational purposes, they are more likely to focus on local Internet retailers; impact of foreign websites discounted).

The Examining Attorney has also submitted copies of pages from both Applicant's and registrant's websites, showing that both Applicant and registrant recognize the Italian origins of the term "bacaro." However, this does not persuade us that consumers would perceive registrant's mark to be weak, but merely underscores the foreign regional nature of the term "bacaro." Applicant's voluntary disclaimer of the term does not alter this finding. A mark is not rendered registrable with a voluntary disclaimer of an allegedly merely descriptive component, and our comparison of Applicant's and registrant's marks is not affected thereby. *See In re National Data*, 224 USPQ at 751 (finding the "technicality of a disclaimer in [an application to register a trademark] has no legal effect on the issue of likelihood of confusion"); *In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm'r Pats. 1991) (no express prohibition against allowing an applicant to voluntarily disclaim otherwise registrable matter).

Turning now to a comparison of the marks in terms of their sight, sound, meaning and commercial impressions, we first note that Applicant has incorporated registrant's entire mark as a significant feature of its own mark. Likelihood of confusion has frequently been found where one mark incorporates the entirety of another mark, even where one mark includes a design feature. *See Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (CCPA 1977) (finding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar);

Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc., 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (finding BENGAL for gin and BENGAL LANCER and design confusingly similar); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE and design for automotive service stations held likely to be confused with ACCUTUNE for automotive testing equipment). Applicant argues that the "041" feature and the color combination serve to distinguish the marks. Despite the larger size of the numbers in the mark, however, the term BACARO is a salient feature of the mark and as such is equally prominent to "041." Moreover, consumers are more likely to remember a pronounceable term such as "bacaro" rather than an arbitrary string of numbers. The additional design elements and colors in the mark are background to the literal portions and as such are of lesser significance. Further, while these give Applicant's mark a different appearance from the cited mark as it appears on the registration certificate, because the cited mark is depicted in standard characters, registrant could also display its mark in the same font style as Applicant's mark. The rights due the registered mark reside in the wording or other literal elements and not in any particular display or rendition thereof. *See Viterra*, 101 USPQ2d at 1909; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010). Regarding the meaning of the marks, to the extent "bacaro" connotes or suggests an Italian-style bar or restaurant, the marks also share the same meaning. Applicant apparently selected the numbers because 041 serves as the telephone area code for Venice, Italy;⁴ thus underscoring the

⁴ From Applicant's website at <http://www.041barcaro.com>, attached to Applicant's response to Final Office Action.

connection that BACARO makes to an Italian-style bar or restaurant. The marks are similar in sight, sound, meaning and commercial impression.

II. Conclusion

Considering Applicant's mark in its entirety, and that the entirety of the registered mark, having no demonstrated weakness, has been incorporated into Applicant's mark, we find the overall commercial impressions of the marks are more similar than dissimilar and not so different as to avoid a likelihood of confusion. We also bear in mind that the marks will be used on identical services, which reduces the degree of similarity between the marks necessary to find a likelihood of confusion. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 94 USPQ2d at 1260; *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010). The legal identity of the services also gives rise to the presumption that Applicant's and registrant's services are likely to be offered to the same classes of consumers through similar trade channels. For these reasons, we find that Applicant's mark is likely to cause confusion with the registered mark.

Decision: The refusal to register Applicant's mark  is affirmed.