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Subject: U.S. TRADEMARK APPLICATION NO. 85867859 - CASA DO FADO - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85867859 **MARK:** CASA DO FADO	
CORRESPONDENT ADDRESS: PAULO A DE ALMEIDA PATEL & ALMEIDA PC 16830 VENTURA BLVD STE 360 ENCINO, CA 91436	**GENERAL TRADEMARK INFORMATION:** http://www.uspto.gov/trademarks/index.jsp **TTAB INFORMATION:** http://www.uspto.gov/trademarks/process/appeal/index.jsp
APPLICANT: ANA ROSA NETO CELESTINO CAMPINA	
CORRESPONDENT'S REFERENCE/DOCKET NO: N/A **CORRESPONDENT E-MAIL ADDRESS:** Paulo@PatelAlmeida.com	

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant appealed the Trademark Examining Attorney's final refusal to register the mark CASA DO FADO (for "Hotel and restaurant services") on the ground that the mark, under Trademark Act Section 2(d), 15 U.S.C. §1052(d), is likely to be confused with U.S. Registration Nos. 2006347 and 2019165.

I. FACTS

Applicant, composed of individuals Ana Rosa Neto Celestino Campina and Carlos Alberto Damiaõ Barroqueiro, applied for registration on the Principal Register for the special form drawing CASA DO FADO for "Hotel and restaurant services." Registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), based on a likelihood of confusion with Registration Nos. 2006347 and 2019165 for the stylized and special form marks FADÓ, each for "restaurant services." The registered marks are owned by the same entity. This appeal now follows the Trademark Examining Attorney's final refusal to register under Section 2(d) of the Trademark Act.

II. ARGUMENT

APPLICANT'S AND REGISTRANT'S MARKS ARE CONFUSINGLY SIMILAR IN OVERALL COMMERCIAL IMPRESSION AND THE SERVICES ARE IDENTICAL IN PART AND OTHERWISE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely 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). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). 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).

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. *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, 1026 (Fed. Cir. 1988).

A. The marks are composed in significant part of phonetically identical wording.

The marks must be compared for similarities in sound, appearance, meaning, or connotation. *E.I. du Pont de Nemours*, 476 F.2d 1357, 1361. Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755, 757 (TTAB 1977). When the 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 offered under applicant's and registrant's marks is likely to result. *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012). The primary 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 at 1438; *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). When an applicant's mark is compared to a registered mark, "the

points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37 (D.C. Cir.), *cert. denied*, 351 U.S. 973 (1956).

As here, where the services of an applicant and registrant are identical in part, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse services. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010). Further, where the services "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004). Here, the services of applicant and registrant are identical in part and otherwise closely related.

Applicant seeks to register the mark CASA DO FADO with the design of a guitar. The registered marks each consists of the literal element FADÓ: one of the registered marks is FADÓ in a simple stylized form and the other is the wording FADÓ contained within a rectangular shape and featuring a design element.

Marks must be compared in their entireties and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1322, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[I]n articulating reasons for reaching a conclusion on the issue of confusion, 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.")).

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. *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)); *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. *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)). Here, the dominant wording in applicant's mark is CASA DO FADO and the wording in registrant's marks is FADÓ.

Applicant has merely added the weakly suggestive wording CASA DO (meaning "HOUSE OF") to a phonetic equivalent of the registrant's marks. Adding a term, especially a term composed of weaker wording, to a registered mark generally does not obviate the similarity between the compared marks 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). In other words, applicant's addition of the wording CASA DO to registrant's FADÓ marks is not sufficient to avoid a likelihood of confusion. In the present case, the word portions of the marks are literally and phonetically identical in part and substantially similar in overall appearance, meaning, connotation, and commercial impression, and factors that favor finding applicant's and registrant's marks are likely to be confused by consumers.

Although applicant likens the facts here to *In re Fairview Imp. Corp.*, 2013 TTAB LEXIS 447 (TTAB Aug. 16, 2013, not precedential), where a prominent design distinguished marks with identical wording, the Board based its decision in large part on the third party usage evidence of record showing the weakness of the shared wording, HERITAGE, in the applied-for and registered marks. Specifically, the Board determined that "the term HERITAGE is not a term with strong source-identifying significance, and that the cited registration is accordingly entitled to a narrower scope of protection." *In re Fairview Imp. Corp.* at 8-9. Here, applicant has not provided any evidence showing weakness of the shared wording based on third party usage of the word FADO in connection with the relevant services. Although it is clear that the facts and record in this case are not analogous to those established in *In re Fairview Imp. Corp.* – applicant has not provided evidence or otherwise established the shared wording is weak – each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

Applicant further argues that, in light of the stylization and guitar design element featured in the applied-for mark, consumers are likely able to distinguish between the marks because FADO/FADÓ have different meanings in the context of the services provided by applicant and registrant as indicated by extrinsic evidence. However, the question of likelihood of confusion is determined based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). The identifications do not indicate any particular theme, and therefore applicant's and registrant's services are presumed to include all restaurant types, including the specified services in the style of Ireland, Portugal, or any other country or theme, and therefore, the interpretation of consumers in all restaurant contexts.

Further, applicant has not provided any evidence for the record showing that consumers of restaurant services and/or hotel services are likely to distinguish between the meaning of the phonetically identical "FADO" in applicant's mark and "FADÓ" in registrant's marks. On the contrary, "FADO" and "FADÓ" are phonetically identical and virtually identical visually. 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). The wording "FADO" and "FADÓ" in the marks in question could clearly be pronounced the same. 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). Even 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); *see In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012). In other words, consumers are likely to pronounce a significant portion of applicant's and registrant's marks identically, and even if consumers pronounce the wording somewhat differently, the slight differences are insufficient to avoid a likelihood of confusion.

Because the dominant word portion of the marks, which consumers will use to call for identical and closely related services, are composed in part of phonetically identical wording that is also virtually identical in appearance, the factor of similarity of the marks favors a finding of likelihood of confusion.

B. The identified services are identical in part and otherwise closely related.

In a likelihood of confusion analysis, the 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). The respective services need only be "related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011). Generally, the greater degree of similarity between the applied-for mark and the registered mark, the lesser the degree of similarity between the services of the respective parties that is required to support a finding of likelihood of confusion. *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009).

Applicant has identified the following services: "Hotel and restaurant services." The registrations each specify "restaurant services."

Absent restrictions in an application and/or registration, the identified services are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, with respect to applicant's "restaurant services," the identifications set forth in the application and registrations are identical and have no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers. *See Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). Accordingly, the

restaurant services of applicant and the registrant are considered related for purposes of the likelihood of confusion analysis.

Furthermore, hotel services and restaurant services are related because the services are encountered by the same set of consumers and are commonly provided under the same mark. That applicant's identification indicates both hotel services and restaurant services demonstrates, on the face of the application, consumers familiar with applicant's services would presume that hotel and restaurant services emanate from the same source.

The record contains evidence, in part detailed below, from the websites of The Brick, The View, The Charlotte Hotel & Restaurant, The Edgewater, Hotel deLuxe, Stanford Park Hotel, and others. This evidence clearly establishes that the same entity commonly provides the relevant services and markets the services under the same mark and that the relevant services are provided through the same trade channels and used by the same classes of consumers in the same fields of use. Therefore, applicant's hotel services and registrant's restaurant services are considered related for likelihood of confusion purposes. *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). *See e.g.:*

- The web pages from http://brickhotelrestaurant.com (The Brick) show the same brand used to indicate source of a hotel and restaurant. Office action dated July 14, 2014, at pp. 49-50.

- The web pages from http://monumentvalleyview.com (The View) show the same brand used to indicate source of a hotel and restaurant. Office action dated July 14, 2014, at pp. 58-60.

- The web page from http://www.thecharlottehotel.com (The Charlotte Hotel & Restaurant) show the same brand used to indicate source of a hotel and restaurant. Office action dated July 14, 2014, at p. 70.

- The web pages from http://www.edgewaterhotel.com (The Edgewater) show a single brand used to indicate source of a hotel featuring restaurant services. Office action dated July 14, 2014, at pp. 54-57.

- The web pages from http://www.hoteldeluxeportland.com (Hotel deLuxe) show a single brand used to indicate source of a hotel featuring restaurant services. Office action dated July 14, 2014, at pp. 71-72.

- The web pages from http://www.stanfordparkhotel.com (Stanford Park Hotel) show a single brand used to indicate source of a hotel featuring restaurant services. Office action dated July 14, 2014, at pp. 73-75.

Finally, the trademark examining attorney has also made of record evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar services as those of both applicant and registrant in this case. Please see evidence attached to Office action dated July 14, 2014, at pp. 2-48 for registrations showing entities that provide both restaurant and hotel services, such as:

- **Design only mark (owned by Kahler Hotels LLC)**, U.S. Registration No. 4549586 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 2-3.

- **HAIYI**, U.S. Registration No. 4010240 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 4-5.

- **HAWAIIAN VILLAGE**, U.S. Registration No. 3953864 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 6-7.

- **SUNDARA INN & SPA**, U.S. Registration No. 3934586 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 8-10.

- **SHANTY CREEK RESORTS**, U.S. Registration No. 3973825 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 11-13.

- **M LIFE**, U.S. Registration No. 4092023 for "Hotel and restaurant services for preferred customers." Office action dated July 14, 2014, at pp. 14-15.

- **THE BASIC**, U.S. Registration No. 4218643 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 16-17.

- **CABINS RESORT**, U.S. Registration No. 4097314 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 18-20.

- **DAVENPORT TOWER**, U.S. Registration No. 4049286 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 21-22.

- **NV HOTELS & RESORTS**, U.S. Registration No. 4176797 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 23-24.

- **JUST INN**, U.S. Registration No. 4104668 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 25-27.

- **CIRCULAR DINING ROOM**, U.S. Registration No. 4212484 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 28-30.

- **TIMBERLAKE LODGE**, U.S. Registration No. 4117953 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 31-32.

- **DANCING RABBIT INN**, U.S. Registration No. 4415345 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 33-35.

- **SWINOMISH**, U.S. Registration No. 4249034 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 36-37.

- **Design only mark (owned by Resort Property Holding)**, U.S. Registration No. 4190627 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 38-39.

- **THE BREWHOUSE INN & SUITES B**, U.S. Registration No. 4400895 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 40-42.

- **FIRMDALE HOTELS**, U.S. Registration No. 4486955 for "Hotel, resort hotel and and restaurant services." Office action dated July 14, 2014, at pp. 43-44.

- **PEACOCK CLUB**, U.S. Registration No. 4360781 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 45-46.

- **WEDMORE PLACE**, U.S. Registration No. 4510776 for "Hotel and restaurant services." Office action dated July 14, 2014, at pp. 47-48.

This evidence tends to show that the services listed therein are of a kind that may emanate from a single source under a single mark. *See In re Davey Prods. Pty Ltd*., 92 USPQ2d 1198, 1203 (TTAB 2009); *In re Albert Trostel & Sons Co*., 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co*., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

Therefore, based on the identification of services in the application and registrations and the evidence of record, the services are related because they are identical in part, with respect to restaurants, and otherwise, with respect to applicant's hotel services, commonly provided by the same establishments to an identical set of consumers. Thus, the factor of the relatedness of the services strongly favors a finding of likelihood of confusion.

III. CONCLUSION

Because the marks are identical in dominant portion and the services are identical in part and otherwise closely related, consumers encountering the applicant's mark and the registered mark in the marketplace are likely to mistakenly believe that the services emanate from a common source. For the foregoing reasons, the refusal to register under Section 2(d) of the Trademark Act should, therefore, be affirmed.

Respectfully submitted,

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