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Subject: U.S. TRADEMARK APPLICATION NO. 85939425 - THOSE WHO KNOW EAT AT SMOKEY MO'S -
801288 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

<p>U.S. APPLICATION SERIAL NOS. 85939425, 85939513, 85939692</p> <p>MARKS: THOSE WHO KNOW EAT AT SMOKEY MO'S, SMOKEY MO'S BBQ, SMOKEY MO'S BAR-B-Q</p>	
<p>CORRESPONDENT ADDRESS: GAIL TAYLOR RUSSELL TAYLOR RUSSELL & RUSSELL PC 10601 FARM RD 2222 STE R-12 AUSTIN, TX 78730-1134</p>	<p>GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp</p> <p>TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp</p>
<p>APPLICANT: Smokey Mo's Bar-B-Q, LLC</p>	
<p>CORRESPONDENT'S REFERENCE/DOCKET NO: 801288</p> <p>CORRESPONDENT E-MAIL ADDRESS: gtrussell@russell-law.com</p>	

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the proposed service marks "THOSE WHO KNOW EAT AT SMOKEY MO'S," (Serial No. 85939425) "SMOKEY MO'S BBQ"

(85939513) and "SMOKEY MO'S BAR-B-Q" (85939692) all for use in connection with "restaurant and catering services" under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

FACTS

On May 22, 2013 the applicant filed applications under Section 1(b) of the Trademark Act for the marks "THOSE WHO KNOW EAT AT SMOKEY MO'S," "SMOKEY MO'S BBQ" and "SMOKEY MO'S BAR-B-Q" all in standard characters and all for use in connection with "restaurant and catering services". Registration was refused under Section 2(d) because of a likelihood of confusion with U.S. Registration No. 2773992, "SMOKIN' MO'S BBQ PIG OUT 'MO BARBEQUE PLEASE!" (in special form) used in connection with "restaurants, [and] catering". The applicant established that "MO" is the name of a living individual, Morris Melchor, whose consent was made of record. The applicant provided required disclaimers for "BBQ" and "BAR-B-Q". The issue on appeal is whether a likelihood of confusion exists between the applicant's marks and the mark in the cited registration. The three cases have been consolidated for consideration of the same issue.

ARGUMENT

A LIKELIHOOD OF CONFUSION EXISTS BETWEEN THE MARKS "THOSE WHO KNOW EAT AT SMOKEY MO'S," "SMOKEY MO'S BBQ" and "SMOKEY MO'S BAR-B-Q" (ALL IN STANDARD CHARACTERS) AND THE REGISTERED MARK "SMOKIN' MO'S BBQ PIG OUT 'MO BARBEQUE PLEASE!" (IN SPECIAL FORM), BECAUSE THE DOMINANT WORDING IN THE MARKS, *SMOKEY MO'S* AND *SMOKIN' MO'S*, CREATES THE SAME COMMERCIAL IMPRESSION WHEN USED WITH THE SERVICES.

A. THE APPLICANT'S MARK AND THE MARK IN THE CITED REGISTRATION ARE SIMILAR IN
COMMERCIAL IMPRESSION

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); TMEP §1207.01(b).

The wording SMOKEY MO'S in the applicant's marks and SMOKIN' MO'S in the registrant's mark create a highly similar commercial impression, in that they would appear to identify the same proprietor.

Furthermore, two of the applicant's marks refer to "BBQ" or "BAR-B-Q" as does the registrant's mark that references "BBQ" and "BARBECUE", further suggesting a relatedness between the marks. 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 terms of their overall commercial impression that confusion as to the source of the services offered under the respective 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); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

The applicant argues that its marks are different in appearance from those of the registrant. The difference between SMOKEY and SMOKIN' in the marks is negligible when coupled with the same name, MO'S, and when commonly used in the context of additional indicia that references barbeque or food services. The applicant has applied for three different marks, all similar to each other, but all with SMOKEY MO'S accompanied by different indicia. These marks are all used as a source identifier for services from the same source, e.g., all used with the same services rendered by the applicant as evidenced by the specimens of record.

The applicant's marks are all in standard characters and the cited registrant's mark is in special form featuring an overall circular design bearing a personified pig with chef's hat and spoon, above a quadrilateral carrier bearing a slogan referencing barbeque. The applicant asserts that the pig design in the registrant's mark is the dominant element in the cited registration; however, 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)); 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)). The wording in the special form mark is "SMOKIN' MO'S BBQ PIG OUT 'MO BARBEQUE PLEASE!" The dominant element is the wording SMOKIN' MO'S. 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)).

In this case, consumers would refer to the wording SMOKIN' MO'S when speaking of the registrant's establishment and services despite the presence of the other elements in the registrant's mark.

The applicant's marks are all in standard characters. Marks in 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 with design elements generally will not avoid likelihood of confusion with a mark in 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"). Nothing prohibits the presentation or use of standard character marks with same or similar slogans that are the same or similar to those used by the registrant.

The wording SMOKEY MO'S and SMOKIN' MO'S are the dominant elements 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). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See *In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751.

The additional wording in the applicant's marks is descriptive of a primary feature of the services,

barbeque, and an invitation to partake of the services rendered in connection with the marks. The additional wording does not detract from the dominant elements of the marks that would be remembered as the source indicating indicia in the various marks that consumers would understand to be SMOKEY MO'S and SMOKIN' MO'S.

That the marks do not sound alike does not detract from the overall commercial impression of the marks in which SMOKEY MO'S and SMOKIN' MO'S are the most memorable portion of the marks and that portion likely to be repeated when speaking to others about the applicant's or registrant's services. The pig design suggests the kind of meat featured by the registrant's services, particularly because pig meat or pork is a common barbecued meat as evidenced by the attached evidence regarding barbecues & grilling at <http://bbq.about.com/cs/barbecuetips/a/aa032198a.htm> that was provided with the first Office action on September 12, 2013, Attachments 6, 7, 8 (TSDR).

B. THE SERVICES OF THE PARTIES ARE IDENTICAL

When analyzing an applicant's and registrant's services for similarity and relatedness, that determination is based on the description of the services stated 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).

Absent restrictions in an application and registration, the identified 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 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 registration(s) 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 services of applicant and the registrant(s) are considered related for purposes of the likelihood of confusion analysis.

Where the services of an applicant and registrant are identical or virtually identical, 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 *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014) (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)); TMEP §1207.01(b).

The applicant's marks are for use with "restaurant and catering services." The registrant's mark is used in connection with "restaurants, catering." The marks of both parties are used in connection with the same services. The references to BBQ, BAR-B-QUE and BARBEQUE in the applicant's marks "SMOKEY

MO'S BBQ" and "SMOKEY MO'S BAR-B-Q" and in the registrant's mark, "SMOKIN' MO'S BBQ PIG OUT 'MO BARBEQUE PLEASE!", suggests that the services of the parties all feature similar food offerings. While the applicant's mark, "THOSE WHO KNOW EAT AT SMOKEY MO'S," does not speak to barbecue, it is but one of a group of marks for the same services and the use of the same wording, SMOKEY MO'S, suggests that the mark is used with similar cuisine. This is supported by the specimen of record. Even if that mark is not used with restaurant and catering services featuring barbecue, the dominant element of the marks is the same as that of the cited registrant, and the services of both parties are identical.

The several marks using the terms BBQ, BAR-B-QUE and BARBECUE all reference foods that are commonly smoked as evidenced by the web evidence referenced above. The term SMOKEY or SMOKIN' used with barbecue services is highly suggestive coupled with the same name, MO. The marks of both parties associate the smoking process of barbecuing with "MO". Again, while consumers tend to remember things generally and not specifically, the difference in the two words SMOKEY and SMOKIN', used in the context of food provision services that feature foods that are commonly smoked, do not serve to distinguish the services of either party from those of the other.

Consumers, upon encountering the SMOKEY MO'S or SMOKIN' MO'S marks used with restaurant and catering services, are likely to believe that the services emanate from a common source.

Overall, the similarities among the marks and the services are so great as to create a likelihood of confusion. The examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988).

CONCLUSION

The applicant's marks, "THOSE WHO KNOW EAT AT SMOKEY MO'S," "SMOKEY MO'S BBQ" and "SMOKEY MO'S BAR-B-Q" and the cited registration, "SMOKIN' MO'S BBQ PIG OUT 'MO BARBEQUE PLEASE!" create a highly similar commercial impression used with restaurant and catering services. Therefore, a likelihood of confusion exists. The Board is requested to affirm the refusal to register the mark under Section 2(d) of the Trademark Act.

Respectfully submitted,

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