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Subject: U.S. TRADEMARK APPLICATION NO. 85969508 - THE KITCHEN - 75159.0016 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85969508

MARK: THE KITCHEN



CORRESPONDENT ADDRESS:

ANDREW ROPPEL

HOLLAND & HART LLP

PO BOX 8749

DENVER, CO 80201-8749

GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: The Kitchen Cafe, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

75159.0016

CORRESPONDENT E-MAIL ADDRESS:

docket@hollandhart.com

EXAMINING ATTORNEY'S APPEAL BRIEF

The Kitchen Cafe, LLC ["applicant"], has appealed the final refusal to register the mark **THE KITCHEN** for "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 No. 3,792,358 for the standard character

mark **DA KITCHEN**, used in connection with, in relevant part, “Restaurant services; carry out restaurant services; [and] catering services.”

I. FACTS

Applicant’s Section 1(a) application was received by the United States Patent and Trademark Office on June 25, 2013. On October 3, 2013, the examining attorney originally assigned to review the application¹ issued the first Office Action in this case, refusing registration under Trademark Act Sections 2(d) and 2(e)(1), having found that (1) there was a likelihood of confusion between applicant’s mark and U.S. Registration Nos. 3,350,493 and 3,792,358, and (2) applicant’s mark was merely descriptive of its services. Additionally, several prior-pending applications were cited as potential grounds for refusal under Section 2(d), and applicant’s claim of acquired distinctiveness under Section 2(f), based on five years’ use in commerce, was found insufficient. On April 3, 2014, the applicant responded by requesting a suspension of its application pending the disposition of the cited pending applications. On April 7, 2014, the examining attorney suspended the application pending the disposition of one pending application and continued and maintained the refusals under Section 2(d) and Section 2(e)(1), as well as the finding that applicant had not proven acquired distinctiveness under Section 2(f). On October 21, 2014, the examining attorney issued an Office Action, resuming action on the application while noting that the suspension had been lifted due to the abandonment of U.S. Application Serial No. 85741893. Accordingly, the previous refusals were made final, applicant having failed to respond to the refusals in its April 3, 2014 suspension request. On April 21, 2015, applicant filed a Request for Reconsideration that included a response to the Section 2(d) refusal as well as a new Section 2(f) claim based on applicant’s ownership of two registrations on the Principal Register for the same mark for the same services. The examining attorney denied applicant’s request for reconsideration on April 24, 2015, for

¹ The case was reassigned to the undersigned examining attorney to address the appeal.

while the claim of acquired distinctiveness based on the prior registrations obviated the Section 2(e)(1) refusal, and the Section 2(d) refusal with respect to U.S. Registration No. 3,191,490 was withdrawn, the examining attorney maintained the Section 2(d) refusal with respect to U.S. Registration No. 3,792,358, to which applicant now appeals.

II. OBJECTION TO NEW EVIDENCE

Applicant has submitted new evidence with its appeal brief. Specifically, applicant has attached evidence from IRISHABROAD.COM, THEJOURNAL.IE, NEWS.YAHOO.COM, RUSSIANLESSONS.NET, BOOKS.GOOGLE.COM, SPEAKSHEETS.COM, WIKIPEDIA.COM, YELP.COM, DAKINEHAWAIIAN.NET, INDOSURFLIFE.COM, DAHUI.COM, DAKINEBAIL.COM, DALOCALBANANA.COM, KAHUMOKU.COM, AMAZON.COM, ALTERNATIVE-HAWAII.COM, DAPINKHOUSE.COM, DAHAWAIIANKITCHEN.COM, BAYLORBEARS.COM, BROWNBARS.COM, GOBLACKBEARS.COM, ONUSPORTS.COM, MISSOURISTATEBEARS.COM, POTSDAMBEARS.COM, CALBEARS.COM, and BEARSPORTS.WUSTL.EDU. In fact, all of the evidence attached to applicant's appeal brief was not part of the record prior to the appeal.

The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. *See In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d 1593, 1596 (TTAB 2014); *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

III. ISSUE

THE MARKS ARE CONFUSINGLY SIMILAR IN OVERALL COMMERCIAL IMPRESSION AND THE SERVICES ARE IDENTICAL 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). 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); TMEP §§1207.01 *et seq.*

A. The services are identical.

The applicant identifies its services as “Restaurant services.” Registrant uses the cited mark in connection with “Restaurant services; carry out restaurant services; [and] catering services.”

As neither the application nor the registration restrict the nature, type, channels of trade, or classes of purchasers, the examining attorney must presume 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). The

respective services are therefore identical under any meaningful analysis. Applicant has not contested this determination.

The examining attorney notes that where the services of an applicant and registrant are identical, as is the case here, 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 Vitterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

B. The marks are nearly identical in sound and connotation.

Applicant seeks to register the mark **THE KITCHEN**. The registered mark is **DA KITCHEN**. 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 Vitterra 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. In both applicant's and registrant's marks, the dominant term is "**KITCHEN**". Therefore, the marks are identical except to the extent that the term **DA** creates a commercial impression distinct from the term **THE**.

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); 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); TMEP §1207.01(b). Here, although the marks differ in terms of the spelling of the first article, the lasting impression of **THE KITCHEN** is identical to the impression created by **DA KITCHEN**.

The examining attorney has provided evidence that the slang word **DA** is pronounced and widely understood as a virtual equivalent of **THE**. See Office Action dated 4/24/2015. The evidence of record also demonstrates that **DA** refers to the manner in which **THE** is colloquially pronounced in many different accent regions across the United States of America, including significant population centers such as Chicago and New York. Office Action dated 4/24/2015, at 7. It is not a uniquely Hawaiian phenomenon, as claimed by applicant. Spoken aloud, **DA** sounds virtually identical to **THE**, with only a slight noticeable difference in the opening consonant. 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). The marks are essentially phonetic equivalents and thus sound similar. 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); TMEP §1207.01(b)(iv).

Additionally, consumer confusion has been held likely for marks that do not physically look alike but convey the same idea, stimulate the same mental reaction, or have the same overall meaning. See *In re M. Serman & Co.*, 223 USPQ 52, 53 (TTAB 1984) (holding CITY WOMAN for ladies' blouses likely to be confused with CITY GIRL for a variety of female clothing); TMEP §1207.01(b). Here, although **DA** has a different appearance than **THE**, the two marks convey the exact same idea, mental reaction, and overall meaning due to the fact that **DA** is a slang equivalent of **THE**, sounding nearly identical and performing the exact same linguistic function.

Applicant argues that, due to the existence of multiple third party registrations which include the term **KITCHEN**, the term is weak and therefore deserves little protection. It is true that the term

KITCHEN is highly descriptive. In fact, it is disclaimed in every single one of the third party registrations cited by applicant in its Appeal Brief, all of which contain additional distinctive elements. However, marks must be considered in their entireties; therefore, a disclaimer does not remove the disclaimed portion from the mark for the purposes of comparing marks in a likelihood of confusion determination. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). The public is generally not aware of disclaimers in trademark applications and registrations that reside only in the USPTO's records. See *In re Nat'l Data Corp.*, 753 F.2d 1056, 1059, 224 USPQ 749, 751 (Fed. Cir. 1985). Accordingly, the term "**KITCHEN**" must be considered when analyzing the likelihood of confusion between "**DA KITCHEN**" and "**THE KITCHEN**". The analysis is not just a comparison of "**DA**" and "**THE**". Comparing these two marks in their entireties further establishes that they are virtually identical and a very strong likelihood of confusion exists.

Additionally, 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 services. 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) (likelihood of confusion is "to be avoided, as much between 'weak' marks as between 'strong' marks, or as between a 'weak' and 'strong mark'").

Based on the above analysis, which establishes that **THE KITCHEN** and **DA KITCHEN** are nearly identical in sound and meaning, the factor of similarity of the marks strongly favors a finding of likelihood of confusion.

IV. CONCLUSION

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).

Because the marks are virtually identical and the services are identical, 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 examining attorney respectfully requests that the refusal of registration under Section 2(d) of the Trademark Act be affirmed.

Respectfully submitted,

/John S. Miranda/

Examining Attorney

Law Office 120

(571) 272-4553

John.Miranda@USPTO.gov

Michael W. Baird

Managing Attorney

Law Office 120