

This Opinion is not a
Precedent of the TTAB

Mailed: December 19, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ben Zour

Serial No. 87210472


Robert J. Makar and Ruth Khalsa of Raj Abhyanker, P.C.
for Yishay Ben Zour.

Brandon N. Marsh, Trademark Examining Attorney, Law Office 112,
Angela Bishop Wilson, Managing Attorney.

Before Kuhlke, Adlin and Gorowitz,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Yishay Ben Zour (“Applicant”) seeks registration on the Principal Register of the

mark  for “coffee shops,” in International Class 43.¹ The application includes a disclaimer of “ARTISAN COFFEE” and this description of the mark: “The mark consists of the literal elements ‘SHEPHERD’, centered within a double-outlined and lightly shade rectangular field with rounded corners. Beneath

¹ Application Serial No. 87210372 was filed on October 20, 2016, 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 rectangle the literal elements ‘ARTISAN COFFEE’, flanked between two horizontal lines. On either side of the rectangle are stylized medallion shapes containing free-form decorations that appear to be carved in bas relief.” Color is not claimed as a feature of the mark.

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) on the ground that it so resembles the registered marks SHEPHARD’S BEACH RESORT (in standard



characters)² and SHEPHARD’S BEACH RESORT³ for “hotel services and restaurant services,” as to be likely to cause confusion, mistake or deception. Both of the cited registrations are owned by Shephard’s Beach Resort, Inc.

When the refusal was made final, Applicant appealed. We reverse the refusal to register.

I. Likelihood of Confusion.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities

² Registration No. 4671018, registered January 13, 2015 with a Section 2(f) claim and a disclaimer of “Beach Resort.”

³ Registration No. 4681186, registered February 3, 2016,

between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

A. Similarity of services, channels of trade and class of customers.

We start our analysis with the second and third *du Pont* factors, the similarity of the services, the channels of trade, and the class of customers. When determining the relationship between the services,

[i]t is well settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the [services] as they are identified in the involved application and cited registration, rather than on what any evidence may show as to the actual nature of the [services], their channels of trade and/or classes of purchasers.

In re Total Quality Group Inc., 51 USPQ2d 1474, 1476 (TTAB 1999). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-1162 (Fed. Cir. 2014). “In comparing the . . . [services], ‘[t]he issue to be determined . . . is not whether the [services] . . . are likely to be confused but rather whether there is a likelihood that purchasers will be misled into the belief that they emanate from a common source.’” *Anheuser-Busch, LLC v. Innvopak Sys. Pty. Ltd.*, 115 USPQ2d 1816, 1825 (TTAB 2015) (quoting *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989)).

Applicant intends to use its mark for “coffee shops.” Applicant concedes that coffee shops are defined as “small restaurants,”⁴

The point, however, is that Applicant’s services are encompassed by those in both of the cited registrations: “restaurant services.” The dictionary definition bears this out and Applicant effectively concedes it. Thus, the services in the cited registrations and those in the involved application are legally identical.⁵ It is well established that absent restrictions in the application and registration, [identical] goods and 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, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). Therefore, because the services are in part legally identical, they are presumed to travel in the same channels of trade to the same classes of purchasers.

Accordingly, the second and third *du Pont* factors favor a finding of likelihood of confusion.

B. Similarity of the marks.


We next determine the similarity or dissimilarity of the marks in their entireties, keeping in mind that “[w]hen marks appear on identical services, the degree of similarity necessary to support a conclusion of likelihood of confusion declines.”

⁴ “Coffee Shop.” Merriam-Webster.com. Merriam-Webster. Feb. 6, 2017 Response, TSDR pp. 4, 18. All citations to the Trademark Status and Document Retrieval (TSDR) database are to the PDF version of the documents.

⁵ In addition, the Examining Attorney introduced numerous third-party registrations showing that the same marks are used for both restaurant services and coffee shops. These registrations have probative value to the extent they may serve to suggest that the goods are of a kind that may emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

Century 21 Real Estate Corp. v. Century Life of Am., 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant's mark is  and the cited marks are

 SHEPHERD'S BEACH RESORT in standard characters and

Because the design elements in the second cited mark present an additional difference with Applicant's mark, we confine our analysis to the issue of likelihood of confusion between Applicant's mark and the cited registration for the mark in standard character format. That is, if confusion is likely between those marks, there is no need for us to consider the issue with respect to the cited registration for the mark with design elements, while if there is no likelihood of confusion between Applicant's mark and the cited mark in standard characters, then there would be no likelihood of confusion with the mark with design elements. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

In comparing the marks we must consider their appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). "The proper test is not a side-by-side comparison of the marks, but instead '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). Moreover, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1645 (TTAB 2009), *citing Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). The average purchaser of coffee shop services and restaurant services is a member of the general public.

While “the similarity or dissimilarity of the marks is determined based on the marks in their entirety ... 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 a consideration of the marks in their entirety.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

When evaluating a composite mark containing both words and designs, such as Applicant’s mark, its verbal portion is generally the one most likely to indicate the origin of the services for which it is used because it is the portion of the mark that consumers would use to refer to or request the services. *Viterra*, 101 USPQ2d at 1908 and 1911. Further, in this case, the design elements in Applicant’s mark are merely a “rectangular field,” “horizontal lines” and decorated “medallion shapes” and have no apparent or claimed meaning. Although the design is minimal, we consider it in determining the similarity between the marks in their entirety.

The word “SHEPHERD” dominates Applicant’s mark as it is centered and depicted in large type. Further, SHEPHERD is the first word in the mark, which is frequently the most dominant portion of a mark since it is the most likely to be

impressed upon the mind of the purchaser and to later be remembered. *See Palm Bay Imports*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 v. Century Life* 23 USPQ2d at 1700 (upon encountering the marks, consumers will first notice the identical lead word); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”).

A “shepherd” is a “person who tends sheep.”⁶ Applicant asserts that its mark “suggests the legendary origin of coffee: a ninth century Ethiopian shepherd who discovered the energizing effects of the red berries of the coffee plant.”⁷ While there is no evidentiary support for this legend, the meaning of the word “SHEPHERD” as sheep herder is not diminished or changed when combined with “ARTISAN COFFEE” which may even enhance the meaning to the extent the word “artisan” connotes a category of person rather than a specific person.

The word SHEPHARD in the cited mark is phonetically quite close to SHEPHERD. However, their meanings differ, particularly when viewing SHEPHARD in the possessive form, which, especially in the context of restaurant services, is clearly a surname. Combining SHEPHARD’S with “BEACH RESORT” connotes a “beach resort” owned by or named after a person named Shephard. Thus, the commercial impression of SHEPHERD ARTISAN COFFEE is different from the

⁶ March 18, 2017 Response, TSDR 12, 18.

⁷ *Id.*, at 12, 21.

commercial impression of SHEPHARD'S BEACH RESORT. We find the marks in this case dissimilar, particularly because of their very different connotations and commercial impressions.

C. Conclusion.

Notwithstanding that the goods are, in part, legally identical, and the channels of trade and purchasers overlap, we conclude that the marks are too dissimilar to warrant a determination of likely confusion. We consider this *du Pont* factor dispositive in this case. *See Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998) (holding that Board did not err in deciding likelihood of confusion based solely on dissimilarity of marks regardless of other *du Pont* factors, that favored a likelihood of confusion, noting that “we have previously upheld Board determinations that one *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks”); *Kellogg Co. v. Pack'em Ent.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (upholding Board decision that “a single *duPont* factor – the dissimilarity of the marks – was dispositive of the likelihood of confusion issue,” observing “we know of no reason why, in a particular case, a single *duPont* factor may not be dispositive”).

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