

This Opinion is Not a  
Precedent of the TTAB

Mailed: June 27, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Mauna Kea Rum Company, LLC*  
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Serial No. 87475384  
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Donald E. Stout of Stout, Uxa & Buyan, LLP,  
for Mauna Kea Rum Company, LLC.

Jacquelyn A. Jones, Trademark Examining Attorney, Law Office 120,  
David Miller, Managing Attorney.

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Before Bergsman, Wellington and Hudis,  
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

Mauna Kea Rum Company, LLC (“Applicant”) seeks registration on the Principal Register of the mark MAUNA KEA RUM COMPANY (in standard characters, with terms “Rum Company” disclaimed) for, as amended, “packaged spirits; packaged rum” in International Class 33.<sup>1</sup>

The Trademark Examining Attorney (“Examining Attorney”) refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that

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<sup>1</sup> Application Serial No. 87475384, filed on June 5, 2017 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based upon Applicant’s bona fide intention to use the mark in commerce.

Applicant's mark, as applied to the goods identified in the application, so resembles the registered marks, owned by the same entity:



for:

“providing recreational facilities for others” in International Class 41

“hotel and restaurant services” in International Class 42,<sup>2</sup>

and



for:

“paper bags, writing paper and envelopes” in International Class 16

“plastic squeeze bottles” in International Class 21

“towels” in International Class 24

“hats, caps and visors; swim wear, shorts, tank tops, sportshirts, T-shirts and golf shirts” in International Class 25

“golf ball markers” in International Class 28

“educational and entertainment services; namely, dinner theatre shows, hula shows, Hawaiian craft and music classes; and providing sporting facilities for golf, tennis, shuffle board, swimming, snorkeling, sailing, and windsurfing” in International Class 41

“restaurant and hotel services” in International Class 42<sup>3</sup>

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<sup>2</sup> Registration No. 0891371, issued on May 19, 1970; third renewal. In the registration, the mark is described as “the drawing is lined for the color orange, but color is not claimed as an integral feature of the mark.”

<sup>3</sup> Registration No. 1701706, issued on July 21, 1992; second renewal. In the registration, the terms “Beach Hotel” are disclaimed. The mark is described as “the mark consists of a stylized drawing of the words ‘MAUNA KEA BEACH HOTEL’ and of a plumeria flower. The mark is lined for the color orange.”

both on the Principal Register,<sup>4</sup> as to be likely to cause confusion, to cause mistake, or to deceive.

When the refusal was made final, Applicant requested reconsideration. After the Examining Attorney denied the request for reconsideration, Applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

## **I. Background**

In the first Office Action, the Examining Attorney issued her likelihood of confusion refusal, required that Applicant enter a voluntary disclaimer of “RUM COMPANY,” and requested that Applicant advise whether Applicant’s goods will be manufactured, packaged, shipped from, sold in or will have any other connection with the geographic location named in the mark.<sup>5</sup> With the first Office Action, the Examining Attorney made the following items of record:

1. Database summary for Registration No. 0891371 (MAUNA KEA & Design);<sup>6</sup>
2. Database summary for Registration No. 1701706 (MAUNA KEA BEACH HOTEL & Design);<sup>7</sup>

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<sup>4</sup> Each registration contains the following translation statement: “MAUNA KEA’ is the Hawaiian name of one of the major mountains on the island of Hawaii and means ‘white mountain’.”

<sup>5</sup> Office Action of September 7, 2017 TSDR 3-5. Page references herein to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system. References to the briefs on appeal refer to the Board’s TTABVUE docket system. Coming before the designation TTABVUE is the docket entry number; and coming after this designation are the page references, if applicable.

<sup>6</sup> *Id.* at TSDR 7-9.

<sup>7</sup> *Id.* at TSDR 10-12.

3. The definition of “MAUNA KEA” from the online English OXFORD LIVING DICTIONARIES;<sup>8</sup>
4. *Trend: The Boom in Restaurant-Distilleries*  
<http://rddmag.com/development/1093-the-boom-in-restaurant-distilleries>  
(last visited September 7, 2017)<sup>9</sup>
5. Bardenay Restaurant Distillery <http://bardenay.com/about/> (last visited September 7, 2017)<sup>10</sup>
6. Lula Restaurant-Distillery <http://www.lulanola.com/lulas-story/> and  
<http://www.lulanola.com/spirits/> (last visited September 7, 2017)<sup>11</sup>
7. Kaptain Jimmy’s Restaurant & Distillery <http://wvffl.kaptainjimmys.com/>  
(last visited September 7, 2017)<sup>12</sup>
8. Topo Restaurant, Brewery, Distillery & Event Space  
<http://www.thetopofthehill.com/#nightlife> (last visited September 7, 2017)<sup>13</sup>
9. Breckenridge Distillery <http://breckenridgedistillery.com/restaurant/> (last visited September 7, 2017)<sup>14</sup>

In its response to the first Office Action, Applicant entered a disclaimer of “RUM COMPANY,” advised that Applicant’s mark is intended to be used for a line of rums produced using imported ingredients and aged, blended, diluted, rectified, bottled, labeled, packaged, shipped and sold from a base in Hawaii, which may be in Kamuela, Hawaii in the foothills of Mauna Kea, and submitted arguments (but no evidence) traversing the Section 2(d) refusal to register.<sup>15</sup>

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<sup>8</sup> *Id.* at TSDR 13. The definition of MAUNA KEA made of record, in relevant part, states: “An extinct volcano on the island of Hawaii, in the central Pacific.”

<sup>9</sup> *Id.* at TSDR 14-20.

<sup>10</sup> *Id.* at TSDR 21-24.

<sup>11</sup> *Id.* at TSDR 25-32.

<sup>12</sup> *Id.* at TSDR 33-36.

<sup>13</sup> *Id.* at TSDR 37-49.

<sup>14</sup> *Id.* at TSDR 50-65.

<sup>15</sup> Response to Office Action of March 6, 2018 TSDR 1-3.

In the second Office Action, the Examining Attorney continued and made final her refusal to register under Trademark Act Section 2(d), and advised that the following requirements had been satisfied: disclaimer of the descriptive wording (“RUM COMPANY”) and Applicant’s response to the request for information.<sup>16</sup> With the second Office Action, the Examining Attorney made the following items of record:

1. *The 5 Best Distillery Restaurants in America*  
<https://www.supercall.com/culture/best-distillery-restaurants> (last visited March 28, 2018)<sup>17</sup>
2. *D.C.’s First Distillery-Eatery Taps into a Growing Trend*  
<https://www.bdcnetwork.com/dc%E2%80%99s-first-distillery-eatery-taps-growing-trend> (last visited March 28, 2018)<sup>18</sup>
3. *Top Beverage Trends for 2016*  
<https://sirvo.com/indinews/top-beverage-trends-2016/> (last visited March 28, 2018)<sup>19</sup>
4. Founding Spirits (portions of website)  
<https://www.foundingspirits.com/> (last visited March 28, 2018)<sup>20</sup>
5. Founding Farmers (portions of website)  
<https://www.farmersrestaurantgroup.com/founding-farmers/> (last visited March 28, 2018)<sup>21</sup>
6. Mason Dixon Distillery & Restaurant (portions of website)  
<http://www.masondixondistillery.com/> (last visited March 28, 2018)<sup>22</sup>
7. Social Still (portions of website)  
<http://www.socialstill.com/our-spirits/> (last visited March 28, 2018)<sup>23</sup>

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<sup>16</sup> Office Action of March 28, 2018 TSDR 3-6.

<sup>17</sup> *Id.* at TSDR 8-13.

<sup>18</sup> *Id.* at TSDR 14-16.

<sup>19</sup> *Id.* at TSDR 17-24.

<sup>20</sup> *Id.* at TSDR 25-39.

<sup>21</sup> *Id.* at TSDR 40-44.

<sup>22</sup> *Id.* at TSDR 45-56.

<sup>23</sup> *Id.* at TSDR 57-68.

8. St. Lawrence Spirits (portions of website)  
<http://www.saintlawrencechateau.com/saintlawrencespiritsdistillery/spirits.html> (last visited March 28, 2018)<sup>24</sup>
9. Dells Distillery (portions of website)  
<http://www.thedellsdistillery.com/> (last visited March 28, 2018)<sup>25</sup>
10. Green Bay Distillery (portions of website)  
<http://www.greenbaydistillery.com/our-spirits/> (last visited March 28, 2018)<sup>26</sup>
11. Treaty Oak (portions of website)  
<https://www.treatyoakdistilling.com/gift-shop-tasting-room> (last visited March 28, 2018)<sup>27</sup>

After issuance of the second Office Action, Applicant filed a Request for Reconsideration again submitting arguments traversing the Section 2(d) refusal to register.<sup>28</sup> With the Request for Reconsideration, Applicant made the following items of record:<sup>29</sup>

1. Copy of Registration No. 3407972 (MAUNA KEA)<sup>30</sup>
2. Marie Callender's Restaurant & Bakery (page from website) (no URL or access date given)<sup>31</sup>

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<sup>24</sup> *Id.* at TSDR 69-87.

<sup>25</sup> *Id.* at TSDR 88-93.

<sup>26</sup> *Id.* at TSDR 89-98.

<sup>27</sup> *Id.* at TSDR 99-104.

<sup>28</sup> Request for Reconsideration of June 14, 2018 TSDR 1-2.

<sup>29</sup> Applicant submitted duplicate copies of Registration No. 3407972 and portions of the Marie Callender's website again with its Reply Brief. This was wholly unnecessary, and the Board discourages this practice. *In re Thor Tech Inc.*, 85 USPQ2d 1474, 1475 n.3 (TTAB 2007) (attaching evidence from record to briefs is duplicative and is unnecessary).

<sup>30</sup> *Id.* at TSDR 4. Registration No. 3407972 was issued on the Principal Register on April 8, 2008 for "bakery goods; and bread" in International Class 30.

<sup>31</sup> *Id.* at TSDR 5.

As noted, in correspondence issued on July 3, 2018, the Examining Attorney denied Applicant's Request for Reconsideration.<sup>32</sup> No additional evidence was made of record by the Examining Attorney.

## II. Applicable Law

We base our determination of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. \_\_\_, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. See, e.g., *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). However, "each case must be decided on its own facts and the differences are often subtle ones." *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Section 2(d), which are to prevent confusion as to source and to protect registrants from damage caused by registration of confusingly similar marks. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566. We have considered each *DuPont* factor that is relevant

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<sup>32</sup> Denial of Request for Reconsideration of July 3, 2018.

and of record, and have treated any other factors as neutral. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the similarities between the goods/services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”)).

### **III. Analysis**

We now review the arguments of Applicant and the Examining Attorney in view of applicable law and the evidence of record.

#### **A. Comparison of Applicant’s Mark to the Registered Marks Cited by the Examining Attorney**

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s and Registrant’s marks in their entireties, taking into account their



appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *In re Detroit Ath. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1048 (Fed. Cir. 2018). “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). *See also, In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016).

Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must instead rely upon their imperfect recollections. *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). “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.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018).

To be sure, the parties’ marks “must be considered ... in light of the fallibility of memory ....” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). Therefore, the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Assoc. of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007). In this appeal, because the goods at issue are packaged spirits and rum and restaurant services, the average purchaser is an ordinary adult consumer.

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, our 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 Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”).

On the other hand, different features may be analyzed to determine whether the marks are confusingly similar. *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). In this connection, as discussed below, we note that Applicant’s mark and the cited marks share the dominant phrase MAUNA KEA.<sup>33</sup> *See In re Nat'l Data*, 224 USPQ at 751 (“in 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 entirety”).

Although we must consider the marks in their entirety, we find the phrase (or terms) MAUNA KEA to be the dominant portion of the marks. MAUNA and KEA are the first terms in Applicant’s mark and the registered marks cited by the Examining Attorney. *See Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897

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<sup>33</sup> Applicant concedes this point in its Brief. 4 TTABVue 5.

(TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 369 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“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); The dominant portion of Applicant’s mark and the cited marks is the “term most likely to be remembered by consumers” and “used in calling for the services” or in otherwise referring to Applicant. *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009).

While we do not disregard them, the significance of the second term(s) in the comparison of marks is diminished because consumers are not inclined to rely on descriptive or generic terms to indicate source. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat’l Data*, 224 USPQ at 752. Because the descriptive, and disclaimed, phrases “Rum Company” in Applicant’s mark and “Beach Hotel” in Registration No. 1701706 merely describe the type of product Applicant intends to sell in the former and merely describe the type of entity providing the Registrant’s services in the latter, they have very little, if any, source-identifying significance. *See, e.g., In re Dixie Rests.*, 41 USPQ2d at 1533-34

“DELTA,” not the disclaimed generic term “CAFE,” was the dominant portion of the mark THE DELTA CAFE).

Simply, disclaimed, descriptive matter has less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed wording is often “less significant in creating the mark’s commercial impression”).

Moreover, because Applicant seeks a standard-character registration,<sup>34</sup> the specific font style of lettering and presence of the plumeria flower design in the Registrant’s cited marks cannot serve as the basis to distinguish them from Applicant’s mark. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1886 (TTAB 2018) (literal elements of standard character marks may be presented in any font style, size or color). “In the case of a composite mark containing both words and a design, ‘the verbal portion of the mark is the one most likely to indicate the origin of the goods [or services] to which it is affixed.’” *In re Viterra*, 101 USPQ2d at 1908.

Applicant’s contention that the common portion of Applicant’s mark and the cited marks, “Mauna Kea,” is weak because of its geographical significance to a mountain

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<sup>34</sup> Another point Applicant concedes in its Brief. 4 TTABVUE 5.

in Hawaii<sup>35</sup> is not persuasive. Even marks that are deemed “weak” or merely descriptive are still entitled to protection under Section 2(d) against the registration by a subsequent user of a similar mark for related goods and services. *see King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010).

The first *DuPont* factor weights in favor of a finding that confusion is likely.

**B. Comparison of the Goods and Services, and Channels of Trade**

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration...” and the third factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1359 (Fed. Cir. 2014).

“Th[e comparison of goods and services] ... factor considers whether ‘the consuming public may perceive the respective goods and services of the parties as related enough to cause confusion about the source or origin of the goods and services.’” *In re St. Helena Hosp.*, 113 USPQ2d at 1086. The issue, moreover, is not whether purchasers would confuse the goods and services, but rather whether there is a likelihood of confusion as to the source of the goods and services. *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984).

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<sup>35</sup> 4 TTABVUE 5.

We compare the goods and services as identified in the application and in the cited registrations. See *Stone Lion Capital Partners*, 110 USPQ2d at 1162 (quoting *Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”)).

“Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services.” *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). “In determining whether the services are related, it is not necessary that the Applicant’s [goods] ... and the Registrant’s services be similar or competitive in character to support a holding of likelihood of confusion; it is sufficient for such purposes if the [goods and] services are related in some manner or if the circumstances surrounding marketing of these [goods and] services are such that they could give rise to the mistaken belief that they originate from or are in some way associated with the same source.” *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1795 (TTAB 2017) (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012)).

Some applicants attempt to avoid a likelihood of confusion by narrowly describing their goods or services, channels of trade or its class of customers; as Applicant did

here during prosecution.<sup>36</sup> Our analysis, however, is the same. Such restrictions to an applicant's identification may not avoid confusion where, as here, the cited registrations contain no express limitations and the respective goods and services otherwise are otherwise related. *See, e.g., In re i.am.symbolic, llc*, 123 USPQ2d at 1750 (affirming Board finding that an identification restricting the goods to those "associated with William Adams, professionally known as "will.i.am," imposed no meaningful limitation on the nature of the goods, trade channels, or classes of purchasers).

We also review the evidence of record regarding channels of trade mindful of "the controlling principle that where the goods [or services] in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein[.]" *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413 (TTAB 2018) "and, in the absence of specific limitations in the application and registration, on consideration of the normal and usual channels of trade and methods of distribution" *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983) for the parties' goods and services.

Applicant argues that the Examining Attorney is required to satisfy a "something more" requirement (over and above a showing that the goods and services are used together) because the relatedness of Applicant's services and the Registrant's products is not evident, citing *In re Opus One Inc.*, 60 USPQ2d 1812, 1813 (TTAB

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<sup>36</sup> Response to Office Action of March 6, 2018 TSDR 2.

2001).<sup>37</sup> On the other hand, “something more” is only required in the context of comparing goods versus services where the relationship between the goods and services is obscure or less evident. *In re St. Helena Hosp.*, 113 USPQ2d at 1087. As explained in the TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1207.01(a)(ii) (“Establishing Relatedness of Goods to Services”):

... when the relatedness of the goods and services is not evident, well known, or generally recognized, “something more” than the mere fact that the goods and services are used together must be shown. *In re St. Helena Hosp.*, 774 F.3d at 754, 113 USPQ2d at 1087 (finding that substantial evidence did not support relatedness of hospital-based residential weight and lifestyle program and printed materials dealing with physical activity and fitness). Therefore, when comparing services such as “restaurant services” with less apparently related goods such as “beer,” or “cooking classes” with “kitchen towels,” “something more”—beyond the fact that the goods are used in the provision of the services—must be shown to indicate that consumers would understand such services and goods to emanate from the same source.

In this case, because the Court of Appeals for the Federal Circuit has held that the requirement that “something more” be shown to establish the relatedness of alcoholic beverages and restaurant services for purposes of demonstrating a likelihood of confusion, *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003), it stands to reason that the USPTO must show “something more” to establish the relatedness between packaged spirits and rum on the one hand and restaurant services on the other hand.

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<sup>37</sup> 4 TTABVUE 8.



In *Coors Brewing*, the Federal Circuit explained why more evidence is required than just showing restaurants sell beverages (alcoholic or otherwise) to prove that those goods and services are related:

It is not unusual for restaurants to be identified with particular food or beverage items that are produced by the same entity that provides the restaurant services or are sold by the same entity under a private label. Thus, for example, some restaurants sell their own private label ice cream, while others sell their own private label coffee. But that does not mean that any time a brand of ice cream or coffee has a trademark that is similar to the registered trademark of some restaurant, consumers are likely to assume that the coffee or ice cream is associated with that restaurant. The *Jacobs* case [*Jacobs v. Int'l Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641 (CCPA 1982)] stands for the contrary proposition, and in light of the very large number of restaurants in this country and the great variety in the names associated with those restaurants, the potential consequences of adopting such a principle would be to limit dramatically the number of marks that could be used by producers of foods and beverages.

*Coors Brewing*, 68 USPQ2d at 1063.

In other words, there is no per se rule that certain goods and services are related. *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2030 (Fed. Cir. 1993) (no per se rule about confusion, where similar marks are used in connection with restaurant services and food products). That is, the Federal Circuit recognizes that the diversity and expansion of businesses in a modern economy is not, in and of itself, sufficient to support an inference that purchasers are apt to believe that disparate products or services emanate from the same source. *In re American Olean Tile Co.*, 1 USPQ2d 1823, 1826 (TTAB 1986).

The Board has found the “something more” requirement to be met under the following circumstances:

1. Applicant's mark made clear that its restaurant specialized in registrant's type of goods. *See In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074, 1075 (TTAB 1990) (GOLDEN GRIDDLE PANCAKE HOUSE for restaurant services likely to be confused with GOLDEN GRIDDLE for table syrup); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209, 1213 (TTAB 1999) (AZTECA MEXICAN RESTAURANT for restaurant services likely to be confused with AZTECA for Mexican food items);
2. The record showed that registrant's wines were actually sold in applicant's restaurant. *See In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001) ("the record in this case reveals that registrant's OPUS ONE wine is offered and served by applicant at its OPUS ONE restaurant"); and
3. Registrant's mark was found to be "a very unique, strong mark." *See In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1469 (TTAB 1988) ("the Examining Attorney has indicated that he has been unable to find, in the records of the Patent and Trademark Office, any registration, other than the cited registration, for a mark containing the expression 'Mucky Duck,'" nor has applicant offered any evidence of third-party use of marks containing the expression).

Here, Applicant and the Examining Attorney focus their arguments regarding goods, services and channels of trade upon the packaged rum and spirits recited in Applicant's Application, and the restaurant services recited in the Registrant's registrations.<sup>38</sup> In this connection, and as noted above in the recitation of the evidence, the Examining Attorney made of record four articles noting the growing trend of restaurant-distilleries selling packaged spirits under the same name or brand as the restaurant portion of the business, and the website captures of 12 restaurant-distilleries that actually have engaged in this practice. In our view, this evidence is sufficient to demonstrate the "something more" required by *Coors Brewing* to establish the relatedness between packaged spirits and rum on the one hand and restaurant services on the other hand.

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<sup>38</sup> 4 TTABVUE 6-10; 6 TTABVUE 8-11; 7 TTABVUE 5-6.

As critique to the Examining Attorney's evidence, Applicant says that "even distillery restaurants do not serve bottled spirits to patrons[,]" "[i]n fact, only a minority of restaurants serve spirits at all, because of state alcohol licensing restrictions[,]" and "the supplied evidence does not at all demonstrate that patrons at the identified distillery restaurants are served anything other than spirits and mixed drinks by the glass."<sup>39</sup> The first critique is a non-sequitur, and contrary to the evidence of record that restaurant-distilleries in fact sell bottled spirits under their own private label brands (under the same names as the restaurants) to patrons. The second critique is without support, and "[a]ttorney argument is no substitute for evidence." *Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)). The third critique is irrelevant and misses the point. Rather, the evidence made of record shows a growing trend that restaurant-distilleries serve food-and-drink and also sell bottled spirits under the same mark and from the same location. In other words, at least one trade channel for Applicant's packaged spirits and rum is that it may be sold through restaurants, like registrant's.

The second and third *DuPont* factors weigh in favor of a finding that confusion is likely.

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<sup>39</sup> 4 TTABVUE 7.

**C. The Number and Nature of Similar Marks in Use on Similar Goods**

The sixth *DuPont* factor examines “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 177 USPQ at 567. Applicant argues that “U.S. trademark registrations for marks including the common term MAUNA KEA already co-exist for ‘hotel and restaurant services’ and for ‘bakery goods; and bread[,]” that “[t]hese goods and services are related, since restaurants sell bakery goods and bread,” “restaurants sometimes sell packaged bakery goods and bread,” and that “[t]here is no evidence of record showing why the prior registrants are entitled to the breadth and scope of protection of their marks which the Examining Attorney has afforded them[.]”<sup>40</sup> In support of these arguments, as noted above in the discussion of the evidence, Applicant made of record Registration No. 3407972 for the mark MAUNA KEA for “bakery goods; and bread” in International Class 30 and a portion of the Marie Callender’s Restaurant & Bakery website.

Regarding the MAUNA KEA registration for bakery goods and bread, its probative value is limited, particularly when the issue being determined here is likelihood of confusion, and Applicant did not submit any evidence of actual use of this mark. *Weider Publications, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1351 n.10 (TTAB 2014) (third-party registrations do not constitute evidence of use, thus they are of limited probative value to show mark is weak), *appeal dismissed per stipulation*, No. 14-1461 (Fed. Cir. Oct. 10, 2014).

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<sup>40</sup> 4 TTABVUE 9.

Third-party registrations may be entitled to some weight to show the meaning of a mark, or a portion of a mark, in the same manner as a dictionary definition; but to be probative the number of such registrations must be significantly high, *Juice Generation, Inc. v. GS Enterprises, LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015) (evidence of extensive number of third-party registrations to be considered), and the marks shown therein must be registered in connection with goods or services similar to those in issue. *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693-94 (Fed. Cir. 2018). Here, Applicant submitted only one third-party registration for the mark MAUNA KEA, and for goods unrelated to the goods and services presently at issue.

Moreover, prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the Board. *See In re USA Warriors*, 122 USPQ2d at 1793 n.10. Each case is decided on its own facts, and each mark stands on its own merits. *Id.*

Regarding the captured webpage from the Marie Callender's Restaurant & Bakery website, we note that authenticating information (i.e., the URL and print date) was not provided with this material.<sup>41</sup> However, because the Examining Attorney did not object to this evidence, either in her denial of Applicant's Request for Reconsideration or in the Examining Attorney's Brief, the objection is waived. *In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1594 n.40 (TTAB 2014) (objection

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<sup>41</sup> *See Safer Inc. v. OMS investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) and *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018) (applying *Safer* rule to evidence submitted by examining attorneys and applicants in ex parte cases).

waived where examining attorney, in a continuing refusal, failed to advise applicant that mere listing of third-party registrations was insufficient to make them of record). Reviewing this evidence, we note on the submitted webpage Marie Callender's promotion of its restaurant services and sale of pies, but not bread. The web page also does not indicate whether the pies are sold in packaging bearing the Marie Callender's mark. This evidence is therefore of minimal probative value. Additionally, Applicant submitted no evidence demonstrating that restaurants in general sometimes sell bakery goods and bread in packaging bearing the same names as the restaurants.

Thus there is evidence of record showing why the prior Registrant is entitled to the breadth and scope of protection of its marks which the Examining Attorney has afforded them, which has not been lessened by any evidence Applicant has made of record. We therefore find the sixth *DuPont* factor to be neutral.

**D. The Conditions under Which and Buyers to Whom Sales are Made, i.e., "Impulse" v. Careful, Sophisticated Purchasing**

The fourth *DuPont* factor looks at "the conditions under which and buyers to whom sales are made, i.e., 'impulse' v. careful, sophisticated purchasing." *DuPont*, 177 USPQ at 567. Applicant argues that "to the extent this crossover market [of packaged spirits and packaged rum vs. restaurant services] is relevant, the purchasers participating in such a market are highly sophisticated and discriminating customers, making very careful and thoroughly researched

purchasing decisions.”<sup>42</sup> Neither Applicant nor the Examining Attorney presented evidence on this issue.

Consequently, when the relevant purchasing public of the parties’ services could consist of both discriminating and ordinary consumers, we focus on the latter, *See, e.g., Somerset Distilling, Inc. v. Speymalt Whiskey Distrib., Ltd.*, 14 USPQ2d 1539, 1542 (TTAB 1989) (alcoholic beverage aficionados vs. ordinary purchasers who purchase alcoholic beverages to stock a bar or for gifts); as the applicable standard of care for a likelihood-of-confusion analysis is that of the least sophisticated consumer. *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018). We therefore consider this factor as neutral.

#### **E. Conclusion - Likelihood of Confusion**

Balancing the *DuPont* likelihood of confusion factors from the evidence of record, we find that Applicant’s MAUNA KEA RUM COMPANY mark and the cited Registrant’s MAUNA KEA & Design and MAUNA KEA BEACH HOTEL & Design marks are confusingly similar. Applicant’s packaged spirits and packaged rum products and the Registrant’s restaurant services, and the respective channels of trade, are overlapping. We find the other likelihood of confusion factors to be neutral. In sum, we find a likelihood of confusion between Applicant’s mark (and applied for goods) and the cited Registrant’s marks (and restaurant services) as recited in its registrations.

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<sup>42</sup> 4 TTABVUE 10.

#### **IV. Decision**

The refusal to register Applicant's mark MAUNA KEA RUM COMPANY on grounds of likelihood of confusion under Trademark Act Section 2(d) is **affirmed**.