

This Opinion is Not a
Precedent of the TTAB

Mailed: September 26, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re White Elephant Enterprises, Inc.

Serial No. 88662792
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for White Elephant Enterprises, Inc.

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Before Wellington, Lynch, and Heasley,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

White Elephant Enterprises, Inc. (“Applicant”) seeks registration on the Principal Register of the standard-character mark **WHITE ELEPHANT SALOON** (SALOON disclaimed) for “bar and restaurant services” in International Class 43.¹

¹ Application Serial No. 88662792; filed October 21, 2019, based on an allegation of first use the mark anywhere and in commerce on January 1, 1971, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the registered standard character mark **WHITE ELEPHANT** for “wine” in International Class 33.²

Applicant filed an appeal that has been fully briefed. For the following reasons, we affirm the refusal to register.

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. DuPont 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. 138, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co. Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor for which there is argument and evidence. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *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.”).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods and/or services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods*,

² Registration No. 4457309 issued on December 31, 2013.

Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“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 [or services].’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)). We discuss these factors below.

A. Similarity or Dissimilarity of the Marks

We first consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

The issue is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are so similar in terms of their overall commercial impression that confusion as to the source of the goods and services offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). The

focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

We do not predicate our analysis on a dissection of the involved marks; rather, we consider the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1160; *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.”). Nevertheless, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See Stone Lion*, 110 USPQ2d at 1161 (finding that the Board did not err in reasoning that the term LION was dominant in both applicant’s mark STONE LION CAPITAL and opposer’s marks LION CAPITAL and LION); *Coach Servs.*, 101 USPQ2d at 1721; *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007).

Here, we find the two marks extremely similar in appearance, sound and commercial impression. This is so because the primary and dominant source-identifying element of Applicant’s mark is WHITE ELEPHANT, which is the entirety of the registered mark.

Indeed, the only difference between the marks is the addition of the disclaimed term SALOON at the end of Applicant's mark. While this is a point of difference, it makes very little difference in terms of distinguishing the marks. The term is highly descriptive, if not generic, for Applicant's bar and restaurant services, has little, if any, source-identifying value, and has been appropriately disclaimed in the application. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (finding the descriptive and disclaimed portions of applicant's mark "unlikely to change the overall commercial impression engendered by the marks.") (citing *Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-4 (Fed. Cir. 1997)); see also *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression").

There is no demonstrated meaning or significance of the term "white elephant," in connection with bar and restaurant services or wine.³ There is no evidence of weakness, either conceptual or commercial, of this term in relation to the involved goods and services. We therefore construe Registrant's WHITE ELEPHANT mark to be arbitrary and entitled to the usual scope of protection accorded to such registered marks. 15 U.S.C. § 1057(b).

³ We take notice that a "white elephant" is an idiom described as "an unwanted or financially burdensome possession, or a project that turns out to be of limited value." THE NEW DICTIONARY OF CULTURAL LITERACY (Third Ed. Copyright © 2005). Published By Houghton Mifflin Harcourt Publishing Company. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (Board may take judicial notice of dictionary definitions). Neither Applicant nor the Examining Attorney argued that this term's idiomatic meaning has any relevance to either mark or the involved goods and services.

Because we find that the marks in their entireties are extremely similar in appearance, sound, connotation and commercial impression, the first *DuPont* factor therefore weighs in favor of finding a likelihood of confusion.

B. Relatedness of the Goods and Services and Channels of Trade

Under the second and third *DuPont* factors, we consider, respectively, “[t]he similarity or dissimilarity and nature of the goods [and services]” and the “established, likely-to-continue channels of trade” for these goods and services. *DuPont*, 177 USPQ at 567; *see also Detroit Athletic*, 128 USPQ2d at 1051. For both factors, we must base our analyses on the identifications in Applicant’s application and the cited registration. *See Stone Lion*, 110 USPQ2d at 1162; *In re Dixie Rests.*, 41 USPQ2d at 1534; *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The goods and services need not be identical for there to be a likelihood of confusion; they need only be related in some manner or the conditions surrounding their marketing such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and services come from a common source. *Coach Servs. Inc.*, 101 USPQ2d 1721; *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re Rexel, Inc.*, 223 USPQ 830, 831 (TTAB 1984).

It is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of services within a particular class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209

USPQ 986, 988 (CCPA 1981). Thus, because Applicant's services include bar **and** restaurant services, we need only find a relationship exists between either of these types services and the goods listed in the cited registration, i.e., wine.

Applicant primarily argues that because it offers restaurant services and the cited goods are wine, we should apply the precedent requiring "something more" to establish relatedness between these goods and services. Applicant points to *In re Coors Brewing Co.*, which held that "to establish likelihood of confusion a party must show something more than that similar or even identical marks are used for food products and for restaurant services." *In re Coors Brewing*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) (citation omitted); *see also In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1087 (Fed. Cir. 2014) (explaining the need to show "something more" than the mere fact that the goods and services are 'used together' in situations where the relatedness of the goods and services is obscure or not evident, well-known, or generally recognized).

However, as noted, the application identifies both restaurant and bar services. A "bar," by definition, is an establishment that focuses on serving alcoholic beverages,⁴ such as wine. Given this defined meaning, we find an inherent relationship between bar services and wine, so there is no need to support the relatedness of such goods and services with a showing of "something more." *Cf. Coors Brewing*, 68 USPQ2d at 1064 (stating that a mark for a brewpub "would clearly be related" to a mark for beer).

⁴ A "bar" is defined as "an establishment where alcohol and sometimes other refreshments are served." Printout of definition attached to January 28, 2021 Office Action, TSDR p. 10.

Indeed, inherent relatedness often exists when the services in question include or center on the sale of the particular goods in question. *See In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) (“applicant’s ‘general merchandise store services’ would include the sale of furniture and the evidence introduced by the applicant in voluminous quantity makes it clear--though its arguments attempt to play down the fact--that it does in fact sell furniture. What else it sells is irrelevant; there is overlap.”); *In re Country Oven, Inc.*, 2019 USPQ2d 443903 (TTAB 2019) (Applicant’s COUNTRY OVEN for bread buns was likely to cause confusion with the cited registration for COUNTRY OVEN for retail bakery shops. “[T]he relevant line of case law holds that confusion may be likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the other.”); *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2050 (TTAB 2012) (“applicant’s broadly worded ‘providing food and drink’ could encompass a coffee house ... [so that] applicant’s services, as recited, are sufficiently related to [Registrant’s] coffee”). In this regard, the Examining Attorney points to Applicant’s own advertising and asserts that Applicant “primarily feature[s] a bar and restaurant that serves alcoholic beverages, such as the ‘wine’ in the cited registration.”⁵ The Examining Attorney further observes that Applicant advertises its business as a “legendary drinking establishment” and “the perfect place to relax with an adult beverage,” with offerings that specifically include “wine.”⁶

⁵ 6 TTABVUE 10; the Examining Attorney refers to evidence attached to the October 19, 2021 Office Action, TSDR p. 27.

⁶ *Id.*

Even if “something more” were necessary, the standard would be met in this case as to restaurant services and wine. As discussed above, the cited mark is arbitrary and inherently distinctive, *In re Opus One Inc.*, 60 USPQ2d 1812, 1813-15 (TTAB 2001), and there is evidence that Applicant “uses its [WHITE ELEPHANT SALOON] mark to promote alcoholic beverages” in its bar and restaurant, *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1060 (TTAB 2017).

In addition, the evidence establishes that restaurant services and wine may be advertised by the same source under the same mark and offered at the same location, and that there is an overlapping customer base for the wine and restaurant services, *In re Shell Oil*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993) and *Coors Brewing*, 68 USPQ2d at 1064.

The Examining Attorney submitted printouts from nearly a dozen third-party websites offering both wine and restaurant services under the same mark, to wit:⁷

- Hitching Post website showing “Hitching Post” wines available for purchase within a store or in the restaurant— “Our Own Hitching Post Wines And Specially Selected Santa Barbara County Wines”;⁸
- Cooper’s Hawk Winery & Restaurants website advertising restaurant services and offering privately branded wine under the same mark, as well as a “wine club”;⁹
- Cascade Mountain Winery & Restaurant website “features a full line of award-winning table wines which can be tasted at the winery tasting bar or enjoyed in the restaurant”;¹⁰ and

⁷ Printouts attached to Office Actions issued on January 28, 2020 and October 19, 2021.

⁸ October 19, 2021 Office action, TSDR pp. 10-11.

⁹ January 28, 2020 Office action, TSDR p. 18-19.

¹⁰ *Id.*, p. 20.

- Tabor Hill Winery & Restaurant website touting “award-winning wines, stunning vineyard views, and a menu that has a combination of locally sourced fresh ingredients ... our restaurant is the perfect destination for all food and wine connoisseurs.”¹¹

Applicant takes issue with this evidence, arguing that the “something more” has not been met and “[j]ust citing wineries with restaurants having the same name as the wine produced by them does not offer anything more than a mark used for wine and the winery’s restaurant services.”¹² We disagree because, as the Examining Attorney explained, the mere fact that “a restaurant is connected with a winery makes it no less true that the same source commonly provides restaurant or bar services as well as wine under the same mark” and “although some of these establishments may use the term ‘winery,’ their restaurants feature prominently, and by definition, these establishments were used as examples of wine and bar services originating from a single source... .”¹³ In other words, the evidence remains probative to the extent that consumers have been accustomed to encountering the same mark used to identify the source of restaurant services and wine, regardless of whether the entities providing these goods and services may be wineries or vineyards.

This evidence demonstrates that consumers encounter wine under the same mark as restaurant services, and that wine-makers often have their own bars and restaurants. *See In re Detroit Ath. Co.*, 128 USPQ2d 1050 (crediting relatedness evidence that third parties use the same mark for the goods and services at issue

¹¹ October 19, 2021 Office action, TSDR p. 6-7.

¹² 4 TTABVUE 6.

¹³ 6 TTABVUE 13-14.

because “[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both”); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (stating that evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”).

Based on the record and given the inherent relationship, we find Applicant’s bar and restaurant services and Registrant’s wine are related. Accordingly, the second *DuPont* factor weighs in favor of finding a likelihood of confusion.

As to the third *DuPont* factor, involving the channels of trade and classes of consumers, we again base our determination on the goods and services as they are identified in the application and registration at issue, and must assume that they move through all normal and usual channels of trade and methods of distribution for such goods and services. *In re i.am.symbolic llc*, 123 USPQ2d 1751; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983). Here, the relevant consuming class for bar and restaurant services, as well as wine, is the same—the general adult population. The third-party Internet evidence set out above reflects that wine and restaurant and bar services are promoted and offered together, through the same websites and business establishments, and the goods and services reach the same classes of consumers. Accordingly, this factor weighs in favor of likely confusion.

C. Conclusion

Applicant’s mark, WHITE ELEPHANT SALOON, and Registrant’s inherently distinctive mark, WHITE ELEPHANT, are very similar in overall appearance, sound,

connotation and commercial impression. There is an inherent relationship between Applicant's bar services and Registrant's wine, and the evidence demonstrates a relationship between Applicant's restaurant services and Registrant's wine. The goods and services travel in some of the same trade channels to some of the same classes of consumers. For these reasons, we find confusion is likely to occur.

Decision: The refusal to register Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), is affirmed.