This Opinion is Not a Precedent of the TTAB

Mailed: April 18, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re RoboBurger Enterprises Inc.

Serial No. 90884560

Derek Fahey of The Plus IP Firm for RoboBurger Enterprises Inc.

Byron Greene, Trademark Examining Attorney,[1] Law Office 107,
Leslie Bishop, Managing Attorney.

Before Zervas, Larkin, and Allard,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

RoboBurger Enterprises Inc. ("Applicant") seeks registration on the Principal Register of the standard-character mark ROBO for goods ultimately identified as

[1] The involved application was originally examined by Trademark Examining Attorney Michael Engel, who issued the final refusal to register from which this appeal was taken. The application was assigned on appeal to Trademark Examining Attorney Greene, who filed the brief of the United States Patent and Trademark Office ("USPTO"). We will refer to them both as the "Examining Attorney."

"vending machines; industrial robots for making and assembling hamburgers and heated patty sandwiches" in International Class 7.[2]

The Trademark Examining Attorney has refused registration of Applicant's mark with respect to the goods identified as "vending machines" under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the standard-character mark ROBOCAFE, registered on the Principal Register for, among other things, "vending machines" in International Class 7,[3] as to be likely, when used in connection with the "vending machines" identified in the application, to cause confusion, to cause mistake, or to deceive.

When the Examining Attorney made the refusal final, Applicant requested reconsideration, which was denied, and subsequently appealed. The case is fully briefed.[4] We affirm the refusal to register.[5]

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[2] Application Serial No. 90884560 was filed on August 16, 2021 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's allegation of a bona fide intention to use the mark in commerce.

[3] The cited Registration No. 6686753 (the "'753 Registration") issued on March 29, 2022. In addition to "vending machines," the identification of goods in the '753 Registration includes "Automatic vending machines; Vending machines for coffee; Coffee extracting machines; Power-operated coffee grinders; Kiosks comprised of vending machines; Automatic vending machines and mechanisms for coin-operated apparatus sold as a unit; Coin-operated vending machines; Reverse vending machines that automate beverage container recycling by accepting empty containers and refunding the deposit to the consumer; Reverse vending machines that automate the return of empty bottles and cans."

[4] Citations in this opinion to the briefs refer to TTABVUE, the Board's online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 WL 2853282, at *1 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Applicant's appeal brief appears at 4 TTABVUE and its reply brief appears at 7 TTABVUE. The Examining Attorney's brief appears at 6 TTABVUE.

[5] As part of an internal Board pilot program on possibly broadening acceptable forms of legal citation in Board cases, this opinion varies from the citation forms recommended in Section 101.03 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") (June 2023).

I. Prosecution History and Record on Appeal[6]

We summarize below the prosecution history of the application because it provides useful background to our disposition of the appeal.

Applicant originally applied to register its mark for "Vending machines; Robotic apparatus for making, delivering, and assembling food items; Robotic apparatus for making, delivering, and assembling food products" in Class 7 and for various services in Class 43.[7]

The Examining Attorney refused registration under Section 2(d), with respect to Class 7 only, based on the '753 Registration and another registration that is not at issue on this appeal, and also noted that two prior pending applications were potential bars to registration if they matured into registrations.[8] The Examining Attorney also requested amendments to Applicant's Class 7 identification of goods,[9] and submitted the USPTO electronic records for the '753 Registration.

Applicant filed an extensive response to the first Office Action. Applicant amended its Class 7 identification of goods to the ultimate one set forth above, and argued

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This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals only by the pages on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). This opinion cites only precedential Board decisions and does so by reference to the Westlaw ("WL") database. Citations from the United States Patents Quarterly ("USPQ") are not used. Until further notice, however, practitioners should continue to adhere to the citation forms set forth in TBMP § 101.03.

[6] Citations in this opinion to the application record are to pages in the USPTO's Trademark Status & Document Retrieval ("TSDR") database.

[7] August 16, 2021 Application at TSDR 1.

[8] May 19, 2022 Office Action at TSDR 1.

[9] *Id.*

against the actual and prospective refusals to register.[10] Applicant made of record dictionary definitions of "café,"[11] "robo,"[12] "coffee,"[13] "recycle,"[14] "hamburger,"[15] "lodging,"[16] "reservation,"[17] "restaurant,"[18] "fast-food,"[19] "worldwide,"[20] and "local;"[21] the results of search engine searches on the terms "vending machine products,"[22] and "hamburger vending machines;"[23] pages from the website of Starbucks Coffee Company;[24] certificates of third-party registrations and USPTO electronic records of marks containing ROBO for various goods and services, and certificates of registration and USPTO electronic records regarding registrations of such marks owned by Applicant;[25] and Internet travel webpages displaying "robo."[26]

[10] November 8, 2022 Response to Office Action at TSDR 1-59.

[11] *Id.* at TSDR 60-66.

[12] *Id.* at TSDR 67-71.

[13] *Id.* at TSDR 72-82.

[14] *Id.* at TSDR 83-88.

[15] *Id.* at TSDR 89-96.

[16] *Id.* at TSDR 131-37.

[17] *Id.* at TSDR 138-43.

[18] *Id.* at TSDR 148-56.

[19] *Id.* at TSDR 157-60.

[20] *Id.* at TSDR 219-27.

[21] *Id.* at TSDR 228-34.

[22] *Id.* at TSDR 97-104.

[23] *Id.* at TSDR 105-08.

[24] *Id.* at TSDR 109-11.

[25] *Id.* at TSDR 112-30, 161-218.

[26] *Id.* at TSDR 144-47.

The Examining Attorney then suspended examination of the application pending the disposition of the prior pending applications.[27] Although no response to the suspension notice was required, Applicant filed a full-blown response and appears to have made of record the same evidence that it made of record in its response to the first Office Action.[28]

Applicant then filed a request to divide its application, requesting that the goods in Class 7 remain in the "parent" application and the services in Class 43 be placed in a new "child" application.[29] The USPTO granted the request and created a new application Serial No. 90979755 containing the Class 43 services.[30] That application is not before us on this appeal.

The Examining Attorney then issued an Office Action making final the refusal to register based on the cited '753 Registration.[31] The Examining Attorney noted that "**[t]his refusal applies only to vending machines, and not to the other goods in the current identification**."[32] The Examining Attorney submitted the USPTO

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[27] November 30, 2022 Suspension Letter at TSDR 1.

[28] March 2, 2023 Response to Suspension Letter at TSDR 54-228. Applicant subsequently made some of the same evidence of record again in its Request for Reconsideration. It was unnecessary and counterproductive for Applicant to make the same evidence of record more than once. *Cf. Made in Nature, LLC v. Pharmavite LLC*, 2022 WL 2188890, at *7 (TTAB 2022) ("The Board views the practice of introducing cumulative evidence at trial with disfavor."). We will cite evidence in only one location in the record.

[29] March 20, 2023 Request to Divide Application at TSDR 1.

[30] May 12, 2023 Notice That Processing of Request to Divide Application is Completed at TSDR 1.

[31] June 2, 2023 Final Office Action at TSDR 1. The Examining Attorney noted that one of the prior pending applications had matured into a registration, but stated that neither mark was considered any longer as a bar to registration. *Id.*

[32] *Id.* at TSDR 1 (emphasis in bold here in underscoring in the original).

electronic records for two of the third-party registrations made of record by Applicant that identify "vending machines" and were issued based on use in commerce.[33]

Applicant then requested reconsideration, making of record the results from searches using the Google Search and Google Shopping search engines on the terms "robo vending machine" and "robo vending machines;[34] the results of a search on the ebay.com website using the term "robo vending machine;"[35] the results of a search of the USPTO's Trademark Electronic Search System ("TESS") database using the term "robo," including certificates of registration of such marks;[36] the same dictionary definitions already in the record;[37] the same Google search engine results already in the record;[38] and the same pages from the Starbucks website already in the record.[39] The Examining Attorney subsequently denied the Request for Reconsideration.[40]

II. Section 2(d) Refusal

"The Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion [or] mistake, or to deceive." *In re Charger Ventures LLC*, 64 F.4th 1375, 1379 (Fed. Cir. 2023) (cleaned up). Our determination

[33] *Id.* at TSDR 2-3.

[34] July 10, 2023 Request for Reconsideration at TSDR 32-58.

[35] *Id.* at TSDR 59-74.

[36] *Id.* at TSDR 75-97.

[37] *Id.* at TSDR 98-134.

[38] *Id.* at TSDR 135-46.

[39] *Id.* at TSDR 147-49.

[40] August 3, 2023 Denial of Request for Reconsideration at TSDR 1.

of the likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) ("*DuPont*"). *Charger Ventures*, 64 F.4th at 1379. We consider each *DuPont* factor for which there is evidence and argument. *See, e.g.*, *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019).

"In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the [goods or] services." *Monster Energy Co. v. Lo*, 2023 WL 417620, at *6 (TTAB 2023) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976)), *civ. action filed*, No. 5:23-cv-00549-GW-PVC (C.D. Cal. Mar. 28, 2023). Applicant references these two key factors, 4 TTABVUE 8, and also cites "evidence of numerous and rampant third-party use of the term 'ROBO' in association with vending machines," *id.*, which references the sixth *DuPont* factor, the "number and nature of similar marks in use on similar goods." *DuPont*, 476 F.2d at 1361.[41]

[41] In its reply brief, 7 TTABVUE 6-8, Applicant appears to invoke the fourth *DuPont* factor, the "conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing." *DuPont*, 476 F.2d at 1361. Applicant makes no reference to this factor in its appeal brief. We have given Applicant's arguments regarding the fourth *DuPont* factor no consideration because they were made for the first time in Applicant's reply brief, and the Examining Attorney thus had no opportunity to address them in his brief. *See Instagram, LLC v. Instagoods Pty Ltd.*, 2023 WL 6786567, at *7 (TTAB 2023) (refusing to consider argument made for the first time in reply brief on motion); *Major League Baseball Players Ass'n v. Chisena*, 2023 WL 2986321, at *26 (TTAB 2023) (argument under the thirteenth *DuPont* factor raised by opposers for the first time in their reply brief not considered under that factor), *appeal docketed*, No. 23-2073 (Fed. Cir. June 26, 2023); *cf. In re City of Hous.*, 2012 WL 423805, at *2 (TTAB 2012) (refusing to consider evidence submitted by applicant with reply brief because examining attorney had no opportunity to respond to it).

A. Similarity or Dissimilarity of the Goods

"The second *DuPont* factor 'considers [t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.'" *In re Embiid*, 2021 WL 2285576, at *10 (TTAB 2021) (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018) (quoting *DuPont*, 476 F.2d at 1361)).

"In analyzing the [goods], the Board 'considers 'the similarity or dissimilarity and nature of the [goods] as described in an application or registration.'" *In re OSF Healthcare Sys.*, 2023 WL 6140427, at *4 (TTAB 2023) (quoting *Embiid*, 2021 WL 2285576, at *10) (internal quotation omitted). The goods identified in the application that are the subject of the final refusal to register are "vending machines,"[42] and the identification of goods in the '753 Registration also includes "vending machines."

Applicant acknowledges that "the Examining Attorney must compare the relatedness of the goods **as described in the application and registration**," 4 TTABVUE 16 (emphasis supplied by Applicant), but argues that the '753 Registration "specifically references coffee within its registered goods in addition to 'beverage container recycling,'" while Applicant's ultimate identification of goods "makes no reference to beverages or recycling of any sort, but rather refers to hamburgers only." *Id.* Applicant discusses these claimed differences between the goods at length, *id.* at 16-19, concluding that "[a]lthough both Applicant's Goods and

[42] As noted above, the Examining Attorney has not refused registration with respect to the goods identified in the application as "industrial robots for making and assembling hamburgers and heated patty sandwiches."

the '753 Mark's Goods include vending machines, they are not interchangeable nor related based upon their genre of consumable material or mechanical purpose."

These arguments reflect a fundamental misunderstanding of the respective identifications. In both the application and cited registration, goods identified as "vending machines" are separated by semicolons from the other goods in the identifications, which refer to hamburgers in the application and, in a few instances, to coffee or recycling in the '753 Registration. "Under standard examination practice, a semicolon is used to separate distinct categories of goods or services." *Monster Energy*, 2023 WL 417620, at *7 n.35 (quoting *In re Midwest Gaming & Ent. LLC*, 2013 WL 1442237, at *4 (TTAB 2013)). The broad category of goods identified as "vending machines" in the application and cited registration stands on its own, and is not narrowed or otherwise modified by the descriptions of other categories of goods in the respective identifications. The goods are identical because the identifications of goods in the application and the cited registration both include "vending machines." The second *DuPont* factor strongly supports a conclusion that confusion is likely.[43]

[43] Applicant does not address the third *DuPont* factor, the "similarity or dissimilarity of established, likely-to-continue trade channels," *DuPont*, 476 F.2d at 1361, 4 TTABVUE 8, but the Examining Attorney correctly notes that because the goods are identical, and the involved identifications have no limitations as to the goods' nature, channels of trade, or classes of consumers, the identical goods "are 'presumed to travel in the same channels of trade to the same class of purchasers.'" 6 TTABVUE 13 (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268 (Fed. Cir. 2002)). The third *DuPont* factor thus also strongly supports a conclusion that confusion is likely.

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

The sixth *DuPont* factor "considers [t]he number and nature of similar marks in use on similar goods.'" *Omaha Steaks Int'l Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1324 (Fed. Cir. 2018) (quoting *DuPont*, 476 F.2d at 1361). "'The Federal Circuit has held that evidence of the extensive registration and use of a term by others can be powerful evidence of the term's weakness.'" *Embiid*, 2021 WL 2285576, at *16 (quoting *Tao Licensing, LLC v. Bender Consulting Ltd.*, 2017 WL 6336243, at *14 (TTAB 2017) (citing *Jack Wolfskin Ausrustung Fur Draussen GmbH v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 1373 (Fed. Cir. 2015) and *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39 (Fed. Cir. 2015)).

"There are two prongs of analysis for a mark's strength under the sixth factor: conceptual strength and commercial strength." *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1362 (Fed. Cir. 2023). "Conceptual strength is a measure of a mark's distinctiveness" along the spectrum of distinctiveness from generic terms to fanciful marks, *id.* (citations omitted), while commercial strength "'is the marketplace recognition value of the mark.'" *Id.* at 1363 (quoting 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. 2023)).

"The purpose of introducing evidence of third-party use is 'to show that customers have become so conditioned by a plethora of such similar marks that customers 'have been educated to distinguish between different [such] marks on the bases of minute distinctions.'" *Omaha Steaks*, 908 F.3d at 1324 (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.2d 1369, 1374 (Fed. Cir. 2005)

(internal quotation omitted)). "Use evidence may reflect commercial weakness, while third-party registration evidence that does not equate to proof of third-party use may bear on conceptual weakness if a term is commonly registered for similar goods or services." *Tao Licensing*, 2017 WL 6336243, at *14.

Applicant argues that "evidence of numerous and rampant third-party use of the term 'ROBO' in association with vending machines demonstrates that the Cited Mark is relatively weak and entitled to only a narrow scope of protection" and that "numerous third-party use of similar marks in relation to similar goods show that the '753 Mark is relatively weak, and therefore, entitled to only a narrow scope of protection." 4 TTABVUE 8.

With respect to third-party registrations, Applicant argues that

> [a] review of the Principal Trademark Register reveals a pattern of registrations reflecting the USPTO's view that the term "ROBO", or variations thereon, is weak and regularly distinguished as a component of marks registered in connection with electronic devices, among a variety of other goods and services. In the present case, the plethora of third-party registrations shows a commercial attractiveness and popularity possessed by the word "ROBO" in Class 007 to an extent where it is now far too late for any one party to claim a right to exclusive use extending beyond a specific mark for specific goods and services.

Id. at 20.[44] In its appeal brief, Applicant provides a table of 16 third-party registrations of ROBO-formative marks in Class 7 that it claims are relevant under

[44] This argument sits ill in Applicant's mouth because Applicant itself "claim[s] a right to exclusive use" of ROBO alone through the involved application, in which it seeks to obtain the exclusive nationwide right to use ROBO for vending machines. *See* 15 U.S.C. § 1057(b).

the sixth *DuPont* factor. *Id.* at 21-24. Applicant concludes that these registrations demonstrate

> three important points: (1) the USPTO considers that the term "ROBO" is entitled to a limited scope of protection vis-à-vis other trademarks which contain the term in relation to automated machines and electronic devices; (2) these registrations are able to co-exist on the Principal Trademark Register without causing a likelihood of confusion; and (3) consumers are conditioned to seeing the term "ROBO" used in connection with robotic related goods and services, and as such, can distinguish between the sources of said services by considering the marks in their entireties. Accordingly, Applicant's Mark is capable of co-existing with the '753 Mark on the Principal Register and in the marketplace without any likelihood of confusion.

Id. at 24.

With respect to third-party uses, Applicant cites "webpages of vending machine related products using the term 'ROBO' (and variations thereof) as appearing on Google," as well as in the results of a search on ebay.com. *Id.* at 25. Applicant cites 17 examples of such uses in its appeal brief. *Id.* at 25-26. Applicant concludes that "[g]iven the widespread use of the term 'ROBO' (and variations thereof) in vending related product titles, consumers are inclined to observe the additional terms which accompany the Marks (or lack thereof in this case) to distinguish the products from one another." *Id.* at 26.

The Examining Attorney responds that eight of the third-party registrations are for "goods that are predominantly different from or unrelated to those identified in the cited registration and applicant's application," 6 TTABVUE 9, and that only six of the registrations "appear to be active and based on use in commerce for vending machines and one of these registrations is the cited mark, U.S. Registration No.

6686753." *Id.* at 10.[45] The Examining Attorney further argues that the third-party registrations that include vending machines "contain the term ROBO in addition to other language that distinguishes the marks from one another." *Id.* He concludes that "the few use-based third-party registrations submitted by applicant are insufficient to establish that the word ROBO is inherently or conceptually weak." *Id.*

With respect to Applicant's third-party use evidence, the Examining Attorney argues that even if the cited mark is weak, it is entitled to protection "against the registration by a subsequent user of a similar mark for closely related goods," and that Applicant's mark "is likely to appear to prospective purchasers as a shortened form of registrant's mark." *Id.* at 11 (citations omitted).

In its reply brief, Applicant significantly broadens what it calls "the trademark landscape" by referring to what it calls "extensive usage of the term 'ROBO' across multiple coordinated classes that are relevant to and intersect with the Applicant's Goods," including Classes 8, 11, 12, 35, 37, 40, and 42, citing a link to pages on the USPTO's website. 7 TTABVUE 4.[46] Applicant argues that the Examining Attorney's "analysis narrowly focused on registrations that specifically incorporate vending machines, disregarding the broader spectrum of third-party marks using 'ROBO' in coordinated classes." *Id.*

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[45] Applicant also cites its own registration of ROBO BURGER. 4 TTABVUE 21 (Registration No. 6594186). This is not a third-party registration. *Made in Nature*, 2022 WL 2188890, at *15.

[46] Putting aside the untimeliness of this purported submission of evidence, a link does not make of record materials accessible through the link. *See*, *e.g.*, *In re Aquitaine Wine USA, LLC*, 2018 WL 1620989, at *9 n.21 (TTAB 2018) (citations omitted). There is no record evidence regarding marks for goods and services in Classes 8, 11, 12, 35, 37, 40, and 42.

Applicant also argues in its reply brief that the Examining Attorney "improperly dismissed consideration of the registrations submitted by applicant (Registration Nos. 4497321, 4564529, 5224648, 6114474, 6283889, 6570876, 6660638, and 6695443) as being predominantly different from or unrelated to those identified in the Cited Registration and the Applicant's [application]." *Id.* at 5.

As discussed above, the involved goods are identical "vending machines." Where the involved goods are identical, third-party uses on other goods have no real probative value regarding a mark's or term's weakness. *Omaha Steaks*, 908 F.3d at 1326 (finding that third-party uses of OMAHA-formative marks on popcorn, alcoholic beverages, and other foods products were not probative of the weakness of the opposer's mark where both parties used their marks on meat products). As the Federal Circuit explained in *Omaha Steaks*, when third-party uses on different goods "are properly understood as having no real probative value for the analysis at hand, the evidentiary universe is much smaller." *Id.; see also Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Eds., Inc.*, 937 F.2d 1572, 1579 (Fed. Cir. 1991) ("ACE for canned, large peas could not escape likelihood of confusion with a prior use of ACE for canned, small peas because ACE is concurrently used by unrelated third parties on aircraft, clothing, computer services, hardware or even bread, bananas, milk and canned carrots. Properly defined, the relevant public in the example need be defined no broader than purchasers of canned peas, and the third party ACE marks outside the segment become essentially irrelevant"); *Made in Nature*, 2022 WL 2188890, at *13

(citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1328-29 (Fed. Cir. 2017)). As discussed below, the "evidentiary universe" of relevant third-party marks is very small here.

Turning first to Applicant's third-party registration evidence, Applicant made of record six registrations of ROBO-formative marks for goods identified as "vending machines" or a legal equivalent:

- Registration No. 5577987 of ROBOBRAIN for "automatic vending machines;"[47]
- Registration No. 4769022 of ROBOLECTOR for "automatic vending machines;"[48]
- Registration No. 5659082 of YYD ROBO and design for "vending machines;"[49]
- Registration No. 5750538 of FUSION ROBOTICS for "vending machines;"[50]
- Registration No. 5688139 of ROBOMINDS for "automatic vending machines;"[51] and
- Registration No. 6897502 of ROBOTISE for "vending machines for the preparation and dispensing of beverages and food products."[52]

As the Examining Attorney notes, 6 TTABVUE 10, Registration Nos. 5688139 and 6897502 issued under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f, which does not require proof of use of a mark to secure its registration. There is no evidence

[47] November 8, 2022 Response to Office Action at TSDR 121. Applicant made of record only a portion of the certificate of registration of this mark.

[48] *Id.* at TSDR 123-24.

[49] *Id.* at TSDR 125-26.

[50] *Id.* at TSDR 127.

[51] *Id.* at TSDR 128-29. Applicant made of record only two of the three pages of the certificate of registration of this mark.

[52] July 10, 2023 Request for Reconsideration at TSDR 81-82. Applicant made of record only two of the three pages of the certificate of registration of this mark.

of use of these registered marks, and these two registrations thus "lack probative value, and we have not considered them." *Made in Nature*, 2022 WL 2188890, at *14.

As a result, there are only four use-based third-party registrations of marks for goods identified as "vending machines" or a legal equivalent, none of which contains the word CAFE that appears in the cited mark. These registrations show "marks containing additional elements, trademark formatives of different grammatical syntax or having a differing overall commercial impression," *id.*, that cause two of the registered marks, FUSION ROBOTICS and YYD ROBO, to be quite dissimilar to the cited mark ROBOCAFE.[53] The marks ROBOBRAIN and ROBOLECTOR are structurally similar to the cited mark ROBOCAFE in that each begins with ROBO and contains a second word, but they have very different commercial impressions than ROBOCAFE, and their probative value is limited accordingly. *Id.*

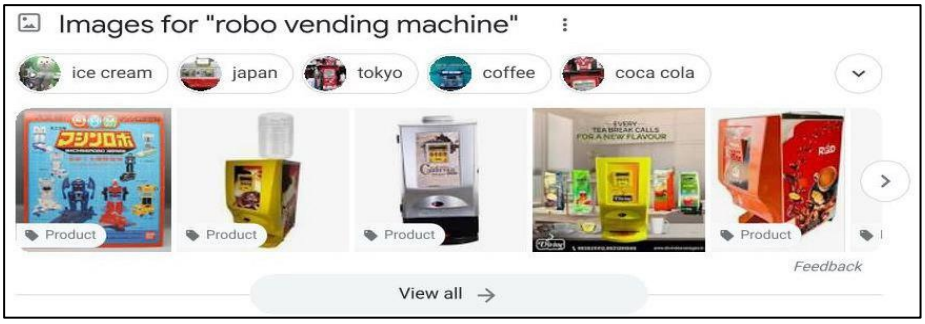
Turning next to Applicant's use evidence, Applicant lists 17 claimed third-party uses on "webpages of vending machine related products using the term 'ROBO' (and variations thereof) as appearing on Google" and ebay.com. 4 TTABVUE 25-26. Based on Applicant's own list, 12 of the listed marks contain "ROBO." *Id.*[54]

[53] The FUSION ROBOTICS mark does not contain the word ROBO alone that is common to the involved marks, and the registrant has disclaimed the exclusive right to use ROBOTICS apart from the mark as shown, November 8, 2022 Response to Office Action at TSDR 127, confirming that the lead word FUSION is the source-identifying portion of the mark. The YYD ROBO mark does not begin with ROBO, and the registrant has disclaimed the exclusive right to use ROBO apart from the mark as shown, *id.* at TSDR 125-26, similarly confirming that the lead element YYD is the source-identifying portion of the mark.

[54] The other five listed uses are "Robotic vending machine," "Robot Ice Cream Vending Machine," "Robotic froyo vending machine," "Vendall Vendor – The Robotic Vending Machine," and "Coca Cola – Vending Machine Robot Red Piggy bank figure." 4 TTABVUE 25-26.

Applicant did not make pages from the websites of sellers of vending machines of record, but instead submitted the results of searches on the google.com and ebay.com websites using the search terms "robo vending machine" and "robo vending machines."[55] We display below a few examples of the search results:

[56]



[57]

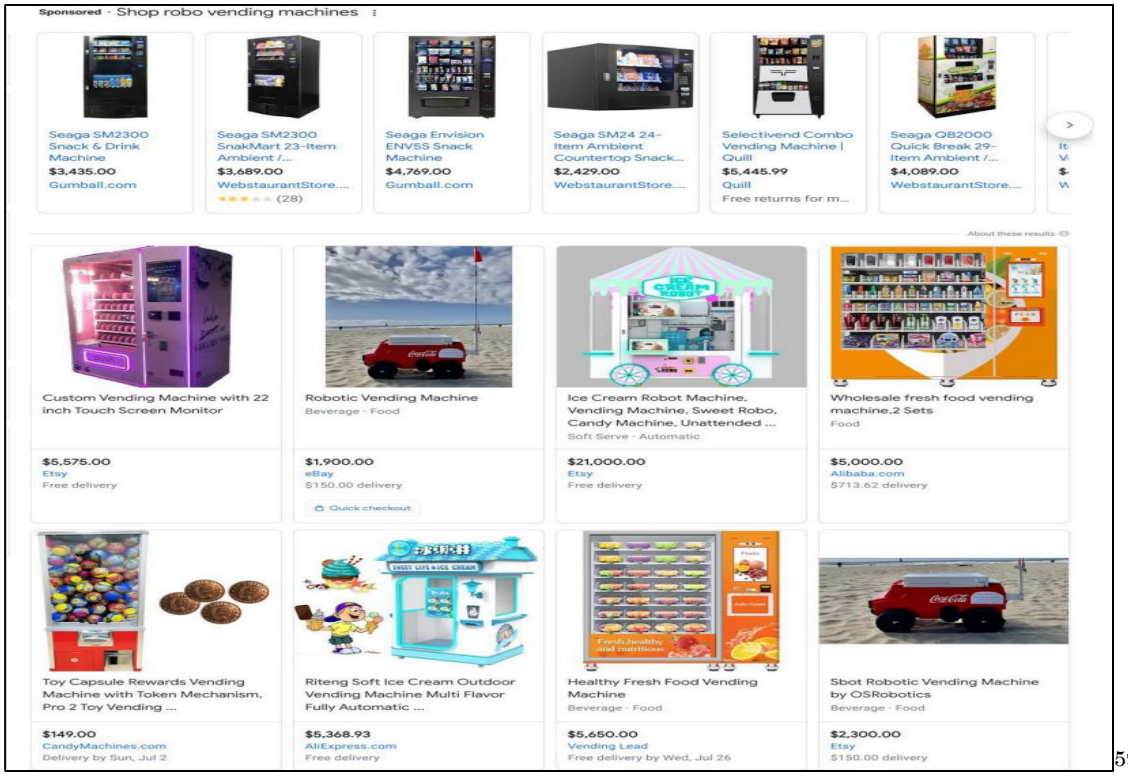
[58]

[55] July 10, 2023 Request for Reconsideration at TSDR 32-74.

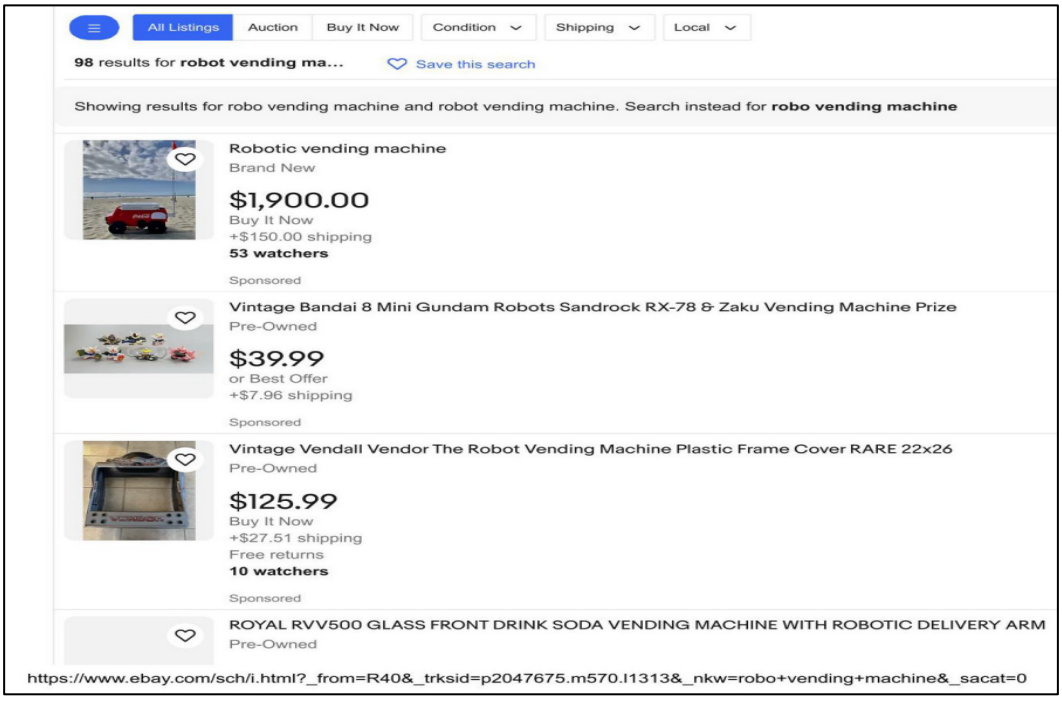
[56] *Id.* at TSDR 33.

[57] *Id.*

[58] *Id.* at TSDR 36. Vending machines from "IndiaMART," including the "Continental Max Robo Coffee Vending Machine" and "Lane Robo" machines listed by Applicant, 4 TTABVUE 25, appear numerous times in the search results. Almost all of these entries contain prices expressed in a currency other than United States dollars, and we cannot tell whether the goods are sold in the United States.



[59]



[60]

[59] July 10, 2023 Request for Reconsideration at TSDR 42 (Google Shopping).

[60] *Id.* at TSDR 63 (eBay).


[61]

Applicant's use of search results rather than the actual webpages of sellers of vending machines is problematic. A "list of Internet search results generally has little probative value, because such a list often does not contain sufficient surrounding text to show the context in which the term is used on the listed web pages." *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 2017 WL 542344, at *11 n.59 (TTAB 2017). "Search engine results—which provide little context to discern how a term is actually used on the webpage that can be accessed through the search result link—may be insufficient to determine the nature of the use of a term or the relevance of the search results to registration considerations." *In re Bayer AG*, 488 F.3d 960, 967 (Fed. Cir. 2007). Here, it is very difficult, and in some instances impossible, to tell from Applicant's search results whether there are any third-party uses of ROBO as a trademark for vending machines in the United States.[62]

The first two search results displayed above illustrate this problem. In the first search result, the word "ROBO" appears to be an internal shorthand for "robotic"

[61] *Id.* at TSDR 73 (eBay).

[62] There are multiple photographs in the search results of what appears to be Applicant's own ROBO vending machine, *id.* at TSDR 51-57, but like Applicant's own registrations, these uses do not involve third-party marks. *Made in Nature*, 2022 WL 2188890, at *15.

rather than a mark for a product sold in the United States because the search result summary states that the referenced vending machine "has the words 'Hug Me' emblazoned on the front," and in 2012 was "giving out freebies" at an unspecified event in Singapore.[63] The referenced machine itself is not shown. In the second search result captioned "Images for 'robo vending machine'," it is very difficult to read what appears on the products shown in the images, but none of them appears to bear a ROBO-formative mark.[64]

To make matters worse, Applicant does not cite to the specific pages in the search results on which the third-party uses of ROBO listed in its appeal brief appear. Instead, Applicant merely directs the Board to Exhibits 1 and 2 to its Request for Reconsideration, 4 TTABVUE 25-26, which contain more than 40 pages and several hundred thumbnail photographs.[65] This is unhelpful advocacy. Nevertheless, we have examined the entire record as best we can to try to locate relevant evidence regarding third-party uses of ROBO-formative marks in the United States on vending machines.

As best as we can tell, there may be three such uses shown in the thumbnail photographs.[66] One is described as a "RoboCrib™ Vending Machine" and is associated

[63] July 10, 2023 Request for Reconsideration at TSDR 33.

[64] *Id.*

[65] *Id.* at TSDR 32-74.

[66] *Id.* at TSDR 36, 42, 63. There are some thumbnail photographs that are accompanied by descriptions that contain the term "ROBO," but because the descriptions in the search results appear to make frequent use of "Robo" as a shorthand for "Robotic," we cannot assume that any vending machines described by the use of "Robo" is actually branded with a ROBO-formative mark. There is a photograph of a machine described as a "Lipton 3 Lane Robo Vending Machine" that appears to bear the Lipton mark, not the ROBO mark. *Id.* at TSDR

with a company identified as "Edmonton Valve & Fitti . . . ."[67] The second is described as "Robo Cafe RC Coffee Toronto Kensington" and bears the ROBO CAFE mark.[68] The third bears the mark "RoboCopy" and is described as a "Robo Copy" machine.[69] None of them is listed by Applicant in its appeal brief. 4 TTABVUE 25-26. The search results from the ebay.com website also include summaries from websites offering vending machines for sale,[70] one of which lists a number of brands.[71] There is no brand listed that contains the word ROBO.

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37. Other products, many of which bear Kanji characters, are described as "RS-127 [Super Rare]: Bio Robo (Vending Machin . . .," "Battle Fever Robo (Vending Machine Version)," "Change Robo (vending machine version)," "1985 vintage Japanese Bandai MACHINE ROBO vending machine Display Card Gobots!!," "Bandai Machinerobo Universe Unitroborn Unitrobo Shark Vending Machine Japan," "Vintage Bandai Super Macross Robotech Vending Gumball Machine Gashapon Robot #3," and "Shogun Warrior Robot Robocon Gumball Vending Machine Japan Lighter," but these products appear to be video games, action figures, or other goods, not vending machines. *Id.* at TSDR 34, 44, 46, 64, 66-67. Photographs of actual vending machines on which we cannot see any marks are described as "Robomarket Smart . . . ." and "Robomarket Smart Micro Mark . . . .", *id.* at TSDR 52, a "2 Lane Robo" machine, *id.* at TSDR 55, and a "Popcorn – SweetRobo" machine. *Id.* Vending machines bearing what appears to be the mark MAX are described as "Robo (2/3 Lane)," "Robo (4/6 Lane)," and "Max 3 Lane Robo" machines. *Id.* at TSDR 54-57. There are other descriptions containing the word "Robo," including the "Robocar Poli Speaking Vending Machine Korean Toy Animation" listed by Applicant, 4 TTABVUE 26, that are not accompanied by thumbnail photographs. July 10, 2023 Request for Reconsideration at TSDR 57, 65.

[67] July 10, 2023 Request for Reconsideration at TSDR 52. Edmonton is a Canadian city and we cannot tell whether this vending machine is sold in the United States.

[68] *Id.* at TSDR 56. Toronto is a Canadian city in the province of Ontario. We note in that regard that the owner of the '753 Registration has an address of record in the city of Mississauga in the province of Ontario. May 19, 2022 Office Action at TSDR 9. This vending machine bearing the ROBO CAFE mark thus may be the registrant's own machine.

[69] July 10, 2023 Request for Reconsideration at TSDR 57. It is not clear that this is a vending machine rather than a copying machine, as the name suggests, and we cannot tell whether this product is sold in the United States.

[70] *Id.* at TSDR 73-74.

[71] *Id.* at TSDR 73 (vendingconcepts.com).

Four third-party registrations of varying probative value and two or three possible third-party uses in the United States are "a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant in both" *Jack Wolfskin* and *Juice Generation*. *In re Inn at St. John's, LLC*, 2018 WL 2734893, at *4 (TTAB 2018), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019). "[I]n *Juice Generation*, there were at least twenty-six relevant third-party uses or registrations of record . . . and in *Jack Wolfskin*, there were at least fourteen." *Sabhnani v. Mirage Brands, LLC*, 2021 WL 6072822, at *13 n.20 (TTAB 2021) (quoting *In re Morinaga Nyugyo K.K.*, 2016 WL 5219811, at *9 n.8 (TTAB 2016)).

The cited ROBOCAFE mark was registered on the Principal Register without a showing of acquired distinctiveness,[72] and it is presumed to be inherently distinctive for vending machines. *Made in Nature*, 2022 WL 2188890, at *12 (citing *Tea Bd. of India v. Republic of Tea, Inc.*, 2006 WL 2460188, at *21 (TTAB 2006)). Applicant's third-party registration and use evidence falls far short of showing that the cited ROBOCAFE mark is either conceptually or commercially weak, and we will accord the mark "the normal scope of protection to which inherently distinctive marks are entitled." *Sabhnani*, 2021 WL 6072822, at *13 (quoting *Bell's Brewery, Inc. v. Innovation Brewing*, 2017 WL 6525233, at *9 (TTAB 2017)). The sixth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

[72] May 19, 2022 Office Action at TSDR 9-11.

C. Similarity or Dissimilarity of the Marks

"Under the first *DuPont* factor, we consider 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" *Sabhnani*, 2021 WL 6072822, at *13 (quoting *Palm Bay Imps.*, 396 F.2d at 1371). "'Similarity in any one of these elements may be sufficient to find the marks confusingly similar.'" *Id.* (quoting *Inn at St. John's*, 2018 WL 2734893, at *5 (internal quotation omitted)).

"The proper test regarding similarity '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.'" *Id.* (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373 (Fed. Cir. 2018) (internal quotation omitted)). "'The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.'" *Id.* (quoting *In re i.am.symbolic, llc*, 2018 WL 3993582, at *4 (TTAB 2018)).

Because the goods are identical, "a lesser degree of similarity between the marks is required for confusion to be likely." *Id.*, at *14 (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992); *New Era*, 2020 WL 2853282, at *17).

The involved marks are ROBOCAFE and ROBO, both in standard characters. Applicant argues that they are "dissimilar as to overall visual appearance and

appearance of the words comprising the Marks," 4 TTABVUE 10, noting that Applicant's ROBO mark contains one word while the cited mark ROBOCAFE contains two. Applicant claims that the presence of the word CAFE in the cited mark "highlights the visual distinction between Applicant's Mark and the '753 Mark" and that consumers "would be able to distinguish the source of goods between robotic vending machines for hamburgers bearing the Applicant's Mark and coffee vending/recycling machines for hamburgers bearing the '753 Mark." *Id.* at 11.

Applicant argues that the marks differ in sound because "[a]lthough both Applicant's Mark and the '753 Mark share the prefix 'ROBO', the auditory impression created by the added suffix 'CAFE' in the '753 Mark is distinct as compared to the term 'ROBO' alone." *Id.* Applicant further argues that the marks

> are overall comprised of different sounding letters, terms, and emphasized syllables that require different pronunciation and spelling. The Applicant's Mark is made up of the singular distinct word, "ROBO" ending with the pronounced "*bo*" sound. By contrast, the '753 Mark is made up of two conjoined words, "ROBO" and "CAFE" wherein the final pronunciation focuses on the "*fe*" sound.

Id. at 12. Applicant offers the following table in its appeal brief regarding "the differences in letters, consonants, vowels, and syllables" between the marks:

Table 2: Relevant Marks

Marks	Total Letters	Consonants	Vowels	Syllables
ROBO (*Applicant's Mark*)	4	2	2	2
ROBOCAFE (*'753 Mark*)	8	4	4	4

Id. Applicant concludes that its mark ROBO "is a two-syllable Mark ending with the vowel 'O'. In contrast, the '753 Mark for 'ROBOCAFE' is a four-syllable Mark ending

with the vowel 'E'. Additionally, the '753 Mark contains double the number of letters, consonants, vowels, and syllables than that of Applicant's Mark as noted in Table 2 above." *Id.* at 13.

With respect to meaning, Applicant argues that its mark "and the '753 Mark taken in their entireties, represent substantially different connotations and commercial impressions" due to the presence of the suffix -CAFE in the cited mark. *Id.* at 14. Applicant argues that "[t]he meaning or connotation of a mark must be determined concerning the named goods or services" and that "[e]ven marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion." *Id.* (citation omitted). Applicant again focuses on the claimed differences between the goods in arguing that "patrons of the '753 Mark [ROBOCAFE] would not be visiting in the hopes of being served a hamburger and those of Applicant's Mark [ROBO] would not be seeking an establishment that serves coffee." *Id.* at 15.

The Examining Attorney responds that "[b]oth marks begin with the identical word, ROBO, and as a result, the marks initially appear similar" and that "[t]his is significant because consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark." 6 TTABVUE 5 (citations omitted). The Examining Attorney further argues that "the entirety of applicant's mark, ROBO, and the first, and thus prominent, part of registrant's mark, ROBOCAFE, consist of the identical and arbitrary word ROBO" and "[i]ncorporating

the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d)." *Id.* at 5-6 (citations omitted). He concludes that "because applicant's and registrant's marks begin with the identical part, ROBO, and because applicant's and registrant's goods involve vending machines, the marks create a similar overall commercial impression of a vending machine robot." *Id.* at 6.

The Examining Attorney argues alternatively that

> even if potential purchasers realize the apparent differences between the marks, they could still reasonably assume, due to the overall similarities in sound, appearance, connotation, and commercial impression in the respective marks, that the vending machines sold under the applied-for mark, ROBO, constitute a new or additional product line from the same source as the vending machines sold under the registered mark, ROBOCAFE, and that the applied-for mark is merely a variation of the registered mark.

Id. He further argues that "the presence of the prominent and arbitrary word ROBO at the beginning of both marks makes it such that the marks are similar in appearance, sound, connotation, and commercial impression." *Id.* at 7. He concludes that "consumers are likely to assume a connection between the parties given that the entirety of applicant's mark, ROBO, and the first part of registrant's mark, ROBOCAFE, are the same and because both parties provide vending machines." *Id.* at 8.

In its reply brief, Applicant argues that "the term 'CAFÉ' conveys a meaning related to an 'informal establishment serving various refreshments (such as coffee)'

as defined by the Merriam-Webster Dictionary." 7 TTABVUE 3.[73] Applicant once again focuses on the claimed differences between the goods in arguing that "patrons of the Cited Registration would not be visiting in the hopes of being served a hamburger and those of the Applicant's Mark would not be seeking an establishment that serves coffee." *Id.*

Applicant concludes in its reply brief that

> the differences in commercial impression between the Applicant's Mark and the Cited Registration are dramatic, and much more significant than any similarities. The interpretative and literal distinctions mentioned herein make it likely that consumers will focus on these discrepancies and properly identify the source of the marked goods and services. As a result, the clear differences in meaning and commercial impression between the Applicant's Mark and the Cited Registration ensure that consumers will not be confused as to the source of goods.

Id. at 4.

The cited mark ROBOCAFE contains the entirety of Applicant's ROBO mark, and "[l]ikelihood of confusion often has been found where the entirety of one mark is incorporated within another." *Hunter Indus., Inc. v. Toro Co.*, 2014 WL 1649332, at *11 (TTAB 2014) (finding the applicant's PRECISION mark to be "substantially similar in sound, appearance, connotation and commercial impression" to the opposer's PRECISION DISTRIBUTION CONTROL mark when used on closely related goods); *see also In re Mighty Leaf Tea*, 601 F.3d 1342, 1347-48 (Fed. Cir. 2010)

[73] We note in that regard that the drawing of the mark shown in the '753 Registration displays the mark as ROBOCAFE without a grave accent on the letter E in CAFE. May 19, 2022 Office Action at TSDR 9-11. The MERRIAM-WEBSTER DICTIONARY states that CAFE is a variant or less common form of CAFÉ. November 8, 2022 Response to Office Action at TSDR 61.

(finding the applicant's ML mark to be confusingly similar to the cited ML MARK LEES mark for the same or similar goods).

The first thing seen and heard in the cited mark, and the only thing seen and heard in Applicant's mark, is the word ROBO, which sounds and appears identical in each mark. As discussed above, Applicant emphasizes the different numbers of "letters, consonants, vowels, and syllables" in the marks, 4 TTABVUE 12, but the Board has long recognized that consumers typically do not focus on such minutia in forming their general impressions of marks, or in comparing them. *See In re John Scarne Games, Inc.*, 1959 WL 5901, at *1 (TTAB 1959) ("Purchasers of game boards do not engage in trademark syllable counting-they are governed by general impressions made by appearance or sound, or both"). The ROBOCAFE and ROBO marks are similar in appearance and sound.

In the context of identical vending machines, the word ROBO also has essentially the same meaning in each mark. "ROBO" is "a combining form extracted from **robot** and meaning 'automated, automatic, or robotic,' used in the formation of compound words." DICTIONARY.COM.[74] When ROBO is combined with CAFE in the cited mark for vending machines, the resulting ROBOCAFE mark suggests an "automated restaurant." Applicant's ROBO mark for vending machines similarly connotes an automated source for food or drink products.

[74] November 8, 2022 Response to Office Action at TSDR 68 (emphasis in bold here in italics in the original).

Applicant's mark ROBO for vending machines "would appear to prospective purchasers to be a shortened version of" the cited mark ROBOCAFE for the identical goods. *Hunter Indus.*, 2014 WL 1649332, at *11 (citing *In re U.S. Shoe Corp.*, 1985 WL 72046, at *3 (TTAB 1985) (finding that the applicant's CAREER IMAGES mark "would appear to a shortened form of registrant's mark" CREST CAREER IMAGES for identical goods and closely related services)). "Because of the overall similarities of the marks, consumers are likely to view [A]pplicant's [ROBO] mark as a variation or shortened version of [the cited ROBOCAFE mark], with both marks indicating a single source for the goods." *Id.*

"Similarity is not a binary factor but is a matter of degree." *KME Ger. GmbH v. Zhe Jiang Hailiang Co.*, 2023 WL 6366806, at *10 (TTAB 2023) (quoting *In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014) (internal quotation omitted)). "There are some specific differences between the [ROBOCAFE and ROBO] marks, but these differences are outweighed by the marks' overall similarities. Considering the marks as a whole, we find them similar." *Id.*, at *13. The first *DuPont* factor supports a conclusion that confusion is likely.

D. Summary

The key first and second *DuPont* factors, as well as the third factor, support a conclusion that confusion is likely, while the sixth *DuPont* factor is neutral. The goods, channels of trade, and classes of consumers are identical, which strongly supports a conclusion that confusion is likely, and the fact that the goods are identical also reduces the degree of similarity of the marks required for confusion to be likely.

The ROBOCAFE and ROBO marks are sufficiently similar to make confusion likely, particularly against the backdrop of the very limited evidence of third-party ROBO-formative marks for vending machines.

We conclude, based on the record as a whole and the applicable *DuPont* factors, that consumers familiar with the cited mark ROBOCAFE for vending machines who separately encounter Applicant's mark ROBO for the identical goods are likely to believe mistakenly that the goods have a common source.

Decision: The refusal to register is affirmed with respect to the goods identified in the application as "vending machines." Those goods will be deleted from the application, which will proceed to publication for opposition with respect to the goods identified as "industrial robots for making and assembling hamburgers and heated patty sandwiches."