

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: January 7, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Outback Steakhouse of Florida, Inc. and OS Asset, Inc.  
v.  
Waterworldwide Pty Ltd.

Opposition No. 91161384  
to application Serial No. 76433576  
filed on July 8, 2002

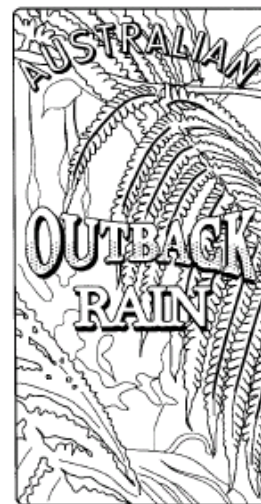
James A. Dimitrijevs, Esq. of Baker & Hostetler LLP for  
Outback Steakhouse of Florida, Inc. and OS Asset, Inc.

Lisa N. Kaufman, Esq. for Waterworldwide Pty Ltd.

Before Bucher, Grendel and Wellington, Administrative  
Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Waterworldwide Pty Ltd. has  
applied to register the mark  
appearing to the right on the  
Principal Register for "bottled  
drinking water" in International  
Class 32.<sup>1</sup> The words AUSTRALIAN  
OUTBACK have been disclaimed.



<sup>1</sup> Serial No. 76433576, filed July 8, 2002, alleging a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

Opposers, Outback Steakhouse of Florida, Inc. and OS Asset, Inc., have opposed registration of applicant's mark on the ground that, as applied to applicant's goods, the mark so resembles opposers' previously used and registered marks OUTBACK and OUTBACK STEAKHOUSE (and design), as well as other marks containing the term OUTBACK,<sup>2</sup> for "beer" and other goods and services, as "to confuse, mislead, and deceive members of the public into believing applicant's goods have been produced, sold, sponsored, approved, or licensed by [opposers]."<sup>3</sup>

Applicant denied the salient allegations in the notice of opposition and filed a counterclaim to cancel two of opposers' pleaded registrations. As grounds for the counterclaim, applicant alleged that opposers' marks, OUTBACK and OUTBACK STEAKHOUSE (and design), subjects of Registrations Nos. 2742171 and 2742172, respectively, are "deceptive under Section 2(a)" because "Outback is a geographically descriptive term for [certain] areas of Australia...Australia is well known for beers...[and] opposer's OUTBACK beer does not originate in Australia." Applicant alternatively pleaded that the marks are

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<sup>2</sup> In all, opposers pleaded ownership of twenty-five different registrations.

<sup>3</sup> Opposer also pleaded a dilution ground for opposition, but expressly withdrew this ground in their brief.

geographically descriptive in the event that opposers' beer "does originate in Australia."<sup>4</sup>

Opposers denied the essential allegations in the counterclaim.

Opposers filed a trial brief; applicant did not.

Record/ Evidentiary Matters

The evidence of record consists of the pleadings, the files of the opposed application and the registrations subject to the counterclaim (Registrations Nos. 2742171 and 2742172). In addition, opposers submitted, under notice of reliance, status and title copies for two of their pleaded registrations (Registrations Nos. 2742171 and 2020110); applicant's responses to Interrogatories Nos. 10, 12-13, 19, 21, and 23; applicant's responses to admission requests Nos. 18 and 20; and printouts of articles obtained from the LexisNexis database.

In view of the above and of particular importance to this case, we note that only three of the twenty-five registered marks pleaded by opposers in the notice of

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<sup>4</sup> Applicant attached, as exhibits to its answer and counterclaim, a copy of a definition of "the outback" and copies of opposers' website. These exhibits are not evidence and do not form part of the record. Rule 2.122(c); see also TBMP § 317 (2d ed. rev. 2004). Nonetheless, as noted later, the Board may take judicial notice of dictionary definitions.

opposition have been properly introduced into evidence or are otherwise of record.<sup>5</sup> These registrations are:

1. Registration No. 2742171 for the mark OUTBACK for "beer" in International Class 32;<sup>6</sup>
2. Registration No. 2742172 for the mark appearing to the right on the Principal Register for "beer" in International Class 32;<sup>7</sup> and
3. Registration No. 2020110 for the mark OUTBACK for "baked goods; namely, bread, biscuits and rolls" in International Class 30.<sup>8</sup>



Counterclaim

We turn first to applicant's counterclaim for cancellation of opposers' Registrations Nos. 2742171 and 2742172. As noted above, the counterclaim essentially is

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<sup>5</sup> It is noted that opposers attached soft copies of several of their pleaded registrations to the notice of opposition. Such a submission, by itself, is insufficient for purposes of being received in evidence. See TBMP § 704.03(b)(1) (2d ed. rev. 2004) and authorities cited therein.

<sup>6</sup> Issued on July 29, 2003, owned by Outback Steakhouse of Florida, LLC. (by way of conversion to a limited liability company - recorded with USPTO on June 6, 2007 at Reel/Frame nos. 3568/0905).

<sup>7</sup> Issued on July 29, 2003, owned by Outback Steakhouse of Florida, LLC. (by way of conversion to a limited liability company - recorded with USPTO on June 6, 2007 at Reel/Frame nos. 3568/0905).

<sup>8</sup> Issued on December 3, 1996, renewed, and currently owned by OS Asset Inc. (by way of an assignment from Outback Steakhouse of Florida, Inc., recorded with USPTO on December 28, 1999 at Reel/Frame nos. 2009/0330).

based on claims that the registered marks are deceptive or, in the alternative, geographically descriptive. However, applicant did not present any evidence at trial in support of the allegations. We therefore find that applicant has failed to establish any grounds for cancellation. Accordingly, applicant's counterclaim for cancellation is denied.

#### Opposers' Standing and Priority

Because three of opposers' pleaded registrations, summarized above, are properly of record, opposers have established their standing to oppose registration of applicant's mark and their priority is not in issue. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

#### Likelihood of Confusion

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

services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Before addressing the two aforementioned *du Pont* factors, we look first to another factor which involves the fame of opposers' pleaded marks. While fame has not been pleaded, opposers argue that their marks containing the term OUTBACK are strong in that they are inherently distinctive and that said marks are "commercially strong and famous." Brief, p. 7. The record supports opposers' former argument, i.e., we may make a finding that opposers' marks, OUTBACK and OUTBACK STEAKHOUSE (with design), are strong to the extent that we must presume that they are inherently distinctive in view of the registrations of record on the Principal Register. As to opposers' latter contention, i.e., that their marks are commercially strong and have "extensive recognition and renown" (brief, p. 9), opposers rely exclusively on purported facts and anecdotal evidence gleaned from the news articles submitted via their notice of reliance. Opposers urge the Board to weigh the "fame" of their prior marks in their favor.

It has long been held that we cannot consider any printed publications submitted in this manner for proof of the facts asserted in the printed publications, as opposers urge us to do here. See *Logicon, Inc. v. Logisticon, Inc.*, 205 USPQ 767, 768 n.6 (TTAB 1980); see also, generally, TBMP

§ 704.08 (2d ed. 2003). Rather, these articles are hearsay and merely serve as evidence that the content appeared and that the public was exposed to that content. *Id.*

In view thereof and on the record before us, we cannot find that the strength of opposers' registered marks of record reach the level of playing "a 'dominant' role in the process of balancing the *du Pont* factors." *Recot Inc. v. Benton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). See also, *Palm Bay Imports, Inc. v. Veuve Clicquot*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003); and *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002).

With the above in mind, we begin our analysis of the marks. Under this *du Pont* factor, we look to the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

The obvious similarity visually and aurally between the parties' marks is that applicant's mark incorporates opposers' registered mark, OUTBACK, into its mark. This similarity is somewhat more pronounced as the term, OUTBACK, in applicant's mark appears in a larger font, prominently in the middle of the mark with the term RAIN. And, as opposers pointed out, there is a line of cases holding that the addition of other matter, such as a house mark, primary mark

or other material, to one of two otherwise similar marks, is not sufficient to distinguish the marks as a whole. See, generally, *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988) and cases cited therein. Nonetheless, this is not a steadfast rule and exceptions have been made when the additional matter was found sufficient to distinguish the marks under circumstances where the marks in their entirety convey significantly different meanings or commercial impressions or the incorporated matter has been so merged with the other matter that it "loses its separate identity." See, e.g., *Castle & Cooke, Inc. v. Oulevay, S. A.*, 370 F.2d 359, 152 USPQ 115 (CCPA 1967) (FARENDOLE not confusingly similar to DOLE for related food products because DOLE is so merged into FARANDOLE that it loses its individual identity therein); *Lever Brothers Company v. The Barcolene Company*, 463 F.2d 1107, 174 USPQ 392 (CCPA 1972) (mark ALL CLEAR! not confusingly similar to ALL); and *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 USPQ 529 (CCPA 1970) (no likelihood of confusion found between marks PEAK for dentifrice and PEAK PERIOD for personal deodorant).

We find here that the additional matter in applicant's mark creates a slightly different overall commercial impression from that created by opposers' OUTBACK mark (the different commercial impressions is even more so with regard



to opposers' OUTBACK STEAKHOUSE and design mark). Specifically, when considered in the context of the identified goods, applicant's mark strongly suggests that its bottled water derives from the rainfall of the rural areas of Australia known as "the outback."<sup>9</sup> The tropical tree branches design in applicant's mark reinforces this suggestion of a natural, unpolluted source for the water. Although opposers' registered mark, OUTBACK, may also conjure the rural region of Australia known as "the outback," it does not share the same connotation as applicant's mark because it is not being used in connection with bottled water and does not contain the additional term, RAIN. In other words, consumers will not perceive opposers' mark OUTBACK as suggesting a natural source for their beer or baked goods.

In our comparisons of the marks, we are also cognizant of the fact that the phrase AUSTRALIAN OUTBACK has been disclaimed by applicant, presumably because it is geographically descriptive of applicant's bottled water. Generally, such descriptive terms are accorded less weight. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751

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<sup>9</sup> We take notice that "outback" is defined as "isolated rural country especially of Australia." *Merriam-Webster's Collegiate Dictionary, Eleventh Edition*. The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

(Fed. Cir. 1985) ("That a particular feature is descriptive [or otherwise lacking in distinctiveness]. . . with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark ..."). Thus, the term OUTBACK, as used in applicant's mark, may be perceived by consumers as merely identifying the source of origin of the goods.

As to opposers' OUTBACK STEAKHOUSE (and design) mark vis-à-vis applicant's mark, there are further noticeable differences visually, aurally and in their commercial impressions. Specifically, opposers' mark contains a kangaroo with a knapsack on a stick over the shoulder. Moreover, we note that the term STEAKHOUSE is not disclaimed in the registration and cannot be ignored. Thus, in addition to the different commercial impressions created thereby, we find overall that applicant's mark is not similar to opposers' OUTBACK STEAKHOUSE (and design) mark. Accordingly, we weigh this *du Pont* factor, with respect to this mark, in favor of applicant.

However, as to opposers' OUTBACK mark, we find that the similarity between it and applicant's mark slightly outweighs the differences. Although we found that applicant's mark, as a whole, takes on a slightly different connotation, this difference does not rise to the level of those cases where we found that the common element had "lost

its separate identity." *Castle & Cooke, Inc.*, 152 USPQ at 115. Moreover, while we acknowledge that the term OUTBACK is descriptive with respect to applicant's goods, we cannot ignore the fact that applicant's mark incorporates opposers' OUTBACK mark, a presumptively strong one, in its entirety. Accordingly, with respect to opposers' OUTBACK mark, we weigh this *du Pont* factor in favor of opposers, albeit slightly.

We next consider the relatedness of the parties' goods. Here, we must make our findings based on the goods as they are recited in the application and registrations. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Again, the goods identified in opposers' registrations of record are beer and baked goods, namely, bread, biscuits and rolls; and applicant has identified bottled drinking water as goods in its application.

In determining the relatedness of the goods, we would be remiss if we did not point out that there is absolutely no evidence in the record on this subject. Opposers, who bear the burden of demonstrating a likelihood of confusion, instead rely heavily on previous Board decisions finding a likelihood of confusion between either restaurant services

and beverages or alcoholic beverages and non-alcoholic beverages. Such reliance is misplaced. First, restaurant services are not at issue in this case. Second, it is well-settled that each case must be decided on its own set of facts of record. See, e.g., *Colgate-Palmolive Company*, 167 USPQ at 530-531 ["We are familiar with, and have considered, the array of decided cases cited and relied on by the parties. Except as the decided cases enunciate principles of trademark jurisprudence, they provide but meager assistance in the disposition of varied cases as they arise"]. Suffice to say, we expect that the records in the cases cited by counsel contained at least some evidence to help establish the relatedness of the involved goods and/or services.

Despite the lack of evidence, we are able to take notice that both beer and bottled drinking water are beverages which may be sold in the same retail stores to the general consuming public. However, the Board has held that "[t]here is and should be no per se rule that alcoholic and non-alcoholic beverages are related products." *In re Jacob Demmer KG*, 219 USPQ 1199, 1201 (TTAB 1983). Moreover, while we take notice that the respective goods are beverages, said goods are at the same time very different inasmuch as beer is an alcoholic beverage (sold in controlled circumstances to those of legal age) and bottled water is more akin to

soft drinks or health beverages. Again, we have no evidence that these differing types of products would ever emanate from a single source or that consumers would have such an expectation that they could.

As to opposers' baked goods, we find the differences between these goods on one hand, and bottled water on the other, are too great to find a likelihood of confusion in the absence of any evidence to support such a conclusion. Again, the record is void of any evidence for us to conclude that these goods are even complementary.

Hence, we cannot determine from the registrations of record, the application, and the evidentiary record before us (or lack thereof) that the goods are related. This factor therefore weighs against a finding of a likelihood of confusion.

With regard to the channels of trade through which the goods move in commerce, the identifications of goods in the application and pleaded registrations of record are not limited by trade channels. Thus, we must assume that the goods are available in all the normal channels of trade to all the usual purchasers for such goods. See *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000). As we have already acknowledged, there is the chance that the goods of both parties will be found in the same retail stores, e.g., a grocery store. However, our cases

caution that little can be concluded merely from the fact that two items can both be found in retail outlets such as a grocery store or served in a restaurant. *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171-72 (TTAB 1987). Should we follow that reasoning, we would come to the same conclusion in nearly every case involving food items and/or beverages.

The only evidence of record as to the parties' demonstrated or anticipated trade channels is contained in applicant's discovery responses. Specifically, applicant stated that its goods are currently being sold in cafes (Interrog. Response No. 10) and at supermarkets and duty-free airport shops (Interrog. Response No. 22), all in Australia. Applicant also admitted that it has not sold its bottled water via an internet website, but "needs to do so" (Admission Response No. 18). Opposers, on the other hand, have not demonstrated that their goods move in the same trade channels or that cafes or duty-free airport shops may be considered normal trade channels for opposers' goods.

Based on the above, we conclude that this factor is neutral or, at most, only slightly favors opposers to the extent that applicant's bottle water and opposers' beer may be served in the same cafes or found in the same supermarket.

Upon balancing all of the relevant *du Pont* factors, we conclude that there is no likelihood of confusion. We reach this conclusion despite opposers' slight advantage regarding the similarity of their OUTBACK mark to applicant's mark, AUSTRALIAN OUTBACK RAIN and design, and acknowledging that the identified goods may be sold in the same grocery stores. Even allowing for the fact that both parties' goods are beverages, opposers have not demonstrated that applicant's bottled water is sufficiently related to opposers' beer, such that we can conclude that there is a likelihood of confusion when the parties' marks are used on said goods.

**Decision:** The opposition and counterclaim are both dismissed, and a Notice of Allowance should issue to applicant in due course.