

This Opinion is Not a
Precedent of the TTAB

Mailed: February 4, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re AM Hospitality, LLC

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Serial No. 97604912

Daniel H. Bliss and W. West Allen of Howard & Howard Attorneys PLLC,
for AM Hospitality, LLC.

Jamilla Galloway, Trademark Examining Attorney, Law Office 121,
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Before Lykos, Casagrande, and Myles, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

AM Hospitality, LLC (“Applicant”) seeks to register on the Principal Register the standard character mark LAUGHING BUDDHA RAMEN (RAMEN disclaimed) for “Restaurant services” in International Class 30.¹

¹ Application Serial No. 97604912, filed on September 23, 2022, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce.

Citations to the prosecution file refer to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system in .pdf format. Citations to the record throughout the decision include references to TTABVUE, the Board’s online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE”

Registration was refused 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 LAUGHING BUDDHA COMEDY (COMEDY disclaimed) on the Principal Register for "Education services, namely, providing live and on-line workshops in the field of comedy; Presentation of live comedy shows" in International Class 41 that it is likely to cause confusion or mistake or to deceive.²

Following issuance of the final refusal, Applicant timely filed a notice of appeal and request for reconsideration, which was denied. Applicant and the Examining Attorney have filed briefs.³ For the reasons explained below, we affirm the refusal.

I. Likelihood of Confusion

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used

refer to the page number(s) of that particular docket entry. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

² Registration No. 4824766, registered on October 6, 2015; combined Sections 8 and 15 Declaration accepted and acknowledged.

The Examining Attorney also refused registration under Trademark Act Section 6(a), 15 U.S.C. § 1056(a), on the basis that RAMEN is merely descriptive of the identified services and therefore must be disclaimed. *See* May 22, 2023 Office Action and September 12, 2023 Final Office Action. In its Request for Reconsideration, Applicant argued that the disclaimer was not required, but alternatively amended the application to disclaim RAMEN apart from the mark as shown. *See* December 12, 2023 Request for Reconsideration at TSDR 3. The Examining Attorney accepted the disclaimer and withdrew the final refusal under Section 6(a). *See* June 26, 2024 Denial of Request for Reconsideration at TSDR 5.

³ The Examining Attorney's submission with its brief of a copy of a non-precedential Board opinion was unnecessary. Citation to non-precedential opinions is permitted but not encouraged. *In re Morrison & Foerster LLP*, 110 USPQ2d 1423, 1427 n.6 (TTAB 2014).

on or in connection with the goods [or services] of the applicant, to cause confusion, or to cause mistake, or to deceive.

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a 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.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In making our determination, the Board has considered each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). When analyzing these factors, the overriding concerns are not only to prevent buyer confusion as to the source of the services, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Shell Oil*, 26 USPQ2d at 1688 (“the various evidentiary factors may play more or less weighty roles in any particular determination”). “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 any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the 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, 1380 (Fed. Cir. 2002)); *see also In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, 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 and differences in the marks.”). These factors, and the others, are discussed below.

A. The Similarity or Dissimilarity of the Marks

The first *DuPont* factor involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed Cir. 2005) (citing *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 per curiam*, 777 F. App’x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation 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.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph*

Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks and citation omitted)). Further, the 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) (quotation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991)), *aff’d per curiam*, 972 F.2d 1353 (Fed. Cir. 1992); *see also In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009). “Similarity is not a binary factor but is a matter of degree.” *St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)).

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 a portion. *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.”). “No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolyte Labs. Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974)). Nonetheless, there is nothing improper in stating that, for rational reasons, more or less weight has been

given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1164 (Fed. Cir. 2014).

Applicant acknowledges that both marks commence with LAUGHING BUDDHA but argues that the marks differ in appearance and sound because its mark ends with the word RAMEN while the registered mark ends with COMEDY. Applicant also emphasizes that the marks contain a different number of letters and are pronounced differently. Applicant further contends that the marks have distinct connotations and commercial impressions. Applicant submits that LAUGHING BUDDHA RAMEN connotes “show[ing] emotion with a chuckle or explosive vocal sound from a representation of Siddhārtha Gautama for quick-cooking egg noodles usually served in a broth with bits of meat and vegetables,”⁴ whereas the cited mark LAUGHING BUDDHA COMEDY projects “show[ing] emotion with a chuckle or explosive vocal sound from a representation of Siddhārtha Gautama for a medieval narrative that ends happily.”⁵

Applicant’s arguments are unconvincing. Each mark comprises three words, the first two of which are LAUGHING BUDDHA. “[T]he identity of the marks’ two initial words is particularly significant because consumers typically notice those words first.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018). This is especially true because LAUGHING BUDDHA is arbitrary in relation

⁴ Definition of “ramen” from www.merriam-webster.com accessed on 5/21/23 submitted with May 22, 2023 Office Action at TSDR 50.

⁵ Applicant’s Brief, 6 TTABVUE 7-8.

to Applicant's and Registrant's identified services, while RAMEN and COMEDY are, at best, merely descriptive of the respective services. *See Palm Bay*, 73 USPQ2d at 1692 ("The presence of this strong distinctive term [VEUVE] as the first word in both parties' marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of the word ROYALE."). Consumers do not, as Applicant urges, focus on minutia such as the number of letters in each mark. *See, e.g., In re John Scarne Games, Inc.*, 120 USPQ 315, 315-16 (TTAB 1959) ("Purchasers ... do not engage in trademark syllable counting—they are governed by general impressions made by appearance or sound, or both."). As a result, both marks share the same dominant portion, LAUGHING BUDDHA, making them similar in sound and appearance.

We also disagree with Applicant's argument that consumers are likely to perceive the marks as having entirely different connotations and commercial impressions. We find more persuasive the record evidence showing "laughing buddha" as a commonly recognized phrase signifying the "ultimate symbol of happiness, taking away any problem, symbolizing good fortune, wealth in private and career, life fulfillment."⁶ Even Applicant implicitly acknowledges this similarity by arguing that the initial impression of each mark is identical. Both marks therefore engender highly similar connotations and commercial impressions as well.

Considering the marks in their entireties, *see Jack Wolfskin Ausrüstung Fur*

⁶ September 12, 2023 Final Office Action at TSDR 13 (entry for "Laughing Buddha" from nationsonline.org accessed on 9/12/2023).

Draussen GmbH v. New Millennium Sports, S.L.U., 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015), we find that the marks are highly similar in sound, appearance, connotation and commercial impression. The first *DuPont* factor weighs in favor of finding a likelihood of confusion.

B. The Services; Established, Likely-To-Continue Trade Channels and Classes of Consumers

The second *DuPont* factor “considers whether the consuming public may perceive the respective services of the parties as related enough to cause confusion about the source or origin of the services.” *Naterra Int’l, Inc. v. Bensalem*, 92 F.4th 1113, 2024 USPQ2d 293, at *2 (quoting *St. Helena Hosp.*, 774 F.3d at 752). We compare the services as they are identified in the involved application and cited registration. *Detroit Athletic*, 128 USPQ2d at 1050; *Stone Lion*, 110 USPQ2d at 1161; *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The services need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that the services emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). Evidence of relatedness might include news articles and/or evidence from computer databases showing that the relevant services are used together or used by

the same purchasers; advertisements showing that the relevant services are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both an applicant's services (or similar goods) and the services listed in the cited registration (or similar services). *See, e.g., Davia*, 110 USPQ2d at 1817 (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores).

To establish that Applicant's and Registrant's services are related, the Examining Attorney submitted evidence from the websites of The DC Improv Comedy Club/Restaurant,⁷ Flapper's Comedy Club,⁸ The Stand Restaurant & Comedy Club,⁹ The Stand,¹⁰ The Comedy & Magic Club,¹¹ Haha Comedy Club,¹² The Ice House¹³ and Gotham Comedy Club¹⁴ showing that it is not uncommon for comedy clubs to also provide restaurant services under the same mark. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (evidence that "a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis"). This evidence demonstrates that consumers may

⁷ May 22, 2023 Office Action at TSDR 6-27.

⁸ September 12, 2023 Final Office Action at TSDR 14-16.

⁹ May 22, 2023 Office Action at TSDR 28-37.

¹⁰ September 12, 2023 Final Office Action at TSDR 32-44.

¹¹ May 22, 2023 Office Action at TSDR 15-17.

¹² September 12, 2023 Final Office Action at TSDR 19-20.

¹³ September 12, 2023 Final Office Action at TSDR 21-31.

¹⁴ September 12, 2023 Final Office Action at TSDR 45-61.

encounter Applicant's and Registrant's services under the same mark from the same provider. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009) (third-party website evidence shows that the applicant's and registrant's products "can be manufactured and sold by a single source").

This same website evidence further demonstrates that such services are complementary in nature insofar as they are advertised together and typically provided together. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (holding bread and cheese to be related because they are often used in combination and noting that "[c]omplementary use has long been recognized as a relevant consideration in determining a likelihood of confusion."); *In re Cook Med. Techs. LLC*, 105 USPQ2d 1377, 1380 (TTAB 2012) (catheters and guiding sheaths used therewith closely related; "[i]f goods [or services] are complementary in nature, or used together, this relatedness can support a finding of likelihood of confusion."). The websites show that patrons can enjoy full restaurant services while watching live comedy shows.

The Examining Attorney also made of record thirteen (13) subsisting use-based, third-party registrations showing that the same entity has registered a single mark identifying "restaurant services" and "Presentation of live comedy shows" or "comedy club services."¹⁵ Third-party registrations that cover services from both the cited

¹⁵ *See* Registration Nos. 5803106, 6149712, 3691671, 5984573, 5608417, 7130642, 6980239, 6206738, 7358382, 7131262, 4385387, 7027876 and 7417743, submitted with the September 12, 2023 Final Office Action at TSDR 62-103 and June 26, 2024 Denial of Applicant's Request For Reconsideration at TSDR 7-29.

registration and an applicant's application are relevant to show that the services are of a type that may emanate from a single source under one mark. *See, e.g., Detroit Athletic*, 128 USPQ2d at 1051; *Hewlett-Packard*, 62 USPQ2d at 1004. This evidence further bolsters our finding that the services are related.

Applicant counters that “while comedy shows may provide drinks and possibly food, Registrant has restricted its identification of “Presentation of live comedy shows” to those that are educational in nature.”¹⁶ Applicant misconstrues the language in the cited registration's identification of services. Registrant's identification comprises two separate services, albeit in the same class. The first-listed service is “Education services, namely, providing live and on-line workshops in the field of comedy.” The second-listed service is “Presentation of live comedy shows.” As aptly put by the Examining Attorney:¹⁷

While Registrant's services do include “Education services, namely, providing live and on-line workshops in the field of comedy”, there is a semi-colon that separates the second entry for “Presentation of live comedy shows”. Semicolons are used to separate a series of distinct categories of goods or services within an international class. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01(a). As such, the identification for “Presentation of live comedy shows” is not an education service as Applicant insists. Therefore, Applicant's statement that “[i]t has restricted the identification of services to restaurant services and registrant has restricted its identification of services to education services” is a misstatement of the record.

¹⁶ Applicant's Brief, 6 TTABVUE 15.

¹⁷ Examining Attorney's Brief, 8 TTABVUE 10.

Likelihood of confusion as to any of the services identified in the cited registration is sufficient to support a Section 2(d) refusal. *Cf. In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (“It is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application.”) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)). The record evidence supports a finding that comedy-show services and restaurant services are related and complementary in nature. Accordingly, this second *DuPont* factor weighs in favor of finding of a likelihood of confusion.

This bring us to “the similarity or dissimilarity of established, likely-to-continue trade channels,” the third *DuPont* factor. Applicant again relies on the faulty logic that Registrant’s second listed service, “Presentation of live comedy shows,” is limited to comedy shows that are educational in nature. Neither the registration nor the application contain any limitations on the channels of trade or classes of purchasers. As such, Applicant’s “restaurant services” and Registrant’s “Presentation of live comedy shows” presumptively move in all normal trade channels and to consumers that purchase such services. *See Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 1373, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013). The same third-party website evidence discussed above under the second *DuPont* factor shows that several venues provide both restaurant services and live comedy shows. In addition, due to the lack of limitations in each identification, the buyers to whom sales are made overlap: members of the general public seeking comedy club shows where food

and beverages are served. The third *DuPont* factor also weighs in favor of finding a likelihood of confusion.

C. The Conditions Under Which the Services are Purchased

Next we consider the conditions under which the services are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers, the fourth *DuPont* factor. Where the relevant purchasers are sophisticated or tend to exercise a high degree of care in selecting a given type of service, that may tend to minimize likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985) (because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED). Conversely, impulse purchases of inexpensive services may tend to have the opposite effect. *Palm Bay*, 73 USPQ2d at 1695.

Applicant maintains that its “restaurant services” are limited to casino operators seeking to provide restaurant services to the general public and that the purchasers of Registrant’s services are night clubs providing live comedy shows. Applicant contends that such purchasers are experienced, knowledgeable and likely to exercise an elevated level of care.¹⁸

¹⁸ Applicant’s Brief, 6 TTABVUE 16-17.

Applicant confuses the provider of each service with the consumer of the services. The purchasers of Applicant's and Registrant's services are members of the general public. Neither Applicant's nor Registrant's identification of services is limited, meaning they include restaurant and comedy club services offered to all members of the general public. *See In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). The record is devoid of evidence to indicate that comedy club and restaurant patrons, in general, are sophisticated or careful in selecting such services. We must base our analysis "on the least sophisticated potential purchasers." *Stone Lion*, 110 USPQ2d at 1163 (internal quotation marks omitted). For these reasons, the fourth *DuPont* factor weighs in favor of finding a likelihood of confusion.

D. The Number and Nature of Similar Marks in Use on Similar Services

"[T]he sixth *DuPont* factor, '[t]he number and nature of similar marks in use on similar [services],' ... is a measure of the extent to which other marks weaken the assessed mark." *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 2023 USPQ2d 737, at *4 (Fed. Cir. 2023) (citing *Palm Bay*, 73 USPQ2d at 1694). This *DuPont* factor allows an applicant in an ex parte appeal to contract the scope of protection otherwise accorded a cited mark by adducing evidence of conceptual and/or commercial weakness.

"[T]he strength of a mark is not a binary factor" and "varies along a spectrum from very strong to very weak." *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal citations omitted). "The weaker [the cited] mark, the closer an applicant's mark can come without causing a likelihood

of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Id.* at 1676 (internal citations omitted).

In determining the strength or weakness of a cited mark, we consider both its inherent strength, based on the nature of the mark itself, and, if there is evidence in the record of marketplace recognition of the mark, its commercial strength. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength ... and its marketplace strength”); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006). Conceptual or inherent strength is a measure of a mark’s distinctiveness. *Chippendales*, 96 USPQ2d at 1686. Distinctiveness is “often classified in categories of generally increasing distinctiveness[:] ... (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 112 S. Ct. 253 (1992). “Commercial strength, on the other hand, is the marketplace recognition value of the mark.” *Spireon*, 2023 USPQ2d 737, at *4 (internal citation and quotation marks omitted). Commercial strength is a question of “whether consumers in fact associate the . . . mark with a unique source.” *Id.* In this regard, the purpose of introducing evidence of third-party marketplace 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 Int’l, Inc. v. Greater*

Omaha Packing Co., 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay*, 73 USPQ2d at 1694); accord *Jack Wolfskin*, 116 USPQ2d at 1136; *Juice Generation*, 115 USPQ2d at 1674.

“Extensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin*, 116 USPQ2d at 1136 (quoting *Juice Generation*, 115 USPQ2d at 1674);

Applicant does not challenge the commercial strength of the cited mark with third-party marketplace evidence. Rather, Applicant introduced third-party registrations purporting to show that the terms LAUGHING BUDDHA, LAUGHING and BUDDHA in the cited mark are conceptually weak. In this context, third-party registrations may “prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak” in connection with the services. *Juice Generation*, 115 USPQ2d at 1675 (internal quotation marks omitted). See also *Jack Wolfskin*, 116 USPQ2d at 1136. Even if “there is no evidence of actual use” of “third-party registrations,” such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used.” *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976). We discuss each category of third-party registration evidence below.

1. LAUGHING BUDDHA formative marks

Applicant maintains that the phrase LAUGHING BUDDHA is inherently or conceptually weak and entitled to only a narrow scope of protection. Its argument is based on a single third-party registration and three third-party applications

comprised of, or incorporating, the phrase in their marks+. The three applications, even if allowed for publication in the Official Gazette, have no probative value other than constituting evidence that the applications were filed. *See In re Team Jesus LLC*, 2020 USPQ2d 11489, at *3 n.29 (TTAB 2020) (“an application would be evidence only of the fact that it was filed, and therefore has no probative value”). This leaves us with a single third-party registration, Registration No. 3270987, for the mark LAUGHING BUDDHA for “Jewelry, namely body piercing jewelry” in International Class 14 and “Beauty services in the form of tattooing, body piercing, branding and scarification, all for cosmetic purposes” in International Class 44.¹⁹ From both a quantitative and qualitative standpoint, one third-party registration for goods and services that are not at all “similar” (i.e. bear a relationship) to Registrant’s services cannot form the basis for finding that the phrase LAUGHING BUDDHA is conceptually weak. *Omaha Steaks*, 128 USPQ2d at 1694 (the “controlling inquiry is the extent of third-party marks in use on ‘similar’ goods or services” offered to “the relevant public”; products, such as “popcorn,” “wine,” “oriental foods,” and “alcoholic beverages” “bear no relationship to meat or meat-based products” and therefore “are not “similar” to meat products.”).

2. LAUGHING formative marks

Applicant made of record seven (7) third-party registrations comprised in part of the word LAUGHING for restaurant services:²⁰

¹⁹ December 12, 2023 Request for Reconsideration at TSDR 25.

²⁰ *Id.* at TSDR 34-40.

- LAUGHING PLANET (Reg. No. 3338486);
- LAUGHING MAN (Reg. No. 5832910);
- THE LAUGHING GOAT (Reg. No. 3295291);
- THE LAUGHIN GOAT and Design (Reg. No. 3295290);
- LAUGHING WATER RESTAURANT (Reg. No. 2338465);
- LAUGHING LIZARD INN (Reg. No. 7094622); and
- THE LAUGHING GOAT COFFEEHOUSE (Reg. No. 3295214).

The seven third-party registrations submitted by Applicant suggest that the shared term LAUGHING has a commonly understood meaning in connection with restaurant services. However, none of these Principal Register registrations show that LAUGHING has been disclaimed or include a claim of acquired distinctiveness in part under Trademark Act Section 2(f) as to this term. Another problem is that the additional wording in each of the third-party marks is significant enough to make them less similar to the cited mark LAUGHING BUDDHA COMEDY since the phrase “laughing buddha” projects its own unique commercial impression. *See Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *25 (TTAB 2021) (“[W]hile the registered marks all contain the word ‘MIRAGE,’ they contain additional elements that cause many of them to be less similar to Petitioner’s mark than Respondent’s marks are.”).

3. BUDDHA formative marks

Applicant submitted the following five (5) third-party registrations comprised in part of the word BUDDHA, all for restaurant services:

- BUDDHA BAR (Reg. No. 2439577);
- BUDDHA BODAI ONE (Reg. No. 5121721);
- TACO BUDDHA (Reg. No. 6143381);
- PINK BUDDHA and Design (Reg. No. 6854161); and
- FAT BUDDHA (Reg. No. 4609547).

Each third-party registered mark is similar to the cited mark because it includes the word BUDDHA. But again, this evidence is insufficient proof of conceptual weakness because the additional wording in each of the third-party marks is significant enough to make it less similar to the cited mark LAUGHING BUDDHA COMEDY.

4. Conclusion

Applicant has failed to demonstrate that the phrase LAUGHING BUDDHA in the cited mark has been conceptually weakened by third-party registrations. We therefore deem the sixth *DuPont* factor neutral.

E. Actual Confusion and Concurrent Use

Applicant argues that “there is no actual confusion.”²¹ This assertion implicates the seventh *DuPont* factor, the “nature and extent of any actual confusion,” and its related eighth *DuPont* factor, “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion,” *DuPont*, 177 USPQ at 567, requires us to

²¹ Applicant’s Brief, 6 TTABVUE 17.

look at actual market conditions, to the extent there is evidence of such conditions of record.” *In re Guild Mtg. Co.*, 2020 USPQ2d 10279, at *6 (TTAB 2020); *see also In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971).

The involved application was filed based on a bona fide intent to use the mark in commerce under Trademark Act Section 1(b). The record lacks any evidence that Applicant has commenced use of its mark in commerce such as a declaration or the filing of an amendment to allege use meaning that any opportunity for actual confusion has yet to occur. *See, e.g., Motion Picture Ass’n of Am. Inc. v. Respect Sportswear Inc.*, 83 USPQ2d 1555, 1564 (TTAB 2007). “Attorney argument is no substitute for evidence.” *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005). As a result, the seventh and eighth *DuPont* factors are neutral.

F. The Extent of Potential Confusion

The twelfth *DuPont* factor examines “the extent of potential confusion, i.e., whether de minimis or substantial.” *DuPont*, 177 USPQ at 567. Applicant asserts that

[i]n the present case, any potential confusion would be de minimis because the registrant’s services are education services, namely, providing live and on-line workshops in the field of comedy and presentation of live comedy shows, and not restaurant services. Contrary to the Examining Attorney, Applicant’s services are not the same type of services that are offered by the registrant. The registrant does not provide restaurant services, but merely provides

comedy workshops and shows. As such, any potential confusion would be de minimis.²²

Applicant's arguments pertain to the second *DuPont* factor which we have already discussed. The twelfth *DuPont* factor is therefore neutral.

II. Weighing the *DuPont* Factors

The final step in analyzing likelihood of confusion is to weigh the *DuPont* factors for which there has been evidence and argument; "explain the results of that weighing;" and "the weight [we] assigned to the relevant factors." *In re Charger Ventures LLC*, 65 F.4th 1375, 2023 USPQ2d 451, at *7 (Fed. Cir. 2023). "No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark." *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010).

We have carefully considered all of the evidence made of record, as well as all of the arguments related thereto. Applicant has not shown that the cited mark has been weakened conceptually or commercially. The sixth *DuPont* factor is therefore neutral. We have deemed the seventh, eighth and twelfth *DuPont* factors neutral as well. None of the remaining factors we have discussed weigh against a finding of likelihood of confusion; rather, the first through fourth *DuPont* factors each weigh in favor of finding a likelihood of confusion. Accordingly, we conclude that confusion is likely between Applicant's applied-for mark and the mark in the cited registration for the

²² Applicant's Brief, 6 TTABVUE 18.

identified services.

Decision: The Section 2(d) refusal is affirmed.²³

²³ Applicant argues that other cases from the U.S. Court of Appeals for the Federal Circuit and federal district courts support a finding of no likelihood of confusion. Applicant's Brief, 6 TTABVUE 18-19. We are compelled to make our decisions based on the factual record before us and not prior cases with different facts. *See, e.g., Curtice-Burns, Inc. v. Nw. Sanitation Prods., Inc.*, 530 F.2d 1396, 189 USPQ 138, 141 (CCPA 1976).