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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/061354

MARK: O'CALLAGHAN'S



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: John P. Callaghan IV

CORRESPONDENT'S REFERENCE/DOCKET NO:

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the Trademark Examining Attorney's final refusal to register the mark O'CALLAHAN'S with design for "bar and restaurant services" on the grounds of a likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

FACTS

The applicant has applied for registration on the Principal Register for the mark "O'CALLAGHAN'S" with design for "bar and restaurant services." In the Office Action dated April 10, 2007, registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), based on a likelihood of confusion with Registration No. 2740854 for the mark "O'CALLAGHAN HOTELS" for "hotels and resort hotel services." On October 11, 2007, the applicant responded by stating that the marks are different in sound, appearance and commercial impression and the channels of trade and

prospective purchasers of the services differ. The examining attorney disagreed with applicant's analysis, and issued a final refusal with respect to the Section 2(d) refusal on October 24, 2007. The applicant did not request reconsideration. This appeal follows the Examining Attorney's final refusal under Trademark Act Section 2(d).

ARGUMENTS

THE MARKS ARE HIGHLY SIMILAR AND THE SERVICES ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. First, the marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b). Then, the goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001);

TMEP §§1207.01, 1207.01(a)(vi). The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

A. THE MARKS ARE HIGHLY SIMILAR

In this case, the appearance, sound and commercial impression of the marks are highly similar. The applicant seeks to register the mark O'CALLAGHAN'S with a Keltic design. The registrant's mark is O'CALLAGHAN HOTEL. The name O'CALLAGHAN is spelled the same and pronounced the same. The only difference in the literal portion of the mark is the disclaimed generic term "HOTELS" in the registrant's mark. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entirety, one feature of a mark may be more significant in creating a commercial impression. Disclaimed matter is typically less significant or less dominant when comparing marks. *See In re Dixie Rests. Inc.*, 105 F.3d

1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii).

Applicant's Arguments

The applicant submits that the marks are different because the cited registration includes the term HOTEL, which the applicant's mark does not; the applicant's mark contains a design element while the registrant's mark does not; and the applicant's mark is plural while the registrant's mark is not. First, the applicant's deletion of the term HOTEL does not obviate the likelihood of confusion. The mere deletion of wording from a registered mark may not be sufficient to overcome a likelihood of confusion. *See In re Optical Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(b)(iii). Applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrant's mark.

Second, the addition of a design element does not distinguish applicant's mark from registrant's, as the literal portions of the mark are nearly identical. When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and/or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729, 735 (TTAB 1976); TMEP §1207.01(c)(ii).

Third, the plural form of the surname O'CALLAGHAN does not change the commercial impression of the mark. Trademarks and/or service marks consisting of the singular and plural forms of the same term are essentially the same mark. *Wilson v. Delaunay*, 245 F.2d 877, 878, 114 USPQ 339, 341 (C.C.P.A. 1957) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark); *In re Pix of Am., Inc.*, 225 USPQ 691, 692 (TTAB 1985) (noting that the pluralization of NEWPORT is “almost totally insignificant” in terms of likelihood of confusion among purchasers); *In re Sarjanian*, 136 USPQ 307, 308 (TTAB 1962) (finding no material difference between the singular and plural forms of RED DEVIL).

B. THE SERVICES OF THE PARTIES ARE CLOSELY RELATED

The applicant's services are bar and restaurant services. The registrant's services are hotels and resort hotels. The evidence of record clearly shows that these services are related. The examining attorney has made of record twenty-five (25) third party registrations indicating that hotel, resort hotels, restaurant and bar services are the kind that emanate from the same source. The examining attorney also has made of record internet evidence showing: (1) it is common to find hotels offering services such as restaurant and bar; and (2) hotel, restaurant and bar services are related as they are all part of the hospitality industry.

Evidence of relatedness may show that the services are used together, used by the same purchasers, or advertised together. TMEP § 1207.01(a)(vi). Hotel, restaurant and

bar services are used together and by the same purchasers as they are commonly found on the same premises. Attached to the October 24, 2007 Final Office Action is internet evidence showing that hotels offer restaurant and bar services. For example, the RAMA HOTELS & RESORTS, NAPLES GRANDE BEACH RESORT, PARK SHORE RESORT, MOVENPICK HOTELS & RESORTS, and the FORT WILLIAM HENRY RESORT & CONFERENCE CENTER are different types of resort hotels that provide restaurant and bar services to its customers.

Not only are hotel, restaurant and bar services found on the same premises, but are related in a broader sense as they are part of the hospitality industry. According to the U.S. Department of Labor, Bureau of Labor Statistics Career Guide to Industries on Hotels and Other Accommodations, service occupations account for sixty-five (65%) percent of the hotel industry's employment, and most of these service jobs are found in two areas: housekeeping and food preparation/food service jobs, e.g., chefs, cooks, waiters, waitresses, bartenders, etc. The Bureau of Labor Statistics Career Guide also states, “[v]ocational courses and apprenticeship programs in food preparation, catering, and hotel and restaurant management, offered through restaurant associations and trade unions, provide training opportunities. Programs range in length from a few months to several years. About 800 community and junior colleges offer 2-year degree programs in hotel and restaurant management.” For example, SIAST Hotel and Restaurant Administration offers a 2 year degree program that teaches students “how to work and manage in the various departments within the hospitality industry (including the front office, housekeeping, catering, food and beverage, and marketing).” Clearly, hotel,

restaurant and bar services are commercially related and found in the same channels of trade.

Applicant's Arguments

The applicant argues that while hotels may have restaurants, the restaurants may have a separate name from that of the hotel. However, the applicant did not provide evidence to support the argument. While the applicant's statement may be true, it is also true that the hotel and restaurant may share the same name. For example, in the internet evidence provided by the examining attorney in the October 24, 2007 Office Action (page 84), The Jefferson hotel in Washington, D.C. is the name of the hotel and the restaurant. Further, even assuming the restaurant has a different name from the hotel, the restaurant is on hotel property. Given the close proximity of the hotel and restaurant services, consumers are likely to perceive the hotel as the source of the restaurant services, and remember the hotel name in connection with the restaurant services. The examining attorney provided third party registration evidence that hotel, restaurant and bar services commonly emanate from the same source. For example, PINK SHELL (U.S. Reg. No. 3058797), THE INN & SPA AT BERKELY SPRINGS (U.S. Reg. No. 3141401), ESCENCIA (U.S. Reg. No. 3138362), PAIZA (U.S. Reg. No. 2999279), LIGHTHOUSE KEY (U.S. Reg. No. 3266180), FONTAINEBLEAU (U.S. Reg. No. 3308980), PARROT CAY (U.S. Reg. No. 3246898) and THE GEORGIAN TERRACE (U.S. Reg. No. 3279731).

The applicant also states that the examining attorney has improperly tried to broaden the goods and services in a manner not contemplated in the registration in order

to find a likelihood of confusion. The examining attorney respectfully disagrees. Contrary to applicant's assertions, any goods or services in the registrant's normal fields of expansion should be considered when determining whether the registrant's goods and/or services are related to the applicant's goods and/or services. TMEP §1207.01(a)(v); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581 1584 (TTAB 2007). Evidence that third parties offer the goods and/or services of both the registrant and applicant suggest that it is likely that the registrant would expand their business to include applicant's goods and/or services. In that event, customers are likely to believe the goods and/or services at issue come from or, are in some way connected with, the same source. *In re 1st USA Realty Prof'ls*, 84 USPQ2d at 1584 n.4; see TMEP §1207.01(a)(v). As the record indicates, there are a number of third party registrations and internet evidence showing that restaurant, bar, hotel and resort hotel services emanate from the same source.

Lastly, the applicant argues that the marks have been concurrently in use since 2002 without any actual confusion. Applicant's claim of priority of use is not relevant to this ex parte proceeding. See *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971). Trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in commerce on or in connection with the goods and/or services specified in the certificate. During ex parte prosecution, the trademark examining attorney has no authority to review or to decide on matters that constitute a

collateral attack on the cited registration. TMEP §1207.01(d)(iv). Further, the test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. TMEP §1207.01(d)(ii); e.g., *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

In any case, the overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but 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, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

C. SUMMARY

Since the marks of the applicant and registrant are highly similar, and the services are closely related, there is substantial likelihood that consumers would confuse the source of the services. Therefore, the applicant's mark must be refused under Trademark Act Section 2(d).

CONCLUSION

For the foregoing reasons, the refusal to register under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) should be affirmed.

Respectfully submitted,

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