

This Opinion is not a  
Precedent of the TTAB

Mailed: November 30, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re SDI Petroleum, LLC*  
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Serial No. 86011946  
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Melissa LaBauve, LaBauve IP Law,  
for SDI Petroleum, LLC.

Josh S. Toy, Trademark Examining Attorney, Law Office 120,<sup>1</sup>  
Michael W. Baird, Managing Attorney.

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Before Ritchie, Adlin and Goodman,  
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

SDI Petroleum, LLC (“Applicant”) seeks registration on the Principal Register of the mark DASH NEIGHBORHOOD (in standard characters), for services ultimately identified as “retail store services featuring gasoline,” in International Class 35.<sup>2</sup>

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<sup>1</sup> The case was reassigned to this Trademark Examining Attorney after the appeal was filed.

<sup>2</sup> Application Serial No. 86011946 was filed on July 16, 2013, under Section 1(b) of the Trademark Act, alleging a bona fide intent to use the mark in commerce.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when applied to the identified services, so resembles the previously registered marks DASH IN,<sup>3</sup> in standard character format, and D DASH IN, and design,<sup>4</sup> as shown below, both owned by the same registrant, and both for, as relevant, "retail store services featuring convenience store items and gasoline," in International Class 35, as to be likely to cause confusion, mistake, or to deceive:



The Examining Attorney also required that Applicant disclaim the term "NEIGHBORHOOD" on the ground that it is merely descriptive of the identified services under Section 2(e)(1) and 6(a) of the Trademark Act, 15 U.S.C. §§ 1052(e)(1) and 1056.

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<sup>3</sup> Registration No. 3060794, issued February 21, 2006. Sections 8 and 15 affidavit accepted and acknowledged. Renewed.

<sup>4</sup> Registration No. 2978044, issued July 26, 2005. Sections 8 and 15 affidavit accepted and acknowledged. Renewed.

When the refusals were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. We affirm the disclaimer requirement, but reverse the Section 2(d) refusal to register.

### I. Disclaimer Requirement

A term must be disclaimed apart from the mark as shown if it is merely descriptive of the identified goods or services. *See In re Grass GmbH*, 79 USPQ2d 1600, 1603 (TTAB 2006); Trademark Manual of Examining Procedure §1215.07 (October 2015). A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used. *See In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012), *citing In re Gyulay*, 820 F.2d 1216, 1217, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that “[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.” *In re Tower Tech Inc.*,

64 USPQ2d 1314, 1316-17 (TTAB 2002). *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

The Examining Attorney argues that the term NEIGHBORHOOD identifies a feature or characteristic of Applicant's services, *i.e.*, that they are offered to the surrounding "neighborhood." The Examining Attorney submitted the following dictionary definition:

Neighborhood: 3. A place or region near; 4.a. The people living near one another; b. a section lived in by neighbors and usually having distinguishing characteristics. *Merriam-Webster; m-w.com.*

The Examining Attorney also submitted third-party web sites that discuss or show use of the term "NEIGHBORHOOD" in a descriptive manner in connection with gasoline and convenience store services. These include the following:

Goodies Convenience Store: Your friendly **neighborhood** convenience store without convenience store prices. October 29, 2013 Office Action, p. 27.  
*Goodiesconveniencestore.com*

Church Produce: Organic Fruits, Vegetables, and Grains: Stop by today for quality produce at affordable prices from your **neighborhood** convenience store. . . .  
History: Church Produce is a neighborhood produce market and convenience store that has been in operation for 30 years. Our owners opened the store because there was a lack of markets in the **neighborhood**, and they wanted to offer customers healthier food choices.  
October 29, 2013 Office Action, p. 29-30.  
*Churchproduce.com*

Welcome to Miller's 76! We are your friendly, old-fashioned **neighborhood** service station with a proud history of exceptional service to the community of Pismo Beach. September 8, 2014 Final Office Action, p. 7.

<http://pismo76.com>

Robersonville, NC Gas Station & Convenience Store: Our Robersonville, NC location also offers kerosene and Western Union money order services for your convenience. Stop by your **neighborhood** Handy Mart gas station today – we're open 24 hours a day, 7 days a week. September 8, 2014 Final Office Action, p. 9.

[Handymarts.com](http://Handymarts.com)

Applicant points out that there are several third-party registrations that include the term "NEIGHBORHOOD," including some with services in International Class 35, but do not disclaim the term:

NEIGHBORHOOD TELEVISION, Registration No. 3,919,508; for "education and entertainment services, namely, video film production, and preparation of special effects including computer-generated imagery and computer-generated graphics for real estate agents, home buyers, renters, location scouters, web-based service providers, businesses and all consumers," in International Class 41;

NEIGHBORHOOD THRIFT, and design, Registration No. 4,414,115, for "retail store services featuring new and used clothing, toys, home accessories, furniture, home décor, sporting goods, and a wide variety of consumer goods . . ." in International Class 35, and disclaiming "thrift";

NEIGHBORHOOD SALON,<sup>5</sup> Registration No. 4,007,805; "beauty salon services; beauty salons" in International Class 44, and disclaiming "salon";

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<sup>5</sup> We note that this registration is registered on the Supplemental Register, and thus is presumed to be merely descriptive regardless of the absence of disclaimers. *See Otter Products LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1255 (TTAB 2012); *citing Perma Ceram Enterprises Inc. v. Preco Indus., Ltd.*, 23 USPQ2d 1134, 1137, n.11 (TTAB 1992) (mark registered on the Supplemental Register constitutes an implied admission that the term is descriptive, at least at the time of registration); *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975) (supplemental registration "may be considered to establish prima

NEIGHBORHOOD DIRECT, Registration No. 4,015,255, for, *inter alia*, “advertising in periodicals, brochures, and newspapers; advertising of commercial or residential real estate”; in International Class 35;

NEIGHBOURHOOD WINERY, Registration No. 3,331,349, for “retail shops featuring wine” in International Class 35 and disclaiming “winery”;

NEIGHBORHOOD BOOKEEPING, Registration No. 4,214,823, for “bookkeeping,” in International Class 35, and disclaiming “bookkeeping”;

NEIGHBORHOOD NURSE, Registration No. 3,469,530, for “personal coaching services in the field of individual health and wellness,” in International Class 41, and disclaiming “nurse”;

YOUR NEIGHBORHOOD CPAS, Registration No. 2,747,316, for “accounting services” in International Class 35, and disclaiming “CPAS”; and

NEIGHBORHOOD FAMOUS, Registration No. 3,404,719, for “restaurant services,” in International Class 43.

None of the registrations are for the same services as those identified in Applicant’s application, nor are they evidence of an Office policy or practice. We also note that some of the marks are slogans, and Office practice does not require a disclaimer of words in unitary marks. Perhaps most importantly, we are not privy to the records of any of the registrations, and our precedent dictates that each case must be decided on its own merits. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some

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facie that, at least the time of registration, the registered mark possessed a merely descriptive significance.”).

characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court.”).

Applicant further argues that the term “NEIGHBORHOOD” is not merely descriptive because the order of the terms in its mark DASH NEIGHBORHOOD is incongruous. However, the disclaimer is only required as to the single term “NEIGHBORHOOD,” and not the mark as a whole. There is no “mental pause,” imagination, or analysis needed to decipher the meaning of “neighborhood” in order to understand its significance in relation to Applicant's services. Rather, based on the dictionary definition as well as the third-party uses, we have no doubt that a consumer would understand the term “NEIGHBORHOOD,” used in connection with Applicant's services, as directly conveying information about them, namely, that its retail store services may serve the surrounding neighborhood. Thus, the applied-for mark immediately describes a key feature or characteristic of the identified goods. Therefore, we find that the mark is merely descriptive of the identified services, and we affirm the disclaimer requirement.

## II. Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, 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). *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). We consider the *du Pont* factors for which there were arguments and evidence. The others, we consider to be neutral.

Services/Channels of Trade

We consider first the similarity or dissimilarity of the services. Applicant identifies “retail store services featuring gasoline.” This is identical-in-part, and thus legally identical to, the services identified in the cited registrations, “retail store services featuring convenience store items and gasoline.”

Because the services identified in the application and the cited registrations are in part identical, we must presume that the channels of trade and classes of purchasers are also the same for those identical services. *See Squirtco v. Tomy Corporation*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); *see also In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.”). Additionally, there is nothing in the identification of services in either the cited registrations or the application that limits either Registrant’s or Applicant’s channels of trade. *See In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992) (because there are no limitations as to channels of trade or classes of purchasers in either the application or the cited registration, it is presumed that the goods listed in the registration and the application move in all channels of trade normal for those goods, and that the goods



are available to all classes of purchasers for the goods). Accordingly, we find that these *du Pont* factors weigh heavily in favor of finding a likelihood of consumer confusion.

### The Marks

When, as here, the services at issue are identical, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than if the services were not identical. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012) (citing *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992)). We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the

marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Applicant's mark is DASH NEIGHBORHOOD, whereas the marks in the cited registrations are DASH IN and D DASH IN, and design, as shown below:



The Examining Attorney argues that these marks are similar in sight, sound, and commercial impression, in that they share the first terms “DASH,” and they give the same commercial impression of dashing in or dashing around [the neighborhood]. Applicant counters that the marks have obvious differences in sight and sound, and argues that the commercial impressions are different as well. Applicant submitted the declaration of Charles Shears, a “member and registered agent” for Applicant, dated February 23, 2015, as well as of linguistics expert Lynn Nichols, dated August 15, 2014. Dr. Nichols opined that, with regard to sound, in her expert opinion, the “dominant acoustic feature of a word or a phrase is the stress pattern,” and that dominant here are the second syllables in each of the standard character marks, “DASH *IN*” and “DASH *NEIGHBORHOOD*.” With

regard to commercial impression, she noted that the term “dash” in English is “nearly always accompanied by a preposition of direction” and without that it is “being used in a novel non-canonical, coined verb form.” August 15, 2014 Response to Suspension Letter, p.18.

While we agree with Dr. Nichols that Applicant’s mark DASH NEIGHBORHOOD does not contain a preposition, we disagree that consumers would not thus understand it to have the connotation and commercial impression of direction. Consumers would understand the mark to indicate a dash into or around the neighborhood, presumably before or after obtaining Applicant’s retail gasoline services. In this regard, the commercial impressions of the standard character marks are generally similar.

Applicant further argues in its brief that regardless of similarities, the shared term “DASH” is weak and “commonly associated with convenience stores” such that consumers will note the differences between the marks in the cited registrations and Applicant’s mark. 8 TTABVUE 7. In this regard, Applicant submitted examples of at least 17 uses of “DASH” in connection with convenience store services around the country, including submission of yellow pages information from the Internet concerning:<sup>6</sup> J&W Dash N Go (Garfield, GA); Gas N Dash Mart (East Moline, IL); A Dash In Grocery (Garland, TX); Dash Food Mart & Deli (Richmond, VA); Splash & Dash (Bellvue, ID); Daily’s Dash (Jacksonville, FL); Dash N Convenient Store

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<sup>6</sup> Applicant’s counsel also made calls to confirm that the businesses were in existence and offering gasoline and convenience store services. See LaBauve decl. attached to August 15, 2014 Response to Suspension Letter.

(Zebulon, NC); Dip N Dash (Ellabell, GA); Cash-N-Dash (Nevada, MO) Dan's Dash In (Spanish Fork, UT); Daniels Parkway Dash In Dash Out Food Mart (Fort Myers, FL); Manatee Ave Dash In Dash Out Mart (Bradenton, FL); Ruskin Dash In Dash Out Food Mart (Ruskin, FL); Gas 'n Dash (Payson UT); Dash Inn (Tulsa, OK); Cash N Dash (Covington, TN) Dash In (Gaithersburg, MD); Fast Dash Convenience Store (Youngstown, OH).

We agree that this evidence indicates that consumers are accustomed to encountering the term "DASH" in relation to convenience store and retail gasoline services, particularly in that some of these uses are quite similar to the standard character mark in the cited registration for DASH IN. *See Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. August 19, 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015). Accordingly, we find that consumers will look to slight differences in the marks, and although their commercial impressions are somewhat similar, the differences in sight and sound are sufficient, given the weakness of DASH for these services, that the first and sixth *du Pont* factors weigh against finding a likelihood of confusion.

### III. Conclusion on Likelihood of Confusion

In conclusion, considering all of the arguments and evidence of record as they pertain to the relevant *du Pont* factors, we find that although the services are in relevant part identical and would therefore travel through the same channels of

trade, the shared term in the marks, "DASH," is so weak that consumers will look to distinguishing features in the marks and there would be no likelihood of confusion.

**Decision:** The Section 2(d) refusal to register Applicant's mark is reversed. The requirement for a disclaimer of the term "NEIGHBORHOOD," as well as the refusal to register in absence of a disclaimer is affirmed. However, if Applicant submits the required disclaimer to the Board within two months of the mailing date of this decision, then the decision will be set aside, and the application will proceed to publication.