

**This Opinion is Not a
Precedent of the TTAB**

Mailed: May 6, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Shah

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Serial No. 86042729

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Matthew H. Swyers of The Trademark Company,
for Shahid Shah and Atlas Shah.

Kim Saito, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

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Before Wolfson, Gorowitz, and Pologeorgis,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Messrs. Shahid Shah and Atlas Shah (“Applicants”) seek registration on the
Principal Register of the mark BUFFALO PHILLY’S and Design (as depicted below):



for “restaurant services” in International Class 43.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, when used in connection with Applicant’s services, so resembles the previously registered mark depicted below:



for “restaurant services” in International Class 42² as to be likely to cause confusion.³

After the Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal.

I. Applicable Law

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177

¹ Application Serial No. 86042729; filed on August 20, 2013, based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as June 2, 2013.

² The cited registration issued prior to the restructuring of International Class 42 and the creation of three additional classes (43, 44 and 45) in January 2002. At that time, “restaurant services” were removed from Class 42 and placed in Class 43. *See* TMEP § 1401.09 (April 2016).

³ Reg. No. 1817227; registered January 18, 1994, renewed. The wording “BUFFALO” and “WINGS” have been disclaimed.

USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

II. Discussion

A. Similarity or Dissimilarity and Nature of the Services

Applicants seek to register their mark for “restaurant services.” The mark in the cited registration is registered for “restaurant services.” It is well settled that the issue of likelihood of confusion between applied-for and registered marks must be determined on the basis of the goods or services as they are identified in the involved application and cited registration, rather than on what any evidence may show as to the actual nature of the goods or services, their channels of trade and/or classes of purchasers. *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-1162 (Fed. Cir. 2014). Here, the identified services are identical.

B. Trade Channels and Classes of Consumers

Where, as in the case at hand, the services are identical, we must presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are

presumed to travel in same channels of trade to same class of purchasers; Board entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). Both Applicants' and Registrant's purchasers are ordinary consumers who would exercise average care in their selection of restaurants.

Applicants argue that the channels of trade and customers are different. In support, Applicants filed the affidavit of Shahid Shah stating that Applicants operate a single restaurant in Virginia while Registrant appears to operate only a single restaurant in Alabama, and that while Applicants market through social media, direct mailing, magazines, coupons, and on-line via their website, Registrant markets its restaurant on-line via its website and through social media but does not appear to advertise in magazines.⁴ Even if proven, because Applicant seeks a geographically unrestricted registration under which it might expand throughout the United States, it is not proper to limit our consideration to the likelihood of confusion in the areas presently occupied by the parties. Section 7(b) of the Trademark Act of 1946, 15 U.S.C. §1057(b), creates a presumption that the registrant has the exclusive right to

⁴ Response dated June 13, 2014. Attached to Mr. Shah's affidavit are examples of Applicants' and Registrant's advertising.

use its mark throughout the United States. Therefore, the geographical distance between the present locations of the respective businesses of the two parties has little relevance in this case. *See Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 393 (Fed. Cir. 1983). Further, Applicants may not rely on extrinsic evidence to restrict the class of customers or the channels of trade; since the recitations of services do not restrict either, we cannot consider the asserted differences in our determination. *In re Midwest Gaming & Entertainment LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008); *In re Bercut-Vandervoort & Co.*, 229 USPQ2d 763, 764 (TTAB 1986). The fact that the advertising media used by Applicants and Registrant are in-part identical further supports a finding that the trade channels and classes of consumers overlap.

C. Similarity or Dissimilarity of the Marks

The first *du Pont* likelihood of confusion factor focuses on “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). We are mindful that where, as here, the services are identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23

USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. IngJing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007). The test, under the first *du Pont* factor, 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 that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). *See also In re Cook Medical Technologies LLC*, 105 USPQ2d 1377, 1381 (TTAB 2012); *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

Applicant seeks to register a design mark that includes the words BUFFALO PHILLY'S. The registered mark is also a design mark that includes the words BUFFALO PHIL'S WINGS. Because a comparison of the marks is determined based on the marks in their entirety, 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 part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981). The "touchstone of this factor is consideration of the marks in total." *Jack Wolfskin Ausrustung Fur Draussen GmbH KGAA v. New Millenium Sports, S.L.U.*, 707 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015). Nonetheless, one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the

commercial impression created by the mark. *In re National Data*, 224 USPQ at 751 (“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 consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.”). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

The Examining Attorney argues that the marks are similar in sound and “very similar in meaning and commercial impression” inasmuch as the literal portion of both marks is composed of two words, “namely, BUFFALO and the possessive of form of nicknames for PHILLIP or its alternate spelling PHILIP.”⁵ In support of the refusal, the Examining Attorney has submitted copies of Internet evidence showing that Phil and Philly are known abbreviations, or nicknames, for the given names Phillip and Philip.⁶

Applicants, on the other hand, argue that the marks create separate and distinct commercial impressions given that Applicants’ mark claims the colors blue and green; the central animal figure in their mark is a buffalo in contrast to the chicken

⁵ 6 TTABVUE 6.

⁶ See at <http://bestnicknameestees.com> and <http://en.wikipedida.org>, attached to Office Action dated December 13, 2013.

displayed in the cited mark; and the term “PHILLY [sic]”⁷ in Applicant’s mark refers to the city of Philadelphia while the term “PHIL’S” in the cited mark is a proper name.

We readily acknowledge that there are some dissimilarities in appearance between the marks because of differences in the design elements. However, the overall look of the marks, in appearance, remains close. Both designs are essentially circular, with two concentric circles surrounding the drawing of the head of a central animal figure, and wording that is placed above and beneath the animal’s head. The dominant portion of both Applicant’s and Registrant’s marks, however, are not the designs, which serve as background, but the prominent words BUFFALO PHILLY’S and BUFFALO PHIL’S; although in the case of Registrant’s mark, the literal portion also includes the word WINGS, the term is of lesser significance because it merely describes a feature of the specific restaurant services, *i.e.*, that Registrant serves hot chicken wings as a menu item. “That a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark.” *National Data*, 224 USPQ at 751.⁸

⁷ 4 TTABVUE 10.

⁸ We note that Applicants and the Examining Attorney both mistakenly refer to Registrant’s mark as BUFFALO PHIL’S, without including the term WINGS. The Office’s electronic (TSDR) records appear to have inadvertently deleted the term from the illustration of the mark, which may account for this oversight. Applicants’ evidence also shows that Registrant uses its mark without the term “wings.” Nonetheless, in comparing the marks, we have not ignored the fact that although it does not form part of the dominant portion of Registrant’s mark, it is certainly present and has been taken into account in analyzing the similarities and dissimilarities of the marks. We hasten to add that the result in this case would not change had either the Applicants or the Examining Attorney referred to Registrant’s mark as BUFFALO PHIL’S WINGS and design.

When a mark comprises both a literal portion and a design, the wording is normally accorded greater weight because literal portion of a mark is far more likely to be impressed upon a purchaser's memory and to be used when requesting the goods. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *see also Viterra*, 101 USPQ2d at 1908 ("In the case of a composite mark containing both words and a design, 'the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.'") (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). There is little memorable difference between the dominant words of each mark: BUFFALO PHILLY'S and BUFFALO PHIL'S. The only variance is in the selection of a slightly different diminutive for the proper name Phillip. Indeed, due to the large size font style of the name PHIL'S in the registered mark, the single term itself is most prominent. Moreover, the similarity between the two forms of Phillip is enhanced by the fact that each is in the possessive form, adding an "apostrophe s" to the end of the name. And the overall similarity between the literal portions of the marks is also enhanced by the fact that they both start with the same word, "BUFFALO." *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"); *see also Palm Bay Imports Inc.*, 73 USPQ2d 1692; *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Because of these

shared literal terms, the marks look somewhat similar and clearly sound alike. “In appropriate cases, a finding of similarity as to any one factor (sight, sound or meaning) alone ‘may be sufficient to support a holding that the marks are confusingly similar.’” *Trak, Inc. v. Traq Inc.*, 212 USPQ 846, 850 (TTAB 1981) (quoted in *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); see also *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP § 1207.01(b).

Turning to the connotations of each mark, there is no evidence in the record to support Applicants’ argument that either BUFFALO or PHILLY refers to a geographic location.⁹ As for Applicants’ alternative argument that the meaning of the word BUFFALO is inherent in the menu item “buffalo wings,” we find it would not be unreasonable for the word “buffalo” to carry this connotation, given the design features of a buffalo and two wings on either side of Applicants’ mark, and the depiction of a chicken (“buffalo wings” are made using chicken wings) plus the disclaimed term “wings” in Registrant’s mark. In this case, however, each mark would be projecting a similar connotation, that of a restaurant serving buffalo wings. To the extent the limited number of third-party registrations submitted by Applicants corroborate that the term “buffalo” carries a suggestive connotation in the relevant industry, they serve to support a finding that consumers are accustomed to perceive distinctions between marks for restaurant services containing the term “buffalo” on

⁹ Moreover, Applicants’ argument suffers on its face because the term in Applicants’ mark is PHILLY’S, not PHILLY.

the basis of other words in the marks, since the marks in each of the third-party registrations contain additional words or designs, or are stylized.¹⁰

We find that the marks are highly similar in pronunciation and connotation and, despite the differences in appearance, are similar in their overall commercial impressions. Accordingly, this factor favors a finding of a likelihood of confusion.

D. Actual Confusion

Mr. Shah declares that he is unaware of any instances of actual confusion since Applicants' first use of their mark in June, 2013. However, the lack of evidence of actual confusion carries little weight, especially in an *ex parte* context, where there is no chance for a registrant to show what opportunity for confusion there is based on registrant's use and advertising of its mark. *See In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001); *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198 (TTAB 2009); *In re Ithaca Industries, Inc.*, 230 USPQ 702, 704 (TTAB 1986). In any event, the record is devoid of probative evidence from Applicants relating to the extent of use of Applicant's and Registrant's marks. *See In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003) ("uncorroborated statements of no known instances of actual confusion are of little evidentiary value"); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. *Weiss Associates Inc.*

¹⁰ Applicants filed copies of six third-party registrations for marks that include the term BUFFALO or BUFFALO'S for restaurant services and two third-party registrations for marks that include PHILLY'S or PHIL'S.

v. HRL Associates Inc. 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990); *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026–27 (TTAB 1984).

We accordingly find this *du Pont* factor neutral.

III. Conclusion

Upon full consideration of all the evidence and argument of record, we find that Applicant's services are identical to the services recited in the cited registration; that they share the same channels of trade and are advertised and sold to the same ordinary consumers; and that Applicants' BUFFALO PHILLY'S and design trademark is highly similar to the registered trademark BUFFALO PHIL'S and design. We conclude that Applicants' applied-for mark, as used on the identified services, is likely to cause confusion with the cited registration.

Decision: The refusal to register Applicant's mark

Trademark Act Section 2(d) is affirmed.



under