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Sent: 11/23/2015 7:55:02 AM

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Subject: U.S. TRADEMARK APPLICATION NO. 86134042 - MF - N/A - EXAMINER BRIEF

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Count: 1

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86134042

MARK: MF



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Mighty Fine Burgers Fries Shakes

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

The applicant has appealed the trademark examining attorney's refusal to register the proposed trademark MF with design for "restaurant services" in International Class 043 based on a likelihood of confusion with the registered mark MF in standard character for "wine" in International Class 033 in U.S. Registration No. 4085163, under §2(d) of the Trademark Act, 15 U.S.C. §1052(d).

FACTS

On December 6, 2013, applicant filed an intent-to-use based application to register the mark MF with a star design enclosed in a rectangle for "restaurant services" in International Class 043. On March 19, 2014, the examining attorney issued an Office action wherein the applied-for mark was refused registration under Section 2(d) of the Trademark Act, based on the likelihood of confusion with the mark MF for "wine" in U.S. Registration No. 4085163. Applicant was also required to amend the description of the mark. In a response of September 19, 2014, applicant submitted arguments in response to the Section 2(d) refusal and submitted an acceptable description of the mark. On October 20, 2014, the examining attorney issued a final refusal under Section 2(d), as applicant's arguments were unpersuasive. Applicant failed to file a response and the application was abandoned May 18, 2015. Applicant filed a petition to revive the application and the application was revived on July 22, 2015. Applicant filed its appeal brief on September 23, 2015.

OBJECTION TO NEW EVIDENCE

Applicant has submitted new evidence with its appeal brief. Specifically, applicant has attached a variety of third party website screen captures.

The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. *See In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d 1593, 1596 (TTAB 2014); *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

ARGUMENT

THE APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO THE REGISTRANT'S MARK AND THE GOODS AND SERVICES ARE CLOSELY RELATED SUCH THAT A LIKELIHOOD OF CONFUSION EXISTS.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, 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). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d

1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and services, and similarity of the trade channels of the goods and services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

MF With Design Is Confusingly Similar To MF

The marks MF with a star design and MF in standard characters are strongly similar in appearance. Applicant's mark incorporates registrant's entire mark MF and merely adds a star and a rectangular carrier element. The addition of the design does not overcome the similarities of the two marks. For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *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)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater

weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). In this case, when consumers are seeking applicant's services, they are likely to use the letters MF, rather than the star or rectangular carrier element, when calling for the services. These letters MF are identical to registrant's entire mark.

Continuing, when comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered under applicant's and registrant's marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

In this case, a purchaser with a general recollection of the marks MF and MF with a star design inside a rectangle is likely to be confused as to the source of the goods and services. Applicant's mark merely adds a design element and minor stylization to the registrant's mark. When they are compared in their entireties, the applied-for mark MF with star design is confusingly similar to the registered mark MF in standard character.

Applicant argues that the letters MF in the applied-for mark “stand for ‘Mighty Fine’” and consumers are likely to refer to the services as “Mighty Fine,” not as “MF” (Applicant’s Brief at 9). However, the words “Mighty Fine” do not appear in the applied-for mark. The applied-for mark is only the letters MF with a star enclosed in a rectangle. While applicant may want consumers to associate MF with the wording “Mighty Fine,” the words “Mighty Fine” are not the mark at issue here. The marks are compared as they appear, and not how applicant may want consumers to perceive the mark. When the registered mark MF and the applied-for mark MF with star design are compared as they appear, the marks are confusingly similar in appearance.

Applicant contends that the examining attorney “has failed to recognize the significance of the design component” of the applied-for mark (Applicant’s Brief at 9). In the next sentence, applicant states that the examiner “claims” to have considered the marks in their entirety. Contrary to applicant’s assertions, the examining attorney has in fact compared the marks in their entirety, as was repeatedly referenced in the prior Office actions. Marks must be compared in their entirety and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1322, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (“[Regarding the issue of confusion,] there is nothing improper in stating that . . . 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 entirety.”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985))). Applicant’s mark incorporates the entire registered mark. The text elements of the applied-for mark, MF, appear in a large font in the center of the mark, while the star is smaller and above the wording. The rectangular

enclosure of the mark is of less significance for comparison purposes, as it functions as a carrier element and it is unlikely that consumers will view the rectangular enclosure as an indicator of source. The marks MF and MF with design will sound the same when pronounced and have a similar overall impression. Again, when the marks are compared in their entireties, the applied-for mark is confusingly similar to the registrant's mark.

Applicant's Services Are Closely Related to Registrant's Goods

The applicant's mark identifies "restaurant services" and the registrant's mark identifies "wine." For purposes of a likelihood of confusion determination, food-related services such as restaurant and catering services, may be found related to wine products where the evidence shows something more than just that such goods and services may be provided under the same or similar marks. *See, e.g., In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001) (holding use of OPUS ONE for both wine and restaurant services likely to cause confusion, where the evidence of record indicated that OPUS ONE is a strong and arbitrary mark, that it is common in the industry for restaurants to offer and sell private label wines named after the restaurant, and that registrant's wines were served at applicant's restaurant); TMEP §1207.01(a)(ii)(A); *see also Jacobs v. Int'l Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641 (C.C.P.A. 1982).

In this case, the evidence of record consists of a variety of third-party website screen captures wherein wines and restaurant services originate from the same source under the same mark. This evidence shows that the goods and services at issue are related because third parties often offer wine and restaurant services, at multiple price points, under the same mark and it is a common practice in the food industry to offer wine and restaurants under the same mark from the same source. For example, attachments from www.bucadibeppo.com were included with the Office action of March 19, 2014.

These screen captures show wines and restaurant services offered under the same trademark. Similarly, with the Office action of October 20, 2014, screen captures from www.theblindhorse.com, www.countrysquireinn.com, www.luvabella.com, and www.canterburyhill.com showed a single mark used to identify wines and restaurant services. The examining attorney included a variety of other third party website screen captures that showed a single mark used to identify wines and restaurants. These screen captures show something more than just that wines and restaurants may be provided under the same or similar marks; they show that it is common for wines and restaurant services to originate from the same source under the same mark and consumers are accustomed to finding wines and restaurant services offered under a single mark. Therefore, consumer confusion as to the source of the goods and services is likely.

Applicant repeatedly argues in its brief that its services are “a casual family restaurant that does not serve wine” and that it is a “casual fast food restaurant serving hamburgers.” (Applicant’s Brief at 11 and 13). Applicant’s identification of services is for the broad “restaurant services.” At no point in the prosecution of this application has applicant chosen to limit its identification to fast food restaurants, or casual family restaurants, or any other type of restaurants. Because applicant has chosen to proceed with the broad “restaurant services,” the likelihood of confusion refusal is based on that identification. “Restaurant services” can include all types of restaurants, from fine dining to fast food restaurants. Thus, despite applicant’s repeated references to its services as a casual hamburger restaurant, it is not appropriate to create such a limitation that does not actually exist in the identification.

With respect to applicant’s and registrant’s goods and services, the question of likelihood of confusion is determined based on the description of the goods and services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion*

Capital LLP, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Absent restrictions in an application and/or registration, the identified goods and services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identifications set forth in the application and registration have no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods and services travel in all normal channels of trade, and are available to the same class of purchasers. As the examining attorney has shown with the evidence, restaurant services often originate from the same source under the same mark as wines. Therefore, applicant’s attempt to limit the identification for appeal purposes only is unacceptable.

Applicant also argues that registrant’s goods are “not marketed nor intended for customers of Applicant,” that the goods and services are not in the same channels of trade, and that “there is very little probability” that they will reach the same consumers. (Applicant’s Brief at 12). However, the registration contains no limitations as to trade channels or potential purchasers; for that matter, the

application also has no limitations as to trade channels or potential purchasers. The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); see TMEP §1207.01(a)(iii). Thus, it is presumed that registrant's wines move in all normal channels of trade, which includes restaurants.

The evidence establishes that the same entity commonly provides the relevant goods and services and markets the goods and services under a single mark, that the relevant goods and services are provided through the same trade channels and that they are used by the same classes of consumers in the same fields of use. Potential purchasers are accustomed to finding these goods and services offered by a single source under a single mark, and are likely to be confused as to the source of the goods and services when offered under the strongly similar marks MF and MF with star design. Therefore, applicant's and registrant's goods and services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009). Evidence obtained from the Internet may be used to support a determination under Section 2(d) that goods or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009).

CONCLUSION

A consumer encountering the mark MF with star design in connection with applicant's restaurant services will incorrectly believe that the services originate from the same source as the registrant's wines under the mark MF. For the reasons specified above, it is respectfully requested that the refusal to register the applied-for mark on the basis of a likelihood of confusion under Trademark Act Section 2(d) be affirmed.

Respectfully submitted,

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