

This Opinion is not a  
Precedent of the TTAB

Mailed: November 23, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Due South Brewing Co.*

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Serial No. 86183992

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Candace L. Moon, The Craft Beer Attorney APC,  
for Due South Brewing Co.

Shannon M. Twohig, Trademark Examining Attorney, Law Office 105,  
Susan Hayash, Managing Attorney.

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Before Mermelstein, Hightower, and Larkin,  
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Due South Brewing Co. Inc. (“Applicant”) seeks registration on the Principal Register of the mark DUE SOUTH BREWING CO. in standard characters (BREWING CO. disclaimed) for “bar services” in Class 43.<sup>1</sup>

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<sup>1</sup> Application Serial No. 86183992 was filed on February 4, 2014 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), on the basis of Applicant’s claimed first use of the mark and first use of the mark in commerce at least as early as May 12, 2012.

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the mark shown in Registration No. 3563743 and reproduced below



for “restaurant and catering services” in Class 43, as to be likely, when used in connection with Applicant's services, to cause confusion, mistake, or deception.<sup>2</sup> After the Examining Attorney made the refusal final, Applicant timely appealed and requested reconsideration, which was denied. The case is fully briefed. We affirm the refusal to register.

## **I. Prosecution History and Record on Appeal**

### **Prosecution History**

Applicant originally sought registration of its mark for “beer” in Class 32 and “bar and restaurant services” in Class 43. The Examining Attorney initially refused registration under Section 2(d) as to the Class 43 services on the basis of the registration that is at issue on this appeal, and as to the Class 32 goods on the basis of a registration of DUE SOUTH for wines. Applicant responded to the initial refusal

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<sup>2</sup> The cited registration issued on January 20, 2009 and was maintained through the filing of a declaration of continuing use that was accepted on September 25, 2014. The mark is described in the registration as consisting of “a design of a pig and the words ‘DUE SOUTH COOKED BBQ.’” The registrant disclaimed the exclusive right to use the words “PIT COOKED BBQ,” as well as the design of the pig, apart from the mark as shown.

by claiming that the wine registration was no longer in effect, deleting “restaurant services” from the identification of services, and arguing against the Class 43 refusal. The Examining Attorney subsequently suspended further examination pending possible cancellation of the wine registration, and continued the refusal as to the amended Class 43 services. The Examining Attorney subsequently removed the application from suspension following cancellation of the wine registration, and made final the refusal in Class 43. Applicant appealed and the Board suspended the appeal when Applicant stated that it intended to request reconsideration. When the Examining Attorney denied the request for reconsideration, the appeal was resumed.<sup>3</sup>

### **The Record on Appeal**

The record consists of the following:<sup>4</sup>

- Internet websites for establishments that offer bar and restaurant services under the same mark (May 13, 2014 Office Action and June 8, 2015 Denial of Request for Reconsideration);
- Definitions of the word “bar” from *Macmillan Dictionary* (July 15, 2014 Suspension Notice);
- Registrations Nos. 4387348, 4520794, 4517568, 4521137, 4521215, 4521233, 4525330, 4521522, 4521612, 4514748, 4478252, 4547115, 4680819, 4682997,

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<sup>3</sup> Applicant divided out the Class 32 portion of the application. Only the parent application covering bar services is before us on appeal.

<sup>4</sup> Certain portions of the record pertain to the refusal in Class 32. They are not pertinent to the issues on appeal and are not listed or discussed.

4681039, 4681249, and 4667715 for marks covering both bar services, and restaurant or catering services (May 13, 2014 Office Action and February 5, 2015 Office Action);<sup>5</sup>

- A menu from a restaurant operating under the cited mark (June 23, 2014 Response to Office Action and April 20, 2015 Request for Reconsideration);

- Pages from Applicant’s website describing its beers and depicting its taproom (June 23, 2014 Response to Office Action and April 20, 2015 Request for Reconsideration); and

- A depiction of Applicant’s mark as used (June 23, 2014 Response to Office Action).

## II. Analysis

Section 2(d) of the Trademark Act prohibits the registration of a mark that so resembles a prior registered mark as to be likely, when used in connection with the goods or services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of likelihood of confusion under § 2(d) is based upon an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In every case under Section 2(d), of course, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d

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<sup>5</sup> The record also contains a registration covering juice bar services and restaurant services. The primary definition of “bar” in the record is “a place where you go to buy and drink alcoholic drinks,” *Macmillan Dictionary*, so we do not consider this registration to be pertinent to the issues on appeal and have not listed it.

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”). We turn first to the similarities of the services.

#### A. Similarities Between the Services

Our determination of the similarities of the services is based upon the identifications of services in the application (“bar services”) and in the cited registration (“restaurant and catering services”). *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The services do not have to be identical or even competitive for confusion to be likely. “[L]ikelihood of confusion can be found ‘if the respective [services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

In *In re Binion*, 93 USPQ2d 1531, 1534-36 (TTAB 2009), the Board found that bar services and restaurant services are closely related,<sup>6</sup> and the record here supports a finding that they are commonly provided under the same mark. Applicant itself

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<sup>6</sup> We confine our analysis to the “restaurant services” in the cited registration. Likelihood of confusion may be found if it exists with respect to Applicant’s bar services and either of the services in the cited registration. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1988).

originally sought registration of its mark for both services.<sup>7</sup> The Examining Attorney also made of record 17 use-based registrations of marks for both bar and restaurant services. This is probative of similarity. *See, e.g., In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). The Examining Attorney also made of record pages from websites in which restaurant services and bar services are offered under the same mark. An example is depicted below:



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<sup>7</sup> Applicant argues that “it amended its application to limit and narrow the scope of its services from ‘bar and restaurant services’ to solely ‘bar services.’ Due to this limitation, the services offered by the Applicant and Registrant are different, so that consumers would not be confused as to source.” 17 TTABVUE 8. Applicant’s amendment in response to the Section 2(d) refusal does not affect the similarity of the services. While registration is not refused to Applicant for use of its mark on restaurant services, Applicant’s claim to registration of its mark for both bar services and restaurant services is evidence that consumers would perceive those services to be related and to share a common source. This is no different in effect than the Examining Attorney’s evidence of third parties using the same mark for both services.

This Internet evidence also supports a finding of similarity. *See, e.g., In re Sela Prods., LLC*, 107 USPQ2d 1580, 1585-87 (TTAB 2013). We accordingly find that restaurant and bar services are closely related in that restaurants commonly have bars and bars often serve food.

Applicant concedes that “restaurant and catering service may relate to bar services in certain instances,” but argues that “here, there is no such relation.” 17 TTABVUE 9.<sup>8</sup> Applicant relies upon extrinsic evidence showing “that Registrant does not offer any bar, or alcohol related, services, nor any beer or alcohol related products,” that a “ cursory glance of their [sic] menu shows that the beverages offered at Registrant’s institution are tea, lemonade, canned soda, and bottled water,” that “Applicant does not offer restaurant or catering services,” and that “Applicant is a brewery, not a brewpub, meaning that there is no kitchen associated with the establishment.” 17 TTABVUE 9-10.

This evidence is irrelevant on this *du Pont* factor.

As discussed above, “[l]ikelihood of confusion must be determined based on an analysis of the mark as applied to the . . . services recited in applicant's application vis-a-vis the . . . services recited in [the] . . . registration, rather than what the evidence shows the . . . services to be.” *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (quoting *Canadian Imperial Bank v. Wells Fargo*

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<sup>8</sup> The cases that Applicant cites in support of this argument, 17 TTABVUE 8-9, are a non-precedential Board decision from 1998 involving resort services and restaurant services, a 1987 Sixth Circuit case involving a civil trademark infringement action between two restaurants, and a 1982 Court of Customs and Patent Appeals case involving restaurant services and tea. They are inapposite here, where the issue is the similarity of bar services and restaurant services for registration purposes.

*Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987)). The “restaurant services” in the cited registration and the “bar services” in the application contain no restrictions or limitations as to their nature, channels of trade, or classes of customers. The registrant's restaurant services “thus must be construed to encompass all types of restaurant services . . .,” *In re Binion*, 93 USPQ2d at 1535, and Applicant’s bar services similarly must be construed to encompass all types of bar services and “cannot be ‘narrowed by [evidence] that the applicant's use is, in fact, restricted to a particular class of purchasers’” of craft beers. *Stone Lion*, 110 USPQ2d at 1162 (quoting *Octocom*, 16 USPQ2d at 1788).

The record shows that restaurant services and bar services are very closely related services. This *du Pont* supports a finding a likelihood of confusion. The close similarity of the services also reduces the degree of similarity between the marks necessary for confusion to be likely. *See, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004). We turn now to this *du Pont* factor regarding similarity of the marks.

#### **B. Similarities Between the Marks**

This 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 Cliquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “The proper test 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.” *Coach*, 101 USPQ2d at 1721 (quotation omitted).

“[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, 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.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Restaurant services are offered to members of the general public, and bar services are offered to members of the general public of legal drinking age. “Although marks must be compared in their entireties, where they are used on goods and services offered to the general public, emphasis must also be placed on the recollection of the average purchaser, who normally retains a general rather than a specific impression of them. In evaluating the similarities of marks, a particular feature or portion of a mark can thus be accorded greater weight if it would make an impression upon purchasers that would be remembered and relied upon to identify the goods or services.” *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987). We first determine the dominant portion of each mark, the portion “that would be remembered and relied upon to identify” Applicant’s and the registrant’s services. *Id.*

In Applicant’s mark, BREWING CO. was disclaimed by Applicant, and in the cited mark, PIT COOKED BBQ and the image of a pig are at least descriptive and have

been disclaimed. The words DUE SOUTH are the only element of either mark that is distinctive and has not been disclaimed.<sup>9</sup> The words DUE SOUTH are the first words in Applicant's standard-character mark and it is well settled that "it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988); *see also Palm Bay Imports*, 73 USPQ2d at 1692; *M.C.I. Foods, Inc. v. Bunte*, 96 USPQ2d 1544, 1551 (TTAB 2010). The term BREWING CO. in Applicant's mark has no source-identifying significance and has been disclaimed. *See, e.g., Dixie Rests.*, 41 USPQ2d at 1533-34 (affirming finding that "DELTA," not the disclaimed word "CAFE," was the dominant portion of the mark THE DELTA CAFE). While we take it into account in the required comparison of the marks in their entireties, it is not the portion of Applicant's mark "that would be remembered and relied upon to identify the goods or services." *Appetito Provisions*, 3 USPQ2d at 1554. We find that DUE SOUTH dominates Applicant's mark.

The cited mark, reproduced below, is a composite word-and design mark.



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<sup>9</sup> There is no evidence in the record that the distinctiveness of DUE SOUTH has been reduced by third-party uses or registrations of the same or similar marks for bar or restaurant services.

Applicant argues that the “pig design is the most dominant and distinct portion of the mark. Consumers are more inclined to remember the pig design, rather than the terms encased in the design,” 17 TTABVUE 5, and to “fixate on the pig, thus, the pig design is in fact the dominate [sic] portion of the mark.” 17 TTABVUE 8. We disagree.

“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.’” *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *CBS Inc. v. Morrow*, 708 F.2d 1579, 218, USPQ 198, 200 (Fed. Cir. 1983)). “[T]he literal component of brand names likely will appear alone when used in text and will be spoken when requested by consumers.” *Id.* at 1911. This “principle is especially important in cases involving restaurant services in view of the propensity of persons to try restaurants based on word-of-mouth recommendations.” *Appetito Provisions*, 3 USPQ2d at 1554; *see also Dixie Restaurants*, 41 USPQ2d at 1534 (“The identity of the dominant portion of Dixie's mark and the registered mark is especially important in the restaurant industry ‘because restaurants are often recommended by word of mouth and referred to orally, [so] it is the word portion of applicant's mark which is more likely to be impressed on the consumer's memory.’” (quoting *Giant Food, Inc. v. Nation's Foodservice*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983))).

We find that the words DUE SOUTH dominate the cited mark. As in Applicant’s mark, the word DUE SOUTH are the first words in the verbal portion of the cited mark as it is read from top to bottom. The remaining words, PIT COOKED BBQ, form

a generic phrase and have been disclaimed. The pig design in the cited mark is not unusual, unique, or proprietary to the registrant, who was required to disclaim the exclusive right to its use because of its descriptiveness. While we take all of the words and the design into account in comparing the marks in their entireties, the disclaimed design and wording are not the elements of the cited mark that “would make an impression upon purchasers that would be remembered and relied upon to identify the goods or services.” *Appetito Provisions*, 3 USPQ2d at 1554.

In determining the dominant portion of the cited mark, we are mindful of the Federal Circuit’s admonition in *Viterra* “that there is no general rule that the letter portion of the mark will form the dominant portion of the mark,” and that each case involving a composite mark must be decided on its own facts. 101 USPQ2d at 1908. There have been a number of cases in which the design element of a composite mark has been found to be dominant. *See, e.g., In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) (discussing several such cases and depicting the subject marks). We find, however, that the cited mark is not similar in nature to the composite marks in those cases, but is more similar in nature to the applicant’s composite mark in *Anthony’s Pizza & Pasta Int’l v. Anthony’s Pizza Holding Co.*, 95 USPQ2d 1271 (TTAB 2009), in which the Board found that the opposer’s word mark ANTHONY’S PIZZA & PASTA for restaurant services was confusingly similar to the applicant’s composite word-and-design mark for restaurant services, depicted below:



The Board found that the word ANTHONY'S dominated the applicant's composite mark because it was the largest element and because the design and the other words in the mark had "little or no source-indicating significance because they describe the goods and the way they are made." 95 USPQ2d at 1279. The disclaimed elements of the cited mark in this case share those characteristics.<sup>10</sup>

The Board in *Anthony's Pizza* also found that it "is clearly as 'ANTHONY'S' that consumers will refer to defendant's mark in using it to identify the source of the services." *Id.* The Board cited a decision of the Court of Customs and Patent Appeals finding that "[C]ompanies are frequently called by shortened names, such as Penney's for J.C. Penney's, Sears for Sears and Roebuck (even before it officially changed its name to Sears alone), Ward's for Montgomery Ward's, and Bloomies for Bloomingdales." 95 USPQ2d at 1280 (quoting *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1333 (TTAB 1992)). In *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135 (Fed. Cir. 2015), the Federal Circuit cautioned against assuming

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<sup>10</sup> The opposer prevailed in *Anthony's Pizza* in the face of "testimony, third-party registrations, and telephone listings" showing "that the name 'Anthony's' has been extensively adopted, registered and used as a trademark for restaurant services, in particular for Italian restaurants and pizzerias, and therefore that 'Anthony's' has a significance in this industry." 95 USPQ2d at 1278. As noted above, there is no evidence here that DUE SOUTH has been used by any third parties for bar or restaurant services.

such truncation of marks without supporting evidence, but the record here shows that both Applicant and the registrant have used a version of their respective marks shortened to Due South alone. Applicant has referred to its beers as “Due South” beers on a page on its website, while the registrant has referred to itself as “Due South” on its menu, in its statement “HEY MAN! DUE SOUTH GOES GREEN” and its offerings of a “Due South BLT” and a “Due South side” dish. We infer, from Applicant’s and the registrant’s own shortening of their marks, that the consuming public is also likely to shorten the marks to “Due South,” especially in the word-of-mouth uses of the marks that are commonly made in connection with restaurant and bar services. This provides additional support for our finding that DUE SOUTH dominates both marks.

Having determined that DUE SOUTH dominates both marks, we turn to the required consideration of the marks in their entireties for similarity or dissimilarity in appearance, sound, connotation and commercial impression. Applicant argues that “it is plain that the marks are distinct based on appearance” because Applicant’s mark is a standard-character mark that “features the distinct identifying terms ‘BREWING CO.’” and the cited mark is “a *design* mark, whose protection extends only to the composite of the design and the words.” 17 TTABVUE 5 (emphasis in original). With respect to sound, Applicant argues that the BREWING CO. element in Applicant’s mark “in no way sounds similar to, or is pronounced anything near, Registrant’s ‘PIT COOKED BBQ’ and that the marks have five and seven syllables, respectively. 17 TTABVUE 6.

With respect to connotation, Applicant argues that “Applicant’s mark is telling of its bar services, given that terms ‘BREWING CO.’ are featured in the mark and were disclaimed,” while “Registrant’s mark is telling of its restaurant and catering services, since it features the terms ‘PIT COOKED BBQ,’ as well as the prominent pig design, which were also disclaimed. Registrant’s mark not only suggests that it offers food services, but it even tells of the specific and narrow type of food offered, namely Southern style barbeque.” 17 TTABVUE 6. Finally, with respect to commercial impression, Applicant argues that the “immediate commercial impression that [Applicant’s] mark evokes is that there is alcohol or alcohol related services connected with the mark,” and that its usual use of a “nautical design” in connection with its mark “is in no way similar to the Registrant’s mark, whose “commercial impression is direct – the mark evokes a down-home country and pork-centric vibe” that “carries the commercial impression of the barbeque cooking style typical of the American South.” 17 TTABVUE 7.<sup>11</sup>

There are differences between the marks as Applicant compares them, but the test is not whether the marks can be distinguished but whether they are sufficiently similar overall that consumers are likely to believe that the respective services originate from or are associated with a common source. “The ultimate inquiry is whether, in light of the conditions of their sale, ‘confusion as to the source of the

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<sup>11</sup> The fact that Applicant has used a “nautical design” together with its mark is irrelevant with respect to the appearance or connotation of the mark because the design is not part of the drawing in the application. *See, e.g., Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016) (rejecting applicant’s argument that because its mark would appear with its house mark and other distinguishing matter, the marks at issue were not similar).

[services] offered under the respective marks is likely to result.” *Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012) (internal quotation omitted).

While marks must be compared as to appearance, sound, connotation and commercial impression, “[i]n a particular case, any one of these means of comparison may be critical in finding the marks to be similar.” *M.C.I. Foods*, 96 USPQ2d at 1550-51 (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)). We find that the close similarities between the marks in sound, and connotation and commercial impression, are more significant than the differences between the marks given the common oral use of marks for restaurant and bar services. *Dixie Restaurants*, 41 USPQ2d at 1534. With respect to sound, the “word portions of the marks here . . . are more likely to be impressed on the consumer's memory,” *id.*, and they alone will be used when the marks are spoken. Applicant’s and the registrant’s own uses of DUE SOUTH alone to identify themselves and their services suggest that the disclaimed verbal portions of the marks will frequently not be a part of oral uses of the marks, or will not be the parts of the marks likely to make the strongest impression. Further, the dominant part of each mark is identical in sound, making the marks aurally similar in their entireties.

With respect to the connotation and commercial impression of the marks, Applicant’s mark as a whole connotes bar services that include beer provided by a brewing company, and the cited mark as a whole connotes restaurant services that include pork barbeque, but because both marks are dominated by DUE SOUTH, they

share a southern or southerly connotation that gives the marks a similar overall commercial impression, taking into account “the recollection of the average purchaser, who normally retains a general rather than a specific impression of” marks. *Appetito Provisions*, 3 USPQ2d at 1534. But even assuming that consumers retained a “specific impression” of the cited mark when they encountered Applicant’s mark for bar services, they would likely believe that the company that offers restaurant services featuring barbecue had expanded under a mark dominated by the word DUE SOUTH into bar services featuring beer.

We find that the marks are very similar when considered in their entireties. This *du Pont* factor supports a finding of likelihood of confusion.

**C. Similarity of Trade Channels, Classes of Customers, and Purchase Conditions**

Both Applicant and the Examining Attorney discussed the trade channels and classes of customers for the subject bar and restaurant services. Applicant claims that the services involve different trade channels and customers because “Applicant’s service does not involve food, in any respect, but solely alcoholic beverages, while Registrant’s services are in fact almost identical to the Registrant’s in *Wuv’s Intern* in that it is a family friendly BBQ restaurant.” 17 TTABVUE 12. Applicant relies on *Wuv’s Int’l, Inc. v. Love’s Enters., Inc.*, 208 USPQ 736 (D. Colo. 1980), a civil trademark infringement action in which the court considered and rejected an infringement counterclaim based in part on differences in the parties’ actual services provided under their registered marks for restaurant services.

The *Wuv*'s case is inapposite because the Examining Attorney correctly notes that "neither the application nor the registration contains any limitations as to channels of trade." 19 TTABVUE 9. As a result, Applicant's bar services and the registrant's restaurant services are presumed to move in the normal channels of trade for those services and to be purchased by all classes of customers for those services. *Stone Lion*, 110 USPQ2d at 1162. Any differences between Applicant's actual use of its mark for bar services and the registrant's actual use of the cited mark for restaurant services shown by extrinsic evidence are irrelevant. *Id.* Given that bar and restaurant services are closely related and are often provided under the same mark, these *du Pont* factors favor a finding of likelihood of confusion.

In addition, because the "restaurant services" in the cited registration and the "bar services" in the application include both expensive and inexpensive services that are provided to members of the general public, the consumers of the respective services are wide ranging and include unsophisticated consumers and consumers who are unlikely to be careful and deliberate in their selection of bars and restaurants. "Board precedent requires [our] decision to be based 'on the least sophisticated potential purchasers.'" *Stone Lion*, 110 USPQ2d at 1163. This element of the fourth *du Pont* factor supports a finding of a likelihood of confusion.

### **Conclusion**

All of the *du Pont* factors for which there is record evidence support a finding of likelihood of confusion. Bar services and restaurant services are closely related and are commonly provided to members of the general public under same mark. The

marks are dominated by the common term DUE SOUTH, which the record shows is inherently distinctive as applied to bar and restaurant services and whose source-identifying capacity has not been diminished by third-party uses or registrations. The marks are similar when considered in their entirety taking into account the fallibility of human memory and the particular importance of the oral use of marks for bar and restaurant services. A consumer familiar with restaurant services offered under the cited mark, or who has had those services recommended to him or her, and who is exposed to Applicant's mark for bar services, is likely to believe that the owner of the cited mark has extended its services from restaurant services into neighboring bar services, or that there is otherwise a relationship or affiliation between the owners of the two marks.

**Decision:** The refusal to register is affirmed.

Hightower, Administrative Trademark Judge, dissenting:

I respectfully disagree with the majority's conclusion under the first *du Pont* factor that the marks at issue "are very similar when considered in their entirety." On the facts of this appeal, I would find the marks in their entirety sufficiently dissimilar to render confusion among the purchasing public unlikely.

Applicant's mark is **DUE SOUTH BREWING CO.**, in standard characters and with BREWING CO. disclaimed, for "bar services."

The cited mark is at right, with PIT COOKED BBQ and the pig design disclaimed, for "restaurant and catering services."



Although the majority properly gives greater weight to the distinctive wording DUE SOUTH, in my view it accords excessive weight to that phrase and thus insufficient weight to the impact of the remaining matter on the respective marks in their entireties. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1676 (Fed. Cir. 2015). When considered as a whole, the marks are very different in appearance, sound, connotation, and commercial impression. *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). The disclaimed matter, moreover, assists in avoiding consumer confusion by reinforcing the distinction between the recited services: BREWING CO. for Applicant's bar services, in contrast to PIT COOKED BBQ – with BBQ displayed as prominently as DUE SOUTH – and especially the encompassing pig design for Registrant's restaurant and catering services.

Accordingly, in view of the differences between the marks in their entireties, I respectfully dissent from the outcome and would reverse the refusal under the first *du Pont* factor, allowing the application to proceed to publication of the mark.