

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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*In re International Grill, Inc.
dba Massis Kabob*
—

Serial No. 86452464
—

Mark R. Kendrick of Kendrick Intellectual Property Law,
for International Grill, Inc.

Tamara Frazier, Trademark Examining Attorney, Law Office 116,
Christine Cooper, Managing Attorney.

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Before Kuczma, Goodman, and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

International Grill, Inc., doing business as Massis Kabob (“Applicant”) seeks
registration on the Principal Register of the following word and design mark:



(with “KABOB,” “ORIGINAL,” and “SINCE 1976” disclaimed) for “restaurant and catering services, restaurant services featuring middle-eastern cuisine” in International Class 43.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that it so resembles the registered mark THE ULTIMATE KABOBERY (in standard characters, with “ULTIMATE” disclaimed) for “restaurant services” in International Class 43, as to be likely to cause confusion or mistake, or to deceive.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusal to register.

I. Analysis

We base our determination of likelihood of confusion under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, ___ U.S. ___, 135 S.Ct. 1293, 113 USPQ2d 2045, 2049 (2015). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). Varying weights may be

¹ Application Serial No. 86452464 was filed on November 12, 2014 based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. 15 U.S.C. § 1051(b).

² Registration No. 4163655 issued on the Principal Register on June 26, 2012. The Examining Attorney’s final refusal was also predicated on Registration Nos. 3767160 and 3767164, both of which were cancelled on November 4, 2016. We give no consideration to the cancelled registrations.

assigned to each *DuPont* factor depending on the evidence presented. *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011). These evidentiary factors “may play more or less weighty roles in any particular determination.” *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993).

We have considered each *DuPont* factor that is relevant, and have treated any other factors as neutral. *See M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). The relevant *DuPont* factors in this proceeding are discussed below.

A. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we compare Applicant’s and Registrant’s marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

The Examining Attorney’s core position is that “the dominant feature of the Registrant’s mark is “KABOBERY”, and the parties’ marks share this same identical unique and coined term.”³

³ Examining Attorney’s brief, 7 TTABVUE 6.

Applicant argues that the Examining Attorney has provided no support for the assertion that KABOBERY is the dominant feature of Registrant's mark, or that potential customers are likely to be confused as to the source of services.⁴ Analogizing to *Ferro Corp. v. Ronco Labs., Inc.*, 356 F.2d 122, 148 USPQ 497 (CCPA 1966) and similar cases, Applicant contends that despite having the single word "KABOBERY" in common, its word and design mark, taken in its entirety, is readily distinguishable from Registrant's.⁵

In *Ferro*, opposer Ferro Corporation, which owned nine federal registrations for marks containing the prefix FERRO or a variation thereof, opposed Ronco's application to register the word and design mark



for rust-preventative oils. The Board found that the applicant's mark was "highly suggestive" of the use of its product, but nonetheless registrable: "it is apparent that the only feature which applicant's mark has in common with opposer's marks and trade name is the term "FERRO" * * * it is concluded that applicant's "FERRO-GARD" and design sufficiently differs from each of opposer's mark [sic] and its trade name as to avoid any likelihood of confusion or mistake." *Id.* at 498-99. When Ferro appealed the Board's ruling to the Court of Customs and Patent Appeals, applicant, Ronco, argued that the common element, FERRO, was not the dominant component, and that the term GARD and design sufficed to distinguish its mark:

⁴ Applicant's brief p. 14, 7 TTABVUE 15, Applicant's reply brief p. 2, 10 TTABVUE 3.

⁵ Applicant's brief pp. 12-13, 7 TTABVUE 13-14.

Appellee [Ronco] argues that when the *complete* mark sought to be registered is compared to appellant's marks there is little resemblance between them. Appellee argues that considering the presence of the animated bolt carrying a flag on which are the letters "VCI"; and that the word "gard" is in larger and bolder lower case letters than the term "Ferro" which is in smaller letters and above the term "gard," there is no likelihood of confusion. In short, appellee argues that the term "gard" and the design dominate the mark sought to be registered and thus the likelihood of confusion is not present.

Id. at 499.

The Court ruled in favor of Ronco: "Considering the many dissimilarities between appellant's marks and the mark sought to be registered, we agree with appellee's argument and the board's holding. It is not believed that appellant is, by virtue of prior registrations, entitled to the sole possession of the term 'ferro.'" *Id.*

Here, as in *Ferro*, the marks' common element, "KABOBERY", has a highly suggestive connotation. A "kabob" (sometimes spelled "kebab") is "a small piece of marinated meat used as for shish kebab," that is, "pieces of meat or vegetables grilled on a long thin stick, or slices of grilled meat served in pita bread."⁶ The suffix "-ery" connotes, in this context, a "place of doing, keeping, producing, or selling (the thing specified) <fishery> <bakery> <eatery>."⁷ Adding the suffix "-ERY" to the generic or descriptive "KABOB" yields the highly suggestive term "KABOBERY": a place for

⁶ Collins American English Dictionary, CollinsDictionary.com, March 9, 2015 Office Action pp. 18-19.

⁷ Merriam-Webster Dictionary, Merriam-Webster.com. The Board may take judicial notice of definitions from dictionaries, including online dictionaries that exist in printed format or have regular fixed editions. *E.g.*, *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014) *aff'd* 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016). The Board also may notice dictionary definitions *sua sponte*, as we do with respect to this definition. *See University of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

producing or selling kabobs.

Where, as here, the common element of marks is highly suggestive and weak, other matter in the marks may suffice to differentiate them and avoid likely confusion. *E.g.*, *General Mills Inc. v. Fage Dairy Proc. Ind. SA*, 100 USPQ2d 1584, 1602 (TTAB 2011) *judgment set aside, opinion not vacated* 110 USPQ2d 1679 (TTAB 2014) *citing In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986); *Embarcadero Techs., Inc. v. Rstudio Inc.*, 105 USPQ2d 1825, 1837 (TTAB 2013) (“The common element STUDIO is highly suggestive and weak and commonly adopted in the field of software. Consumers, viewing the marks in their entirety, will therefore focus on the initial letters, R and ER, and when viewing these marks on or in connection with the respective types of software and services, they will be able to distinguish the marks.”); *Top Tobacco LP v. North Atl. Op. Co., Inc.*, 101 USPQ2d 1163, 1174 (TTAB 2011) (“[C]onsumers encountering this mark [ZIG ZAG CLASSIC AMERICAN BLEND] will focus on the ZIG ZAG element and relegate the wording CLASSIC AMERICAN BLEND as highly suggestive of the tobacco goods.”); *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005) (NORTON MCNAUGHTON ESSENTIALS for ladies’ sportswear not confusingly similar to ESSENTIALS for women’s clothing because ESSENTIALS is a highly suggestive term for articles of clothing) *cited in Coach/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1478 (TTAB 2014); *In re Huncke & Jocheim*, 185 USPQ 188, 189 (TTAB 1975) (“...the addition of other matter to a highly suggestive or descriptive designation, whether such matter be equally suggestive or even descriptive, or possibly nothing more than a variant of the term, may be sufficient to

distinguish between them so as to avoid confusion in trade.”). *See generally* 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:48 (4th ed. 2016).



The additional word and design elements in Applicant’s mark suffice to differentiate it. MASSIS is clearly its dominant element, set forth in large stylized white lettering thrown into high relief against a black background. The words THE ORIGINAL KABOBERY and SINCE 1976 are relegated to smaller supporting roles, providing supplemental information that appears in much smaller, lower-case letters in the surrounding reddish-brown circle and the white area it encloses. We do not agree with Applicant’s contention that the design element predominates over the literal elements in its mark.⁸ Unlike *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) and like decisions where marks were dominated by their design features, the design elements here serve as a backdrop, emphasizing the literal elements, which should be given greater weight. *See generally In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (in composite marks, words normally given greater weight) *cited in Bond v. Taylor*, 119 USPQ2d 1049, 1055 (TTAB 2016). And the literal element they emphasize most is MASSIS.

In both connotation and appearance, then, Applicant’s mark can be differentiated from Registrant’s. In terms of sound, Applicant’s mark consists of seven words, “MASSIS KABOB THE ORIGINAL KABOBERY SINCE 1976,” which, despite some overlap, would be pronounced differently from Registrant’s mark. *See Rocket*

⁸ Applicant’s brief p. 9 et seq., 7 TTABVUE 10.

Trademarks Pty Ltd. v. Phard S.p.A., 98 USPQ2d 1066, 1075 (TTAB 2011) (ZU ELEMENT sounds different from ELEMENT). Registrant’s mark consists of three words: “THE ULTIMATE KABOBERY.” Of those three words, the first, “THE” is not distinctive. *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (“The addition of the word ‘The’ at the beginning of the registered mark does not have any trademark significance.”). And the second, ULTIMATE, is rightly disclaimed as a merely descriptive laudatory word. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (...“substantial evidence supports the Board’s finding that consumers will immediately regard THE ULTIMATE BIKE RACK as a laudatory descriptive phrase that touts the superiority of Nett Designs’ bike racks.”).

The word ULTIMATE does not impart the commercial impression that Registrant’s KABOBERY is unique; rather, it touts the superiority of Registrant’s kabobery over other, lesser kaboberies. *Id.* All in all, as in *Ferro*, if the marks are considered in their entireties, as they must, *see Stone Lion*, 110 USPQ2d at 1161, the different words and the design serve to distinguish them in appearance, sound, connotation and commercial impression.

B. Similarity of the Services

The second *DuPont* factor addresses “[t]he similarity or dissimilarity and nature of the ... services as described in an application or registration....” *DuPont*, 177 USPQ at 567.

Registrant’s “restaurant services” are clearly identical to Applicant’s identified restaurant services, and encompass Applicant’s more narrowly defined “restaurant services featuring middle-eastern cuisine.” *See In re Midwest Gaming &*

Entertainment LLC, 106 USPQ2d 1163, 1165 (TTAB 2013) (registrant's identified 'restaurant and bar services' encompass and are legally identical to Applicant's identified 'bar services located in a casino'). The Examining Attorney has also adduced evidence in the form of use-based third-party registrations and uses in commerce establishing that a single entity may offer both catering services and restaurant services under a single mark.⁹ See generally *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) *aff'd per curiam*, 864 F.2d 149 (Fed. Cir.1988); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009).

Applicant does not dispute that its identified services are similar or related to Registrant's services. The second *DuPont* factor therefore weighs in favor of finding a likelihood of confusion.

II. Balancing the Factors

We have considered all of the arguments and evidence of record, and all relevant *DuPont* factors. We are mindful that under the second *DuPont* factor, the services are the same or related, so the degree of similarity between the marks necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Nevertheless, under the first *DuPont* factor, the dissimilarities in the subject marks in terms of appearance, sound, connotation, and commercial impression outweigh their similarity. All other *DuPont*

⁹ See, e.g., Oct. 6, 2015 Office Action pp. 6-20; May 4, 2016 Office Action, pp. 3-46.

factors are treated as neutral. On balance, we find that the applied-for mark is not likely to cause confusion with the registered mark, THE ULTIMATE KABOBERY.



Decision: The refusal to register Applicant's mark is reversed.