

This Opinion is not a
Precedent of the TTAB

Mailed: May 27, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Mudskipper Media LLC
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Serial No. 86570258
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Luke Brean of Breanlaw, LLC,
for Mudskipper Media LLC.

Carol Spils, Trademark Examining Attorney, Law Office 104,
Dayna Browne, Managing Attorney.

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Before Zervas, Bergsman and Ritchie,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Mudskipper Media LLC (“Applicant”) seeks registration on the Principal Register of the mark HEROES AMERICAN CAFE and design, shown below, for “café services; catering services; restaurant services; restaurants,” in Class 43.¹

¹ Application Serial No. 86570258 was filed on March 19, 2015, 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).



Applicant disclaimed the exclusive right to use the phrase “American Cafe.”

The Trademark Examining Attorney 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 so resembles the two registered marks listed below as to be likely to cause confusion. The marks in the cited registrations are owned by different entities.

1. Registration No. 1997721 on the Supplemental Register for the mark HEROS PIZZA & SUBS and design, shown below, for “restaurant services,” in Class 42.² Registrant disclaimed the exclusive right to use the words “heros” and “pizzas & subs.”



² Registered on August 27, 1996; renewed.

2. Registration No. 2963418 for the mark HEROES PUB (standard characters) for “restaurant and bar services,” in Class 43.³ Registrant disclaimed the exclusive right to use the word “Pub.”

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

I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter. In her June 30, 2015 Office Action, the Trademark Examining Attorney included links to third-party websites to show that the services are related.⁴ *See Safer Inc. v. OMS Invs. Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). Because of the transitory nature of Internet postings, websites referenced only by address or hyperlinks may be modified or deleted at a later date without notification. Therefore, providing only a website address or hyperlink to Internet materials is insufficient to make such materials of record. *In re Powermat Inc.*, 105 USPQ2d 1789, 1791 (TTAB 2013); *In re HSB Solomon Assocs. LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012). *See also* TMEP § 710.01(b) (April 2016). In view thereof, we do not give the links to the third-party websites any consideration.

³ Registered June 21, 2005; renewed.

⁴ The Trademark Examining Attorney included the same links in her October 27, 2015 Office Action. Assuming the links were admissible, multiple submissions of the same evidence does not add to their probative value.

II. 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 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 any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 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.”).

A. *The similarity or dissimilarity and nature of the services.*

The services are in part identical because they all include restaurant services. Under this *du Pont* factor, the Trademark Examining Attorney need not prove, and we need not find, similarity as to each and every activity listed in the description of services. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any activity encompassed by the identification of services in a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679

(TTAB 2014); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007).

B. Established, likely-to-continue channels of trade.

Because the services described in the application and the cited registrations are in part 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); *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).

C. The similarity of dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In a particular case, “two marks may be found to be confusingly similar if there are sufficient similarities in terms of sound or visual appearance or connotation.” *Kabushiki Kaisha Hattori Seiko v. Satellite Int’l, Ltd.*, 29 USPQ2d 1317, 1318 (TTAB 1991), *aff’d mem.*, 979 F.2d 216 (Fed. Cir. 1992) (citation omitted). *See also Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1519

(TTAB 2009) (citing *Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”)).

In comparing the marks, we are mindful that where, as here, the services are in part 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. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

“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 Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721. *See also 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.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *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). Because the services at issue in the application and the cited registrations include restaurant services without any limitation or restriction as to the type of restaurant, the average customer is an ordinary consumer.

1. Registration No. 1997721 the mark HEROS PIZZA & SUBS and design, shown below:



As indicated above, Applicant is seeking to register the mark HEROES AMERICAN CAFE and design, shown below:



The marks are similar because they share the phonetically identical words “Heros” and “Heroes.” However, Applicant’s use of HEROES references a person of distinguished courage or ability, admired for his brave deeds and noble qualities, whereas, Registrant’s use of HEROS references “a large sandwich.” Where the marks

are identical, or nearly identical, differences in connotation and/or commercial impression can outweigh visual and phonetic similarity. *See Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721 (despite the identity in appearance and sound of the COACH marks, they have different meanings and create distinct commercial impressions); *Blue Man Prods. Inc. v. Tarmann*, 75 USPQ.2d 1811, 1820-21 (TTAB 2005) (finding that BLUE MAN GROUP “has the connotation of the appearance of the performers” and that applicant's BLUEMAN mark “has no such connotation for cigarettes or tobacco. Thus, the marks differ in their connotations and commercial impressions”); *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (considering CROSSOVER for brassieres and CROSSOVER for ladies’ sportswear and finding that, “[a]s a result of their different meanings when applied to the goods of applicant and registrant, the two marks create different commercial impressions, notwithstanding the fact that they are legally identical in sound and appearance”).

In view of the foregoing, we find that the marks are not similar because the differences in their meanings and commercial impressions outweigh any similarities in appearance and sound.

2. Registration No. 2963418 for the mark HEROES PUB (standard characters).

HEROES PUB and HEROES AMERICAN CAFE and design are similar because they share the word “Heroes” as their dominant element. While the similarity or dissimilarity of the marks cannot be predicated on dissecting the marks into their various components, 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 a consideration of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

With respect to the appearance and sound of the marks, we note that because the cited registration is in standard character form, Registrant's mark HEROES PUB is not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording, and not in any particular display. Thus, Registrant is entitled to all depictions of its standard character mark regardless of the font style, size, or color. Registrant's mark could at any time in the future be displayed in a manner similar to Applicant's mark; that is, the word(s) could be displayed in the same font style and size. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909-11 (Fed. Cir. 2012); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (rejecting argument that a mark in standard character format (typed) is distinct from a mark in a logo format; "[b]y presenting its mark in a typed drawing, a *difference* cannot legally be asserted by that party" (emphasis in original)); *In re RSI Systems, LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). Also, there is nothing in Registrant's mark that would preclude it from being used in conjunction with a stylized American flag.

In the case of Applicant's mark consisting of words and a design, the words are normally accorded greater weight because the words are likely to make an impression

upon purchasers, would be remembered by them, and would be used by them to request the services. *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)); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983); *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)).

The words "American Cafe" in Applicant's mark and the word "Pub" in Registrant's mark are descriptive of the nature of the restaurant services and do not carry much source indicating significance.⁵ *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'") (quoting *In re National Data Corp.*, 224 USPQ at 752)); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression").

⁵ The Trademark Examining required Applicant to disclaim the exclusive right to use the phrase "American Cafe" on the ground that it is merely descriptive. (June 30, 2015 Office Action). Applicant complied with the disclaimer requirement. (September 28, 2015 Response).

The position of the word “Heroes” as the first part of both marks further reinforces the prominence of the word “Heroes” as the dominant element of the mark. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *Presto Products Inc. v. Nice-Pak Products, 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”).

With respect to connotation and commercial impression of the marks, the word “Heroes” in both marks references a person of distinguished courage or ability, admired for his brave deeds and noble qualities. Because of the similarity of the marks, consumers encountering Registrant’s HEROES PUB and Applicant’s HEROES AMERICAN CAFE, at different times, may mistakenly believe that the services rendered under those marks are variations of restaurant services honoring heroes which are sponsored by or associated with the same source.

We find that the marks are similar in appearance, sound, connotation and commercial impression.

D. Balancing the factors.

Despite the fact that Applicant’s mark HEROES AMERICAN CAFE and design and the registered mark HEROS SUBS & PIZZA and design are intended for use in

connection with in part identical services presumed to move in the same channels of trade, and be offered to the same consumers, because the marks have different meanings and engender different commercial impressions, we find that there is no likelihood of confusion between these marks.

On the other hand, because Applicant's mark HEROES AMERICAN CAFE and design is similar to the mark HEROES PUB, they are used in connection with in part identical services and we must presume that they move in the same channels of trade and offered to the same consumers, we find that Applicant's mark HEROES AMERICAN CAFE and design is likely to cause confusion with the registered mark HEROES PUB.

Decision: The refusal to register Applicant's mark HEROES AMERICAN CAFE and design is affirmed.