

This Opinion is not a  
Precedent of the TTAB

Mailed: August 1, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Mendocino Farms, LLC*

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Serial No. 86731456

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Sheila Fox Morrison of Davis Wright Tremaine LLP,  
for Mendocino Farms, LLC.

Jacob Vigil, Trademark Examining Attorney, Law Office 113,  
Odette Bonnet, Managing Attorney.

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Before Kuhlke, Kuczma and Heasley,  
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Mendocino Farms, LLC (“Applicant”) seeks registration on the Principal Register of the mark EAT HAPPY in standard characters for “Restaurant services; take out restaurant services; catering,” in International Class 43.<sup>1</sup>

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that

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<sup>1</sup> Application Serial No. 86731456 was filed on August 20, 2015, under Section 1(a) of the Trademark Act, based upon Applicant’s allegation of first use and first use in commerce in December 2011.

Applicant's mark, when used in connection with the identified services, so resembles the mark shown below registered on the Principal Register for "Restaurant services; Fast-food restaurant services" in International Class 43,<sup>2</sup> as to be likely to cause confusion, mistake or deception.<sup>3</sup>



When the refusal was made final, Applicant appealed and requested reconsideration. Upon the denial of the request for reconsideration, the appeal was resumed and briefs were filed. We affirm the refusal to register.

### **Likelihood of Confusion**

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *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.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key

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<sup>2</sup> Registration No. 4286172, issued on February 5, 2013. The registration does not claim color as a feature of the mark and includes the following description of the mark:

The mark consists of the literal elements "MICHAEL'S EATHAPPY!" written in stylized form wherein smiley is placed on the top of the letter "I" in the word "MICHAEL'S" and below it on right corner the word "EATHAPPY" is written with an exclamation sign as shown in the mark.

<sup>3</sup> The Examining Attorney also refused registration under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§1051-1053, 1127, because as shown on the original specimen of use EAT HAPPY was displayed inside the restaurant and the wording meaning to "feel good" while eating in a restaurant displayed in that manner was likely to be understood as a quote or saying and not as an indicator of source. Applicant responded by submitting other specimens of use showing use of the proposed mark on its website and the refusal was withdrawn.

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 (CCPA 1976). *See also M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (even within the *du Pont* list, only factors that are “relevant and of record” need be considered).

*Similarity of the Services/Channels of Trade/Consumers*

With regard to the services, channels of trade and classes of consumers, we must make our determinations under these factors based on the services as they are identified in the application and cited registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Applicant does not present argument on these *du Pont* factors and, indeed, Applicant’s “restaurant services” are identical to Registrant’s “restaurant services.” *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981) (it is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of services within a particular class in the application); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004).

As to channels of trade, because the services are identical and there are no limitations as to channels of trade or classes of purchasers, we presume that Applicant's and Registrant's services will be offered via the same channels of trade to the same classes of consumers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). In view thereof, these *du Pont* factors strongly favor a finding of likelihood of confusion.

*Similarity/Dissimilarity of the Marks*

We consider Applicant's mark EAT HAPPY and Registrant's mark  and compare them "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). 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 terms of their overall commercial impression that confusion as to the source of the 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). Further, the marks "must be considered ... in light of the fallibility of memory ...." *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)).

The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). “[S]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 113 USPQ2d at 1085 (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)). And when the services are identical, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. See *Bridgestone Americas Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 1337, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *In re Viterra Inc.*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

The Examining Attorney contends that the marks are similar “in appearance, sound, meaning and overall commercial impression because applicant’s mark is incorporated in its entirety in registrant’s mark.” 10 TTABVUE 6. In particular, the Examining Attorney categorizes the “eathappy!” portion of Registrant’s mark as a slogan and describes Applicant’s mark also as a slogan. *Id.* The Examining Attorney asserts that the exclamation point and absence of a space between the words in Registrant’s mark are not sufficient to distinguish the common wording. The Examining Attorney also contends that the wording “eat happy” is not diluted for restaurant services and the additional wording in Registrant’s mark does not

significantly change the overall commercial impression “because purchasers are likely to believe that applicant’s mark is merely registrant’s slogan being used without the restaurant name.” 10 TTABVUE 8.

In support of his position, the Examining Attorney relies in particular on *In re The United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (finding CREST CAREER IMAGES and CAREER IMAGE confusingly similar). In *United States Shoe*, the Board made the following determinations:

The marks are similar. Applicant’s mark consists solely of two thirds of registrant’s mark. In registrant’s mark, “CREST CAREER IMAGES,” the word “CREST” appears in larger letters, alone, above “CAREER IMAGES”, which is in different style letters. “CAREER IMAGES” comes across as a single, unified component of the mark and “CREST” as a separate part of the mark, perhaps a house mark. Applicant’s mark would appear to prospective purchasers to be a shortened form of registrant’s mark. The marks are similar in sound, meaning and appearance because the words in applicant’s marks are virtually the same as the words making up one element of registrant’s mark.

*Id.* at 709.

In response to the applicant’s argument that CREST is dominant in the registrant’s mark, the Board explained:

Applicant argues that the marks are not similar because “CREST” dominates the registered mark and is not present in applicant’s marks, and because the word “CAREER”, as a weak trademark for clothes, should be given only a narrow scope of protection. In support of this contention applicant has made of record photocopies of third-party registration certificates for marks containing the word “CAREER” used on various items of apparel. As noted above, “CAREER IMAGES” is clearly one unitary component of registrant’s mark. Whether “CREST” dominates the mark is not at issue. Applicant has not

appropriated “CREST”; rather, it has adopted as its mark almost the same thing as the “CAREER IMAGES” portion of registrant's mark. It is because of the similarities between “CAREER IMAGE” and “CAREER IMAGES” that the marks have similar sounds, appearances and connotations.

*Id.*

The Examining Attorney contends that the same reasoning applies here:

The terms “MICHAEL’S and “EATHAPPY!” in registrant’s mark are separate because the size, location, and context of the wording shows “MICHAEL’S” is the name and “EATHAPPY!” is a slogan. The larger wording “MICHAEL’S” appearing above the slogan “EATHAPPY!” does not obviate the similarity with EAT HAPPY because applicant’s appropriation of the distinctive slogan portion of the mark is likely to lead consumers to believe that applicant’s mark is registrant’s slogan being used without the name portion. Thus, consumers are likely to believe there is a common source, association or sponsorship between the highly related and identical services.

Therefore, because applicant’s slogan mark appropriates the slogan portion of registrant’s mark, the common wording is not weak, and the removed wording and design do not significantly alter the overall commercial impression, the average purchaser with a general recollection of trademarks is likely to be confused as to the source of the services. Thus, the marks are confusingly similar.

10 TTABVUE 10-11.

Finally, the Examining Attorney argues the design of the small round smiley face above the letter “I” in “MICHAEL’S” “does not add new meaning to the mark” but rather “the design reinforces the commercial impression of happiness created by the slogan ‘EATHAPPY!’ – the same commercial impression created by applicant’s mark, EAT HAPPY.” 10 TTABVUE 9.

Applicant argues that the Examining Attorney improperly “grounded the finding of similarity on the impermissible dissection of the cited mark, rather than given

consideration to the  mark in its entirety” and that the finding that the wording “eathappy” is the dominant element of the registered mark was in error.

8 TTABVUE 9. Applicant contends that MICHAEL’S is the dominant portion of the mark due to its prominent appearance in larger capital letters and its placement as the first word in the registered mark. 8 TTABVUE 10. Applicant also contends that consumers are more likely to shorten Registrant’s mark to MICHAEL’S because they are accustomed to seeing names of individuals used as a source identifier for restaurant services such as DENNY’S, WENDY’S and JIMMY JOHN’S. 8 TTABVUE 11.<sup>4</sup> Further, as suggested by the Examining Attorney, Applicant argues that to the extent the “eathappy!” portion of Registrant’s mark could be characterized as a slogan, its placement in much smaller lettering beneath the much larger term MICHAEL’s, makes it more likely that perspective consumers will overlook EATHAPPY! and instead focus on the dominant term MICHAEL’S.” 8 TTABVUE 13 n. 17.

As to the wording “eathappy!” and EAT HAPPY, Applicant argues that the presentation of Registrant’s wording as one word with an exclamation point following the possessive form of MICHAEL’S serves to make it “a whimsical synonym for an eatery.” 8 TTABVUE 13. Specifically:

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<sup>4</sup> See Req. for Reconsideration 7 TTABVUE 9-11 (third-party registrations for DENNY’S, WENDY’S and JIMMY JOHN’S).

It operates as a noun to connote[] a definite, physical place, in the same way that the terms ‘pub,’ ‘place,’ or ‘speakeasy’ would function in the marks ‘MICHAEL’S PUB,’ ‘MICHAEL’S PLACE’ or ‘MICHAEL’S SPEAKEASY’” such that “the registered mark MICHAEL’S EATHAPPY! conveys the connotation and commercial impression akin to ‘Michael’s Restaurant.’ In contrast, Applicant’s mark EAT HAPPY has the connotation and commercial impression of a directive to consumers to eat food that makes them happy. ... in that EAT HAPPY is direct, concise, and has gravitas.

*Id.*

Finally, Applicant points to the following third-party registrations incorporating the phrase “EAT HAPPY” to support its position that the absence of additional elements in its mark does not affect the fact that there is no likelihood of confusion with Registrant’s mark that has a different commercial impression due to its additional wording and design elements.<sup>5</sup> We view this evidence and argument as addressing the strength of the shared wording as a source identifier.

REGISTRATION NUMBER	MARK	GOODS/SERVICES
3965980	EAT HAPPY. BE WELL.	Restaurant and bar services, including restaurant carryout services
4573563	EAT HAPPY	Providing a website featuring the ordering of foods and snack mixes for delivery; on-line ordering services featuring foods and snack mixes for delivery; administration

<sup>5</sup> Applicant also referred to a third-party application, Serial No. 86636373 for EAT HAPPY CHICPEA LENTILLE and design for snack foods, breadsticks, etc.; however, third-party applications have no probative value other than as evidence that the applications were filed. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016).

		of a customer loyalty program which provides coupons and discounts for the purchase of snack kits and the referral of customers; promoting the goods and services of others by distributing coupons, advertisements, product samples and promotional items of others
4138668	EAT HAPPY	Consulting services in the fields of holistic health, nutrition and corporate wellness programs
3982610	DON'T WORRY EAT HAPPY	Frozen meals consisting primarily of meat, fish, poultry or vegetables

*Analysis*

The marks are similar in appearance and sound by virtue of the identical wording “eat happy.” The absence of a space in the wording in Registrant’s mark does not serve to distinguish it from Applicant’s mark. *Seaguard Corp. v. Seaward Int’l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (SEAGUARD and SEA GUARD “are, in contemplation of law, identical”); *Stock Pot, Inc. v. Stockpot Rest., Inc.*, 220 USPQ 52, 52 (TTAB 1983), *aff’d* 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (STOCKPOT and STOCK POT are similar). In addition, the exclamation point does not serve to distinguish the marks. In general, punctuation is not sufficient to alter the commercial impression of marks and, as such, are not sufficient to distinguish marks. *See In re St. Helena Hospital*, 113 USPQ2d at 1085 (TAKETEN and TAKE 10! engender similar commercial impressions despite addition of exclamation point); *Bond v. Taylor*, 119

USPQ2d 1049 (TTAB 2016) (BLACK MEN ROCK confusingly similar to BLACK GIRLS ROCK!); *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1712 (TTAB 2010) (hyphen does not distinguish MAG-NUM from MAGNUM), *aff'd mem.*, \_\_\_ Fed. Appx. \_\_\_, 2011 WL 5400095 (Fed. Cir. 2011). *Cf. In re Promo Ink*, 78 USPQ2d 1301, 1305 (TTAB 2006) (finding proposed mark merely descriptive Board stated punctuation mark in PARTY AT A DISCOUNT! does not significantly change the commercial impression of the mark); *In re Burlington Indus., Inc.*, 196 USPQ 718, 719 (TTAB 1979) (“[A]n exclamation point does not serve to identify the source of the goods.”). We further find in this case that the exclamation point simply underscores the commercial impression of the wording “eathappy” as a declaratory, directive or imperative statement, which is the same commercial impression of Applicant’s mark. We add that the stylization in Registrant’s wording “eathappy!” also does not serve to distinguish this portion of its mark because Applicant’s mark is in standard characters and it 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. *In re RSI Sys., LLC*, 88 USPQ2d 1445 (TTAB 2008); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); TMEP § 1207.01(c)(iii) (Jan. 2017). We must consider Applicant’s mark “regardless of font style, size, or color,” *Citigroup Inc. v. Capital City Bank Group Inc.*, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011), including iterations similar to the depiction of the wording in Registrant’s mark.

We are not persuaded by Applicant’s argument that the placement of “eathappy!” after the possessive MICHAEL’S turns it into a noun as though the meaning of

“eathappy!” is transformed to a place like a pub or restaurant. Rather, we find the meaning and commercial impression of “eathappy!” to be a directive to “eat happy” identical to the meaning and commercial impression of Applicant’s mark “EAT HAPPY.” The smiley face in Registrant’s mark simply underscores the directive to eat happy.

We agree with Applicant that “eathappy!” is not the dominant element of Registrant’s mark, but as in *United States Shoe*, whether “MICHAEL’S” dominates the mark is not at issue. Applicant has not appropriated “MICHAEL’S”; rather, it has adopted as its mark almost the same thing as the “eathappy!” portion of Registrant’s mark. It is because of the similarities between “eathappy!” and “EAT HAPPY” that the marks have similar sounds, appearances and connotations. Certainly, the word MICHAEL’S is more prominent both in size and placement, but the phrase “eathappy!” is not overwhelmed, lost or minimized by the word MICHAEL’S. It is well settled that marks containing additional wording may be confusingly similar. *Stone Lion Capital Partners v. Lion Capital*, 110 USPQ2d at 1161 (STONE LION CAPITAL incorporated entirety of registered marks LION CAPITAL and LION).

As the Examining Attorney explains, when marks share confusingly similar elements, likely confusion may be avoided if 1) the matter common to the marks is merely descriptive or diluted, or 2) the compared marks in their entireties convey a significantly different commercial impression. *See, e.g., Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) (CITY BANK diluted for banking services); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73

USPQ2d 1350 (Fed. Cir. 2004) (THE RITZ KIDS for clothing items (including gloves) different commercial impression from RITZ for kitchen textiles (including barbeque mitts)).

The evidence does not support a finding that the phrase “eat happy” is frequently registered or used (only one of the four third-party registrations is for similar services EAT HAPPY. BE WELL.) in connection with restaurant services. The word EAT certainly has meaning and significance in the field of restaurant services and in the imperative form directs the consumer to eat. But taken as a whole “eathappy!” is not merely descriptive.

As for the commercial impression of the marks, the addition of the name of the restaurant MICHAEL’S and the smiley design, which underscores the meaning of the shared wording “eat happy,” do not remove the identical commercial impression conveyed by the “eathappy!” portion of Registrant’s mark and Applicant’s mark EAT HAPPY. As in *United States Shoe*, the marks are similar “because the words in [A]pplicant’s marks are virtually the same as the words making up one element of [R]egistrant’s mark.” *In re United States Shoe*, 229 USPQ at 709. And “eathappy!” “comes across as a single, unified component of the mark and [MICHAEL’S] as a separate part of the mark.” *Id.*

In support of its position, Applicant relies on *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066 (TTAB 2013). In that case, the Board found no likely

confusion between the applicant’s mark  and the registrant’s mark

ELEMENT. The Board based that decision on the prominence of the term ZU and, in connection with the clothing goods, the weakness of the term ELEMENTS.<sup>6</sup>

Despite sharing an ELEMENT-formative term, we find the parties' marks, overall, to be dissimilar. This is mainly due to the dominant role of the term ZU in applicant's mark. The term ZU appears significantly larger and very prominently above the smaller font-sized ELEMENTS. ZU visually dominates applicant's mark and, consequently, is the term that will most likely be impressed in the minds of consumers.

*Id.* at 1074-75.

In *Rocket Trademarks v. Phard*, the common portion is obscured and overwhelmed by the addition of the prominent term ZU. Here, the common portion is a declaratory phrase that jumps out and directs the consumer to behave in a certain way -- to eat happy. We find the facts of this case hew more closely to *United States Shoe*, where the common portion is "one unitary component." 229 USPQ at 709.

Overall, and in view of the identical services, we find that the similarities outweigh the dissimilarities and that this *du Pont* factor also weighs in favor of finding a likelihood of confusion.

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<sup>6</sup> The Examining Attorney attempts to distinguish this case by observing that the Board also found the term ELEMENT to be weak and diluted. However, this finding only applied to the clothing goods and not to the remaining goods in classes 16 and 18. Nevertheless, the likelihood of confusion refusal was also reversed as to the goods in these classes as well based solely on the prominence of ZU.

### **Balancing of Factors**

In conclusion, because the marks are similar, the services are identical, and the channels of trade and consumers overlap, we find that confusion is likely between

Applicant's mark EAT HAPPY and Registrant's mark



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