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Mailed:
August 28, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Big Kahuna Donuts

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Serial No. 86774996

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Gene Bolmarcich, Esq. for Big Kahuna Donuts.

Nelson Snyder, Trademark Examining Attorney, Law Office 107
(J. Leslie Bishop, Managing Attorney).

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Before Lykos, Masiello, and Lynch, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Big Kahuna Donuts (“Applicant”) filed an application¹ for registration on the Principal Register of the mark BIG KAHUNA DONUTS in standard characters for the following goods and services:

Donuts, in International Class 30;

Retail store services featuring donuts, in International Class 35.

¹ Application Serial No. 86774996 was filed on October 1, 2015. Although initially filed on the basis of use of the mark in commerce, the application is now based upon Applicant’s *bona fide* intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b). Applicant has disclaimed the exclusive right to use DONUTS apart from the mark as shown.

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as used in connection with Applicant's goods and services, so resembles the registered mark BIG KAHUNA CLIFF'S HAWAIIAN COFFEE as to be likely to cause confusion, or to cause mistake, or to deceive. The cited mark is registered for:

Coffee, in International Class 30;

On-line retail store services featuring coffee; Retail store services featuring coffee, in International Class 35.²

When the refusal was made final, Applicant appealed to this Board. Applicant and the Examining Attorney have filed briefs.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the issue of likelihood of confusion as set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In this case, Applicant and the Examining Attorney have also presented evidence and arguments regarding the number and nature of similar marks in use in the marketplace.

(a) The goods and services.

We will first consider the similarity or dissimilarity of the goods and services as identified in the application and the cited registration. *Stone Lion Capital Partners,*

² Reg. No. 4612907, issued September 30, 2014. Registrant has disclaimed the exclusive right to use HAWAIIAN COFFEE apart from the mark as shown.

LP v. Lion Capital LLP, 746 F.3d 1317, 110 USPQ2d 1157, 1161-62 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). The Examining Attorney argues that doughnuts and coffee are “*complementary* food/beverage items that are *commonly* offered under the same mark.”³ The Examining Attorney has provided internet evidence showing three actual examples of coffee and doughnuts being offered under the same brand: Dunkin’ Donuts, Starbucks, and Krispy Kreme.⁴ He has also submitted copies of at least 25 use-based third-party registrations, each of which covers both coffee and doughnuts.⁵ Third-party registrations which individually cover different goods and services and are based on use in commerce may serve to suggest that the listed goods and services are of types which may emanate from the same source. *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). Finally, the Examining Attorney has submitted many news items and other online items that refer to the consumption of coffee and doughnuts together.⁶ On this record, there is no doubt that the combination of brewed coffee and doughnuts is a favorite treat among relevant consumers, and that this combination is often offered as an enticement to attend a social or commercial event or as a gesture of hospitality.

³ Examining Attorney’s brief, 7 TTABVUE 8 (emphasis in original).

⁴ Office Action of March 10, 2017 at 114-142.

⁵ See, generally, Office Action of January 29, 2016 at 8-95; Office Action of March 10, 2017 at 8-142.

⁶ Office Action of April 4, 2017 at 6-10, 12-23, 32-35; Office Action of March 10, 2017 at 8, 12-14, 16, 18, 20-25, 27-28.

Such complementary consumption is a relevant consideration in determining likelihood of confusion. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *Sholl Dental Laboratory Co. v. McKesson & Robbins, Inc.*, 150 F.2d 718, 66 USPQ 223, 226 (CCPA 1945). While the Examining Attorney's evidence demonstrates that doughnuts and brewed coffee are related, it bears noting that they are different in nature, one being a baked or fried food, the other a beverage made by roasting, grinding and brewing.

In order to show that stores that feature doughnuts are related to stores that feature coffee, the Examining Attorney has submitted approximately 13 use-based registrations that cover shops that offer both coffee and doughnuts.⁷ Dunkin' Donuts, Starbucks, and Krispy Kreme, discussed above, are actual market examples of stores that offer both coffee and doughnuts, although one might question whether Krispy Kreme is a store that "features" coffee and whether Starbucks is a store that "features" doughnuts. The Examining Attorney has also submitted news items and other internet evidence referring to shops that offer both coffee and doughnuts:⁸

... we stopped at Cumberland's Milk Store on the way home for coffee and a donut ...

Golf was followed by coffee and a donut at Supreme Donuts on Flushing Road.

Then I leave, drive home, stop at the 7-11 for a cup of coffee and a donut ...

⁷ Office Action of March 10, 2017 at 33-40, 44-48, 57-59, 66-67, 74-78, 94-101, 111-113.

⁸ Id. at 9, 11, 15, 17. Office Action of April 4, 2017 at 11, 28-30, 36-37.

The restaurant became the spot for a quick cup of coffee and a donut, a family meal or a gathering on Sunday after church.

A breakfast staple is coffee and donuts (\$3.99); ...

Five Best Places to Get Coffee and a Donut in Chicago

...

Stan's Donuts & Coffee ...

Glazed & Infused ...

Do-Rite Donuts & Coffee ...

Doughnut Vault ...

West Town Bakery ...

Donna's Donuts ... Stop in for a hot cup of coffee or tea and your favorite donut.

The evidence shows that the services at issue are commercially related. It is relevant that some general merchandise stores, such as 7-11, offer both coffee and doughnuts among many other goods. Other stores identify themselves as specializing in doughnuts, such as Supreme Donuts, Dunkin' Donuts, and Doughnut Vault, but also offer coffee. Others, such as Starbucks, identify themselves as specializing in coffee, but also offer doughnuts. Thus, the evidence illustrates that there often is some distinction in nature between a store that "features" coffee and a store that "features" doughnuts. Overall, however, with respect to both the goods and the services, this *du Pont* factor weighs in favor of a finding of likelihood of confusion.

(b) The marks.

We next consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). “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.

The marks have some similarity in appearance and sound to the extent that each includes the expression BIG KAHUNA. The remaining words of the two marks, CLIFF’S HAWAIIAN COFFEE and DONUTS, respectively, are points of difference in appearance and sound.

Regarding the meaning of the marks, Applicant argues that Registrant’s mark refers to “a person who is the ‘Big Kahuna’ (namely, ‘Cliff)’”; but that Applicant’s mark does not refer to a person at all.⁹ The Examining Attorney contends that both marks share the commercial impression of “a person who is the ‘Big Kahuna.’”¹⁰ The Examining Attorney submitted dictionary definitions indicating that “big kahuna” is slang meaning “the most important person; a chief” and “An authoritative person,

⁹ Applicant’s brief at 3, 4 TTABVUE 4.

¹⁰ Examining Attorney’s brief, 7 TTABVUE 4.

the chief.”¹¹ However, one of the usage examples provided in the definition refers to a motion picture as a “big kahuna,”¹² giving some support to the argument that the term need not necessarily refer to a person. We also note that <merriam-webster.com> defines “kahuna” as “a preeminent person *or thing*” (emphasis added) and provides usage examples applying the term both to a person and to a thing:¹³

The industry’s big *kahuna*, with ... 57 percent of the market.

Apple isn’t going to let the nano steal the spotlight from its precious big-*kahuna* iPod that got all of this started.

We agree with Applicant’s contention that Registrant’s mark clearly refers to an individual named “Cliff.” In Registrant’s mark, the term CLIFF’S is the most specific source-indicating component of Registrant’s mark, giving the impression that an individual named Cliff is the source of the goods and services. We also agree that Applicant’s mark, rather than referring to a person, gives more of an impression that Applicant’s DONUTS are great, preeminent, and perhaps large. To this extent, the meanings of the two marks are somewhat different, in that Registrant’s mark suggests that Cliff is a great man, while Applicant’s mark suggests that Applicant’s goods or establishment have attributes of greatness.

¹¹ Definitions from “Dictionary.com’s 21st Century Lexicon” and “The Dictionary of American Slang” at <dictionary.com>, Office Action of April 4, 2017 at 25-26.

¹² “Which brings us to The Expendables 3 – the big kahuna of boarding.” *Id.* at 25.

¹³ The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

The descriptive or generic wording of the marks also gives rise to some distinction in meaning and commercial impression, at least as applied to the services at issue. In the context of the services, HAWAIIAN COFFEE indicates not just a retail store in which coffee may be purchased among other goods, but a store that specializes in coffee, such as a coffee shop or café. Similarly, DONUTS indicates not just a retail store in which doughnuts happen to be available among other goods, but a store that specializes in doughnuts (probably freshly baked), like a doughnut shop or bakery. These are types of establishments that are familiar to most relevant consumers and they are generally considered to be somewhat different in nature, the one dominated by preparation of baked and fried goods and the other dominated by the preparation of brewed beverages.

Before we complete our comparison of the marks, we must address Applicant's contentions regarding the strength or weakness of the term BIG KAHUNA. During prosecution, Applicant argued that the expression BIG KAHUNA should be given a narrow scope of protection, and submitted internet evidence showing use of the expression by the following establishments:¹⁴

<u>MARK</u>	<u>SERVICES, LOCATION</u>
THE BIG KAHUNA	billiards, grill, sports bar and lounge, Jericho, New York
BIG KAHUNA BBQ	pit barbecue, Colorado
BIG KAHUNA'S PIZZA	pizza shop, restaurant, Indianapolis, Indiana

¹⁴ Applicant's response of February 4, 2016 at 10 and 16-30. We have not considered evidence of "The Big Kahuna Bar and Restaurant," which is located in the Philippines.

BIG KAHUNA'S	restaurant, catering, Imperial Beach, California
BIG KAHUNA	dining, Atlanta, Georgia
BIG KAHUNA BAR & GRILL	restaurant and bar, Grafton, Illinois
BUSTER'S BIG KAHUNA CAFÉ	dining, Panama City, Florida
DA BIG KAHUNA'S PIZZA 'N STUFFS	restaurant, Honolulu, Hawaii
BIG KAHUNA RUM SHACK	restaurant, St. Thomas, Virgin Islands
BIG KAHUNA'S CATERING	catering, New Hampshire
THE BIG KAHUNA LU'AU	luau services, Honolulu, Hawaii
KAHUNA BAR AND GRILL	restaurant, Deerfield Beach, Florida
IWAYAMA SUSHI & DA BIG KAHUNA BISTRO	restaurant, Littleton, Colorado
BIG KAHUNA PUB & GRILL	bar and grill, Seaside, Oregon

We also note that the dictionary definition submitted by the Examining Attorney indicates public familiarity with a fictional restaurant mentioned in the film *Pulp Fiction*: “big kahuna Burger is a fictional chain of Hawaiian-themed fast food burger joints out in Los Angeles dreamed up by Tarantino. ... That Tarantino never opened a real-life big kahuna Burger out in L.A. seems like a huge missed opportunity.”¹⁵

None of the third-party uses listed above relates to a coffee shop or to coffee as a product.¹⁶ Accordingly, these examples do not effectively demonstrate that the cited

¹⁵ Office Action of April 4, 2017 at 25.

¹⁶ We note that at the time Applicant submitted this evidence the refusal it was facing was based not on the mark now cited by the Examining Attorney, but on Reg. No. 3387853 for

mark is commercially weak for coffee and coffee shops. However, these uses do illustrate the manner in which the expression BIG KAHUNA is used in the marketplace. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015). Considered together with the dictionary definitions and other usage examples, we find that the expression BIG KAHUNA has a laudatory suggestiveness and is commonly used to suggest size, importance, or greatness in general. In view of the suggestive nature of this term, Registrant's mark is not entitled to such a broad scope of protection that it will necessarily bar the registration of every mark comprising, in whole or in part, the expression BIG KAHUNA.

(c) Balancing the factors.

This is a very close case. The marks at issue are similar in part, but their point of similarity, the term BIG KAHUNA, has a laudatory, aggrandizing character that has proven attractive to merchants as a way to praise themselves or their goods. The most notable difference between the marks, the term CLIFF'S in Registrant's mark, is the most specific aspect of that mark and, as part of the phrase BIG KAHUNA CLIFF'S, creates a very specific impression of a particular individual as the source of Registrant's goods and services. Because of the laudatory nature of BIG KAHUNA, customers are unlikely to perceive every use of this term as a reference to "Cliff."

the mark DA BIG KAHUNA RESTAURANT AND TIKI LOUNGE. *See Office Action of January 29, 2016 at 8-9.*

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The goods and services at issue are related, and yet distinguishable, and different in nature. Although a doughnut shop is likely to accommodate its customers by providing coffee, and a coffee shop might sometimes have doughnuts available for purchase, customers appreciate that these are very different types of establishment.

Under these circumstances, we find BIG KAHUNA CLIFF'S HAWAIIAN COFFEE and BIG KAHUNA DONUTS to be sufficiently different to coexist, as applied to the respective goods and services, without creating a likelihood of confusion as to source.

Decision: The refusal under Section 2(d) is REVERSED.