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Subject: U.S. TRADEMARK APPLICATION NO. 87055289 - CREPES BONAPARTE - N/A - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87055289

MARK: CREPES BONAPARTE



**CORRESPONDENT ADDRESS:**

ERIK M PELTON

ERIK M PELTON & ASSOCIATES PLLC

PO BOX 100637

ARLINGTON, VA 22210

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Brats Berlin, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

uspto@tm4smallbiz.com

## **EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant has appealed the trademark examining attorney's refusal to register the service mark CREPES BONAPARTE for "food truck services; mobile catering services" in Class 43 based on likelihood of confusion with a registered mark under 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

It is respectfully requested that this refusal be affirmed.

### **Statement of Facts**

On 5/3/16, BRATS BERLIN, INC. applied for a federal service mark registration for the standard character mark CREPES BONAPARTE pursuant to 15 U.S.C. §1051(a). Applicant identified its service mark for, “food truck services; mobile catering services” in Class 43.

On 9/3/16, the examining attorney refused registration of applicant’s service mark due to a likelihood of confusion with U.S. Registration Number 4670082 and required a disclaimer of CREPES.

On 10/11/16, the applicant filed a timely response with arguments in favor of registration and satisfied the disclaimer requirement.

On 11/1/16, the examining attorney issued a final Office action citing U.S. Registration Number 4670082.

On 3/7/17, the applicant filed a Notice of Appeal and Request for Reconsideration.

On 3/15/17 the examining attorney denied the Request for Reconsideration.

On 5/9/17, the applicant filed a timely appeal brief.

### Issue

The sole issue on appeal is whether under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), there is a likelihood of confusion between the applicant's standard character mark CREPES BONAPARTE for "food truck services; mobile catering services" in Class 43 and U.S. Registration Number 4670082 for the stylized wording CAFÉ BONAPARTE below a letter B and wreath design for "restaurant services" in Class 43.

### Arguments

**APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO REGISTRANTS' MARK AND THE GOODS AND SERVICES ARE CLOSELY RELATED SUCH THAT A LIKELIHOOD OF CONFUSION, MISTAKE, OR DECEPTION EXISTS UNDER SECTION 2(D) OF THE TRADEMARK ACT**

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In*

*re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record.

*Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

#### **THE MARKS ARE CONFUSINGLY SIMILAR**

The application is for the standard character mark CREPES BONAPARTE.

The cited registration is for the stylized wording CAFÉ BONAPARTE below a letter B and wreath design.

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 goods and/or 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, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d at 1960 (citing *Spoons Rests, Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013)); TMEP §1207.01(b).

Marks must be compared in their entireties and should not be dissected. However, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1322, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (“[Regarding the issue of confusion,] there is nothing improper in stating that . . . 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.”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985)).

BONAPARTE is the dominant feature of the applied-for mark and the cited registration.

The applicant has disclaimed CREPES and the registrant has disclaimed CAFÉ. Disclaimed matter that is descriptive of or generic for a party's goods and/or services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii).

The letter B and wreath design in the cited registration are merely decorative. The word portion generally may be considered the dominant and most significant feature of a mark because consumers will request the goods and/or services using the wording. See *Bond v. Taylor*, 119 USPQ2d 1049, 1055 (TTAB 2016) (citing *In re Vittera Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012)); TMEP §1207.01(c)(ii). For this reason, greater weight is often given to the word portion of marks when determining whether marks are confusingly similar. *In re Vittera Inc.*, 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Furthermore, the applied-for mark is in standard characters. A mark in typed or standard characters may be displayed in any lettering style. See *In re Vittera Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, the marks could be presented in the same manner of display. See, e.g., *In re Vittera Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "the argument concerning a difference in type style is not viable where one party asserts rights in no particular display").

The applicant's argument that BONAPARTE has limited source identifying significance is not accurate. BONAPARTE is inherently distinctive because of the historical meaning. Otherwise, the application would have been refused under Section 2(e)(4) as primarily merely a surname in addition to Section 2(d). *See* TMEP §1211.01(a)(iv).

The applicant's three examples of third-parties using the term BONAPARTE for the same or similar services is insufficient to show dilution in the marketplace. The fact that there is a second CAFÉ BONAPARTE is an issue for the registrant, BONAPARTE'S RETREAT Reg. No. 4040026 creates a completely different commercial impression, and BONAPARTE BREADS is a bakery not a restaurant or food truck. The TTAB has routinely found that third-party evidence of real world use of trademarks is not sufficient to show that a registered mark is entitled to a limited scope of protection. *See, e.g., In re Fourth Wall Rests., LLC*, Serial No. 77930437 (Aug. 29, 2012) (finding that the 50 eating establishments shown in a Dun & Bradstreet report using the mark HURRICANE were insufficient to find that the wording was crowded when comparing the marks THE HURRICANE CLUB and HURRICANE GRILL AND WINGS & Design); *In re Merrimack Acad. for the Performing Arts, Inc.*, Serial No. 77452144 (May 11, 2010) (noting that the third party website evidence submitted had "limited probative value because there is no indication of the extent to which the services identified at the websites have been rendered, when the marks were adopted, or customer familiarity with the marks."); *In re Madmann Trademark Holding Co.*, Serial No. 77228194 (Apr. 13, 2010) (finding that "a mere ten websites" and a Dun & Bradstreet report identifying approximately fifty business in the food and restaurant field were insufficient to find that the term MAVERICK was entitled to only a limited scope of protection in the same); *In re Slater*, Serial Nos. 78344467 & 78344449 (Mar. 13, 2006) (finding that over thirty examples of use of the mark LAKESHORE in third party websites and online directories, and results of Internet searches, were insufficient to find that the LAKESHORE mark was crowded in the real estate field).

The applicant has not provided any other examples of third-party registrations with the word BONAPARTE and is instead arguing the novel theory that the dilution of other completely different marks should somehow apply to their own. Third-party registrations that do not include the term BONAPARTE are not relevant. Whether JOHNNY or MICHAEL or JERRY or FRANKIE or MESA is diluted in Class 43 has no bearing on the applied-for mark. Prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); see *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

Therefore, the marks are confusingly similar.

#### **THE GOODS AND SERVICES ARE RELATED**

The application is for “food truck services; mobile catering services” in Class 43.

The cited registration is for “restaurant services” in Class 43.

The evidence of record includes numerous examples of third-party restaurants who offer food truck and/or mobile catering services. This evidence establishes that the same entity commonly provides the relevant services and markets the services under the same mark and that the relevant services are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use. Therefore, applicant's and registrant's services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the internet may be used to support a determination under Section 2(d) that goods and/or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007). The Internet has become integral to daily life in the United States, with Census Bureau data showing approximately three-quarters of American households used the Internet in 2013 to engage in personal communications, to obtain news, information, and entertainment, and to do banking and shopping. *See In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1642 (TTAB 2015) (taking judicial notice of the following two official government publications: (1) Thom File & Camille Ryan, U.S. Census Bureau, Am. Cmty. Survey Reports ACS-28, *Computer & Internet Use in the United States: 2013* (2014), available at <http://www.census.gov/content/dam/Census/library/publications/2014/acs/acs-28.pdf>, and (2) The Nat'l Telecomms. & Info. Admin. & Econ. & Statistics Admin., *Exploring the Digital Nation: America's Emerging Online Experience* (2013), available at [http://www.ntia.doc.gov/files/ntia/publications/exploring\\_the\\_digital\\_nation\\_-\\_americas\\_emerging\\_online\\_experience.pdf](http://www.ntia.doc.gov/files/ntia/publications/exploring_the_digital_nation_-_americas_emerging_online_experience.pdf)). Thus, the widespread use of the Internet in the United States suggests that Internet evidence may be probative of public perception in trademark examination.

The record also includes evidence submitted by the examining attorney from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar services as those of both applicant and registrant in this case. This evidence shows that the services listed therein, namely restaurants and food trucks or mobile catering, are of a kind that may emanate from a single source under a single mark. See *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015) (citing *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); TMEP §1207.01(d)(iii).

The goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods and/or services need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] 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)); TMEP §1207.01(a)(i).

Therefore, restaurants like the registrant's are related to food trucks and mobile catering like the applicant's.

**Conclusion**

The examining attorney, having established that the respective marks are similar and the respective goods and services are closely related, respectfully submits that the applicant's mark so resembles the registrants' mark that it is likely, when applied to the applicant's services, to cause confusion, or to cause mistake, or to deceive. Accordingly, the Trademark Attorney respectfully submits that registration of applicant's mark is properly refused under Trademark Act Section 2(d).

Respectfully submitted,

/Samuel R. Paquin/

Examining Attorney

Law Office 101

(571) 272-2514

samuel.paquin@uspto.gov

Ronald R. Sussman

Managing Attorney

Law Office 101

