

**This Opinion is Not a
Precedent of the TTAB**

Mailed: October 25, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re 8415927 Canada, Inc.

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Serial No. 87056710
Serial No. 87056720
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Cheryl L. Burbach of Hovey Williams LLP,
for 8415927 Canada, Inc.

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Before Mermelstein, Greenbaum and Coggins,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

8415927 Canada, Inc. (“Applicant”) filed two applications seeking registration on the Principal Register of the mark DIVE PRIME SEAFOOD in standard characters,



and in stylized form displayed as , for

Bar services; Restaurant services; Take-out restaurant
services, in International Class 43.¹

¹ Application Serial Nos. 87056710 and 87056720 were filed on June 1, 2016, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section

In each application, 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 Applicant's mark, when used in connection with Applicant's services, so resembles the previously registered mark DIVE COASTAL CUISINE, in stylized



form displayed as  for "restaurant services" in International Class 43 as to be likely to cause confusion, mistake or deception.²

When the refusal was made final in each application, Applicant appealed and requested reconsideration. After the Examining Attorney denied the requests for reconsideration, the appeals were resumed. We consolidate the appeals and decide them in a single opinion because they involve common issues of law and fact and largely identical records. *See In re Anderson*, 101 USPQ2d 1912, 1915 (TTAB 2012) (Board *sua sponte* consolidated two appeals); *In re Bacardi & Co. Ltd.*, 48 USPQ2d

1(b) of the Trademark Act, 15 U.S.C. § 1051(b). PRIME SEAFOOD is disclaimed in both applications. The stylized mark (Application Serial No. 87056720) is described as follows: "The mark consists of the word 'DIVE' with a curved line through the top and the smaller words 'PRIME SEAFOOD' directly underneath. Color is not claimed as a feature of the mark.

² Registration No. 4160332 issued on June 19, 2012. Section 8 accepted and Section 15 acknowledged. COASTAL CUISINE is disclaimed. The mark is described as follows: "The mark consists of the stylized word 'Dive' in all capital letters, in which the top of the letter 'I' is tilted toward the letter 'D' and the bottom of the letter 'I' is tilted toward the letter 'V', disposed upon a field of scattered particles, below two flying birds passing over the letter 'V', and above a black circle and the stylized phrase 'Coastal Cuisine' in all capital letter." Color is not claimed as a feature of the mark.

1031, 1033 (TTAB 1997) (Board *sua sponte* considered appeals in five applications together and rendered single opinion).³

We affirm the refusal to register in each application.

I. Applicable Law

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, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int'l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *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.”). We discuss below these and other relevant factors. *See M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (even within *du Pont* list, only factors that are “relevant and of record” need be considered); *see also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive

³ Unless otherwise noted, all references to TTABVUE are to the appeal in Application Serial No. 87056710 for the mark DIVE PRIME SEAFOOD in standard characters, and all references to the Trademark Status & Document Retrieval database (“TSDR”) are to the prosecution history of that same application, in .pdf format.

factors, such as similarity of the marks and relatedness of the goods”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. Similarity of the Services and Channels of Trade

Under the second and third *du Pont* factors, we make our determinations about the services and channels of trade based on the services as they are identified in the applications and registration. *See In re Dixie Rests.*, 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, 1004-05 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Applicant presented no argument on these factors.

The “restaurant services” identified in the applications and registration are identical, and the broadly worded “restaurant services” in the registration encompass, and therefore are legally identical to, the “take-out restaurant services” identified in the applications. *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”). We need not address the remaining bar services because it is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the identification of services in a particular

class in the applications. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Given the literal and legal identity of the restaurant services, and the lack of restrictions or limitations in the applications and registration as to their nature, channels of trade, or classes of customers, we presume that those services travel through the same channels of trade, namely all types of restaurants, and that they are offered to the same potential purchasers, namely ordinary consumers who are dining out. *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).

These *du Pont* factors weigh heavily in favor of a finding of likelihood of confusion.

B. Strength of the Cited Mark

Under the sixth *du Pont* factor, we consider “[t]he number and nature of similar marks in use on similar goods [or services].” *du Pont*, 177 USPQ at 567. Evidence of third-party use bears on the strength or weakness of a registrant’s mark. *i.am.symbolic*, 123 USPQ2d at 1751. If the evidence establishes that the consuming public is exposed to third-party uses of similar marks for similar goods or services, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

Applicant contends that “dive” is a weak term entitled to a narrow scope of protection of exclusivity of use because it is a widely used colloquial term referring to a “type of shabby establishment,” and in view of twenty-two third-party registrations of DIVE-formative marks for restaurant and bars.⁴ According to Applicant, if the cited



registration for  can coexist with other DIVE-formative marks, then its marks also should be permitted to register.

Definitions introduced by both Applicant and the Examining Attorney reflect that “dive” means different things in different contexts, such as “plunge head first into water [as in] ‘she walked to the deep end, then she dived in,’” “swim underwater using breathing equipment,” and “move quickly or suddenly in a specified direction.” Other definitions include one listed “informal”: “a shabby or sleazy bar or similar establishment” with the examples “he got into a fight in some dive” and “a detective story set in the smoky clubs and dive bars of 1940s Los Angeles;” one listed as the phrase “take a dive”: “pretend to be knocked out;” and one listed as a phrasal verb “dive in”: “help oneself to food, with the variation “dive into”: “occupy oneself suddenly and enthusiastically with (a meal, or an engrossing subject or activity)” such as “dive

⁴ App. Br., 7 TTABVUE 22. The registrations are use-based and reside on the Principal Register.

into a barbecued beef burrito.”⁵ Applicant also submitted a wikipedia entry for the term “dive,” and printouts from the Syracuse.com entertainment blog, the travelchannel.com food-culture blog, thrillist.com, and huffingtonpost.com showing use of the term “dive” in the informal or colloquial sense, to refer to a shabby bar or restaurant.⁶

Applicant points to 22 third-party registrations for DIVE-inclusive marks for restaurants as additional evidence that DIVE is conceptually weak.⁷ Evidence of third-party use and registration of a term in the relevant industry is considered in the likelihood of confusion analysis. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015); *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135-36 (Fed. Cir. 2015). In this case, however, Applicant relies exclusively on the third-party registrations, and submitted no evidence that any of the registered marks is in use. Such registrations are not evidence that the marks therein are in use on a commercial scale or that the public has become familiar with them. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 177 USPQ 462, 463 (CCPA 1973); *see also In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) (“Applicant’s citation of third-party registrations as evidence of market weakness is

⁵ Definitions of “dive” from en.oxforddictionaries.com, attached to April 14, 2017 Final Office Action, TSDR 7-9 from Google and dictionary.com, attached to December 18, 2017 Request for Reconsideration, 4 TTABVUE 10-12. The Examining Attorney submitted similar definitions from THE AMERICAN HERITAGE DICTIONARY with her February 22, 2018 Denial of Request for Reconsideration, 5 TTABVUE 20.

⁶ March 15, 2017 Response to Office Action, TSDR 68-102.

⁷ March 15, 2017 Response to Office Action, TSDR 24-67.

unavailing because third-party registrations standing alone, are not evidence that the registered marks are in use on a commercial scale, let alone that consumers have become so accustomed to seeing them in the marketplace that they have learned to distinguish among them by minor differences.”).

The probative evidentiary value of the third-party registrations alone is in showing the sense in which the term DIVE is used and understood. *Juice Generation*, 115 USPQ2d at 1675; *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976) (third-party registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”); *Institut Nat’l Des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (“Third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services.”). As the Board explained in *Morinaga*, 120 USPQ2d at 1745-46, third-party registrations can be used in the manner of a dictionary as “evidence that a term is suggestive or descriptive of the relevant goods or services. Such terms may be conceptually weak because the more descriptive a term is, the less likely prospective purchasers are to attach source-identifying significance to it.”

To the extent Applicant bases its argument that “dive” is conceptually weak on the volume of third-party registrations of record, a closer inspection reveals that all of the marks contain distinguishing matter such as additional wording or a design,

or both. The additional matter results in marks with various commercial impressions, including some of those defined above, which undercuts their probative value.

For example, registrations for marks such as FIVE STAR DIVE BAR, PEACE BURGER DIVE BAR AND GRILL, PEARL DIVE OYSTER PALACE (with and without design), POTBELLY SANDWICH WORKS A FIRST CLASS DIVE SINCE 1977 and design, and TACO DIVE NOT YOUR AVERAGE HOLE IN THE WALL and design, use the term DIVE to refer to “a shabby or sleazy bar or similar establishment.”⁸ Registrations for the marks DIVE IN. DINE. UNWIND. and DIVE INN and design are plays on “dive in,” and the registration for the mark DIVE-IN THEATER is a play on a “drive-in theater.” The registration for the mark UDE ULTIMATE DIVE EXPERIENCE and design, which identifies numerous services including rental of deep water diving suits and diving bells, uses the term “dive” to refer to under water diving. And the registration for the mark NOSE DIVE is a unitary expression meaning “a downward nose-first plunge of a flying object (as an airplane)” and “a sudden extreme drop” such as “stock prices took as nosedive.”⁹ NOSE DIVE is a variation of the “plunge headfirst into water” definition of “dive” listed above. The other marks, DIG & DIVE (with and without design), DIVE ‘N’

⁸ DUG’S DIVE, LOUIE’S WINE DIVE, MAX’S WINE DIVE (with and without stylization), SNOOTY’S WINE DIVE, and LA BETTOLA DI TERRONI (which includes the translation statement: “the intended meaning of the mark is ‘DINER, DIVE, JOINT OR GREASY SPOON OF THE TERRONI’”), and SOUPDIVE A FUSION OF HEALTH AND DELICIOUS and design, also fall in this category

⁹ Definition of “nose-dive” from merriam-webster.com, attached to April 14, 2017 Final Office Action, TSDR 11-14.

BOAR, and DUCK DIVE (with and without design) also are unitary in that they refer to specific activities.

Despite the evidentiary infirmities, the record supports a finding that the term “dive” is not entirely unique when used in connection with restaurants, and may be referring to a style or type of restaurant, and that restaurant patrons would be aware of these meanings. We find, therefore, that the mark in the cited registration has some conceptual weakness, and accordingly, it is entitled to a slightly narrowed scope of protection than would be accorded an arbitrary mark.

C. The similarity or dissimilarity of the marks

Under this factor, we compare the marks DIVE PRIME SEAFOOD and



on the one hand, and



on the other, “in their

entireties as to appearance, sound, connotation and commercial impression.” *Viterra*, 101 USPQ2d at 1908 (quoting *du Pont*, 177 USPQ at 567); see also *Palm Bay Imps.*, 73 USPQ2d at 1691. “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*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). 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 purchaser, who normally retains a general rather than a specific impression of trademarks. See *St. Helena Hosp.*, 113 USPQ2d at 1085; *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971). Because the services are restaurants with no restrictions or limitations as to prices or classes of consumers, the average customer is an ordinary consumer.

Our analysis cannot be predicated on dissection of the involved marks. *Stone Lion*, 110 USPQ2d at 1161. Rather, we are obliged to consider the marks in their entirety. *Id.*; see also *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Nonetheless, 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 entirety. *Stone Lion*, 110 USPQ2d at 1161. For instance, as the Federal Circuit has observed, “[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In addition, and of particular relevance here, where the parties use their marks in connection with identical services, the similarity between the marks necessary to support a determination that confusion is likely declines. *Bridgestone Ams. Tire*

Operations LLC v. Fed. Corp., 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applicant argues that the differences in the marks in appearance and sound are sufficient to distinguish them, and that when they are viewed in their entirety, the marks create different commercial impressions. In particular, Applicant contends



that its marks DIVE PRIME SEAFOOD and convey a top-notch, fine dining seafood restaurant where the term DIVE refers to the act of diving “in terms of fishing as is required to harvest the seafood,” while Registrant’s mark



conveys the idea of a “casual, shabby, dingy restaurant on a coastline,” where DIVE is used in the colloquial sense to refer to the type of restaurant.¹⁰ The Examining Attorney focuses on the visual and aural similarities between Applicant’s marks and the cited registered mark due to the shared term DIVE, which she contends is the most distinctive portion, and therefore the strongest source identifying element, of each of the marks, combined with terms that are descriptive of the identified restaurant services.

¹⁰ App. Br., 7 TTABVUE 11-13.



The marks DIVE PRIME SEAFOOD and



are highly similar to the mark  in appearance, sound, connotation and overall commercial impression. The literal terms of the marks are presented in the same three-word structure, leading with the identical word DIVE, followed by two words, PRIME SEAFOOD or COASTAL CUISINE, which would be perceived simply as variants of each other, with each indicating a seafood restaurant, albeit possibly of a different caliber.

In each instance, the additional wording has greatly reduced source-identifying capacity because it describes the type of food served in the restaurant. Indeed, the additional wording is disclaimed in all of the marks. *See Dixie Rests.*, 41 USPQ2d at 1534. We conclude that the identical common term DIVE is the dominant element in each mark. *Nat'l Data Corp.*, 224 USPQ at 751 (“[I]n articulating reasons for reaching a conclusion on the issue of confusion, 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 consideration of the marks in their entireties.”). The prominence of the word DIVE is further enhanced by its placement at the beginning of Applicant’s and Registrant’s marks, and by the relative size of the word in Applicant’s stylized mark and that of the Registrant. *See Palm Bay Imps.*, 73

USPQ2d at 1692; *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988).

Applicant's stylized mark  and Registrant's stylized mark



also are visually similar because DIVE appears in a very large, dark font above two words in much smaller, lighter font. DIVE stands out as the most visually prominent element, conveying the strongest commercial impression, in each of the stylized marks. The designs of two very small birds in Registrant's mark and the curved line in Applicant's mark highlight rather than overwhelm or detract from the wording in each mark, and evoke the coastal or oceanic aspect of both seafood restaurants.

Finally, Applicant's standard character mark DIVE PRIME SEAFOOD is not limited to any particular depiction. The rights associated with a standard character mark reside in the wording and not in any particular display. *In re RSI Sys., LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). We must consider Applicant's standard character mark "regardless of font style, size, or color" *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011), including iterations emphasizing the lead term DIVE.

For these reasons, we find that DIVE is the dominant term in each mark, and accordingly, it is entitled to more weight in our analysis. In coming to this conclusion, we do not discount the presence of the additional wording in each mark or the stylization in the two composite marks. However, for the reasons discussed above, we find that the term DIVE in each mark is more likely to be remembered by consumers than the other elements of the marks. *See In re Detroit Athletic Co.*, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (“Indeed, in view of the marks’ structural similarity, the lead words are their dominant portion and are likely to make the greatest impression on consumers.”).

There is no evidence that consumers would ascribe different meanings to the same term DIVE when viewed in the context of Applicant’s and Registrant’s marks in connection with identical restaurant services, especially when it is combined with descriptive terms that refer to seafood restaurants. We find it more likely that consumers would understand the term DIVE to mean the same thing when viewed in Applicant’s and Registrant’s marks, whether an allusion to a shabby restaurant, in the sense of “diving into” a delicious meal, or in the “fishing sense” that Applicant posits applies only to its marks

We find that when viewed in their entirety, the marks are very similar in all respects. The first *du Pont* factor thus weighs heavily in favor of a finding that confusion is likely.

D. Conclusion

Having considered all the evidence and arguments bearing on the relevant *du Pont* factors, we conclude that the identified services are identical in part and move through the same channels of trade to the same classes of purchasers, the marks are highly similar, and any conceptual weakness in the cited registered mark does not outweigh these *du Pont* factors. Ultimately, Applicant's marks are likely to cause confusion with the cited mark when used in connection with the services identified in the applications.

Decision: The Section 2(d) refusal to register each of Applicant's marks is affirmed.