

This Opinion is not a
Precedent of the TTAB

Mailed: October 26, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Allen Street Owner LLC
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Serial No. 87138386
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Anthony F. Lo Cicero of Amster Rothstein & Ebenstein LLP,
for Allen Street Owner LLC

Monica L. Beggs, Trademark Examining Attorney, Law Office 105,
Jennifer L. Williston, Managing Attorney.

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Before Kuczma, Hightower and Goodman,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Allen Street Owner LLC (“Applicant”) seeks registration on the Principal Register of the mark ALLEN HOTEL (in standard characters, with “hotel” disclaimed) for “hotel accommodation services” in International Class 43.¹

¹ Application Serial No. 87138386 was filed on August 15, 2016, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

Page references herein to the application record refer to the USPTO’s Trademark Status & Document Retrieval (TSDR) system database. References to the briefs on appeal refer to the Board’s TTABVUE docket system.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(e)(2), 15 U.S.C. § 1052(e)(2), on the basis that Applicant's mark is primarily geographically descriptive of Applicant's services, and under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the registered mark ETHAN ALLEN for "providing facilities for business meetings" in International Class 35 and "hotel services, namely, inn and motel services, restaurant services" in International Class 43 as to be likely to cause confusion, mistake or deceive.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusals to register.

I. Preliminary Matter

Applicant attached exhibits to its appeal brief, almost all of which were submitted during prosecution. The Board discourages the practice of attaching copies of evidence submitted during examination to appeal briefs. *See, e.g., In re Allegiance Staffing*, 115 USPQ2d 1319, 1323 (TTAB 2015); TBMP § 1203.01 (2018).

The Examining Attorney objects to our consideration of Exhibit I, attached to Applicant's appeal brief, which consists of a dictionary.com definition for "Allen" that was not submitted prior to appeal. 4 TTABVUE 66-70. In response to the objection, Applicant argues that Applicant's Exhibit I is based on the Random House

² Reg. No. 2905879 issued November 30, 2004; Section 8 accepted, Section 15 acknowledged; renewed. The registration includes the following statement: "The name shown in the mark does not identify a living individual."

Unabridged Dictionary (in printed form) and that the Board can take judicial notice of the material. We take judicial notice of the dictionary.com definition for “Allen” and deny the Examining Attorney’s objection.

II. Likelihood of Confusion

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 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.*, 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 Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors, and the other relevant *du Pont* factors now before us, are discussed below.

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

We first turn to the second *du Pont* factor relating to the similarity or dissimilarity of the respective services. The issue of likelihood of confusion must be determined on the basis of the services as set forth in the application and the cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). In comparing the services, it is not necessary that they be identical or even competitive in nature in order to support a finding of likelihood of confusion. The 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 they emanate from the same source.” *Coach Servs. Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

The Examining Attorney has focused on Registrant’s Class 43 hotel services and we do the same. Applicant’s services are “hotel accommodation services.” Registrant’s services are identified as “hotel services, namely, inn and motel services, restaurant services.” The Examining Attorney has provided the following definitions:

Inn: “hotel”;³

Motel: “a roadside hotel designed primarily for motorists, typically having the rooms arranged in a low building with parking directly outside”;⁴

Hotel: “an establishment providing accommodations, meals, and other services for travelers and tourists.”⁵

Based upon the above definitions, we find that Applicant’s services are closely related, if not legally identical, to Registrant’s “inn and motel services” as both are concerned with providing lodging, usually temporary, for travelers and other guests. It is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods or services within a particular class in the application or cited registration. *See Tuxedo Monopoly, Inc. v. General Mills*

³ April 19, 2017 Office Action at 6. American Heritage Dictionary (ahdictionary.com).

⁴ *Id.* at 8.

⁵ November 18, 2016 Office Action at 5. Oxford Dictionary (en.oxford.com).

Fun Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). We find the second *du Pont* factor weighs in favor of finding a likelihood of confusion.

- B. The similarity or dissimilarity of established, likely-to-continue trade channels, classes of purchasers, and the conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing

We next consider the third and fourth *du Pont* factors. As to channels of trade and classes of purchasers, neither Applicant’s nor Registrant’s recitation of services contains any limitations regarding the channels of trade or the classes of purchasers. Thus, Applicant’s and Registrant’s services are presumed to move in all normal channels of trade and be offered to all ordinary classes of consumers for the services. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). We find Applicant’s and Registrant’s channels of trade, if not the same, are overlapping. The third *du Pont* factor weighs in favor of finding a likelihood of confusion.

As to the fourth *du Pont* factor, “the conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing,” Applicant contends that the relevant consumers are sophisticated since hotel lodging services are not inexpensive and could cost hundreds of dollars for a weekend stay. Applicant also argues that agents or professional event planners often book hotels for clients, “exercising even greater care.” 6 TTABVUE 11.

Other than Applicant’s argument, there is no evidence that purchasers of any type of hotel or motel lodging exercise a greater degree of care. The descriptions of services in the application and cited registration do not contain any limitations pertaining to the conditions of sale. Therefore, services for both the application and cited

registration include all types of hotel, motel and temporary lodging service, from upscale, luxury establishments to economy, budget operations. Also, the average purchaser of hotel and motel services could vary from the person driving down the road and deciding on impulse to stop for the day, to the person who planned and made an advance reservation after careful consideration. Even if purchasers may exercise a higher degree of care in making hotel or motel reservations, that does not immunize them from source confusion. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (citing *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) (“Human memories even of discriminating purchasers...are not infallible.”). We find the fourth *du Pont* factor neutral.

C. The similarity or dissimilarity of the marks

We next consider the first *du Pont* factor, whether ALLEN HOTEL and ETHAN ALLEN are similar or dissimilar “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “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.*, 101 USPQ2d at 1721 (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)).

The Examining Attorney argues that “Allen” is the dominant portion of Applicant’s mark, due to the disclaimed term “Hotel,” and that “Allen” could be perceived in both marks as a surname. The Examining Attorney contends that Applicant’s mark and the registered mark convey the same meaning and create the same commercial impression.

Applicant, on the other hand, argues that the commonality of “Allen” in the marks is an insufficient basis upon which to find the marks to be similar. Rather, Applicant contends that the marks must be considered in their entirety and, when so considered, the marks differ in connotation and overall commercial impression. Applicant asserts that ETHAN ALLEN is a well-known furniture company and that the term ETHAN ALLEN is synonymous with furniture and interior design. Applicant submits that consumers are likely to view ETHAN ALLEN as indicating a hotel that “promotes the Ethan Allen lifestyle aesthetic and which features Ethan Allen furniture.” 4 TTABUVE 9. Applicant also notes that the Ethan Allen Hotel is located adjacent to Ethan Headquarters in Danbury, Connecticut. As to its mark, Applicant contends that ALLEN HOTEL simply suggests hotel services.

The record includes the following evidence: “Ethan Allen Global Inc. is an American furniture chain with almost 300 stores across the United States, Canada and the United Kingdom,” listing revenues of \$1.1 billion in 2015.⁶ January 31, 2017

⁶ As shown in Registrant’s registration for furniture, Ethan Allen identifies the name of an early American patriot. January 31, 2017 Response to Office Action at 15. Ethan Allen was an “American soldier in the Revolutionary War and leader of the ‘Green Mountain Boys’ of Vermont.” Dictionary.com, Random House Unabridged Dictionary. 4 TTABVUE 67. As noted above, we have taken judicial notice of this dictionary entry.

Response to Office Action at 11, 18. The Ethan Allen Headquarters Complex is located in Danbury, Connecticut and includes the “Ethan Allen Hotel, corporate headquarters offices, and an interior design center.” *Id.* at 12. The Ethan Allen Hotel is “devoted to the Ethan Allen Furniture Company’s aesthetic of simple livable luxury. ... [T]he hotel’s social areas and 193 rooms and suites showcase the legendary craftsmanship and interiors that define the Ethan Allen lifestyle” and “boasts Ethan Allen furniture and design.” September 7, 2017 Request for Reconsideration at 15, 18.

As to the term “Allen,” evidence in the record shows that the term can reference not only a surname, but also a given name, or one of many geographic locations. June 2, 2017 Response to Office Action at 9-13. (Wikipedia.com).

In considering the marks, they are somewhat similar in sound and appearance since they share the common word “Allen,” but also dissimilar in sound and appearance due to the additional term “Ethan” and, to a limited extent, the generic term “Hotel.” As to connotation and commercial impression, the marks must be considered in their entireties, and when so compared, ETHAN ALLEN and ALLEN HOTEL take on different meanings and commercial impressions. In association with hotel services, ETHAN ALLEN suggests either the widely recognized historical figure, or a hotel emphasizing the Ethan Allen style aesthetic and containing Ethan Allen furnishings. *Cf. Philip Morris, Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB 1990) (PARK AVENUE represents a certain “upscale, affluent” imagery and style; mark is used to suggest a sophisticated aura linked to that street

associated with fashionable living in Manhattan). On the other hand, ALLEN HOTEL is reminiscent of a surname or a given name associated with a hotel. Consumers viewing the mark ETHAN ALLEN would see it as having the connotation of a hotel featuring ETHAN ALLEN furniture and design or associate it with the historical person. ALLEN HOTEL, on the other hand, would be perceived as the given name or surname of someone associated with the hotel.

Moreover, there is nothing in the record to support a finding that ALLEN HOTEL would be perceived as a variant of Registrant's ETHAN ALLEN mark. We find that the marks in their entirety convey overall different commercial impressions and that consumers would be able to differentiate the marks. The differences in connotation and commercial impression outweigh any similarities in sound and appearance. *See Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) (CRISTAL for champagne held not confusingly similar to CRYSTAL CREEK for wine); *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992) (VARGA GIRL for calendars held not confusingly similar to VARGAS for calendars). This *du Pont* factor weighs in Applicant's favor.

D. Conclusion on Likelihood of Confusion

We have considered all of the evidence and arguments relating to the *du Pont* factors, including those that have not been discussed, and conclude that in spite of services that are legally identical in part as well as overlapping channels of trade and potential purchasers, the marks are too dissimilar to warrant a determination of likely confusion. We consider the first *du Pont* factor dispositive in this case. *See*

Champagne Louis Roederer, 47 USPQ2d at 1460 (holding that Board did not err in deciding likelihood of confusion based solely on dissimilarity of marks regardless of other *du Pont* factors, that favored a likelihood of confusion, noting that “we have previously upheld Board determinations that one *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks”); *Kellogg Co. v. Pack’em Ents.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (upholding Board decision that “a single *duPont* factor – the dissimilarity of the marks – was dispositive of the likelihood of confusion issue,” observing “we know of no reason why, in a particular case, a single *duPont* factor may not be dispositive”).

The refusal to register under Section 2(d) is reversed.

III. Section 2(e)(2) Primarily Geographically Descriptive

We now turn to the Section 2(e)(2) refusal. The Examining Attorney issued this refusal after Applicant advised, in response to an information request, that services will be rendered “at the address 139-141 Orchard Street New York, NY 10002, physically located between Orchard and Allen Streets in New York City.” January 31, 2017 Response to Office Action at 8.

The test for determining whether a term is primarily geographically descriptive is whether (1) the primary significance of the term in the mark sought to be registered is the name of a place generally known to the public, (2) the public would make an association between the goods or services and the place named in the mark, that is, believe that the goods or services for which the mark is sought to be registered

originate in that place, and (3) the source of the goods or services is the geographic region named in the mark. See *In re Newbridge Cutlery Co.*, 776 F.3d 854, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015) (citing *In re Societe Generale Des Eaux Minerales De Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987)); *In re Miracle Tuesday, LLC*, 695 F.3d 1339, 104 USPQ2d 1330 (Fed. Cir. 2012); *In re Jacques Bernier, Inc.*, 894 F.2d 389, 213 USPQ 889 (Fed. Cir. 1990)).

The relevant public in the test is the purchasing public in the United States of the types of goods or services identified in the application. *In re Newbridge Cutlery*, 113 USPQ2d at 1449. The refusal applies “only to those marks for which the geographical meaning is perceived by the relevant public as the primary meaning and ... the geographical significance of the mark is to be assessed as it is used on or in connection with the goods [or services].” *Id.* at 1448.

A. Whether the primary significance of the term in the mark sought to be registered is the name of a place generally known to the public.

For this prong of the test, the Federal Circuit has explained that evidence “that the population of the location is sizable and/or that members of the consuming public have ties to the location ... is evidence that a location is generally known. By contrast, that the geographic meaning of a location is ‘minor, obscure [or] remote’ indicates that the location is not generally known. ... Of course, there are many probative factors to the question of whether a location is generally known.” *In re Newbridge Cutlery*, 113 USPQ2d at 1449.

Applicant’s applied-for mark ALLEN HOTEL must be evaluated as a whole. It is settled, however, that the primarily geographic significance of a term is not overcome

by the addition of a generic term. *In re Cheezwhse.com Inc.*, 85 USPQ2d 1917, 1920 (TTAB 2008) (affirming refusal of NORMANDIE CAMEMBERT for cheese); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 (TTAB 1998) (“CAROLINA APPAREL, APPAREL being generic and disclaimed by applicant, is geographic.”). In this case, “hotel” is a generic term for Applicant’s hotel accommodation services. November 28, 2016 Office Action at 5 (en.oxforddictionaries.com), see definition above.

The Examining Attorney’s evidence that ALLEN is a generally known geographic location consists of a portion of a map that shows “Allen St.” is a street in New York City and a photograph of a street image of Allen street (both google.com/maps), a Wikipedia entry (wikipedia.com) for “Allen Street,” an article from ny.curbed.com, and an article from boweryboogie.com, both of which discuss the “Allen Street Hotel.” April 19, 2017 Office Action at 2-17.

The Wikipedia article describes “Allen street” as a “street in the New York City borough of Manhattan that runs north-south through the Lower Manhattan neighborhood of Chinatown and the Lower East Side. ... The street is named after Brigadier General William Henry Allen, the youngest person to command a Navy Ship in the War of 1812.” *Id.* at 9. The entry indicates that “Allen street” was previously known by other names, and a 1979 New York magazine article described “Allen street” as an “unbusy area removed from the bustle of Grand Street and the Bowery.” *Id.* at 9, 11. In the earlier part of the 20th century, the street was populated by Romanian and Sephardic jews, and in 1903 rival gangs fought a gun battle beneath the elevated train tracks (since demolished) at Allen and Rivington streets. *Id.* at 9.

There was a tenement fire on Allen street in 1905. *Id.* The article from ny.curbed.com describes the hotel located “at 139-141 Orchard Street/139 Allen Street” as a “severely stalled hotel site ... originally purchased in 1999 Construction began but was never completed.” *Id.* at 14. The article at boweryboogie.com describes the hotel property as being on Orchard and Allen, with the property comprising 139-141 Orchard street. *Id.* at 13-14.⁷

Several non-geographic meanings for the term “Allen” are shown on Wikipedia pages for the entry “Allen” Applicant submitted. June 2, 2017 Response to Office Action at 9-13. (Wikipedia.com). Allen can refer to both a surname and a given name. *Id.* at 12. Allen refers to an American tool company well known for hex keys known as “Allen keys.” *Id.* at 11. Allen also identifies schools: Allen University, Allen Community College and Allen high school; and buildings: Allen Center in Houston, Texas, Allen Arena in Nashville, Tennessee, and Allen Fieldhouse, in Lawrence, Kansas. *Id.* at 11.

While not disputing that Allen Street is a geographic location, Applicant argues that Allen Street

is neither well known nor is Applicant’s Mark ALLEN STREET HOTEL—the mark is ALLEN HOTEL. “ALLEN” standing alone does not hold any independent significance, geographic or otherwise. And, even if it did hold such geographic significance, there are at least 25 geographic locations named “ALLEN” in the United States.

⁷ The same evidence was submitted with the final office action dated August 15, 2017, which was unnecessary and duplicative. Applicant also submitted the Wikipedia article relating to Allen Street in its September 17, 2017 Request for Reconsideration at 37-40, when it could have simply referenced the evidence submitted by the Examining Attorney to support its arguments.

4 TTABVUE 14. Applicant further argues that the record lacks substantial evidence to support the conclusion that ALLEN is generally known to the relevant public as a geographic location in New York City. *Id.* at 15.

The record supports Applicant's contention that there are numerous geographic locations named "Allen" in the United States. Places with the name "Allen" include locations in Alabama, Arizona, California, Kansas, Kentucky, Louisiana, Maryland, Michigan, Mississippi, Nebraska, New York, Oklahoma, South Dakota, Texas, West Virginia and Wisconsin. June 2, 2017 Response to Office Action at 9-10. Streets with the name Allen include Allen Parkway in Houston, "a major street," as well as Allen Street in New York City. *Id.* at 12. The abundance of other geographic locations with the name "Allen" distinguishes this case from *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 868 (Fed. Cir. 1985), in which the record contained only "a few other uses" of the relevant term, DURANGO, as a geographic name. Nor can we conclude from the record here that Applicant's own geographic location is the place most prominently associated with the name "Allen." *Cf. In re Cambridge Dig. Sys.*, 1 USPQ2d 1659, 1662 n.4 (TTAB 1986) (affirming refusal to register CAMBRIDGE DIGITAL where applicant conceded that its location, Cambridge, Mass., "can generally be considered the most well-known location in this country bearing the name 'Cambridge.'").

Considering the record as a whole, we are unconvinced that "Allen" primarily identifies a geographic location in New York City that is "known generally to the American purchasing public." *See Newbridge Cutlery*, 113 USPQ2d at 1450. We take

account of the Federal Circuit's guidance in *Newbridge Cutlery*, which reversed a Section 2(e)(2) refusal for lack of substantial evidence showing that Newbridge, Ireland was generally known to the relevant American public. *Id.* According to the court, although Internet evidence may be relied on to establish that a location is generally known, "the fact that Newbridge, Ireland, is mentioned on some internet websites does not show that it is a generally known location. The internet (and websites such as Wikipedia) contains enormous amounts of information: some of it is generally known, and some of it is not." *Id.* The Court also held that evidence of "other meanings, both geographical and non-geographical," rendered it less likely that the term is generally known as the name of a place. *Id.* at 1451.

In this case, the record reflects that Allen has non-geographic significance and can refer to numerous geographic locations. Additionally, the quantity and nature of the evidence regarding Allen Street in New York City does not establish that it is generally known to United States consumers. We lack persuasive evidence showing, for example, that Allen Street has a well-known historical significance, is a popular tourist destination, or has a widely recognized reputation for some other reason. Rather, we find a similarity to the situation in *Societe Generale des Eaux Minerales*, 3 USPQ2d at 1452, where the Court stated, "[t]here can be no doubt that the PTO has established that Vittel is in fact the name of a small town in the Voges mountain region of France ... but how many people in this country know that?"

We find the first prong of the inquiry under Section 2(e)(2), that the primary significance of the term in the mark sought to be registered is the name of a place generally known to the public, is not satisfied.

B. Conclusion on primarily geographic descriptiveness

Because the Examining Attorney has failed to prove the first prong of the test for a primarily geographically descriptive term, the Section 2(e)(2) refusal to register cannot stand and is reversed.

Decision: The Section 2(d) and Section 2(e)(2) refusals to register Applicant's mark ALLEN HOTEL are reversed.