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Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Win Win Asian Restaurant, LLC

Serial No. 88412518

Rory Weiner of Rory B. Weiner PA
for Win Win Asian Restaurant, LLC.

Seth Willig Chadab, Trademark Examining Attorney, Law Office 104,
Zachary Cromer, Managing Attorney.

Before Cataldo, Bergsman, and Johnson,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Win Win Asian Restaurant, LLC, seeks registration on the Principal Register of the mark WIN WIN ASIAN KITCHEN (in standard characters, “ASIAN KITCHEN” disclaimed), identifying “restaurant services” in International Class 43.¹

¹ Application Serial No. 88412518 was filed on May 2, 2019, based on Applicant’s assertion of April 7, 2019 as a date of first use of the mark anywhere and in commerce under Section 1(a) of the Trademark Act. 15 U.S.C. § 1051(a).

Page references to the application record are to the downloadable .pdf version of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board’s TTABVUE docket system.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with three cited registered marks, all owned by the same entity, including WIN WIN (in standard characters) identifying, inter alia, "take out restaurant services; restaurant services" in International Class 43.²

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

I. Evidentiary Matter

Before proceeding to the merits of the refusal, we address an evidentiary matter. Applicant did not submit any evidence during the prosecution of its involved application. In the evidence section of its brief, Applicant references "OAR of January 16, 2020" and evidence purportedly submitted therewith.³ However, Applicant's January 17, 2020 Response to Office Action does not include any evidence.⁴ In his

² Registration No. 5556062 issued on the Principal Register on September 4, 2018. The registration also recites goods and services in International Classes 4, 30, and 35.

³ Applicant's brief, 6 TTABVUE 9. It is the responsibility of the party making submissions to the Board via the electronic database to ensure that the evidence has, in fact, been properly made of record. See *In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 11512, *7 n.23 (TTAB 2019). Cf. *RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1805 n.16 (TTAB 2018); *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1350-51 (TTAB 2014); *Alcatraz Media v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1758 n.16 (TTAB 2013) ("the onus is on the party making the submissions to ensure that, at a minimum, all materials are clearly readable by the adverse party and the Board"); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) ("It is reasonable to assume that it is opposer's responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible and identified as to source and date.").

However, we note that Applicant did not refer to any of the purported exhibits in its response.

⁴ Applicant did not submit any response on January 16, 2020.

brief, the Examining Attorney noted that “the record shows no attachments to the January 17, 2020 Response to Office Action.”⁵ Applicant did not file a reply brief addressing this discrepancy.

Applicant subsequently attached evidence to its appeal brief that appears to correspond to the evidence purportedly submitted with its January 17, 2020 communication.⁶ Trademark Rule 2.142(d) reads as follows:

The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal. If the appellant or the examining attorney desires to introduce additional evidence after an appeal is filed, the appellant or the examining attorney should submit a request to the Board to suspend the appeal and to remand the application for further examination.

The evidence submitted with Applicant’s appeal brief is untimely and will not be considered.⁷ *See* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 1203.02(e), 1207.01, and authorities cited therein.

We turn now to the merits of this appeal.

II. Likelihood of Confusion

We base our determination of likelihood of confusion under Trademark Act Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the

⁵ Examining Attorney’s brief; 8 TTABVUE 4.

⁶ 6 TTABVUE 20-30.

⁷ The proper procedure for an applicant or examining attorney to introduce evidence after an appeal has been filed is to submit a written request with the Board to suspend the appeal and remand the application for further examination. *See* Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). *See also* TBMP § 1207.02 and authorities cited therein.

factors enunciated in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); see also *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019).

We have considered each *DuPont* factor that is relevant, and have treated other factors as neutral. See *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.”)); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“the various evidentiary factors may play more or less weighty roles in any particular determination”). Two key considerations are the similarities between the marks and the relatedness of the goods or services. See *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.”); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1672 (TTAB 2018).

For purposes of our likelihood of confusion determination, we will concentrate our discussion on cited Reg. No. 5556062 for the mark WIN WIN in standard characters identifying, inter alia, “take out restaurant services; restaurant services.” If likelihood of confusion is found as to the mark and services in this registration, it is unnecessary to consider the other cited registrations. Conversely, if likelihood of confusion is not found as to the mark and services in this registration, we would not find likelihood of confusion as to the mark and services in the other cited registrations.

A. The Services, Channels of Trade, and Classes of Customers

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration,” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Applicant’s “restaurant services” are identical to the “restaurant services” identified in cited Reg. No. 5556062.

Applicant argues that the owner of the cited registration provides as a core business a gas station and convenience store whose “primary business model is to attract customers who primarily want gasoline”⁸ whereas Applicant’s services “are only restaurant services.”⁹ Applicant reasons:

⁸ 6 TTABVUE 16.

⁹ *Id.*

To find that the services are “identical”, as the Examining Attorney does, requires plucking “restaurant services” from the Registrant’s incidental or secondary services and elevating them to primary or fundamental services, which they are clearly not, and then use these mischaracterized services as a comparison for the Applicant’s mark. That move is not a way to show related services; it is a way to show you can make services related.¹⁰

Applicant is mistaken. It is long settled that likelihood of confusion is determined on the basis of the goods as they are identified in the application and registration at issue. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976); *see also Octocom Systems*, 16 USPQ2d at 1787 (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed”). In this case, the cited Reg. No. 5556062 identifies “restaurant services” without limitation or qualification related to its other identified goods and services, and the identification of services in this registration remains unchallenged.¹¹

¹⁰ 6 TTABVUE 18.

¹¹ An applicant for a trademark registration may file for registration in more than one class by filing a single application. *See* Trademark Rule 2.86, 37 C.F.R. § 2.86. A multiple-class application can be viewed as a series of applications for registration of a mark in connection with goods or services in each class, combined into one application. As a general matter, the filer of such an application is in the same position it would be had it filed several single-class applications instead. *G & W Labs. Inc. v. GWPharma Ltd.*, 89 USPQ2d 1571, 1573-74 (TTAB 2009). *See also Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 28 (CCPA 1976); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224, 1226 (TTAB 1987); *Electro-Coatings, Inc. v. Precision Nat’l Corp.*, 204 USPQ 410, 420 (TTAB 1979).

In addition, where services are broadly identified in an application or registration (i.e., restaurant services), “we must presume that the services encompass all services of the type identified.” *Sw. Mgmt., Inc. v. Ocinoled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (where the services in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein), *quoted in In re Country Oven, Inc.*, 2019 USPQ2d 443903, * 4 (TTAB 2019) and *cited in In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, *11-12 (TTAB 2020). Thus, the broadly worded identification of “restaurant services” necessarily encompasses all types of restaurant services, including restaurants affixed to gas stations. *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.’”). Thus, the Examining Attorney properly found the “restaurant services” recited in Reg. No. 5556062 identical to the services in the involved application.

Furthermore, because the services in the application and cited Reg. No. 5556062 are identical, there is no need for us to further consider the relatedness of Applicant’s services with the other goods and services identified in the cited registrations. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 938-39 (Fed. Cir. 1983) (holding that a single good from among several may sustain a finding of likelihood of confusion); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be

confusion with respect to any item that comes within the identification of goods or services in the application).

The third *DuPont* factor concerns “[t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1161 (quoting *DuPont*, 177 USPQ at 567). Inasmuch as the “restaurant services” identified in the application and the cited Reg. No. 5556062 are identical, we must presume that the channels of trade and classes of purchasers for these services are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). Thus, we are not persuaded by Applicant’s arguments that “Registrant caters to drivers; the Applicant caters to diners.”¹² *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) (“Given the in-part identical and in-part related nature of the parties’ goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade”); *In re Smith & Mehoffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers”). *See also Octocom Sys.*, 16 USPQ2d at 1787 (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the

¹² *Id.*

particular channels of trade or the class of purchasers to which the sales of goods are directed.”).

We find that the identity of the services, and their presumed overlapping channels of trade and consumers weigh heavily in favor of likelihood of confusion.

B. The Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Applicant’s WIN WIN ASIAN KITCHEN mark and Registrant’s WIN WIN mark in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1160; *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014); accord *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted). *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018). “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) (internal quotation marks omitted). See also *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470

(TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016). Consumers may not necessarily encounter the marks in close proximity and must rely upon their recollections thereof over time. *In re Mucky Duck Mustard*, 6 USPQ2d 1467, 1468 (TTAB 1988).

Applicant's applied-for WIN WIN ASIAN KITCHEN mark adopts the wording of the registered mark WIN WIN in its entirety, adding the following term "ASIAN KITCHEN." "Marks have frequently been found to be similar where one mark incorporates the entirety of another mark, as is the case here." *Coca-Cola Bottling Co. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105, 106 (CCPA 1975) (BENGAL is similar to BENGAL LANCER); *Johnson Publ'g Co. v. Int'l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (EBONY is similar to EBONY DRUM); *In re S. Bend Toy Mfg. Co.*, 218 USPQ 479, 480 (TTAB 1983) (LIL' LADY BUG is similar to LITTLE LADY). Both marks appear in standard characters and therefore we must consider all reasonable presentations of those marks, including their presentation in the same stylization. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000) ("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce"); *In re Cox Enterprises Inc.*, 82 USPQ2d 1040, 1044 (TTAB 2007) ("We must also consider that applicant's mark, presented in typed or standard character form, is not limited to any special form or style as displayed on its goods.").

We find that the term WIN WIN in Applicant's WIN WIN ASIAN KITCHEN mark is the most distinctive portion thereof. The disclaimed term ASIAN KITCHEN

appears, at best, to describe a feature or characteristic of Applicant's "restaurant services." With regard to the term WIN WIN, Applicant argues:

One meaning that is the same for both marks compared in their entirety is a "win-win game" or a "no lose situation." However "Win Win" has a second meaning in front of "Asian Kitchen." In front of "Asian Kitchen," "win win" connotes a specific type of Asian Kitchen as if the wording has been transliterated from the original Asian language.¹³

However, Applicant does not further explain the asserted second meaning of WIN WIN in Applicant's mark, and no definition is of record. Accordingly, we have no basis to find that WIN WIN possesses a meaning in Applicant's mark that differs from the commonly understood connotation of a situation wherein everyone wins and no one loses. Used in connection with identical restaurant services, we find that WIN WIN will not have a separate, distinguishable connotation in Applicant's WIN WIN ASIAN KITCHEN mark from the registered WIN WIN mark. Thus, Applicant's mark connotes an Asian kitchen or restaurant where everyone wins and no one loses. The registered WIN WIN mark carries similar connotations in connection with its restaurant services. As a result, the marks are highly similar in meaning or connotation.

Furthermore, we note that WIN WIN, the term comprising the registered mark and the only distinctive word element in Applicant's mark, is also the first word thereof. *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("[it is] a matter of some importance since it is often the first part of a mark

¹³ 6 TTABVUE 14.

which is most likely to be impressed upon the mind of a purchaser and remembered.”). *See also Palm Bay Ims.*, 73 USPQ2d at 1692 (“The presence of this strong distinctive term as the first word in both parties’ marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of ROYALE.”).

We acknowledge that the presence of ASIAN KITCHEN as the following term in Applicant’s mark differentiates it visually and aurally from the registered mark. This point of distinction, however, does not significantly diminish the strong similarities in connotation and overall commercial impression engendered by these two marks. Based upon the above analysis, we find that WIN WIN ASIAN KITCHEN is more similar than dissimilar to the WIN WIN mark in terms of appearance, sound, connotation, and commercial impression. As a result, consumers encountering WIN WIN and WIN WIN ASIAN KITCHEN could mistakenly believe the latter is a variation on the registered mark used to identify a particular type of restaurant, but nonetheless emanating from a common source. *See In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1961 (TTAB 2016) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring) (“the users of language have a universal habit of shortening full names—from haste or laziness or just economy of words”)).

This is especially the case because, “[w]hen marks would appear on virtually identical ... services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines.” *See Century 21 Real Estate Corp. v. Century*

Life of Am., 23 USPQ2d 1698, 1799, (Fed. Cir. 1992). See also *ECI Division of E-Systems, Inc. v. Environmental Commc'ns. Inc.*, 207 USPQ 443, 449 (TTAB 1980).

For these reasons, we find that the marks are similar. The first *DuPont* factor thus also weighs in favor of finding a likelihood of confusion.

C. Conclusion

When we consider the record and the relevant likelihood of confusion factors, and all of Applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that consumers familiar with Registrant's "restaurant services" offered under its WIN WIN mark would be likely to believe, upon encountering Applicant's proposed WIN WIN ASIAN KITCHEN mark, that the identical services originated with or are associated with or sponsored by the same entity.

Decision: The refusal to register Applicant's proposed mark is affirmed under Section 2(d) of the Trademark Act as to the cited Reg. No. 5556062.