

This Opinion is Not a
Precedent of the TTAB

Mailed: April 15, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Golden Coffee, LLC

Serial No. 88577515
—

Paul W. Kruse of Bone McAllester Norton PLLC
for Golden Coffee, LLC.

Kerry A. Nicholson, Trademark Examining Attorney, Law Office 120,
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Before Zervas, Wellington, and English
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Golden Coffee, LLC (“Applicant”) seeks registration on the Principal Register of

the mark **STAY
GOLDEN** COFFEE CO. (“COFFEE CO.” disclaimed) for “bagged coffee sold to
wholesale consumers by the pound” in International Class 30.¹

¹ Application Serial No. 88577515; filed August 13, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use and first use in commerce on August 13, 2018.

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the standard character mark STAY GOLDEN for services in International Classes 41 and 43, the most pertinent of which are “restaurant services; café services” in International Class 43.²

When the refusal was made final, Applicant appealed. After Applicant filed its appeal brief, the Examining Attorney requested remand to submit additional evidence in support of the Section 2(d) refusal.³ The Board granted the request and suspended the appeal. The Examining Attorney issued “a new final Office action” with additional evidence.⁴ The appeal resumed, and Applicant was allowed time to file a supplemental appeal brief, but did not do so. The Examining Attorney filed a brief. No reply brief was filed.

We affirm the refusal to register.

I. Analysis

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. DuPont de Nemours & Co*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co. Inc.*, 315

² Registration No. 5074859; registered November 1, 2016.

³ After the refusal was made final, the application was reassigned to the Examining Attorney who requested remand and handled the appeal.

⁴ May 5, 2020 New Final Office Action, TSDR 7.

F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor for which there is argument and evidence. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc'ns., Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *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.”).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods and/or services. *See In re Chatam Int'l Inc.*, 380 F.3d 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.”); *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 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)). We discuss these factors and the other relevant *DuPont* factors below.

A. Similarity of the Goods and Services, Channels of Trade and Classes of Consumers

We focus our analysis on Registrant’s “restaurant services; café services” as these are most pertinent to Applicant’s goods. A likelihood of confusion may be found “if the

goods and services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider.” *In re Azteca Rest. Enters. Inc.*, 50 USPQ2d 1209, 1210-11 (TTAB 1999); *see also Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012).

Certainly, coffee is featured in restaurants and cafes. There is no per se rule that food or beverage products and restaurant/café services are related.⁵ *In re Azteca Rest. Enters.*, 50 USPQ2d at 1210. Rather, “something more” is necessary to demonstrate relatedness. *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1087 (Fed. Cir. 2014) (the “something more” standard “has application whenever the relatedness of the goods and services is not evident, well-known or generally recognized”).

To establish “something more,” the Examining Attorney introduced printouts from third-party websites showing 12 entities using the same mark for coffee sold to wholesale consumers on the one hand and café/restaurant services on the other:⁶

- 8&R COFFEE CO.

⁵ We have not considered Applicant’s assertion that Registrant’s “restaurant and café services [are] offered incidental” to Registrant’s hotel services (4 TTABVUE 2-3, 8) because the cited registration does not include any such limitation. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *M2 Software, Inc.*, 78 USPQ2d at 1947 (“we consider the applicant’s goods as set forth in its application, and the opposer’s goods as set forth in its registration”).

⁶ May 5, 2020 New Final Office Action, TSDR 8-96; January 3, 2020 Final Office Action, TSDR 23-36; November 16, 2019 Office Action, TSDR 29-36.

- BLUESTONE LANE
- CRIMSON CUP
- CAFÉ GRUMPY
- INTELLIGENTSIA
- JERSEY SHORE COFFEE ROASTERS
- MOBJACK BAY COFFEE ROASTERS
- RED ROOSTER;
- SQ1;
- WAKE;
- STONEWALL KITCHEN and COASTAL MORNING COFFEE; and
- ZINGERMAN'S

This evidence shows that bagged coffee sold to “wholesale consumers” and café/restaurant services are the types of goods and services that emanate from a common source. *See, e.g., Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis”); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355-56 (TTAB 2015) (relatedness found where Internet evidence demonstrated goods commonly emanated from the same source under a single mark).

The Examining Attorney also submitted 17 use-based, third-party registrations owned by different entities identifying both coffee and restaurant/café services. The registrations do not specify that the coffee is sold to wholesale consumers or that it is

bagged, but there are no limitations in the registrations that exclude wholesale consumers and coffee in bags and we must presume that the coffee may be bagged and that the entities offer their coffee to all ordinary consumers for such goods, including wholesale consumers. While the third-party registrations are not evidence that the registered marks are in use or that the public is familiar with them, they have some probative value to the extent they serve to suggest that the goods and services listed in the registrations are of a kind that may emanate from a single source. *In re Aztec Rest. Enters.*, 50 USPQ2d at 1211 (ten third-party registrations covering both restaurant services and food items, five of which specified Mexican food items, found probative of the relatedness between restaurant services and applicant's Mexican food items); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

Based on the third-party uses and registrations, we find the requisite “something more” establishing that Applicant’s “bagged coffee sold to wholesale consumers by the pound” and Registrant’s restaurant and café services are commercially related.

Applicant argues that there is no likelihood of confusion because the goods and services “are directed to different audiences (i.e. retail resort services v. wholesale food distributors) via different channels of trade (i.e. resort services sold directly to guests v. bagged coffee sold to wholesale consumers by the pound to middlemen who in turn sell to their customers, namely, other retailers).”⁷ Professor McCarthy has

⁷ Appeal Brief, 4 TTABVUE 6. Applicant’s characterization of its goods is narrower than the goods identified in the application. Also, as noted, we focus our likelihood of confusion analysis on Applicant’s restaurant/café services as opposed to its resort hotel services.

stated that where one entity sells exclusively at retail to the general public and the other sells exclusively to wholesale consumers, there may be little likelihood of confusion if the wholesale product does not reach the retail consumer under the mark. 4 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:51 (5th ed. March 2021 update).

The record shows that wholesale consumers of coffee include coffee shops, cafés, restaurants, caterers, hotels, offices, and hospitals as well as coffee retailers that resell coffee to the general public.⁸ The fact that Applicant’s coffee is “bagged” and sold “by the pound” reflects an intent that Applicant’s wholesale consumers resell Applicant’s bagged coffee bearing Applicant’s mark to the general public. Indeed, it appears from Applicant’s specimen (below) that Applicant’s “bagged coffee” sold “by the pound” is ultimately offered to the general public in retail stores.⁹

⁸ May 5, 2020 New Final Office Action, TSDR 9, 23-25, 38-39, 90. A third-party named Wake Coffee lists its “wholesale partners” as coffee shops, bakeries, cafes, restaurants, grocery stores, and offices.

Wholesale is defined as “the selling of goods in relatively large quantities and usually at lower prices than at retail, esp. such selling to retailers for resale to consumers.” <https://www.collinsdictionary.com/dictionary/english/wholesale> (Collins Dictionary, American English definition, last visited April 14, 2021). We take judicial notice of this definition. 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 regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

⁹ August 13, 2019 Specimen, TSDR 2. 8&R coffee, one of the above-noted third-party coffees sold to wholesale consumers such as retail stores, is also shown in Applicant’s specimen on the bottom shelf further supporting that wholesale consumers of coffee in turn sell the same goods they purchased wholesale, to retail consumers.



Accordingly, notwithstanding that Applicant sells its product to “wholesale consumers,” Applicant’s specimen shows that Applicant’s “bagged coffee” sold “by the pound” may be encountered by the same general consuming public as Registrant’s restaurant and café services. *In re Revillon*, 154 USPQ 494, 495 (TTAB 1967) (“The fact, as asserted by applicant, that applicant presently sells her merchandise only at retail whereas the registrant is a large wholesale concern is of no particular significance for neither the registrations nor the subject application contain any

restriction as to the manner in which the respective goods are marketed; **and** whether sold at retail or at wholesale, the goods of the parties reach the ultimate purchasers bearing their respective trademarks.”) (emphasis added); *Cf. In re Albert Trostel*, 29 USPQ2d at 1786 (“What is missing from the record is convincing evidence that finished products of this nature [luggage, attaché cases, portfolio briefcases, and handbags] commonly carry not only the trademark of their manufacturer but also the trademark of the producer of the leather from which they are made” such that “the ultimate purchasers of registrant’s goods are likely to encounter applicant’s mark as well as registrant’s.”). In other words, in this particular case, the “wholesale consumer” limitation in Applicant’s identification of goods is not a meaningful limitation for purposes of likelihood of confusion because the record shows that Applicant’s “wholesale consumers” include grocery stores that sell Applicant’s “bagged coffee” bearing Applicant’s mark to the general consuming public who are also purchasers of Registrant’s restaurant/café services. *See In re i.am.symbolic*, 123 USPQ2d at 1748 (“the will.i.am restriction does not impose a meaningful limitation in this case for purposes of likelihood of confusion analysis.”).

B. Sophistication of the Purchasers

Applicant argues that the relevant consumers are sophisticated: “It is obvious that users of [Registrant’s] resort services will exercise a high degree of care because of the importance of using a resort provider with desirable services and amenities” and

because of the “sizeable” cost of such services.¹⁰ “All the same can be said” of Applicant’s “bagged coffee sold to wholesale consumers by the pound.”¹¹

As explained, in assessing whether there is a likelihood of confusion, we focus on Registrant’s “restaurant services; café services” rather than Registrant’s “resort hotel services.” Moreover, we must consider the least sophisticated purchaser. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (the standard of care is that of the least sophisticated potential purchaser). We must presume that Registrant’s “restaurant services; café services” include “grab-and-go” and fast-food restaurants likely to be frequented by an ordinary consumer without the exercise of great care in purchasing decisions. Similarly, the record reflects that Applicant’s goods bearing Applicant’s mark reach the ordinary retail consumer of coffee and there is no evidence that such a consumer would exercise particular care in making a purchasing decision. *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984) (finding tea a “relatively inexpensive, comestible good[] subject to frequent replacement” and that “[p]urchasers of such products have been held to a lesser standard of purchasing care”). To the extent that purchasers of goods as described by Applicant are wholesale consumers, we note that even sophisticated wholesale consumers would not be immune to trademark confusion. *Top Tobacco, L.P. v. North Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011) (“While we agree that it stands to reason that

¹⁰ Appeal Brief, 4 TTABVUE 7.

¹¹ *Id.*

wholesale buyers should be accorded a higher degree of purchaser sophistication over the general public in terms of determining susceptibility to confusion, we have often noted that even consumers who exercise a higher degree of care are not necessarily knowledgeable regarding the trademarks at issue, and therefore immune from source confusion.”); *see also, e.g., In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (“even sophisticated purchasers can be confused by very similar marks”); *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (“That the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods. Human memories even of discriminating purchasers ... are not infallible.”) (internal quotations and citation omitted).

For these reasons, the sophistication of the relevant purchasers is neutral.

C. Similarity of the Marks

We consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Stone Lion*, 110 USPQ2d at 1160; *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

The issue is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression such that confusion as to the source of the goods

and services offered under the respective marks is likely to result. *Coach Servs.*, 101 USPQ2d at 1721. We do not predicate our analysis on a dissection of the involved marks; we consider the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1160; *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.”). But one feature of a mark may be more significant than another, and it is not improper, for rational reasons, to give more weight to a dominant feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1161 (finding that the Board did not err in reasoning that the term LION was dominant in both applicant’s mark STONE LION CAPITAL and opposer’s marks LION CAPITAL and LION); *In re Chatam Int’l*, 71 USPQ2d at 1946.

While there is no rule that a likelihood of confusion is present where one mark encompasses another, in this case, the fact that Applicant’s mark includes the entirety of the cited mark increases the similarity between them. *See, e.g., In re Mighty Tea Leaf*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant’s mark ML is similar to registrant’s mark ML MARK LEES); *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (finding CALIFORNIA CONCEPT marks substantially similar to prior mark CONCEPT); *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, *6-7 (TTAB 2019) (finding likelihood of confusion where respondent’s mark ROAD WARRIOR encompassed petitioner’s mark WARRIOR in its entirety); *In re Toshiba Med. Sys.*

Corp., 91 USPQ2d 1266, 1271 (TTAB 2009) (finding applicant's mark VANTAGE TITAN confusingly similar to registered mark TITAN); *In re U.S. Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (finding applicant's CAREER IMAGE marks similar to registered mark CREST CAREER IMAGES).

The additional phrase "COFFEE CO." in Applicant's mark is generic for Applicant's goods and has been disclaimed. *See, e.g., In re Detroit Athletic Co.*, 128 USPQ2d at 1050 (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression"). Also, "STAY GOLDEN" is the first portion of Applicant's mark and it is displayed in significantly larger font than the generic words "COFFEE CO." *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered[.]"); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006). For these reasons, "STAY GOLDEN" is the dominant portion of Applicant's mark and most likely to be remembered by consumers.

Applicant argues that the marks have different commercial impressions asserting that its mark "suggests bagged coffee of a golden flavor and hue" while Registrant's mark "used in connection with resort hotel services (including restaurant and café services offered incident thereto) ... suggests something entirely different, namely,

an unparalleled, high-end and extravagant resort experience in the warmth of the California sun.”¹² In support of its position, Applicant points to Registrant’s specimen an excerpt of which is set forth below:¹³



GOLDEN ISN'T A COLOR,
IT'S A FEELING.

Golden is inspired by the warmth of the California sun and the feeling that the world is smiling upon you. And maybe even giving you a wink. Each property in the Meritage Collection reflects this unique state of mind, one that is inspired by the effortless bliss, natural beauty and unexpected adventure found at each of our unique resorts.

LUXURY PROPERTIES.
CALIFORNIA SOUL.

The Meritage Collection blends iconic, one-of-a-kind places with locally inspired enrichment programs designed for the curious traveler. A uniquely laid-back approach to the good life reflects our warm, sunshine-soaked California roots.

S T A Y G O L D E N™

¹² Appeal Brief, 4 TTABVUE 3-4.

¹³ *Id.* at 4; *see also* December 12, 2019 Office Action Response, TSDR 21.

The record, however, shows that the marks have similar connotations. “Stay golden” means “to not let all the troubles of life overshadow the simply joys.”¹⁴ Both Applicant and Registrant promote this general concept in relation to their respective goods and services. As shown above, Registrant promotes “[a] uniquely laid-back approach to the good life” and “the feeling that the world is smiling on you.” Similarly, Applicant’s packaging (below) bears a seal with the words “STAY GOLDEN COFFEE CO. NASHVILLE” encircling the phrase “GOOD VIBES,” which means a positive distinctive feeling thus conveying that its coffee produces a good or positive feeling.¹⁵

¹⁴ Urbandictionary.com, January 3, 2020 Final Office Action, TSDR 18.

Applicant makes a passing argument that the cited mark is “*not* a strong and arbitrary mark,” 4 TTABVUE 8, but the definition of “STAY GOLDEN” does not support this assertion and there is no other evidence in the record that the cited mark is weak.

¹⁵ August 13, 2019 Specimen, TSDR 1.

We take judicial notice that “vibe” means “a distinctive feeling or quality capable of being sensed.” <https://www.merriam-webster.com/dictionary/vibe> (Merriam-Webster Dictionary, last visited April 14, 2021).



Accordingly, the marks engender an overall similar commercial impression of feeling good that both Applicant and Registrant promote in their marketing.

**STAY
GOLDEN**
COFFEE CO.

It also is significant that Applicant's mark **STAY GOLDEN COFFEE CO.** encompasses the cited mark in its entirety. The record shows it is not uncommon for restaurants to sell pre-packaged coffee under the name of their restaurant or café.¹⁶ Accordingly, it is likely

¹⁶ November 19, 2019 Office Action, TSDR 10-36, 44-55; January 3, 2020 Final Office Action, TSDR 23-58, 65-73.

that consumers familiar with Registrant's mark who encounter Applicant's mark will perceive it as identifying coffee associated with Registrant's STAY GOLDEN restaurants and cafés. *In re Opus One Inc.*, 60 USPQ2d 1812, 1816 (TTAB 2001) (consumers aware that restaurants sell private-label wine named after themselves “are more likely to assume, upon encountering a wine and a restaurant bearing the same mark, that the wine is the restaurant's private label wine or that some other source connection between the wine and the restaurant exists”); *In re Mucky Duck*, 6 USPQ2d at 1469 (“[W]e think it is common knowledge that restaurants sometimes market their house specialties, including items such as salad dressings, through retail outlets.”).

In view of the foregoing, we find that the marks, in their entirety, are substantially similar in overall appearance, sound, connotation and commercial impression and this supports a finding of likely confusion.

II. Conclusion

“As we have long held, each case must be decided on its own facts and the differences are often subtle ones.” *In re St. Helena Hosp.*, 113 USPQ2d at 1087. Here, the marks are substantially similar overall in appearance, sound, connotation and commercial impression and the goods and services are related. The restriction in Applicant's identification that its “bagged coffee” is “sold to wholesale consumers” is not sufficient to preclude confusion because the record shows that Applicant's “wholesale consumer” includes grocery stores that resell Applicant's bagged coffee bearing Applicant's mark to the general consuming public who are also purchasers of

Registrant's restaurant and café services. Accordingly, Applicant's mark

**STAY
GOLDEN**
COFFEE CO

for "bagged coffee sold to wholesale consumers by the pound" is likely to cause confusion with Registrant's mark STAY GOLDEN for "restaurant services; café services."

Decision: The refusal to register Applicant's mark under Section 2(d) of the Trademark Act is affirmed.