

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: December 12, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Cxffeeblack LLC
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Application Serial No. 90109203
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William A. Wooten of Wooten Law Office,
for Cxffeeblack LLC.

Michael Eisnach, Trademark Examining Attorney, Law Office 104,
Zachary Cromer, Managing Attorney.

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Before Bergsman, Shaw, and Lynch,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Cxffeeblack LLC (“Applicant”) seeks registration on the Principal Register of the
mark GUJI MANE (in standard characters) for the goods listed below:

Mugs; Coffee cups; Coffee cups, tea cups and mugs; Coffee
mugs; Cups and mugs, in International Class 21;

Sweatshirts; T-shirts; Athletic apparel, namely, shirts,
pants, jackets, footwear, hats and caps, athletic uniforms;
Graphic T-shirts; Hooded sweatshirts; Short-sleeved or
long-sleeved t-shirts, in International Class 25; and

Coffee; Coffee beans; Ground coffee beans; Roasted coffee beans; Unroasted coffee, in International Class 30.¹

Applicant disclaims the exclusive right to use the word “Guji.”

The Examining Attorney refused, in part, to register Applicant’s mark as to the goods in International Class 30 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 GUJI, in standard characters, for “coffee,” in International Class 30, as to be likely to cause confusion.²

I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter. Applicant, in its brief, cites website links (URLs) and refers to what the content of the websites purportedly demonstrates vis-à-vis the likelihood of confusion refusal.³ Applicant did not attach copies of the websites identified by the URLs.

¹ Application Serial No. 90109203 was filed on August 12, 2020. Applicant filed the application for the goods in International Classes 21 and 30 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere since at least June 6, 2019 and use in commerce since at least as early as June 30, 2019 for the products in both classes.

Applicant filed for the application for the goods in International Class 25 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s asserted bona fide intention to use the mark in commerce.

When we cite to the prosecution history record, we refer to the USPTO Trademark Status and Document Retrieval (TSDR) system. When we cite to the briefs, we refer to TTABVUE, the Board’s online docket system.

² Registration No. 5365155, issued December 26, 2017.

³ Applicant’s Brief, pp. 7-9 (6 TTABVUE 8-10).

The Examining Attorney objects to the URLs because such evidence was not timely filed in accordance with Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d) (the record in an application should be complete prior to the filing of an appeal).⁴

Applicant's Appeal Brief includes the reference to evidence that is not of record. Specifically, the Appeal Brief includes URLs for a number of websites and describes the contents allegedly therein.⁵

Applicant, in its Reply Brief, responds that "all relevant evidence included in Applicant's appeal brief was previously provided to the Examining Attorney through Applicant's responses to Office Actions."⁶

We list below the URLs to websites to which Applicant cites and indicate to what extent and where they appear in the record:

- Registrant's Twitter page (twitter.com/dufsar). Applicant cited this URL in its March 22, 2022 Request for Reconsideration (TSDR 6). Applicant did not submit a screenshot from this URL;

- Registrant's Facebook page (facebook.com/dufsar/ and facebook.com/BekamaCoffee/?ref=page_internal). Applicant cited these URLs in its March 22, 2022 Request for Reconsideration (TSDR 6). Applicant did not submit a screenshot from these URLs;

- An Amazon.com webpage (<http://dufsar.com/?fbclid=IwAR19SH68kVJIWkCunz4aBTnpBHDIRTpTtimGiOt0i2aJ2CB0Xj8mF2QrdnQ>) for Registrant's product.

⁴ Examining Attorney's Brief (8 TTABVUE 3-4).

⁵ *Id.* at TSDR 3.

⁶ Applicant's Reply Brief, p. 5 (9 TTABVUE 6).

Applicant cited this URL in its March 22 2022 Request for Reconsideration (TSDR 6).

Applicant did not submit a screenshot from this URL;

- Applicant's website (cxffeeblack.com/collections/guji-mane-coffee). The Examining Attorney submitted a screenshot from this website in his December 14, 2020 Office Action (TSDR 30-32). In addition, Applicant submitted a screenshot from this website in its June 14, 2021 Response to an Office Action (TSDR 18 and 20-23) and cited to the URL in its March 2, 2022 Request for Reconsideration (TSDR 6);

- Applicant's Facebook page (facebook.com/Cxffeeblack-215834112589234). Applicant cited this URL in its March 22, 2022 Request for Reconsideration (TSDR 7). Applicant did not submit a screenshot from this URL;

- Applicant's Instagram account (Instagram.com/cxffeeblack/?hl=en). Applicant cited this URL in its March 22, 2022 Request for Reconsideration (TSDR 7). Applicant did not submit a screenshot from this URL;

- Applicant's Twitter account (twitter.com/cxffeeblack?ref). Applicant cited this URL in its March 22, 2022 Request for Reconsideration (TSDR 7). Applicant did not submit a screenshot from this URL;

- The "Guji" entry posted on Wikipedia.org. Applicant cited the link to this Wikipedia.org entry in its June 14, 2021 Response to an Office Action (TSDR 11). Applicant did not submit a screenshot of the actual webpage; and

- Trabocca.com website. The Examining Attorney submitted a screenshot from this website in his December 14, 2020 Office Action (TSDR 16-19).

Links to websites are not admissible evidence. Providing only the link without the underlying material attached is not sufficient to introduce the material into the record. *In re ADCO Indus. – Technologies, L.P.*, 2020 USPQ2d 53786, at *2 (TTAB 2020) (web addresses or hyperlinks are insufficient to make the underlying webpages of record); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1195 n.21 (TTAB 2018) (Board does not consider websites for which only links are provided); *In re Olin Corp.*, 124 USPQ2d 1327, 1332 n.15 (TTAB 2017) (“Because the information displayed at a link’s Internet address can be changed or deleted, merely providing a link to a website is insufficient to make information from that site of record.”); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1462 n.8 (TTAB 2017) (providing only a web address or hyperlink is insufficient to make such materials of record).

When making Internet evidence part of the record, the examining attorney or applicant must provide (1) an image of the webpage, (2) the date the evidence was downloaded or accessed from the Internet, and (3) the complete URL address. *See In re ADCO Indus.-Techs., L.P.*, 2020 USPQ2d 53786, at *2 (citing *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018)); *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1587 (TTAB 2018). If either party fails to satisfy the requirements for submission of Internet evidence, and the other party objects, the Internet material will not be considered. *See Mueller Sports Med.*, 126 USPQ2d at 1587.

An examining attorney must object to improperly submitted Internet evidence in the first Office action following the submission of the evidence and advise the applicant how to properly make the Internet evidence of record. *See Mueller Sports*

Med., 126 USPQ2d at 1587. Otherwise, the Board may consider the objection to be waived. *Id.*; cf. *In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1594 n.40 (TTAB 2014) (objection waived where examining attorney, in a continuing refusal, failed to advise applicant that mere listing of third-party registrations was insufficient to make them of record). In addition, if the applicant appeals, the examining attorney's appeal brief must indicate that the objection to the improperly submitted evidence is continued, or else the Board has the discretion to consider it. *See I-Coat Co.*, 126 USPQ2d at 1733 (citing *Mueller Sports Med.*, 126 USPQ2d at 1587).

In this appeal, because Applicant cited to these URLs during prosecution and the Examining Attorney failed to timely object to Applicant's reference to the URLs without copies of the associated webpages, he waived the objection. However, where the only evidence is a URL without a copy of the associated webpage, there is nothing for us to consider anyway.

Finally, evidence should not be attached to briefs, and we will not consider the exhibits Applicant attached to its Reply Brief unless they were properly made of record during the prosecution of the application at issue.⁷

II. Likelihood of Confusion

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used

⁷ Applicant's Reply Brief (9 TTABVUE 14-20).

on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1533).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). “Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because 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 Embiid*, 2021 USPQ2d 577, at *10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). 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)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004).

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

Applicant is seeking to register its mark for, inter alia, coffee, and the mark in the cited registration is registered for coffee. Thus, the goods are in part identical. Applicant does not dispute that the goods are in part identical.

Under this *DuPont* factor, the Examining Attorney need not prove, and we need not find, similarity as to each product listed in the description of goods. It is sufficient for a refusal based on likelihood of confusion that we find any item encompassed by the identification of goods in a particular class in the application and registration related. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at *3-4 (TTAB 2020); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff’d* 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *In re Aquamar, Inc.*, 115 USPQ2d 1122,

1126 n.5 (TTAB 2015) (“[I]t is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application.”).

B. Established, likely-to-continue channels of trade and classes of purchasers

Because the goods described in the application and the cited registration are in part identical, we presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers) (cited in *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (“With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and ‘presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods....”))).

C. The strength of the mark in the cited registration

The strength of Registrant’s mark affects the scope of protection to which it is entitled. Thus, we consider the inherent or conceptual strength of Registrant’s mark based on the nature of the mark itself and its commercial strength based on marketplace recognition of the marks. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength.”); *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *Top*

Tobacco, L.P. v. N. Atlantic Operating Co., Inc., 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (market strength is the extent to which the relevant public recognizes a mark as denoting a single source); 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. September 2022 update) (“The first enquiry is for conceptual strength and focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”).

The Examining Attorney required Applicant to disclaim the exclusive right to use the word “Guji” because “it is primarily geographically descriptive of the origins of applicant’s goods in International Class 30.”⁸ The Examining Attorney submitted webpages from the websites listed below showing that “Guji” is a geographic place known for coffee:

- Trabocca.com website referring to “Guji” “as a coffee region”;⁹
- Volcanica Coffee Company website (volcanicacoffee.com) advertising Ethiopian

Guji Coffee.¹⁰ The website provides the following information:

⁸ December 14, 2020 Office Action (TSDR 4).

⁹ *Id.* at TSDR 16. The copies of the Trabocca.com webpage the Examining Attorney submitted has popups that block a significant portion of the text making the webpage less probative than it could have been. Nevertheless, from the what we can tell from the readable portions of the webpage, it appears that Guji is a region in Ethiopia. *Id.* at TSDR 17.

¹⁰ *Id.* at TSDR 20.

Ethiopian Guji coffee is from the Kayon Mountain Coffee Farm located in the Cromia region, in the Guji zone of Shakiso district of Ethiopia.¹¹

- Tropiq website (tropiq.no) states that Guji is a zone and an administrative area that produces “amazing coffees.”¹² According to the website, “Guji covers a huge area and they are producing more specialty coffees than ever before.”¹³

- Ethnos Coffee Roasters website (ethnos.coffee/products) advertising Guji Mane coffee describing it as “from the Guji region of Ethiopia.”¹⁴

Because Guji is a geographical region in Ethiopia known for coffee, it is geographically descriptive of coffee. However, because the cited mark is registered on the Principal Register, it is entitled to the presumptions accorded such a registration under Section 7(b) of the Trademark Act, 15 U.S.C. § 1067(b) (“A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate.”). Nevertheless, the term “Guji” when used in connection with coffee is inherently weak and therefore entitled to a narrow scope of protection or exclusivity of use.

¹¹ *Id.* at TSDR 21.

¹² *Id.* at TSDR 23. The .no top level domain belongs to Rackspace Ltd.

¹³ *Id.* at TSDR 24.

¹⁴ *Id.* at TSDR 28.

D. The similarity or dissimilarity of the marks

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Inn at St. John’s*, 126 USPQ2d at 1746 (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019); *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 comparing the marks, we are mindful that “[t]he 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.” *Cai v. Diamond Hong*, 127 USPQ2d at 1801 (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012).

We keep in mind that “[s]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)).

Applicant is seeking to register the mark GUJI MANE and Registrant’s mark is GUJI. Given the preceding discussion regarding the strength of the term “Guji,” and

given Applicant's disclaimer of the exclusive right to use that term, we find that the word "Mane" is the dominant part of Applicant's mark. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *Dixie Rests.*, 41 USPQ2d at 1533-34; *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.") (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression").¹⁵

MANE appears to have no significance in relation to the goods, and we treat the term as arbitrary in Applicant's mark. It is for this reason, contrary to the Examining Attorney's argument, "Guji," as the first word of Applicant's mark, is not the dominant part of the mark.¹⁶ In fact, there is no mechanical test to select the dominant element of a mark. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1059 (TTAB 2017). While the first term in a mark generally is considered to be the feature which will be called for, and so remembered, by consumers, this is not invariably the case. See *Stone Lion Capital Partners, LP v. Lion*

¹⁵ The Examining Attorney, in his brief, focuses on the fact that a disclaimer does not remove the term "Guji" from Applicant's mark and that the public is not generally aware of disclaimers in trademark applications. Examining Attorney's Brief (8 TTABVUE 6). However, because "Guji" is geographically descriptive, this affects consumers' perception of whether the two marks as a whole are similar.

¹⁶ Examining Attorney's Brief (8 TTABVUE 5-6).

Capital LLP, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (“[T]he Board did not err in finding that ‘STONE LION CAPITAL’ is ‘similar in sight, sound, meaning, and overall commercial impression’ to ‘LION CAPITAL’ and ‘LION.’”); *Chatam Int’l*, 71 USPQ2d at 1946 (“Viewed in their entireties with non-dominant features appropriately discounted, the marks [GASPAR’S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical.”). Because of the geographic significance of “Guji,” consumers are unlikely to rely on it for source indication in Applicant’s mark GUJI MANE.

There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Viterra*, 101 USPQ2d at 1908; *Nat’l Data*, 224 USPQ at 751.

As we have already found “Guji” geographically descriptive, the scope of protection to which it is entitled is limited. In this regard, the Board has made the following observation:

The question involved in this proceeding is what measure of protection should be afforded a mark like “ROYAL.” It is settled that, unlike in the case of arbitrary or unique designations, suggestive or highly suggestive terms, because of their obvious connotation and possible frequent employment in a particular trade as a part of trade designations, have been considered to fall within the category of “weak” marks, and the scope of protection afforded these marks have been so limited as to permit the use and/or registration of the same mark for different goods or of a composite mark comprising this term plus other matter, whether such matter be equally suggestive or even descriptive, for the same or similar goods. The term “ROYAL”, because of its obvious laudatory suggestive

connotation, has been considered by various tribunals to be a “weak” mark entitled to a narrow orbit of protection in determining the question of the likelihood of confusion. [Internal citations omitted]. As stated in *Peerless Electric Company v. Peerless Electric, Inc.*, supra [103 USPQ 283 (NY Sup. Ct., 1954)].

“There are certain names which are given different tags- descriptive, laudatory, or the like- which are technically known as “weak,” meaning that an exclusive right in them is hard to obtain. Such names as “Superior,” “Majestic,” and “Royal” are so common that the use in and of itself imports nothing * * *.”

The character of the term “ROYAL” and the limited orbit of protection to be afforded such a term is clearly revealed by the third-party registrations made of record by applicant. That is, they are indicative that this Office has, over the years, treated “ROYAL” as a “weak” mark that could not be exclusively appropriated in the food field thereby permitting the registration of “ROYAL”, per se, to different entities for different food products and composite marks containing this term for like goods on the basis that there is no likelihood of confusion as to source.

Standard Brands Inc. v. Peters, 191 USPQ 168, 172 (TTAB 1976). *See also Glamorene Prods. Corp. v. Earl Grissmer Co., Inc.*, 203 USPQ 1090, 1097 (TTAB 1978) (“Both marks [RINSENVAC and SPRAY “N VAC] are highly suggestive of their products and this only enhances the association of each mark with its own goods”).

Likewise, viewing the marks GUJI MANE and GUJI in the context of the facts and circumstances presented by the record in this case, we find the addition of the word “Mane” by Applicant is sufficient to render Applicant’s mark GUJI MANE distinguishable from GUJI. The Examining Attorney argues, to the contrary, that Applicant’s addition of the word “Mane” does not obviate the similarity between the

two marks (GUJI MANE vs. GUJI).¹⁷ However, because of the geographically descriptive nature of the term “Guji,” it is entitled to only a narrow scope of protection or exclusivity of use. Accordingly, we find that Applicant’s mark GUJI MANE is not sufficiently similar to Registrant’s mark GUJI to render confusion likely.

In addition, there is no express rule that we must find marks similar where the Applicant’s mark encompasses Registrant’s entire mark although, under such circumstances, we often have found marks to be similar. *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *6-7 (TTAB 2019) (quoting *Hunter Indus., Inc. v. Toro Corp.*, 110 USPQ2d 1651, 1660 (TTAB 2014)). As discussed above, Applicant’s addition of the word “Mane” to its mark GUJI MANE distinguishes the marks because consumers will not look to the term “Guji” as indicating source; rather, consumers will look to the word “Mane” as the indicator of source.

The Examining Attorney relies on *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) to support his contention that the marks are similar. We consider *Mighty Leaf Tea* distinguishable, however. In that case, applicant filed an application to register the mark ML for “personal care products and skin care preparations, namely, skin soap, body wash, foam bath, body lotion, body scrub, bath salts and massage oil; potpourri; incense.” The Examining Attorney cited the registered mark ML MARK LEES, reproduced below, for “skin care products, namely, skin cleanser, skin toner, skin cream, skin lotion, skin mask gel, make-up foundation, powder and blush.”

¹⁷ Examining Attorneys’ Brief (8 TTABVUE 5).



The court held that the presence of the name “Mark Lees” in the cited mark did not distinguish the marks.

In this case the Board found, similarly, that ML is likely to be perceived as a shortened version of ML MARK LEES when used on the same or closely related skin care products. The Board thus recognized that these initials comprise a dominant feature of the registered mark, and that a newcomer's use of the same initials, in connection with the same goods, would likely lead consumers to view the goods as coming from the same source. Avoidance of this kind of confusion about the provenance of goods is the very problem to which the Lanham Act was directed.

Id. at 94 USPQ2d 1260.

In *Mighty Tea Leaf*, the common portion of the marks is the arbitrary letters ML which in the case of the cited mark is the initials for the name Mark Lees. In the appeal before us, however, the common portion of the marks is not arbitrary, and instead is the geographically descriptive term “Guji.” Because of the geographically descriptive nature of the term “Guji,” customers and prospective customers will rely

on MANE as the source-indicating part of Applicant's mark and, therefore, distinguish it from Registrant's GUJI mark.¹⁸

In comparing the marks in their entireties, GUJI versus GUJI MANE, we find that the presence of the additional word "Mane" in Applicant's mark is enough to distinguish the marks. *See, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1044-45 (TTAB 2010); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008).

E. Whether Registrant's mark is in use

Applicant argues that the mark in the cited registration is no longer in use. Applicant states, "[s]ince the trademark holder has not publicly offered the Guji coffee product for sale in the last three years, its trademark is no longer active. The mark owner appears to have discontinued bona fide use of its mark in US commerce."¹⁹ However, as noted above in our discussion regarding the strength of Registrant's mark, a registered mark it is entitled to the presumptions accorded such a registration under Section 7(b) of the Trademark Act, 15 U.S.C. § 1067(b), including prima facie evidence of the validity of the registered mark and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods.

¹⁸ Likewise, in *Stone Lion*, 110 USPQ2d 1157, on which the Examining Attorney also relies, the common portions of the marks, the word "Lion" and "Lion Capital," were arbitrary and inherently strong when used in connection with investment management services.

¹⁹ Applicant's Brief, p. 8 (6 TTABVUE 9).

Thus, during the prosecution of an application, an applicant may not attack the validity of the cited registration. *See In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997) (an ex parte proceeding is not the proper forum to challenge the validity of the cited registration); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992) (an attack on the validity of the cited registration is not permitted in an ex parte appeal). Accordingly, we may not consider Applicant's argument that Registrant is no longer using its GUJI mark.

F. Conclusion

Despite the overlapping goods, given the weakness resulting from the geographic significance of the term shared between Applicant's mark GUJI MANE and the cited mark GUJI, we find them sufficiently different that there is no likelihood of confusion.

Decision: We reverse the Section 2(d) likelihood of confusion partial refusal to register Applicant's mark.