

This Opinion is Not a
Precedent of the TTAB

Hearing: January 4, 2024
(App. Serial No. 90691470)

Mailed: February 1, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

*In re Kattina V. Barsik, Linda D. Barsik, Sean E. Barsik
and Tamara A. Barsik*
—

Serial Nos. 90691080 and 90691470
—

Kattina V. Barsik, Esq.,
for Kattina V. Barsik, Linda D. Barsik, Sean E. Barsik and Tamara A. Barsik.

Sandra Snabb and Leslee Friedman,¹ Trademark Examining Attorneys, Law Office
120, David Miller, Managing Attorney.

—

Before Cataldo, Coggins, and Dunn,
Administrative Trademark Judges.

Opinion by Dunn, Administrative Trademark Judge:

¹ Trademark Examining Attorney Sandra Snabb examined both applications and briefed the appeals. Trademark Examining Attorney Leslee Friedman was reassigned both applications, addressed the remands in both applications, and appeared for the oral hearing in Application Serial No. 90691470.

Kattina V. Barsik, Linda D. Barsik, Sean E. Barsik and Tamara A. Barsik (“Applicant”²) seeks registration on the Principal Register of the two marks summarized below:

App. Serial No. 90691080 ³	App. Serial No. 90691470 ⁴
<p style="text-align: center;">THE BOOKSTORE</p> <p style="text-align: center;">[standard characters]</p>	<p style="text-align: center;">THE BOOKSTORE SPEAKEASY</p> <p style="text-align: center;">[standard characters] [SPEAKEASY disclaimed]</p>
<p>Bar and restaurant services; Restaurant and bar services; Restaurant and bar services, including restaurant carryout services; Restaurant, bar and catering services, in International Class 43.</p>	<p>Restaurant; Restaurant and bar services; Restaurant and bar services, including restaurant carryout services; Restaurant and catering services; Restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises; Restaurant, bar and catering services; Bar and restaurant services, in International Class 43.</p>

The applications were assigned to the same Trademark Examining Attorney and both were refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s marks, as applied to the services identified in the respective applications, so resemble the mark LIBRARY BISTRO &

² While the joint Applicants are properly identified in the plural, the applicant entity has no impact in these appeals. For convenience, we shall refer to the joint Applicants in the singular. Similarly, we will refer to the assigned Examining Attorneys in the singular.

³ Application Serial No. 90691080 filed May 5, 2021, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as April 1, 2010.

⁴ Application Serial No. 90691470 filed May 5, 2021, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as January 1, 2011.

BOOKSTORE BAR (in the stylized form shown below) for “bar and restaurant services,” in International Class 43,⁵ on the Principal Register as to be likely to cause confusion, to cause mistake, or to deceive.



When the refusal in each application was made final, Applicant appealed and requested reconsideration in each application. After the Examining Attorney denied the request for reconsideration in each application, the appeals were resumed and briefs were filed.⁶

Applicant filed in each application a request for remand to the Examining Attorney for review of the refusal in view of new evidence. The request was granted and jurisdiction was returned to the newly-assigned Examining Attorney. After review, the Examining Attorney denied reconsideration, and maintained and continued the final refusal in each application.

Applicant filed a reply brief in each application, and requested an oral hearing in Application Serial No. 90691470.

⁵ Registration No. 2899946 issued November 2, 2004, with a claim of acquired distinctiveness as to BOOKSTORE BAR and disclaimers of BISTRO and BAR. If no declaration of continued use/renewal is filed by November 2, 2024, or within the following six-month grace period, the registration will be cancelled. Trademark Act Sec. 9(a), 15 U.S.C. §1059(a); Trademark Rule 2.182, 37 C.F.R. §2.182.

⁶ In both applications, the appeal was dismissed for failure to file a brief. At Applicant’s request, each dismissal was set aside and the time for filing a brief reset.

These appeals present common questions of law and fact and the records are substantially similar. In the interest of judicial economy, we consolidate the cases and decide them in this single opinion. *See In re Pohl-Boskamp GmbH & Co. KG*, 106 USPQ2d 1042, 1043 (TTAB 2013); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1214 (July 2023). We have considered all arguments and evidence filed in each case. We affirm the refusal to register as to each application.

I. Evidentiary Issues

Before proceeding to the merits of the refusal, we address evidentiary matters. In Applicant's brief for each application Applicant included a chart purporting to summarize by application number, registration number, mark, and live or dead status, third-party registered BOOKSTORE marks for "similar or related goods."⁷ The briefs also include exhibits not previously of record.⁸

The Examining Attorney objects in her brief to consideration of the evidence submitted with the briefs as untimely.⁹ Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), provides in relevant part "[t]he record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board

⁷ 9 TTABVUE 7-10 (App. Serial No. 90691080); 9 TTABVUE 11-14 (App. Serial No. 90691470).

References to the applications are to the downloadable .pdf version of documents available from the TSDR (Trademark Status and Document Retrieval) database. The TTABVUE citations refer to the Board's electronic docket, with the first number referring to the docket entry and the second number, if applicable, referring to the page within the entry.

⁸ 9 TTABVUE 14-35 (App. Serial No. 90691080); 9 TTABVUE 14-34 (App. Serial No. 90691470).

⁹ 11 TTABVUE 2-3 (App. Serial No. 90691080); 11 TTABVUE 3 (App. Serial No. 90691080).

after the filing of a notice of appeal.” The Examining Attorney also advised Applicant that, with respect to its chart, the Board generally does not take judicial notice of third-party registrations, and to make third party registrations part of the record, an applicant must submit copies of the registrations, or the complete electronic equivalent from the USPTO’s automated systems, prior to appeal.¹⁰ Insofar as the Examining Attorney has timely objected to Applicant’s late-filed evidence, the objection is sustained and the evidence submitted concurrently with Applicant’s appeal briefs has been given no consideration.

However, with the subsequent request for remand, Applicant submitted a copy of the brief with the chart, but none of the third-party registrations.¹¹ Applicant also submitted a “bookstore” definition excerpt, excerpts from Applicant’s website, Facebook, and Instagram pages bearing its marks, a gift certificate bearing the mark, and the ICANN registration printout for Applicant’s website domain.¹² The evidence submitted with the request for remand now is of record for whatever probative value it possesses.

Applicant submitted additional evidence with its reply brief.¹³ Because the Examining Attorney has no opportunity to respond to such late-filed evidence, the

¹⁰ 11 TTABVUE 3 (App. Serial No. 90691080 and App. Serial No. 90691470).

¹¹ 12 TTABVUE 6-17 (App. Serial No. 90691080 and App. Serial No. 90691470). In the response denying reconsideration and maintaining the refusal in each application the Examining Attorney again pointed out that the mere submission of a list of registrations does not make such registrations part of the record. 14 TTABVUE 2 (App. Serial No. 90691080 and App. Serial No. 90691470).

¹² 12 TTABVUE 18-39 (App. Serial No. 90691080 and App. Serial No. 90691470).

¹³ 16 TTABVUE 2-18 (App. Serial No. 90691080 and App. Serial No. 90691470).

Board will not consider it. *See Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1300 n. 18 (TTAB 2016) (“Applicant submitted additional evidence with its reply brief which purportedly demonstrates use of Applicant’s ΑΦΩ mark on clothing items. This evidence is untimely submitted and has been given no consideration.”).

II. Likelihood of Confusion Refusal

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and 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 [or services] 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 [or services].”)

(quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. The relatedness of the services, trade channels and classes of consumers and purchasing conditions

We first consider the *DuPont* factors regarding the similarity or dissimilarity of the parties' respective services, their trade channels, consumers, as well as conditions of purchase. It is not necessary that the services be identical or competitive, or even that they move in the same channels of trade, to support a finding of likelihood of confusion. Rather, it is sufficient that they are related in some manner, or that the circumstances surrounding their marketing are such that they would or could be encountered by the same persons in situations that would give rise, because of the similarity of the marks, to a mistaken belief that they originate from the same source or that there is an association or connection between the sources of the services. See *Coach Servs. Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009).

Here, the cited registration is for "bar and restaurant services" and both applications include "restaurant and bar services." The transposition of terms in the respective recitations does not change their meaning, and we find Applicant and Registrant use their marks on identical services. It is sufficient for a finding of 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. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Because the services are in-part legally identical without restriction, we also must presume that they are offered in all normal trade channels and to all normal classes of purchasers for such goods. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). Thus, we consider Applicant's and Registrant's trade channels and classes of purchasers to be the same. *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 ...'" (citing *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012))).

As to the conditions of purchase, there is no evidence on this point, but we must base our determination on the least sophisticated purchaser. *Stone Lion*, 110 USPQ2d at 1163. Here, restaurant and bar services may be the subject of impulse visits as well as advance reservation, and may offer inexpensive sandwiches and drinks at a counter as well as more elaborate fare in a formal dining room, and so we find these services are not subject to a heightened level of care. *See Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, *7-8 (TTAB 2020); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1407 (TTAB 1998).

Applicant's brief in each application does not contend that any difference between the services, trade channels, classes of purchasers, and sales conditions, and the

services, trade channels, classes of purchasers, and sales conditions in the cited registration support a finding no likelihood of confusion; Applicant's briefs do not address these factors.

We find the *DuPont* factors relating to the similarity of the goods, trade channels, classes of consumers, and conditions of sale favor a finding of likelihood of confusion.

B. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression

Next, we consider the *DuPont* factor relating to the similarity of the marks. In comparing the marks, we must consider their appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Similarity as to any one of these factors may be sufficient to support a finding that the marks are confusingly similar. See *Krim-Ko Corp. v. Coca-Cola 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."); *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) ("Similarity in any one of these elements may be sufficient to find the marks confusingly similar.") (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

The test under the first *DuPont* factor 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 that confusion as to the source of the services offered under the respective marks is likely to result. *Coach Servs., Inc.*, 101 USPQ2d at 1721. Although we consider the marks

as a whole, “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Finally, we bear in mind that “when the goods [or services] at issue are identical, ‘the degree of similarity necessary to support a conclusion of likely confusion declines.’” *Viterra*, 101 USPQ2d at 1912 (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992)).

As set forth above, the registered mark is a stylized display of LIBRARY BISTRO & BOOKSTORE BAR, and Applicant seeks to register THE BOOKSTORE and THE BOOKSTORE SPEAKEASY. When we compare the marks in their entireties, we recognize that there are differences in appearance and sound. The registered mark has four words, while Applicant’s marks have two words and three words. However, the distinctive word BOOKSTORE in the registered mark forms the dominant part of both THE BOOKSTORE and THE BOOKSTORE SPEAKEASY, and so for the “rational reasons” set forth below, we find that all three marks share highly similar connotations and overall commercial impressions.

Beginning with the connotation and commercial impression of the registered mark, we find LIBRARY BISTRO & BOOKSTORE BAR is comprised of two phrases of similar meaning which reinforce each other. We take judicial notice that a library offers books for use but not for sale, and the record includes a definition of bookstore

as “a store that sells books.”¹⁴ Both “library” and “bookstore” connote a place where books are found, an arbitrary connotation when used in connection with restaurant and bar services. *See Palm Bay Imps.*, 73 USPQ2d at 1692 (an arbitrary term is “conceptually strong as a trademark”); *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004) (“An arbitrary mark is a known word used in an unexpected or uncommon way.”). This strong similar connotation of a place for books outweighs the difference that one place offers books for free and one sells them.

The additional terms BISTRO and BAR are disclaimed in the registered mark and do not alter the dominance of the other terms in the mark as a whole. *See In re Detroit Athletic Co.*, 903 F3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018 (“[N]on-source identifying nature of the words and the disclaimers thereof constitute rational reasons for giving those terms less weight in the analysis.”); *In re Chatam Int’l*, 71 USPQ2d at 1946 (“Because ALE has nominal commercial significance, the Board properly accorded the term less weight in assessing the similarity of the marks under *DuPont*.”). Finally, we find that the minor stylization employed by the Registrant is insufficient to alter the commercial impression created by the similar terms LIBRARY and BOOKSTORE when applied to restaurant and bar services. *See In re*

¹⁴ More specifically, a library is defined as “a place in which literary, musical, artistic, or reference materials (such as books, manuscripts, recordings, or films) are kept for use but not for sale. Merriam-Webster.com Dictionary, <https://www.merriam-webster.com/dictionary/library>. Accessed Jan. 31, 2024. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016). The definition of BOOKSTORE appears at April 26, 2023 Request for Remand TSDR 18 (App. Serial No. 90691080 and App. Serial No. 90691470).

1st USA Realty Professionals Inc., 84 USPQ2d 1581, 1584 (TTAB 2007) (“The registered mark is for the words FIRST USA in a slightly stylized typestyle. However, the stylization is so minimal that it does not make a real commercial impression.”). The mark LIBRARY BISTRO & BOOKSTORE BAR has the connotation and commercial impression of a place for books.

Similarly, the term BOOKSTORE creates the dominant connotation and commercial impression of Applicant’s marks. In the marks THE BOOKSTORE and THE BOOKSTORE SPEAKEASY, the remaining elements of Applicant’s two marks are not distinctive terms that modify the arbitrary connotation of BOOKSTORE as applied to Applicant’s services. The term THE generally does not affect the likelihood of confusion analysis because it has little to no source-identifying significance. *See Motorola, Inc. v. Griffiths Elecs., Inc.*, 317 F.2d 397, 137 USPQ 551, 552 (CCPA 1963) (THE is “of trifling importance”); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (the word “the” in THE WAVE merely emphasizes the word “wave”). The record in Applicant’s THE BOOKSTORE SPEAKEASY application shows SPEAKEASY defined as “an illicit establishment that sells alcoholic beverages, or a retro style bar that replicates aspects of historical speakeasies.”¹⁵ The highly descriptive term SPEAKEASY is disclaimed in Applicant’s mark THE BOOKSTORE SPEAKEASY. *See In re Detroit Athletic Co.*, 128 USPQ2d at 1049 and *In re Chatam Int’l*, 71 USPQ2d at 1946.

¹⁵ January 14, 2022 Office Action TSDR 16.

While not ignoring the differences, when comparing LIBRARY BISTRO & BOOKSTORE BAR to THE BOOKSTORE and THE BOOKSTORE SPEAKEASY, we find the common term BOOKSTORE creates the same arbitrary connotation and commercial impression in connection with restaurant and bar services. *See Stone Lion*, 110 USPQ2d at 1161 (Fed. Cir. 2014) (affirming TTAB's finding that applicant's mark STONE LION CAPITAL incorporated the entirety of the registered marks LION CAPITAL and LION, and that the noun LION was the dominant part of both parties' marks); *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant's mark ML is similar to registrant's mark ML MARK LEES).

Because Applicant seeks registration of both marks in standard characters, this similarity is not lessened because the registered mark is stylized. The ability to employ any font, size, style, or color when using Applicant's marks could result in use of displays which increase or emphasize the similarities between the marks. *See In re Viterra Inc.*, 101 USPQ2d at 1909; *In re Davia*, 110 USPQ2d at 1814.

Applicant contends in both applications that the marks are not similar because the common element BOOKSTORE is weak as applied to restaurant and bar services. No evidence of record supports this argument. Despite being advised multiple times that its argument, namely, that third-party registrations weakened the term BOOKSTORE as applied to restaurant and bar services, required copies of the third-party registrations, Applicant failed to submit them. While the chart of registrations is of record, it is entitled to very little probative weight because it does not indicate the goods and services for which each mark is registered. Assuming *arguendo* that

the chart properly lists the marks, the term BOOKSTORE would have a different connotation as applied to, for example, bookstores. *See Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694 (Fed. Cir. 2018) (“It is less relevant that ‘Century’ is used on unrelated goods or services such as ‘Century Dental Centers’ or ‘Century Seafoods.’”).

Accordingly, the similarity of the marks is a factor that weighs in favor of a finding of likelihood of confusion.

C. Balancing the factors

We have considered all of the arguments and evidence of record, and all relevant *DuPont* factors. In sum, we find the services are in part identical, the trade channels and classes of consumers presumed to be the same, no evidence of a heightened degree of care or sophistication, and Applicant’s marks THE BOOKSTORE and THE BOOKSTORE SPEAKEASY have highly similar connotations and overall commercial impressions as the registered mark LIBRARY BISTRO & BOOKSTORE BAR (stylized). All other factors are neutral.

When we balance the *DuPont* factors, we conclude that Applicant’s marks are likely to create confusion with the registered mark. *See Stone Lion*, 110 USPQ2d at 1164) (“The Board properly determined that the first four *DuPont* factors weighed in favor of finding a likelihood of confusion and that the remaining factors were neutral. The refusal of Stone Lion’s application for trademark registration is therefore affirmed.”).

III. Decision

The refusal to register Applicant's mark in each application is affirmed.