

This Opinion is Not a
Precedent of the TTAB

Mailed: March 13, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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LP Global, Inc.
v.
Seoul Gool Dae Gee, Inc.
—

Opposition No. 91221967
—

Kennon Peebles, Jr., for LP Global, Inc.

Angela L. Hart, of Chung & Press PC, for Seoul Gool Dae Gee, Inc.

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

Opinion by Larkin, Administrative Trademark Judge:

Seoul Gool Dae Gee, Inc. (“Applicant”) seeks registration on the Principal Register of the mark HONEY PIG in standard characters for “restaurant, catering, restaurant carry-out and bar services,” in International Class 41.¹ LP Global, Inc. (“Opposer”) opposes registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the basis of its claim that Applicant’s mark so resembles the service mark and trade

¹ Application Serial No. 86365509 was filed on August 13, 2014 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), on the basis of Applicant’s claim of first use of the mark and first use of the mark in commerce on July 1, 2007.

name HONEY PIG previously used by Opposer in the United States in connection with restaurant and related services, and not abandoned, as to be likely, when used in connection with Applicant's services, to cause confusion, to cause mistake, or to deceive.

Opposer's Notice of Opposition pleads a single claim for relief under Section 2(d) of the Trademark Act. 1 TTABVUE 3-6. In Applicant's Answer, 4 TTABVUE, Applicant denied the material allegations in the Notice of Opposition, and interposed affirmative defenses of laches, estoppel, and ownership of a prior registration of a substantially similar registered mark.² 4 TTABVUE 2-4. Opposer and Applicant have filed briefs. We sustain the opposition.

I. The Record

The record consists of:

- (1) the pleadings;
- (2) the file history of Applicant's application, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1);
- (3) Opposer's First Notice of Reliance on the file history of Opposer's abandoned Application Serial No. 77796974 (26 TTABVUE);
- (4) Opposer's Second Notice of Reliance on the file history of Applicant's Registration No. 3749135 (27 TTABVUE);

² As discussed below, Applicant's affirmative defenses are waived because Applicant did not separately pursue them in its brief. *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014). Applicant discussed its prior registration in connection with Opposer's likelihood of confusion claim.

- (5) Opposer's Third Notice of Reliance on certain responses by Applicant to Opposer's First Set of Interrogatories (28 TTABVUE);
- (6) Opposer's Fourth Notice of Reliance on certain responses by Applicant to Opposer's First Requests for Admission (29 TTABVUE);
- (7) The testimony deposition of Opposer's owner Wea Ju Lee and exhibits thereto (30 TTABVUE);
- (8) Applicant's Notice of Reliance on (i) Applicant's Registration No. 3749135, (ii) the Notice of Acceptance and Notice of Acknowledgment of Applicant's Section 8 and 15 declaration on Registration No. 3749135, (iii) Opposer's Application Serial No. 77796974, (iv) certain responses by Opposer to Applicant's First Set of Interrogatories, and (v) certain responses by Opposer to Applicant's First Set of Requests for Admission (42 TTABVUE);
and
- (9) The testimony deposition of Applicant's owner Mi Kyung Kim and exhibits thereto (43 TTABVUE).

II. Factual Background³

Opposer and Applicant have been operating Korean barbecue restaurants in Duluth, Georgia and Annandale, Virginia, respectively, for about 10 years under service marks containing the words "Honey Pig." We must determine whether

³ This section does not contain all of our factual findings. Additional factual findings are discussed below in connection with specific issues.

Opposer may prevent Applicant from registering its HONEY PIG mark in standard characters.

A. Opposer and Its Restaurant

Opposer's Conception of the Honey Pig Mark and Restaurant Business Plan

Opposer's owner Wea Ju Lee testified that he first had the idea of opening a restaurant called Honey Pig in Duluth, Georgia around 2005. Lee Tr. 4:17-5:25.⁴ He decided on the name after consulting with a friend in Los Angeles, California who runs a "Gool Dae Gee" restaurant. Lee Tr. 6:1-8. Mr. Lee testified that the name "Gool Dae Gee" could be translated as "Honey Pig," but that his friend's restaurant used the name "Gool Dae Gee" in both Korean and English. Lee Tr. 6:9-13. Mr. Lee testified that he began the development of a business plan for the restaurant in mid-2006 in order to get a bank loan to open the restaurant. Lee Tr. 8:13-9:5; Ex. 2 (30 TTABVUE 95-122).

Opposer's Pre-Opening Activities

Opposer was incorporated in 2007. Lee Tr. 8:7-9. Opposer entered into a Retail Lease Agreement for restaurant premises in Duluth, Georgia on February 1, 2007, in which it identified itself as doing business as "Honey Pig." Lee Tr. 7:4-34; Ex. 1 (30 TTABVUE 36-94). After Opposer registered "Honey Pig" as a trade name with the Gwinnett County Superior Court on April 16, 2007, Lee Tr. 9:6-10:9; Ex. 3 (30

⁴ Citations to the testimony of the parties' witnesses are to the internal numbered pages and lines of their transcripts, which may be found at 30 TTABVUE (Mr. Lee) and 43 TTABVUE (Ms. Kim). Citations to exhibits are to exhibit numbers followed by the TTABVUE pages on which the exhibits or pertinent pages may be found.

TTABVUE 123-125), it entered into a contract for the construction of the restaurant on May 2, 2007. Lee Tr. 10:10-24; Ex. 4 (30 TTABVUE 126-135). Opposer obtained a license to sell alcohol at some point in 2007, Lee Tr. 10:25-11:2,⁵ and a license to sell cigars and cigarettes issued by the Georgia Department of Revenue on December 5, 2007, with an effective date of December 12, 2007. Lee Tr. 11:15-12:4; Exs. 5-6 (30 TTABVUE 136-137).

The Opening and Operation of Opposer's Restaurant

Opposer opened its Honey Pig restaurant on December 12, 2007 under signage bearing the service mark shown below. Lee Tr. 12:5-7.



Mr. Lee testified that since its opening, Opposer's restaurant has operated continuously under the name "Honey Pig," and has always specialized in Korean barbecue. Lee Tr. 12:8-14; 13:14-20. Mr. Lee authenticated several articles about Opposer's restaurant. Lee Tr. 13:24-14:6; Exs. 8-10 (30 TTABVUE 172-186). One of the articles contains a photograph of exterior signage for Opposer's restaurant that displays the word "Honey pig" with different design elements from those shown above. The signage depicted in the article is reproduced below.

⁵ The license is not in the record.



Lee Tr. Ex. 10 (30 TTABVUE 177) (restaurant review dated December 22, 2015 on Atlanta Restaurant Blog). The articles refer to Opposer's restaurant as "Honey Pig." 30 TTABVUE 172, 174, 176-178.

Mr. Lee testified that Duluth, Georgia is the only location in which Opposer is currently operating a Honey Pig restaurant, although Opposer is pursuing other possible locations, including in the mid-Atlantic area, and that he has received inquiries about franchise opportunities. Lee Tr. 16:20-17:18; 22:2-25:13.

Opposer's Filing and Abandonment of Application Serial No. 77796974

On August 4, 2009, Opposer filed Application Serial No. 77796974 in the Patent and Trademark Office to register the service mark shown on the preceding page for bar and restaurant services, claiming first use and first use in commerce on December 12, 2007. Lee Tr. 12:15-13:9; Ex. 7 (30 TTABVUE 138-171). On November 12, 2009, the examining attorney assigned to the application issued an office action in which he noted, as a prospective bar to registration under Section 2(d) of the Trademark

Act, prior pending Application Serial No. 77768942, which had been filed by Applicant on June 26, 2009 to register the service mark shown below.



30 TTABVUE 145; 42 TTABVUE 24-30, 65 (Response to Request for Admission No. 8). The examining attorney on Opposer's application found that the services were identical and that the "foreign wording in the prior application translates to HONEY PIG, which is identical to the wording in the applicant's mark." 30 TTABVUE 145-146. Opposer did not respond to the office action and the application became abandoned on June 17, 2010. 30 TTABVUE 140. Mr. Lee did not convincingly explain why Opposer did not respond to the office action. Lee Tr. 13:10-13.

Opposer's Knowledge of and Contact with Applicant

Mr. Lee testified that he became aware of Applicant's restaurant "some time in 2008" "[t]hrough other people talking" about a "similar version" of Opposer's restaurant. Lee Tr. 14:7-16. Applicant argues that this testimony, and an unspecified response to Applicant's requests for admission, show that "Opposer was aware in 2008 that Applicant was operating a Korean barbecue restaurant in Annandale, Virginia under the name Honey Pig Restaurant," 45 TTABVUE 10, but the record does not support that claim. In its responses to Applicant's requests for admission, Opposer specifically denied having knowledge of Applicant's use of HONEY PIG in

English when Opposer filed its application in 2009, and when it received the November 12, 2009 office action noting the pendency of Applicant's application. 42 TTABVUE 64-65 (Responses to Requests for Admission Nos. 5, 9). Opposer admitted only that "sometime in approximately 2008 or 2009 . . . it became generally aware that Applicant was operating Korean barbeque restaurants under the name GOOLDAEGEE in the Virginia area." 42 TTABVUE 64 (Response to Request for Admission No. 6).

In response to one of Applicant's interrogatories, Opposer stated that it "first became aware of Applicant's use of HONEY PIG in late 2014, when it hired its previous counsel, Mark VanderBroek, to research the state of its Trademark Application Serial No. 77796974." 42 TTABVUE 57-58 (Response to Interrogatory No. 25). That response is consistent with the contents of a December 15, 2014 letter, discussed below, from Opposer's counsel to Applicant, in which Opposer asserted prior rights in the HONEY PIG mark based on "recently obtained news articles which indicate that . . . [Applicant's] use in commerce of its GOOLDAEGEE and HONEY PIG Marks did not occur *until 2008*." 43 TTABVUE 51.⁶

Mr. Lee testified that he has never had discussions with Applicant's owners, Lee Tr. 14:17-20, and there is no evidence in the record of any response from Applicant to the December 15, 2014 letter, or of any other contacts between the parties prior to the filing of this opposition.

⁶ The letter states that one of the articles is enclosed, but if it was enclosed, it was not included with the copy of the letter made of record by Applicant, and it is not otherwise in the record.

B. Applicant and Its Restaurant

Applicant's Conception of Its Gooldaegee Korean B.B.Q. Mark

Applicant's principal Mi Kyung Kim testified that in 2005 she made the decision to open a Korean barbecue restaurant. Kim Tr. 18:10-19. She came up with the name "Seoul Gooldaegee Korean BBQ," Kim Tr. 19:4-6, explaining that the word "Gooldaegee" was her childhood nickname ("pig"), and that Seoul, Korea was her birthplace. Kim Tr. 19:10-21.

Applicant's Pre-Opening Activities

In 2006, Ms. Kim found a location for her restaurant in Annandale, Virginia, and on October 3, 2006, she signed a lease, in her own name, for premises there. Kim Tr. 20:4-21:19; Ex. 4.⁷ The lease did not identify the name of the prospective restaurant. Construction on the restaurant began a few months later, and Ms. Kim anticipated opening it in October 2007. Kim Tr. 23:7-12. She testified that beginning in about August 2007, a banner bearing the words "Coming soon, Seoul Gooldaegee" appeared outside the restaurant while it was being constructed. Kim Tr. 27:4-13.

Ms. Kim testified that she obtained a liquor license from the Virginia Department of Alcoholic Beverage Control under the name "Seoul Gool Dae Gee" in August 2007, Kim Tr. 29:12-31:7; Ex. 8,⁸ and a Temporary Certificate of Business, Professional and Occupational License, in her personal capacity and under the trade name "Seoul Gool

⁷ It is not clear from the record when Applicant was formed, but the lease was assigned to, and assumed by, Applicant in June 2008, after the restaurant had opened. Kim Tr. 21:20-22:18; Ex. 4 (43 TTABVUE 72-73).

⁸ The liquor license is not in the record.

Dae Gee,” on September 11, 2007. Kim Tr. 23:19-25:3; Ex. 5 (43 TTABVUE 74). She then placed the advertisement reproduced below in a weekly entertainment newspaper that was available at no charge at supermarkets and shopping centers in Maryland, the District of Columbia, and northern Virginia.

COMING SOON 11월 29일

명품을
꿀돼지 삼겹살 전문점
Korean Barbeque Grill

꿀꿀꿀~ 서울 꿀돼지가 몰려옵니다.
애난데이일 최초의
삼겹살, 현판요리, 송두쟁 요리 전문점

B.B.Q. GRILL 소고기, 돼지고기, 해물

식사후 허산후
매운 소스로
입을 뽀아 드립니다.

매콤하고 얼큰한 **매운 소스**는 서울꿀돼지만의 자랑입니다.

송두쟁요리	현판요리	소고기요리	기타요리
<ul style="list-style-type: none"> ■ 생 삼겹살 ■ 대패 삼겹살 ■ 차돌박이 ■ 고추장 삼겹살 	<ul style="list-style-type: none"> ■ 불누웠판 ■ 오삼철판 ■ 낙삼철판 ■ 주삼철판 	<ul style="list-style-type: none"> ■ 생 등심 ■ 생 볼고기 ■ 생 주물럭 (소고기) 	<ul style="list-style-type: none"> ■ 불타는 닭발 ■ 돼지 껌데기 ■ 매운 김치찜

703.505.8324 | 애난데이일 미건의료기 뒷편
7220-C Columbia Pike, Annandale, VA 22003

Kim Tr. 25:4-27:3; Ex. 6 (43 TTABVUE 75). The advertisement began running in October 2007 and stated that the anticipated opening date for the restaurant was November 2, 2007. Kim Tr. 27:14-20. The opening of Applicant’s restaurant was postponed until February 2008, however, apparently due to construction and inspection delays. Kim Tr. 23:6-15; 26:22-27:3.

The Opening and Operation of Applicant's Restaurant

Ms. Kim testified that a permanent sign went up outside the Annandale, Virginia restaurant in January 2008, Kim Tr. 28:2-29:11; Ex. 7 (43 TTABVUE 76), and has appeared there since then. Kim Tr. 29:2-3. The photograph of the sign reproduced below was submitted by Applicant as its specimen of use in support of the opposed application.



Applicant claims in its brief that a “soft opening” of its restaurant occurred in January 2008, 46 TTABVUE 9,⁹ and Ms. Kim testified that the grand opening of the restaurant was on February 28, 2008. Kim Tr. 31:14-18.¹⁰ In an answer to one of

⁹ Ms. Kim did not testify about the “soft opening.” Instead, Applicant cites its response to one of Opposer’s interrogatories, which was made of record by Opposer under notice of reliance. 28 TTABVUE 9 (Response to Interrogatory No. 9). Trademark Rule 2.120(k)(7), 37 C.F.R. § 2.120(k)(7), provides that “[w]hen . . . an answer to an interrogatory . . . has been made of record by one party in accordance with the provisions of paragraph (k)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.”

¹⁰ In response to one of Opposer’s interrogatories, Applicant stated that the Annandale location opened on February 8, 2008, 28 TTABVUE 9 (Response to Interrogatory No. 8), and Ms. Kim testified elsewhere that the restaurant opened in the beginning of February 2008. Kim Tr. 23:16-18. The discrepancies in the dates are not significant on the issue of priority or otherwise.

Opposer's interrogatories, Applicant stated that a second location in Annandale opened in 2009 and that additional restaurants opened in Ellicott City, Maryland in 2010, in Centreville, Virginia in 2010, and in Germantown, Maryland in 2011. 28 TTABVUE 8-9 (Response to Interrogatory No. 8). There is no information in the record, however, regarding any locations other than the original one in Annandale, Virginia, and Applicant does not discuss any other locations in its brief.

Ms. Kim testified that the English words "Honey Pig" appear as a mark on Applicant's restaurant menus, and some unspecified "business-related items in the restaurant," in addition to the restaurant signage. Kim Tr. 32:19-33:3.

Applicant's Registration No. 3749135

Opposer did not oppose registration of the mark shown in Applicant's Application Serial No. 77768942 discussed above when it was published for opposition on December 1, 2009. 42 TTABVUE 58, 67 (Opposer's Responses to Applicant's Interrogatory No. 26 and Request for Admission No. 21). On February 16, 2010, the application matured into Registration No. 3749135 for the mark shown on page 7 above for bar and restaurant services.¹¹ Kim Tr. 8:5-16:1; Exs. 1-2 (43 TTABVUE 43-49). The registration became incontestable in March 2015. 42 TTABVUE 11.

Applicant's mark is described in the registration as follows:

The mark consists of the Korean characters for "gool dae gee", with the "gool" character in red and "dae gee" characters in black with white outlining; the Korean characters for "sam gyup sal" and "jeon moon jeom" and the wording "Gooldaegee Korean B.B.Q." appear in white. The

¹¹ The specimen of use submitted by Applicant in support of the application that matured into Applicant's registration was a gift card for Applicant's restaurant. 27 TTABVUE 54, 57.

mark also consists of a pig design in white, outlined in black, with the nose in red, all on a black rectangular background.

42 TTABVUE 9. The colors red, white, and black are claimed as a feature of the mark. The translation statement in the registration reads as follows: “The non-Latin characters in the mark transliterate to ‘gool dae gee’ and this means honey pig, same gyup sal and this means three layer meat or pork belly and joen moon joem and this means special restaurant in English.” *Id.* at 8. The transliteration statement in the registration reads as follows: “The English translation of ‘gooldaegee’ in the mark is honey pig.” *Id.*

Opposer’s Demand Letter to Applicant

As discussed above, Applicant’s composite mark was brought to Opposer’s attention during examination of Opposer’s abandoned application to register HONEY PIG and design. In a letter to Applicant dated December 15, 2014, more than four years after Opposer’s application had been abandoned, counsel for Opposer noted the existence of Applicant’s registration and the pendency of the opposed application, claimed that Opposer had prior rights in the HONEY PIG mark, and demanded that Applicant surrender the registration and abandon the application, or face cancellation and opposition proceedings. Kim Tr. 16:6-17:17; Ex. 3 (43 TTABVUE 50-52). Opposer’s counsel stated that Opposer “desires to register its HONEY PIG Mark with the U.S. Trademark Office for restaurant services” but “will not be permitted to do so while [Applicant] owns a federal registration for its GOOLDAEGEE Mark (which can be translated as ‘Honey Pig’), and has a pending application to register [Applicant’s] HONEY PIG Mark” 43 TTABVUE 52. Opposer’s counsel

emphasized that Opposer “is *not* asking that [Applicant] cease using those marks to identify the services provided at its restaurants,” but was “only requesting that [Applicant] abandon its registration and application to register those marks, so as to permit [Opposer] to apply for federal registration of the HONEY PIG Mark consistent with its prior use in commerce and resulting rights in that mark.” 43 TTABVUE 52. Applicant hired a lawyer in response to the letter, Kim Tr. 17:22-18:5, but no subsequent correspondence between the parties is in the record.

III. Standing

A threshold issue in every inter partes case is the plaintiff’s standing to challenge registration. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). Section 13 of the Trademark Act permits an opposition by “[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register. . . .” 15 U.S.C. § 1063. To establish its standing, Opposer must demonstrate that it possesses a “real interest” in this proceeding beyond that of a mere intermeddler, and a “reasonable basis” for its belief of damage. “A ‘real interest’ is a ‘direct and personal stake’ in the outcome of the proceeding.” *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1179 (TTAB 2017) (quoting *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999)). “A claim of likelihood of confusion that ‘is not wholly without merit,’ including prior use of a confusingly similar mark, may be sufficient ‘to establish a reasonable basis for a belief that one is damaged.’” *Id.* (quoting *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982)).

On the basis of Opposer's ownership of a common law composite word-and-design service mark containing the words Honey Pig for restaurant services, we find that Opposer has shown a real interest in this proceeding and a reasonable basis for its belief of damage from registration of Applicant's mark, and thus has standing.

IV. Opposer's Section 2(d) Claim

Section 2(d) of the Trademark Act prohibits registration of 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 on or in connection with the goods of the applicant, to cause confusion, to cause mistake, or to deceive." 15 U.S.C. § 1052(d).

A. Priority

Under Section 2(d), to "establish priority, [Opposer] must show proprietary rights in the mark that produce a likelihood of confusion." *Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002). "These proprietary rights may arise from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights." *Id.* Opposer invokes the portion of Section 2(d) that "permits opposition on the basis of ownership of 'a mark or trade name previously used in the United States . . . and not abandoned.'" *Exec. Coach Builders*, 123 USPQ2d at 1180. Opposer "must establish proprietary rights in its pleaded common-law mark that precede Applicant's actual or constructive use of its involved mark," *id.* (citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317,

209 USPQ 40, 43 (CCPA 1981)), by a preponderance of the evidence. *Hydro-Dynamics Inc. v. George Putnam & Co.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987).

Applicant all but concedes Opposer's priority on the basis of Opposer's service mark use beginning with the opening of its restaurant on December 12, 2007,¹² about a month before Applicant first used HONEY PIG in connection with its restaurant in January 2008.¹³ In a sub-section of its brief captioned "Any Prior Use by Opposer Was Minimal and Does Not by Itself Warrant Deference," 46 TTABVUE 18, which comprises Applicant's entire discussion of priority, Applicant does not argue that it is the senior user, but instead states as follows:

The evidence set forth in the record is clear that both Opposer and Applicant each planned, independently and without knowledge of the other, to open a Korean barbeque restaurant using the name Honey Pig during the same time period in 2007, one in Duluth, Georgia and one 600 hundred miles away in Annandale, Virginia. But for construction delays at its business premises, Applicant would have opened its business in November 2007 . . . but instead, Applicant conducted a soft opening in January

¹² Opposer argues that it has priority of use of Honey Pig both as a service mark and as a trade name. 45 TTABVUE 12-14. Section 45 of the Trademark Act defines "trade name" as "any name used by a person to identify his or her business or vocation." 15 U.S.C. § 1127. We find that Opposer's use of "Honey Pig" as the name under which Opposer identified itself as doing business in various pre-opening documents, and in the trade name registration with the Gwinnett County Superior Court, do not establish priority because they did not expose the name to the public, or identify Opposer's nascent restaurant business to the public. *Nat'l Cable Television Ass'n Inc. v. Am. Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1427-29 (Fed. Cir. 1991); *see also TuTorTape Labs., Inc. v. Halvorson*, 155 USPQ 268, 270 (TTAB 1967); *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996) (considering use analogous to trademark use).

¹³ As noted above, the nature of Applicant's claimed "soft opening" of the restaurant in January 2008 is unclear, but even if the restaurant was not fully operational until sometime in February 2008, we find that Applicant's use of exterior signage for the restaurant bearing the words "Honey Pig Restaurant" beginning in January 2008 was sufficient to create rights in the mark as of then by virtue of use analogous to service mark use. *PacTel Teletrac*, 37 USPQ2d at 1881.

2008 with a full opening in February 2008. . . . The near simultaneous use of the mark is unique, and contrasts greatly to the reported cases addressing prior use that typically involve and establish one party's prior use for some significant period of time when opposing a registration or pursuing a cancellation. To the extent that Opposer is deemed to have established prior use, this fact by itself should not convey any deference to Opposer in that said initial use did not create any special level of fame, reputation or advantage, especially where the parties have concurrently used the specific mark from its inception for the past ten years. Instead, the near simultaneous timing of the use of the mark warrants a careful review of all of the unique and specific facts of this case, as applied to the applicable criteria[.]

46 TTABVUE 19.¹⁴

Applicant's implicit concession of Opposer's priority is consistent with its admissions in discovery, 29 TTABVUE 5-6 (Applicant's Responses to Opposer's Requests for Admission Nos. 1-6), and with the record evidence discussed above. We find that Opposer established its priority by a preponderance of the evidence, and turn now to the issue of likelihood of confusion.

B. Likelihood of Confusion

"Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of

¹⁴ As discussed below, Applicant argues that the translation of the Korean word "Gooldaegge" into English as "honey pig" is significant on the issue of likelihood of confusion. With respect to priority, however, Applicant does not argue that it can "tack" its public-facing use of "Gooldaegge" in Latin letters or Korean characters in its construction site signage and in its pre-opening advertisement onto its use of the words "Honey Pig Restaurant" on its restaurant signage beginning in January 2008 to establish use of HONEY PIG before Opposer's restaurant opened in December 2007. *See generally Hana Fin., Inc. v. Hana Bank*, ___ U.S. ___, 135 S. Ct. 907, 113 USPQ2d 1365 (2015); *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991).

likelihood of confusion, as set forth in *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).” *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015). “Not all of the *duPont* factors are relevant or of similar weight in every case.” *Opryland USA Inc. v. The Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992). We consider each *du Pont* factor that is relevant and for which there is record evidence. *See, e.g., M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark*, 114 USPQ2d at 1242.

The parties view the relative significance of the various *duPont* factors very differently. Opposer argues that the *duPont* factors regarding the similarity of the marks, services, and channels of trade are dispositive:

Opposer indisputably adopted the HONEY PIG mark prior to Applicant, and has valid, protectable common law rights in the mark HONEY PIG in connection with restaurant, catering, carry-out and bar services. Applicant should be denied registration of the HONEY PIG mark, the application for which designates identical goods [sic] in virtually identical channels of trade and, therefore, is likely to cause substantial confusion among consumers.

45 TTABVUE 6.

Applicant “does not contest that its HONEY PIG mark and the mark used by Opposer are (1) similar in appearance, sound, connotation and commercial impression or that the (2) services provided by both parties are similar.” 46 TTABVUE 20-21. Instead, it argues that “[w]hile these two *duPont* Factors initially weigh in favor of Opposer, the unique facts of this case as established by the record merit a finding that there is no reasonable basis for determining that there is a

likelihood of confusion.” 46 TTABVUE 21. Applicant relies on the seventh, eighth, twelfth, and thirteenth *duPont* factors: “the nature and extent of any actual confusion,” “the length of time during and conditions under which there has been concurrent use without evidence of actual confusion,” “the extent of potential confusion, i.e., whether de minimis or substantial,” and “[a]ny other established fact probative of the effect of use.” *duPont*, 177 USPQ at 567. 46 TTABVUE 21-25.

Applicant’s position is encapsulated in the first paragraph of the Argument section of its brief:

The facts of this case present a unique and maybe even rare situation where two parties, unbeknownst to each other, simultaneously initiated and carried through on plans to own and operate a restaurant business using the mark known as Honey Pig. As a result, the parties almost simultaneously opened their restaurants, and for the past ten years they have concurrently operated their businesses using the Honey Pig mark. The uniqueness of this case also includes the fact that the Applicant as of February 16, 2010, has owned the U.S. registration of GOOLDAEGEE KOREAN B.B.Q., U.S. Registration No. 3749135, for restaurant services . . . where said registration specifically sets forth that “Honey Pig” is the English translation of the Korean word “gooldaegee” Opposer has known of the application for and existence of the Gooldaegee Registration, as well as the English translation thereof, since its genesis. With this coexistence, the record also established that . . . in response to direct inquiries during discovery, Opposer is unable to establish even one example where there existed any confusion among consumers in the marketplace. Applicant submits that the specific and unique facts of this case support the granting of the Applicant’s registration.

46 TTABVUE 17-18.

We must analyze the record evidence on the various relevant *duPont* factors to determine their relative significance in our determination of likelihood of confusion.

1. Similarity of the Marks, Services, Channels of Trade, and Classes of Customers

As noted above, Applicant concedes that the similarity of the marks and the similarity of the services “initially weigh in favor of Opposer.” 46 TTABVUE 21. Irrespective of Applicant’s concession, however, the record shows that the services are legally identical and the literal portions of the marks are very similar, and we give substantial weight to these *duPont* factors in our analysis of likelihood of confusion 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.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Turning first to the similarity of the services, this *du Pont* 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). The analysis of this factor is premised upon the identifications of services in the application and in the cited registration. *Id.* at 1161-63; *Octocom Sys., Inc. v. Houston Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The “restaurant services” identified in Applicant’s application contain no restrictions or limitation as to their nature, and “thus must be construed to encompass all types of restaurant services,” *In re Binion*, 93 USPQ2d 1531, 1535 (TTAB 2009), including the Korean barbeque restaurant services offered by Opposer

under its common law mark.¹⁵ The parties' services are thus legally identical.¹⁶ *See Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (holding, in Section 2(d) analysis in concurrent use proceeding, that “[w]here an applicant identifies its services broadly, we must presume that the services encompass all services of the type identified” and that “‘Restaurant services,’ as identified in the application, encompass the services of both Defendants and, accordingly, we must deem the services at issue to be identical.”). The second *duPont* factor supports a finding of a likelihood of confusion.

The identification of services in the application is also unlimited in terms of the channels of trade and classes of customers for restaurant services, and we thus presume that they are rendered through all usual channels of trade to all usual customers for restaurant services. Those trade channels and customers encompass the demonstrated trade channels and customers for Opposer's Korean barbecue restaurant services. *Stone Lion*, 110 USPQ2d at 1161-62; *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).¹⁷ The third *duPont* factor thus

¹⁵ Applicant seeks registration of HONEY PIG for “restaurant, catering, restaurant carry-out and bar services” in International Class 41 but we focus on restaurant services because if a likelihood of confusion is found as to those services, registration may be refused as to all of the Class 41 services identified in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1325, 209 USPQ 986, 988 (CCPA 1981).

¹⁶ Applicant admitted that the parties' HONEY PIG marks are both used in connection with restaurant services, 29 TTABVUE 7 (Applicant's Response to Opposer's Request for Admission No. 10), and the record shows that both parties specialize in Korean barbecue. 30 TTABVUE 14 (Lee Tr. 13:14-20); 42 TTABVUE 66 (Opposer's Response to Applicant's Request for Admission No. 17); 43 TTABVUE 7, 19-20 (Kim Tr. 6:18-7:7; 18:10-15, 20-19:3).

¹⁷ The record shows that the channels of trade and classes of customers are in fact identical because both parties offer their restaurant services to consumers of Korean barbecue.

supports a finding of a likelihood of confusion. We turn next to the similarity of the marks.

This *du Pont* factor focuses on “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Cliquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). “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) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)). The legal identity of the services reduces the degree of similarity between the marks that is necessary for confusion to be likely. *See, e.g., Viterra*, 101 USPQ2d at 1912; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. On the other hand, 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, provided the ultimate conclusion rests on consideration of the marks in their entireties.

In re Nat'l Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In the case of a composite word-and-design mark such as Opposer's,¹⁸ "the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed." *Viterra*, 101 USPQ2d at 1908 (quoting *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). The record shows that the words "Honey Pig" are the portion of Opposer's mark that is used to identify Opposer's restaurant in textual references, 30 TTABVUE 172, 174, 176-178, and we infer that "Honey Pig" would also be used to identify Opposer's restaurant when Opposer's common law mark is verbalized.

The identity of Applicant's standard character mark HONEY PIG in sound to Opposer's mark when it is verbalized is especially significant in our analysis of the similarity of the marks "in view of the propensity of persons to try restaurants based on word-of-mouth recommendations." *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); *see also In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (because "restaurants are often recommended by word of mouth and referred to orally," the word portion of a restaurant mark "is more likely to be impressed on the consumer's memory.") (Internal quotation omitted)). We also find that Applicant's mark HONEY PIG is identical in meaning to the words "Honey Pig"

¹⁸ As noted above, the record indicates that Opposer has used the words "Honey Pig" as part of two composite marks, the one shown in its abandoned Application Serial No. 77796974 and discussed by Mr. Lee in his testimony, and the one shown on the sign in the picture that appears in the December 2015 review of Opposer's restaurant. Our analysis of the similarity of Opposer's composite marks to Applicant's standard character mark is the same for both composite marks, and, like Applicant, 46 TTABVUE 20, we will consider Opposer's use of HONEY PIG to involve one mark and will refer to that mark in the singular.

in Opposer's mark in the context of the use of the marks in connection with restaurant services.

With respect to the marks' appearance, Applicant seeks registration of HONEY PIG in standard characters, and we thus must assume that those words "may be displayed in any lettering style," including in "the same manner of display" as the stylized words "Honey Pig" in Opposer's mark. *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1823 (TTAB 2015) (a standard character mark "could be used in any typeface, color, or size, including the same stylization actually used . . . by the other party, or one that minimizes the differences or emphasizes the similarities between the marks.") (citing *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011)).

The marks are identical in sound, connotation, and commercial impression, and similar in appearance, and the first *duPont* factor, like the second and third factors, supports a finding of a likelihood of confusion.

"Absent other *duPont* factors, the virtual identity in the marks, and the identity in the [services], trade channels, and purchasers . . . presents a compelling case for finding a likelihood of confusion." *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1961 (TTAB 2016) (considering impact of consent agreement on likelihood of confusion where all other *duPont* factors supported a finding of a likelihood of confusion and concluding that agreement was outweighed by other factors). We thus must determine whether the other relevant *duPont* factors are sufficient to overcome a "compelling case for finding a likelihood of confusion." *Id.* We begin with the

thirteenth *duPont* factor, “[a]ny other established fact probative of the effect of use.” *duPont*, 177 USPQ at 567.

2. The Thirteenth *duPont* Factor

Applicant’s discussion of the thirteenth *duPont* factor focuses primarily on the existence of Applicant’s Registration No. 3749135 for the mark shown below for restaurant and bar services.



46 TTABVUE 21-24.

As noted above, Applicant pleaded an affirmative defense in its answer regarding this registration. 4 TTABVUE 4. That defense appeared to invoke *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969), which held that an “opposer cannot be damaged, within the meaning of section 13 of the statute, by the issuance to applicant of a second registration where applicant already has an existing registration of the same mark for the same goods.” *Id.* at 717. “The *Morehouse* defense is an equitable doctrine that applies where an applicant owns a prior registration for essentially the same mark identifying essentially the same goods (or services) that are the subject mark and goods of the proposed application.” *Green Spot (Thailand) Ltd. v. Vitasoy Int’l Holdings*, 86 USPQ2d 1283, 1285 (TTAB 2008). “In such case, ‘the opposer cannot be further injured because there already exists an

injurious registration,’ and therefore the additional registration does not add to the injury.” *Id.* (quoting *O-M Bread Inc. v. U.S. Olympic Comm.*, 65 F.3d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995)).

Opposer addressed Applicant’s putative *Morehouse* defense at length in Opposer’s brief, 45 TTABVUE 16-20, but Applicant did not specifically address the defense in its brief, and thus waived it. *See* note 2 *supra*. Applicant argues instead that its ownership of Registration No. 3749135 “presents a unique situation supporting Applicant’s registration of the Honey Pig mark.” 46 TTABVUE 21. Applicant cites *In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012),¹⁹ for the proposition that the Board has “recognized that pursuant to the thirteenth *duPont* Factor requiring the consideration of any other established fact probative of the effect of use,” each case must “be decided on its own specific and sometimes, unique facts that in turn create[] the need for flexibility in making such assessments.” 46 TTABVUE 21. Applicant argues that the existence of Registration No. 3749135, Opposer’s inaction against it, and the coexistence of the parties’ marks, outweigh the other *duPont* factors that support a finding of a likelihood of confusion. 46 TTABVUE 21-24.

In *Strategic Partners*, the Board reversed a refusal to register the slightly stylized mark ANYWEAR for footwear on the basis of a registration of ANYWEAR BY JOSIE NATORI and design for various items of clothing. The applicant’s primary argument was that it owned an incontestable registration of ANYWEARS in standard characters for footwear. The Board briefly analyzed the first, second, third, and fourth

¹⁹ Applicant miscites the case as appearing at 103 USPQ2d 1397. 46 TTABVUE 20-21.

duPont factors, *id.* at 1398-99, and stated that it “would conclude, under usual circumstances, that confusion is likely to occur among consumers in the marketplace,” but that “[t]here is an unusual situation in the present case . . . which must be considered in our analysis.” 102 USPQ2d at 1399. The Board found that it “must balance the similarities between the marks and goods against the fact that applicant already owns a registration for a substantially similar mark for the identical goods, and that applicant’s registration and the cited registration have coexisted for over five years,” such that the applicant’s registration was not subject to cancellation on the basis of priority and likelihood of confusion. *Id.*

The Board was careful to note that it “was not applying the so-called *Morehouse* defense,” which “does not apply in an *ex parte* context,” *id.* at 1399-1400, but that in “the unique situation presented by the coexistence of applicant’s existing registration with the cited registration for over five years, when applicant’s applied-for mark is substantially similar to its existing registered mark, both for identical goods,” the thirteenth *duPont* factor “outweighs the others and leads us to conclude that confusion is unlikely.” *Id.* at 1400.

There are similarities between *Strategic Partners* and this case. In both cases, the applicants sought new registrations for goods or services that were identical to some of those covered by their existing registrations, and the existing registrations were more than five years old, and thus invulnerable to cancellation on the ground of priority and likelihood of confusion.²⁰ We find, however, that there are several

²⁰ Moreover, in this case, the invulnerability of Applicant’s registration to cancellation on that ground resulted from Opposer’s decision not to make good on its threat to seek cancellation

reasons why the differences between *Strategic Partners* and this case are more significant than the similarities.

First, *Strategic Partners* was an ex parte case in which the *Morehouse* prior registration defense was not available to the stymied applicant. In this inter partes case, the defense was available and pleaded, but ultimately not pursued. Applicant cites no inter partes case, and we have found none, in which the Board's analysis in *Strategic Partners* of the impact of a prior registration was applied under the thirteenth *duPont* factor to support a finding of no likelihood of confusion.

Second, Applicant's argument under *Strategic Partners* focuses primarily on Applicant's claim that "Opposer has failed to present a single piece of evidence that the coexistence [of the registered mark and Opposer's mark] has led to any actual confusion." 46 TTABVUE 22, 23.²¹ In *Strategic Partners*, the Board did not address, much less rely on, the absence of actual confusion during the period of coexistence of applicant's registration and the cited registration. In this inter partes case, the significance of the coexistence, without actual confusion, of the parties' marks, including Applicant's previously-registered mark,²² can be taken into account in the

of Applicant's registration on that ground, which Opposer made before the registration became five years old. Kim Tr. 16:6-17:17; Ex. 3 (43 TTABVUE 50-52).

²¹ Applicant also argues that "Opposer knew of the Applicant's 'Gooldaegge' registration and that it literally translated to 'Honey pig', yet took no action to attack Applicant's registration" and that "Opposer's inaction to protect its rights runs contrary to any argument Opposer attempts to generate that actual confusion ever arose, let alone resulted in any damage." 46 TTABVUE 22. Applicant pleaded an estoppel defense in its answer, 4 TTABVUE 4, but we do not interpret these arguments, made under the thirteenth *duPont* factor, to reflect pursuit of Applicant's estoppel defense, and we deem it waived.

²² In that regard, we note that there is no evidence in the record regarding the extent of use of Applicant's registered mark per se. Kim Tr. 9:1-10:8; 11:3-17, 22-16:1; Exs. 1-2 (43 TTABVUE 43-49). The exterior signage for Applicant's restaurant displays dispersed

analysis of likelihood of confusion under the seventh, eighth, and twelfth *duPont* factors, which we discuss below, on the basis of evidence of both parties' uses of their marks, evidence that is unavailable in an ex parte case. *See, e.g., In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-17 (TTAB 1984) (a claim of no "actual confusion as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding where we have no evidence pertaining to the nature and extent of the use by applicant and registrant" and "the registrant has no chance to be heard from . . .").

Finally, the applied-for and registered marks here differ far more than did their counterparts in *Strategic Partners*. In *Strategic Partners*, the applied-for mark consisted of the word "Anywear" in the stylized font shown below

ANYWEAR

whereas the registered mark was the word ANYWEARS in standard characters. 102 USPQ2d at 1397. The Board found that there was "no meaningful difference between the standard character and stylized versions of applicant's marks," or between the singular and plural forms of the word ANYWEAR, *id.* at 1399, that the "applicant's existing registration of ANYWEARS in standard character form means that the mark can be depicted in the identical font style in which applicant's applied-for mark is shown," *id.*, and that "[p]urchasers are unlikely to perceive any distinction in overall

elements of the registered mark, but not the exact mark that is shown in the registration. Kim Tr. 28:12-29:11; Ex. 7 (43 TTABVUE 76). Applicant's specimens of use submitted to register the mark and to maintain the registration consisted of gift cards, 27 TTABVUE 19, 57, but Ms. Kim did not testify regarding the extent or frequency of their distribution, and she did not testify regarding other uses of the registered mark in Applicant's business.

commercial impression between ANYWEARS and ANYWHERE.” Indeed, although the Board described the applied-for and registered marks as merely “substantially similar,” *id.*, the Board’s analysis of the nature of their similarity strongly suggests that if a *Morehouse* argument had been available to the applicant, it would have succeeded because the applied-for and registered marks would have been found to be “essentially the same mark.” *Green Spot (Thailand)*, 86 USPQ2d at 1285.

The applied-for mark here consists of the English words HONEY PIG in standard characters, whereas the registered composite mark contains translation of these terms, along with a design and other literal elements. Applicant argues that “the doctrine of foreign equivalents as applied to facts of this case further supports the rationale in *Strategic Partners*, and that it should be applied to the established facts of this case.” 46 TTABVUE 22. According to Applicant, “[i]f any other party filed an application to register the mark HONEY PIG, the existence of Applicant’s registration for GOOLDAEGEE KOREAN B.B.Q. would likely bar that registration under the doctrine of foreign equivalents” because “the foreign word in Applicant’s registration is ‘Gooldaegee,’ and, as established, the English equivalent of ‘Gooldaegee’ is ‘honey pig.’” 46 TTABVUE 22-23.²³ Applicant cites Opposer’s abandoned application to register its composite mark and suggests that its applied-

²³ The issue of the registrability of HONEY PIG by “any other party,” or by Opposer itself, is, of course, not before us. If Opposer re-files to register HONEY PIG following our decision in this case, the Patent and Trademark Office will determine whether Opposer’s mark is eligible for registration over Applicant’s registered mark on the basis of the record in that case, and will not be bound by the action of the examining attorney on Opposer’s 2009 application, or by our decision here, which involves different marks. *See, e.g., In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1634-35 (Fed. Cir. 2016); *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017).

for mark and its registered mark are “substantially similar,” as the Board described the counterpart marks in *Strategic Partners*, under the doctrine of foreign equivalents:

When Opposer filed its application to register HONEY PIG, U.S. Serial No. 77796974, the USPTO issued an office action on the grounds that Applicant’s the[n] pending application to register GOOLDAEGEE KOREAN B.B.Q. may present a bar to Opposer’s registration because “Gooldaegee” translates to “honey pig”. . . . A number of years later, after Applicant’s GOOLDAEGEE KOREAN B.B.Q. mark registered, Opposer acknowledged, in a letter dated December 15, 2014, sent to Applicant from Opposer’s then attorney, that Applicant’s registration of GOOLDAEGEE KOREAN B.B.Q. prevented Opposer from registering HONEY PIG because “Gooldaegee” translates to “honey pig”. . . .

46 TTABVUE 23.

As discussed above in connection with the first *duPont* factor, the similarity of marks is assessed by comparing them in appearance, sound, and connotation and commercial impression. The doctrine of foreign equivalents typically focuses on the similarity of marks in meaning, *Green Spot (Thailand)*, 86 USPQ2d at 1286 n.9 (considering *Morehouse* defense), and similarity in meaning resulting from the application of the doctrine of foreign equivalents may be outweighed by dissimilarity in the other means of comparison. *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) (SECOND CHANCE and REPECHAGE found not to be confusingly similar under the doctrine of equivalents because “such similarity as there is in connotation must be weighed against the dissimilarity in appearance, sound, and all other factors, before reaching a conclusion on likelihood of confusion as to source.”).

Applicant's applied-for mark HONEY PIG in standard characters and its registered composite mark may have some similarity in meaning for speakers of both English and Korean because, as the parties agree, the Romanized word "Gooldaegee" and the corresponding Korean characters in the registered mark mean "Honey Pig" in English. Unlike Applicant's applied-for standard character mark, however, the registered mark contains significant design and other verbal elements, and the two marks are thus quite different in appearance and sound. In contrast to the marks in *Strategic Partners*, the applied-for and registered marks here have meaningful differences and are not substantially similar for consumers who speak both Korean and English, and for consumers who do not speak Korean, they are quite dissimilar.²⁴

Applicant's composite mark has been registered for more than eight years and it has coexisted with Opposer's mark for more than 10 years, and both periods are longer than their counterparts in *Strategic Partners*. Nevertheless, given the differences between Applicant's applied-for and registered marks, and the lack of evidence regarding the extent of use of the registered mark, we find that if, in this inter partes case, the "co-existence of Applicant's prior registration and [Opposer's mark] is a relevant consideration, it does not outweigh the other *duPont* factors in this case." *USA Warriors Ice Hockey Program*, 122 USPQ2d at 1793.

²⁴ The record shows that both parties provide their services to non-Korean speakers as well as Korean speakers, as their signage uses "Honey Pig" in English. Lee Tr. 12:5-13:6; Kim Tr. 28:2-29:11; Ex. 7 (43 TTABVUE 76).

3. The Seventh, Eighth, and Twelfth *duPont* Factors

The seventh and eighth *duPont* factors are “the nature and extent of any actual confusion,” and “the length of time during and conditions under which there has been concurrent use without evidence of actual confusion,” respectively. *duPont*, 177 USPQ at 567. The twelfth *duPont* factor is “the extent of potential confusion, i.e., whether de minimis or substantial.” *Id.*

Opposer argues that actual confusion has occurred, claiming that Mr. Lee testified that he “has received inquiries from customers as to the ownership or sponsorship of the Annandale Restaurant after it began using the HONEY PIG mark, believing that the Duluth Restaurant and Annandale Restaurant were commonly owned or controlled.” 45 TTABVUE 15. In the cited portion of his testimony, Mr. Lee claims only that he learned of the existence of Applicant some time in 2008 “[t]hrough other people talking” about how “there was a similar version of this that popped up.” Lee Tr. 14:7-16. We cannot find, on the basis of this snippet of testimony, that “customers” inquired “as to the ownership or sponsorship of Applicant’s restaurant,” much less that they believed that the parties’ restaurants “were commonly owned or controlled.” 45 TTABVUE 15. We agree with Applicant that Opposer has not shown the existence of any instances of actual confusion.

It is, of course, unnecessary to show actual confusion to establish a likelihood of confusion. *Herbko Int’l*, 64 USPQ2d at 1380; *Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842 (Fed. Cir. 1990). The absence of any reported instances of actual confusion is meaningful under the eighth *duPont* factor only if the

record indicates appreciable and continuous use by the parties of their marks for a significant period of time in the same markets. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). “In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred.” *Citigroup*, 94 USPQ2d at 1660.

Applicant does not address this issue beyond stating the truism that “the parties have concurrently used the Honey Pig mark going back approximately ten years to the very inception of the mark as used by these two parties.” 46 TTABVUE 24. As Applicant acknowledges, the parties have used their respective marks during that period in restaurants “in Duluth, Georgia and [in] one 600 hundred [sic] miles away in Annandale, Virginia.” 46 TTABVUE 19. Applicant argues that “Opposer does not use the name ‘Honey Pig’ for any business or restaurant other than one business location in Duluth, Georgia,” that “Opposer’s use of the HONEY PIG mark is not well known,” and that there is “no evidence that [Opposer’s] restaurant has been featured or advertised outside of the Atlanta, Georgia area,” 46 TTABVUE 12-13,²⁵ and the record supports these arguments.²⁶

²⁵ We take judicial notice that Duluth, Georgia is a suburb of Atlanta. *In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1744 n.4 (TTAB 2016).

²⁶ Opposer claims that it “has developed a strong reputation for its high quality Korean barbecue and restaurant services, not only in Georgia but across the United States,” 45 TTABVUE 9, but the cited testimony and exhibits, Lee Tr. 13:21-14:6; Exs. 8-10 (30 TTABVUE 172-186), do not support that claim. The articles about Opposer’s restaurant appeared in Atlanta-based online publications and there is nothing in the record to show their exposure “across the United States.” Mr. Lee also did not testify about other exposure

Even assuming that the parties' restaurants to some degree "attract the travelling public" to their respective locations, *America's Best Franchising Inc. v. Abbott*, 106 USPQ2d 1540, 1552 (TTAB 2013) (quoting *Brennan's, Inc. v. Brennan's Rest., LLC*, 360 F.3d 125, 69 USPQ2d 1939, 1944 (2d Cir. 2004)), we find that the "lack of evidence of actual confusion, despite contemporaneous use of the parties' marks for a period of [10] years, is not significant given the circumstances of the parties' respective uses." *Carl Karcher Enters.*, 35 USPQ2d at 1133 (finding that the absence of actual confusion between the parties' restaurant marks "is easily explained by the fact that the parties operate in different geographic areas."). This *duPont* factor and the twelfth *duPont* factor are neutral.

4. Balancing the *duPont* Factors

The marks are similar in appearance, and identical in meaning and sound, and the services, channels of trade, and classes of customers are legally identical. Taken together, these *duPont* factors strongly support a finding of a likelihood of confusion, and they outweigh the facts that Opposer's mark has coexisted with Applicant's registered composite mark, and that there has been no proven instances of actual confusion during the 10 years of simultaneous operation of the parties' restaurants in different states.

of the restaurant outside the Atlanta area, and Opposer's annual sales figures between \$1.5 million and \$2 million for the years 2012-2016, Lee Tr. 25:14-27:8, are relatively modest and do not provide a basis on which to find that Opposer has established a national reputation. *Cf. Carl Karcher Enters. Inc. v. Stars Rests. Corp.*, 35 USPQ2d 1125, 1130 (TTAB 1995) (sales of restaurant services in excess of \$3 billion over seven-year period, supported by many millions of dollars in advertising, did not establish restaurant chain's national fame, but only "local notoriety in its trading area.").

V. Conclusion

We find that Opposer proved, by a preponderance of the evidence, that it has priority of use of its common law mark containing the words HONEY PIG, and that Applicant's use of HONEY PIG in standard characters for restaurant services is likely to cause confusion as to the source or sponsorship of those services.

Decision: The opposition is sustained.