

This Opinion is Not a
Precedent of the TTAB

Mailed: April 28, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Couscous Maghrebi Grill LLC
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Serial No. 98085780
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Mark C. Johnson of Johnson | Dalal,
for Couscous Maghrebi Grill LLC.

Lyal Fox, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

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Before Lykos, Cohen and Stanley,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Couscous Maghrebi Grill LLC (“Applicant”) seeks registration on the Principal
Register of the mark COUSABLANCA in standard characters for

Restaurants; Restaurant services; Restaurant services featuring North African cuisine; Restaurant services, including sit-down service of food and take-out restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises; Restaurant and bar services, including restaurant carryout

services; Take-out restaurant services in International Class 43.¹

Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's applied-for mark so resembles the registered standard character mark CASABLANCA on the Principal Register for "Hotel and restaurant services" in International Class 43 that, when used on or in connection with Applicant's identified services, it is likely to cause confusion or mistake or to deceive.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Trademark Examining Attorney denied the request for reconsideration,³ the appeal was resumed and is now fully briefed.⁴ For the reasons explained below, we reverse the refusal to register.

I. Examining Attorney's Objection

Applicant submitted with its appeal brief as exhibits materials that appear to be the entire evidentiary record. The Examining Attorney notes that "some exhibits are

¹ Application Serial No. 98085780, filed July 14, 2023, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce.

² Registration No. 3191159, registered January 2, 2007; renewed.

³ On September 3, 2024, Applicant erroneously submitted two identical requests for reconsideration. Each request contained, verbatim, the same evidence and arguments from Applicant's May 16, 2024 Response to Office Action. As aptly put by the Examining Attorney, the Office and the Board frowns upon resubmission of identical evidence and arguments because it creates unnecessary delay. September 6, 2024 Denial of Request for Reconsideration at TSDR 1 and Examining Attorney's Brief, 10 TTABVUE 2.

Citations to the prosecution file are to the USPTO's TRADEMARK STATUS & DOCUMENT RETRIEVAL ("TSDR") system in .pdf format. Citations to the appeal record are to TTABVUE, the Board's online docketing system.

⁴ Applicant's operative main brief may be found at 8 TTABVUE.

in different order, and therefore, to the extent any new or altered evidence has been added that was not previously of record, [the] examining attorney objects to such evidence.”⁵ The objection is sustained. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); *see, e.g., In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018) (untimely evidence not considered). Any new or altered evidence has not been considered.

Applicant is also reminded that attaching materials to briefs is neither a courtesy nor a convenience to Board, and requires more time and effort on the Board’s part to ascertain which materials have been previously made of record. *In re Michalko*, 110 USPQ2d 1949, 1950-51 (TTAB 2014). Citation directly to the record is advised. Trademark Rule 2.142, 37 C.F.R. § 2.142(b)(3). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (Oct. 7, 2016) (“The Office is adding new § 2.142(b)(3) to specify that citation to evidence in briefs should be to the documents in the electronic application record by date, the name of the paper under which the evidence was submitted, and the page number in the electronic record. The amendment is intended to facilitate review of record evidence by the applicant, the examining attorney, the Board, and the public.”).

II. Likelihood of Confusion

We now turn to the substantive refusal before us. 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

⁵ 10 TTABVUE 3.

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

Our determination under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In making our determination, the Board has considered 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).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented, *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011), so long as we “explain the results of that weighing” and “the weight [we] assigned to the relevant factors.” *In re Charger Ventures LLC*, 65 F.4th 1375, 2023 USPQ2d 451, at *7 (Fed. Cir. 2023). “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). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *see also 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.”). These factors, and the others, are discussed below.

It is undisputed that both the application and registration include “restaurants” or the legal equivalent thereof.⁶ *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (“The relevant inquiry . . . focuses on the goods and services described in the application and registration.”). Because the services are identical in part, we must presume that these services travel in the same channels of trade to the same classes of consumers. *See In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). The second and third *DuPont* factors therefore weigh heavily in favor of finding a likelihood of confusion.

The fourth factor also weighs in favor of finding a likelihood of confusion because ordinary consumers of restaurant services are likely to exercise only ordinary care, especially given the lack of price restrictions in the identifications. *See Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1325 (Fed. Cir. 2014) (where the identifications are unrestricted, Board bases analysis “on the least sophisticated potential purchasers.”). The sixth factor is neutral because Applicant was unable to show that the cited mark CASABLANCA is either commercially or conceptually weak. Of the thirty (30) third-party registrations for marks comprised or consisting of CASABLANCA Applicant made of record, none are for goods or services that are

⁶ Applicant does not address the second *DuPont* factor in its brief.

either identical or “similar” to restaurant services.⁷ *See, e.g., Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694 (Fed. Cir. 2018) (products, such as “popcorn,” “wine,” “oriental foods,” and “alcoholic beverages” “bear no relationship to meat or meat-based products” and therefore “are not “similar” to meat products.”).

That being said, a single *DuPont* factor may be dispositive, and when we compare the marks, we find that to be the case here.⁸ *See Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020) (“Any single factor may control a particular case.”); *Kellogg Co. v. Pack’em Enter. Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (same). The first *DuPont* factor involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks,

⁷ May 16, 2024 Response to Office Action at TSDR 47-104. Two of the registrations are not third-party registrations because they are owned by Registrant; indeed, one of the registrations is the cited registration. *Id.* at 56 and 68 (Reg. Nos. 3191159 and 4450986).

⁸ Applicant’s argument that Registrant’s actual use of the CASABLANCA mark in connection with its house mark misses the point. Applicant’s Brief, 8 TTABVUE 12-15. Unlike federal district court litigation, in an *ex parte* appeal before the Board, our analysis is based on the marks as depicted in the application and cited registration without regard to whether the marks will appear with a house mark (whether previously registered or not) or other elements. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993) (applicant’s arguments that the applied-for mark would appear with applicant’s house mark not considered); *see also In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) (“[W]e do not consider how Applicant and Registrant actually use their marks in the marketplace, but rather how they appear in the registration and the application. We must compare the marks as they appear in the drawings, and not on any labels that may have additional wording or information.”).

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).

The marks COUSABLANCA and CASABLANCA are similar in sound and appearance. The only distinction is that the diphthong “ou” in Applicant’s mark has been substituted for the letter “a” in the cited mark. That distinction, however, is critical here. Consumers are generally more inclined to focus on the first syllable or prefix in a mark, *see, e.g., Palm Bay Imps.*, 73 USPQ2d at 1692, and the first syllable in each word distinguishes the marks in connotation and commercial impression.

Registrant’s mark CASABLANCA connotes not only the “city and port on the Atlantic in Western Morocco,”⁹ but also the iconic Warner Brothers film starring Humphrey Bogart and Ingrid Bergman. The specimen submitted during prosecution of the cited registration, reproduced below, confirms that Registrant’s mark CASABLANCA connotes both the city and movie of the same name, as it shows that Registrant promotes its services in a way to remind consumers of the film “Casablanca.” *Cf. In re Integrated Embedded*, 120 USPQ2d 1504, 1510 (TTAB 2016) (holding BARR GROUP primarily merely a surname, noting evidence that applicant’s co-founder, Michael Barr, is prominently featured on specimens, which also indicate that applicant derived its name from him); *Société Civile Des Domaines Dourthe*

⁹ “Casablanca.” *Merriam-Webster.com Dictionary*, MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/Casablanca>. Accessed 16 May 2024. Submitted with May 16, 2024 Response to Office Action at TSDR 37.

Frères v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde, 6 USPQ2d 1205, 1208 (TTAB 1988) (holding DOURTHE primarily merely a surname, the Board noted applicant’s references to “Dourthe” as the name of a particular family and found the surname significance of the term to be reinforced by the appearance on applicant’s wine labels of the name and/or signature of an individual named Pierre Dourthe). It consists of an advertising brochure displaying a photo of Humphrey Bogart and Ingrid Bergman, along with the quote “I think this is the beginning of a beautiful friendship” and directly credits the 1942 film “Casablanca.”¹⁰

¹⁰ Registrant’s Specimen, submitted with May 16, 2024 Response to Office Action at TSDR 41.





*"I think this is
the beginning
of a beautiful friendship"*

"Casablanca" the movie - WARNER BROTHERS 1942

THE ROMANCE OF CASABLANCA

Celebrated as one of New York City's most popular hotels, the Casablanca Hotel is a hidden gem, just steps away from vibrant Times Square. Inspired by the romance of the movie "Casablanca", this oasis of luminous Moroccan glamour and hospitality is only outshined by its talented and eager to please staff.

COMPLIMENTARY AMENITIES

Complimentary refreshments are served 24 hours a day in Rick's Café, including a lavish European style breakfast buffet provided every morning, international coffees and a selection of teas, cookies, pastries and fresh fruit served throughout the day, plus a wine and cheese reception every evening from 5-8 p.m.

Live Piano Entertainment on Friday evenings

Guest passes to New York Sports Clubs

Selection of local newspapers

DVDs and books

Computer Station in Rick's Café

High speed DSL/WiFi Internet access throughout the hotel

CASABLANCA HOTEL

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By contrast, Applicant's mark COUSABLANCA combines the word "couscous" with "Casablanca" to create a portmanteau referencing culinary dishes from that region. "Couscous" is "a North African dish of steamed semolina usually served with meat or vegetables."¹¹ The unique spelling of "Casablanca" as COUSABLANCA when used in connection with restaurants services results in a clever double entendre. The primary connotation and commercial impression reflect that of a restaurant specializing in Moroccan dishes¹² serving couscous from Casablanca. Thus, Applicant's mark has its own unique humorous play on words that projects a separate meaning and commercial impression distinct from the film. As a result, when confronted with both marks, prospective consumers are unlikely to assume that Applicant's and Registrant's respective goods originate from the same source.

Any of the *DuPont* factors may play a dominant role. *DuPont*, 177 USPQ at 567. In some cases, the first *DuPont* factor may be dispositive, even when the second and third factors weigh heavily in favor of finding a likelihood of confusion. *See e.g., Kellogg Co. v. Pack'em*, 21 USPQ2d 1142 (the marks FROOTEE ICE and FROOT LOOPS are so different that, even if the goods, channels of trade, and customer classes were the same, confusion would still be unlikely). Here, the dissimilarity of the marks in meaning and commercial impression are so great as to outweigh the second, third and fourth *DuPont* factors discussed above. For that reason, we conclude

¹¹ "Couscous." *Merriam-Webster.com Dictionary*, MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/couscous>. Accessed 16 May 2024. Submitted with May 16, 2024 Response to Office Action at TSDR 43.

¹² Indeed, a portion of the identification of services in the Application describes the restaurant services as featuring "North African cuisine."

that the first *DuPont* factor is pivotal, meaning that Applicant's mark is unlikely to cause confusion with the cited mark for the identified services.

Decision: The Section 2(d) refusal is reversed.