

This Opinion is not a
Precedent of the TTAB

Mailed: January 25, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Shaffer Young LLC
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Serial No. 86590798
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H. Michael Drumm of Drumm Law LLC,
for Shaffer Young LLC.

Samuel R. Paquin, Trademark Examining Attorney, Law Office 101,
Ronald R. Sussman, Managing Attorney.

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Before Bergsman, Goodman and Coggins,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Shaffer Young LLC (“Applicant”) seeks registration on the Principal Register of the mark BLUE OWL BREWING (in standard characters) for “bar services; taproom services; taproom services featuring beer brewed on premises,” in Class 43.¹ Applicant disclaimed the exclusive right to use the word “Brewing.”

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¹ Application Serial No. 86590798 was filed on April 8, 2015, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used in connection with the activities in the description of services, so resembles the registered mark BLUE OWL for "restaurant services, namely, providing of food and beverages for consumption on and off the premises," in Class 43, as to be likely to cause confusion.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

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 likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*") (cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 135 S.Ct. 1293, 113 USPQ2d 2045, 2049 (2015)); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant and for which there is evidence of record. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) ("While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant."). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the

² Registration No. 3973565, registered on June 7, 2011.

similarities between the goods and/or services. *See In re Chatam Int'l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015).

A. The similarity or dissimilarity of the marks.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In comparing the marks, we are mindful that “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver &*

Winston, Inc., 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Since the services at issue are restaurant services, bar services, and taproom services without any limitations, the average customer is an ordinary consumer.

The marks are similar because they share the unitary term “Blue Owl.”³ Inasmuch as there is no evidence to the contrary or providing an alternative interpretation, the mark means and engenders the commercial impression of a blue-colored owl. As such the term “Blue Owl” is arbitrary when used in connection with restaurant services and, therefore, it is entitled to a broad scope of protection or exclusivity of use.

The marks are different because Applicant’s mark includes the descriptive word “Brewing.” However, it is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations and, therefore, we find that “Blue Owl” is the dominant part of Applicant’s mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is

³ Applicant concedes that “Blue Owl” is a unitary term by referring to it as a “single word.” *See Applicant’s Brief*, p. 4 (7 TTABVUE 7) (“The single word BLUE OWL, by itself, carries no association with beer or brewing.”).

often “less significant in creating the mark’s commercial impression”). There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Further reinforcing the significance of the term “Blue Owl” as the dominant part of Applicant’s mark BLUE OWL BREWING is its position as the first part of the mark. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *Presto Prod. Inc. v. Nice-Pak Prod., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”).

Under the circumstances discussed above (*i.e.*, BLUE OWL is an arbitrary term, BLUE OWL is the dominant part of Applicant’s mark, and the word “Brewing” is descriptive), the fact Registrant’s mark BLUE OWL is subsumed by Applicant’s mark BLUE OWL BREWING increases the similarity between the two. *See, e.g., Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (applicant’s mark BENGAL LANCER for club

soda, quinine water and ginger ale is likely to cause confusion with BENGAL for gin); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (applicant's mark VANTAGE TITAN for medical magnetic resonance imaging diagnostic apparatus confusingly similar to TITAN for medical ultrasound diagnostic apparatus); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (applicant's mark MACHO COMBOS for food items confusingly similar to MACHO for restaurant entrees).

Applicant argues that the addition of the word "Brewing" distinguishes its mark BLUE OWL BREWING from the BLUE OWL registration because it "intrinsically identifies a maker of beer."⁴ Applicant contends that the 17 sets of registrations for similar marks for restaurant services and bar services distinguished by the addition of descriptive words such as "beer," "brewing," "ale," *etc.* corroborate its argument.⁵ The following registrations submitted with Applicant's August 8, 2016 Request for Reconsideration are representative:

- EPIPHANY ALE for beer (Registration No. 3873558) and THE EPIPHANY for restaurant and bar services (Registration No. 4568785);
 - BARREL BOTTLE for bottles containing beer (Registration No. 0995937) and THE BARREL for bar and restaurant services;
 - CABIN FEVER ALE for beer (Registration No. 3180241) and CABIN FEVER COFFEE for coffee shops and fast-food restaurants (Registration No. 3205714);
- and

⁴ Applicant's Brief, p. 4 (7 TTABVUE 7).

⁵ Applicant's Brief, p. 4 (7 TTABVUE 7). *See also* Applicant's August 8, 2016 Request for Reconsideration making the registrations of record. (4 TTABVUE 17-57).

- EPIC BREWING for brewery services and restaurant services (Registration No. 4214386) and EPIC SMOKEHOUSE for restaurant services (Registration No. 4493764) and EPIC BUFFET for restaurant services (Registration No. 4399890) and EPIC BURGER for restaurant services (Registration No. 3584153) (all owned by different entities).

In the registrations noted by Applicant, the USPTO registered similar marks for beer and restaurant or bar services. However, the case before involves similar marks for restaurant and bar or taproom services. Assuming *arguendo* that the registrations referred to by Applicant do indeed corroborate its position, it is still our well-settled practice that each application must be evaluated on its own set of facts. As the Board stated in *In re BankAmerica Corp.*, 231 USPQ 873, 876 (TTAB 1986):

The cases are legion holding that each application for registration of a mark for particular goods or services must be separately evaluated. See, for example, *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985) [other citations omitted]. Section 20 of the Trademark Act, 15 USC Section 1070, gives the Board the authority and duty to decide an appeal from an adverse final decision of the Examining Attorney. This duty may not be delegated by adoption of conclusions reached by Examining Attorneys on different records.

Suffice it to say that each case must be decided on its own merits based on the evidence of record. We obviously are not privy to the record in the files of the registered marks and, in any event, the issuance of a registration(s) by a Trademark

Examining Attorney cannot control the result of another case.⁶ *See In re Sunmarks Inc.*, 32 USPQ 1470, 1472 (TTAB 1994). These prior registrations do not conclusively rebut the Trademark Examining Attorney's argument that the marks are similar. Even if some prior registrations with characteristics similar to the marks at issue were registered, the registration of those marks does not bind the Trademark Examining Attorney or this Board. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

We find that Applicant's mark BLUE OWL BREWING is similar to the registered mark BLUE OWL in terms of appearance, sound, connotation and commercial impression.

B. The similarity or dissimilarity and nature of the services.

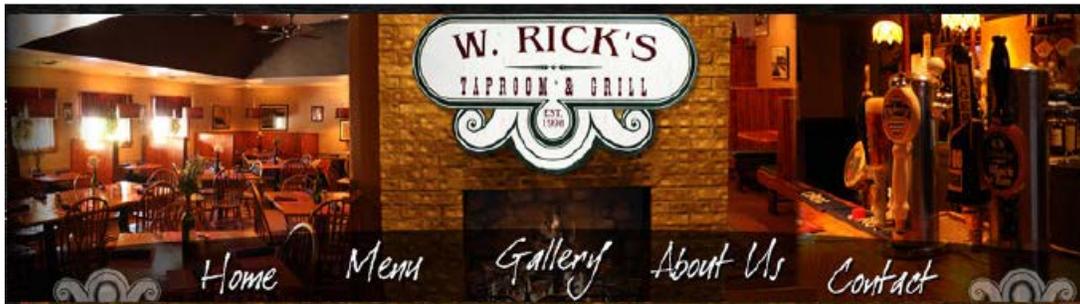
In determining whether the services are related, it is not necessary that Applicant's services and Registrant's services be similar or competitive in character to support a holding of likelihood of confusion; it is sufficient for such purposes that the services are related in some manner and/or that conditions and activities surrounding marketing of these services are such that they would or could be encountered by same persons under circumstances that could, because of similarities of marks used with them, give rise to the mistaken belief that they originate from or are in some way associated with the same producer. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1722; *Edwards Lifesciences Corp. v. VigiLanz Corp.*,

⁶ For example, the registrants for those registrations may have executed consents to register or entered coexistence agreements, or the record may have shown that the dominant part of those registered marks were diluted.

94 USPQ2d 1399, 1410 (TTAB 2010); *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 507 (TTAB 1980); *Oxford Pendaflex Corp. v. Anixter Bros. Inc.*, 201 USPQ 851, 854 (TTAB 1978).

To prove that the services are related, the Trademark Examining Attorney submitted excerpts from 25 third-party websites advertising restaurant services and bar or taproom services under the same mark.⁷ The websites listed below are illustrative:

1. W. Rick's Taproom & Grill (wrickstaproom.com)⁸



The Bar and Restaurant provide two different atmospheres for customers, and the rooms are separated by the kitchen. The Restaurant side is a relaxed atmosphere with a cozy feel. You will typically hear "Golden Oldies" playing on the sound system. The Taproom is a place where good friends meet to have a good time.

⁷ July 16, 2015 and February 8, 2016 Office Actions.

⁸ July 16, 2015 Office Action.

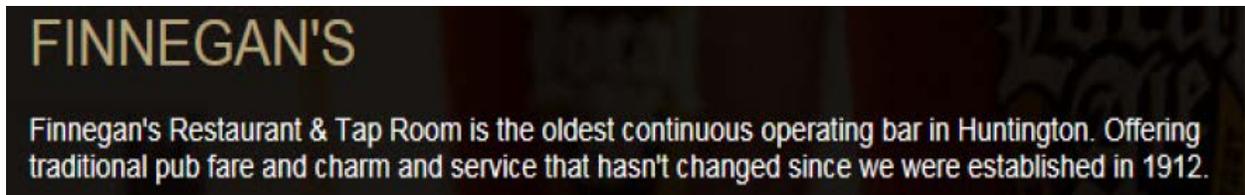
2. Boondocks Brewing Tap Room & Restaurant (boondocks-brewing.com)⁹



Boondocks Brewing Tap Room & Restaurant opened our doors on August 1, 2012 with a mission to provide a fresh, unique and engaging destination for residents as well as visitors to Ashe County. We are a locally owned and employee run small business that is Dedicated to Excellence and Committed to our Community. We offer an extensive menu and daily specials featuring locally sourced ingredients.

We are Ashe County's first and only commercially licensed Craft Beer Brewery and we brew small batches of hand crafted beers weekly. We have one of the State's best craft beer selections on tap and in bottles in addition to having our own beer on tap.

3. Finnegan's (lessings.com)¹⁰



These websites demonstrate that the services of the type offered by both Applicant and Registrant are marketed and sold together. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis”); *In re Integrated Embedded*, 120 USPQ2d 1504, 1514-15 (TTAB 2016).

⁹ July 16, 2015 Office Action.

¹⁰ July 16, 2015 Office Action.

The Trademark Examining Attorney also submitted 14 third-party, use-based registrations for services listed in both the application and registration at issue. Third-party registrations based on use in commerce that individually cover a number of different services may have probative value to the extent that they serve to suggest that the listed services are of a type that may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Representative registrations, with relevant portions of the identifications, are listed below.¹¹

Mark	Reg. No.	Services
LOCAL BREWING CO.	4813043	Bar and restaurant services; taproom services
RUBICON BREWING COMPANY	4591368	Taproom services; restaurant and cafe services
SUGAR CREEK BREWING CO.	4657346	Restaurant and bar services; taproom services
VICTORY BIERGARTEN	4813810	Restaurant, bar and catering services; taproom services
OLD BAKERY	4890080	Restaurant and bar services; taproom services

Applicant argues that its mark will be used to identify bar and taproom services featuring beer brewed on the premises while Registrant’s mark is for restaurant services specializing in pies and baked goods.¹² However, in considering the scope of

¹¹ February 8, 2016 Office Action.

¹² Applicant’s Brief, p. 8 (7 TTABVUE 11).

the cited registration, we look to the registration itself, and not to extrinsic evidence about the registrant's actual goods, customers, or channels of trade. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987) (quoting *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983)); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958)).

Moreover, it is not necessary for Registrant to offer Applicant's services to find that the services are related. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *In re Integrated Embedded*, 120 USPQ2d at 1515. The Trademark Examining Attorney's evidence shows that third parties provide the types of services offered and advertised by both Applicant and Registrant under a single mark. Such evidence is sufficient to find that the services at issue are related. *See, e.g., In re Integrated Embedded*, 120 USPQ2d at 1515; *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Applicant also contends that “[w]hen distinct, non-overlapping services are offered in separate facilities, consumers are not likely to believe they originate from the same source,” particularly because Applicant's bar and taproom services are rendered in Austin, Texas, and Registrant's restaurant services are rendered in Kimmswick, Missouri.¹³ However, Applicant has applied for a geographically unrestricted registration. Likewise, the cited registration is not geographically restricted and, therefore, it has a presumption of exclusive nationwide use. *See* Section 7(b) of the

¹³ Applicant's Brief, p. 8 (7 TTABVue 11).

Trademark Act, 15 U.S.C. § 1057(b); *see also Giant Food, Inc. v. Nation's Foodservice, Inc.* 710 F.2d 1565, 218 USPQ 390, 393 (Fed. Cir. 1983). Therefore, the geographic distance between the present locations of the respective businesses has no relevance to our likelihood of confusion analysis.

We find that the services are related.

C. Established, likely-to-continue channels of trade.

Because there are no meaningful limitations in the identification of services in either the application or the cited registration, we must presume that the services move through all the usual channels of trade and are offered to all normal potential purchasers. *In re i.am.symbolic, llc*, 116 USPQ2d at 1412; *see also Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973); *In re Elbaum*, 211 USPQ at 640. The third-party websites show that restaurant, bar and taproom services are advertised and offered to the same consumers at the same time and, therefore, the services at issue move in the same channels of trade.

D. Balancing the factors.

Because the marks are similar, the services are related and the services move in the same channels of trade, we find that Applicant's mark BLUE OWL BREWING for "bar services; taproom services; taproom services featuring beer brewed on premises" is likely to cause confusion with the registered mark BLUE OWL for "restaurant services, namely, providing of food and beverages for consumption on and off the premises."

Decision: The refusal to register Applicant's mark BLUE OWL BREWING is affirmed.