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**THIS DISPOSITION
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Paper No. 11
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Churchill Coffee Company, LLC

Serial No. 75/736,513

Charles H. Young of Husch & Eppenberger, LLC for Churchill Coffee Company, LLC.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law Office 103 (Thomas G. Howell, Managing Attorney).

Before Hairston, Wendel and Rogers, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Churchill Coffee Company, LLC has filed an application to register the mark shown below,

for "restaurants."¹

¹ Application Serial No. 75/736,513, filed September 27, 1999, alleging a bona fide intention to use the mark in commerce. The words "COFFEE COMPANY" have been disclaimed apart from the mark as shown.

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act, in view of two prior registrations, owned by the same entity, for the mark CHURCHILL'S PUB AND RESTAURANT² in typed capital letters and the mark shown below³,

both for "providing of food and drink, namely, a restaurant and pub."

When the Examining Attorney made the refusal final, applicant appealed. Both applicant and the Examining Attorney filed briefs, but an oral hearing was not requested. We affirm the refusal.

² Registration No. 2,099,850 issued September 23, 1997. The words "PUB AND RESTAURANT" have been disclaimed apart from the mark as shown.

³ Registration No. 2,063,997 issued May 20, 1997. The words "PUB & RESTAURANT" have been disclaimed apart from the mark as shown. Also, the registration includes a statement that "The portrait in the mark does not identify a living individual."

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 likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key factors are the similarities between the marks and the similarities between the good or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to the respective services, they are virtually identical. Applicant does not dispute this, but concentrates its arguments on asserted differences in the marks.

Applicant argues that its mark is very different from the cited marks. In particular, applicant points out that its mark includes the wording COFFEE COMPANY which is different from the words PUB AND RESTAURANT in the cited marks; that its mark does not use the possessive form of "Churchill" as do the cited marks; and that its mark includes a prominent lion's head design whereas the cited design mark includes what appears to be a likeness of Winston Churchill. Further, applicant argues that marks consisting of the term "Churchill(s)" are weak marks and therefore entitled to only a limited scope of protection.

In considering the marks, we are mindful of the well-established principle that when marks would appear on virtually identical goods or services, the degree of similarity between the marks necessary to support a finding of likelihood of confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Moreover, while marks must be compared in their entireties, it is nevertheless the case that, in articulating reasons for reaching a conclusion of the issue of likelihood 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 a consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir, 1985). For instance, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark . . ." 224 USPQ at 751.

Here, not only is the disclaimed "COFFEE COMPANY" in applicant's mark merely descriptive of applicant's services, and thus the dominant and principal source-indicative element of such mark is "CHURCHILL," but the disclaimed "COFFEE COMPANY" appears below the "CHURCHILL"

term and in a smaller font, such that the larger "CHURCHILL" clearly dominates the mark. Similarly, in the cited marks, the disclaimed "PUB AND (or &) RESTAURANT" is merely descriptive/generic of the registrant's services. Moreover, in the cited design mark, "PUB & RESTAURANT" appears below the term "CHURCHILL'S" and in a smaller font. Thus, the dominant source-indicative element of the two cited marks is "CHURCHILL'S." It is of little consequence that applicant's mark includes the name CHURCHILL and the cited marks include the possessive form thereof. See *Hess's of Allentown, Inc. v. National Bellas Hess, Inc.*, 169 USPQ 673, 677 (TTAB 1971)("[N]o distinction for legal or practical purposes can be made between a name and the possessive form thereof..."). Further, it would be quite natural for prospective consumers of applicant's restaurant services to refer to the restaurant(s) as "Churchill's," rather than articulate the entire name. *Id.* (Petitioner's change from HESS BROTHERS to HESS'S prompted by "manner in which the purchasing public had come to refer to and identify its store and operations.")

There is no question that the portrait in the cited design mark and the lion's head design in applicant's mark are noticeable parts of the respective marks, and if we were making a side-by-side comparison of the marks, the

differences in these designs would be obvious. This, however, is not the proper test. Rather, it is the overall commercial impression which will be recalled over a period of time that must be taken into account in determining likelihood of confusion.

In this case, the virtual identity of the dominant portion of applicant's mark (CHURCHILL) and the cited marks (CHURCHILL'S) is especially important. As noted by our reviewing court in *Giant Food, Inc. v Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983), "restaurants are often recommended by word of mouth and referred to orally, [so] it is the word portion of applicant's mark which is more likely to be impressed on the consumer's memory."

In view of the foregoing, and while differences admittedly exist between the respective marks, when considered in their entirety, and according appropriate weight to the dominant portions thereof, applicant's mark CHURCHILL COFFEE COMPANY and design is substantially similar in commercial impression to the cited marks CHURCHILL'S PUB AND RESTAURANT and CHURCHILL'S PUB & RESTAURANT and design.

As to applicant's argument that the cited marks are weak and therefore entitled to a limited scope of

protection, we should point out the third-party registrations made of record by applicant, in and of themselves, are entitled to little weight in evaluating whether there a likelihood of confusion. See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); and *In re Hub Distributing, Inc.*, 218 USPQ 284, 285-86 (TTAB 1983). This is because third-party registrations are not evidence of what happens in the marketplace. Also, we note that none of the third-party registrations include services of the type involved in this appeal. Moreover, it has long been settled that "the 'weak mark' doctrine to which applicant's argument is directed does not so severely restrict the rights of the owner of such a mark or permit registration thereof by a subsequent user for closely related goods." *Robert A. Johnston Company v. Ward Foods, Inc.*, 157 USPQ 204, 206 (TTAB 1968)(Board sustained opposition to application to register JOHNSTON'S in particular form of lettering for frozen dessert pies and frozen cakes based upon prior registrations for JOHNSTON in block print for cookies and crackers and in a different form of lettering for inter alia, biscuits, candies and chocolates.) See also *King-Kup Candies, Inc. v. King Candy Co.*, 128 USPQ 272 (CCPA 1961).

Finally, it is well settled that, if there is any doubt on the issue of likelihood of confusion, that doubt must be resolved against the newcomer and in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc. 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1986).

In sum, we find that in view of the substantial similarity in the commercial impression of applicant's mark and the cited marks, their contemporaneous use on the virtually identical services involved in this case is likely to cause confusion as to the source or sponsorship of such services.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed as to each of the cited registrations.