

**THIS OPINION
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THE TTAB**

Mailed: August 27, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Issa Hotels & Resorts Limited

Serial No. 76661251

Carol N. Green of Law Offices of Carol N. Green for Issa
Hotels & Resorts Limited.

Christopher Buogiorno, Trademark Examining Attorney, Law
Office 102 (Karen Strzyz, Managing Attorney).

Before Walters, Zervas and Cataldo, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Issa Hotels & Resorts Limited has filed an application
to register the standard character mark COUPLES NEGRIL on
the Principal Register for "resort hotel, restaurant and
making reservations and bookings for temporary lodging," in
International Class 43.¹ The application includes a claim
of acquired distinctiveness under Section 2(f) of the
Trademark Act, 15 U.S.C. §1052(f).

¹ Serial No. 76661251, filed June 2, 2006, based on use of the mark in
commerce, alleging first use and use in commerce as of October 1998.

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark NEGRIL, previously registered for "restaurant services,"² that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

As a preliminary matter, applicant submitted evidence with its brief and the examining attorney has objected thereto. We agree that this evidence is untimely, as all evidence must be submitted prior to appeal, and, therefore, we have not considered this evidence. *See*, 37 CFR 2.142(d); and *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). Moreover, even if we were to consider this evidence, it would not change our decision in this case.

Also preliminarily, we note that in its brief, applicant requested that, if we affirm the examining attorney's refusal, "applicant be allowed to register the mark on the Supplemental Register." (Brief, p. 13)

² Registration No. 2108331 issued October 28, 1997, to Earl P. Chinn. The registration includes a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f). [Renewed for a period of ten years from October 28, 2007; Section 15 affidavit acknowledged.]

However, marks registered on the Supplemental Register are within the scope of Section 2(d) and, thus, if we affirm the refusal to register on this ground, applicant would be equally prohibited from registering its mark on the Supplemental 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 likelihood of confusion issue. *See In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 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); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We note, first, that the recitations of services in both the application and the cited registration include

"restaurant services." The examining attorney submitted evidence in the form of third-party registrations for marks registered in connection with both restaurant and hotel services; and excerpts from Internet websites for resorts that include both a hotel and a restaurant identified by the same mark. Therefore, we conclude that the resort hotel services recited in the application are related to registrant's restaurant services. In view of the identical nature of applicant's and registrant's restaurant services, it is unnecessary to consider whether or to what extent applicant's remaining recited services may be related to registrant's restaurant services.

Applicant's argument that there is minimal overlap between the services because there is a "competitive distance" between applicant's and registrant's services is unavailing because a federal registration is national in scope and neither the application nor the registration are restricted in any way as to class of purchasers or trade channels.

Further, inasmuch as the identifications of goods in both the involved application and the cited registrations are not limited to any specific channels of trade, we presume an overlap and that the goods would be offered in all ordinary trade channels for these goods and to all normal classes of purchasers. See *In re Linkvest S.A.*, 24

USPQ2d 1716 (TTAB 1992). In other words, the channels of trade and classes of purchasers are, at least in part, the same. While applicant argues that its customers are sophisticated, applicant's and registrant's restaurant services are not so limited in the recitations of services and, thus, encompass the general public, including all levels of sophistication.

Considering, next, the marks, we note that in determining likelihood of confusion, a lesser degree of similarity between two marks is required when the marks are applied to identical goods or services. *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd* 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). See also *In re J.M. Originals*, 6 USPQ 1393 (1987). The question is whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air*

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Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

Furthermore, although the marks at issue must be considered in their entirety, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Both the registration and the application include claims of acquired distinctiveness under Section 2(f), which is indicative of the descriptive nature of both marks. The evidence of record demonstrates that Negril is a place in Jamaica. Thus, while the registered mark is likely a weak mark and therefore not entitled to a broad scope of protection, the mark is at least entitled to protection from registration of a similar mark for identical and closely related goods. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974) (likelihood of confusion is to be avoided as much between weak marks as between strong marks).

Applicant's mark incorporates the registered mark in its entirety and precedes it with the word COUPLES. Applicant argues that COUPLES is not merely descriptive; however, because applicant amended its application to assert a claim of acquired distinctiveness, under Section 2(f),

applicant has conceded that its mark is merely descriptive. *See, In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443 (TTAB 1994). Applicant argues that COUPLES is the dominant portion of its mark and this term distinguishes its mark from the registered mark. But applicant may not avoid a likelihood of confusion by appropriating registrant's entire mark and adding descriptive matter to it. *See In re Denisi*, 225 USPQ 624 (TTAB 1985) and *The State Historical Society of Wisconsin v. Ringling Bros.-Barnum Bailey Combined Shows, Inc.*, 190 USPQ 25 (TTAB 1976). We find that the marks are sufficiently similar that purchaser's familiar with registrant's restaurant identified by the mark NEGRIL are likely, upon encountering applicant's resort hotel and restaurant identified by the mark COUPLES NEGRIL, to mistakenly believe that applicant's resort hotel and restaurant are related in some manner to registrant's restaurant, but directed specifically to "couples." Even if applicant were to contend that its mark has greater renown than registrant's mark, the marks are sufficiently similar that the same association would be present in the form of reverse confusion.

Therefore, when we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that in view of

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the similarities in the commercial impressions of applicant's mark, COUPLES NEGRIL, and registrant's mark, NEGRIL, their contemporaneous use on the identical restaurant services and closely related resort hotel services involved in this case is likely to cause confusion as to the source or sponsorship of such services.

Decision: The refusal under Section 2(d) of the Act is affirmed.