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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re John P. Callaghan IV

Serial No. 77061354

John S. Artz of Dickinson Wright PLLC for John P. Callaghan IV.

Andrea P. Butler, Trademark Examining Attorney, Law Office 102 (Karen M. Strzyz, Managing Attorney).

Before Zervas, Walsh, and Wellington, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

On December 11, 2006, John P. Callaghan IV filed an application to register the following mark:



for "bar and restaurant services" in International Class 43. The application is based on applicant's allegation that he first used the mark in commerce on June 1, 2004.

The examining attorney refused to register the mark under Section 2(d) of the Trademark Act based on a prior

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registration (Registration No. 2740854) for the mark O'CALLAGHAN HOTELS (in typed form) for, "hotels; resort hotels" in International Class 43. 15 U.S.C. § 1052(d). The mark issued on July 23, 2003 on the Supplemental Register and contains a disclaimer of HOTELS.

After the examining attorney made the refusal final, this appeal followed.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973).

However, as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the relatedness of the goods/services at issue and the similarity or dissimilarity of the respective marks in their entireties.

We first consider the marks at issue. In doing so, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test, under the first *du*

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Pont factor, 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 impression that confusion as to the source of the goods 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 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 Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In applying the aforementioned principles, it is immediately apparent that the dominant elements in applicant's mark and the registered are nearly identical. Specifically, the literal portion O'CALLAGHAN'S in applicant's mark and O'CALLAGHAN in the registered mark figure prominently in the respective marks and they are nearly identical - one is merely the possessive form of the

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other. There is only a slight visual difference and they will be pronounced the same but for the "s" at the end in applicant's mark. Although applicant's mark contains two identical interlocking ring designs, the name O'CALLAGHAN'S in the center is most prominent. Applicant's use of the surname (in possessive form) dominates this mark because it is the portion of the mark which is capable of being verbalized by purchasers. See *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). In the registered mark, the term HOTELS is generic for registrant's services and is disclaimed. While we have not disregarded this term in our comparison of the respective marks as a whole, it is entitled to less weight than the term O'CALLAGHAN because generic terms are accorded less weight in the likelihood of confusion analysis. See *In re Chatam International Inc.*, 380 F.3d 1340; *In re National Data Corp.*, 753 F.2d 1056.

The commercial impressions created by both marks and their connotations are also very similar. Both marks imply that a person with the surname "O'CALLAGHAN" is the proprietor of both establishments and thus the source of the respective services. The possessive form has little, if any, significance for consumers in distinguishing the parties' marks. See, e.g., *Wilson v. Delaunay*, 245 F.2d

877, 114 USPQ 339, 341 (CCPA 1957) ("It is evident that there is no material difference, in a trademark sense, between the singular and plural forms of the word 'Zombie' and they will therefore be regarded here as the same mark"). The interlocking ring design also does not create a strong, separate commercial impression because it appears simply as a geometric design to those who do not recognize it as reminiscent of a Celtic knot. To those who perceive it as Celtic in nature, they will view it as underscoring the Irish origin of the surname.

In view thereof, we find the respective marks taken as a whole are similar in appearance, sound, connotation, and commercial impression. This *du Pont* factor thus weighs strongly in favor of finding a likelihood of confusion.

We turn now to the similarity or dissimilarity of registrant's hotel/resort hotel services and applicant's bar and restaurant services. In this regard, the examining attorney submitted evidence in the form of third-party registrations for marks registered in connection with restaurant, bar and hotel services, and excerpts from internet websites indicating that hotels (including resort hotels) offer restaurant services at the same location. Specifically, the examining attorney introduced twenty-one (21) use-based, third-party registrations which show that

various entities have adopted a single mark under which they provide all three services: hotel, restaurant and bar services; and four (4) such registrations for hotel and restaurant services (not bar services).¹ Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). These third-party registrations support a finding that applicant's bar and restaurant services are related to registrant's hotel services.

The internet evidence also demonstrates that consumers are accustomed to restaurant and bar services being rendered inside (or at the same location as) hotels. According to the U.S. Bureau of Labor Statistics (BLS) website, many hotels will also have "cocktail lounges and formal fine-dining restaurants."² The BLS website also identifies "waiters and waitresses" among the list of ten "largest occupations in hotels and other accommodations" for 2004, thus indicating a prevalence of restaurant

¹ Attached to Office actions dated April 10, 2007 and October 24, 2007.

² Attached to Office action dated October 24, 2007.

service within hotels. The remaining internet evidence consists in large part of third-party hotel websites indicating the presence of restaurants at the same location.

Applicant argues that "when hotels do have a restaurant within, the restaurant is typically under separate ownership and has a name separate and distinct name from the from the (sic) hotel." Applicant did not submit any evidence in support of this proposition. Nonetheless, even if we assumed that restaurants within hotels may conduct business under a different trademark from that of the hotel, we find it equally possible that hotel restaurants may employ the same trademark for the different services. Also, even if a distinct mark were used to identify the restaurant or bar in a hotel, the "hotel" mark may nonetheless also be associated with the restaurant or bar located in the hotel.

Based on the record before us, we conclude that the restaurant and bar services recited in the application are related to the cited registrant's hotel services. Consequently, the factor involving the similarity of applicant's and registrant's services favors a finding of a likelihood of confusion.

Further, inasmuch as the recitations of services in both the involved application and the cited registration are not limited to any specific channels of trade, we presume an overlap and that the services would be offered in all ordinary trade channels for these services 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 the same inasmuch as they will include the general public.

In summary, weighing all the relevant *du Pont* factors, we conclude that consumers who are familiar or otherwise acquainted with registrant's O'CALLAGHAN HOTELS mark for hotel and resort hotel services would be likely to believe, upon encountering applicant's substantially similar O'CALLAGHAN'S (stylized with design) mark for restaurant services that the respective services emanate from, or are sponsored by or affiliated with, the same source.

Decision: The examining attorney's refusal to register under Section 2(d) is affirmed.