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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re John S. Hendricks

Serial Nos. 78206219 and 76487280

Anthony V. Lupo and Jennifer L. Myron of Arent Fox PLLC for John S. Hendricks.

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Before Quinn, Grendel and Walsh, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant's appeals in application Serial Nos. 78206219 and 76487280 are hereby consolidated and shall be decided in this single opinion.

In application Serial No. 78206219 (hereinafter '219), applicant seeks registration on the Principal Register of the mark PALISADE (in standard character (typed) form) for services recited in the registration, as amended, as

"hotels; resort hotels; inns," in International Class 43.[1] In Serial No. 76487280 (hereinafter '280), applicant seeks registration on the Principal Register of the mark depicted below for the same Class 43 services, i.e., "hotels; resort hotels; inns."[2]

[1] This application was filed on January 23, 2003, and is based on applicant's asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b). As originally filed, the recitation of services in the application was "restaurants; hotels; resort hotels; inns" in Class 43, and "health spa services" in Class 44. In his response to the first Office action (in which the Trademark Examining Attorney issued the Section 2(d) refusal at issue in this appeal), applicant deleted "restaurants" from the Class 43 recitation of services. The Class 44 "health spa services" subsequently were divided out, at applicant's request, into the child application Serial No. 78975702; the child application is not at issue herein.

[2] This application was filed on January 31, 2003, and also is based on applicant's asserted bona fide intention to use the mark in commerce under Trademark Act Section 1(b). The original recitation of services in this application did not include "restaurants" as in the '219 application, but it did include the Class 44 "health spa services." The Class 44 services subsequently were divided out, at applicant's request, into child application Serial No. 76977134; the child application is not at issue herein.

In each application, the Trademark Examining Attorney has issued a final refusal to register on the ground that applicant's mark, as used in connection with applicant's recited services, so resembles the mark PALISADE, previously registered (in standard character form) for services recited in the registration as "restaurant services,"[3] as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant has appealed the final refusal in each case. Applicant and the Trademark Examining Attorney filed main appeal briefs in each case; applicant did not file a reply brief in either case, nor did applicant request an oral hearing. We affirm the refusal to register in each case.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v.*

[3] Registration No. 1732203, issued November 10, 1992, renewed. Affidavits under Trademark Act Sections 8 and 15 accepted and acknowledged. The "restaurant services" recited in the registration are classified in the registration in International Class 42, the class in which such services were classified at the time the registration was issued. Such services now are classified in Class 43.

Veuve Clicquot Ponsardin Maison Fondee 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); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The first *du Pont* factor requires us to determine whether each of applicant's marks and the cited registered mark are similar or dissimilar when compared in their entireties 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 impression that confusion as to the source of the 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 Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, 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).

We find that applicant's standard character mark PALISADE (in the '219 application) is identical to the cited registered mark, PALISADE. We also find that applicant's PALISADE and design mark (in the '280 application) is highly similar to the cited registered mark. The cited registered mark and applicant's PALISADE and design mark are identical to the extent that PALISADE appears prominently in both; applicant has merely added a design element. The dominant feature of applicant's PALISADE and design mark is the word PALISADE, and it is this feature of the mark which commands greater weight in our comparison of the marks. *See In re National Data Corp.*, *supra*. The word PALISADE dominates the commercial impression of applicant's design mark because it appears in large, bold lettering. The design element of the mark appears to be a highly stylized representation of a palisade,[4] which merely reinforces the meaning and significance of the word PALISADE in the mark. Moreover,

[4] We take judicial notice that "palisade" is defined, in pertinent part, as "a line of lofty steep cliffs, usually along a river." The American Heritage® Dictionary of the English Language (4th ed. 2000). The Board may take judicial notice of dictionary definitions. *See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

the word PALISADE 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).

For these reasons, we find that applicant's '219 standard character mark is identical to the cited registered mark, and that applicant's '280 design mark is highly similar to the cited registered mark. In both cases, the first *du Pont* factor weighs heavily in favor of a finding of likelihood of confusion. Applicant has not contended otherwise.

We also find that PALISADE is a strong, distinctive mark as applied to the services recited in the cited registration, and that it therefore is entitled to a broad scope of protection. We reject applicant's contention to the contrary. The numerous third-party registrations of PALISADE marks made of record by applicant are not probative evidence under the sixth *du Pont* factor ("the number and nature of similar marks in use on similar goods [or services]"). *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). Moreover, none of these registrations covers the services at issue herein. Likewise, applicant's Internet evidence of third party uses of PALISADE does not support

applicant's case because, with one exception, all of these instances of use are in connection with goods and services far afield from the restaurant and hotel services at issue herein. The only evidence of third-party use of PALISADE as a mark in the hospitality industry pertains to a hotel in Sydney, Australia; this foreign use is not probative under the sixth *du Pont* factor, and is de minimis in any event. We find that the sixth *du Pont* factor weighs in favor of a finding of likelihood of confusion.

We turn next to the second *du Pont* factor, i.e., the similarity or dissimilarity of the services as recited in the applications and in the registration, respectively. It is settled that it is not necessary that the respective services be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the services themselves, but rather whether they would be confused as to the source of the services. It is sufficient that the services be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that

there is an association or connection between the sources of the respective services. *See In re Martin's Famous Pastry Shoppe, Inc*., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp*., 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp*., 197 USPQ 910 (TTAB 1978).

Moreover, it is settled that the greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods or services and the registrant's goods or services that is required to support a finding of likelihood of confusion. Where the applicant's mark is identical to the registrant's mark, as it is in this case, there need be only a viable relationship between the respective goods in order to find that a likelihood of confusion exists. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Opus One Inc*., 60 USPQ2d 1812, 1815 (TTAB 2001); and *In re Concordia International Forwarding Corp.,* 222 USPQ 355 (TTAB 1983).

Applying these principles in the present case, we find that the "restaurant services" recited in the cited registration are identical in part, and otherwise similar and related, to the services recited in each of applicant's

applications, i.e., “hotels; resort hotels; inns.” We take judicial notice that one definition of the word “inn” is “a tavern or restaurant.” The American Heritage® Dictionary of the English Language (4th ed. 2000). To that extent, applicant’s services (which include “inns”) are identical to the restaurant services recited in the cited registration.

The Trademark Examining Attorney also has made of record Internet website printouts from at least five different establishments which offer hotel and restaurant services in the United States under a single mark. See, for example, the websites of The Panama Hotel & Restaurant (San Rafael, California); The Villa Inn-Restaurant-Spa (Indianapolis, Indiana); Montecito Inn Hotel and Restaurant (Santa Barbara, California); Riverfront Lodge Hotel & Restaurant (Boardman, Oregon); and Peerless Hotel and Restaurant (Ashland, Oregon). Also of record are twenty-four third-party registrations which include in their recitations of services both restaurant services and hotel services. Although such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a

single source under a single mark. *See In re Albert Trostel & Sons Co.,* 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc*., 6 USPQ2d 1467 (TTAB 1988).

Applicant does not dispute that hotels often offer restaurant services as well as lodging services. However, applicant has made of record approximately fifteen printouts from Internet websites of hotels which offer their restaurant services under a name other than that of the hotel. Examples are “Citronelle” at the Latham Hotel in Washington, D.C.; “Melrose Restaurant” at the Park Hyatt Hotel in Washington, D.C.; “Café 15” at the Sofitel Lafayette Square Hotel in Washington, D.C.; and “Maxfield’s Restaurant” at the Palace Hotel in San Francisco. We have considered this evidence, but we cannot conclude therefrom that hotels always or necessarily offer their restaurant services under separate marks; the Trademark Examining Attorney has submitted significant and persuasive evidence to the contrary. We cannot help but note as well that applicant itself, in its ‘219 application as originally filed, stated its bona fide intention to use the PALISADE mark in connection with “restaurants,” as well as with “hotels; resort hotels; inns.”

Based on this evidence and for these reasons, we find that purchasers encountering hotel services and restaurant

services offered under the identical or highly similar marks at issue herein are likely to assume that a source or other connection exists. We note that the Board has reached a similar conclusion in at least two previous reported cases, i.e., *In re The Summit Hotel Corporation*, 220 USPQ 926 (TTAB 1983), and *Bonaventure Associates v. Westin Hotel Company*, 218 USPQ 537 (TTAB 1983).[5] The second *du Pont* factor accordingly weighs in favor of a finding of likelihood of confusion.

We also find, under the third *du Pont* factor, that restaurant services, as recited in the cited registration, and hotel, resort hotel and inn services, as recited in applicant's applications, are marketed in the same trade channels to the same classes of purchasers. Applicant's argument that applicant and registrant are or will be offering their respective services in different geographic areas of the country is unavailing. Neither the cited registration nor applicant's applications are geographically restricted, and they thus must be presumed to be nationwide in scope. Any current actual geographical separation between applicant and registrant is not

[5] We reject applicant's unsupported and obviously erroneous contention that these cases are not citable as precedential authority of the Board.

pertinent in this case. The third *du Pont* factor weighs in favor of a finding of likelihood of confusion.

We also find that the purchasers of the respective services include ordinary consumers who would not exercise more than ordinary care and sophistication in purchasing the services. The fourth *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Finally, we note that applicant cites *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993). As applicant acknowledges, however, in that case there was a consent agreement between the applicant and the owner of the cited registration, a fact to which the court gave great if not dispositive weight. No such consent agreement is of record in the present case, and the tenth *du Pont* factor (the parties' market interface, including any consent agreements) accordingly is not pertinent herein.

Weighing all of the evidence of record as it pertains to the du Pont likelihood of confusion factors, we conclude that a likelihood of confusion exists and that registration of each of applicant's marks accordingly is barred by Trademark Act Section 2(d). To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts against applicant. *See In re Shell Oil*

Co., supra; *In re Hyper Shoppes (Ohio) Inc.,* 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc., supra*.

Decision: The refusal to register in application Serial No. 78206219 is affirmed. The refusal to register in application Serial No. 76487280 is affirmed.