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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re D&B Mitchell Group, LLC

Serial No. 78652937

David L. Kane, Esq. for D&B Mitchell Group, LLC Don Mitchell.

Mariam Aziz Mahmoudi, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

Before Walters, Walsh and Taylor, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

D&B Mitchell Group, LLC has filed an application to register the mark shown below on the Principal Register for "restaurants," in International Class 43.¹



The application includes a disclaimer of EXPRESS apart from the mark as a whole; a statement that the transliteration of

the Chinese characters is LAN ZHU, which means BLUE BAMBOO in English; a claim of the colors blue and white as features of the mark; and a description of the mark as consisting of "the color blue appearing in the wording BLUE BAMBOO XPRESS and the rectangle containing the Chinese characters, which appear in the color white."

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 BLU BAMBU, in typed form, previously registered for "catering and restaurant services,"² that, if used on or in connection with applicant's services, 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.

We begin by noting that applicant submitted evidence with its appeal brief and the examining attorney has objected to that evidence. The evidentiary record must be complete prior to appeal and therefore we have not considered the untimely evidence submitted by applicant with its appeal brief. See 37 CFR § 2.142(d). See also *In re Trans Continental Records Inc*, 62 USPQ2d 1541 (TTAB 2002);

¹ Serial No. 78652937, filed June 17, 2005, based on use of the mark in commerce, alleging first use and use in commerce as of March 1, 2005.

and *In re Lamb-Weston Inc.*, 54 USPQ2d 1190, 1191 n.2 (TTAB 2000).

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 consider, first, the respective services and find that applicant's restaurant services are identical to the restaurant services listed along with catering services in the cited registration.

² Registration No. 2958387 issued May 31, 2005, to Blu Bambu, LLC.

Applicant argues that the services are different because it operates a fast food restaurant in a food court at DFW airport; whereas, registrant operates an upscale restaurant in an entirely different geographic location. However, it is well established that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). *See also, Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Both applicant's and registrant's identical services are identified broadly as "restaurant services." Even if we had considered applicant's late-filed evidence, this argument would be unavailing as both recitations of services must be understood to encompass all restaurants from fast food stands to high-end restaurants.

Because neither applicant's nor registrant's recitation of services contains limitations, we assume that both applicant's and registrant's restaurant services are

available through all of the normal channels of trade and to all the usual purchasers of such services. Therefore, we find that the channels of trade and classes of purchasers of the applicant's and registrant's services are the same. The factors of the services, channels of trade and classes of purchasers weigh against applicant.

We turn, next, to a determination of 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 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*

Serial No. 78652937

National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applicant's mark consists of a blue rectangle with Chinese characters in white within the rectangle, followed on the same line by the words BLUE BAMBOO XPRESS in the same color blue and approximately the same size as the rectangle. The standard font used for the English words BLUE BAMBOO XPRESS and the simple rectangle preceding the wording are certainly less significant than the wording in the mark. The word XPRESS is the phonetic equivalent of the word EXPRESS, which is defined in this record as a noun meaning "fast delivery service,"³ and is clearly merely descriptive and, thus, is of less significance in the overall commercial impression of the mark than the words BLUE BAMBOO. Similarly, the blue color in the mark is less significant than the wording because purchasers are more likely to remember the wording used to call for the services. The Chinese characters meaning BLUE BAMBOO reinforce the significance of the English words BLUE BAMBOO in the mark. We find that purchasers viewing applicant's mark will find the words BLUE BAMBOO to be the dominant portion of the mark.

³ *Encarta World English Dictionary*, 2005. This definition was excerpted by the examining attorney from the website www.encycarta.msn.com and entered into the record with the January 20, 2006 office action.

The registered mark is in typed, or standard character, form, which means that the registration covers the use of the mark in any number of colors, including blue, and in any font, including the one used by applicant. In comparing the marks, we must conclude that BLUE BAMBOO and BLU BAMBU are phonetic equivalents, have the same connotation, and differ by only a few letters. Viewing the marks in their entireties, we conclude that the marks are substantially similar in appearance, sound, connotation and commercial impression. Therefore, this factor also weighs against applicant.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's design mark dominated by the words BLUE BAMBOO and registrant's mark, BLU BAMBU, their contemporaneous use on the same services involved in this case is likely to cause confusion as to the source or sponsorship of such services. We note, in particular, that the examining attorney submitted copies of sixteen third-party registrations owned by eight entities. Each entity owns a registration for particular mark for restaurant services as well as a second registration for the same mark followed by the word EXPRESS for restaurant services. Therefore, it would not be unusual for consumers familiar with registrant's mark to mistakenly believe that applicant's identical services identified by a

Serial No. 78652937

substantially similar mark are related to the services of registrant. Finally, the alleged geographic separation of applicant's and registrant's services is immaterial because federal registration provides rights nationwide.

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