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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Baccarat

Serial No. 78729129

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of Roylance Abrams Berdo & Goodman LLP for Baccarat.

John Hwang, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Walters, Grendel and Walsh, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

Baccarat (applicant) has applied to register the mark
shown below on the Principal Register for services now
identified as "restaurants; bars; restaurants and bar
services, all the foregoing exclusively in hotels and
resorts identified by and bearing applicant's proprietary

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brand name BACCARAT" in International Class 43.¹ Applicant has disclaimed "BAR."



The Examining Attorney has finally refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with Registration No. 3223442 on the Principal Register for the mark shown below for services identified as "bar and cocktail lounge services" in International Class 43. The registration issued on March 27, 2007. The registration claims first use of the mark anywhere and first use of the mark in commerce on April 28, 2005. The registration includes a disclaimer of "BAR," and the registration also includes the following statement: "The mark consists of the stylized words B BAR."

¹ Application Serial No. 78729129, filed October 27, 2005, now based only on applicant's statement of its bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1052(b).



Applicant has appealed. Applicant and the Examining Attorney have filed briefs. We affirm.

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office ... as to be likely, when used on or in connection with the goods [or services] of the applicant, to cause confusion ..." 15 U.S.C. § 1052(d). In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977), the Court set forth the factors to consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the services of applicant and registrant. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.").

Regarding the marks, in comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicant argues:

... the cited registered mark ... connotes an obvious musical significance. The mark resembles a musical note combined with a stylized piano shaped design and/or evokes a fusion of the G clef ... and a C clef ... commonly found in musical notations.²

When viewed in its entirety the ... [cited] mark connotes a readily apparent association with music, which when coupled with the musical significance of the term "bar" as a measure of the number of beats for a given duration results in a double entendre that amplifies the distinction between the respective ... marks.

... the commercial impression conveyed by the respective marks in their entireties are readily divergent and distinguishable, and particularly in view of the irrefutable fact that the prominent feature of each mark constitutes a clearly one-of-a-kind, identifiable and distinguishing inventive design of a highly stylized and distinctly unique letter B.

² G clef:  C clef: 

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Applicant's Brief at 5.

Applicant also provided copies of numerous third-party applications and registrations for marks consisting of stylized "B" designs for services similar to those at issue here in an attempt to show that the mark in the cited registration is weak and distinguishable from its mark.

The Examining Attorney argues that the marks are "audibly identical," that the mark both "feature the identical alliterative element of the letter B followed by the word 'bar,'" and that "Both stylized marks even bear similar configurations with the letter B above the word bar." Examining Attorney's Brief at 2. The Examining Attorney finally argues that the marks must be viewed in their entireties and that the marks are similar when so viewed.

We conclude that the marks are similar. *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1509 (TTAB 2007).

In its brief, applicant presents the marks side-by-side in an apparent attempt to emphasize any differences between the marks. However, "... it is well established that the test to be applied in determining likelihood of confusion is not whether marks are distinguishable on the basis of a side-by-side comparison but rather whether they

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so resemble one another as to be likely to cause confusion, and this necessarily requires us to consider the fallibility of memory over a period of time. That is to say, the emphasis must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks." *Sealed Air Corporation v. Scott Paper Company*, 190 USPQ 106, 108 (TTAB 1975) (design marks, each consisting of a number of dots in a square, each with differing numbers of dots and differing borders held similar). See also *Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624, 1628 (TTAB 2007); *Puma-Sportschuhfabriken Rudolf Dassler KG v. Garan, Inc.*, 224 USPQ 1064, 1066 (TTAB 1984). This bedrock principle holds true for customers of bars, the service identified in both the application and the registration.

In this case, even when we compare the marks side-by-side, the marks are remarkably similar. See *Textron Inc. v. Maquinas Agricolas "Jacto" S.A.*, 215 USPQ 162, 164-165 (TTAB 1982) (marks, each consisting of a stylized J design held similar) and cases cited therein. Cf. *In re Rodix, Inc.*, 187 USPQ 255 (TTAB 1975) (differing designs, each including the single letter R, held not similar). Of course, to begin with each mark includes a stylized upper-case B. The word "BAR" appears in each of the marks

directly below the stylized B. Applicant's arguments notwithstanding, the B designs are also quite similar. Each is in script form with swirls forming the B on a line tilted slightly to the right anchoring the B.

We reject applicant's argument that the registered mark projects a musical connotation or commercial impression. This determination is admittedly subjective, but the focus of our inquiry must be the likely perception of relevant customers.³ *In re Johnson Products Co., Inc.*, 220 USPQ 539, 540 (TTAB 1983) (overlapping/interlocking S design held similar to repeating S design). We conclude that bar customers are not likely to perceive the musical connotation and commercial impression applicant suggests. We find the suggestion that they would unreasonable. Accordingly, in the absence of any evidence that bar customers would perceive this connotation we reject this argument.

We also reject applicant's arguments based on the third-party registrations for other "B" letter marks.⁴ This

³ Though it does not dictate our decision here, it is worth noting that the registration describes the mark as follows: "The mark consists of the stylized words B BAR." There is no mention of pianos, G or C clefs, or anything else related to music.

⁴ We have not considered the marks in the third-party applications. These records are evidence only of the fact that the applications were filed. *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

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evidence fails to support applicant's implication that the cited, registered mark is weak or diluted. In fact, this evidence generally lends greater support to the Examining Attorney's position and our conclusion that the marks are similar. The stylized B designs in the third-party registrations differ significantly from one another, and more importantly, from the two marks at issue here. In fact, the two marks at issue here are, by far, more similar to one another than any two other stylized B marks in the record.

Though there are differences between the marks, those differences are too subtle to distinguish the marks. Accordingly, we conclude that the marks are similar in appearance, sound, connotation and commercial impression.

Applicant also argues, "The fame and recognition of Applicant and its highly stylized and famous signature letter B precludes any and all likelihood that consumers and the relevant trade would confuse the source or origin of the respective services." Applicant's Brief at 7. Applicant has not presented evidence of the fame of the mark at issue here. The only evidence of fame applicant provided consists of web pages which provide a brief history of the current Baccarat company and its predecessors. See Attachment to Applicant's Response of

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March 1, 2006. There is no evidence regarding the use of applicant's stylized B Bar mark, or of any other mark, in this submission. Furthermore, the history is devoted nearly entirely to activities outside the United States. Accordingly, we conclude that applicant has failed to show that the fame of its mark is entitled to any weight in this case. *Cf. In re General Motors Corp.*, 23 USPQ2d 1465, 1470 (TTAB 1992).

As to the services, the services of applicant and the registrant need not be identical to find a likelihood of confusion under Section 2(d). They need only be related in such a way that the circumstances surrounding their marketing would result in relevant purchasers mistakenly believing that the services originate from the same source. *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Furthermore, in comparing the services and the channels of trade for those services we must consider the services as identified in the application and registration. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on

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the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed.").

Applicant identifies its services as "restaurants; bars; restaurants and bar services, all the foregoing exclusively in hotels and resorts identified by and bearing applicant's proprietary brand name BACCARAT." The services in the cited registration are identified as "bar and cocktail lounge services."

Apart from the restriction in applicant's identification, the services in the application and the cited registration are, at least in part, identical, and otherwise closely related. Both include bar services. *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1506-1507 (TTAB 2007). Applicant does not seriously dispute this point. The only real dispute here relates to the effect of the restriction in the application which limits applicant's services to services offered "... exclusively in hotels and resorts identified by and bearing applicant's proprietary brand name BACCARAT." On the basis of this restriction applicant argues that the services are offered

in distinct channels of trade. Above all else applicant emphasizes the importance of the use of its BACCARAT mark in the trade channel restriction. Applicant also suggests that it would preclude the registrant from using the registered mark in applicant's hotels and resorts, and thereby ensure against any breach of the trade channel boundary.

The Examining Attorney argues that the identification of services in the cited registration is not restricted, and therefore, we must assume that the registrant offers its services in all normal trade channels for those services, citing *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1981) and other cases. He argues further, "Thus the registrant may operate its B BAR's independently in stand alone business establishments as well as within various hotel buildings." Examining Attorney's Brief at 3.

The Examining Attorney provides evidence that hotels provide bar services under marks distinct from the hotel mark within hotels. The evidence includes web pages connected with: the Four Seasons Hotel New York listing "The Bar" and "TY" as "lounges" within the hotel; The Waldorf Astoria New York listing the Peacock Alley Bar, the Bull & Bear's Bar, Oscar's Bar, Sir Harry's Bar and the Cocktail Terrace as bars within the hotel; the Hyatt

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Regency Austin listing the Branchwater Lounge as a bar operating in the hotel; and the New York New York Hotel and Casino in Las Vegas featuring the ESPN Zone sports bar and restaurant within the facility. See Attachments to April 18, 2008 Office Action.

The Examining Attorney also provides an article from ecnext.com which discusses the opening of a Starbuck's Coffee in the building housing the Marrakech Hotel in New York City and excerpts from a website connected with the MGM Grand Hotel promoting a Starbuck's Coffee and other similar facilities in the hotel. *Id.* The Examining Attorney argues that this is an example of other types of businesses, similar to bars, which operate under the same mark in hotels operated by others as well as in facilities not in hotels.

Contrary to applicant's detailed arguments, based on this record we conclude that the restriction in the application would not preclude a likelihood of confusion. We concur with the Examining Attorney's point that the restriction in the application is without effect because there is no restriction in the cited registration. *In re Collegian Sportswear Inc.*, 224 USPQ 174, 176 n.3 (TTAB 1984) (restrictions in trade channels in application are generally without effect in the absence of restrictions in

the cited registration). This is unlike other cases where there is not only a trade channel restriction in the application, but also a consent agreement with the owner of the cited registration. *Cf. In re The Shoe Works Inc.*, 6 USPQ2d 1890, 1891 (TTAB 1988).

As the Examining Attorney observes, the services identified in the cited registration could include bar and lounge services operated either as a separate establishment, or located within a hotel, as the example of the ESPN operation within the New York New York hotel and casino illustrates. The other examples, such as those connected with the Waldorf, may also illustrate the point. Therefore, a customer of registrant's bar services offered under the stylized B Bar mark in a separate establishment or one within a hotel not connected with applicant who encounters applicant's B Bar mark in applicant's hotel may associate the two marks and the two bars. Applicant takes particular exception to the Starbuck's example. While it generally confirms our conclusions here, we do not find it necessary to rely on that evidence.

Also, in assessing the effect of the restriction in the application we have not considered, as applicant appears to urge, that its stylized B Bar mark is used with the BACCARAT mark as such.

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In this application, applicant seeks to register the stylized B Bar mark alone, without BACCARAT or any other element. If applicant were to secure the registration, among other things, the registration would be prima facie evidence of "... registrant's exclusive right to use the mark in commerce on or in commotion with goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate." Trademark Act Section 7(b), 15 U.S.C. § 1057(b).

It is reasonable to construe the "conditions or limitations" contemplated by the Trademark Act to include restrictions, such as those limiting the rendering of the specified service to facilities operated by the registrant, including a hotel or resort. However, it is not reasonable to construe the "conditions and limitations" as including the use of another mark with the registered mark. The Act permits an applicant to secure registration of a composite mark, for example, a mark including both the stylized B Bar and BACCARAT, provided the applicant meets all relevant

requirements for doing so.⁵

The certificate of registration provides notice of the registered *mark* in the *mark* field. In the examination of the applications, the USPTO conducts a search with respect to *the mark* applicant identifies. To state the obvious, it is the registered mark which provides notice to the public as to *the mark* which is registered. In practical terms, the public looks to the mark field in conducting searches for marks. It is not appropriate to specify an additional element of or modification of *the mark* in the "conditions or limitations" regarding the goods and services, or any place else other than in the mark field.

Accordingly, we have construed applicant's limitation as specifying that its services are rendered in its own hotels or resorts, but we have not considered the limitation as specifying that the B BAR mark is used with the BACCARAT mark. As we stated, we find the restriction ineffective for the purpose of avoiding a likelihood of

⁵ In fact, applicant made of record a copy of the USPTO electronic record regarding its Application No. 78857728 for the mark shown here:



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confusion.

Therefore, based on this record we conclude that the services identified in the application and the services identified in the cited registration are identical and otherwise related and that the trade channels for the respective services are rendered through overlapping trade channels to the same class of purchasers.

Finally, after considering all of the evidence and arguments presented here, including those arguments we have not specifically discussed, we conclude that there is a likelihood of confusion between applicant's stylized B BAR mark when used in connection with "restaurants; bars; restaurants and bar services, all the foregoing exclusively in hotels and resorts identified by and bearing applicant's proprietary brand name BACCARAT" and the stylized B BAR mark in Registration No. 3223442 when used in connection with "bar and cocktail lounge services."

Decision: We affirm the refusal under Trademark Act Section 2(d).