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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Backcountry Provisions, Inc.

Serial No. 78769198

Susan F. Fisher of Fairfield and Woods, P.C. for Backcountry Provisions, Inc.

Michael Webster, Trademark Examining Attorney, Law Office
102 (Karen Strzyz, Managing Attorney).

Before Quinn, Bucher and Wellington, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Backcountry Provisions, Inc. seeks registration on the
Principal Register of the mark shown below:



for services recited in the application, as amended, as "restaurant and delicatessen featuring sandwiches, soup, carry-out and catering sold solely through applicant's retail outlets" in International Class 43.¹

This case is now before the board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has found that applicant's mark, when used in connection with the identified goods, so resembles the mark **BACKCOUNTRY** for "restaurant services,"² as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and applicant have fully briefed the case. We affirm the refusal to register.

In arguing for registrability, applicant contends that the Trademark Examining Attorney has violated the anti-

¹ Application Serial No. 78769198 was filed on December 8, 2005 based upon applicant's allegation of first use anywhere and use in commerce at least as early as July 1, 1999. According to the application, "the mark consists of a circle filled with a drawing of a donkey with pack provisions on its back, and an outside ring with the words 'Backcountry Provisions' in it."

² Registration No. 1675449 issued to Backcountry Barbeque, Inc. on February 11, 1992 based on an application filed on May 29, 1990 claiming first use anywhere and first use in commerce at least as early as August 11, 1986; renewed. According to the Assignment Division of the United States Patent and Trademark Office, this registration is currently owned by Cook's Back Country Barbecue, Inc., Reel 1694, Frame 0832.

dissection rule in the way he applied the law when comparing the two marks; and that applicant's mark and the registered mark are dissimilar as to appearance, sound, connotation and commercial impression.

By contrast, the Trademark Examining Attorney contends that the services are legally identical; that applicant may not, by using extrinsic evidence, restrict in any way the scope of registrant's services or the nature of its mark; that in comparing the marks in their entireties, the marks are highly similar in sound, connotation and commercial impression inasmuch as applicant has merely added a design and a highly suggestive term to the registered mark; and that the word BACKCOUNTRY - the entirety of registrant's mark - is the first and most dominant portion of applicant's composite mark.

Likelihood of Confusion

We turn then to a consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on this issue. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201

(Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the relationship between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The Services

As seen above, the services in the cited registration are recited merely as "restaurant services." Applicant's amended services are recited as "restaurant and delicatessen featuring sandwiches, soup, carry-out and catering sold solely through applicant's retail outlets." As to this critical *du Pont* factor, as argued by the Trademark Examining Attorney, applicant and registrant offer legally identical restaurant services. On the face of the cited registration, registrant's services are not limited in any way (e.g., as to type of cuisine, channel of trade, classes of purchasers, etc.). Although applicant points to registrant's website for the proposition that registrant offers Lexington-style, wood-cooked barbecue, we cannot resort to such extrinsic evidence in order to restrict registrant's services. See, e.g., *In re Bercut-Vandervoort*

& Co., 229 USPQ 763, 764 (TTAB 1986) [evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration].

Furthermore, the fact that applicant, in addition to reciting "restaurant [services]" specifically enumerates "delicatessen," "carry-out" and "catering" services, does not eliminate this overlap in restaurant services. Hence, this *du Pont* factor favors the position of the Trademark Examining Attorney.

Channels of trade

As to the related *du Pont* factor focusing on the channels of trade, we are not persuaded by applicant's attempt to restrict its recitation of services by adding "sold solely through applicant's retail outlets." In fact, even if one reads this limitation at the end of the recitation of services as applying back to "restaurant" services, this purportedly-limiting language has no meaningful effect on applicant's actual trade channels. As noted by the Trademark Examining Attorney, restaurant services are generally provided by a restaurateur at her own establishment. The question is whether consumers would believe the services provided at applicant's "outlets" are

associated in some way with the same, potentially-anonymous source as the services provided at registrant's establishment(s). Also, the fact that registrant currently operates in North Carolina and applicant's outlets are located in the Rocky Mountain West is also irrelevant when deciding nationwide registrability. Accordingly, this *du Pont* factor too points toward a likelihood of confusion herein.

Condition of purchases

Moreover, we must presume that these legally-identical services will be perceived identically by potential purchasers, and that they will both be available to all classes of potential customers, including ordinary consumers. We assume that these respective services are not expensive, and that ordinary consumers will not exercise a high degree of care in selecting these restaurant services. Accordingly, this related *du Pont* factor also supports the position of the Trademark Examining Attorney herein.

The marks

We turn then to the *du Pont* factor focusing on the similarity or dissimilarity of the respective marks in their entirety as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports Inc. v. Veuve*

Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). We begin this part of the analysis mindful of the fact that when marks would appear on identical services, the degree of similarity in the marks necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Yet, as to each of the methods for comparison, applicant argues that the respective marks are not at all confusingly similar. Applicant has also repeatedly accused the Trademark Examining Attorney of dissecting the marks in his analysis of the similarities of the two marks.

While we must consider the similarity or dissimilarity of the marks when viewed in their entirety, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entirety." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Undeniably, there are obvious differences in the appearance of these two marks if one subjects them to a side-by-side comparison. Appellant's composite mark shares

only a single word, BACKCOUNTRY, with the cited mark, adding the word "PROVISIONS," the image of a pack animal, and all three of these components contained within two concentric circles. It is in this context that applicant argues that its constant inclusion of the image of a pack animal, with the words BACKCOUNTRY PROVISIONS, changes the appearance of the mark as a whole. However, under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons between marks. Hence, the proper test in determining likelihood of confusion is not whether the marks can be distinguished in a side-by-side comparison, but rather, the decision must be based on the similarity of the general commercial impressions engendered by the involved marks. *See Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980).

As to the dissimilarities in sound, again it is undeniable that registrant's "Backcountry" mark contains three syllables while applicant's "Backcountry Provisions" mark contains six syllables. On the other hand, the Trademark Examining Attorney points out that customers tend to focus more on the first word of a composite mark, and significantly, the seemingly arbitrary word "Backcountry" is presented in a larger and bolder font than is the highly-

suggestive word "Provisions."³ Accordingly, in the instant case, we have given more weight to the arbitrary BACKCOUNTRY portion of applicant's mark, which is identical to the entirety of registrant's mark.⁴

The Trademark Examining Attorney points out that the word portion is normally accorded greater weight as customers will call for these services with the literal portion of the mark. See, e.g., *In re Dakin's Miniatures*



Applicant's marks



Registrant's marks

Inc., 59 USPQ2d 1593 (TTAB 1999). In the *Dakin's* case, the Board held that the presence of various design elements in

³ In order to clear up any misunderstanding that applicant may have, whatever weakness the Trademark Examining Attorney may have ascribed to the word "Provisions" alone as a source indicator does not taint the entire mark. Applicant spends a significant portion of its reply brief (at 4 and 5) arguing that its mark is not merely descriptive. This is a position the Trademark Examining Attorney never took at any time during the prosecution of this application.

⁴ We also cannot resort to extrinsic evidence such as registrant's website or a classified advertisement, as applicant would have us do, to modify the nature of registrant's service mark or trade name to "Backcountry Barbecue" or "Backcountry Bar-B-Q."

the parties' marks does not dispel likelihood of confusion, because it is the word portion that consumers will remember.

However, applicant argues that its customers are likely to envision appellant's entire composite design because of the overall impression created by the consistent usage of the composite on all of applicant's signage, menus, napkins, decor, advertising and carry-out bags. In fact, applicant contends that the overall impression conveyed by its mark "is one of the Old West when the Rocky Mountains were sparsely populated by Native Americans, settlers, and miners, and of the equipment and food that pack animals carried to settlements and mines during the 1800's."

(Applicant's reply brief at 4). However, we find that the word "Backcountry" alone is entirely consistent, for example, with the connotation and commercial impression of a remote wilderness area reachable only by horseback.⁵

Interestingly, we note that a likelihood of confusion was found in *Dakin's* in spite of the difference in commercial impressions between that applicant's horses/western themes and the cuddly bear/baby themes of that registrant.

⁵ **backcountry:** n. sparsely inhabited rural areas; wilderness: *exploring the backcountry on horseback*, THE NEW OXFORD AMERICAN DICTIONARY, 2nd ed. 2005.

Apart from the design feature, appellant argues that its customers are likely to call for appellant's services using both of the mark's two literal elements, namely, "Backcountry" and "Provisions." However, the Trademark Examining Attorney has shown that the word "Provisions" that applicant has added to registrant's mark is a highly suggestive term for a service offering food. This is certainly a commonly-accepted rationale for giving somewhat lesser weight to a portion of a mark in reaching a likelihood of confusion determination.

Accordingly, we find that this critical factor supports a finding of likelihood of confusion.

Resolving Doubt

Finally, as pointed out by the Trademark Examining Attorney, any doubt we may harbor regarding a likelihood of confusion must be resolved in favor of the prior registrant.

Conclusion

Inasmuch as the respective services are legally identical, will presumably move through the same channels of trade to the same ordinary consumers, and the respective marks, in their entireties, are highly similar in sound, connotation and commercial impression, we find a likelihood of confusion herein.

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