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Mailed: June 27, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sally J. Coxe

Serial No. 78877323

William L. Bartow of DLA Piper US LLP for Sally J. Coxe.

Cory Boone, Trademark Examining Attorney, Law Office 104
(Chris Doninger, Managing Attorney).

Before Rogers, Kuhlke and Taylor, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Sally J. Coxe, applicant, has filed an application to register the mark BONOBO BREW (in standard character form) for goods ultimately identified as "coffee sold in connection with raising funds for, and awareness of, the Bonobo and its habitat" in International Class 30 and "beer sold in connection with raising funds for, and awareness of, the Bonobo and its habitat" in International Class 32.¹

¹ Application Serial No. 78877323, filed May 5, 2006, alleging first use on January 10, 2005 and first use in commerce in February, 2006 under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a).

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In response to a request from the examining attorney, applicant disclaimed the word BREW.

Registration has been refused 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 BONOBO'S registered (in typed form) for "naturally grown and organic foods, namely dried and frozen fruits and vegetables; edible oils, namely coconut oil, olive oil and nut and seed oils; nut and seed butters; nut and seed crisps" in International Class 29, "crackers, cookies, cakes and ice-cream" in International Class 30, "naturally grown and organic agricultural products, namely fresh fruits, vegetables, nuts and seeds" in International Class 31, and "restaurant services" in International Class 43, that, when used with its identified goods, applicant's mark is likely to cause confusion, mistake or deception.²

When the refusal was made final, applicant appealed and briefs have been filed. We reverse the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative

² Registration No. 3000676, issued September 27, 2005.

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facts in evidence that are relevant to the factors set forth in *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, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

With regard to the first du Pont factor, i.e., whether applicant's mark BONOBO BREW and registrant's mark BONOBO'S are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression, we find that the marks are similar.

The analysis is not whether the marks can be distinguished when compared side-by-side. Rather, we must determine whether the marks are sufficiently similar that there is a likelihood of confusion as to source and, in making this determination, we must consider the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Further, while it is correct that we must view the mark in its entirety, *Kangol Ltd. v. KangaROOS*

U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992), it is also well settled that "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." In re National Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985).

The word BONOBO in applicant's mark dominates over the disclaimed word BREW. The dominant portion of applicant's mark, BONOBO, is virtually identical to registrant's mark, BONOBO'S, and retains the same meaning, that of an "ape of north-central Congo, having black hair and more arboreal habits than the common chimpanzee." The American Heritage Dictionary of the English Language (4th ed. 2006).³ The disclaimed word BREW in applicant's mark and the possessive form of registrant's mark are not differences sufficient to distinguish the marks.

In view thereof, we find that the marks BONOBO BREW and BONOBO'S are similar in sound, appearance, connotation and commercial impression. Thus, the factor of the

³ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

similarity of the marks favors a finding of likelihood of confusion.

We turn then to a consideration of the goods and services identified in the application and the cited registration. It is well settled that goods and services need not be similar or competitive in nature to support a finding of likelihood of confusion. The question is not whether purchasers can differentiate the goods and services themselves, but rather whether purchasers are likely to confuse the source of the goods and services. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Further, we must consider the cited registrant's goods and services as they are described in the registration and we cannot read limitations into those goods and services. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). If the cited registration describes goods and services broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration encompasses all goods and services of the type described, that they move in all channels of trade normal for these goods and services, and that they are available

to all classes of purchasers for the described goods and services. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). Finally, it is well established that goods and services may be related. See *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (mark for distributorship services in the field of health and beauty aids held likely to be confused with mark for skin cream).

The examining attorney argues that applicant's goods and registrant's goods and services "serve related purposes and likely appear in the same channels of commerce" and that the "parties' products serve the same general human needs for nourishment and human desire for culinary enjoyment." Br. p. 9. In addition, the examining attorney argues that "applicant's goods are within the reasonable field of expansion typically accorded registrants." *Id.* Further, he contends that:

the registrant produces a wide variety of foods and operates restaurants [and c]onsumers would expect that an entity providing whole lines of foods could easily expand their product lines to include additional foods or beverages. The registrant's goods appear to focus on natural and organic ingredients, and the registrant could extend this product philosophy to beverages like coffee and beer as well. By affording the registrant a logical zone of expansion, the relationship between the registrant and applicant's goods becomes clearer."

Br. p. 10.

Finally, he argues that “[g]iven [that] the scope of the term ‘restaurant’ includes beverages, it is reasonable that the registrant serves, or could come to serve, beverages like the applicant’s coffee and beer in its course of business. Therefore, the registrant’s restaurant services, like its goods, are also related to the applicant’s goods.” Br. p. 11. In support of his position, the examining attorney submitted excerpts from registrant’s online menu for the restaurant which includes a listing of “beverages” (for example, young Thai coconut water, pressed sugar cane juice, pressed fruit juices du jour, and warm lemon ginger or mint tea).

Addressing the requirement to show “something more”⁴ in making a connection between applicant’s coffee and beer and registrant’s restaurant services, the examining attorney states:

The registrant produces goods beyond simply providing restaurant services. This fact affords the registrant the opportunity to expand its products into related fields. At the same time, the presence of goods in the registration causes the relatedness analysis in this case to concern more than merely the applicant’s goods and the services provided by the registrant. Finally,

⁴ In re Coors Brewing Co., 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) citing Jacobs v. International Multifoods Corp., 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982) (fact that restaurants serve food and beverages not enough to find food and beverages related to restaurant services, rather a party must show something more than that similar or even identical marks are used for food products and for restaurant services).

the fact that the registrant's restaurants provide brewed beverages establishes the "something more" requirement to which the applicant refers. As the applicant notes, "'something more' than a mere conflict between a use on food and a use on restaurant services is needed, *such as use on a food product of the type likely to be marketed by a restaurant.*" Applicant's Br. at 3. [Emphasis added] This case presents the "something more" in two ways. The registrant also produces goods, and those goods are related to the applicant's. And the applicant's coffee and beer are goods of *the type likely to be marketed by the registrant's restaurants.*

Br. p. 15. [Emphasis in original]

The examining attorney attempts to distinguish In re Coors Brewing Co. by stating that, in addition to beer, the applicant here also provides coffee, which is often sold in all classes of restaurants and without clear branding. In addition, the examining attorney notes that in this case the registration includes both restaurant services and goods. Thus, the examining attorney argues:

...the difference here is that the cited registrant already produces goods under a house label, and is therefore entitled to reasonable expansion for goods related to its identified goods or of the type it would serve in its restaurants...Here, the issue is the rather simpler one of whether it is likely that the registrant would reasonably expand its existing house label for goods to coffee or beer goods.

Br. p. 16.

While the examining attorney argues that beer and coffee are related to registrant's goods, there is no

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evidence in the record to support this argument or even to support the position that beer and coffee are within registrant's logical zone of expansion. We do not find the listed goods in the registration to be such a broad product line that registrant could naturally expand to such diverse products as coffee and beer. As to the restaurant services, the only evidence of record tends to undercut the examining attorney's argument inasmuch as coffee and beer, although ubiquitous on restaurant menus, are noticeably absent from registrant's menu. In fact, based on the excerpts of record it is hard to imagine registrant serving coffee or beer. The following excerpt from registrant's website describes the inspiration for the registrant's cuisine:

...Instinct is responsible for their diets instead of social custom and food manufacturers. Their diet is predominantly raw, wild and plant based: fruits, vegetables, nuts and seeds. Since there is so much discussion about the correct diet for humans, bonobos can give us tremendous insight into what we are meant to eat and what kind of lifestyle we should have. In fact humans for millions of years had the same diet. The cooked-food animal-based diet is very recent in history and its rise parallels the rise of degenerative disease and related challenges.

February 25, 2008 Office Action Attachment 6. See also February 25, 2008 Office Action Attachment 4 ("Bonobo's Restaurant is New York City's newest and most spectacular

Vegetarian Restaurant. Bonobo's offers the most delicious, nutritious and eco-friendly food choices on the planet.")

As stated by the Court of Appeals for the Federal Circuit:

It is not unusual for restaurants to be identified with particular food or beverage items that are produced by the same entity that provides the restaurant services or are sold by the same entity under a private label. Thus, for example, some restaurants sell their own private label ice cream, while others sell their own private label coffee. But that does not mean that any time a brand of ice cream or coffee has a trademark that is similar to the registered trademark of some restaurant, consumers are likely to assume that the coffee or ice cream is associated with that restaurant. The Jacobs case stands for the contrary proposition, and in light of the very large number of restaurants in this country and the great variety in the names associated with those restaurants, the potential consequences of adopting such a principle would be to limit dramatically the number of marks that could be used by producers of foods and beverages.

In re Coors, supra at 1346 citing Jacobs v. International Multifoods Corp., supra at 642 (CCPA 1982).

Based on this record, we cannot find that the involved goods are related or that applicant's goods are related to registrant's restaurant services. The fact that the cited registration includes restaurant services and certain food items which are not related to applicant's coffee or beer, is not sufficient to conclude that applicant's goods are related to or within the zone of expansion of registrant's

goods or services. Moreover, the expansion of trade doctrine has limited application in an ex parte proceeding. See *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1584 (TTAB 2007), citing *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977).

In view of the above, we find that the examining attorney has not established that applicant's coffee and beer sold in connection with raising funds for and awareness of the Bonobos are related to registrant's organic dried, frozen and fresh fruits, vegetables, nuts and seeds, oils, butters, crackers, cookies, cakes, ice-cream, and restaurant services, and the du Pont factor of the similarity of the goods and services does not weigh in favor of a finding of likelihood of confusion.

As to the channels of trade, applicant argues that its goods "will be sold in specific and recognizable channels of trade such that the coffee and beer are sold in connection with raising funds for, and awareness of, the Bonobo and its habitat." Reply Br. p. 5. Applicant also states that its "goods are to be sold in supermarkets and through BCI [Bonobo Conservation Initiative] itself." Br. p. 19. However, because the identification of goods in the registration is not limited to any specific channels of trade it is possible that applicant's goods and

registrant's goods could be sold in the same store.⁵ However, "[a] wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on any goods so displayed." Federated Foods, *supra* at 29. There is no evidence in the record to support a finding that such items (coffee and beer, and crackers, nuts, oils, dried, frozen and fresh fruits and vegetables) would be in close proximity to each other or are complementary in a manner that would imply some relationship as to source. As to the restaurant services, it is true that coffee and beer are often served in restaurants, and to that extent the channels of trade could overlap, but with applicant's qualifying language that these goods are only sold in connection with fundraising activities it is less likely that such overlap would occur.

⁵ Applicant's argument that the "evidence shows that the only channel of commerce for the Registrant's goods is its restaurant" (Br. p. 5) is unavailing inasmuch as we must make our determination based on the identification of goods and there is no limitation as to trade channels for registrant's goods. Hewlett Packard, *supra*.

As to the conditions of sale, although applicant argued that the potential purchasers of the involved goods and services would be sophisticated, we do not believe the record supports such a finding and find this factor to be neutral in our analysis.

In conclusion, because we find that the goods and services are not related, despite the marks being similar and some overlap in the channels of trade, confusion is not likely between applicant's mark and the mark in the cited registration.

Decision: The refusal to register under Section 2(d) of the Trademark Act is reversed.