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Mailed: August 4, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

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In re Parallel World Brewing Company LLC

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Serial No. 87403137
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Brian D. Kaider of Kaiderlaw,
for Parallel World Brewing Company LLC.

Sandra Snabb, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

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Before Wolfson, Pologeorgis, and Johnson,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Parallel World Brewing Company LLC (“Applicant”) seeks registration on the Principal Register of the standard character mark CHRONICLE for “beer” in International Class 32.¹

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with the mark CHRONICLE (in standard characters)

¹ Application Serial No. 87403137, filed on April 7, 2017, based on an allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

registered on the Principle Register for “Restaurant; café; snack bar; coffee bar and coffee house; carry out restaurant, and take out restaurant services; catering services; coffee supply services for offices; contract food services; food preparation; preparation of carry out foods and beverages” in International Class 43.²

When the refusal was made final, Applicant appealed. Both Applicant and the Examining Attorney filed briefs. For the reasons explained below, we reverse the refusal to register.³

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor for which there is evidence and argument of record. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular

² Registration No. 4601901, issued on September 9, 2014.

³ The TTABVue and Trademark Status & Document Retrieval (“TSDR”) citations refer to the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .PDF version of the documents.

determination.”).

In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. Similarity of the Marks

We first consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 369 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). Here, the marks are identical and, therefore, they are identical in sound, appearance, connotation, and commercial impression.

Thus, the first *DuPont* factor strongly favors a finding of likelihood of confusion.

B. Similarity of the Goods and Services

We next turn to the comparison of the goods and services under the second *DuPont* factor. In making our determination regarding the relatedness of the goods and services, we must look to the goods as identified in Applicant’s application and

services listed in the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Computs. Servs. 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 the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”)); *see also In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

Moreover, registration must be refused in a particular class if Applicant’s mark for any of its identified goods in that class is likely to cause confusion with the Registrant’s mark for any of its identified services. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 938-39 (Fed. Cir. 1983) (holding that a single good from among several may sustain a finding of likelihood of confusion); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application).

Applicant’s goods are “beer.” Registrant’s services include “restaurant services.” It is settled that it is not necessary that the respective goods and services be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. The respective goods and services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they

could give rise to the mistaken belief that goods [and services] emanate from the same source.” *Coach Servs. Inc., v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); see also *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991).

Evidence of relatedness may include news articles and/or evidence from computer databases showing that the relevant goods and services are used together or used by the same purchasers; advertisements showing that the relevant goods and services are advertised together or offered by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both Applicant’s goods and the services identified in the cited registration. *In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014) (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores). The issue is not whether purchasers would confuse the goods and services, but rather whether there is a likelihood of confusion as to their source. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830, 832 (TTAB 1984).

However, we point out that in cases such as this one, where restaurant services are being compared to actual food or drink items, there is no per se rule that those goods and services are related. *Lloyd’s Food Prods., Inc. v. Eli’s, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2030 (Fed. Cir. 1993) (no per se confusion, where similar marks are

used in connection with restaurant services and food products). Rather, when it comes to restaurant services and food or beverages, including alcoholic beverages, “something more” is required (over and above a showing that the goods and services are offered together) because the relatedness of the parties’ respective goods and services is not evident. *In re Opus One Inc.*, 60 USPQ2d 1812, 1813 (TTAB 2001).

In *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063-64 (Fed. Cir. 2003), the Federal Circuit assessed whether “something more” showed the relatedness of beer and restaurant services. The court explained why more evidence than just showing that restaurants sell beer under a private label is required to prove that beer and restaurant services are related:

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 [*Jacobs v. Int’l Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641 (CCPA 1982)] 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.

Id. at 1064.

The Board has found the “something more” requirement to be met or a viable relationship between the goods and services at issue has been demonstrated under the following circumstances:

- Applicant’s mark made clear that its restaurant specialized in

registrant's type of goods. *See In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990) (GOLDEN GRIDDLE PANCAKE HOUSE for restaurant services confusingly similar to GOLDEN GRIDDLE for table syrup); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) (AZTECA MEXICAN RESTAURANT for restaurant services confusingly similar to AZTECA for Mexican food items);

- The record showed that registrant's wines were actually sold in applicant's restaurant. *See Opus One*, 60 USPQ2d at 1815 ("the record in this case reveals that registrant's OPUS ONE wine is offered and served by applicant at its OPUS ONE restaurant.");
- The record shows that applicant's or registrant's restaurants are of a certain type (e.g., "coffee houses") that commonly package and sell food or beverage items under the restaurant's mark. *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2050-51 (TTAB 2012) (COLOMBIANO and COLOMBIAN both meaning "from Colombia;" the country is known for coffee beans; Applicant's services of "providing food and drink" related to Registrant's "coffee"); and
- Registrant's mark was found to be "a very unique, strong mark." *See In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1469 (TTAB 1988) ("the Examining Attorney has indicated that he has been unable to find, in the records of the Patent and Trademark Office, any registration, other than the cited registration, for a mark containing the expression 'Mucky Duck,'" nor had applicant offered any evidence of third-party use of marks containing the expression).

To demonstrate that the "something more" requirement has been satisfied in this case, the Examining Attorney submitted 10 third-party registrations showing that the same entity has registered a single mark for "beer," "restaurant services," "catering services," and "food preparation."⁴ Additionally, the Examining Attorney furnished screenshots belonging to 11 third-party dining establishments purportedly

⁴ August 26, 2017 Suspension Letter; TSDR pp. 5-32.

demonstrating that these eateries use a single mark as a source indicator not only for the beer they serve on premise at their restaurants but also for the dining services, take out services, and carry out services they provide.⁵ The Examining Attorney also argues that since the cited mark CHRONICLE is an arbitrary mark in relation to Registrant's restaurant services, it is conceptually strong and, therefore, it is entitled to the normal scope of protection afforded inherently distinctive marks.⁶ Finally, the Examining attorney notes that there is no evidence of record of widespread third-party use of the term CHRONICLE for restaurant services so as to weaken or dilute the cited mark for restaurant services.⁷

In challenging the refusal, Applicant argues that the evidence submitted by the Examining Attorney is precisely the type of evidence rejected by the Federal Circuit in *In re Coors* as being sufficient to satisfy the "something more" requirement.⁸ In support of its argument, Applicant cites to the following portions of the *In re Coors* decision:

[w]hile the evidence produced by the examining attorney shows that some restaurants brew or serve their own private label beer, that evidence does not support the Board's conclusion that consumers are likely to conclude that beer and restaurant services with similar marks emanate from the same source.

In re Coors, 68 USPQ2d at 1063.

although the Board had before it a few registrations for both restaurant

⁵ *Id.*; TSDR pp. 33-61; May 17, 2019 Office Action, TSDR pp. 17-44; and August 31, 2019 Final Office Action, TSDR pp. 8-44.

⁶ Examining Attorney's Brief, p. 10; 6 TTABVUE 11.

⁷ *Id.* at p. 11; 6 TTABVUE 12.

⁸ Applicant's Appeal Brief, p. 11; 4 TTABVUE 12.

services and beer, the very small number of such dual use registrations does nothing to counter Coors' showing that only a very small percentage of restaurants actually brew their own beer or sell house brands of beer; instead, the small number of such registrations suggests that it is quite uncommon for restaurants and beer to share the same trademark. Thus, the evidence before the Board indicates not that there is a substantial overlap between restaurant services and beer with respect to source, but rather that the degree of overlap between the sources of restaurant services and the sources of beer is de minimis. We therefore disagree with the Board's legal conclusion that Coors' beer and the registrant's restaurant services are sufficiently related to support a finding of a likelihood of confusion.

Id. at 1063-64.

Additionally, Applicant has submitted evidence demonstrating that, according to the National Restaurant Association's 2019 Restaurant Industry Factbook, there were over one million restaurants operating throughout the United States in 2018.⁹ Applicant also submitted screenshots from the Brewers Association's website that indicates that there were 2,594 brewpubs and 4,522 microbreweries operating in the United States in 2018.¹⁰

Applicant concludes that, "[i]n light of the *Coors* case and the evidence presented ... that the ratio of restaurants to breweries is >1,000,000 to 7,450; the Examiner's conclusion that 'applicant's and registrant's goods and services are considered related for likelihood of confusion purposes' is not supported by substantial evidence and Applicant respectfully requests that the refusal be overturned."¹¹

⁹ August 12, 2019 Response to Office Action, TSDR p. 14.

¹⁰ *Id.*, TSDR pp. 15-20.

¹¹ Applicant's Appeal Brief, p. 11; 4 TTABVUE 12.

While we acknowledge that the Internet materials submitted by Applicant from the Restaurant Association and Brewer's Association websites technically constitute hearsay, the

We agree with Applicant. Initially, we note that only 6 of the 11 screenshots of third-party dining establishments submitted by the Examining Attorney demonstrate that these eateries provide both beer and their dining services under the same mark.¹² The screenshots from the remaining 5 third-party eateries only show that these dining establishments serve beer and not under the same mark as the dining services.¹³ Moreover, the 6 eating establishments that do serve beer and provide dining services under the same mark all appear to be brewpubs.¹⁴ If Registrant's mark had been for brewpub services or for restaurant services and beer, "the case for a likelihood of confusion therefore [would be] much stronger. But the registered mark in this case is simply for restaurant services in general" *In re Coors*, 68 USPQ2d at 1064. (noting that the Board's conclusion that restaurant

Board generally takes a somewhat more permissive stance with respect to the admissibility and probative value of such evidence in an *ex parte* proceeding than it does in an *inter partes* proceeding. *See, e.g., In re Sela Products LLC*, 107 USPQ2d 1580, 1584 (TTAB 2013) ("...the Board does not, in *ex parte* appeals, strictly apply the Federal Rules of Evidence, as it does in *inter partes* proceedings."); *In re Hudson News Co.*, 39 USPQ2d 1915, 1920 n.10, 1924 n.18 (TTAB 1996) (Board allowed NEXIS evidence to show psychological effect of color blue, despite hearsay nature of such evidence), *aff'd* without opinion (Fed. Cir. 1997); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208 (2020); *cf.* Fed. R. Evid. 803(17) (which provides that market quotations, tabulations, lists, directories, or other published compilations, generally used and relied upon by the public or by persons in particular occupations, are not excluded by the hearsay rule).

¹² May 17, 2019 Office Action, TSDR pp. 17-20 and 41-44; and August 31, 2019 Office Action, TSDR pp. 8-44.

¹³ August 26, 2017 Suspension Letter; TSDR pp. 33-61; May 17, 2019 Office Action, TSDR pp. 21-40.

¹⁴ We take judicial notice of the definition of "brewpub" which is defined as "a bar serving beer brewed at a small microbrewery on the premises." *See* www.dictionary.com (based on The Random House Unabridged Dictionary – 2020). The Board may take judicial notice of dictionary definitions, including online dictionaries, definitions in technical dictionaries and translation dictionaries that exist in printed format. *See In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013).

services and beer are related “is based on the fact that a tiny percentage of all restaurants also serve as a source of beer, which is a very weak evidentiary basis for a finding of relatedness.”). Further, in considering Applicant’s evidence regarding the amount of brewpubs/microbreweries versus the amount of restaurants operating in the United States, even if all the brewpubs and microbreweries featured restaurant services, those establishments would only constitute approximately .007% of the total number of restaurants in the U.S. *See In re Coors*, 68 USPQ2d at 1063 (“Coors introduced evidence that there are about 1,450 brewpubs, microbreweries, and regional specialty breweries in the United States, while there are approximately 815,000 restaurants. There was no contrary evidence introduced on those points. That means that even if all brewpubs, microbreweries, and regional specialty breweries featured restaurant services, those establishments would constitute only about 18 one-hundredths of one percent of all restaurants, or fewer than one in 500.”).

While the Examining Attorney submitted evidence of six restaurants that sell private label beer, that evidence does not suggest that such restaurants are numerous. Moreover, although the Examining Attorney also submitted 10 third-party registrations for both restaurant services and beer, the number of such dual use registrations does not sufficiently counter Applicant’s evidence showing that only a very small percentage of restaurants actually brew their own beer or sell house brands of beer. Instead, the evidence of record suggests that it is not common for restaurants and beer to share the same trademark. Lastly, the Examining Attorney did not submit any trade publications or articles demonstrating that it is

commonplace for restaurants in general to provide private label beer under the same mark as their restaurant services. *Compare In re Opus*, 60 USPQ2d at 1815 (The examining attorney submitted 35 Nexis articles demonstrating that it is an increasingly common practice in the industry for restaurants to offer and serve to their patrons “private label” wines which are named after the restaurant). Thus, the evidence of record does not indicate that there is a substantial overlap between restaurant services and beer with respect to source. Rather, the record reveals that the degree of overlap between the sources of restaurant services and the sources of beer is not extensive.

We additionally note that there is no evidence of record that Applicant’s beer is offered at Registrant’s restaurant. Nor is there any of evidence that Registrant’s restaurant services feature beer, such as a brewpub or microbrewery. Accordingly, we find that, based on the rationale espoused by the Federal Circuit in *In re Coors*, the evidence submitted by the Examining Attorney, collectively, is quite simply insufficient to satisfy the “something more” requirement, notwithstanding the fact that the cited mark is conceptually strong and there is no evidence of extensive third-party use of CHRONICLE-formative marks for restaurant services.¹⁵

Therefore, the second *DuPont* factor favors a finding that confusion is unlikely.

C. Similarity of Trade Channels and Classes of Purchasers

Next we consider established, likely-to-continue channels of trade, the third

¹⁵ We note that on a different record we may have reached a different conclusion.

DuPont factor. The record demonstrates that the ordinary trade and distribution channels for beer include restaurants.¹⁶ Registrant provides, in part, restaurant services under the cited mark. Thus, the trade channels and classes of purchasers for both Applicant's beer and Registrant's restaurant services, at a minimum, overlap.

Accordingly, the third *DuPont* factor also favors a finding of likelihood of confusion.

D. Extent of Potential Confusion

Applicant also argues that the twelfth *DuPont* factor, the extent of potential confusion, i.e., whether de minimis or substantial, is also a relevant consideration. According to Applicant, any potential confusion would be de minimis because Registrant's restaurant operating under the CHRONICLE mark in a single location in St. Louis, Missouri has closed.¹⁷ In support thereof, Applicant submitted, inter alia, (1) an online article from www.stltoday.com stating that Registrant's CHRONICLE restaurant closed in 2014;¹⁸ (2) a screenshot from www.northwestcoffee.com/news (a company that purportedly owns Registrant's restaurant) indicating that Registrant's CHRONICLE restaurant has permanently closed;¹⁹ and (3) a screenshot taken from Google Maps ostensibly demonstrating that the site of Registrant's restaurant appears to be vacant with no external signage.²⁰ Applicant also contends that its

¹⁶ See fn. 5, supra.

¹⁷ Applicant's Appeal Brief, pp. 11-13; 4 TTABVUE 12-15.

¹⁸ August 12, 2019 Response to Office Action; TSDR pp. 21-26.

¹⁹ *Id.*; TSDR pp. 27-28.

²⁰ *Id.*; TSDR p. 31.

counsel placed a telephone call to the phone number listed for Registrant's restaurant and received a recording that the number was no longer in service.²¹

To the extent Applicant is arguing that Registrant is no longer using its CHRONICLE mark for "restaurant services," such an argument constitutes an impermissible collateral attack on the cited registration. Under Trademark Act Section 7(b), a certificate of registration is prima facie evidence of the validity of the registration. 15 U.S.C. § 1057(b). If an applicant believes a cited registration is invalid, those arguments will not be heard in an ex parte proceeding; instead the applicant must petition to cancel the registration. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re Fiesta Palms*, 85 USPQ2d 1360, 1363 (TTAB 2007); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 716.02(a) (October 2018). Thus, we cannot consider the extrinsic evidence submitted by Applicant that purportedly demonstrates that Registrant's "restaurant services" are no longer operational under the cited CHRONICLE mark.

That being said, however, because we have found that the "something more" requirement has not been met in this case, i.e., the evidence of record does not demonstrate that Applicant's "beer" is sufficiently related to Registrant's "restaurant services" for likelihood of confusion purposes, we find that the extent of possible confusion cannot be substantial.

Accordingly, this *DuPont* factor favors a finding that confusion is not likely.

²¹ Applicant's Appeal Brief, p. 13; 4 TTABVUE 14.

II. Conclusion

We have considered all of the arguments and evidence of record. We find that the marks at issue are identical, that the cited mark is arbitrary in nature and, therefore, conceptually strong, and that Applicant's goods and the restaurant services identified in the cited registration move in common channels of trade to the same or overlapping classes of consumers. However, the evidence of record is insufficient to satisfy the "something more" requirement under *In re Coors* so as to establish that Applicant's beer and Registrant's restaurant services, as well as the other services recited in the cited registration, are sufficiently related for likelihood of confusion purposes. This is a critical shortcoming in the evidence, because even identical marks will not cause confusion unless there is at least some degree of relatedness of the goods and services at issue. *See In re Opus, Inc.*, 60 USPQ2d at 1815 ("[T]he requisite 'viable' relationship between registrant's goods and applicant's services, **even if they are sold under identical marks**, must consist of 'something more' than the fact that registrant uses the mark on a food or beverage item (wine) and applicant uses the mark in connection with restaurant services.") (emphasis added). In view thereof, we conclude that Applicant's CHRONICLE mark, as used in connection with the goods identified in its involved application, is not likely to cause confusion or mistake, or to deceive with Registrant's CHRONICLE mark used in conjunction with Registrant's listed services under Section 2(d) of the Trademark Act.²²

²² In light of our decision, Applicant's alternative request to suspend this appeal until the time for Registrant to file its Section 8 affidavit of continued use has expired, *see* Applicant's Brief, p. 15; 4 TTABVUE 16, is deemed moot and will be given no further consideration.

Serial No. 87403137

Decision: The refusal to register Applicant's CHRONICLE mark under Section 2(d) of the Trademark Act is reversed.