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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

**26 MAR 1998**

Paper No. 12  
EWH/TLW

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Captain Morgan's Retreat, Ltd.

Sams  
attys

Serial No. 74/554,300

03-7-31-00

Joseph J. Jochman, Jr. of Andrus, Sceales, Starke & Sawall  
for Captain Morgan's Retreat, Ltd.

Elizabeth A. Dunn, Trademark Examining Attorney, Law Office  
109 (Deborah S. Cohn, Managing Attorney).

Before Cissel, Hanak and Hohein, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge.

Captain Morgan's Retreat, Ltd. (applicant) seeks  
registration of CAPTAIN MORGAN'S RETREAT in typed capital  
letters for "resort and hotel services, including activities  
such as boating, scuba-diving, tours, fishing, swimming,  
snorkling and restaurant services featuring gourmet dining."  
The application was filed on July 28, 1994 with a claimed  
first use date of September 1987.

The Examining Attorney has refused registration  
pursuant to Section 2(d) of the Trademark Act on the basis

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that applicant's mark, as applied to applicant's services, is confusingly similar to the mark CAPTAIN MORGAN'S SEAFOOD, previously registered in typed capital letters for "restaurant services." This Registration No. 1,120,268 issued on June 12, 1979 with a claimed first use date of March 1976.

When the refusal was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing

In any likelihood of confusion analysis, two key considerations are the similarities of the goods and/or services and the similarities of the marks. *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 the differences in the essential characteristics of the goods [or services] and differences in the marks.").

Considering first applicant's services and registrant's services, it is the position of the Examining Attorney that they are essentially identical. At page four of her brief, the Examining Attorney makes the following allegation. "For the purposes of a Section 2(d) comparison, the restaurant services of both parties must be presumed to include restaurant services available through resorts and hotels which feature gourmet dining "

To cut to the quick, we find that the services of the parties are by no means identical. Applicant's services are "resort and hotel services." Registrant's services are "restaurant services." In its formal description of its services, applicant has chosen to list certain of the "activities" which are included in its resort and hotel services. One such activity is "restaurant services featuring gourmet dining." The listing of this activity is, in reality, unnecessary because resorts, by their very nature, offer to their guests restaurant services. Contrary to the assertion of the Examining Attorney, the services of applicant and registrant are simply not identical.

We note that in her discussion of applicant's and registrant's services, the Examining Attorney has cited In re Dixie Restaurants Inc., 41 USPQ2d 1531 (Fed. Cir. 1997). However, the facts of that case are distinguishable from the facts of this case. In Dixie Restaurants, applicant's services were "restaurant services" and registrant's services were "hotel, motel, and restaurant services." 41 USPQ2d at 1532. In affirming the refusal to register, the Court noted that applicant's services were identical to certain of registrant's services in that registrant's mark was specifically "registered, in part, for restaurant services." 41 USPQ2d at 1534. In contrast, applicant in this case does not seek to register its mark for stand alone

restaurant services. Rather, applicant seeks to register its mark for resort and hotel services. The Examining Attorney has presented absolutely no evidence showing that resorts use their names to likewise name the restaurants within the resorts.

In short, we find that consumers would clearly distinguish between resort and hotel services, and restaurant services. Indeed, our primary reviewing Court has noted that consumers would be readily able to distinguish between even resort services and hotel services. In re Four Seasons Hotels Ltd., 987 F.2d 1565, 26 USPQ2d 1071, 1072 (Fed. Cir. 1993). Obviously, resort services and hotel services are more closely related than are "resort and hotel services" and restaurant services. If consumers can distinguish between the former two types of services, they clearly can distinguish between the latter two types of services.

Before concluding our discussion of the services of the parties, one final comment is in order. The Examining Attorney has never disputed applicant's contention that typically consumers exercise a fair amount of care in selecting a resort. In its opening brief, applicant states that a purchaser of resort services "is clearly not an impulse purchaser," but rather "is a careful sophisticated buyer." (Applicant's brief page 4). In her brief, the

Examining Attorney never took issue with applicant's characterization of the level of purchaser sophistication for resort and hotel services. This level of purchaser sophistication is important in any likelihood of confusion analysis because, as our primary reviewing Court has stated, purchaser "sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." *Electronic Design v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992).

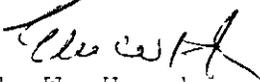
Turning to a consideration of the marks, we find that the presence of the word RETREAT in applicant's mark and the presence of the word SEAFOOD in registrant's mark is sufficient to avoid any likelihood of consumer confusion given the fact that the services of the parties are different and the additional fact that consumers of applicant's services would exercise a fair degree of care in the selection of said services. Put quite simply, we do not believe a consumer familiar with CAPTAIN MORGAN'S SEAFOOD restaurant would, in selecting a resort at which to vacation, simply assume that CAPTAIN MORGAN'S RETREAT resort was associated with the restaurant

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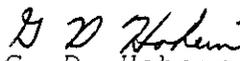
Decision: the refusal to register is reversed.



R. F. Cissel



E. W. Hanak



G. D. Hohein

Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board