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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Island Oasis Frozen Cocktail Company, Inc.

Serial No. 75/883,870

John L. Welch of Foley, Hoag & Eliot LLP for applicant.

Stephanie M. Davis, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Simms, Wendel and Drost, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Island Oasis Frozen Cocktail Company, Inc.

(applicant), a Massachusetts corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark ISLANDER for non-alcoholic bases and concentrates used in making frozen drinks, both alcoholic and non-alcoholic; bases and concentrates for making smoothies; frozen drinks, both alcoholic and non-alcoholic; smoothie beverages consisting primarily of fruit base, ice,

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and ice cream or yogurt; and smoothie beverages consisting primarily of fruit base and ice.¹ The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), on the basis of Registration No. 1,032,576, issued February 3, 1976 (renewed) for the mark ISLANDER COFFEE HOUSE ("COFFEE HOUSE" disclaimed) for restaurant services. Applicant and the Examining Attorney have submitted briefs but no oral argument was requested.

It is the Examining Attorney's position that, because disclaimed and descriptive matter is less significant and less dominant, and because greater weight may be given to the dominant part of a mark, applicant's mark ISLANDER and registrant's mark ISLANDER COFFEE HOUSE are similar. That is to say, applicant's mark is identical to the dominant part of registrant's mark. With respect to the goods, because a "coffee house" is defined as a "restaurant where coffee and other refreshments are served," registrant's restaurant services could include the serving of frozen drinks and smoothie beverages, the Examining Attorney argues. Also, the Examining Attorney maintains that coffee is sometimes served frozen or chilled with or without liquor. Applicant's goods, according to the Examining

¹Application Ser. No. 75/883,870, filed December 30, 1999, based upon an allegation of a bona fide intention to use the mark in commerce.

Attorney, could be offered in registrant's establishments. In any event, the Examining Attorney contends that registrant could expand its field of trade to include applicant's goods. Finally, the Examining Attorney asks us to resolve any doubt in favor of the prior registrant.

In support of her refusal, the Examining Attorney submitted copies of third-party registrations covering both cocktails and espresso beverages on the one hand and restaurant services on the other.²

Applicant argues that the respective marks are different in that the words "COFFEE HOUSE" in registrant's mark indicate the nature of registrant's services and play a "critical role" in the perception of registrant's mark. Concerning the respective goods and services, aside from arguing that there is no per se rule with respect to finding likelihood of confusion in cases involving restaurant services and food products, applicant maintains that its frozen beverages and concentrates would not be found in a coffee house. It is applicant's position that there is no evidence that the public might expect frozen drinks to be sold under the same mark as restaurant

² These registrations are for the marks CHI-CHI'S for restaurant services and for prepared alcoholic cocktails, T.G.I. FRIDAY'S for restaurant and bar services and for "wines, liqueurs and spirits; namely, prepared alcoholic cocktails," and STARBUCKS COFFEE for restaurant services featuring coffee and espresso beverages.

services, and that there is no evidence that registrant would or could expand into applicant's different goods. Further, with respect to the dictionary definition, applicant argues that there is no proof that "other refreshments" include frozen drinks and smoothie beverages. Finally, applicant contends that none of the third-party registrations made of record by the Examining Attorney specifically include applicant's goods.³

Upon careful consideration of this record and the arguments of the attorneys, we conclude that confusion is not likely. First, with respect to the marks, they obviously share the dominant origin-indicating word "ISLANDER," but differ since the registered mark includes the generic words "COFFEE HOUSE." While the respective marks must, of course, be compared in their entireties, including any disclaimed matter, our principal reviewing court has indicated that, in articulating reasons for

³ Applicant has objected to the Web page printouts of definitions from "A Seattle Lexicon" submitted with the Examining Attorney's brief, on the ground that these definitions are not from a well-known or recognized reference work. Applicant points out that this reference is an "Interpretive guide for non-Northwesterners who want to get the inside line on the local lingo."

Because evidence may not be submitted with an appeal brief (Trademark Rule 2.142), we may only consider this evidence if it is matter of which we may take judicial notice. We agree with applicant that this source is not sufficiently reliable to allow judicial notice to be taken. We do, however, take judicial notice of the definitions from The American Heritage College Dictionary (Third Edition 1993), Webster's New Collegiate Dictionary (1981) and Webster's New Twentieth Century Dictionary (Second Edition 1983) submitted with applicant's appeal brief.

reaching a conclusion on the issue of likelihood of confusion, "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 [that] the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" 224 USPQ at 751. Nevertheless, in this case the words "COFFEE HOUSE" lend a different significance and commercial impression to the registered mark than any meaning or impression conveyed by applicant's mark.

With respect to applicant's goods, such as its non-alcoholic frozen drinks and smoothie beverages consisting of fruit base and ice, the Examining Attorney has introduced no specific evidence from which we might conclude that such goods would be sold in coffee house-type restaurants.⁴ Nor is there any evidence that coffee house restaurants are likely to serve applicant's alcoholic

⁴ Both applicant and the Examining Attorney have assumed, as do we, that registrant's services are coffee house restaurant services. The Examining Attorney has not argued that we should construe registrant's services to be broader than that.

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beverages. Rather, the only evidence of record pertains to restaurants that prepare and serve food as well as alcoholic cocktails, and a coffee house restaurant that serves coffee and espresso beverages. Suffice it to say that, because there is no per se rule for finding likelihood of confusion in cases involving restaurant services and specific food or beverage items, we cannot conclude from this record that the Examining Attorney has demonstrated that applicant's frozen drinks or its smoothie beverages containing fruit base and ice (or any other of its beverages) would be sold in registrant's restaurant such that purchasers would believe that applicant's goods come from registrant's coffee house restaurant. Moreover, applicant's concentrates and bases are even more unlikely to be sold in registrant's coffee house restaurants.

We should also point out that the Examining Attorney has not presented any evidence, or even argued, that coffee house restaurants (or any restaurants for that matter) have or are likely to sell their beverage products in grocery stores and supermarkets, such that consumers may have become accustomed to seeing such restaurant service marks on beverage products available in retail stores. Such evidence might tend to indicate that purchasers, aware of registrant's restaurants, who then encounter beverage

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products such as some of those sold by applicant, would believe that those products come from or are sponsored or licensed by the restaurant.

We conclude that the Examining Attorney has not demonstrated on this record that confusion is likely.

Decision: The refusal of registration is reversed.