

**This Opinion is Not a
Precedent of the TTAB**

Mailed: September 4, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Starr Restaurant Organization, L.P.
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Serial No. 86750107
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David V. Radack of Eckert Seamans Cherin & Mellott, LLC,
for Starr Restaurant Organization, L.P.

John Dwyer, Trademark Examining Attorney, Law Office 116,
Christine Cooper, Managing Attorney.

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Before Wellington, Heasley, and English,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Starr Restaurant Organization, L.P. (“Applicant”) seeks registration on the Principal Register of the standard character mark SURFSIDE 6 for “bar and restaurant services” in International Class 43.¹

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the registered

¹ Application Serial No. 86750107, filed on September 8, 2015, is based on Applicant’s claim 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).

standard character mark SURFSIDE for “restaurant and bar services” in International Class 43.²

The refusal was made final and Applicant has appealed to this Board. For the reasons given herein, we affirm the refusal to register the mark.

I. Applicable Law

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods and 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 [or services] and differences in the marks.”).

A. Identity of Services and Trade Channels

With regard to the *du Pont* factors involving the relatedness of the services, channels of trade and classes of consumers, we must make our determinations based on the services as they are identified in the application and cited registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

² Registration No. 4897005 issued on February 9, 2016.

In this case, the involved services are identical – both Applicant’s and Registrant’s services are described as “bar and restaurant services.” In view of the identity of services, we presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods or services are presumed to travel in same channels of trade to same class of purchasers). Applicant presents no argument on these *du Pont* factors.

Accordingly, the *du Pont* factors involving similarity of the services and trade channels strongly favor a finding of likelihood of confusion.

B. Alleged Weakness of Registered Mark

Before we turn to a comparison of the marks, we address Applicant’s argument that the registered mark, SURFSIDE, is “weak and diluted” in connection with restaurant and bar services.³ Applicant contends that consumers will thus “focus on the differences between the marks, which in this case is the addition by Applicant of the arbitrary numeral ‘6.’”⁴ To support its arguments, Applicant relies on Internet printouts from seven different websites for restaurants or bars with the term SURFSIDE displayed in their name.⁵ These include: SURFSIDE RESTAURANT (in Virginia Beach, Virginia); SURFSIDE RESTAURANT AND LOUNGE (in Florence, Oregon); LA OLA SURFSIDE RESTAURANT (in Fort Myers Beach, Florida);

³ 4 TTABVUE 3.

⁴ *Id.*

⁵ Attached to Applicant’s response filed on July 5, 2018.

MALIBU OF SURFSIDE RESTAURANT (in Surfside Beach, South Carolina); SURFSIDE BAR & GRILL (in Mound, Minnesota); SURFSIDE INN (in Montauk, New York); and SURFSIDE DINER (in Palm Beach, Florida).

Applicant also asserts that the term SURFSIDE “itself is highly descriptive of a location near the ‘surf.’”⁶ Applicant relies on a definition submitted by the Examining Attorney showing that the term means “the area alongside the seashore.”⁷

In response to Applicant’s Internet evidence of SURFSIDE used for restaurants, the Examining Attorney asserts that given “the absence in the record of evidence to the contrary, it is entirely plausible that the registrant owns these restaurants [identified in Applicant’s Internet printouts] or is affiliated with these restaurants.”⁸ The Examining Attorney contends that even if Registrant is not the owner and has no affiliation with them, “seven is a statistically insignificant number and does not demonstrate that the term SURFSIDE is weak and diluted in the restaurant and bar industry.”⁹ The Examining Attorney also relies on printouts from an Office database for “search strategy and search results ... [for] registered third party marks that include the term ‘SURFSIDE’ or ‘SURF SIDE’ or ‘SURF-SIDE’ for restaurant or bar services,” demonstrating that Registrant is the only owner of such a registration.¹⁰

⁶ 4 TTABVUE 3.

⁷ Attached to Office Action issued on August 7, 2018, TSDR 4-5. Definition taken from THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (online version, www.ahdictionary.com).

⁸ 6 TTABVUE 8.

⁹ *Id.*

¹⁰ *Id.*, citing to printouts attached to Office Action issued on August 7, 2018, TSDR 6-8.

Finally, as to any conceptual weakness of the term SURFSIDE, the Examining Attorney asserts that the term is “arbitrary, or may possibly be suggestive of a bar or restaurant being near a seashore.”¹¹

In evaluating the strength or weakness of the registered mark, we are ultimately trying to gauge the scope of protection to which it is entitled. We consider both inherent strength, based on the nature of the mark itself, and commercial strength or recognition. *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”). Our findings are made in accordance with the fifth *du Pont* factor involving the “fame” or strength of the prior mark, and the sixth factor involving the number and nature of similar marks in use for similar goods or services. *du Pont*, 177 USPQ at 567. Under the latter factor, we may find that a mark’s commercial strength is curtailed by extensive third-party use of similar marks with similar goods or services. *Jack Wolfskin Austrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015).

Applicant’s Internet evidence demonstrates, at the very least, that Registrant is not alone in using SURFSIDE for restaurant and bar services. While the Examining Attorney’s suggestion that Registrant possibly owns (or has some affiliation) with the various restaurants is theoretically possible, we do not find this plausible as to all of

¹¹ *Id.*

them. On the other hand, even if we assume the record shows seven unrelated third-party restaurants using SURFSIDE in their names, this does not constitute the amount and type of evidence whereby we can conclude that such widespread use exists that consumers have become conditioned to distinguishing SURFSIDE marks based on differences that would otherwise be considered less significant. *See In re i.am.symbolic*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (evidence of third-party use “falls short of the ‘ubiquitous’ or ‘considerable’ use of the mark components present in [applicant’s] cited cases”); *cf. Jack Wolfskin*, 116 USPQ2d at 1136 (discussing “voluminous evidence” of registration and use of paw print design elements); *Juice Generation.*, 115 USPQ2d at 1674 & n.1 (referring to evidence of “a considerable number,” 26 third-party marks). We agree with the Examining Attorney that seven is a relatively small number of restaurants given the ubiquity of restaurants in this country.

With respect to the conceptual weakness of SURFSIDE, we agree that the term may be understood by consumers as suggesting a location by the seashore (or that seafood is a likely fare being served). We disagree with Applicant’s assertion, however, that SURFSIDE is “highly descriptive.” The cited registration is on the Principal Register without a claim of acquired distinctiveness and thus is entitled to a presumption of validity that cannot be challenged via this *ex parte* proceeding. 15 U.S.C. § 1057(b). We also keep in mind the Examining Attorney’s evidence showing no other registrations for marks with the term SURFSIDE (or SURF SIDE or SURF-SIDE) in connection with restaurants. *Cf., In re i.am.symbolic*, 123 USPQ2d at 1751

(Registrations are not evidence of use of the marks in the marketplace, but may be relevant to show whether a term is descriptive, suggestive, or so common that the public will look to other elements to distinguish the source of the goods or services).

Ultimately, the record supports a finding that the term SURFSIDE is not entirely unique in connection with restaurants and the term may be understood as slightly suggestive. However, the evidence is not overwhelming in this regard, and we cannot conclude the mark is very weak. Rather, we find the registered mark's scope of protection is less than that would be accorded to a very strong and arbitrary mark.

C. Similarity of the Marks

Under this factor, we compare Applicant's SURFSIDE 6 mark with the cited registered mark SURFSIDE "in their entirety as to appearance, sound, connotation and commercial impression." *In re Viterra*, 101 USPQ2d at 1908 (quoting *du Pont*, 177 USPQ at 567); see also *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). The degree of similarity between the marks necessary to support a finding of likely confusion declines when, as is the case here, the services are identical. See *Bridgestone Ams. Tire Operations LLC v. Federal Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant argues that its addition of "the numeral '6' to the Registrant's mark . . . will give Applicant's mark a different pronunciation, meaning and commercial

impression.”¹² We disagree. Despite Applicant’s addition of the numeral, the most prominent element of Applicant’s mark is SURFSIDE, or Registrant’s mark. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (“Indeed, in view of the marks’ structural similarity, the lead words [DETROIT ATHLETIC] are their dominant portion and are likely to make the greatest impression on consumers.”). *See also In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985); *Palm Bay Imps.*, 73 USPQ2d at 1692 (first word in the mark most prominent); *Century 21 Real Estate*, 23 USPQ2d at 1700 (upon encountering the marks, consumers must first notice the identical lead word); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). Consumers viewing or verbalizing Applicant’s mark will necessarily begin with the term SURFSIDE.

Our finding that the term SURFSIDE is not entirely arbitrary or unique in connection with the involved services tempers the significance of what is essentially Applicant’s mere addition of “6” to Registrant’s mark. However, we also find that the addition of the numeral does very little to distinguish the two marks. That is, Applicant’s mark, when viewed in its entirety, does not create a significantly different overall commercial impression from that created by Registrant’s mark. Both marks will be understood in the context of restaurant services as suggestive of a sea side location. “Considering the substantial similarities between the marks in this case, it

¹² 4 TTABVUE 2.

seems to us that a purchaser who sees one mark and later encounters the other is likely to think, if the two marks are applied to the same or related goods and/or services, that the second mark is the same mark he had seen earlier, or, if he realizes that there are some differences in the marks, that the second is simply a slightly varied version of the first, with both serving to indicate origin in the same source.” *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1468 (TTAB 1988). Put more precisely in the context of this proceeding, it would not be unreasonable for consumers already familiar with Registrant’s SURFSIDE restaurant who then encounter a SURFSIDE 6 restaurant to mistakenly believe that the latter is a new (or sixth) location affiliated with former.

II. Conclusion

We have considered all evidence and arguments bearing on the relevant *du Pont* factors. We conclude that should the marks SURFSIDE and SURFSIDE 6 be used in connection with restaurant and bar services, offered to the same class of consumers in the same trade channels, they are likely to cause confusion amongst consumers as to the source of the services. We reach this ultimate conclusion with the understanding that the registered mark’s scope of protection is not as wide as that of a strong and arbitrary mark; but it is well-recognized that even weak marks are entitled to protection against a mark that is substantially similar and used on identical services, as here. *See King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d. 1400, 182 USPQ 108, 109 (CCPA 1974).

Decision: The refusal to register Applicant’s proposed mark is affirmed.