

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Trademark Application of

Royal Caribbean Cruises Ltd.)
Mark: PORTSIDE BBQ)
Serial No.: 88/311,922)
Filing Date: February 22, 2019)
Examiner: Xheneta Ademi)
Telephone: (571) 272-7151)

BOX RESPONSES

NO FEE

Commissioner for Trademarks

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RESPONSE TO OFFICE ACTION

Applicant responds to the Office Action dated April 18, 2019 (“the Office Action”), as follows:

REMARKS

I. Potential Likelihood of Confusion

Following the filing of Applicant’s trademark application, the Examiner raised a Section 2(d) advisory indicated that registration of Applicant’s Mark may be refused at a later date on the basis of a potential likelihood of confusion between Applicant’s Mark PORTSIDE BBQ (“the Mark”) and the marks PORTSIDE GELATO & COFFEE in U.S. Application No. 87/473,509 (hereafter referred to as “the ‘509 Application”) and PORTSIDE PIER in U.S. Application No. 87/473,543 (hereafter referred to as “the ‘543 Application”) (the marks in the ‘509 Application and the ‘543 Application collectively referred to herein as “the Cited Marks”).

In the refusal, the Examiner argues that the Mark so resembles the Cited Marks that it is likely that a potential consumer would be confused, mistaken, or deceived as to the source of the

goods and/or services of Applicant and those of the Cited Marks. Applicant respectfully disagrees, and responds as follows:

A. Applicant's Mark and the Cited Marks Are Not the Same or Very Similar

The Mark and the Cited Marks are different in sight, sound, and commercial impression. The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services. *See Midwestern Pet Foods, Inc., v. Societe Des Produits Nestle S.A.*, 685 F3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); *I, LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010). When comparing the marks, “[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). In evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *See e.g., In re Cynosure, Inc.*, 90 USPQ2d 1644, 1645 (TTAB 2009) (citing *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975)).

Here, Applicant's Mark appears differently when compared to the Cited Marks. Applicant's Mark contains additional and dissimilar words than the Cited Marks as it has added the term BBQ following the word PORTSIDE. A consumer viewing Applicant's Mark would immediately take note of the additional term, understanding BBQ to be a source indicator of the goods and services provided in connection with Applicant's Mark. Further, Applicant's Mark does not contain any of the wording that is prevalent in the Cited Marks, namely, the wording GELATO

& COFFEE or PIER. Due to the additional and dissimilar wording, an inherent difference exists in the pronunciation of Applicant's Mark and each of the Cited Marks. Moreover, the additional and dissimilar words included in the Cited Marks and Applicant's Mark convey different commercial impressions due to the connotation of each distinct word. Furthermore, the additional wording in Applicant's Mark is phonetically dissimilar to the additional wording included in each of the Cited Marks. As a result, consumers can distinguish easily and quickly between the Cited Marks and Applicant's Mark as they present different appearances, sounds, and connotations.

Additionally, by including the term BBQ, Applicant's Mark creates a different commercial impression than the Cited Marks. Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions. *See, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB's holding that contemporaneous use of applicant's CAPITAL CITY BANK marks for banking and financial services, and opposer's CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that the phrase "City Bank" is frequently used in the banking industry and that "CAPITAL" is the dominant element of applicant's marks, which gives the marks a geographic connotation as well as a look and sound distinct from opposer's marks); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, inter alia, THE RITZ KIDS creates a different commercial impression).

With the addition of the word BBQ to Applicant's Mark, the commercial impression created by the Mark differs substantially from the Cited Marks as that term (i.e., BBQ) evokes in

the mind of a consumer a connection with restaurant and bar services featuring barbequed food items. Additionally, Applicant's Mark refers to bar and restaurant services aboard a cruise ship, which is further word play and connotes various meanings when you consider the multiple definitions of "portside." In a nautical sense, the term "portside" refers to the left side of the ship or vessel. *See* Exhibit A, dictionary definition for the term "portside." However, "portside" can also refer to a location near the waterfront or near a port. *See* Exhibit A. Here, the commercial impression of Applicant's Mark is used in the nautical sense due to Applicant's services being provided aboard a cruise ship rather than the waterfront, landlocked services provided under the Cited Marks at brick-and-mortar locations. *See* Exhibit B, locations of the restaurants owned by the owner of the Cited Marks. The waterfront, landlocked nature of the registrant's services is also evident due to the inclusion of the word PIER in the '543 Application, wherein piers are exclusively found on the shoreline near bodies of water. A consumer will understand that Applicant's Mark is related to food and drinks, including barbeque, served on a cruise ship and will be able to differentiate between Applicant's Mark and the Cited Marks due to the different connotations of the various words seen in each mark. Applicant's Mark does not give any commercial impression that it is used in connection with ice cream parlors or coffee shops on land or on a cruise ship. When analyzing the marks, it is unlikely that Applicant's Mark will be confused with the Cited Marks as Applicant's Mark consists of multiple words that create a different meaning and commercial impression for Applicant's Mark as compared to the meanings and commercial impressions of the Cited Marks. Given these differences in commercial impression created by Applicant's Mark and the Cited Marks, no likelihood of confusion exists between them.

Moreover, “the use of identical, even dominant, words in common doesn’t automatically mean that two marks are similar.” *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 U.S.P.Q.2d 1442 (8th Cir. 1987). A court must assess the overall commercial impression of the marks, rather than analyze or compare the individual components. *Id.* Pursuant to *General Mills*, the fact that the marks share the singular word PORTSIDE does not indicate that the marks are similar. As discussed above, when compared with the Cited Marks, Applicant’s Mark is dissimilar in appearance, sound, meaning, and commercial impression due to its additional and different wording. Therefore, consumers can easily and quickly distinguish between the Cited Marks and Applicant’s Mark as they present different appearances, sounds, and connotations, which obviates any potential likelihood of confusion.

B. The Cited Marks Are Entitled to Only Narrow Protection Because They Exist in a “Crowded Field” of Similar Marks

The Cited Marks are not entitled to broad protection because they exist in a “crowded field” of similar marks in use with similar goods and services. Customers will not likely be confused between any two marks in a crowded field, and may have learned to carefully pick out one from the other. *Standard Brands Incorporated v. RJR Foods, Inc.*, 192 U.S.P.Q. 383, 385, 1976 WL 21135 (T.T.A.B. 1976). As a result, each member of the crowd is relatively “weak” in its ability to prevent use by others in the crowd. § 11:85. Crowded trademark markets, 2 McCarthy on Trademarks and Unfair Competition § 11:85 (5th ed.). Previously, the Trademark Board reversed a refusal to register GRAND HOTELS NYC based on a likelihood of confusion with a registration for GRAND HOTEL after the applicant in that case submitted evidence of similar registrations using GRAND HOTEL and website advertising. *In re Hartz Hotel Services Inc.*, 102 U.S.P.Q.2d 1150, 2012 WL 1193704 (T.T.A.B. 2012). The Board concluded GRAND was a highly suggestive

term for a hotel, and due to the many variations of GRAND for hotels, the mark was entitled to only a very narrow scope of protection. *Id.*

Previously, the terms PORTSIDE or PORT have been registered in connection for use with various food and beverage related goods and services. For example, Applicant wishes to bring the following registrations to the Examining Attorney's attention:

1. Registration No 1,836,958 for the mark PORTSIDE in connection with "canned fish" in Class 29;
2. Registration No. 1,969,870 for the mark PORTSIDE in connection with "frozen fish" in Class 9;
3. Registration No. 4,608,875 for the mark BABOR (the English translation of BABOR is PORTSIDE) in connection with "wines" in Class 33;
4. Registration No. 2,187,792 for the mark PORT ROYAL in connection with "fish" in Class 29;
5. Registration No. 1,116,692 for the mark PORT CLYDE in connection with "canned fish" in Class 29;
6. Registration No. 2,695,364 for the mark PORT CITY JAVA in connection with "coffee" in Class 30; "retail store services" in Class 35, and "restaurant services" in class 43;
7. Registration No. 1,779,075 for the mark PORT AUTHUR in connection with "soups" in Class 29;
8. Registration No. 2,989,543 for the mark PORTLOCK in connection with "fish" in Class 29;
9. Registration No. 2,989,542 for the mark PORTLOCK and Design in connection with "fish" in Class 29;
10. Registration No. 2,073,663 for the mark PORT-A-PIT in connection with "barbecue sauce powdered mix" in Class 30;
11. Registration No. 1,466,450 for the mark PORT-SALUT in connection with "cheeses" in Class 29;
12. Registration No. 4,221,385 for the mark PORT HOUSE in connection with "restaurant services" in Class 43;

13. Registration No. 4,244,223 for the mark PORT PARADISE in connection with “beer” in Class 32;
14. Registration No. 4,349,475 for the mark PORT D’HIVER in connection with “bed and breakfast inn services” in Class 43;
15. Registration No. 4,504,740 for the mark PORT THEATER in connection with “entertainment services” in Class 41 and “bar and restaurant services” in Class 43;
16. Registration No. 4,559,855 for the mark PORT ROYAL EXPORT in connection with “beer” in Class 32;
17. Registration No. 4,627,899 for the mark PORT BREWING CO EST 2006 SAN MARCOS, CALIFORNIA and Design in connection with “beer” in Class 32;
18. Registration No. 4,896,811 for the mark PORT MOKA and Design in connection with “coffee” in Class 30;
19. Registration No. 4,976,180 for the mark PORT ROYAL PREMIUM SINCE 1936 and Design in connection with “canned fruits and vegetables” in Class 29 and “vegetable relishes; ketchup; pasta” in Class 30;
20. Registration No. 3,951,408 for the mark PORT CITY in connection with “beer” in Class 32;
21. Registration No. 5,033,032 for the mark PORT O’ CALL in connection with “beer” in Class 32;
22. Registration No. 5,044,858 for the mark PORT CITY PRETZELS THE MAYORS’ CHOICE EST. 2015 in connection with “pretzels” in Class 30;
23. Registration No. 5,043,682 for the mark PORT ROYAL in connection with “canned fruits and vegetables” in Class 29 and “vegetable relishes; ketchup; pasta” in Class 30;
24. Registration No. 5,052,615 for the mark PORT TOWN BREWING COMPANY in connection with “beers” in Class 32;
25. Registration No. 5,052,614 for the mark PORT TOWN BREWING COMPANY EST. 2012 PORTTOWN BREWING.COM PORT OF LOS ANGELES in connection with “beers” in Class 32;
26. Registration No 5,128,105 for the mark PORT OF MOKHA in connection with “coffee” in Class 30;

27. Registration No. 3,855,680 for the mark PORT CLYDE QUENCHER in connection with “soft drinks” in Class 32.

See Composite Exhibit C, attaching copies of the foregoing registrations. The long list of registered marks above containing the term PORT or PORTSIDE are in addition to those relied upon in the Office Action. As evidenced by the numerous registrations, the Trademark Office has allowed a large number of marks (at least 29, which includes the two Cited Marks) including the terms PORT or PORTSIDE to be registered, all of which coexist, many within the same classes (including Class 43) and for identical goods/services. As a result, Applicant’s Mark PORTSIDE BBQ will easily coexist with these other marks as well as the Cited Marks.

Moreover, the issue here is analogous to the issue raised in *Hartz Hotel*. There, the Board held that the term GRAND was a highly suggestive term for a hotel and was entitled to only a very narrow scope of protection. Here, it is clear that due to the vast abundance of registered marks containing the term PORT or PORTSIDE, the term has become highly suggestive with various food and beverage related goods and services and is only entitled to a narrow scope of protection. Therefore, Applicant’s Mark should be allowed to proceed to registration as it exists in a “crowded field” for similar marks for similar goods and services.

C. The Services Are Not Related

The Cited Marks are used in association with “ice cream parlors” in the ‘509 Application and “restaurant, café, and bar services; coffee shop services; ice cream parlor” in the ‘543 Application, respectively. Unlike the services with which the Cited Marks are used, Applicant seeks to use its Mark with restaurant and bar services provided exclusively aboard cruise ships. Applicant has amended its identification of services to confirm the same. Restaurants and cruise ships provide different types of services in that traditional land-based restaurants serve food to

individuals who may walk in or who may dine after making a reservation. On the other hand, customers cannot simply walk into one of Applicant's restaurants nor may customers make a simple reservation in order to dine in Applicant's restaurants. Instead, customers must purchase passage on a luxury cruise and only during the cruise voyage may a guest on that cruise dine in Applicant's onboard restaurants. In this way, Applicant's services differ starkly from those provided under the two Cited Marks. Moreover, the cruise industry typically operates its own onboard restaurants rather than allowing licensed operators of land-based restaurants to open restaurants aboard their vessels. Therefore, it is highly unlikely that a restaurant would enter the cruise line industry either by establishing its own cruise line and operating restaurants aboard its vessels or by operating a licensed restaurant onboard a ship of an existing cruise line. As a result of the services being readily distinguishable, no likelihood of confusion exists between Applicant's Mark and the Cited Marks.

D. The Channels of Trade Are Not Related

Even when there is potential overlap of markets, if the marks are sold in different channels of trade there can be no likelihood of confusion. *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 U.S.P.Q. 2d 1388 (Fed. Cir. 1992); *In re The W.W. Henry Company, L.P.*, 82 U.S.P.Q.2d 1213, 2007 WL 186661 (T.T.A.B. 2007). In *In re The W.W. Henry Company*, the Board ruled that there was no conflict when a chemical filler was sold to plastic manufacturers and a cement patch for drywell and concrete was sold to contractors in hardware stores, because the two products would be sold to different classes of purchasers through different channels of trade. *Id.* Furthermore, different price ranges are significant evidence that the goods or services are unrelated and travel in different channels of trade when they are considered for purchase by entirely different classes of purchasers. *Field Enterprises Educational Corp. v.*

Grosset & Dunlap, Inc., 256 F. Supp. 382, 150 U.S.P.Q. 517 (S.D.NY. 1966); *Estee Lauder, Inc. v. The Gap, Inc.*, 108 F. 3d 1503, 42 U.S.P.Q. 2d 1228 (2d Cir. 1997).

Here, the cruise line industry is in a different channel of trade in comparison to the restaurant industry. The two industries are not in competition with each other as they serve completely different functions. The restaurant industry provides food and drink related services in land-based restaurants while the cruise line industry provides travel and leisure services onboard a cruise ship and (by necessity) food and beverages to its customers traveling on those ships. Cruise lines maintain and run their own restaurants aboard their ships, as outside chains rarely are used aboard cruise ships. Further, Applicant's services are always mobile and moving around the world, while the Cited Marks are always landlocked at their brick and mortar locations. Moreover, due to the differences in price range and sophistication of restaurant customers in general and of cruise line customers in particular to whom Applicant and the owner of the Cited Marks market their respective services, the services travel in drastically different channels of trade. Therefore, the refusal based on a likelihood of confusion should be withdrawn.

E. The Services Are Purchased By Sophisticated Buyers

Further, when customers are purchasing goods or services that are expensive, confusion is less likely than where the goods are cheap or bought casually. *Kiekhaefer Corp. v. Willys-Overland Motors, Inc.*, 236 F.2d 423, 111 U.S.P.Q. 105 (C.C.P.A. 1956). Courts have also held that informed sophisticated buyers "are less likely to be confused as to the source or origin of a product than ordinary consumers of inexpensive foods or services." *CMM Cable Rep., Inc. v. Ocean Coast Properties, Inc.*, 888 F. Supp. 192, 36 U.S.P.Q. 2d 1458 (D. Me. 1995); *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 U.S.P.Q. 786 (1st Cir. 1983).

Here, Applicant is an international cruise line that provides vacation packages for consumers aboard a cruise ship. Due to the nature of its services, Applicant's prices for its cruises average nearly \$1,000 per person. *See* Exhibit D, showing a sampling of Applicant's cruises and prices per person. Applicant's customers are sophisticated buyers who are unlikely to confuse Applicant's services with a small restaurant chain or ice cream parlor. Furthermore, due to the expensive nature of the services provided by Applicant, neither Applicant's customers nor the customers of the Cited Marks are likely to be confused as to the source or origin of their respective services. The drastic differences in price between the Applicant's services and the services provided under the Cited Marks only serves to reinforce the luxurious and exclusive source of the Applicant's services, which are wholly unrelated to the services of the Cited Marks. Applicant's customers are unlikely to confuse Applicant's Mark and the services provided thereunder, which are provided aboard cruise ships only to passengers who have purchased a cruise, with the services provided by the owners of the Cited Marks under their respective marks, which are land-based ice cream parlors and restaurants open to any customer who wishes to walk in. Likewise, customers of the owners of the Cited Marks are highly unlikely to confuse Applicant's Mark and its services that are provided exclusively aboard cruise ships with low and moderately priced restaurants located solely on land. Due to the sophistication of Applicant's buyers and the less expensive nature of the services provided under the Cited Marks, a likelihood of confusion is virtually non-existent and the refusal is unwarranted.

II. Conclusion

Applicant believes that the foregoing is fully responsive to the refusal to register, and that the refusal should be withdrawn. The Examiner is cordially invited to call the undersigned if

clarification is needed on any matter within this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.