

To: Evergreen USA LLC (trademark@psh.com)
Subject: U.S. TRADEMARK APPLICATION NO. 87682304 - BUCCA - 11221-30
Sent: 9/4/2018 8:46:24 AM
Sent As: ECOM127@USPTO.GOV
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION
SERIAL NO.** 87682304

MARK: BUCCA

87682304

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**GENERAL TRADEMARK
INFORMATION:**
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APPLICANT: Evergreen
USA LLC

**CORRESPONDENT'S
REFERENCE/DOCKET
NO:**

11221-30

**CORRESPONDENT
E-MAIL ADDRESS:**

trademark@psh.com

SUSPENSION NOTICE: NO RESPONSE NEEDED

ISSUE/MAILING DATE: 9/4/2018

The trademark examining attorney is suspending action on the application for the reason stated below. *See* 37 C.F.R. §2.67; TMEP §§716 *et seq.*

MAINTENANCE DOCUMENTS DUE FOR CITED REGISTRATION(S): Registration has been refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), based on the cited registrations; however, registration maintenance documents are or were due to be filed for the registrations. If registration maintenance documents are not or were not timely filed, the registrations will be cancelled under Section 8 or 71, and/or expire under Section 9 and will no longer present a bar to registration under Section 2(d). *See* 15 U.S.C. §§1058, 1059, 1141k; 37 C.F.R. §§2.160(a), 2.182, 7.36(b). Therefore, action on this application is suspended pending disposition of the cited registrations for six months, after

which time the trademark examining attorney will determine whether to withdraw the Section 2(d) refusal. *See* 37 C.F.R. §2.67; TMEP §716.02(e).

PRELIMINARY RESPONSE TO APPLICANT'S ARGUMENTS

Applicant argues that the registered marks are not similar in appearance, sound, connotation, and commercial impression to applicant's mark, and that the number of similar "BUCA" and "BUCCA" marks in use on similar goods has caused the wording to be diluted in the minds of consumers. Applicant's arguments do not obviate the likelihood of confusion and are unpersuasive.

Similarity of Marks

Visual Similarity

Applicant first argues that the addition of "DI BEPPO" at the end of registrant's mark and stylization of one registrant's mark causes the marks to "look nothing like applicant's mark." However, regarding the addition of "DI BEPPO," consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("VEUVE . . . remains a 'prominent feature' as the first word in the mark and the first word to appear on the label"); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) ("[T]he dominance of BARR in [a]pplicant's mark BARR GROUP is reinforced by its location as the first word in the mark."); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("**it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered**" when making purchasing decisions). The proper focus is on the recollection of the average purchaser, who retains a **general rather than specific impression of trademarks**. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); TMEP §1207.01(b). Purchasers with a general recollection of the marks are likely to recall the first word of the marks. Also, "BUCCA" and "BUCA" are nearly identical in appearance. The only difference between the wording is applicant's addition of a repeated "C" in the middle of the word. Since "BUCA" is the first term of registrant's mark, "BUCA" is the wording which is most likely to be impressed upon the mind of a purchaser and remembered. Thus, the addition of "DI BEPPO" does not obviate the likelihood of confusion between applicant and registrant's mark because the wording "BUCA" and "BUCCA" visually nearly identical.

The similarity between the marks are more problematic regarding Reg. No. 4173012 and its stylization. Whilst "BUCA" is considered to be the most dominant wording in the registrations because it is the first word, "BUCA" is even more dominant in the stylized mark. In Reg. No. 4173012, "BUCA" appears to be more than twice the size of the other wording, further cementing "BUCA" as the part of the mark which is most likely to be impressed upon the mind of a purchaser and remembered.

However, applicant contends that the mere inclusion of stylization of this mark distinguishes it from applicant's mark. Applicant has filed a standard character mark. A mark in typed or standard characters may be displayed in **any lettering style**; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Vitterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Vitterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "**the argument concerning a difference in type style is not viable where one party asserts rights in no particular display**"). Thus, applicant is free to stylize their mark in any manner, including registrant's stylization. Because applicant is free to stylize their mark in this manner, applicant's mark is confusingly similar to registrant's mark because of the similarities of "BUCA and "BUCCA." Therefore applicant's argument that registrant's stylization looks nothing like registrant's mark is unpersuasive.

Sound Similarity

Applicant's next argument is similar to their first; registrant's addition of "DI BEPPO" causes their mark to sound differently than applicant's mark. However, the same principle about the dominance of the first word remains the same. Furthermore, applicant concedes that "BUCA" and "BUCCA" are identical in sound. Applicant mentions that the products are not the type to be ordered over the telephone or orally in person. This argument is unpersuasive because how consumers purchase goods generally not a consideration for a likelihood of confusion analysis. Consumers are free to purchase goods however is most convenient for themselves. Neither applicant nor registrant have restrictions as to nature, type, channels of trade, or classes of purchasers. Thus it can be presumed that applicant's and registrant's goods could travel in the same trade channels or be marketed to the same class of purchasers, including ordered telephonically or in person. *In re Vitterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d

Applicant mentions that no evidence was given of Buca Inc. shorting the mark “BUCA DI BEPPO” to “BUCA” on goods in class 029 and 030 even though evidence was given that Buca Inc. often shortens the wording for their restaurant services. Although it is unclear if Buca Inc. shortens the mark of the goods, it would not be a far cry if Buca Inc. were to shorten the mark. Considering that the previous evidence submitted demonstrates that shortening to “BUCA” is a common practice for Buca Inc, and that using the dominate term of a mark as short hand for goods or services, it is not unlikely that Buca Inc. would shorten mark for their goods, i.e., Buca Olives.

Thus applicant’s argument concerning the sound of the marks are unpersuasive

Connotation

Applicant states that, as far as applicant is aware, “BUCCA” has no meaning in any language. The registrations state that BUCA DI BEPPO means “Joe’s Cave” in Italian. Although the marks appear to not share a similar translation, an ordinary consumer would not immediately know the meanings of either mark. Thus, purchasers are likely to rely on the nearly identical appearance and identical sounds of the dominant part of the marks. Here, the connotation to purchaser would merely be that they are purchasing goods from marks that look nearly identical and sound identical. Such similarities may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

DILUTION

Last, Applicant has submitted printed or electronic copies of third-party registrations for marks containing the wording “BUCA” to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. These registrations appear to be for goods and/or services unrelated and predominantly different from the goods identified in applicant’s application.

The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services. See *Nat’l Cable Tel. Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of widespread third-party use of similar marks with similar goods and/or services “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection” in that particular industry or field. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); see *In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1062-63 (Fed. Cir. 2003).

However, evidence comprising of third-party registrations for similar marks with different or unrelated goods and/or services, as in the present case, has “**no bearing on the strength of the term in the context relevant to this case.**” See *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058 (TTAB 2017) (citing *In re i.am.symbolic, llc*, 866 F.3d at 1328, 123 USPQ2d at 1751)). Applicant has submitted evidence of other registrant’s using the wording “BUCA” for:

- “Buca Boot” Reg No. 4875427 - Bicycle accessories, namely, panniers adapted for bicycles, transporting bags adapted for bicycles, open carrying compartments adapted for bicycles, closable carrying compartments adapted for bicycles, and lockable carrying compartments adapted for bicycles
- “Buca Boot” Reg No. 4875427 - storage containers specially adapted for mounting on bicycles
- “Buca” Reg No. 3920190 - Referral services in the field of child care; Referral services in the field of adult care; Business administration services in the field of child care; Business administration services in the field of adult care; Providing a web site featuring on-line reservation services for child care; Providing a web site featuring on-line reservation services for adult care; Child care services; Consultation services in the field of child care; Consultation services in the field of adult care; In-home adult care services, namely, providing senior persons assistance with personal affairs and personal care in the nature of activities of daily living such as bathing, grooming, and personal mobility
- “Bucas” Reg No. 1972726 - saddle girths; halters; reins; horse rugs; leggings for horses; numnahs and saddle blankets
- “Buca” Reg No. 2058534 - Clay

Thus, these third-party registrations submitted by applicant are insufficient to establish that the wording BUCA is weak or diluted. Therefore, applicant’s argument of the wording BUCA is weak, diluted, or so widely used that it should not be afforded a broad scope of protection is unpersuasive.

SUSPENSION INCOMING

The USPTO will periodically conduct a status check of the application to determine whether suspension remains appropriate, and the trademark examining attorney will issue as needed an inquiry letter to applicant regarding the status of the matter on which suspension is based. TMEP §§716.04, 716.05. Applicant will be notified when suspension is no longer appropriate. *See* TMEP §716.04.

No response to this notice is necessary; however, if applicant wants to respond, applicant should use the “Response to Suspension Inquiry or Letter of Suspension” form online at <http://teasroa.uspto.gov/rsi/rsi>.

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PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the Trademark Electronic Application System (TEAS) form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **9/4/2018** FOR U.S. APPLICATION SERIAL NO. 87682304

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov/>, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

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Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the "United States Patent and Trademark Office" in Alexandria, VA; or sent by e-mail from the domain "@uspto.gov." For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.