

HOLLYWOOD COFFEE CO likely to be confused with HOLLYWOOD CAFÉ

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Legal updates: case law analysis and intelligence

- TTAB affirmed likelihood of confusion refusal of HOLLYWOOD COFFEE CO for retail services featuring packaged coffee based on HOLLYWOOD CAFÉ for restaurant services featuring coffee
- Case is instructive on the importance of following the rules for entering third-party registrations into the record
- Although crediting cases in which “something more” is required to show relatedness between goods and services, the board held that line of case law was not applicable when determining whether two types of services are related

The Trademark Trial and Appeal Board’s decision in *In re USA Innovations Inc* (TTAB 25 June 2024) affirmed the likelihood of confusion refusal of HOLLYWOOD COFFEE CO for retail services featuring packaged coffee based on the registration HOLLYWOOD CAFÉ for restaurant services featuring coffee.

The case is particularly instructive on two points.

First is the importance of following the rules for entering third-party registrations into the record. In arguing the dissimilarity of the marks, the applicant asserted that the term HOLLYWOOD is weakened by coexisting marks. The third-party marks relied upon by the applicant were not timely because they were not mentioned during examination and thus were not part of the record on appeal. The board thus resolved up front the ‘evidentiary issue’, holding that it would not consider these marks in rendering the instant decision because they were not raised below.

Moreover, the applicant also failed to properly make the registrations of record by including only the below snip from the USPTO website search results:

3	90742251	6975574	HOLLYWOOD & MAINE
4	90166249	6346755	HOLLYWOOD AT HOME
5	88360466	5974280	HOLLYWOOD HILLS COFFEE
6	87015875	5418870	PLANET HOLLYWOOD OBSERVATORY
7	86692078	5052475	HOLLYWOOD GAMING
8	86692077	5029902	HOLLYWOOD GAMING
9	85503530	4256473	HOLLYWOODLAND
10	85861839	4424783	HOLLYWOOD CASINO AT CHARLES TOWN RACES
11	85871351	4400203	HOLLYWOOD CASINO
12	85971372	4969093	HOLLYWOOD CAFÉ
13	85970718	4956219	HOLLYWOOD CAFÉ

A footnote in the board's decision is a reminder that "mere listings" are not sufficient to enter registrations into the record and refers to the provisions for properly doing so, which involves submitting a copy of each registration (from either the electronic records of the USPTO or the paper USPTO record). The inadequacy of such a listing is readily apparent in that the owner information, status and goods/services are all missing from the above. Without such information there is no way to determine the relevance of these coexisting marks. Indeed, while the applicant's brief characterised the above coexisting registrations as "pertaining to coffee or coffee related services", the full listing of goods/services shows that one of the registration's only reference to "coffee" was for a "coffee table", and another was for charitable fundraising services involving sales of a long list of goods, including "coffee mugs". On the other hand, some of the coexisting marks were for relevant related services or otherwise might have demonstrated that HOLLYWOOD marks can coexist in related fields, but the chance for those arguments to be considered was squandered by not making the registrations properly of record during examination.

Second is the issue of the relatedness of the involved services. The board disagreed with the applicant's contention that the examining attorney "simply argued that the goods (coffee) and services (restaurant services) are used together and did not provide 'something more' to provide substantial evidence of the relatedness". The board pointed out that the comparison here is between two types of services (retail services versus restaurant services, both featuring coffee), rather than a goods-to-services comparison. Not only was the argument thus factually flawed, but it also meant that the cases requiring "something more" to demonstrate relatedness between goods and services were inapplicable. Thus, while the board credited the cases in which "something more" is required to show relatedness between goods and services (eg, between food products and restaurant services), that line of case law was not applicable when determining whether two types of services are related.

In the end, the board upheld the refusal under the *DuPont* factors most relevant to the analysis. The marks were found to be similar because HOLLYWOOD was the dominant element in each. The services were related and would be offered to the same consumers through the same channels, as supported by the examining attorney's evidence of third-party websites and registrations showing that retail sales of packaged coffee and restaurants featuring coffee are offered under the same marks.

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