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Subject: U.S. TRADEMARK APPLICATION NO. 76649149 - PATSY'S PIZZERIA - PAT00IUS - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**U.S. APPLICATION SERIAL NO.** 76649149

**MARK:** PATSY'S PIZZERIA



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** I.O.B. Realty, Inc.

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

PAT00IUS

**CORRESPONDENT E-MAIL ADDRESS:**

## EXAMINING ATTORNEY'S APPEAL BRIEF

This is an appeal from the trademark examining attorney's final refusal to register applicant I.O.B. Realty Inc. (hereinafter referred to as applicant)'s mark, **PATSY'S PIZZERIA**, for "pizzeria services," on the ground that there is a likelihood of confusion within the meaning of Section 2(d) of the Trademark Act,

15 U.S.C. Section 1052(d). Registration was refused because the applicant's mark, when used on or in connection with the identified services, so resembles the mark **PATSY'S OF NEW YORK**, U.S. Registration No. 3090551 for "restaurant services", as to be likely to cause confusion, to cause mistake or to deceive. TMEP Section 1207 *et seq.* It is respectfully requested that this refusal to register be affirmed.

### **FACTS**

On October 25, 2005, the applicant applied for registration of the mark PATSY'S PIZZERIA for "restaurant services, including take-out restaurant services."

On April 28, 2006, examining attorney issued an office action refusing applicant's mark pursuant to Section 2(d) of the Trademark Act in connection with U.S. Registration Nos. 1874789, 2777068, 2854063, 3009866 and 3009836 and advised of potential refusals with respect to two pending applications, Serial Nos. 76647346 and 76208702. Also requested was a clarification of the recitation of services and a requirement for a disclaimer of PIZZERIA.

On October 31, 2006, in its response, the applicant advanced arguments in support of registration, and successfully responded to the procedural requirements.

On December 2, 2006, the Office suspended proceedings in this case pending the disposition of prior pending Application Serial Nos. 76647346 and 76209702.

On June 24, 2007, the Office issued a new refusal since prior pending Application Serial Nos. 76647346 and 76209702, matured into U.S. Registration Nos. 3090551 and 3243279 and were cited against applicant's mark. The refusals with respect to the other cited registrations were presumed to be continued and maintained.

On December 21, 2007, applicant responded, providing substantive arguments, and providing information regarding other proceedings allegedly related to the instant application.

On December 30, 2007, the Office suspended action on the application pending receipt of maintenance documents.

On November 29, 2011, the Office issued a suspension inquiry regarding the status of the maintenance documents.

On May 30, 2012, the applicant submitted a response to the suspension inquiry stating that its civil proceeding had been concluded.

The case remained suspended until the proceedings concluded, and Registration Nos. 3009836 and 3009866 were cancelled on March 15, 2012 and March 22, 2012.

On August 2, 2012, a response was received outlining the outcome of litigation proceedings.

On October 17, 2012, an office action was issued withdrawing refusals with respect to U.S. Registration Nos. 3243279, 2845063, 2777068 and 1874789. The refusal with respect to Registration No. 3090551 was made FINAL.

On April 16, 2013, the applicant filed a request for reconsideration of the Section 2(d) final refusal; the applicant also filed a Notice of Appeal on April 16, 2013.

On June 24, 2013, the examining attorney denied the request for reconsideration and continued the final refusal to register applicant's mark. An appeal brief was forwarded to examining attorney on September 4, 2013.

**ISSUES PRESENTED**

There are two issues on appeal. The first is whether applicant's mark, when used on or in connection with the identified services, so resembles the mark in U.S. Registration No. 3090551 as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d). The second is whether the Board should apply the doctrine of stare decisis based on the prior court decisions regarding applicant's and registrant's previous uses of marks including the term PATSY'S.

## **ARGUMENT**

I. *Applicant's Mark, PATSY'S PIZZERIA, for "pizzeria services," is Likely To Cause Confusion with the Mark, in U.S. Registration No. 3090551, PATSY'S OF NEW YORK, for "restaurant services," Under Section 2(d) Of The Trademark Act.*

### **A. General Rules Of Analysis For Section 2(d) Likelihood Of Confusion Cases**

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256

(Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

**B. Applicant's Mark, PATSY'S PIZZERIA, Is Similar In Sound, Appearance, And Impression to Registrant's Mark, PATSY'S OF NEW YORK**

In a likelihood of confusion determination, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks 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).

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered under applicant's and registrant's marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

Here, applicant's mark, PATSY'S PIZZERIA, and registrant's mark, PATSY'S OF NEW YORK, are highly similar because both are comprised of the term PATSY'S followed by descriptive or geographically descriptive wording. PATSY'S is spelled identically in both marks, including the use of the possessive "'S,'" and thus this term has the same sound, appearance, and impression in both marks.

Further, as PATSY'S is the first term in each mark, consumers are more inclined to focus on that term. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also 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).

Regarding the additional wording in each mark, it should be noted that although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See *In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751. Disclaimed matter is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii).

In these particular marks, applicant has already disclaimed the merely descriptive wording PIZZERIA, and the registration includes a disclaimer of the geographically descriptive wording OF NEW YORK. As stated, disclaimed matter is typically less significant or less dominant when comparing marks. Thus, PATSY'S is the dominant portion of both marks, as it is the first term, and the additional wording in each mark is merely descriptive or geographically descriptive, and has been disclaimed.

Moreover, the minor differences in the marks do not change their commercial impressions, which are highly similar. Both marks use a name followed by the possessive "'S'" to imply that the services are associated with someone named Patsy.<sup>1</sup> Consumers viewing the mark would presume that both sets of services are associated with the same Patsy.

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<sup>1</sup>The history of the applicant's and registrant's businesses indicates that both were founded by persons named Patsy. Please see *Applicant's Request for Reconsideration, 4/16/2013, Exhibit 1 at 5-6.*

Applicant argues that the marks have different visual impressions because they contain a different number of elements (two in PATSY'S PIZZERIA, and four in PATSY'S OF NEW YORK), and the additional terms are different (descriptive vs. geographically descriptive). Applicant further contends that both marks are "primarily sold in a visual or self-service manner," and that therefore "the visual impact predominates over any phonetic impact." *Please see Applicant's Appeal Brief, 9/03/2013, at 5-6.*

With respect to this argument, applicant provides no evidence to support its contention that both marks are encountered primarily visually, nor does applicant account for the possibility of "word of mouth" discussion amongst people, radio advertising, or other circumstances when the marks might first be encountered aurally. More relevantly here, both marks are presented in standard character format.

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 Viterra 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). Because both marks are presented in standard character format, both applicant and registrant could choose to display their respective marks in highly similar fonts or styles, thus increasing the likelihood of confusion for consumers who do encounter the marks visually, and would presume that similarly stylized marks that both start with the term PATSY'S offer services that emanate from the same source.

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For the reasons discussed above, the mark PATSY'S PIZZERIA is highly similar in sound, appearance, and impression to the mark PATSY'S OF NEW YORK, and this similarity increases the likelihood of confusion for consumers encountering the marks.

**C. Applicant's Pizzeria Services Are Highly Similar And Closely Related To Registrant's Restaurant Services**

In the second part of a likelihood of confusion analysis, the goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Applicant has identified its services as “pizzeria services”. The registered mark, “PATSY’S OF NEW YORK”, is for “restaurant services”.

Throughout this proceeding, applicant has continually stated that the court orders resulting from the previous rounds of litigation between itself and registrant have ultimately found that “pizzerias” are distinct from “restaurants.” *Please see, e.g., Applicant’s Appeal Brief, 9/03/2013, at 6-7, 8-9, 14-15.*

Although the prior court proceedings may have reached that conclusion based on the particular evidence and practices of the parties presented during those inter partes proceedings, in this instance we look to the plain meaning of the term “pizzeria” as defined in the dictionary:

**pizzeria – a place where pizzas are made and sold.** *Please see First Office Action, 4/28/2006.*

*Please see an additional definition of pizzeria:*

**pizzeria – a restaurant that sells pizza.** *See attached definition from Macmillan Dictionary.*<sup>2</sup>

Therefore, contrary to applicant’s contentions that the terms “pizzerias” and “restaurants” have entirely different meanings, the dictionary definition shows that consumers understand that a “pizzeria” is a

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<sup>2</sup> It is respectfully requested that the Board take judicial notice of the dictionary definition from Macmillan Dictionary – ©Macmillan Publishers Limited, 2009 -2013. *In re Thomas White Int’l Ltd*, 106 USPQ2d 1158, 1160 n.1 (TTAB 2013) (judicial notice taken from dictionary existing in print format); TBMP Sections 704.12 and 1208.04.

type of restaurant, and that a party who offers restaurant services, or services related to restaurant services, might also be including pizzeria services, or services related to pizzeria services, under its brand.<sup>3</sup> For purposes of the Section 2(d) analysis, then, registrant's "restaurant services" is presumed to be a broad term including all types of restaurant services, including such specialties as pizzerias.

Turning now to the relationship between applicant's services and registrant's services, evidence shows that companies that offer restaurant services also commonly offer pizzeria services, and they do so under the same brand name.

Attached as evidence, from the USPTO's X-Search database, are a number of third-party marks registered for use in connection with the same or similar services as those of both applicant and registrant in this case. This evidence shows that the services listed therein, namely restaurant services and pizzeria services, are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP Section 1207.01(d)(iii). The complete set of registrations may be found attached to the Final Office Action, 10/17/2012, at 2-49 and Request for Reconsideration, 6/24/2013 at 2-30. Below is a sampling of the registrations that were previously attached:

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<sup>3</sup> Please note that applicant's stare decisis claim is based upon prior litigation, *Patsy's Italian Restaurant, Inc., v. Banas*, 531 F. Supp. 2d 483 (E.D.N.Y. 2008), which did not include the registrant's mark cited against this application.

- **VILLA MONTE** (U.S. Reg. No. 1663056) for “restaurant and pizzeria services”.
- **CIOFFI’s** (U.S. Reg. No. 2078367) for “restaurant, pizzeria and deli services”.
- **TOTONONNO’S PIZZERIA NAPOLITANO** (U.S. Reg. No. 2383913 for “restaurant and pizzeria services”.
- **MAMA THERESA’S PIZZERIA AND RESTAURANT** (U.S. Reg. No. 2504578 for “restaurant, pizzeria and carry-out services.”
- **PIZZA ROMA** (U.S. Reg. No. 4077841) for “pizzeria services; restaurant services”.

This evidence shows that consumers typically encounter both types of services from one source, and the services are closely related.

Applicant also argues that confusion is unlikely because it uses the mark on a variety of services, and that the use creates an association of the mark PATSY’S PIZZERIA with applicant. Applicant also indicates that registrant’s services do not include pizza. Applicant’s argument is not persuasive.

The question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). In this case, the applicant's and registrant's identifications do not contain any limitation as to the types of foods served. As previously noted, use of the term "restaurant services" is broad enough to include establishments that serve pizza. Unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In addition, applicant states that its mark and registrant's mark have coexisted for years without actual confusion. Applicant contends that this is strong evidence that there will be no confusion in the future. However, it is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); TMEP §1207.01(d)(ii). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence

pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case). *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).

The evidence demonstrates that pizzeria services and restaurant services are commonly offered by the same companies, and that restaurant services may encompass pizzeria or pizza restaurants. Also, the identified services contain no limitations regarding the type of food served and no restrictions on trade channels. As such, the services are closely related.

**D. Applicant's Pizzeria Services And Registrant's Restaurant Services Travel In The Same Channels Of Trade And Are Available To The Same Class Of Purchasers**

In this case, the identifications set forth in the application and registration(s) have no restrictions as to nature, type, channels of trade, or classes of purchasers. Absent restrictions in an application and/or registration, the identified goods and/or services are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterro 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 1001, 1005 (Fed. Cir. 2002)). That is, both applicant and registrant's pizzeria and restaurant

services are presumed to be available to anyone who is interested in dining out. Both populations are presumed to include the general public, and therefore overlap.

Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

The registration uses the broad wording “restaurant services” to describe their services and this wording is presumed to encompass all of services of the type described, including those in applicant’s more narrow identification of “pizzerias”.

Applicant argues for distinguishing the channels of trade stating that a “pizzeria” is a specialty and not “subsumed by an overly broad and generic restaurant services identification”. *Please see Applicant’s Appeal Brief, 9/03/14, at 14.* As stated in Section I.C., *supra*, and supported by evidence attached to the final office action and the request for reconsideration, pizzeria services and restaurant services are commonly provided under the same mark. Consumers seeing a given mark associated with one set of services would likely make an assumption of association if they saw a highly similar mark being used with a subset of those services.

**E. Applicant’s Claim of Prior Use is Not Relevant in This Ex Parte Proceeding**

In a Section 2(d) analysis, the overriding concern is to prevent buyer confusion as to the source

of the goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir.1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

Applicant stated in its appeal brief that “doubts about the likelihood of confusion should then be resolved against the newcomer and in favor of the prior user or registrant” and cited to two cases: *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1345, 71 U.S.P.Q.2d 1944 (Fed. Cir. 2004); and *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 U.S.P.Q. 308 (T.T.A.B. 1976). Please see *Applicant’s Appeal Brief*, 09/4/2013, at 4.

Contrary to its declaration, applicant’s claim of priority of use is not relevant to this ex parte proceeding. See *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971). Trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of the validity of the registration, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the mark in commerce on or in connection with the goods and/or services specified in the certificate. Applicant’s assertion is based primarily on a principal taken from an inter partes proceeding, *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 U.S.P.Q. 308 (T.T.A.B. 1976), where both parties were able to present evidence and arguments. During ex parte prosecution, the trademark examining attorney has no authority to review or to decide on matters that constitute a collateral attack on the cited registration, and applicant’s argument that any doubts should be resolved in its favor as the prior user has no weight. TMEP §1207.01(d)(iv).

*II.* The Decisions from Applicant's and Registrant's Prior Proceedings Do Not Apply to this Current Proceeding

In its response to office action, request for reconsideration and appeal brief, applicant argues that the findings of the Eastern District of New York, and affirmed by the United States Court of Appeals for the Second Circuit, should be followed under the principle of stare decisis. That line of proceedings, which revolved around applicant's use of its marks PATSY'S and PATSY'S PIZZERIA for restaurant/pizzeria services and registrant's use of its mark PATSY'S PR and PATSY'S for restaurant services, as well as additional issues stemming from the nature of use of the PATSY'S PIZZERIA mark by some of applicant's franchisees at the time, involved a long and protracted legal battle over the rights to the name PATSY'S. Ultimately, it was found that both applicant and registrant could continue using their respective marks, but that both must distinguish themselves by using the wording PIZZERIA or ITALIAN RESTAURANT in association with the name PATSY'S. Additionally, each party was limited as to the type of food and dining options it could offer under the respective marks PATSY'S PIZZERIA or PATSY'S ITALIAN RESTAURANT. Finally, various federal trademark registrations belonging to each party were ordered cancelled by the court orders.

However, the court orders clearly indicated that the findings in that case were heavily influenced by the particular facts of use, lack of policing of the marks, and a need for the parties to define their services so as to avoid confusion in the marketplace. Additionally, the marks litigated in those

proceedings **differ** from the marks at issue in this case. TMEP Section 1217 indicates that (emphasis added):

Stare decisis provides that when a court has once laid down a principle of law as applicable to a certain set of facts, it will adhere to that principle, and apply it to all future cases, *where the facts are substantially the same*, regardless of whether the parties and properties are the same. *In re Johanna Farms Inc.*, 8 USPQ2d 1408, 1410 (TTAB 1988).

In the instant application, the facts are not substantially the same as in the proceedings before the Eastern District of New York and the Second Circuit as discussed below.

**A. Registrant's Mark in this Instance Was Not Subject To The Prior Litigation**

As noted above, in the prior proceedings, the marks at issue were applicant's PATSY'S and PATSY'S PIZZERIA marks for restaurant/pizzeria services and registrant's PATSY'S and PATSY'S PR marks for restaurant services. The cited registration, PATSY'S OF NEW YORK was **not** one of the marks included or discussed in the proceedings. Applicant counters that if the term PATSY'S is, as the examining attorney asserts, the "dominant portion" of the marks, then it should not matter that registrant is using a different set of descriptive/geographically descriptive wording here than the highly descriptive ITALIAN

RESTAURANT wording the Court found registrant entitled to use. Rather, if the issue at hand is the use of PATSY'S by both parties, then the standing civil court orders have already addressed that.

However, the registrant's marks differ by more than just the terms following PATSY'S. Registrant's use of the wording ITALIAN RESTAURANT versus applicant's use of the wording PIZZERIA was determined to be directly related to the particular services each offered under its brand, and the distinction between the pizzeria and Italian restaurant services, as found by the courts. The registered mark cited here includes no reference to the terms ITALIAN RESTAURANT, and only includes the additional wording OF NEW YORK. Given that both applicant and registrant operate establishments in New York, this raises a *new consideration*, and it cannot be said that this matter has already been decided.

**B. Applicant's Services In This Instance Were Not Subject To The Prior Litigation**

Although the court orders make clear that evidence presented during litigation showed that the restaurant services offered by registrant at the time and under the marks listed in the litigation differed from the pizzeria services offered by applicant under the mark PATSY'S PIZZERIA, at no point was the mark PATSY'S OF NEW YORK, or what type of foods/services might be included under its "restaurant services," considered. Thus, it cannot be said that the facts of the prior proceeding and the current one are substantially the same.

**C. The Court Clearly Left Future Trademark Application Decisions To The United States Patent and Trademark Office**

Perhaps most tellingly, the court order from the United States District Court for the Eastern District of New York included language that unquestionably left decisions about future trademark applications, submitted by either applicant or registrant in this case, to the Office. Specifically, after advising both parties to define their services narrowly and “fully acknowledge each other’s existence and rights to the PTO” in any future trademark applications, the Court said that “[i]t will then be left to the examiners at the PTO to determine whether to grant concurrent service mark registrations to both” parties. *Please see Applicant’s Request for Reconsideration, 4/16/2013, Exhibit 1 at 71.* This language clearly states that the court has left it up to the U.S. Patent and Trademark Office to decide whether or not it is appropriate to grant trademark registrations based on individual applications.

**D. No Consent, Concurrent Use or Limitation of Services has been presented by Applicant or Registrant**

Applicant has stated that the Registrant never sought to prevent the Applicant’s use of its mark. However, no acknowledgement of the dissimilarity of the marks has been provided by the Registrant. There has been no provision narrowing their services, no express statement to the Patent and Trademark Office that they will definitively not be providing pizzeria services, no expression of their view on the dissimilarity of the services or the channels of trade, no consent document, nor has there been a concurrent use statement been provided by registrant.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

#### **CONCLUSION**

The applicant's mark is highly similar to the registrant's mark, and the applicant's services are closely related to or encompass the registrant's services. The services of the parties may be found in the same trade channels. As a result of these similarities, a likelihood of confusion exists. Further, the principal of stare decisis does not apply to the particular facts of this application and the cited registration. Therefore, the Board is respectfully requested to affirm the refusal to register under Section 2(d) of the Trademark Act.

Respectfully submitted,

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to inhale ... the vapour produced by an electronic cigarette

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HD peradventure piece of work motherism  
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