

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
November 29, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re The Works Gourmet Burger Bistro, Inc.

—
Serial No. 76704958

—
David K. Hou of Boylan Code LLP for The Works Gourmet Burger Bistro, Inc.

Warren L. Olandria, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

—
Before Kuhlke, Bergsman and Adlin, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

The Works Gourmet Burger Bistro, Inc., (“applicant”) filed an intent-to-use application to register the mark THE WORKS, in the stylized format shown below,

THE WORKS

for the following goods and services as amended:

Clothing, namely, t-shirts, tank tops, vests, jackets, sweatshirts, hats and baseball caps related to restaurant services and food products, in Class 25; and

Operation of restaurant services; operation of carry-out food services, in Class 43.

The Trademark Examining Attorney refused to register applicant's mark pursuant to Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that it so resembles the previously registered mark THE WORKS, in typed drawing form, for *inter alia* "restaurant services; take-out restaurant services," in Class 43, as to be likely to cause confusion.¹

The Trademark Examining Attorney also refused to register applicant's mark pursuant to Section 2(d) of the Trademark Act of 1946 on the ground that it so resembles the previously registered mark WORKS, in typed drawing form, for *inter alia* "clothing, namely, t-shirts related to motorsports, motorsports racing jerseys, and motorcycle racing pants," in Class 25.²

Preliminary Issue

Applicant submitted evidence, not previously made of record, with its appeal brief. The Trademark Examining Attorney lodged an objection to the evidence attached to applicant's brief on the ground that it was not timely filed. Applicant did not file a reply brief or otherwise contest the objection.

Trademark Rule 2.142(d) provides the following:

The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the

¹ Registration No. 2944307, issued April 26, 2005; Sections 8 and 15 affidavits accepted and acknowledged.

² Registration No. 2699070, issued March 25, 2003; renewed.

appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request the Board to suspend the appeal and to remand the application for further examination.

The objection is therefore sustained and we have not considered the evidence submitted with applicant's brief.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth 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., Inc.*, 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 similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). *See also*, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

A. Registration No. 2944307 for the mark THE WORKS for “restaurant services; take-out restaurant services.”

1. The similarity or dissimilarity and nature of the services as described in the applications and registration, established likely-to-continue channels of trade and classes of consumers.

Applicant's “operation of restaurant services; operation of carry-out food services” and registrant's “restaurant services; take-out restaurant services” are for our purposes identical. Applicant does not argue that the services are different.

Because the services described in the application and registration are identical, we must presume that the channels of trade and classes of purchasers are

the same. *See American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.”). *See also In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

We find that the *du Pont* factors of similarity of services and channels of trade favor a finding of likelihood of confusion.

2. The similarity or dissimilarity of the marks in their entirety in terms of appearance, sound, connotation and commercial impression.

We turn next to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. The marks are essentially identical. Nevertheless, applicant argues that “[t]he essence of Applicant’s mark is entirely dependent and dominated by its stylized lettering as its distinguishing element.”³ However, applicant’s mark is presented in block letters which do not serve to distinguish applicant’s mark from the registered mark. In any event, the registered mark is presented in typed drawing form, now referred to as standard characters, and it is not limited to any particular depiction. The rights associated with a mark in typed drawing form

³ Applicant’s Brief, p. 7.

reside in the wording and not in any particular display. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983); *In re RSI Systems, LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988). This means that registered mark may be displayed in the same block letters as applicant's mark.

3. The strength of registrant's mark.

Applicant argues that "registrant's use of 'WORKS' is highly descriptive, and is so commonly used that consumers will look to other elements to distinguish the source of goods or services."⁴ To support this argument, applicant submitted the following evidence.⁵

1. Four third-party registrations on the Principal Register for trademarks incorporating the word "Works" for restaurant services.⁶

- a. Registration No. 4069926 for the mark A1A BURRITO WORKS TACO SHOP. Registrant disclaimed the exclusive right to use "A1A BURRITO" and "TACO SHOP."
- b. Registration No. 3132146 for the mark EGG WORKS. Registrant disclaimed the exclusive right to use the word "Egg."
- c. Registration No. 2890229 for the mark FRESH WORKS. Registrant disclaimed the exclusive right to use the word "Fresh."

⁴ Applicant's Brief, p. 9.

⁵ Applicant also submitted the results of a search of the USPTO automated database for marks comprising the word "Works" in Class 43 that displays the serial number, registration number, mark and status. However, because applicant did not display the services and because Class 43 is not limited to restaurant services, the search results have limited probative value.

⁶ January 9, 2012 response to Office action.

- d. Registration No. 368137 for the mark POTBELLY SANDWICH WORKS and design. Registrant disclaimed the exclusive right to use the word “Sandwich.”
2. Excerpts from third-party websites displaying the use of the term “Works” as a part of a trademark in connection with restaurant services.⁷
 - a. Bone Works Grill (boneworksgrill.com).
 - b. EGG WORKS (theeggworks.com) “the flagship breakfast joint in the Las Vegas area.”
 - c. THE FRESH WORKS (thefreshworks.com) located in the Philadelphia metropolitan area.
 - d. THE WORKS (gearedforfun.com) located in Wyomissing, Pennsylvania.
 - e. THE WORKS BRICK OVEN RESTAURANT (theworkspizza.com) located in Loveland, Ohio.
 - f. THE WORKS (gyrosglenview.com) located in Glenview, Illinois.
 3. The definition of the word “Works” as a location where “a specific type of business or industry is carried on,” and regarding “the full range of possibilities; everything. Use with *the*: *ordered a pizza with the works.*”⁸

Applicant argues that “third party [sic] registrations are useful in demonstrating the extent of a common mark’s usage or adoption in common parlance to narrow the scope of protection available to it. ... Use of third-party registrations in this way has been recognized by the Office by allowing marks to be registered (such as those submitted by Applicant as evidence), which contain

⁷ January 9, 2012 response to Office action. We do not consider WILDSTAR FOOD STORE – THE WORKS because it is not located in the United States.

⁸ **AMERICAN HERITAGE DICTIONARY** (ahdictionary.com) attached to the January 9, 2012 response to Office action. *See also* Oxford Dictionaries Online (Oxforddictionaries.com).

common or similar features for the same or closely related goods where the remaining portions of the marks are sufficient to distinguish the marks as a whole.”⁹ Moreover, applicant contends that by providing evidence of third-party use, it has shown that “it is unlikely that consumers will be confused; rather, third-party uses can confirm that consumers are able to distinguish between marks based on other elements or features, even descriptive ones.”¹⁰ Thus, applicant concludes that “the referenced third party [sic] registrations and actual uses in commerce demonstrate that the registrant’s use of ‘WORKS’ is highly descriptive, and is so commonly used that consumers will look to other elements to distinguish the source of the goods or services.”¹¹

The main problem with applicant’s arguments is that the marks at issue are identical and they are proposed for use in connection with identical services so there is no basis upon which consumers could distinguish the marks. Registrant is entitled to a measure of protection against the registration of another mark likely to cause confusion no matter how limited registrant’s rights may be. *BAF Industries v Pro Specialties, Inc.*, 206 USPQ 166, 175 (TTAB 1980).

4. Balancing the factors.

Because the marks are identical, the services are identical and we must presume that the services move in the same channels of trade and that the services are rendered to the same classes of consumers, we find that applicant’s mark THE

⁹ Applicant’s Brief, p. 8.

¹⁰ Applicant’s Brief, p. 8.

¹¹ Applicant’s Brief, pp. 8-9.

WORKS (stylized) for the “operation of restaurant services; operation of carry-out food services” so resembles the mark THE WORKS for “restaurant services; take-out restaurant services” as to be likely to cause confusion.

B. Registration No. 2699070 for the mark WORKS for “clothing, namely, t-shirts related to motorsports, motorsports racing jerseys and motorcycle racing pants.”

1. The similarity or dissimilarity and nature of the goods as described in the application and registration, established likely-to-continue channels of trade and classes of consumers.

Applicant is seeking to register its mark for restaurant services and “clothing, namely, t-shirts, tank tops, vests, jackets, sweatshirts, hats and baseball caps related to restaurant services and food products” and the cited mark is registered for “clothing, namely, t-shirts related to motorsports, motorsports racing jerseys, and motorcycle racing pants,” as well as “motorcycle seat covers and motorcycle exhaust pipes,” in Class 12.

In analyzing the relatedness of the goods, the issue is whether clothing related to restaurants is sufficiently related to clothing for motorsports in the minds of the common purchasers to result in a likelihood of confusion. On this record, we cannot find that applicant’s sale of clothing related to restaurants is sufficiently related to clothing used for motorsports to support a finding that there is a likelihood of confusion. It is not uncommon for restaurants to apply their names to t-shirts, tank tops, jackets, sweatshirts, hats and baseball caps as souvenirs rather than for establishing a reputation for clothing separate and apart from promoting the restaurant services. There is nothing in the record to suggest that:

1. Clothing related to restaurant services and food products is connected in any way to clothing related to motorsports;
2. The ordinary trade channels for clothing related to restaurant services overlap with the ordinary trade channels for clothing related to motorsports; or
3. The same classes of purchasers will buy clothing related to restaurant services and food products and clothing related to motorsports.

In other words, there is no evidence to support a finding that the applicant's mark and registrant's mark will be encountered by the same consumers under circumstances likely to give rise to the mistaken belief that the clothing products of applicant and registrant come from the same source or are somehow associated.

The Trademark Examining Attorney argues that there are no limitations regarding trade channels in the description of goods for either the application or the registration. We disagree. As we discussed above, applicant's clothing is related to restaurant services and food products while registrant's clothing is related to motorsports.

In view of the foregoing, we find that the relatedness of the goods, the channels of trade and the classes of consumers weigh against finding that there is a likelihood of confusion.

2. The similarity or dissimilarity of the marks in their entirety in terms of appearance, sound, connotation and commercial impression.

We turn next to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177

USPQ at 567. In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Applicant's mark THE WORKS and registrant's mark WORKS are virtually identical in terms of appearance and sound. However, the meaning and commercial impression of the marks are different. As discussed above, the definition of the word "Works" is a location where "a specific type of business or industry is carried on," and "the full range of possibilities; everything. Use with *the*: *ordered a pizza with the works.*" It is also defined as "engineering structures" and "internal mechanism; *the works of a watch.*"¹² Thus, in the case of applicant's mark, the mark THE WORKS suggests a food item with everything on it. However, in the

¹² The word "Work" is defined *inter alia* as "engineering structures" and "internal mechanism; *the works of a watch.*" **AMERICAN HERITAGE DICTIONARY** (ahdictionary.com) attached to the January 9, 2012 response to Office action.

case of the registrant's mark, WORKS suggests an engineering structure such as an engine or motorcycle. In view of the different meanings and commercial impressions engendered by the marks, we find that applicant's mark THE WORKS is not similar to registrant's mark WORKS. *See Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1609 (TTAB 2010) (COACH applied to fashion accessories suggests a carriage or travel accommodations thereby engendering the commercial impression of a traveling bag while COACH used in connection with student test preparation software calls to mind a tutor), *aff'd* 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012).

3. Balancing the factors.

In view of our findings that the marks are not similar, the goods are not related and they move in different channels of trade and are sold to different classes of consumers, we find that applicant's mark THE WORKS for "clothing, namely, t-shirts, tank tops, vests, jackets, sweatshirts, hats and baseball caps related to restaurant services and food products" is not likely to cause confusion with the registered mark WORKS for "clothing, namely, t-shirts related to motorsports, motorsports racing jerseys, and motorcycle racing pants."

Decision: The refusal to register applicant's mark in Class 43 is affirmed. The refusal to register applicant's mark in Class 25 is reversed. The application for the goods in Class 25 will proceed for the issuance of a notice of allowance in due course.