

THIS OPINION
IS NOT A PRECEDENT OF
THE T.T.A.B.

Mailed:
January 29, 2009
jtw

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Twenty Three East Adams Street Corp.

Serial No. 76978795

Charles T. Riggs, Jr. of Patula & Associates, P.C. for
Twenty Three East Adams Street Corp.

Renee McCray, Trademark Examining Attorney, Law Office 111
(Craig D. Taylor, Managing Attorney).

Before Quinn, Walsh and Taylor, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

Twenty Three East Adams Street Corp. (applicant) has
applied to register the mark shown below¹ for "restaurant
and bar services" in International Class 43.²

¹ Applicant provided a new drawing with the paper filed June 24,
2008. The new drawing, which displays the mark more clearly in
the same general style of lettering, was not entered. It must be
entered in the event this application proceeds to publication.
Our decision here would be same based on either drawing.

² Application Serial No. 76978795, filed September 7, 2004,
claiming first use of the mark anywhere and first use of the mark
in commerce on June 1, 1950.

MILLER'S

The application includes the following statement: "The term 'MILLER'S' is a surname. The term 'MILLER'S' does not identify a living individual." The application also includes a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

The Examining Attorney has finally refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion between applicant's mark and the mark in Registration No. 2850178, owned by Ale House Management, Inc., shown here:



for services identified as "full service restaurant" in International Class 43. The registration issued on June 8, 2004.

Applicant has appealed. Applicant and the Examining Attorney have filed briefs. We affirm.

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office... as to be likely, when used on or in connection with the goods [or services] of the applicant, to cause confusion..." 15 U.S.C. § 1052(d). The opinion in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors to consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the services of the applicant and registrant. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks."). Below we will consider each of the factors as to which applicant or the Examining Attorney presented arguments or evidence.

The services of applicant and the registrant need not be identical to find likelihood of confusion under Section 2(d) of the Trademark Act. They need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods originate from or are associated

Serial No. 76978795

with the same source. See *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Furthermore, in comparing the services we must consider the services as identified in the application and cited registration. See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

In this case the services are not only related, but identical or overlapping. Applicant has not argued otherwise. The "full service restaurant" services identified in the registration logically include or overlap with applicant's "bar and restaurant services."

Also, in view of the fact that the services are identical or overlapping, we conclude that the channels of trade for the services are also identical or overlapping. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

Turning to the marks, as a starting point we observe that, in cases such as this, where the applicant's services

Serial No. 76978795

are identical to or overlap with the services identified in the cited registration, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the services were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Furthermore, in comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

While we must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. As the Court of Appeals for the Federal Circuit observed, "... in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Furthermore, "... it is well established that the test to be applied in determining likelihood of confusion is not whether marks are distinguishable on the basis of a side-by-side comparison but rather whether they so resemble one another as to be likely to cause confusion, and this necessarily requires us to consider the fallibility of memory over a period of time. That is to say, the emphasis must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks." *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975) (internal citations omitted).

Applicant argues that MILLER'S is primarily merely a surname, and as such, "non protectible" absent a showing of acquired distinctiveness. Applicant argues that no such showing was made in the case of the cited registration. Proceeding from that premise applicant argues further that a proper comparison of the marks must focus on the display or stylization of the respective word marks and accompanying design elements, and not on the word MILLER'S as such. Applicant finally argues that, when one compares the display and design elements of the respective marks, the marks are "extremely dissimilar."

On the other hand, the Examining Attorney argues,

"... the marks are confusingly similar not only in appearance and sound, but also in connotation and commercial impression because they contain the identical wording MILLER'S." Examining Attorney's Brief at 3.

First, we reject the premise underlying applicant's arguments. That is, we may not assume, as applicant urges, that the word MILLER'S in the registered mark is not protected. We must accord the mark in the cited registration, including the word portion, MILLER'S, the full benefits set forth in Trademark Act Section 7(b), 15 U.S.C. § 1057(b), including the recognition that the registration is prima facie evidence of the "validity of the registered mark" and of "the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate..." 15 U.S.C. § 1057(b). Applicant's argument that we should accord the cited registration something less than full effect is an impermissible collateral attack on the registration. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1535 (Fed. Cir. 1997). Consequently, we decline to disregard the significance of MILLER'S in the registered mark.

Furthermore, we concur with the Examining Attorney and conclude that MILLER'S is the dominant element in both

applicant's mark and the registered mark. Most importantly, MILLER'S is dominant because it is the only word element in both marks. Here, as is generally the case, the word elements in the respective marks are dominant because potential purchasers commonly use word marks in requesting goods or services. *In re Dixie Restaurants Inc.*, 41 USPQ2d at 1534.

There is nothing in the stylization of letters or the designs at issue here which dictates any other construction of the marks. For the record, we have considered applicant's many arguments concerning the importance of the design elements here. We have also considered the cases applicant cites and discusses, and find them distinguishable. For example, in *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (CCPA 1974), the designs in the respective mark not only differed, but the word and letter elements in the respective marks also differed, unlike this case where the word elements are identical.

Applicant also argues, "The connotation and commercial impression of the cited registration is that of a family oriented seafood restaurant in view of the depiction of a funny man riding a swordfish. To the contrary, the connotation and commercial impression of Applicant's mark

Serial No. 76978795

is that of a more sophisticated, adult oriented British Isle pub-style restaurant." Applicant's Brief at 7. Applicant has not provided any evidence to support this conclusion. We conclude that there is no significant difference between the marks in connotation, commercial impression or otherwise; the dominant element in each mark is the word MILLER'S which contributes most significantly to the connotation and commercial impression, as well as the appearance and sound.

Also, in our comparison of the marks at issue we must take into account the fallibility of human memory and strictly avoid a simplistic side-by-side comparison.

Sealed Air Corp. v. Scott Paper Co., 190 at 108.

Applicant's suggestion that potential customers for the respective restaurant services of applicant and registrant will distinguish those services on the basis of the differing stylization in the letters in the respective marks or based on the inclusion of the design element in the registered mark does not comport with either the law or reality. Accordingly, we conclude that the marks are similar when viewed in their entireties.

Applicant also argues that we should accord the registered mark, in particular, the word MILLER'S, a narrow scope of protection because it is weak. To support this

Serial No. 76978795

argument applicant has made of record third-party registrations for the following marks for restaurant services: ANNA MILLERS' PIES; BILL MILLER BAR-B-Q; MILLER'S ROAST BEEF; CHERRY MILLER'S CAFE; MILLER'S CROSSING; and PETE MILLER'S.

Based on this evidence, we acknowledge that there are numerous registrations for the surname "MILLER" in some form in connection with restaurant services. Each third-party mark does include some other wording unlike the marks at issue here. In this case, both marks include the identical wording MILLER'S, and no additional wording, and as we noted, the services are identical or overlapping. Under the particular circumstances before us, we find applicant's showing regarding "MILLER" insufficient to conclude that there is no likelihood of confusion.

We likewise find unpersuasive applicant's evidence of multiple registrations for other marks, which include apparent surnames, such as, LEE'S DELI and LEE'S SANDWICHES, for restaurant services. We must decide each case on its unique facts. Actions by examining attorneys in other applications do not dictate our determination in this case. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Applicant also argues that the potential purchasers of restaurant services are sophisticated and that this fact would preclude confusion in this case. Neither the application nor the registration limit the restaurant services in question in a way which would suggest that the services are particularly expensive or which would otherwise confine the services to knowledgeable or sophisticated clientele. Accordingly, we conclude that both applicant's and registrant's services would be rendered to the general public and could include less expensive offerings. Furthermore, as the Examining Attorney notes, even sophisticated purchasers may be subject to trademark confusion. *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983). Thus, we conclude that the sophistication of purchasers is not a factor in this case.

Finally, based of all evidence and argument in this case bearing on the *du Pont* factors, we conclude that there is a likelihood of confusion.

Decision: We affirm the refusal under Trademark Act Section 2(d).