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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Luca's Chophouse LLC

Serial No. 77335047

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Chophouse LLC

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Before Seeherman, Drost and Zervas, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Luca's Chophouse LLC has appealed from the final
refusal of the trademark examining attorney to register
LUCA'S CHOPHOUSE and design, as shown below, with CHOPHOUSE
disclaimed, for "restaurant and bar services."¹

¹ Application Serial No. 77335047, filed November 21, 2007, and
asserting first use as of December 2006 and first use in commerce
as early as March 2007.



Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, as used in connection with its services, is likely to cause confusion with the following two registrations, both owned by the same entity:

LUCA PIZZA DI ROMA, in standard character form, with PIZZA DI ROMA disclaimed, and with the statement that the English translation of DI ROMA is "OF or FROM ROME," registered for restaurant services² and

LUCA PIZZA, in standard character form, with PIZZA disclaimed, registered for restaurant services.³

We affirm the refusal of registration.

As a preliminary matter, we note that with its appeal brief applicant has submitted copies of the exhibits that were previously filed during the prosecution of the application. The Board discourages such duplicate filings. See TBMP § 1203.01 (papers that are already in the file should not, as a matter of course, be resubmitted as

² Registration No. 3398268, issued March 18, 2008.

³ Registration No. 3249643, issued June 5, 2007.

exhibits to the brief); In re SL&E Training Stable Inc., 88 USPQ2d 1216, 1220 n.9 (TTAB 2008) (attaching exhibits to brief of material already of record only adds to the bulk of the file, and requires Board to determine whether attachments had been properly made of record); In re Thor Tech Inc., 85 USPQ2d 1474, 1475 n. 3 (TTAB 2007) (material attached to briefs that is duplicative of matter submitted during examination is already part of application file and its submission with briefs is unnecessary).

We turn now to the issue on appeal, i.e., whether applicant's use of its mark for restaurant and bar services is likely to cause confusion with the two cited registrations. Our determination of this issue 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 (CCPA 1973). See also, In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (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 (CCPA 1976). See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to a consideration of the services. Applicant has identified its services as "restaurant and bar services" and the services in the two cited registrations are identified as "restaurant services." Thus, the restaurant services are legally identical. Applicant has argued at length about the differences in the actual services, noting that the registrant's website shows that its restaurants are casual style eateries specializing in pizza that are frequently located in shopping malls, while applicant operates a single restaurant that is "an upscale fine dining establishment" offering "a full service bar and live dinner entertainment such as small jazz/singing groups" and providing table service by wait staff. Affidavit of Luca Gjonaj, the founder and owner of applicant. Applicant contends "that looking beyond the general registration of 'restaurant services' for Luca Pizza di Roma/Luca Pizza and 'restaurant and bar service' for Luca's Chophouse to the actually [sic] type of operation operated by the two entities shows that there is not a likelihood of confusion." Brief, p. 10.

The foregoing statement in applicant's brief sums up the problem with applicant's arguments. We may not look beyond the identification set forth in the cited registrations and applicant's application to the actual

type of operation of applicant and the registrant. The ownership of the registrations gives the registrant the benefits of Section 7(b) of the Trademark Act, that is, the registrations are prima facie evidence of the registrant's exclusive right to use the mark on or in connection with the goods or services specified in the certificate.

Because the registrations specify the services as "restaurant services," registrant is entitled to use its marks in connection with all types of restaurant services; its rights are not limited to using the marks for casual or fast food restaurants specializing in pizza. Similarly, if a registration were to issue to applicant with the identification of "restaurant and bar services," the registration would give it the right to use its mark with any type of restaurant, including a casual or fast food restaurant specializing in pizza. "Likelihood of confusion must be determined based on an analysis of the mark as applied to the ... services recited in applicant's application vis-a-vis the ... services recited in [a] ... registration, rather than what the evidence shows the ... services to be." In re Dixie Restaurants Inc., 41 USPQ2d at 1534, quoting Canadian Imperial Bank v. Wells Fargo Bank, N.A. , 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed.Cir. 1987). As applicant itself has recognized from

its quoting of the du Pont factors at p. 4 of its reply brief, the second factor is "the similarity or dissimilarity of the goods or services as described in an application or registration." (emphasis added). Further, although it is the identification of services that is controlling, we point out that applicant's restaurant menu lists "Personal Pizza" as one of the featured categories of food it offers.

Because as identified the services are in part legally identical, the du Pont factor of the similarity of the services favors a finding of likelihood of confusion.⁴

Further, because the services are legally identical, they must be presumed to be offered in the same channels of trade to the same classes of consumers, which in this case would be the public at large. This du Pont factor favors a finding a likelihood of confusion. And, because the decision to patronize a restaurant may be made on impulse, the factor of the conditions of purchase also favors a finding of likelihood of confusion. Applicant's argument

⁴ Although not raised as an argument by applicant, the fact that its identification includes "bar services" and the registrant's identification does not is not sufficient to avoid a likelihood of confusion. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application).

with respect to the conditions of purchase factor, that its restaurant is high-end while the registrant's restaurants are a fast food chain and therefore consumers would not be confused as to the source of the respective restaurants, cannot be given any weight since the identifications in the respective application and registrations must control.

We now consider the marks, keeping in mind that when marks would appear on virtually identical goods or services the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). We also repeat the well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood 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 a consideration of the marks in their entireties. In *re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Both applicant's mark and the registrant's marks consist of the word LUCA'S or LUCA, followed by a generic term for the goods sold in the restaurant (PIZZA or PIZZA DI ROMA) in the registrant's marks, or a generic term for

the services (CHOPHOUSE) in applicant's mark. In this connection we take judicial notice that "chophouse" is defined as "a restaurant that specializes in serving chops and steaks."⁵ Although LUCA appears in the possessive in applicant's mark and is not in the possessive in the registered marks, the meaning of the name is the same in all three marks, as applicant acknowledges. "Certainly [applicant] agrees both parties' marks contain the same proper name (Luca)." Brief, p. 5. This name is clearly the dominant element in applicant's and the registrant's marks, as it is the element that consumers would view as the source-indicating part of the marks; further, the source-indicating part of the marks are virtually identical.

Applicant, contends, however, that the stylization of its mark and the difference in the descriptive/generic words in the mark are significant.

With respect to applicant's arguments about the differences in appearance of the marks, we point out that the cited mark is shown in standard character format. This does not mean, as applicant apparently believes, that the

⁵ The American Heritage Dictionary of the English Language, © 1970. The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

registered mark appears in something called "standardized font." On the contrary, a registration in standard character format is not limited to any special form or style, and we must therefore consider the mark in all reasonable manners in which it may be displayed. See *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351 (TTAB 2007), and cases cited therein. Thus, the registrant would be entitled to use its mark in the same capital letter font used in applicant's mark. Applicant has not discussed the oval background on which the word CHOPHOUSE appears, presumably because it does not regard it as a distinguishing feature. Nor do we. The "carrier" for the generic word CHOPHOUSE does not create a separate commercial impression, nor is it likely to be noted or remembered by consumers. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987) (if a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods or services).

As for the word CHOPHOUSE in applicant's mark and the words PIZZA and PIZZA DI ROMA in the cited marks, these words convey to consumers that there is a difference in the type of restaurant they identify, since a CHOPHOUSE, as the dictionary definition states, is a restaurant that

specializes in steaks and chops, while the word PIZZA in the registrant's marks indicates that its restaurants specialize in pizza. However, the question is not whether consumers will confuse the goods or services, but whether they will confuse the source of the goods or services. Thus, a consumer who is familiar with the registrant's LUCA PIZZA or LUCA PIZZA DI ROMA restaurant, and sees the mark LUCA'S CHOPHOUSE on a restaurant, is likely to believe that the LUCA PIZZA people have expanded their operations and have opened a restaurant that has a broader menu. Accordingly, these additional words in the marks are not sufficient to distinguish applicant's mark from the cited marks.

Comparing the marks in their entireties, and giving appropriate weight to the various elements of the marks, and further taking into account that the marks are used in connection with identical services, we find that the marks are similar in appearance, pronunciation, connotation and commercial impression, and that this du Pont factor favors a finding of likelihood of confusion.

Applicant has argued that LUCA "is a fairly common name for individuals from the Mediterranean Area." Brief, p. 5. Applicant has not submitted any evidence in support of this statement and, more importantly, it has not

submitted any evidence of third-party use of LUCA marks in the restaurant or food service field. On the contrary, in its reply brief applicant has stated that it "is unaware of any other restaurant [than its own] with the name Luca contained in it." Reply brief, p. 5. Thus, on the record before us, we must consider the registrant's marks LUCA PIZZA and LUCA PIZZA DI ROMA to be strong marks that are entitled to a broad scope of protection.

With respect to the du Pont factor of evidence of actual confusion, applicant has stated that it is unaware of any instances of such confusion. In general, such uncorroborated statements by an applicant are of little evidentiary value. See *In re Majestic Distilling Co.*, 65 USPQ2d at 1205 and cases cited therein. The lack of evidence of actual confusion carries little weight. Id. That is particularly true in the present case because, according to applicant, it has used its mark for its services only in Michigan, while the registrant has no restaurants in that state. Thus, there has been no opportunity for confusion to occur.⁶

⁶ Applicant has argued that there is no likelihood of confusion because it and the registrant are located in different states. However, as the examining attorney has pointed out, applicant is seeking a geographically unrestricted registration which would give applicant the right to use its mark throughout the country. Further, the cited registrations are unrestricted. Therefore, we must determine the issue of likelihood of confusion on the

Applicant has cited a number of cases in support of its argument that there is no likelihood of confusion.⁷ We will not burden this opinion with a discussion of them. Suffice it to say that most of them are trademark infringement cases which are distinguishable both on their facts and the principles of law that govern them, while one is a non-precedential opinion issued by the Federal Circuit in 2006.

After considering the relevant du Pont factors, and the evidence and argument pertaining thereto, we find that applicant's mark LUCA'S CHOPHOUSE and design, used in connection with restaurant and bar services, is likely to cause confusion with the cited registrations.

Decision: The refusal of registration is affirmed.

assumption that the applicant's and the registrant's services would be offered in the same geographic areas.

⁷ Applicant has not provided the case cites to the United States Patent Quarterly for the federal court cases it has cited. "When cases are cited in a brief, the case citation should include a citation to *The United States Patent Quarterly* (USPQ), if the case has appeared in that publication." TBMP §801.03 (2d ed., revised 2004). See also *In re Carlson*, 91 USPQ2d 1198, 1199 n.2 (TTAB 2009).