

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
May 26, 2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Viccino's Pizza Restaurants, Inc.

Serial No. 77472394

Richard E. Steck of Richard E. Steck & Associates for
Viccino's Pizza Restaurants, Inc.

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Office 108 (Andrew Lawrence, Managing Attorney).

Before Grendel, Taylor and Ritchie, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Viccino's Pizza Restaurants, Inc. ("applicant") has
filed an application seeking registration on the Principal
Register of the mark depicted below for services recited in
the application as "delivery of food by restaurants," in
Class 39, and "carry-out restaurants," in Class 43.¹

¹ Serial No. 77472394, filed on May 12, 2008. The application is
based on use in commerce under Trademark Act Section 1(a), 15



The Trademark Examining Attorney has issued a final refusal of registration of applicant's mark as to both Class 39 and Class 43, on the ground that the mark, as applied to the services recited in the application, so resembles the mark **IL VICINO**, previously-registered on the Principal Register (in standard character form) for Class 43 services recited in the registration as "restaurants,"² as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant has appealed the final refusal as to both classes. The appeal is fully briefed. An oral hearing was held on May 26, 2010 at which applicant's counsel and the Trademark Examining Attorney presented arguments.

U.S.C. §1051(a). December 15, 1998 is claimed in the application as the date of first use of the mark and the date of first use of the mark in commerce. The application includes the following statements regarding the mark: "The mark consists of the word "Viccino's" containing a stylized letter "O" depicting a pizza with a triangular slice offset."; "The stippling is a feature of the mark and does not indicate color."; and "Color is not claimed as a feature of the mark."

² Registration No. 1891500, issued on April 25, 1995. Section 8 affidavit accepted; Section 15 affidavit acknowledged; Renewed.

After careful consideration of the evidence of record and the arguments of applicant's counsel and the Trademark Examining Attorney, we **affirm** the refusal to register as to both classes.³

Initially, we reject applicant's argument that the Section 2(d) refusal should be reversed because (quoting from the application) "[t]he mark was previously registered May 29, 2001, under number 2,454,535 by an officer of the company in his individual name, and that officer allowed the registration to expire, which resulted in cancellation of the registration without the knowledge of the other officers of the company or its Board of Directors." Applicant argues that during the course of prosecution of the previous application, the Office made, but then withdrew, a Section 2(d) refusal based on the same registration cited against applicant in the present application. Applicant argues that nothing has changed in the interim that warrants a different result in the present

³ The application includes a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f), which applicant has not withdrawn even though the Trademark Examining Attorney informed applicant that it is unnecessary. Applicant's voluntary Section 2(f) claim does not affect our Section 2(d) determination in this case. *Cf. In re RSI Systems, LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008) (applicant's voluntary disclaimer does not affect determination of Section 2(d) refusal).

application. Applicant argues that it merely seeks to return to the *status quo ante*.

However, the issuance of the prior registration is not determinative or even relevant in the present case. It is settled that our decision must be based solely on our analysis of the evidence of record in this case. Applicant is not entitled to return to the *status quo ante*. See *In re Davey Products Pty Ltd.*, 92 USPQ2d 1198, 1205-06 (TTAB 2009); *In re Ginc UK Ltd.*, 90 USPQ2d at 1472, 1480 (TTAB 2007).⁴

We turn now to the Section 2(d) refusals, starting with the refusal as to the Class 43 services identified in the application as "carry-out restaurants."

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v.*

⁴ We note in passing that, as a factual matter, applicant has presented no evidence (such as USPTO documents from the prior application file) to support its contentions regarding the prosecution history of the prior registration. Moreover, it would appear from applicant's statement in the present application (quoted above) that applicant lacks privity with the prior registrant. However, even if such evidence had been submitted by applicant, it would avail applicant nothing here.

Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In our analysis of the *du Pont* factors, we need consider and weigh only those factors as to which there is pertinent evidence of record. "...[t]he thirteen *DuPont* factors must be considered when they are of record. However, not all of the *DuPont* factors are relevant or of similar weight in every case. Indeed, any one of the factors may control a particular case." *In re Dixie Restaurants, Inc.*, *supra*, 41 USPQ2d 1531 at 1533 (internal citations and quotation marks omitted).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and services in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 at 29 (CCPA 1976). "While it must consider each factor for which it has evidence, the Board may focus its analysis on dispositive factors, such as

similarity of the marks and relatedness of the goods [and/or services]." *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557 at 1559 (Fed. Cir. 2001).

We begin our likelihood of confusion analysis with the second *du Pont* factor, under which we determine the similarity or dissimilarity of applicant's Class 43 services recited in the application as "carry-out restaurants" and the services recited in the cited registration as "restaurants." Our determination under the second *du Pont* factor is based solely on the services as they are recited in the application and in the cited registration, respectively. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re La Peregrina Ltd.*, 86 USPQ2d 1645 (TTAB 2008); *In re Continental Graphics Corp.*, 52 USPQ2d 1374 (TTAB 1999).

Because there are no limitations or restrictions as to the nature or type of the "restaurants" covered by the cited registration, we presume that they encompass and include all types of restaurants, including the "carry-out restaurants" identified in applicant's application. We therefore find that applicant's services are legally identical to the services recited in the cited

registration.⁵ We find that the second *du Pont* factor weighs heavily in favor of a finding of likelihood of confusion in this case as to the Class 43 refusal.

Under the third *du Pont* factor, we consider the similarity or dissimilarity of the trade channels in which, and the classes of purchasers to whom, the services are or would be marketed. Because applicant's services as identified in the application are legally identical to the services as recited in the cited registration, we find that the respective trade channels and purchasers likewise are legally identical. See *In re Jump Designs LLC*, 80 USPQ2d 1370, 1373 (TTAB 2006); *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). For these reasons, we find that the third *du Pont* factor also weighs heavily in favor of a finding of likelihood of confusion as to the Class 43 refusal.

Under the fourth *du Pont* factor, we consider the conditions under which the services are purchased. We presume and find that the "restaurants" recited in the

⁵ See, e.g., *In re Dixie Restaurants Inc.*, *supra*, 41 USPQ2d 1531 ("restaurant" services legally identical to "restaurant services specializing in Southern-style cuisine"); *Anthony's Pizza & Pasta Int'l Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271 (TTAB 2009) ("restaurant services" legally identical to "restaurant services, namely, eat-in and take-out coal oven pizza and other items"); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104 (TTAB 2007) ("restaurant services" legally identical to "restaurant services featuring bagels as a main entrée").

cited registration would include inexpensive restaurants (including carry-out restaurants). See *In re Opus One Inc.*, 60 USPQ2d 1812 at 1817 (TTAB 2001) (broadly-identified "restaurant services" "must be presumed to encompass inexpensive or moderately-priced restaurant services," not just expensive restaurants). We find that restaurants in general, including carry-out restaurants, are or could be patronized by ordinary consumers, including impulse purchasers, who would exercise at most only a normal degree of care in identifying and distinguishing source based on the service marks used by the restaurants. See *Jansen Enterprises Inc. v. Rind, supra*, 85 USPQ2d 1104, 1108. For these reasons, we find that the fourth *du Pont* factor weighs in favor of a finding of likelihood of confusion in this case as to the Class 43 refusal.

We turn finally to the first *du Pont* factor, under which we determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc., supra*.⁶

The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a

⁶ We note that this factor is the only one as to which applicant presented any argument in its briefs.

side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Moreover, because applicant's services are legally identical to the registrant's services, the degree of similarity between the marks necessary to support a conclusion that confusion is likely declines. *See Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

To review, the cited registered mark is **IL VICINO**, in standard character form. Applicant's mark is depicted below:



We find, first, that the dominant feature of applicant's mark as an indication of source is the literal or word element of the mark, i.e., VICCINO'S. We also find

that the word VICINO is the dominant feature of the registered mark IL VICINO.

It is settled that although the marks at issue must be considered in their entireties under the first *du Pont* factor, one feature of a mark may contribute more than the others to the mark's significance as an indication of source, and it is not improper to give more weight to this dominant feature in our determination of the commercial impression created by the mark and in our comparison of the marks at issue. See *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

When considering a mark comprised of both a word element and a design element, often it is the word element that will be the dominant feature in the source-indicating significance of the mark. *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). This is especially so in cases where the mark is used in connection with restaurant services. See, e.g., *In re Dixie Restaurants, supra*, 41 USPQ2d 1531, 1534 (word portion of mark tends to be dominant feature in marks used in connection with restaurant services "because restaurants are often recommended by word of mouth and referred to orally, [so] it is the word portion of applicant's mark which is more

likely to be impressed on the consumer's memory"); *In re Appetito Provisions Co. Inc.*, *supra*, 3 USPQ2d 1553, 1554 ("The principle is especially important in cases involving restaurant services in view of the propensity of persons to try restaurants based on word-of-mouth recommendations").

In this case, we find that the dominant feature of applicant's mark as an indication of source is the word VICCINO'S. The pizza design element of applicant's mark (integrated into the mark as the "O" and the apostrophe in the word VICCINO'S) certainly contributes to the visual impression of the mark, but we find that it also is highly suggestive because it informs purchasers that applicant's carry-out restaurants feature pizza as a menu item.⁷ It is the word VICCINO'S that purchasers, with their imperfect recollections, would use as their primary means of

⁷ This case is similar to our recent decision in *Anthony's Pizza & Pasta Int'l Inc.*, *supra*, 95 USPQ2d 1271, where the design element of the mark (a pizza oven bearing the disclaimed words COAL FIRED PIZZA, depicted below) served as the letter "A" in ANTHONY'S but was found to be of lesser source-indicating significance than the word ANTHONY'S as applied to the pizza-related restaurant services at issue.



identifying and recalling the source of the restaurant services. The word VICCINO'S also would be the way that word-of-mouth recommendations to patronize the restaurant (or not to patronize the restaurant) would be made.

We also find that the dominant feature of the registered IL VICINO mark as an indication of source is the word VICINO. Although the word IL appears first in the mark, it is just a two-letter, one-syllable word that purchasers, with their imperfect recollections, are likely to perceive and recall (if they recall it at all) as merely an introduction to the longer and more prominent word VICINO.

In short, we must and shall consider applicant's mark and the cited registered mark in their entireties. However, we find that the word VICCINO'S is the dominant feature of applicant's mark as an indication of source, and we find that the word VICINO likewise is the dominant feature of the cited registered mark as an indication of source. We therefore accord greater weight to these dominant features of the marks as we compare the marks in their entireties under the first *du Pont* factor.

Comparing the two marks in terms of appearance, we find that the marks look different in that the word "IL" appears at the start of registrant's mark, the pizza design

element appears in applicant's mark to form an apostrophe and "S", and VICCINO'S has two "C"s versus the one "C" in IL VICINO. However, we find that these points of dissimilarity are counter-balanced by the basic visual similarity of the marks which arises from the presence at the heart of the marks of the same letters in the same order, i.e., VIC followed by INO.⁸

In terms of sound, we find that the marks are highly similar. It is settled that there is no "correct" pronunciation of marks. See *Edwards Lifesciences Corp. v. Vigilanz Corp.*, 94 USPQ2d 1399 (TTAB 2010); *Central Industries Inc. v. Spartan Chemical Co. Inc.*, 77 USPQ2d 1698 (TTAB 2006). Applicant's mark ends with an "s" sound, but apart from that the dominant words VICINO and VICCINO'S could readily be pronounced the same way by purchasers. The cited registered mark includes the opening short syllable "IL," but we find that to be an insufficient basis for distinguishing the marks in their entireties in terms

⁸ Contrary to applicant's argument, the font or stylization of the lettering in applicant's mark is not a basis for distinguishing the marks visually because the registrant's mark is registered in standard character form, which entitles the registrant to depict the mark in any reasonable manner of lettering, including, we find, the minimally-stylized lettering employed by applicant's mark. See *In re RSI Systems, LLC*, 88 USPQ2d 1445 (TTAB 2008).

of sound given the identical nature of the following three syllables of the dominant words VICCINO'S and VICINO.

In terms of connotation or meaning, we find (as applicant argues) that applicant's mark VICCINO'S has no specific meaning. There is some evidence that IL VICINO is Italian for "the neighbor," but there is no evidence that the ordinary American purchaser would "stop and translate" the mark from Italian to English. See *Palm Bay Imports, supra*, 73 USPQ2d 1689, 1696 (improbable that relevant purchasers would "stop and translate" the French word VEUVE into the English word WIDOW.) We find that neither mark has a straightforward connotation or meaning which purchasers might use to distinguish the marks.

In terms of commercial impression, we find that applicant's mark, as applied to applicant's services, gives the impression of the name of an Italian restaurant (which serves pizza) named after someone with the Italian-looking name VICCINO. Registrant's mark likewise gives the impression of being an Italian restaurant due to the Italian-looking words IL VICINO.

Comparing the marks in their entireties in terms of appearance, sound, connotation and commercial impression, we find them to be similar, due primarily to the similarity in the way the marks sound. It is settled that "in a

particular case, any one of these means of comparison may be critical in finding the marks to be similar." *Edwards Lifesciences, supra*, 94 USPQ2d 1399 at 1409. See also *Central Industries Inc., supra*, 77 USPQ2d 1698, 1701 ("What stands out in the comparison between the marks ICE SHINE and ISHINE (stylized) is the similarity in sound"). We find in this case that the similarity in sound is particularly significant because the marks are used in connection with restaurant services which, as noted above, are often recommended by word-of-mouth.

Finally, as noted above, where the respective marks are used in connection with identical services, as they are in this case, the degree of similarity between the marks which is necessary to support a finding of likelihood of confusion declines. We find that the degree of similarity between applicant's mark and registrant's mark suffices to support a finding that confusion is likely to result from use of the marks in connection with the identical restaurant services involved in this case.

For these reasons, when we consider the marks in their entirety, we find that the first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Considering and weighing all of the evidence of record as it pertains to the relevant *du Pont* factors, we conclude

that a likelihood of confusion exists. Weighing heavily in favor of a finding of likelihood of confusion are the facts that the services are identical, the trade channels and purchasers are identical, and the services would be purchased by ordinary consumers exercising only an ordinary degree of care (and possibly on impulse). Given these facts, we find that the marks are sufficiently similar that source confusion is likely. We are not persuaded by applicant's arguments that the marks are dissimilar, and we certainly are not persuaded by applicant's argument that the marks are so dissimilar that the first *du Pont* factor by itself outweighs all of the facts under the other *du Pont* factors which weigh in favor of a conclusion that confusion is likely.

Accordingly, we conclude that confusion is likely. To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts against applicant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

We therefore affirm the Section 2(d) refusal as to Class 43.

We turn now to the Section 2(d) refusal as to Class 39.

We start with the second *du Pont* factor (similarity or dissimilarity of the services. All of the legal principles regarding the second *du Pont* factor which were discussed above in connection with the Class 43 Section 2(d) refusal apply to the Class 39 refusal as well.

Applicant's Class 39 services are recited in the application as "delivery of food by restaurants." The services recited in the cited registration are "restaurants." The Trademark Examining Attorney has made of record approximately twenty third-party use-based registrations which include in their recitations of services both restaurant services and delivery of food by those restaurants. Although such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the services listed therein are of a kind which could be marketed by a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). Based on this evidence (and on the fact that applicant itself offers both restaurant services and

delivery services), we find that the respective services are related, and that the second *du Pont* factor weighs in favor of a finding that conclusion is likely.

We likewise find that the trade channels and purchasers of the respective services are the same or overlapping, and that the third *du Pont* factor therefore weighs in favor of a finding of likelihood of confusion.

We also find that the purchasers of the respective services would be ordinary consumers exercising only a normal degree of care. The fourth *du Pont* factor therefore weighs in favor of a finding of likelihood of confusion.

Under the first *du Pont* factor, and as discussed above in connection with the Class 43 refusal, we find that the marks are similar when considered in their entirety in terms of appearance, sound, connotation and commercial impression. The first *du Pont* factor therefore weighs in favor of a finding of likelihood of confusion.

Considering and weighing all of the evidence of record as it pertains to the relevant *du Pont* factors, we find that a likelihood of confusion exists as to applicant's Class 39 services. Accordingly, we affirm the Section 2(d) refusal as to Class 39.

Ser. No. 77472394

Decision: The Section 2(d) refusal as to Class 43 is affirmed. The Section 2(d) refusal as to Class 39 is affirmed.