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Subject: U.S. TRADEMARK APPLICATION NO. 78934642 - CARMINE'S -  
27471.001

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# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 78/934642

**MARK:** CARMINE'S



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** Carmine's Broadway Feast Inc.

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

27471.001

**CORRESPONDENT E-MAIL ADDRESS:**

## **EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the trademark examining attorney's final refusal to register the stylized mark CARMINE'S for "Restaurant and bar services, banquet services, catering services and restaurant take-out services" on the ground of likelihood of confusion, mistake or deception under Trademark Act Section 2(d), 15. U.S.C. §1052(d), with the mark in U.S. Registration No. 1444609 for CARMINE'S (in stylized form) for "Restaurant Services" and U.S. Registration No. 2864349 CARMINE'S RESTAURANT (& design) for "Restaurant Services". It is respectfully requested that this refusal be affirmed.

### **I. STATEMENT OF FACTS**

On July 21, 2006, applicant filed this application applying to register on the Principal Register the stylized mark CARMINE'S for "Restaurant and bar services, banquet services, catering services and restaurant take-out services" in Class 43.

On December 26, 2006, the first Office action was issued. The first Office action refused registration under Section 2(d) on the ground that the mark, when used on or in connection with the identified services, so resembles the mark in U.S. Registration Nos. 1444609, 3112007, 2864349, and 2403390 as to be likely to cause confusion, to cause mistake, or to deceive.

On October 2, 2008, the trademark examining attorney issued a Final Office action. In the Final Office action, the trademark examining attorney refused registration under

Section 2(d) with respect to Registration Nos. 1444609 and 2864349. The Section 2(d) with respect to Registration Nos. 3112007 and 2403390 was withdrawn.

On June 8, 2009, the trademark examining attorney denied applicant's Request for Reconsideration of the Section 2(d) refusal.

Applicant now files this appeal.

## II. ISSUE

The issue on appeal is whether applicant's mark, when used on or in connection with the identified services, so resembles the marks in U.S. Registration Nos. 1444609 and 2864349 as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Section 2(d).

## III. ARGUMENT

### **THE MARKS OF THE APPLICANT AND THE REGISTRANT ARE CONFUSINGLY SIMILAR AND THE SERVICES ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION OR MISTAKE UNDER SECTION 2(d) OF THE TRADEMARK ACT.**

Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark, that it is likely, when applied to the goods or services, to cause confusion, or to cause mistake or to deceive. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the similarity of the goods and services. The overriding concern is to prevent buyer confusion as to the source of the goods and services. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

#### **A. THE SERVICES OF THE PARTIES ARE IDENTICAL IN PART AND ARE OTHERWISE CLOSELY RELATED**

The 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, they need

only be related in some manner, 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).

The applicant identified the following services: "Restaurant and bar services, banquet services, catering services and restaurant take-out services."

Registrant in U.S. Registration Numbers 1444609 and 2864349 identified "Restaurant Services".

In the present case, the services are identical in part as both applicant and registrant identified restaurant services. The remaining services are highly related. Applicant's bar, banquet, catering and restaurant take-out services are highly related to registrant's restaurant services. The evidence of record clearly shows that services identified by the applicant and the registrant are of the type that emanate from a single source. For instance, Ligonier Tavern offers restaurant services as well as banquet, catering, and restaurant take-out services. *See* web pages attached to Office Action dated October 2, 2008 from Ligonier Tavern at <http://ligoniertavern.com> (pages 2-8 on TICRS) (stating *e.g.*, "The Ligonier Tavern is a full service restaurant in a turn-of-the-century Victorian house located in beautiful, historic downtown Ligonier, PA....The Tavern is much more than just a restaurant! We offer banquet rooms for up to 275 guests, a catering service, an in-house bakery and Takers, where you can get quality take-out meals for your family in a hurry!").

Similarly, Giannilli's offers restaurant, banquet, catering, and restaurant take-out services. *See* web pages attached to Office Action dated October 2, 2008 from Giannilli's at <http://www.ginogiannillis.com> (pages 9-11 on TICRS) (stating *e.g.*, "At Giannilli's II, great food and great service go hand in hand. Whether you spend an evening with us in our Home Style Italian Restaurant and Lounge, enjoy our take out and delivery service, or take advantage of our exceptional wedding and event menus, Giannilli's II welcomes you warmly.... We cater to any event, large or small, formal or informal, your place or ours" and "Our Banquet Hall is Ideal for: Weddings").

Further, Espresso Café & Restaurant, Pasta Luna Italian Restaurant, Vinny's Italian Grill and Pizzeria, Warm Fork Restaurant, Marios Italian Steakhouse & Catering, Spumoni's Restaurant, Green Mill Restaurant, Jolly Roger Restaurant & Bar, Mackey's American Pub, New Delhi Restaurant, Arrowhead Sports Grill, and Sweet Basil Restaurant & Bar offers services identified by applicant and registrant. *See* web pages attached to Office Action dated October 2, 2008 (pages 12-52 on TICRS). This evidence establishes that consumers are frequently exposed to restaurant, bar, banquet, catering, and restaurant take-out services being offered together under the same mark from the same entity. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *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 §1207.01(d)(iii).

The evidence of record also shows that bar services, banquet services, catering services and restaurant take-out services are within the registrant's normal fields of expansion. Expansion of trade should be considered when determining whether the registrant's services are related to the applicant's services. TMEP §1207.01(a)(v); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1584 (TTAB 2007). The examiner notes that registrant in Registration Number 1444609 offers the catering and restaurant take-out services identified by applicant. *See* web pages attached to Office Action dated October 2, 2008 (pages 54-56 on TIGRS) and web pages attached to Reconsideration letter dated June 8, 2009 (pages 9-11 on TIGRS). Likewise, the registrant in Registration Number 2864349 offers the bar, banquet, catering and restaurant take-out services identified by applicant. *See* web pages attached to Office Action dated October 2, 2008 (pages 57-61 on TIGRS) and web pages attached to Reconsideration letter dated June 8, 2009 (pages 2-8 on TIGRS).

Notably, the applicant does not dispute the relatedness of the services in its brief.

If the services of the respective parties are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

## **B. THE MARKS HIGHLY SIMILAR**

The examining attorney must compare the marks for similarities in sound, appearance, meaning or connotation. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §1207.01(b).

Applicant seeks to register the mark CARMINE'S in stylized form.

Registrant in Registration Number 1444609 has registered the mark CARMINE'S also in stylized form. Registrant in Registration Number 2864349 has registered the mark CARMINE'S RESTAURANT (& design)

In the present case, the applicant's mark CARMINE'S is highly similar to the registered mark CARMINE'S and CARMINE'S RESTAURANT (& design) because the marks are similar in appearance, sound, and commercial impression.

The marks sound similar because the marks would be pronounced CARMINE'S. The term CARMINE'S is more likely to be impressed on the consumer's memory because restaurants are often recommended by word of mouth. *See In re Dixie Restaurants*, 105 F.3d 1405, 1407 (Fed. Cir. 1997) (stating "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"). Thus, the term CARMINE'S is likely to be the term that customers remember when they refer to applicant's and registrant's establishments.

Although similarity in sound alone may be sufficient to support a finding of likelihood of confusion, the marks are also similar in appearance. *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980). Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark, here the dominant term CARMINE'S. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii).

With respect to Registration Number 1444609, although that mark is in a different stylization from applicant's mark, the marks create the same commercial impression. The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

With respect to Registration Number 2864349, although that mark also contains the term RESTAURANT, that term is generic and therefore disclaimed. 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). Additionally, although that mark also contains a design, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987);

*Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729, 735 (TTAB 1976); TMEP §1207.01(c)(ii).

Here, the dominant feature of the marks is CARMINE'S. The difference in stylization in Registration Number 1444609 and the design element and the term RESTAURANT in Registration Number 2864349 is insufficient to distinguish the marks in this case.

### **C. APPLICANT'S ARGUMENTS ARE NOT PERSUASIVE**

Applicant contends that there is no likelihood of confusion because Carmine is a common name. *See* Applicant's Appeal Brief at 10. Specifically, applicant argues the following:

“Carmine” is a commonly used Italian first or given name. *815 Tonawanda Street Corp. v. Fay's Drug Co., Inc.*, 6 USPQ 2d 1284 (2d. Cir. 1998) (FAY'S is widely perceived as the possessive form of a common first name of a woman and hence is a personal name entitled to a narrow scope of protection, unless secondary meaning is shown). Thus, the name “Carmine”, in and of itself, is entitled to a narrow scope of protection.

*Id.* This argument is not persuasive. First, contrary to applicant's contention, none of the registered marks is merely descriptive by virtue of it being a given name such that secondary meaning is required. Given name marks (so long as they are not primarily merely surnames) are deemed to be inherently distinctive and are registrable on the Principal Register without a claim of acquired distinctiveness under Section 2(f). The two cited registrations at issue are each registered on the Principal Register, and one of them (Registration Number 1444609) is now incontestable.

Second, to the extent that applicant, by calling the registered marks merely descriptive, is challenging the validity of the registrations, such is a collateral attack a valid registration. Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register shall be 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 in connection with the goods or services specified in the certificate. TMEP §1207.01(d)(iv).

Third, the given name CARMINE is not a common first name. The evidence of record shows that only 0.007% of males in the United States are named Carmine. *See* web pages attached to the Final Office action dated October 2, 2008 (page 53 on TICRS).

Fourth, even assuming *arguendo* that Carmine is a common name, the registrant in Registration Number 1444609 has been using the mark since 1983. In those 26 years, the registrant's mark has acquired secondary meaning. Therefore, applicant's use of the same mark for restaurant services would likely cause confusion as to the source of those services.

Applicant argues that “Applicant’s Mark and the Cited Marks have such differing stylizations that a consumer cannot but pay attention to these differences”. See Applicant’s Appeal Brief at 11. Applicant further argues that “Applicant’s Mark is CARMINE’S written in a distinctive stylized Castellar font...the mark in Registration No. 1,444,609 consists of CARMINE’S written in a completely different font.” *Id.* at 11-12. However, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. See *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b). As discussed above, customers would call for CARMINE’S when referring to applicant’s and registrant’s establishments.

Applicant contends that “[n]ot only does the stylization of the word CARMINE’S differ, but the mark in Registration No. 2,864,349 incorporates a distinctive design of a chef holding plates of food and drink. The word ‘CARMINE’S’ is written above this design in a stylized font that does not resemble the font of Applicant’s Mark.” See Applicant’s Appeal Brief at 12. However, when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser’s memory and to be used in calling for the services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729, 735 (TTAB 1976); TMEP §1207.01(c)(ii). Here, customers would refer to applicant’s and registrant’s establishments as CARMINE’S. The examiner further notes that registrant in Registration No. 2,864,349 is referred to as CARMINE’S. See web pages attached to Reconsideration letter dated June 8, 2009 (pages 4 and 8 on TICRS) (stating “At Carmine’s, you’re not restricted to a packaged meal like you might find at some other restaurants” and “Unlike the chain restaurants, every dish we offer is cooked by us, to order here, at Carmine’s. We don’t defrost, microwave or use prepared contents from a bag”).

Even assuming *arguendo* that the stylizations and the designs are able to visually distinguish the marks in Registration Numbers 1444609 and 2864349, both marks are pronounced Carmine’s. Since restaurant recommendations are often provided through word of mouth, consumers would not be aware of the difference in stylizations and designs. See *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (restaurants are often recommended by word of mouth); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987) (noting that “[t]he 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 finding likelihood of confusion between APPETITO & design for Italian sausage and A APPETITO’S for restaurant services). Similarity in sound **alone** may be sufficient to support a finding of likelihood of

confusion. *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975); *see* TMEP §1207.01(b)(iv).

Applicant further argues that there is no likelihood of confusion in this case because the marks create different overall commercial impressions. *See* Applicant's Appeal Brief at 13. Specifically, applicant argues the following:

Calgin, Inc., the registrant of Registration No. 2,864,349, successfully argued that there is no likelihood of confusion between its mark and the mark in Registration No. 1,444,609 because the design element in the mark imparted a very different commercial impression to this mark. The Office accepted this argument. It follows that there is no reason why it should not accept the argument that Applicant's Mark, in its stylized font, is unlikely to be confused with the mark in Registration No. 2,864,349 because of the different overall commercial impressions.

*Id.* This argument is not persuasive. First, prior decisions and actions of other trademark examining attorneys in registering different marks are without evidentiary value and are not binding upon the Office. *See In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); TMEP 1207.01(d)(vi). Here, both applicant's and registrant's mark contain the dominant wording CARMINE'S and the services are identical in part. Second, this Section 2(d) refusal is consistent the Office's prosecution of applicant's application Serial No. 75507285 (which resulted in Registration No. 2764494 for CARMINE'S) for the same stylized CARMINE'S mark in Castellar font. In Serial No. 75507285, the examiner refused registration under Section 2(d) based on the same Registration No. 1444609 for the CARMINE'S against applicant's "sauces, salad dressing, pasta." *See* prosecution of Serial No. 75507285 attached to the Office action dated March 7, 2008 (pages 4-102 and 308-315 on TICRS). Here, the Section 2(d) refusal is even more appropriate because the services are identical.

Applicant argues that the respective marks can co-exist and had co-existed for several years. *See* Applicant's Appeal Brief at 13-14. This argument is not persuasive. First, registrant has not been provided with an opportunity to provide evidence of any actual confusion that it may be aware of. Thus, it is unclear if registrant is aware of instances of actual confusion. Second, the test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. TMEP §1207.01(d)(ii); *e.g.*, *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). 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).

Applicant contends that CARMINE is weak or “highly common” because “there are numerous common law uses of CARMINE/CARMINE’S/CARMINES in the restaurant field, all with differing designs and/or stylizations”. Applicant’s Appeal Brief at 14. In support of its contention, applicant provided a list of fourteen third-party Carmine formative restaurant names. *See id.* at 14-16. However, the evidence of record shows that the CARMINE mark is not weak for restaurant services. There are only three live registered marks comprising of CARMINE for restaurant services and two other pending applications comprising of the term CARMINE for restaurant services owned by Mercato 24011. *See* TARR printouts showing the three live registered marks, applicant’s two pending CARMINE marks, and two pending applications owned by Mercato 24011, Serial Nos. 77065024 and 77064993, attached to the 3/7/2008 Office action (pages 103-122 on TICRS). The two pending Mercato 24011 applications Serial Nos. 77065024 and 77064993 have also been refused under Section 2(d) with respect to the cited marks. *See* prosecution of Serial Nos. 77065024 and 77064993 attached to the Office action dated March 7, 2008 (pages 123-216 and 217-240 on TICRS).

Moreover, the existence of third-party common law usage of CARMINE restaurants showing potentially infringing use cannot justify the registration of another mark that is so similar to a previously registered mark as to create a likelihood of confusion, or to cause mistake, or to deceive. *See* 15 U.S.C. § 1052(d) (granting authority to refuse registration to a trademark that so resembles a registered mark “as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive”); *see Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 1369-70 (Fed. Cir. 2002) (stating “[w]here a likelihood of confusion exists as to the origin of goods traveling under a particular mark, that mark cannot be registered.”). Thus, applicant’s evidence of third-party uses and registrations do not serve to preclude a finding of likelihood of confusion. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973).

Further, assuming *arguendo* that CARMINE is weak or “highly common”, a weak mark is entitled to protection against the registration of a similar mark for identical services. *See Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976) and cases cited therein; TMEP §1207.01(b)(ix).

Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

#### **D. SUMMARY**

Since the marks of the applicant and registrant are highly similar, and the services of the parties are identical in part and are otherwise closely related, there is a substantial likelihood that purchasers would confuse the source of these services.

#### **IV. CONCLUSION**

For the foregoing reasons, the refusal to registration under Section 2(d) of the Trademark Act should be affirmed.

Respectfully submitted,

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