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U.S. PATENT AND TRADEMARK OFFICE

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July 26, 2010
Via Hand Delivery

Office of the General Counsel
United States Patent and Trademark Office
10B20
Madison Building East
600 Dulany Street
Alexandria, Virginia 22314

TRADEMARK PROCESS
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Re: IN RE CARMINE'S BROADWAY FEAST INC.
Mark: CARMINE's (Stylized)
U.S. Application Serial No. 78/934,642
Our Ref: 358535US-257740-303889-35-L

Dear Sir/Madam:

Enclosed and served upon you pleased find Applicant's Notice of Appeal to the United States Court of Appeals for the Federal Circuit. 37 CFR §§2.145(a) and (d)(1) and (2), and 104.2.

Please acknowledge receipt of this letter and Appeal by date stamping and returning a copy of same to the bearer.

Very truly yours,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.

Beth Chapman

Beth A. Chapman

RSB/BAC/cli {3734529_1.DOC}

Enclosure: Applicant's Notice of Appeal to the United States Court of Appeals for the Federal Circuit

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Letter With Copy of Notice of Appeal was served this 26th day of July, 2010, via Hand Delivery, to:

Trademark Trial and Appeal Board
United States Patent and Trademark Office
Madison Building West
600 Dulany Street
Alexandria, Virginia

Beth Chapman

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

IN RE CARMINE'S BROADWAY FEAST INC. Application Serial No. 78/934,642 Appellant	)	NOTICE OF APPEAL

Carmine's Broadway Feast Inc. hereby appeals the Court for review of the February 25, 2010, order of the Trademark Trial and Appeal Board affirming the refusal to register the mark in Application Serial No. 78/934,642. A copy of the Board's February 25, 2010 Order is enclosed.

The United States Patent and Trademark Office, Office of the Solicitor, granted Applicant's request for an extension of time to commence judicial review to July 26, 2010. A copy of Applicant's request showing the Solicitor's approval is attached.

Respectfully submitted,

CARMINE'S BROADWAY FEAST INC.

By: Beth A. Chapman

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Dated: July 26, 2010

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Notice of Appeal was served this 26th day of July, 2010, via Hand Delivery, to:

Office of the General Counsel
United States Patent and Trademark Office
10B20
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Alexandria, Virginia

Beth Chapman

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

Mailed:
February 25, 2010
jtw

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Carmine's Broadway Feast Inc.

Serial No. 78934642

Arlana S. Cohen and Sujata Chaudhri of Cowan, Liebowitz & Latman, P.C. for Carmine's Broadway Feast Inc.

Benji Paradewelai, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Walsh, Cataldo and Taylor, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

Carmine's Broadway Feast Inc. (applicant) has applied to register the mark shown here on the Principal Register for services identified as "restaurant and bar services, banquet services, catering services and restaurant take-out services" in International Class 43.

Applicant filed the application on July 21, 2006 and based the application on its statement that it first used the mark anywhere and first used the mark in commerce in 1992. The application also includes the following statements:

> Color is not claimed as a feature of the mark.
>
> and
>
> The name(s), portrait(s), and/or signature(s) shown in the mark does (sic) not identify a particular living individual.

The Examining Attorney has issued a final refusal under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the grounds that applicant's mark is likely to be confused with the marks in the following two registrations on the Principal Register owned by different parties:

> 1. Registration No. 1444609 for the mark shown here for services identified as "restaurant services" in International Class 42.

The registration issued on June 23, 1987 and it has been renewed.

2. Registration No. 2864349 for the mark shown here for services identified as "restaurant services" in International Class 43, with "restaurant" disclaimed.

The registration issued on July 20, 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 in the application and the cited registrations. *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.").

As to the services, the services in the application and the cited registrations need not be identical to find a likelihood of confusion under Section 2(d). They need only be related in such a way that the circumstances surrounding their marketing would result in relevant customers mistakenly believing that the services originate from the same source. *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Furthermore, in comparing the services and the channels of trade for those services we must consider the services as identified in the application and cited

registrations. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed.").

In this appeal applicant does not argue that the services differ. Obviously, the services are identical, in part, and otherwise closely related. This is an important fact which applicant, by its silence as to the services, tends to discount. In this connection we note that, "… the degree of similarity [between the marks] necessary to support the conclusion of likely confusion declines" when the services are identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1992).

We now turn to the comparison of the marks. In our comparison, we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*

Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

The Board has stated, "… 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).

Furthermore, it is a 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).

More specifically, if a mark includes both a word and a design, then the word is normally accorded greater weight

because it would be used by purchasers to request the goods or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987).

In this case applicant argues:

> Applicant's mark presents a highly stylized form of the possessive form of the given name "Carmine" in a unique font. The Cited Marks also present the possessive form of the given name "Carmine", albeit in very different stylizations that do not resemble the stylization of Applicant's Mark. Since given names are entitled to a narrow scope of protection, the difference in the stylizations of Applicant's Mark, on the one hand, and the Cited Marks, on the other, are sufficient to obviate any likelihood of confusion in this case because consumers are used to distinguishing between these different stylizations.

Applicant's Brief at 9-10.

On the other hand, the Examining Attorney argues that CARMINE'S is the dominant element in applicant's mark and in both of the cited marks, and further that the differences in the displays and designs are not sufficient to distinguish applicant's mark from the cited marks.

We conclude that applicant's mark is highly similar to both cited marks. We concur with the Examining Attorney in finding that CARMINE'S is the dominant element in each of the marks. Furthermore, we reject applicant's unsupported assertion that consumers are conditioned to distinguish between the marks based on the differing displays and

designs. Although we acknowledge, as applicant argues, that word elements are not always dominant over designs, we find no rational reason to depart from that principle of construction here.

Applicant's mark sounds exactly like both cited marks. The presence of the generic term "restaurant" in the second cited mark is not significant, nor does applicant contend that it is. Applicant's mark projects the same connotation and commercial impression as both cited marks, that of a given name, because each of the marks has CARMINE'S as the only distinctive word element. The displays and designs do nothing to alter that connotation or impression. The design of the chef in the second cited mark merely reinforces the connection to restaurant services which also applies to applicant's mark. Finally, the presence of CARMINE'S as the sole distinctive word element in the respective marks also renders the marks similar in appearance.

Consequently, when we compare applicant's mark to each of the cited marks in appearance, sound, connotation and commercial impression, we conclude that applicant's mark is highly similar to both cited marks.

Applicant presents a number of additional arguments related to the marks to support its contention that there

is no likelihood of confusion in spite of the obvious similarity in the word elements of the marks. Either directly or indirectly, those arguments address the general treatment of given names as marks, the strength of the registered marks and the absence of actual confusion. Applicant also argues that actions taken by examining attorneys on earlier applications for marks including CARMINE or CARMINE'S dictate reversal here.

Applicant first argues that, because CARMINE'S is a given name, it is entitled to a narrow scope of protection. The Trademark Act provides that a mark which is "primarily merely a surname" is not registrable on the Principal Register without a showing of acquired distinctiveness.[1] Trademark Act Section 2(e)(4), 15 U.S.C. § 1052(e)(4). Contrary to the implication in applicant's argument, this provision does not apply to given names, such as Carmine. Nor is there any other provision in the Trademark Act which dictates the treatment of given names differently than other marks. Accordingly, we reject applicant's argument

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[1] *In re Martin's Famous Pastry Shoppe, Inc.*, 221 USPQ 364, 367 n.6 (TTAB 1984) ("… surnames have not been regarded as weak marks once statutory surname issues have been resolved. It is a recognized principle of trademark law that when one uses a family surname as part of a trademark, registrability is subject to the same considerations, including the public interest in avoiding source confusion, as apply to other types of marks. See *Ford Motor Co. v. Ford*, 174 USPQ 456 (CCPA 1972); *Lyon Metal Products, Inc. v. Lyon, Inc.*, 134 USPQ 31 (TTAB 1962).").

that the cited registrations provide protection which is narrow in scope merely because the word elements in the registered marks are a given name. *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104 (TTAB 2007) (IZZY'S BROOKLYN BAGELS - KOSHER and Design for restaurant services featuring bagels as a main entrée held likely to be confused with IZZY's for restaurant services). Rather, we will proceed on the basis that both cited registered marks are entitled to all presumptions, including the presumption of validity, accorded registered marks under Trademark Act Section 7(b), 15 U.S.C. § 1057(b).

Applicant also argues that the coexistence of the two cited registrations dictates reversal. In particular, applicant notes that the Examining Attorney who acted on the application which led to the issuance of the second registration cited here, refused registration based on the first registration cited here, and that the Examining Attorney ultimately withdrew that refusal. Applicant thus argues that we should reverse the refusal here, consistent with that earlier action. We reject this argument. In rejecting similar arguments based on actions taken in earlier applications, the Court of Appeals for the Federal Circuit stated, "… the Board (and this court in its limited review) must assess each mark on the record of public

perception submitted with the application. Accordingly, this court finds little persuasive value in the registrations that Nett Designs submitted to the examiner or in the list of registered marks Nett Designs attempted to submit to the Board." *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Thus, we are not bound by the actions that examining attorneys have taken with regard to applications which are not before us, but rather, we must decide this, and every other case, on the record and the particulars of the case before us.

Applicant argues further that CARMINE or CARMINE'S is a weak mark in the restaurant field as a result of use by several third parties, in addition to applicant and the owner's of the cited registrations. To support this argument applicant has provided copies of menus from fourteen establishments which use CARMINE or CARMINE'S as the entire mark or as the principal element in the mark: CARMINE'S ITALIAN RESTAURANT AND BAR (South Pasadena, CA); CARMINE'S (Chicago); CARMINE'S STEAK HOUSE (St. Louis); CARMINE'S RESTAURANT AND BAR (Los Angeles); CARMINE'S (Asbury Park, NJ); IL TERRAZZO CARMINE (Seattle); CARMINE'S ITALIANO (Williamsville, NY); CARMINE'S GOURMET RESTAURANT AND LA TRATTORIA RESTAURANT (Palm Beach Gardens, FL); CARMINE'S ITALIAN-AMERICAN RESTAURANT (Port Jervis, NY);

CARMINE'S CREOLE CAFÉ (Bryn Mawr, PA); CARMINE'S EXPRESS (Rochester, NY); CARMINE'S ON PENN (Denver); CARMINE'S ITALIAN GRILL (Bristol, CT); and CARMINE'S PIZZERIA (Brooklyn, NY).

We do not find this argument, nor this evidence, persuasive. This is unlike cases where the Board has found a term to be weak because it is highly suggestive or descriptive, as applied to the relevant goods or services, based on evidence of third-party use in the relevant field. *Cf. Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1315 (TTAB 2005). Rather, the record, limited as it is, suggests that numerous parties use these marks in distinct geographical areas. There is no basis for us to conclude that the customers of restaurants would view CARMINE as highly suggestive or descriptive of restaurant services. Quite the contrary -- in each example CARMINE or CARMINE'S appears to be the most distinctive element of the mark.

For the record, the case before us is readily distinguishable from the Board's decision in *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477 (TTAB 1987), which applicant cites, on several grounds, among them, the fact that the goods and services were not identical in that case.

The Board has encountered similar circumstances in the restaurant field in many concurrent use proceedings. *See, e.g., Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227 (TTAB 1989); *Meijer, Inc. v. Purple Cow Pancake House*, 226 USPQ 280 (TTAB 1985); *Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048 (TTAB 1982).

In fact, during the prosecution of this application applicant argued that its restaurant services were targeted to consumers in different geographical locations than the restaurant services of the owners of the cited registrations. Applicant's Response of June 28, 2007, at 7. Applicant does not raise this argument directly on appeal. Of course, this argument is not appropriate here because applicant seeks an unrestricted registration. More importantly, both of the two cited registrations are unrestricted. As such, here again, we must accord both cited registrations all presumptions, including the presumption of nationwide rights, dictated by Trademark Act Section 7(b). In fact, in its argument applicant acknowledges that it began use of its CARMINE'S mark well after the issuance of the first cited registration.

Accordingly, we reject applicant's arguments to the effect that the registered marks are weak because other similar marks are allegedly in use.

Applicant also argues that we should find no likelihood of confusion because applicant and the owners of the cited registrations have coexisted peacefully for a substantial period, that is, because there has been no actual confusion between applicant and the owners of both cited registrations. We also reject this argument. The focus of our inquiry must be the likelihood of confusion, not actual confusion. *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992). Also, applicant's assertion that applicant and the owners of the cited registrations operate in different geographical areas belies this argument. Based on this assertion, we have no reason to believe that there has been an opportunity for confusion. More importantly, self-serving arguments of no actual confusion have little or no probative value in an ex parte proceeding. *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). Accordingly, we reject the arguments based on the absence of evidence of actual confusion.

Finally, after considering all evidence and arguments bearing on the *du Pont* factors, we conclude that there is a likelihood of confusion between applicant's CARMINE'S mark in stylized form when used in connection with "restaurant and bar services, banquet services, catering services and

restaurant take-out services" and both cited CARMINE'S and Design marks for "restaurant services."

Decision: We affirm the refusal under Trademark Act Section 2(d) as to both cited registrations.

Attorney Docket No.: 358535US-35-L

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
OFFICE OF THE SOLICITOR

IN RE CARMINE'S BROADWAY FEAST INC.,	)	
Applicant.	)	Appln. Serial No. 78/934,642

APPLICANT'S SUBSTITUTE MOTION TO EXTEND ITS TIME TO COMMENCE JUDICIAL REVIEW PURSUANT TO TRADEMARK RULE 2.145(e)

Applicant's respectfully requests this Motion be substituted for its Motion filed earlier today, April 23, 2010.

Carmine's Broadway Feast Inc. ("Applicant"), pursuant to Trademark Rule 2.145(e), hereby requests the Solicitor extend Applicant's time to seek judicial review by ninety (90) days. TBMP §902.02 (Second Edition rev. 2004).

On February 25, 2010 the Trademark Trial and Appeal Board ("Board") issued an *ex parte* decision in Application Serial No. 78/934,642 affirming the Examining Attorney's refusal to register under Section 2(d) of the Trademark Act, 15 USC §1052(d), based on two cited registrations owned by different parties. Applicant's appeal of the Board decision is due April 26, 2010 pursuant to Trademark Rule 2.145(d)(1)and (2).

Applicant seeks time to review and consider with its counsel the various options for judicial review of the Board decision, particularly in view of the circumstances in this case. Applicant believes it has shown good cause for the requested extension of time to seek judicial review as required by Trademark Rule 2.145(e).

Applicant respectfully requests the Solicitor grant Applicant's Motion to Extend, allowing time to July 26, 2010.

If a fee for this Substitute Motion is required, the Office of the Solicitor is hereby authorized to charge the appropriate fee to Deposit Account No. 50-2014.

If the Solicitor's Office has questions, please contact the undersigned.

Respectfully submitted,

CARMINE'S BROADWAY FEAST INC.

By: Beth Chapman

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Date: April 23, 2010
RSB/BAC/cli {3741543_1.DOC}

The request for an extension of time to commence judicial review of the TTAB decision in Serial No. 78/934,642 is GRANTED for a period of ninety (90) days, i.e., until July 26, 2010.

Signature: _____
Raymond T. Chen, Solicitor

Date: April 26, 2010