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TTAB

Mailed: May 15, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re Carmine's Broadway Feast Inc.*

Serial No. 78934642

Beth A. Chapman and Roberta S. Bren of Oblon, Spivak, McClelland, Maier & Neustadt, L.L.P. for Carmine's Broadway Feast Inc.

Before Richey, Deputy Chief Administrative Trademark Judge, Cataldo and Taylor, Administrative Trademark Judges.[1]

Opinion by Richey, Deputy Chief Administrative Trademark Judge:

The Board issued a nonprecedential decision in this matter on February 25, 2010, affirming the Examining Attorney's refusal to register CARMINE'S (and design) sought by Carmine's Broadway Feast Inc. (Applicant) for "restaurant and bar services, banquet services, catering services and restaurant take-out services"

[1] Administrative Trademark Judge Walsh was a member of the original panel on the decision in this case but has since retired.

in International Class 43.[2] The Application was refused under § 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d) as likely to cause confusion with the registered marks CARMINE'S (and design) for "restaurant services" in International Class 42[3] and CARMINE'S RESTAURANT (and design) for "restaurant services" in International Class 43.[4] The Examining Attorney issued the refusal based on both cited registrations.

Applicant appealed the Board's final decision to the U.S. Court of Appeals for the Federal Circuit and, while the appeal was pending, one of the cited registrations,

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[2] Application Serial No. 78934642 was filed under § 1(a) of the Trademark Act of 1946, 15 U.S.C. § 1051(a). The mark that is the subject of the Application is shown below:


Color is not claimed as a feature of the mark and the name does not identify a particular living individual.

[3] Registration No. 1444609; the mark is shown below:


[4] Registration No. 2864349; the mark is shown below:


The word "RESTAURANT" is disclaimed.

Registration No. 2864349, was cancelled[5] and Applicant acquired ownership of the second cited registration, Registration No. 1444609. Applicant and the Under Secretary for Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office (USPTO) submitted a joint motion asking the appellate court to vacate the Board's decision as moot and to remand the matter to the Board for further proceedings. Citing *U.S. Bancorp Mortgage Co. v. Bonner Mall Partnership*, 513 U.S. 18 (1994), the court declined to grant vacatur and remanded the matter to the Board for consideration of Applicant's request for vacatur.[6]

The Supreme Court's decision in *U.S. Bancorp* holds that "mootness by reason of settlement does not justify vacatur of a judgment under review" in an appellate court in light of the strong public interest in legal precedent. However, the decision also acknowledges that "happenstance provides sufficient reason to vacate." *Id.* at 25 n.3. Happenstance may be described as an event that cannot be attributed to any party in the proceeding or that is occasioned by the unilateral action of the prevailing party below. *Id.* at 23. *See also Rolex Watch USA Inc. v. AFP Imaging Corp.*, 107 USPQ2d 1626 (TTAB 2013) (applicant's express abandonment of an application for registration pending appellate review of a Board order dismissing an opposition proceeding frustrated opposer's right to seek review and justified vacating the order). Here, the Applicant's acquisition of one of the registrations

[5] The registration was cancelled on February 25, 2011, because the registrant failed to file an acceptable declaration under § 8 of the Trademark Act, 15 U.S.C. § 1058. Timely filing of an acceptable declaration is required by the statute in order to maintain a registration and, failure to do so, results in cancellation by the USPTO.

[6] *In re Carmine's Feast Inc.*, No. 2010-1528, Order May 27, 2011 (issued as a mandate July 19, 2011).

cited against its Application would not have mooted the appeal in the absence of the second registrant's failure to file the appropriate maintenance documentation. In other words, without the unilateral act of a nonparty, which cannot be attributed to the Applicant, the appeal would not have been mooted.

Given the Applicant's lack of fault, the joinder of the USPTO in seeking vacatur from the appellate court, and the nonprecedential nature of the Board's order at issue, we find vacatur to be merited.

**Decision:** The Board's February 25, 2010 decision in this proceeding is vacated, the proceeding will be terminated in due course and the application shall proceed to registration.