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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78934642
Applicant	Carmine's Broadway Feast Inc.
Applied for Mark	CARMINE'S
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Serial No. 78/934,642

Mark: **CARMINE’S (Stylized)**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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In re Application of	:	
Carmine’s Broadway Feast Inc.	:	EA: Benji Paradowelai
Serial No. 78/934,642	:	Law Office 101
Filed: July 21, 2006	:	
For Mark: CARMINE’S (Stylized)	:	

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**APPEAL BRIEF OF APPLICANT**

This Appeal Brief is filed in response to the Examining Attorney’s final refusal to register Applicant’s Mark CARMINE’S (Stylized) (“Applicant’s Mark”) on the ground of an alleged likelihood of confusion under Section 2(d) of the Trademark Act.

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**STATEMENT OF RECORD**

The record consists of the prosecution history of the present application.

**STATEMENT OF FACTS**

On July 21, 2006, Applicant, Carmine's Broadway Feast Inc., filed the present application to register the mark CARMINE'S (Stylized) (shown below), based on use since at least as early as 1992, for "restaurant and bar services, banquet services, catering services and restaurant take-out services" in Class 43.



On December 26, 2006, the Examining Attorney issued a preliminary refusal to register Applicant's Mark on the ground of likelihood of confusion with four registered marks, owned by four different parties, for "restaurant services." In addition, the Examining Attorney issued advisories regarding two pending applications. Particulars of the four cited registrations and two applications are as follows:

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Cited Mark and Reg/App. No	Registrant/Applicant	Goods/Services
<p>(1) CARMINE'S (Stylized)                      (Reg. No. 1,444,609)</p> 	<p>Carmine's Family                      Restaurant</p>	<p>Restaurant services</p>
<p>(2) CARMINE'S RESTAURANT &amp; Design                      (Reg. No. 2,864,349)</p> 	<p>Calgin, Inc.</p>	<p>Restaurant services</p>
<p>(3) CARMINE CALZONE &amp; Design                      (Reg. No. 2,403,390)</p> 	<p>LKD Enterprises, Inc.</p>	<p>Restaurant services</p>
<p>(4) CARMINE'S PIZZA KITCHEN                      (App. Ser. No. 78/693,474)</p>	<p>The Carmine and Anne                      M. Vento Family Trust</p>	<p>Restaurant services</p>

(5) CARMINE’S BAKERY (Reg. No. 3112007)	Giraldi Management Services, LLC	Bakery desserts; cheesecakes.
(6) CARMINE’S (App. Ser. No. 78/849,374)	Mercato 2401 Inc.	Olive oil and soups Pasta and sauces

Applicant timely filed a response to the preliminary refusal. After considering Applicant’s arguments, the Examining Attorney withdrew the preliminary refusal to register Applicant’s Mark on the ground of likelihood of confusion with (5) and (6) above. The refusal relating to (4) was also withdrawn because the application to register CARMINE’S PIZZA KITCHEN was abandoned. However, the refusals relating to (1)-(3) were maintained. Again, Applicant timely filed a response arguing why these refusals should be withdrawn.

After considering Applicant’s second response, the Examining Attorney issued a final Office action on October 2, 2008. In that Office action, the Examining Attorney withdrew the likelihood of confusion refusal with respect to (3), but again maintained the refusal with respect to (1) and (2). Applicant timely filed a Request for Reconsideration at the Office. Applicant also filed a Notice of Appeal at the Trademark Trial and Appeal Board (“TTAB”).

On June 8, 2009, the Examining Attorney refused Applicant’s Request for Reconsideration. Subsequently, on June 24, 2009, the TTAB issued an order resuming the appeal proceeding and requiring Applicant to file an appeal brief within a period of sixty (60) days from the date of the order.

To sum up the situation as it stands at this time, Applicant's application to register the mark CARMINE'S in a stylized form has been refused registration on the ground of an alleged likelihood of confusion with the two following registered marks, owned by unrelated parties, both covering "restaurant services":

**Registration No. 1,444,609**



**Registration No. 2,864,349**



Notably, Applicant first began using its CARMINE'S (Stylized) mark in connection with the goods covered by its application, namely, "restaurant and bar services, banquet services, catering services and restaurant take-out services", since at least as early as 1992. Applicant has continued to use its mark since then in connection with these services. Applicant also notes that it owns Registration No. 2764494 for the mark CARMINE'S (Stylized) for "beverage glassware" in Class 21 and "clothing, namely, t-shirts and hats" in Class 25. Notably, the stylization of the mark in Registration No. 2764494 is identical to the stylization of the mark in the present application. This registration claims use going back to 1992.

Registration No. 1,444,609 issued on June 23, 1987. Registrant, Carmine's Family Restaurant, alleges first use since May 23, 1987.

Registration No. 2,864,349 issued on July 20, 2004. Registrant, Calgin, Inc., alleges first use since August 1, 1996. The word "restaurant" has been disclaimed apart from the mark in this registration.

Hereinafter, the marks in Registration Nos. 1,444,609 and 2,864,349 are referred to as the "Cited Marks."

### **ISSUE**

The sole issue in this appeal is whether there is a likelihood of confusion between Applicant's stylized mark which includes the given name "Carmine" for the above-noted services, and the Cited Marks, each of which also incorporate the given name "Carmine" in different stylized formats, for "restaurant services."

### **ARGUMENT**

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 differences in the stylizations of Applicant's Mark, on the one hand, and the Cited Marks, on the other, are sufficient to obviate any likely confusion in this case because

consumers are used to distinguishing between these different stylizations. Moreover, coexistence of Applicant's Mark with the Cited Marks for more than a decade makes any confusion between these marks unlikely.

The thirteen factors that determine likelihood of confusion are set out in *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973). *DuPont* set out thirteen evidentiary factors which, when of record, should be considered by the TTAB. *Id.* at 567. The factors relevant to this case are: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression, (2) the number and nature of similar marks in use on similar goods, (3) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion, and (4) any other established fact probative of the effect of use. A consideration of these factors reveals that in the instant case the requisite likelihood of confusion cannot be established.

"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. It follows that when consumers encounter restaurants using the given name "Carmine" (or its possessive

form "Carmines"), they are able to distinguish between these restaurants on the basis of only the differences in fonts and stylizations.

In this case, Applicant's Mark and the Cited Marks have such differing stylizations that a consumer cannot but pay attention to these differences. Applicant respectfully states that the Examining Attorney's analysis that despite the differences in the stylizations of the marks, an average consumer who retains a general rather than a specific impression of trademarks will be confused is erroneous. In fact, in this case, the differences between the stylizations of Applicant's Mark and the Cited Marks create such differing impressions that consumers are unlikely to be confused. Moreover, this is a case in which consumers are conditioned to recognize that restaurant services offered under the same given name "Carmines" (or its possessive form "Carmines") emanate from different sources based on different stylizations.

It is well-settled that in a likelihood of confusion analysis, marks must be considered in their entireties, not dissected or split into component parts and each part compared with other parts. This is so because it is the entire mark which is perceived by the purchasing public, and therefore, it is the entire mark that must be compared to any other mark. *See Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 23 USPQ2d 1945 (Fed. Cir. 1992) and *Franklin Mint Corporation v. Master Manufacturing Company*, 212 USPQ 233 (CCPA 1981).

In this case, Applicant's Mark is CARMINE'S written in a distinctive stylized Castellar font. The mark consists of upper case lettering, with a black border surrounding

each letter. On the other hand, as shown above, the mark in Registration No. 1,444,609 consists of CARMINE'S written in a completely different font. In fact, when a consumer first looks at this mark, he may even think that the mark consists of the made up word "Armine" that is bounded on the left hand side by a letter that resembles a "C", but could merely be a notation of a boundary, and on the right hand side by the letter "S." This is because the fonts of the letters "C" and "S" differ from the font of "Armine." Moreover, the apostrophe in this mark does not even look like an apostrophe. Thus, a consumer may not even realize that the mark is CARMINE'S written in a stylized font.

Notably, the mark in Registration No. 1,444,609 co-exists with yet another mark that incorporates CARMINE'S written in a yet another stylization, *i.e.*, the mark in Registration No. 2,864,349 as shown above. (Applicant notes that the word RESTAURANT in Registration No. 2,864,349 is disclaimed). Not 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. Applicant respectfully states that the dominant element in this mark is not the word CARMINE'S, but the distinctive design of the chef. The design is the center-piece of the mark so that a consumer is likely to focus on the design rather than the word elements of the mark. Moreover, this is not a case in which the design element simply reinforces the word portion of the mark. Thus, the design element makes CARMINE'S RESTAURANT & Design visually distinguishable from Applicant's Mark. *Steve's Ice Cream v. Steve's Hot Dogs*, 3

USPQ 2d (TTAB 1987) (STEVE'S & Design for restaurants featuring hot dogs not likely to be confused with STEVE'S (in block letters) for ice-cream). As shown in **Exhibit B** attached to Applicant's Office action response dated June 26, 2007, 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.

On the other hand, even assuming that the word CARMINE'S is the dominant element in the mark in Registration No. 2,864,349, then Applicant's Mark should be allowed to coexist with the Cited Marks because if the Cited Marks, both with the dominant element CARMINE'S, can coexist then Applicant's Mark, which is visually dissimilar to the Cited Marks, should be allowed to coexist as well.

In fact, Applicant's Mark has co-existed, and continues to co-exist, with the Cited Marks for several years. Applicant's Mark was first used in 1992 and is currently in use. A copy of a printout from Applicant's web site is attached as **Exhibit B** to Applicant's submission dated February 8, 2008. Moreover, registrants of the Cited Marks have allegedly used, and allegedly continue to use, their respective marks. The registrant of Registration No. 1,444,609 alleges use of its mark since May 11, 1983 and the registrant of Registration

No. 2,864,349 alleges use of its mark since August 1, 1996. Thus, Applicant's Mark has coexisted with the Cited Marks for many years. Such coexistence favors Applicant. *G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 1295 (Fed. Cir. 1990) (concurrent use for approximately ten years weighs against a finding of likelihood of confusion).

In addition to these marks, there are numerous common law uses of CARMINE/CARMINE'S/CARMINES in the restaurant field, all with differing designs and/or stylizations, which is not surprising because "Carmine" is a highly common Italian given name. *Miguel Torres, S.A. v. Bodegas Muga, S.A.*, 2006 U.S. App. LEXIS 8945 (Fed. Cir. 2006). In *Miguel Torres*, Applicant submitted evidence of actual use of such third-party uses. The TTAB gave great weight to this evidence because it held that actual use evidence was "quantitatively and qualitatively different" from what is normally encountered in likelihood of confusion cases. *Id.* Similarly, as shown in the menus from different third-party Carmine's restaurants (attached as **Exhibit A** to Applicant's February 8, 2008 submission) different parties listed below use different stylizations of the given name Carmine in connection with their restaurants:

- a. Carmine's Italian Restaurant and Bar located at 424 Fair Oaks Avenue, South Pasadena, CA 91030.
- b. Carmine's located at 1043 N. Rush Street, Chicago, IL 60611.
- c. Carmine's Steak House located at 20 South Fourth Street, St. Louis, MI 63102.
- d. Carmine's Restaurant and Bar located at 10463 Santa Monica Blvd., Los Angeles, CA 90025.

- e. Carmine's located at 162 Main Street, Asbury Park, NJ 07712.
- f. Il Terrazzo Carmine located 411 1<sup>st</sup> Avenue S., Seattle WA 98104.
- g. Carmine's Italiano located at 4715 Transit Road, Williamsville, NY 14221.
- h. Carmine's Gourmet Restaurant and La Trattoria Restaurant located at 2401 PGA Blvd, Suite 172, Palm Beach Gardens, FL 33410.
- i. Carmine's Italian-American Restaurant located at 1483 Route 6, Port Jervis Greenville, NY.
- j. Carmine's Creole Café located at 818 W. Lancaster Ave, Bryn Mawr, PA 19010.
- k. Carmine's Express located at 3872 Lyell Road, Rochester, NY 14606.
- l. Carmine's on Penn located at 92 S. Pennsylvania, Denver, Colorado 80209.
- m. Carmine's Italian Grill, 650 Farmington Ave, Bristol, CT 06010.
- n. Carmine's Pizzeria, 358 Graham Avenue, Brooklyn, NY.

These third-party uses are further evidence that consumers who encounter restaurant names with the given name "Carmine" in different fonts and designs are not confused because no single party can have exclusive rights in the underlying given name "Carmine". Rather each party's rights are limited to the special font and/or design in which they use the name "Carmine" (unless of course, a third-party uses an identical font and/or design or passes itself off as related to the party).

Accordingly, application of the *Du Pont* factors to this case demonstrates that there is no likelihood of confusion between Applicant's Mark and the Cited Marks.

**CONCLUSION**

On a balancing of the *DuPont* factors, there is no likelihood of confusion in this case and Applicant's application should be passed to publication.

Dated: New York, New York  
August 24, 2009

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