

**THIS OPINION IS NOT A
PRECEDENT OF
THE TTAB**

Mailed: December 13, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Top That! Pizza Holding, LLC

Serial No. 85151866

Mark G. Kachigian of Head Johnson & Kachigian for Top That!
Pizza Holding, LLC

Kim Saito, Trademark Examining Attorney, Law Office 102
(Mitch Front, Managing Attorney).

Before Quinn, Shaw, and Greenbaum, Administrative Trademark
Judges.

Opinion by Shaw, Administrative Trademark Judge:

Top That! Pizza Holding, LLC filed an application to
register on the Principal Register the mark TOP THAT! PIZZA
WHERE PIZZA GETS PERSONAL and design, for services
identified as "dine-in and carry-out restaurant featuring
individually topped pizzas" in International Class 43.¹
Applicant has disclaimed PIZZA.

¹ Serial No. 85151866 was filed on October 13, 2010, with
an allegation of a bona fide intention to use the mark in
commerce. An amendment to allege use was filed on November
24, 2010 and accepted.

The examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of a likelihood of confusion with the mark in U.S. Registration No. 3590559 for the mark TOP THIS! in standard characters for "pizza; pizza crust," in international Class 30.²

After the refusal was made final, applicant appealed. The case is fully briefed. Applicant also filed a supplemental brief. For the reasons discussed below, we affirm the refusal to register.

Preliminary Matters.

On October 10, 2012, nearly seven months after the examining attorney filed her brief, applicant submitted a supplemental brief arguing that the recent allowance for publication of an unrelated third-party mark compels a finding that there is no likelihood of confusion between applicant's mark and the mark in the cited registration. The supplemental brief has not been considered for the following reasons.

First, and most importantly, the argument regarding the third-party mark is untimely. The record in an application should be complete prior to the filing of an appeal. After an appeal is filed, if the applicant (or the

² Issued March 17, 2009.

examining attorney) desires to introduce additional evidence, they may request the Board to suspend the appeal and to remand the application for further examination. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). Thus, if applicant desired to submit additional evidence, its recourse was to file a request for remand. See TBMP § 1209.04 (3d ed. 2012). See *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1244 n.4 (TTAB 2010) (registration that issued after notice of appeal and submitted with appeal brief not considered, applicant could have filed a request for remand).

Second, the filing of the supplemental brief has not been authorized by the Board. Supplemental briefs may only be filed by permission of the Board, generally upon resumption of an appeal after remand, and no such permission was requested or given in this instance. See 37 CFR § 2.142(f)(1); TBMP § 1209.01 (3d ed. 2012).

Finally, even if we were to consider the allowance of the identified third-party mark, we are not bound by prior decisions of examining attorneys. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); and *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994).

Accordingly, the supplemental brief has not been considered.

Analysis

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

A. The Similarity or Dissimilarity of the Marks in their Entireties as to Appearance, Sound, Connotation and Commercial Impression

We first consider the similarity or dissimilarity of the marks, comparing the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, USPQ2d 1689, 1692 (Fed. Cir. 2005). "[T]he test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial

Serial No. 85151866

impression so that confusion as to the source of the goods offered under the respective marks is likely to result."

H.D. Lee Co. v. Maidenform Inc., 87 USPQ2d 1715, 1727 (TTAB 2008).

Applicant's mark is TOP THAT! PIZZA WHERE PIZZA GETS PERSONAL with a circular background design as shown below.



where PIZZA gets PERSONAL

Registrant's mark is TOP THIS! in standard characters.

The examining attorney argues that TOP THAT! is the dominant portion of applicant's mark because it comes first in the mark and is the name of the restaurant by which consumers will identify applicant's services. Examining Attorney's Br. at 3. Thus, when applicant's TOP THAT! mark is compared to registrant's TOP THIS! mark, both marks are similar in meaning and commercial impression. In particular, the examining attorney argues that TOP THAT! and TOP THIS! are similar because they share a number of grammatical similarities and because they are both double entendres with the same commercial impression.

Applicant, on the other hand, argues that while its mark "admittedly" shares the same word "top" and an exclamation point with registrant's mark, nonetheless, its mark is distinct in "appearance, sound, and meaning when contrasted - *in its entirety*" to registrant's mark. Applicant's Br. at 4 (emphasis in original). Thus, the presence of "THAT" instead of "THIS", the addition of the circle background design, the word PIZZA, and the phrase WHERE PIZZA GETS PERSONAL, all suffice to distinguish applicant's mark from registrant's mark.

We disagree. One feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("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 consideration of the marks in their entireties.").

We find that TOP THAT! is the dominant feature of applicant's mark. It is the first portion of applicant's mark and is the one most likely to be spoken and remembered by purchasers, especially given the tendency of consumers to shorten marks. *See In re Abcor Dev. Corp.*, 588 F.2d

Serial No. 85151866

511, 200 USPQ 215, 219 (CCPA 1978) (J. Rich, concurring); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). TOP THAT! also appears in a larger typeface than any of the other words in applicant's mark. The other elements of applicant's mark are less significant.

The term PIZZA is less significant because it has been disclaimed and is descriptive of the goods sold in applicant's restaurants. It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), *quoting, In re Nat'l Data*, 224 USPQ at 752 ("Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion").

Similarly, the graphic logo is less significant because design elements are normally given less weight than words which are used by consumers to request the products or services. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 2 USPQ2d 1553, 1554 (TTAB 1987).

Finally, the phrase WHERE PIZZA GETS PERSONAL is less significant because it appears in smaller typeface below the TOP THAT! PIZZA element and merely reinforces the suggestion that consumers can top their own pizzas.

TOP THIS! is the entirety of registrant's mark.

When we compare the dominant feature of applicant's mark with the entirety of registrant's mark, we find that both marks share the same double entendre. That is, both TOP THAT! and TOP THIS! challenge the consumer to "top" or improve upon the pizza, while also suggesting that the consumer can "top" their pizzas with their toppings of choice.³ The substitution of the term "that" in applicant's mark for "this" in registrant's mark does not change the similar connotation or commercial impression. Slight differences in marks do not normally create dissimilar marks. *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985) ("Moreover, although there are certain differences between the [marks' CAYNA and CANA] appearance, namely, the inclusion of the letter 'Y' and the design feature in applicant's mark, there are also obvious

³ Top is defined in part as "**a:** to be or become higher than : overtop <tops the previous record> **b:** to be superior to : excel, surpass **c:** to gain ascendancy over : dominate." *Merriam-Webster Online Dictionary* (2012). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

similarities between them. Considering the similarities between the marks in sound and appearance, and taking into account the normal fallibility of human memory over a period of time (a factor that becomes important if a purchaser encounters one of these marks and some weeks, months, or even years later comes across the other), we believe that the marks create substantially similar commercial impressions").

Despite the similar commercial impression conveyed by the marks, applicant argues that confusion is unlikely nevertheless because "'TOP' is suggestive and should not be given great weight." Applicant's argument is unpersuasive. Although the individual word TOP may have a suggestive or even descriptive connotation when used on pizzas or in connection with pizza restaurants, there is no evidence that the combinations TOP THIS! or TOP THAT! are weak or commonly used in connection with any of the goods or services at issue. On the contrary, the double entendres create noticeable and arbitrary marks.

We conclude that, although the presence of additional matter in the applicant's mark necessarily creates differences in pronunciation if the entire mark is spoken, both marks convey the same double entendre and, when the marks are viewed in their entirety, they are similar in

terms of appearance, connotation and commercial impression. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 1347-48, 94 USPQ2d 1257, 1260-61 (Fed. Cir. 2010) (if the dominant portion of both marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences).

This *du Pont* factor favors a finding of likelihood of confusion.

B. The similarity or dissimilarity and nature of the goods and services described in the application and registration.

In an *ex parte* appeal, likelihood of confusion is determined on the basis of the goods and services as they are identified in the application and the cited registration. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976). *See also Octocom Sys., Inc. v. Houston Computers Servs. 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 set forth in the application").

The examining attorney argues that registrant's pizza and pizza crust are closely related to applicant's restaurants featuring pizza because the goods and services

travel in the same channels of trade. To support the refusal, the examining attorney submitted copies of twenty-two third-party registrations that serve to suggest that pizza and restaurant services may emanate from a single source. The following are representative:

- **Reg. No. 2842933** for the mark PRIMA PIZZA for, *inter alia*, "pizza" in International Class 30 and "restaurant and carry out restaurant services featuring pizza" in International Class 43;
- **Reg. No. 2920889** for the mark PINCH for, *inter alia*, "pizza" in International Class 30 and "restaurant services" in International Class 43;
- **Reg. No. 3020846** for the mark GROTTA PIZZA and design for "pizza" in International Class 30 and "restaurant services" in International Class 43;
- **Reg. No. 3176503** for the mark CAMPI'S PIZZA for, *inter alia*, "pizza" in International Class 30 and "restaurant services featuring pizza" in International Class 43; and
- **Reg. No. 3473869** for the mark PIEZONI'S for, *inter alia*, "prepared foods, namely, fresh and frozen pizza" in International Class 30 and "restaurant services" in International Class 43;

Although such third-party 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 they are based on use in commerce and serve to suggest that the goods and services identified therein are of a kind which may emanate from a single source under a single mark, i.e., that it is common for the same entity to provide prepared pizzas and

restaurant services under the same mark. See *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); and *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The examining attorney also has made of record several excerpts from third-party websites to show that a number of restaurants also market frozen pizza under the same mark:

- nickbayless.com - The website of a Chicago restaurant business advertising the "Frontera" restaurant and also selling frozen pizza under the same mark;"
- wolfgangpuck.com - A website advertising the "Wolfgang Puck" restaurants and also advertising frozen pizza under the same mark;" and
- cpk.com - A website advertising the "California Pizza Kitchen" restaurants and also advertising frozen pizza under the same mark."

Applicant does not seriously contest that pizza and a "dine-in and carry-out restaurant featuring individually topped pizzas" are not related. Rather, applicant argues that applicant's services and registrant's goods travel in different channels of trade because registrant's pizza and pizza crust "are sold wholesale to restaurants for their use in preparing food or in retail stores to consumers to take home to prepare." Applicant's Br. at 7. This argument is unavailing.

In considering the scope of the cited registration, we must look to the registration itself, and not to extrinsic

evidence about the registrant's actual goods, customers, or channels of trade. *In re Elbaum*, 211 USPQ at 640.

Because there are no limitations as to channels of trade or classes of purchasers in the description of goods in the cited registration, it is presumed that registrant's goods move in all channels of trade normal for those goods, and that they are available to all classes of purchasers for those goods. See *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

The third-party registrations and internet website evidence demonstrate that pizza and restaurant services are closely related and travel in the same channels of trade.

This *du Pont* factor also favors a finding of likelihood of confusion.

Accordingly, we find that purchasers familiar with registrant's "pizza" and "pizza crust" offered under the mark TOP THIS! would be likely to mistakenly believe, upon encountering applicant's mark, TOP THAT! PIZZA WHERE PIZZA GETS PERSONAL and design, for a "dine-in and carry-out restaurant featuring individually topped pizzas," that the

Serial No. 85151866

goods and services originated from or are associated with
or sponsored by the same entity.

Decision: The refusal to register under Section 2(d)
of the Trademark Act is affirmed.