

ESTTA Tracking number: **ESTTA558041**

Filing date: **09/05/2013**

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

Proceeding	85449899
Applicant	SBE Licensing, LLC
Applied for Mark	GREYSTONE MANOR
Correspondence Address	LEE J EULGEN NEAL GERBER & EISENBERG LLP 2 N LASALLE STREET , SUITE 1700 CHICAGO, IL 60602-4000 UNITED STATES trademarks@ngelaw.com, leulgen@ngelaw.com, temanuelson@ngelaw.com
Submission	Request for Reconsideration
Attachments	Motion for Reconsideration (Serial No. 85449899).pdf(236213 bytes)
Filer's Name	Lee J. Eulgen
Filer's e-mail	leulgen@ngelaw.com,ssmith@ngelaw.com,temanuelson@ngelaw.com, trademarks@ngelaw.com
Signature	/Lee J. Eulgen/
Date	09/05/2013

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

In re Application of SBE Licensing, LLC

Serial No.: 85449899

Filing Date: October 17, 2012

Mark: GREYSTONE MANOR

**MOTION FOR RECONSIDERATION OF
BOARD'S FINAL ORDER AFFIRMING FINAL REFUSAL TO REGISTER**

TABLE OF CASES

CASES	Page(s)
<i>Nat'l Cable Television Ass'n., Inc. v. Am. Cinema Editors, Inc.</i> , 937 F.2d 1572, 1579, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991)	2
<i>Shen Mfg. Co. v. Ritz Hotel Ltd.</i> , 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004)	3

Pursuant to TBMP §1217, applicant SBE Licensing, LLC (“Applicant”) hereby submits the instant Motion for Reconsideration of the Board’s August 5, 2013 order (the “Order”) affirming the examining attorney’s final refusal on the ground that, based on the evidence and the prevailing authorities, the Order affirming the Examiner’s refusal to register the GREYSTONE MANOR mark at issue pursuant to Section 2(d) of the Trademark Act on the ground that it is likely to be confused with the registered mark GREYSTONE GRILL was reached in error. The Board focused its inquiry on the relatedness of the respective owners’ services and the similarity of the respective marks. However, as set forth below and in its appellate brief, Applicant maintains that there is no prospect of confusion between the two marks, particularly given that (i) while some third parties may offer both restaurant and nightclub services, that simply is not the case with the marks at issue here, and (ii) the senior third-party registration for GRAYSTONE COFFEE COMPANY for use in connection with the identical services in the same class did not prevent the registration of the GREYSTONE GRILL mark, further punctuating that Applicant’s Mark and services are sufficiently distinct so as to avoid confusion. Applicant accordingly requests that the Order be reversed and that the subject mark be reversed and that Applicant’s mark be permitted to proceed to publication on the Principal Register.

I. There is No Prospect Of Confusion Given The Mark Owners’ Respective Uses In A Real World Setting.

The linchpin of both the final refusal and the Board’s final order affirming that refusal is an insistence that confusion is likely because the respective mark owners’ services are “closely related,” which the Board determined based on “the examining attorney’s submission of web pages reflecting the offering of restaurant and nightclub services in the same establishments.” (Order, at p. 5.) However, the record establishes that that simply is not the case here. The owner of the Cited Mark (“Registrant”) has registered and uses that mark only with restaurant services. (*See Applicant’s Motion for Reconsideration of Final Refusal*, at Ex. 3.) On the other hand, Applicant seeks to register its Mark with nightclub services in Class 41. Live music is at the heart of Applicant’s nightclub services, and is the reason that nightclub services are in Class 41 (covering a variety of entertainment services) as opposed to Class 43

(covering, *inter alia*, restaurant services). The record confirms that live music is a central component of Applicant's nightclub services. (*See Id.*, at Ex. 2.) However, web site printouts also show that live music is not offered at the GREYSTONE GRILL restaurant. (*See Id.* at Ex 3.) This fundamentally differentiates the respective owners' uses. Hence, the fact that some third parties may offer both nightclub services and restaurant services under the same mark is of no moment here because in this "real world" instance, the Registrant provides only restaurant services in Class 43 under the Cited Mark, while Applicant provides nightclub services in Class 41 under its Mark.¹ *Nat'l Cable Television Ass'n., Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991) ("The determination of likelihood of confusion involves, to the extent possible, an evaluation of what happens in a real world setting") (emphasis added). Therefore, the simple fact is that the respective mark owners' services are not closely related but are distinct.

Moreover, the GRAYSTONE COFFEE COMPANY mark (Reg. No. 2780042) and GREYSTONE GRILL mark co-exist on the Federal Register even though those registrations cover identical "restaurant services" in Class 43. The fact that the senior registration for the GRAYSTONE COFFEE COMPANY mark did not prevent the registration of the GREYSTONE GRILL mark for the identical services further punctuates that there should be no objection to registering Applicant's Mark with distinct nightclub services. For these reasons as well as those set forth in Applicant's appellate brief, Applicant's Mark is not likely to be confused with the Cited Mark, and should be permitted to proceed to publication on the Principal Register.

II. The Respective Marks Are Sufficiently Different In Appearance, Sound, Connotation and Commercial Impression.

In its Order, the Board concluded that Applicant's Mark is similar in sound, appearance and meaning to the Cited Mark because both marks share the term GREYSTONE, which the Board reasoned

¹ Indeed, businesses providing restaurant services occasionally provide myriad other services, from theater to video gaming and amusement services to off-track betting. It can hardly be argued that those services are "closely related" simply because a minority of third-party businesses may provide both.

was the first and dominant term of both marks. (Order, at p. 10-11.) However, the first and dominant term of the GRAYSTONE COFFEE COMPANY mark (Reg. No. 2780042) is phonetically identical and virtually visually identical to the term GREYSTONE. In addition, apart from the terms GRAYSTONE and GREYSTONE, all additional matter was disclaimed from those marks. Yet, despite the virtual identity of those marks, the senior GRAYSTONE COFFEE COMPANY registration did not prevent the registration of the GREYSTONE GRILL mark even though they both covered the identical “restaurant services.”

In contrast, Applicant’s Mark features the addition of the distinctive term MANOR, and the effect of that distinctive term on consumer perception should not be dismissed.² Indeed, whereas the GRAYSTONE COFFEE COMPANY and GREYSTONE GRILL are for all intent and purposes identical, the term MANOR significantly distinguishes Applicant’s Mark from the Cited Mark in sight, sound, meaning and commercial impression, thereby avoiding any likelihood of confusion. *See, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB’s holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, *inter alia*, THE RITZ KIDS creates a different commercial impression); TMEP § 1207.01(b)(iii) (“Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if ... the marks in their entireties convey significantly different commercial impressions.”) Since the GRAYSTONE COFFEE COMPANY and GREYSTONE GRILL marks used with identical services are not impermissibly similar, Applicant respectfully submits that the sight, sound, meaning and commercial impression of Applicant’s GRAYSTONE MANOR mark are sufficiently different from those of the Cited Mark, particularly since Applicant’s Mark is used with distinct services.

III. CONCLUSION

There is no prospect of confusion between the Mark and the Cited Mark, particularly given that

² The examining attorney withdrew its request for Applicant to disclaim the term MANOR, thereby conceding that that term is a distinctive portion of Applicant’s Mark.

(i) while some third parties may offer both restaurant and nightclub services, that simply is not the case with the marks at issue here, and (ii) the senior third-party registration for GRAYSTONE COFFEE COMPANY for use in connection with the identical services in the same class did not prevent the registration of the GREYSTONE GRILL mark, further punctuating that Applicant's Mark and services are sufficiently distinct so as to avoid confusion. In addition, as set forth above and in Applicant's appellate brief, Applicant's Mark is distinct in appearance, sound, connotation or commercial impression and Applicant and the owner of the Cited Mark operate in separate markets and provide distinct services to sophisticated and discriminating clientele. For at least these reasons, Applicant respectfully submits that the Order was reached in error, and requests that the Order be reversed and that Applicant's Mark be permitted to proceed to publication on the Principal Register.

Date: September 5, 2013

Respectfully submitted,

/Lee J. Eulgen/
Attorney for Applicant

Lee J. Eulgen, Esq.
Sarah E. Smith, Esq.
NEAL, GERBER & EISENBERG LLP
Two North LaSalle Street
Chicago, Illinois 60602
Telephone: 312.269.8000

CERTIFICATE OF TRANSMISSION

I hereby certify that the foregoing **MOTION FOR RECONSIDERATION OF BOARD'S FINAL ORDER AFFIRMING FINAL REFUSAL TO REGISTER** is being electronically transmitted via the Electronic System for Trademark Trials and Appeals ("ESTTA") at <http://estta.uspto.gov/> on the date noted below:

Date: September 5, 2013

By: /Lee J. Eulgen/
One of the Attorneys for Applicant,
SBE Licensing, LLC