

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
September 18, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re SBE Licensing, LLC

—
Serial No. 85449899

—
Lee J. Eulgen of Neal Gerber & Eisenberg LLP for SBE Licensing, LLC.

Emily K. Carlsen, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

—
Before Zervas, Adlin, and Gorowitz, Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

On September 5, 2013, applicant filed a Motion for Reconsideration of the Board's order of August 5, 2013, wherein it affirmed the refusal to register.

In its motion, applicant reasserts the arguments in its appeal brief regarding the relationship between the services and the similarity of the marks.

The general premise underlying a request for reconsideration is that, "based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued. The request may not be ... devoted simply to a reargument of

the points presented in the requesting party's brief on the case.” TBMP Section 543.

Here, applicant’s motion consists of mere reargument. For example, in its appeal brief, Applicant asserts:

The Examiner argues that these services are similar because some businesses in America provide both restaurant and nightclub services under the same name. However, 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 two services are “closely related” simply because a minority of third-party businesses may provide both of those services.

Indeed, “the determination of likelihood of confusion involves, to the extent possible, an evaluation of what happens in a real world setting.” *Nat’l Cable Television Ass’n., Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991) (emphasis added). In refusing to register a mark, the Examiner must show that the services would be “likely to be seen by the same persons under circumstances which would give rise...to a mistaken belief that they originate from or are in some way associated with the same producer” or that the two producers are associated. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010)

Appeal Brief, p. 3-4 (internal citations omitted).

In the request for reconsideration, applicant argues:

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.” 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. 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. 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. *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.

Request for Reconsideration p. 1-2.

In addition to merely rearguing its appeal brief, applicant quotes a portion of *National Cable Television Ass'n* out of context. The quoted passage refers not, as applicant implies, to whether particular services are related, but instead to whether consumers have become conditioned by common third party use of a term to expect that goods or services offered under the term come from different sources. The Federal Circuit's clear holding with respect to services, as explained in our final decision, is that our evaluation must be based on the services as identified in the cited registration and involved application. Final Decision at 3 and cases cited therein. And we have repeatedly held, as explained in the Final Decision at page 4,

that we may consider third party registrations establishing that the services in question are of a kind that may emanate from a single source. The “real world” is not for applicant alone to define.

Applicant also asserts that the cited registration’s co-existence with a third-party registration weighs against a finding of likelihood of confusion. The mark in the cited registration is GREYSTONE GRILL and the mark in the third-party registration is GRAYSTONE COFFEE COMPANY. Applicant’s argument that the co-existence of these registrations weighs against a finding of likelihood of confusion is inapposite in that it presumes that the prior registration of a particular term should be of some persuasive authority in handling later applications involving similar marks. However, we are not privy to the record of the prior proceeding and are bound to make a decision based on the record before us. See *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (CCPA 1973); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); and *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994).

In view of the foregoing, petitioner’s motion for reconsideration is denied.