

**This Opinion is Not a
Precedent of the TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Chicken Pickers, LLC

Serial No. 85593576

David M. Carter of The Van Winkle Law Firm,
for Chicken Pickers, LLC.

Brendan D. McCauley, Trademark Examining Attorney, Law Office 114,
K. Margaret Le, Managing Attorney.

Before Bucher, Wellington and Ritchie,
Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Chicken Pickers, LLC (“applicant”) seeks registration on the Principal Register of the mark **ROCKY’S HOT CHICKEN SHACK** (*in standard character format*) for “restaurant services” in International Class 43.¹

Registration has been finally refused on the ground of likelihood of confusion mistake or deception under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d),

¹ Application Serial No. 85593576 was filed on April 10, 2012, based upon applicant’s claim of first use anywhere and use in commerce since at least as early as January 29, 2009. No claim is made to the exclusive right to use the term “Hot Chicken” apart from the mark as shown.

in view of the registered mark **ROCKY’S** for “restaurant and bar services.”² The examining attorney also refused registration pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), based upon applicant’s failure to comply with the requirement to disclaim the three-word phrase “Hot Chicken ***Shack***” on the ground that this phrase describes the nature of applicant’s restaurant services as a genre of restaurants serving hot chicken within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

After the examining attorney made the refusal final, applicant appealed to this Board. The issues have been fully briefed by applicant and the examining attorney. We affirm both refusals to register.

I. Likelihood of confusion

Our determination of the examining attorney’s refusal to register the mark under Section 2(d) of the Trademark Act is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Company, 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 relatedness of the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

² Registration No. 2611123 issued on August 27, 2002; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

With respect to the services, applicant continues to argue a difference in the services:

The Examining Attorney states that Applicant's services and registrant's services are identical. ... Registrant's services are "restaurant and bar services." It is important to note that registrant's services are not "restaurant services" and "bar services," but the services of restaurant and bar are combined in the identification of services. Thus, it is clear that registrant's mark relates to a full service restaurant as opposed to Applicant's mere restaurant services. Thus, the types of customers and the channels of trade are different.

In response, the examining attorney placed into the record, *inter alia*, copies of screen-prints from registrant's website showing that registrant's menu includes chicken parmigiana, lemon chicken, chicken marsala, chicken scampi, chicken fettuccini, and chicken fettuccini alfredo.

Rocky's Chicken & Pasta	
★ CHICKEN PARMIGIANA \$12.99 Parmesan and Provolone Cheeses melted over a lightly breaded Chicken breast and topped with Marinara Sauce. Served with a side of Penne Pasta Marinara.	PASTA SIENA \$10.99 Sundried Tomato Cream Sauce, Sausage, seasoned Tomato, Banana Peppers, crispy Pepperoni garnish with your choice of Pasta.
PASTA CARBONARA \$11.99 Grilled Chicken breast topped with chopped Bacon, Mushrooms, and roasted Red Bell Peppers tossed in our Garlic cracked Black Pepper Alfredo Sauce, a top a bed of Penne Pasta.	CHICKEN MARSALA \$13.99 Scalloped Chicken sautéed with Mushrooms in a rich Marsala Wine Sauce over Penne Pasta.
★ TORTELLINI ALA PARMA \$11.79 Cheese filled Tortellini with Prosciutto Ham, Mushrooms, Tomatoes and Peas in a rich Lemon Parmesan Cream Sauce.	CHICKEN SCAMPI \$13.99 Sautéed Chicken breast, Broccoli, sun-dried Tomatoes and Red Pepper Flakes in a light White Wine Cream Sauce tossed with Penne Pasta.
★ LINGUINI ROSA \$12.99 Tender grilled Chicken, Italian Sausage, roasted Red Peppers, Garlic and diced Tomatoes tossed with Linguini in a fresh Herb and Tomato Cream Sauce.	CHICKEN FETTUCCINI Half \$8.99 / Whole \$12.49 Rich blend of Asiago Cheese and Cream Sauce tossed with Fettuccini Pasta and topped with Grilled Chicken.
ROCKY'S LEMON CHICKEN \$12.99 Lemon spiced Chicken breast sautéed with Mushrooms, Capers, and Artichoke Hearts over Penne Pasta.	Alfredo Only Half \$6.99/Whole \$10.49 Shrimp \$13.99 Salmon \$14.99 Broccoli and Mushroom \$10.99 Shrimp and Scallops \$14.99
PASTA PRIMAVERA \$10.99 A Vegetarian Delight! A perfect mix of Carrots, Zucchini, Broccoli, roasted Red Pepper and Onions tossed in a light sauce. Choose your own pasta.	

They are all delicious but these are our favorites!

CHICKEN FETTUCCINI ALFREDO \$8.29 Rich blend of asiago cheese and cream sauce tossed with fettuccini pasta and topped with grilled chicken.
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Furthermore, the examining attorney argues that we must assume from the respective recitations of services that applicant's "restaurant services" are legally identical to registrant's services as recited in its "restaurant and bar services." We agree that as far as this Board is concerned, these are legally identical services, and moreover, we must presume that the respective trade channels are the same and that applicant and registrant are marketing to the same classes of ordinary

customers. Accordingly, we conclude without further discussion that *du Pont* factors two, three and four all favor a finding of likelihood of confusion.

As to the marks, we examine the similarities and dissimilarities of the marks as to their appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In situations such as the present case, where the marks appear on legally identical services, the degree of similarity between the marks that is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Nonetheless, applicant argues that the examining attorney has violated the anti-dissection rule with his focus on the word “Rocky’s” within applicant’s composite mark. Applicant is correct in that it would be improper to conclude that the words “Hot Chicken Shack” has no trademark significance, and then pointing solely to a direct comparison between the cited mark and the sole remaining word in applicant’s composite.

However, while disclaimed portions of marks must be considered when making comparisons (*In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)), as the examining attorney contends, it is well-settled that disclaimed, descriptive matter generally has 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 National Data Corp.*, 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”); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); and *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

For the reasons articulated by the examining attorney, we find the dominant elements of the two marks are substantially identical. That is, the term “Rocky’s” figures prominently in the respective marks, and as the only non-descriptive or non-generic element, will be perceived by consumers as the principal (or sole) source-identifying element in the respective marks. The descriptive terms in applicant’s composite, on the other hand, contain very little in the way of distinctiveness when applied to the applicant’s recited services (*see* disclaimer discussion *infra*).

As to sound and appearance, the obvious differences between the marks are applicant’s addition of the descriptive and generic wording. As noted above, while we do not ignore these dissimilarities, such visual and aural differences are outweighed by the similarity resulting from both marks’ use of “Rocky’s.” We make this decision keeping in mind the oft-stated proposition that our analysis involving the similarity of the marks is not based on whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether they are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods or services offered under the respective

marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd*, No. 92-1086 (Fed. Cir. June 5, 1992). Consumers are rarely offered a side-by-side comparison and we therefore focus on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Hence, viewing the marks in their entirety, we find them to be significantly more similar than dissimilar. Again, consumers will focus on and recall the designations “Rocky’s” in each of these marks as identifying the source of the restaurant services rather than relying on the additional wording that appears in applicant’s composite mark.

Accordingly, the *du Pont* factor focusing on the similarity of the marks favors a finding of likelihood of confusion.

We turn next to the sixth *du Pont* factor focusing on the number and nature of similar marks used on similar services. In this regard, applicant has placed into the record a listing of thirty-two (32) marks, both alive and dead, in International Class 43 which include the “Rocky(s)” formative. Based upon this listing, applicant argues that the word “Rocky(s)” is widely used in trademarks in International Class 43, the cited mark is weak, and this factor favors the position taken by applicant. We disagree.

Applicant's listing has absolutely no probative value on this point for a variety of reasons:

- Not every service in International Class 43 involves restaurant services;
- This listing of 32 properties includes pending applications and abandoned applications, which stand for nothing except that they were once filed; *see* TBMP § 704.03(b)(2);
- The dead registrations are of no value to applicant's argument; *see* TBMP § 704.03(b)(1)(A)
- A hit list from TESS does not have the value of actual copies of the live registrations; *see In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n. 2 (TTAB 1998).
- Even live registrations are not evidence of actual use, and we cannot assume that the public has been exposed to those marks; *see Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the United States Patent and Trademark Office). *See also In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983); and,
- Marks containing a phrase like "Rocky Mountain," for example, have totally different connotations and overall commercial impressions from applicant's and registrant's "Rocky's" marks.

In view thereof, we do not agree with applicant's argument that consumers have become so conditioned by their exposure to a plethora of "Rocky's" marks that they are able to distinguish the marks based upon applicant's addition of the trailing words "Hot Chicken Shack" – a difference in the marks that would otherwise be fairly meaningless in the context of identical restaurant services.

In conclusion, when we consider the record and the relevant likelihood of confusion factors, we conclude that, should potential purchasers who are acquainted

with the registered mark encounter applicant's mark on the services recited in the application, they are likely to believe that these services emanate from the same source. As a result, there is a likelihood of confusion.

II. Disclaimer:

Applicant has agreed to disclaim the exclusive right to use the term "Hot Chicken" apart from the mark as shown. However, the examining attorney has required that applicant also disclaim the word "shack."

In support of this position, the examining attorney has included in the record the following dictionary entry:

shack *noun* \ 'shak\
1: hut, shanty
2: a room or similar enclosed structure for a particular person or use <a guard *shack*>

In addition, the examining attorney placed into the record the following two examples of disclaimers of "Chicken Shack" and "Hot Chicken Shack" in third-party registrations:

Hattie's Chicken Shack	for "restaurant, bar and catering services" in International Class 43; ³ and
PRINCE'S HOT CHICKEN SHACK	for "restaurant services" in International Class 43. ⁴

³ Registration No. 3471921 issued on July 22, 2008; Section 8 affidavit accepted. Entire registration issued under Section 2(f) of the Act. No claim is made to the exclusive right to use the words "Chicken Shack" apart from the mark as shown.

⁴ Registration No. 3756528 issued on March 9, 2010. No claim is made to the exclusive right to use the words "Hot Chicken Shack" apart from the mark as shown.

Applicant then countered with the following examples where the word “Shack” is not disclaimed. See TESS copies attached to applicant’s response of January 22, 2013:

	for “restaurant services featuring southern-fried French cuisine; restaurant services, including sit-down service of food and take-out restaurant services” in International Class 43; ⁵
GYRO SHACK	for “restaurant services” in International Class 43; ⁶
BUBBA’S FISH SHACK	for “restaurant services” in International Class 43; ⁷
	for “mobile restaurant services; restaurant and catering services” in International Class 43; ⁸
TACO SHACK	for “fast-food restaurants; restaurant; restaurant services; restaurant services featuring Tex-Mex food; restaurant services, including sit-down service of food and take-out restaurant services; restaurant services, namely, providing of food and beverages for consumption on and off the premises; restaurants; take-out restaurant services” in International Class 43; ⁹ and,

⁵ Registration No. 4249364 issued on November 27, 2012. No claim is made to the exclusive right to use the words “Fine Food” apart from the mark as shown.

⁶ Registration No. 4221410 issued on October 9, 2012. No claim is made to the exclusive right to use the word “Gyro” apart from the mark as shown.

⁷ Registration No. 4213265 issued on September 25, 2012. No claim is made to the exclusive right to use the word “Fish” apart from the mark as shown.

⁸ Registration No. 4160974 issued on June 19, 2012. No claim is made to the exclusive right to use the word “Crepe” apart from the mark as shown.

⁹ Registration No. 3845153 issued on September 7, 2010. No claim is made to the exclusive right to use the word “Taco” apart from the mark as shown.

Frites Shack

for “fast-food restaurants” in International Class
43.¹⁰

These registrations do represent composite marks where the word(s) modifying “Shack” – often naming the type of cuisine involved – are disclaimed. We note, however, that none involve the exact term “Chicken Shack” that is involved in applicant’s composite mark. In this regard, the examining attorney has placed into the record brief excerpts of fifty-five (55) stories from Lexis/Nexis having the three-word phrase “chicken-shack restaurant.” Inasmuch as some of these restaurants appeared in more than one story, it seems fair to conclude that “chicken-shack restaurants” are reported on in at least twenty-five cities scattered across the continental United States.¹¹ From this, we conclude that “chicken-shack” represents a well-known type of restaurant, perhaps conveying information about the cuisine and the ambiance one expects.

For many of the same reasons we discussed above as to why applicant’s listing of marks containing a “Rocky” formative had no probative value, similarly, applicant’s hit list from TESS of 154 applications and registrations having “Shack” with an International Class 043 limitation is of no probative value either.

¹⁰ Registration No. 4025744 issued on September 13, 2011. The English translation of “Frites” in the mark is “French fries.” No claim is made to the exclusive right to use the word “Frites” apart from the mark as shown.

¹¹ From the brief excerpts, it appears there is at least one “chicken-shack restaurant” in each of the following cities: Phoenix, AZ; Little Rock, AK; San Diego, CA; St. Petersburg, FL; Tallahassee, FL; Chicago, IL; Baton Rouge, LA; New Orleans, LA; Shreveport, LA; Battle Creek, MI; Detroit, MI; Port Huron, MI; Newark, NJ; Passaic Co, NJ; Santa Fe, NM; Rochester, NY; Syracuse, NY; Charlotte, NC; Tulsa, OK; Corpus Christi, TX; Fort Worth, TX; Houston, TX; Norfolk, VA; Richmond, VA; Charleston, WV; and Madison, WI.

Furthermore, of the nearly sixty live registrations shown on this listing, presumably some of the other listed registrations also support the position taken by the examining attorney and contain disclaimers of the word “shack” – especially when the establishment is offering the types of informal cuisine often associated in the public’s mind with going to a “hut” or “shanty,” rolling up one’s sleeves, and scarfing down on barbeque ribs, hot wings, fresh crabs or spicy fried chicken.

Accordingly, we agree with the examining attorney that a proper disclaimer on applicant’s part would be of the words “Hot Chicken Shack.”

Decision: The refusal to register applicant’s mark, **ROCKY’S HOT CHICKEN SHACK**, is hereby affirmed.