

<p>This Opinion is Not a Precedent of the TTAB</p>

Mailed: November 13, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Brar Business Enterprises

Serial No. 85641460

Mark Borghese of Borghese Legal, Ltd.,
for Brar Business Enterprises.

Lyndsey Kuykendall, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

Before Seeherman, Kuhlke and Masiello,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Brar Business Enterprises has appealed from the final refusal of the Trademark Examining Attorney to register SLICE OF ITALY, in standard characters, with ITALY disclaimed, as a trademark for “bar services, restaurant services, restaurants featuring home delivery; take-out restaurant services” in Class 43.¹

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the basis that Applicant’s mark so resembles the registered

¹ Application Serial No. 85641460, filed June 1, 2012, asserting first use and first use in commerce as early as August 10, 2010.

mark A LITTLE SLICE OF ITALY in standard characters, for “pizza products, namely, pizza,”² that Applicant’s use of its mark for its identified services is likely to cause confusion or mistake or to deceive.

We affirm the refusal of registration.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are 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). *See also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We therefore begin our analysis with a comparison of the marks in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Applicant’s mark is SLICE OF ITALY; the cited mark is A LITTLE SLICE OF ITALY. Applicant’s mark SLICE OF ITALY is obviously identical to the SLICE OF ITALY portion of the cited mark. Applicant argues that the marks are different because the registered mark contains two additional words,

² Registration No. 3276310, issued August 7, 2007; Section 8 affidavit accepted. As a result of the filing and acceptance of the Section 8 affidavit, additional items in the original registration, “stromboli, calzones, French bread pizza, pizza crust and pizza bagels,” were deleted from the identification of goods.

thereby making it five words instead of three, and because the additional words have three syllables, the cited mark is 60% longer when spoken than is Applicant's mark. The question for us, however, is not whether the marks are identical, but whether the addition of the words A LITTLE in the cited mark, or the lack of these words in Applicant's mark, is sufficient to distinguish the marks.

We find that it does not. As Applicant has pointed out, we must look to the overall impression created by the marks and not merely compare individual features. In viewing the marks in that manner, the overall similarity between them is striking. Both convey the idea of a bit of Italy, with SLICE also having the meaning of a slice or piece of pizza. In this connection, we note that Applicant advertises itself as a pizza restaurant, with its specimen headed, "INTRODUCING THE NEWEST PIZZA RESTAURANT IN TOWN," and featuring a menu with the heading "PIZZAS," including "TRADITIONAL PIZZAS" and "SPECIALTY PIZZAS." Thus, the marks even share the same double entendre.

Although the cited mark also includes the words A LITTLE, the lack of this modifier in Applicant's mark does not serve to distinguish the marks. Rather, consumers who are aware of the registrant's mark A LITTLE SLICE OF ITALY will view SLICE OF ITALY as a shortened version or variation of the registrant's A LITTLE SLICE OF ITALY mark. The courts and this Board have previously commented on the propensity of consumers to shorten names. *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1446-47 (TTAB 2014) and cases cited therein; *Big M. Inc. v. United States Shoe Corp.*, 228 USPQ 614, 616

(TTAB 1985) (“we cannot ignore the propensity of consumers to often shorten trademarks.”)

We are not persuaded by Applicant’s argument that the registrant’s mark will be understood as a reference to the Little Italy locations throughout the United States. We acknowledge that the term LITTLE ITALY can refer to an Italian neighborhood, but in the cited mark the words LITTLE ITALY do not appear together in a manner that would indicate such a location. We have already discussed the meaning that we find the mark to convey; in our view, no reasonable person would understand A LITTLE SLICE OF ITALY to mean or refer to LITTLE ITALY.

Before leaving the discussion of the marks, we briefly address the strength of the cited registration. Although Applicant did not address this *du Pont* factor in its brief, it did submit evidence of third-party registrations during its prosecution of the application. Specifically, Applicant submitted a number of registrations that include the words SLICE *or* ITALY for various food products, e.g., Registration No. 1306243 for MR. SLICE for bread, buns and rolls; Registration No. 1601149 for SWEET SLICE for unsliced, boneless, bone-in ham; Registration No. 1918173 for SUN OF ITALY for a wide variety of food items; Registration No. 2066942 for THE ITALIAN SLICE OF LIFE for processed meats and cheeses; and Registration No. 2507588 for THE REAL SLICE for pizza. As the Examining Attorney has pointed out, third-party registrations are not evidence that the marks shown therein are in use, or that the public is familiar with them. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993). However, they can be used in the manner of dictionaries,

to show by the fact that a number of companies have chosen a particular term to use in their marks that the term has a significance within an industry. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). In this case, the registrations show the same meaning as the dictionary definition of “slice” --“a thin, flat piece cut from something: *a slice of bread*.”³ ITALY, of course, would have a significance for food that is associated with or is reminiscent of Italy. However, although the individual elements in the marks have a suggestive or even descriptive significance, as Applicant’s disclaimer of ITALY and the disclaimer of ITALY and SLICE in some of the third-party registrations show, the similarities in Applicant’s mark and the cited mark are not limited to simply the inclusion of both of these words. Rather, it is the marks as a whole that are similar. Therefore, although the protection to be accorded the cited registration may not extend to preventing the registration of marks that contain the individual elements SLICE or ITALY, that protection does extend to prevent the registration of the similar mark SLICE OF ITALY for similar goods or services.

Accordingly, we find that, because SLICE OF ITALY is identical to the words SLICE OF ITALY in the cited mark A LITTLE SLICE OF ITALY, overall the marks are similar in appearance and pronunciation. They are also, as discussed above, virtually identical in connotation and commercial impression. Thus, the marks as a

³ Dictionary.com, based on the Random House Dictionary © 2104. 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).

whole are confusingly similar, and this *du Pont* factor favors a finding of likelihood of confusion.

We now consider the factor of the similarity of the goods and services. First, we note that Applicant has argued that the evidence regarding the relatedness of “bar services” and “pizza” is “scant.” Brief, p. 4. 10 TTABVue 7. Aside from the fact that the Examining Attorney has submitted evidence on this issue, such evidence is not necessary to support a finding of likelihood of confusion. If there is a likelihood of confusion due to any of the services in Applicant’s single-class application, then likelihood of confusion must be found for the entire class. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application). Because the bulk of the Examining Attorney’s evidence goes to the relatedness of Applicant’s restaurant services and the pizza identified in the cited registration, we will concentrate our discussion on those services.

It is not necessary that the goods or services be identical or even competitive in nature in order to support a finding of likelihood of confusion, it being sufficient that the goods or services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks employed thereon, to the mistaken belief that they originate from or are in some way associated with the same producer. *In re Home Builders Ass’n of Greenville*, 18

USPQ2d 1313, 1317 (TTAB 1990). Further, the cases are legion in which relatedness has been found between goods and the retail services that feature such goods. *See In re Hyper Shoppes*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (likelihood of confusion found between applicant's mark for general merchandise store services [which would include furniture] and the cited mark for furniture); *Genesco Inc. v. Martz*, 66 USPQ2d 1260 (TTAB 2003) (clothing items commercially related to services of retail and mail order sales of various clothing items).

However, as Applicant has pointed out, when the goods and services at issue are food products and restaurant services, to establish likelihood of confusion the Office “must show something more than that similar or even identical marks are used for food products and for restaurants services.” *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ2d 641, 642 (CCPA 1982). Merely because a restaurant serves a particular food item is not sufficient to show that the goods and services are related.

To show “something more,” the Examining Attorney has presented a significant amount of evidence of third-party registrations and third-party use.⁴ The third-party registrations list both pizza and restaurant services in their identifications, for example, Registration Nos. 3171418, 3473869, 3293800, 3247058 and 3916530. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. *See In re Albert*

⁴ We commend the Examining Attorney for the thoroughness with which she supported the Office's position.

Trostel & Sons Co., 29 USPQ2d at 1786. As for the Internet evidence showing third-party use, many of the websites show that restaurants feature pizza on their menus, e.g., Ledo Pizza, p. 2, Bertucci's, p. 5, Shakeys, p. 7,⁵ and other websites show that companies offer both restaurant services and frozen pizza as a retail product, i.e., California Pizza Kitchen, pp. 35-36, Connie's Pizza, pp. 44-45,⁶ Dino's, pp. 10-11, The Dish, pp. 12-16, Home Run Inn, pp. 17-19, Mystic Pizza, pp. 20-25, Russo's New York Pizzeria, pp. 26-28, Shakespeare's Pizza, pp. 29-34, and Uno, pp. 35-39.⁷

In addition to the evidence submitted by the Examining Attorney, Applicant's own specimen demonstrates the connection between pizza and restaurant services, as it features "pizza" as the primary item in its advertising. As noted previously, the heading on the advertising piece is INTRODUCING THE NEWEST PIZZA RESTAURANT IN TOWN.

The evidence of record clearly demonstrates "something more" by the specific commercial relationship between pizza and restaurant services.⁸ That is, pizza is featured as the primary item by many restaurants, and restaurants do, in fact, sell pizza outside of their restaurant premises, for example, in the form of frozen pizza.

⁵ These webpages were made of record with the Office action mailed September 24, 2012.

⁶ These two companies' webpages were made of record with the Office action mailed November 27, 2012.

⁷ This latter group of webpages was made of record with the Office action mailed June 17, 2013.

⁸ Applicant relies on a decision by the Board that was marked "Not Citable as Precedent" to assert that there are only two ways that "something more" can be shown. Non-precedential decisions are not binding on the Board, *see* TBMP Section 101.03 and cases cited therein, and we do not consider it as setting forth a test for "something more."

In other cases, the Board has found the “something more” requirement to be met where the applicant’s restaurant specialized in the registrant’s type of goods. *See In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) (AZTECA MEXICAN RESTAURANT for restaurant services confusingly similar to AZTECA for Mexican food items); *In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990) (GOLDEN GRIDDLE PANCAKE HOUSE for restaurant services confusingly similar to GOLDEN GRIDDLE for table syrup).

In view of the connection between pizza and restaurants featuring or specializing in pizza, we find that Applicant’s services are related to the registrant’s identified goods, and that the average consumer would be likely to view pizza and such restaurant services as emanating from or sponsored by the same source if such goods and services are sold under the same or confusingly similar marks.

Applicant relies on the Court’s decision in *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003) to argue that “[t]he registration examples cited by the examining attorney only establish that a few restaurants happen to sell pizza products, out of the thousands of restaurants in the United States,” and “[t]he examples cited are only a tiny fraction of all the restaurants in the United States, meaning there is only a *de minimus* [sic] relationship between pizza products and restaurant services.” Brief, pp. 5-6, 10 TTABVUE 8-9.

First, we do not consider the third-party registrations to establish that only *a few* restaurants sell pizza products. This Board discourages the submission of unnecessarily cumulative evidence. *See* TBMP § 1208.01; *In re Max Capital Group*

Ltd, 93 USPQ2d 1243, 1245-46 (TTAB 2010) (Board criticized applicant for submitting over 300 pages of Internet material, much of which was duplicative or irrelevant); *In re Homes & Land Publishing Corp.*, 24 USPQ2d 1717, 1718 (TTAB 1992) (it is not necessary that an examining attorney submit all stories found in the NEXIS database, especially where there are a large number of them). In *In re Kysela Pere et Fils Ltd*, 98 USPQ2d 1261, 1264-65 (TTAB 2011), the applicant made an argument similar to that of Applicant's herein (footnotes omitted):

Applicant argues that because the examining attorney has submitted "only" about thirty third-party registrations, and there are many thousands of applications and registrations in the USPTO database that include "wine" or "beer" in their identifications, the thirty registrations represent "a negligible percentage (.00025-.00053) and not nearly enough to establish a relationship between the goods sufficient to lead to a finding of likelihood of confusion in this case." Brief, p. 16.

The Board responded by stating, *inter alia*:

Most importantly, the fact that the examining attorney submitted approximately twenty probative third-party registrations listing beer and wine does not mean that they are the only registrations that include these goods. There is no requirement for the examining attorney to submit *all* the evidence that supports his position and, indeed, the Board would be very critical if the examining attorney were to submit an inordinate number of registrations. *Cf. In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010) ("The Board has frequently stated, in connection with the submission of articles retrieved by a NEXIS search, that it is not necessary that all articles be submitted" and "the same is true for materials retrieved through Internet searches").

Although the submission of a very limited number of registrations might lead the Board to conclude that these were all the probative registrations that an examining attorney could find, *see In re The Monotype Corp. PLC*, 14 USPQ2d 1070,

1071 n.2 (TTAB 1989), that is not the case here. The Examining Attorney has explained that the evidence she submitted is a representative sample, see Brief, 12 TTABVUE 11, and therefore we find that she has made of record a sufficient number of third-party registrations for both pizza and restaurant services to show that it is not uncommon for a party to adopt a single mark for both the goods and services.

Second, we do not interpret *Coors* to require that the Office show that a significant number of *all* restaurants in the United States feature pizza as an item on their menus to establish “something more.” In *Coors*, the issue was whether the Office had demonstrated a relationship between beer and restaurant services, and it was clear that the mere fact that beer is sold in restaurants would not suffice to show that the goods and services are related. The Office tried to establish the “something more” by showing that restaurants brewed their own beer and sold it under their own label, and it was the *de minimis* nature of such restaurants that caused the Court to find that the Office had not shown “something more” than that beer was served in restaurants. In the present case, there is a significant amount of evidence showing that pizza is featured in restaurants, and that restaurants also market pizza products, such as frozen pizza, for consumers to purchase elsewhere.⁹ Moreover, the recognition that restaurants are devoted to the sale of pizza is shown by the fact that there is actually a term, “pizzeria,” to describe a restaurant where

⁹ Again, the Examining Attorney has stated that the evidence she submitted was a representative sample.

pizzas are made and sold.¹⁰ This evidence and the dictionary definition show that the connection between restaurant services and pizza is more than *de minimis*.

The *du Pont* factor of the relatedness of the services and goods favors a finding of likelihood of confusion.

Applicant also argues that the extent of potential confusion is *de minimis*, apparently basing this contention on its views of the differences in the marks and goods/services, and the fact that the cited mark is not famous or unique. We have already discussed the *du Pont* factors of the similarities of the marks and goods/services, and the strength of the cited mark. We agree that there is no evidence of the fame of the cited mark (and we note that there seldom is such evidence in the context of an ex parte proceeding); the factor of fame is therefore neutral. In our view, the extent of potential confusion also concerns the number of people who are likely to be confused, and since pizza and restaurant services are common consumer items and services marketed to the public at large, the extent of potential confusion is great.

Finally, although neither Applicant nor the Examining Attorney addressed this factor, we find that the conditions of purchase *du Pont* factor also favors a finding of likelihood of confusion. As we have already said, the goods and services are purchased by the general public. Further, pizza is not a particularly expensive item. Applicant's specimen shows that a small pizza with one topping costs \$7.99, and

¹⁰ We take judicial notice of the definition of "pizzeria," "a restaurant, bakery, or the like, where pizzas are made and sold," taken from Dictionary.com, and based on the Random House Dictionary, © 2014.

even an extra large specialty pizza costs only \$21.99. Although we must consider goods and services that are not more particularly restricted to encompass all price ranges appropriate for such goods and services, it is clear from Applicant's specimen, as well as other evidence of record, (see menu for Mystic Pizza II, showing a small plain pizza costs \$7.40 and a large plain costs \$13.70, Office action mailed June 17, 2013, p. 23) that restaurant services would encompass inexpensive restaurants that could be the subject of an impulse decision to visit, rather than the result of careful consideration.

In view of the foregoing, we find that Applicant's mark SLICE OF ITALY for its identified services is likely to cause confusion with the mark A LITTLE SLICE OF ITALY for pizza.

Decision: The refusal to register Applicant's mark SLICE OF ITALY is affirmed.