

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

Mailed:  
February 3, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re The Express Cafe & Bakery, LLC dba Goose Feathers*  
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Serial No. 85862485  
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Kate D. Strain of Belzer PC, for The Express Café & Bakery, LLC  
dba Goose Feathers.  
Hélène Liwinski, Trademark Examining Attorney, Law Office 104,  
Chris Doninger, Managing Attorney.

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Before Seeherman, Taylor and Wellington,  
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

The Express Cafe & Bakery, LLC, dba Goose Feathers, has appealed from the Trademark Examining Attorney's final refusal to register THE LAFAYETTE in standard characters as a mark for "sandwiches."<sup>1</sup> Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the mark LAFAYETTE in typed characters,

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<sup>1</sup> Application Serial No. 85862485, filed February 28, 2013, and asserting first use and first use in commerce as early as December 31, 1986.

registered for “vegetable salads,”<sup>2</sup> that when used on Applicant’s goods it is likely to cause confusion or mistake or to deceive.

Applicant and the Examining Attorney filed briefs.<sup>3</sup>

We affirm the refusal to register.

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).

Turning first to the *du Pont* factor of the similarity of the marks, we must consider the marks in their entirety as to appearance, sound, connotation, and commercial impression. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). Nevertheless, there is nothing improper in stating that more or less weight has

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<sup>2</sup> Registration No. 2414764, issued August 6, 1999; Section 8 & 15 affidavits, respectively, accepted and acknowledged; renewed.

<sup>3</sup> It is noted that Applicant submitted as attachments to its appeal brief evidence that it had previously made of record with its response to the first Office action. Applicant is advised that doing so is duplicative and unnecessary, as the Board has ready access to the application file. *See In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1315 (TTAB 2011); *In re SL&E Training Stable Inc.*, 88 USPQ2d 1216, 1220 n.9 (TTAB 2008); *In re Thor Tech Inc.*, 85 USPQ2d 1474, 1475 n.3 (TTAB 2007).

been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In the present case, LAFAYETTE is the entirety of the cited mark, and we find it to be the dominant element of Applicant's mark. The only other element in Applicant's mark is the definite article THE, a word that has been found to have no source-indicating significance. *See In re Thor Tech Inc.*, 85 USPQ2d at 1635 (the marks WAVE and THE WAVE are virtually identical, "[t]he addition of the word 'The' at the beginning of the registered mark does not have any trademark significance."); *In re Narwood Productions, Inc.*, 223 USPQ 1034 (TTAB 1984) (likelihood of confusion found between THE MUSIC MAKERS and juke box design for radio programs and MUSIC-MAKERS for production of films and composing and recording music, fact that applicant's mark includes the definite article "the" insignificant in determining the likelihood of confusion).

Thus, the marks here are virtually identical. Applicant's mark is THE LAFAYETTE in standard characters; the cited mark is LAFAYETTE in typed form which, prior to November 2, 2003, was the term used for standard character drawings. *See* TMEP § 807.03(i). The only difference in the marks is that Applicant's mark includes the word THE, but the presence of this article has no real effect on the commercial impression of the mark, it acts only to emphasize the word LAFAYETTE. Applicant argues that the term THE has source-indicating significance because "[s]andwich consumers are accustomed to sandwich marketing

including the term “THE.” Brief, 4 TTABVUE 6. We are not persuaded by this argument. First, we note in Applicant’s specimen that Applicant uses LAFAYETTE both with and without the word THE, and therefore it is unlikely that consumers will attach any weight to it when used in the mark THE LAFAYETTE. Second, and more importantly, if indeed it is a practice to use THE as part of the trademark or name of a sandwich,<sup>4</sup> consumers are not likely to view this term in Applicant’s mark as having source-indicating significance. Third, because the registrant’s goods are a salad, even those consumers who are familiar with the practice of adding the definite article THE in connection with the trademark for a sandwich are likely to assume, when they see the mark LAFAYETTE with a salad, that the word THE has been omitted not because LAFAYETTE represents a different source, but because the mark is being used with a salad and not a sandwich.

We are also not persuaded by Applicant’s argument that “LAFAYETTE immediately connotes something foreign and may furthermore directly implicate a French hero of the American revolution,” while THE LAFAYETTE “avoids an immediate reference to something foreign and instead connotes very different specific domestic references, such as any of the American populated places, characters, schools, landmarks, buildings, or the like....” Brief, 4 TTABVUE 9. In our view, Applicant is assuming that the average purchaser of a salad or sandwich will give far more consideration to the nuances of the word THE than is likely. It must be remembered that under actual marketing conditions, consumers do not

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<sup>4</sup> Applicant has submitted examples of ten restaurants using “THE” to name their sandwiches, hardly a sufficient basis to find that this is a practice in the industry.

necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980). As a result, consumers are not likely to remember whether a mark has or does not have the element THE. Rather, they will remember the significant aspect of the mark, the arbitrary name LAFAYETTE (whether they associate it with the French hero, or a place named after that hero).

Applicant also makes the argument that the marks have different commercial impressions because LA means THE in French, and therefore Applicant's mark conveys the incongruous meaning of repeating the word "THE". Lest there be any question that we have misstated this argument by paraphrasing it, we quote it in its entirety:

Applicant's use of the term "THE" in "THE LAFAYETTE" promotes a distinct and different commercial impression than "LAFAYETTE" alone. Here, "THE LAFAYETTE" will give rise to a sense of repeated "the," de-emphasizing the shared term "LAFAYETTE." The French article "la" is generally understood to mean "the" (*see* TMEP 809.01(b)(ii)), so to the extent that any similar commercial impression may remain possible in spite of the discussion above, any such similarities would be further obviated by the incongruity of Applicant's mark being "THE the FAYETTE" instead of merely "the FAYETTE."

Brief, 4 TTABVUE 9-10. Given Applicant's own use of both THE LAFAYETTE and LAFAYETTE in its specimen, and the fact that "Lafayette" is the name of a hero of the American Revolution, we are not persuaded that consumers will parse the name LAFAYETTE into LA and FAYETTE and treat the cited mark as meaning "the Fayette" and Applicant's mark as meaning "the the Fayette."

We find that the marks are extremely similar in appearance and pronunciation and essentially identical in connotation and commercial impression. This *du Pont* factor strongly favors a finding of likelihood of confusion.

We thus turn to a consideration of the goods, keeping in mind that the greater the similarity between the applicant's mark and the cited registered mark, the less the degree of similarity between the applicant's goods or services and the registrant's goods or services that is required to support a finding of likelihood of confusion. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001), cited with approval in *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ 1059 (Fed. Cir. 2003). "Where, as in this case, the applicant's mark is virtually identical to the registrant's mark, there need only be a viable relationship between the goods to find that there is a likelihood of confusion." *In re Thor Tech Inc.*, 90 USPQ2d at 1636, finding WAVE and THE WAVE to be virtually identical. Moreover, the goods and/or services of the applicant and registrant need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that the goods and/or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used or intended to be used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each of the parties' goods and/or services. *In re Iolo Technologies LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010).

With respect to the *du Pont* factor of the similarity of the goods, the Examining Attorney has made of record five third-party registrations for goods that include both sandwiches and salads, to wit: Registration No. 4165354 for, *inter alia*, fruit, garden and vegetable salads and sandwiches; Registration No. 4021996 for, *inter alia*, vegetable salads and sandwiches; Registration No. 4176494 for, *inter alia*, sandwiches, garden salads, vegetable salads and prepared entrees consisting primarily of vegetable salads; Registration No. 4311932 for, *inter alia*, salads, vegetable salads and garden salads and sandwiches; and Registration No. 4279598 for, *inter alia*, “salads except macaroni, rice, and pasta salad,” “hamburger sandwiches,” “sandwiches, namely chicken, lamb and veggie wraps,” and “veggie burger sandwiches.” 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 Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Applicant takes issue with several of these registrations because they also include restaurant or retail bakery services, and it objects to Registration No. 4279598 because “‘salads’ are not ‘vegetable salads’ and ‘wraps’ are not ‘sandwiches.’” Brief, 4 TTABVUE 11. Again, we do not find Applicant’s argument persuasive. Whether or not these third-party registrations also include restaurant or retail bakery services, the registrations are for salads and sandwiches, and there is no restriction as to their sales, such as that they may be sold only through the registrants’ restaurants or bakeries. Further, the identification of “salads” would

include all types of salads, including vegetable salads; there is no requirement that to be probative a third-party registration must include not just the acceptable general identification for an item, but also must list every type of product within that general identification. As for the argument that a wrap is not a sandwich, the identification in Registration No. 4279598 clearly identifies wraps as sandwiches: “sandwiches, namely chicken, lamb and veggie wraps.” The identification also lists other, non-wrap sandwiches as well.<sup>5</sup>

In short, we find all of the third-party registrations to be probative as showing that salads and sandwiches can emanate from a single source under a single mark, and that given the virtual identity of the marks, this evidence is sufficient to show that the goods are related.

Applicant discusses in some detail the differences between vegetable salads and sandwiches, e.g. sandwiches are main dishes and contain bread, and vegetable salads are side dishes that rarely serve as an entire meal. We need not get mired in an extensive discussion of the similarities and differences of salads and sandwiches. Suffice it to say that, as stated above, there is no requirement that the goods be identical or even competitive to support a finding of likelihood of confusion. Here, the Examining Attorney has submitted third-party registration evidence to show that both salads and sandwiches can emanate from a single source and that, in fact, Registration No. 4176496 lists as an item “prepared entrees consisting primarily of

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<sup>5</sup> We also point out that one of the examples of “THE-named” sandwiches provided by Applicant is a wrap: THE AL GORE, listed as a turkey sandwich at the Two Bears Deli contains “mixed greens, feta cheese, dried cherries, and walnuts in a tomato wheat *wrap*.” (emphasis added). Response filed December 9, 2013, p. 12.



vegetable salads,” i.e., vegetable salads can act as entrees. Further, the Examining Attorney has submitted evidence to show that vegetable salads may be marketed in the same manner as meat/entrée salads (see spinach sweet crisp salad from Corner Bakery Café website, Office action mailed January 3, 2014, p. 7; hearty veggie & brown rice salad from Starbucks website, Office action mailed June 13, 2013, p. 23; and chickpea veggie salad from Potbelly website, Office action mailed June 13, 2013, p. 28). The evidence also shows that both salads and sandwiches may be marketed as variations of each other (see Office action mailed January 3, 2014, p. 18, in which Quiznos website lists, on the same webpage, five dishes in both the salad version and the wrap sandwich version, e.g., “Black & Blue” shown as a salad, and “Black & Blue Wrap”).

We note that the Examining Attorney has submitted an extensive amount of evidence from third-party websites to show that salads and sandwiches may emanate from a single source. However, these websites all appear to be for restaurants, and the fact that a restaurant may sell salads and sandwiches has less probative significance, since, with the exception of the “Black & Blue” salad/sandwich referenced above, it is not clear that these items are sold under a trademark identifying the sandwich/salad, as opposed to a trademark identifying the source of the restaurant services. As a result, we do not rely on this third-party website evidence for this purpose.

Nonetheless, as previously stated, the evidence is sufficient for us to find that the goods are related. Pre-packaged sandwiches and salads may be sold separate

from restaurants, for example, in grocery stores, convenience stores, highway rest stops, truck stops and the like. Applicant acknowledges that salads and sandwiches may be sold in grocery stores. Brief, 4 TTABVUE 11. Although Applicant contends that salads and sandwiches would be sold in different sections of such stores, we see no reason why both may not be sold in the same refrigerated cases, so that a customer can simply grab a sandwich or salad “to go.” The *du Pont* factors of the similarity of the goods and the trade channels favor a finding of likelihood of confusion.

Although not discussed by Applicant or the Examining Attorney, the conditions of purchase *du Pont* factor also favors a finding of likelihood of confusion. Sandwiches and salads are inexpensive items; Applicant’s specimen shows its “Lafayette Monday” sandwich priced at \$6.75. By their very nature, salads and sandwiches are eaten in a single meal, and thus are subject to frequent replacement. As a result, consumers are not likely to closely examine the trademark of a salad or sandwich when taking a pre-packaged one from a refrigerated case, and given the virtual identity of the marks, they are not likely to notice that Applicant’s mark includes the word THE while the cited mark does not.

We must also treat the cited mark as a strong mark, since LAFAYETTE is an arbitrary term for vegetable salads. We recognize that Applicant has submitted a third-party registration for CAFE LAFAYETTE for “food court restaurant services; providing food and beverages to retail consumers for consumption on or off the premises.” However, we cannot conclude from this single third-party registration

that LAFAYETTE has some significance in the food service industry. (Third-party registrations are not evidence of actual use of the marks shown therein, but they may be used to show the meaning of a mark in the same way that dictionaries are used. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976).) Nor can we reach the conclusion urged by Applicant that this third-party registration negates the likelihood of confusion between Applicant's mark and the cited mark because the food court restaurant services listed in that registration are more closely related to vegetable salads than sandwiches are. We do not know what went into the Examining Attorney's decision to allow this registration, as that file is not part of the record, but certainly the mere fact that a single third-party registration for a mark containing the element LAFAYETTE issued does not reflect a policy by the Office that would entitle Applicant "a certain degree of reliance on the trademark office's treatment of similar marks." Brief, 4 TTABVUE 14.

Applicant and the Examining Attorney did not discuss any other *du Pont* factors, nor did they submit evidence relating to them. To the extent that any are relevant, we treat them as neutral.

After considering all of the relevant *du Pont* factors, we find that Applicant's mark THE LAFAYETTE for sandwiches is likely to cause confusion with the registered mark LAFAYETTE for vegetable salads.

**Decision:** The refusal to register Applicant's mark THE LAFAYETTE is affirmed.