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Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pizza Pro, Inc.

Serial No. 86320662

Pizza Pro, Inc., *pro se*, by Scott A. Stevens, President.

William H. Dawe, III, Trademark Examining Attorney, Law Office 108,
Andrew Lawrence, Managing Attorney.

Before Seeherman, Zervas and Kuczma,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Pizza Pro, Inc., seeks registration on the Principal Register of the mark BYO
PIZZA BUILD YOUR OWN PIZZA, as shown below, for “fresh pizza; pizza; pizza
dough; pizza sauce.”¹

¹ Application Serial No. 86320662, filed June 25, 2014, based on Section 1(b) of the
Trademark Act (intent-to-use).



The colors black and red are claimed as a feature of the mark. The mark consists of the stylized capital letters BYO in black above the stylized word Pizza in red, along with the stylized phrase Build Your Own Pizza in black below. Applicant has disclaimed exclusive right to use PIZZA BUILD YOUR OWN PIZZA apart from the mark as shown.

The Trademark Examining Attorney issued a final refusal of registration of Applicant's mark 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 BYOPizza, in standard characters, registered for "restaurant services, including sit-down service of food and take-out restaurant services,"² that if used in connection with Applicant's identified goods it is likely to cause confusion or mistake or to deceive.

Applicant has appealed. We affirm the refusal to register.

I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter. In its brief Applicant has referenced an online search of OneLook.com and some of the meanings it retrieved for BYO. The brief also lists 31 registrations for marks that include the letters "BYO." However, this material was never made of record,

² Registration No. 4421968, issued October 22, 2013.

and therefore it has not been considered. *See* Trademark Rule 2.142(d), which provides that “[t]he record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed.” Moreover, in this case the evidence was never filed, the brief merely lists some information regarding definitions and third-party registrations.

Applicant also referenced, in its November 20, 2014 response, certain third-party registrations for prepared alcoholic cocktails and beer. Although Applicant did not properly make these registrations of record, the Examining Attorney did not advise Applicant of this fact at a point when the registrations could have been submitted, and therefore we will consider the information that was listed in the response for whatever probative value it may have. We add, however, that the probative value of these registrations is quite limited since they are for different marks and goods from the marks and goods/services at issue herein.

Applicant did make of record five pages from a Google search summary for “byo.” The listings in such summaries are often too truncated to show the context within which a term is used, and therefore they may have limited probative value. *See* TBMP § 1208.03 (June 2015). For example, there is a truncated listing from InternetSlang.com that starts to explain what the meaning of BYO is, but ends with “The slang word/acronym/abbreviation BYO means...” and does not give the meaning. Response filed October 15, 2014, p.2.

Finally, we note that in his brief the Examining Attorney requested that we take judicial notice of the meaning of BYO from www.acronymfinder.com. However, the Examining Attorney made this evidence of record with the December 30, 2014 Office action, pp. 3-4, and therefore the request is moot.

II. Applicable Law

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 turn first to the *du Pont* factor of the similarity of the goods and services. As Applicant has pointed out, there is no *per se* rule that confusion is likely to result from use of similar or even identical marks for food or beverage items and restaurant services; there must be *something more*. *In re Opus One Inc.*, 60 USPQ2d 1812, 1813 (TTAB 2001), citing *Jacobs v. International Multifoods Corporation*, 668 F.2d 1234, 212 USPQ 641 (CCPA 1982). In the present case, the *something more* includes evidence submitted by the Examining Attorney that the primary focus of the Registrant's restaurant services is pizza. The Registrant's website prominently

lists, as a slogan beneath the mark, “build your own pizza,” and the Home page has the title “Fresh, quick-fired pizza designed by you!” along with the subtitle, “Build your personal favorite pizza or create something unique,” and several pictures of pizza pies.³ In addition, the Examining Attorney has made of record a large number of third-party registrations showing that a single mark has been registered for both “pizza” and for “restaurant services.”⁴

In addition, the evidence submitted by Applicant itself shows that certain restaurants are so associated with “pizza” that they are referred to as “pizza restaurants” or “pizzerias,” and that build-your-own pizza is a growing trend. *See* Investor Place, July 30, 2012 article, “A New Type of Pizza Restaurant Is Popping Up Across the U.S.,” discussing how consumers can “build” their own pizzas: “Patrons place their orders at a counter and then select the ingredients they want on their pizza as a [sic] restaurant staffers build the pie before their eyes.”⁵ Another article, also submitted by Applicant, reports:

Build-your-own has entered the pizza world, too, with Blaze Pizza encouraging consumers to not only choose the toppings, but also the types of sauces, dough and even cheeses. And, yes, Chipotle is eyeing build-you-own pizza, with two Pizza Locale locations it owns in Colorado.⁶

The foregoing demonstrates the “something more” between pizza and restaurant services. Quite simply, pizza is not merely an ingredient or a minor item that can be

³ <http://byopizza.com>, December 30, 2014 Office action, p. 5.

⁴ October 6, 2014 Office action, pp. 9-107.

⁵ November 20, 2014 response, pp. 2-3.

⁶ “Wendy’s: Tests build-your-own burger,” USA Today, submitted as part of November 20, 2014 response, pp. 4-5.

found in a restaurant, but it is a major part of restaurant services, and a product that restaurants also market separately. We acknowledge Applicant's statements that its pizza is not a prepared pizza that is ready to eat, but is an uncooked pizza that a consumer would cook himself or herself. We point out, however, that Applicant's identification of goods does not limit its goods to uncooked pizza. Rather, its goods as identified include "fresh pizza" and "pizza"; if it were to obtain a registration for the goods as identified, it would be prima facie evidence of Applicant's right to use its mark for any type of pizza, including "fresh pizza" that would be sold by a restaurant.

In any event, the evidence submitted by the Examining Attorney shows the relatedness between even the uncooked pizza described by Applicant and the Registrant's identified services. The evidence shows that Applicant, Pizza Pro, renders restaurant services in addition to selling uncooked pizza. *See*, for example, the website allmenus.com, showing various pizzas one can order from Applicant, including pizzas that the consumer "builds" himself or herself.⁷ The website menuism.com lists Applicant's Pizza Pro business, along with customer reviews that say, *inter alia*, that the delivered pizza "is always hot."⁸ An offer to sell a Pizza Pro franchise describes Applicant's business as having begun with carry-out delivery locations that have expanded to "full size buffet and sit-down restaurants."⁹ In addition, the Examining Attorney has shown that third parties sell pizza dough

⁷ December 30, 2014 Office action, p. 17.

⁸ December 30, 2014 Office action, pp. 22-24.

⁹ www.bizquest.com, December 30, 2014 Office action, p. 25-27.

and/or wrapped pizza that can be baked at home, as well as rendering restaurant services.¹⁰

Accordingly, we find that Applicant's "fresh pizza" and "pizza" are related to the Registrant's restaurant services. In view thereof, we need not consider whether the remaining items in Applicant's identification of goods are related to the restaurant services identified in the cited registration. *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 or services in the application). The *du Pont* factor of the similarity of the goods and services favors a finding of likelihood of confusion.

With respect to the *du Pont* factor of the channels of trade, the information we have from Applicant as to its planned channels of trade is rather limited. It appears from Applicant's statements that its mark is to be used with "fresh pizza which a consumer will 'build,' using Appellant's proprietary pizza dough and proprietary pizza sauce along with an assortment of cheeses and fresh toppings, which pizza will then be wrapped for transporting by the consumer to his or her own kitchen for cooking." Brief, 4 TTABVUE 5. Applicant also makes the statement that its pizza "will appeal to fast food consumers who are cost-conscious as well as health-conscious, and will offer an alternative to delivery or frozen pizzas." *Id.* at 5-6.

¹⁰ December 30, 2014 Office action: www.doughpizzeria.com, DOUGH Pizzeria Napoletana, pp. 28-35; <http://glutenfreeguidehq.com>, Godfather's Pizza, p. 56; "Buying Pizza Dough from a Pizzeria," www.yelp.com, p. 66-67; www.localtabletours.com, Pizzeria Locale-Pizza Dough To Go, p. 69-71.

Again, the manner in which Applicant has identified its goods does not restrict its pizza to a non-restaurant channel of trade. Further, we see no particular reason why uncooked pizza of the type described by Applicant cannot be sold through a restaurant; as noted above, there is evidence that some restaurants in fact sell both cooked pizza and “take-n-bake” style pizza. Even if we were to treat Applicant’s pizza as not being sold through restaurants, the pizzas are still products that are sold to the general public. As a result, the same classes of consumers would encounter Applicant’s pizza and the Registrant’s restaurant services. This *du Pont* factor favors a finding of likelihood of confusion.

Moreover, “pizza” is in the nature of fast food, particularly the pizza described by Applicant itself. Pizza in general can be an inexpensive item, for example, the Examining Attorney has submitted evidence showing a price of \$6.95 for a 9 inch pie at Caffè Italia and \$12.79 for a 12 inch pie at Cenario’s Pizza.¹¹ Therefore, the decision to purchase a pizza, either an unbaked pie or a take-out pizza from a restaurant, or even to patronize a pizzeria, can be made on impulse. We are simply not persuaded by Applicant’s unsupported argument that the determination as to whether a consumer will want to purchase a pizza for consumption at a later date “would require careful, studied consideration.” Brief, 4 TTABVue 6. Even if the consumer must decide when he or she will eat Applicant’s pizza prior to purchasing it, that decision does not require a careful examination of the trademark used on

¹¹ December 30, 2014 Office action, pp. 72-73.

the pizza. This *du Pont* factor regarding the conditions of purchase favors a finding of likelihood of confusion.

This brings us to a consideration of the marks. Applicant's mark is



while the cited mark is BYOPizza in standard characters.

In both marks, the letters BYO stand out; they are the first part of both marks, and in Applicant's mark they are displayed on a separate line, while in the cited mark, because BYO and PIZZA have actual meanings, as discussed below, BYO would be understood as a separate term from the word PIZZA.¹² We also point out that, because the cited mark is registered in standard character format, the Registrant is not limited to any particular type font or color. *See In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012). Therefore, it could depict its mark with BYO in much larger letters than "Pizza," with all of the wording in the same font as Applicant's mark, and with BYO in black letters and Pizza in red, the same colors that Applicant uses for its mark. Although Applicant's mark also includes the slogan BUILD YOUR OWN PIZZA, this difference is not sufficient to differentiate the marks. The Examining Attorney has submitted evidence that one meaning of BYO is "build your own";¹³ consumers are likely to view the BUILD YOUR OWN

¹² In fact, although the cited mark is registered in standard character format, it is depicted in the registration as BYOPizza.

¹³ www.acronymfinder.com, December 30, 2014 Office action, p. 3.

PIZZA portion of Applicant's mark as merely reinforcing, or advising consumers, of the meaning of the BYO PIZZA portion of the mark. "Build your own" is also the meaning consumers are likely to ascribe to BYO in the Registrant's mark, particularly since the Registrant uses the slogan "build your own pizza" immediately below the mark in its advertising. We find unpersuasive Applicant's argument that the cited mark "could be interpreted either as identifying a restaurant where you 'bring your own pizza', or as a type of pizza, i.e. a 'BYOP' pizza, or as a restaurant location, i.e., 'by OPizza.'" Brief, 4 TTABVUE 9. Applicant has not provided any evidence that there is such a thing as a restaurant where one brings one's own pizza such that consumers would view the Registrant's mark as having this meaning, nor any evidence that there is such a thing as a BYOP pizza, or that BYOPizza would be viewed as BY OPizza. On the contrary, because both marks begin with BYO, followed by the word PIZZA, the marks are likely to both be understood as BYO PIZZA. Thus, we find the marks to be very similar in appearance and connotation. As for pronunciation, Applicant asserts that the marks do not sound the same because the Registrant's mark "is obviously pronounced 'Bi Op Izza' or 'Bio Pizza.'" Brief, 4 TTABVUE 9. We disagree. Although there is no correct pronunciation of a trademark that is not a known word, certainly when used in connection with a pizza restaurant the term PIZZA in the Registrant's mark would be readily recognized, and would be pronounced as "pizza." And there is no "obvious" reason why the identical letters BYO in both Applicant's mark and the Registrant's mark would not be pronounced the same, most likely as the individual

letters B-Y-O, since this is the way consumers are used to pronouncing BYO when used as an abbreviation.

Viewing the marks in their entirety, we find that they convey the same commercial impression, and that the *du Pont* factor of the similarity of the marks weighs in favor of a finding of likelihood of confusion.

We have also taken into consideration the strength of the registered mark. As noted, BYO, in the context of the mark and services, has the connotation of “build your own,” and therefore is suggestive of restaurant services which allow one to customize one’s own pizza. Suggestive marks, of course, are entitled to a more limited scope of protection than more distinctive marks. However, even highly suggestive marks are still deserving of protection, and given the similarity of Applicant’s and the Registrant’s marks and the goods and services, the scope of protection to be accorded the Registrant’s mark extends to prevent the registration of Applicant’s mark. As for the sixth *du Pont* factor, the number and nature of similar marks in use on similar goods and services, Applicant has made of record five pages from a Google search summary. As previously mentioned, the results as shown in the summary are highly truncated and therefore have limited probative value. There are some listings that appear to refer to third-party uses, such as BYO Records, BYO Wireless prepaid phone service, www.byoplayground.com for commercial playground equipment for schools, BYO Ethanol to blend your own ethanol, BYO Burger which appears to be a burger restaurant, Build Your Own BMW for BMW automobiles, BYOstudio.com for cash advances, and BYO Fitness

for fitness classes. However, because of the limited number of listings of BYO for food-related goods and services, and the lack of information about such uses, we cannot conclude that the sixth *du Pont* factor favors Applicant. In this connection, we point out that none of the listings shows BYO for pizza or pizza restaurant services.

Of the remaining *du Pont* factors, Applicant asserts that all but one are neutral, while the Examining Attorney does not address them at all. We agree that there is no evidence regarding them, and therefore we have treated them as neutral. Applicant does contend that the factor of the extent of potential confusion favors it, because of the claimed differences in the goods and services and the differences in the marks. We have already discussed why we have found the marks to be similar and the goods and services to be related. In addition, the extent of potential confusion is substantial because Applicant's and the Registrant's goods and services are consumer items and services that would be purchased by the general public. Therefore, to the extent that this *du Pont* factor is relevant, it favors a finding of likelihood of confusion.

After considering all of the relevant *du Pont* factors, we find that Applicant's mark, if used in connection with Applicant's identified goods, is likely to cause confusion with the mark and services shown in the cited registration.

Decision: The refusal to register Applicant's mark BYO PIZZA BUILD YOUR OWN PIZZA in stylized form is affirmed.