

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Mailed: July 10, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Zabar's & Co., Inc.  
v.  
Zaba's Grill, LLC

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Opposition No. 91163191  
to application Serial Nos. 78358762 and 78358819  
filed on 1/28/04

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Stephen L. Baker, John M. Rannells and Ryan A. McGonigle of  
Baker & Rannells PA for Zabar's & Co., Inc.

Burkeley N. Riggs and Leigh Augustine of Moye White LLP for  
Zaba's Grill, LLC.

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Before Seeherman, Walters and Cataldo,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

On January 28, 2004, applicant, Zaba's Grill, LLC,  
filed applications to register on the Principal Register the  
mark ZABA'S, in standard character form, and the mark shown  
below, both based upon an assertion of October 10, 2001 as

the date of first use of the marks anywhere and in commerce for "restaurant services," in International Class 43.<sup>1</sup>



Registration has been opposed by Zabar's & Co., Inc.

("opposer"). As grounds for opposition, opposer asserts that it provides numerous goods and services under the mark and trade name ZABAR'S in the fields of food catering services, retail store services and mail order services for gourmet foods and related items; that it is the owner of the following marks, previously used and registered on the Principal Register:

ZABAR'S

in typed or standard character form, for "food catering services, retail store services and mail order services for gourmet foods, gourmet cookware utensils, and gourmet books" in International Class 42<sup>2</sup>;

**ZABAR'S**

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<sup>1</sup> Application Serial Nos. 78358762 and 78358819.

<sup>2</sup> Registration No. 0947377 issued on November 14, 1972. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

for "food catering services, retail store services and mail order services for gourmet foods, gourmet cookware utensils, and gourmet books" in International Class 42<sup>3</sup>;

**NEW YORK IS ZABAR'S • ZABAR'S IS NEW YORK**

for "food catering services, retail store services and mail order services for gourmet foods, gourmet cookware utensils, and gourmet books" in International Class 42<sup>4</sup>; and

**ZABAR'S**

in standard character form for "olive oil and fruit preserves," in Class 29 and "coffee and barbeque sauce," in Class 30.<sup>5</sup> Opposer further asserts that its marks are famous; that applicant's marks, when used in connection with applicant's services, so resemble opposer's previously used and registered marks for its recited goods and services as to be likely to cause confusion, to cause mistake, and to deceive; that in addition, registration of applicant's marks will cause the distinctiveness of opposer's famous marks to be diluted; and that opposer will be damaged thereby.

Applicant's answer consists of a general denial of the allegations in the notice of opposition.<sup>6</sup>

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<sup>3</sup> Registration No. 0977006 issued on January 15, 1974. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

<sup>4</sup> Registration No. 2313197 issued on February 1, 2000 with a disclaimer of "NEW YORK." Section 8 affidavit accepted; Section 15 affidavit acknowledged.

<sup>5</sup> Registration No. 2726658 issued on June 17, 2003.

<sup>6</sup> In addition, applicant asserted certain "affirmative defenses" which we have construed as amplifications of its denials.

**Evidentiary Matters**

Before addressing the merits of the case, certain evidentiary matters require our attention. Each party has filed numerous objections against certain testimony and exhibits introduced by its adversary. Opposer has objected to 22 of applicant's 32 notices of reliance, while applicant, for its part, has objected to 30 of opposer's 34 notices of reliance. Each party has responded to the other's objections.

Opposer objects to applicant's notices of reliance upon the printed copies of screenshots of a page from opposer's Internet website (1<sup>st</sup>); the source code for such Internet website (2<sup>nd</sup>); printouts from the third-party Internet website clifbar.com (20<sup>th</sup>); printouts of Internet web pages from brittanica.com (27<sup>th</sup>); and a printout of an Internet web page from mapquest.com (28<sup>th</sup>), all on the ground that such Internet postings are not proper subject matter for a notice of reliance. We sustain these objections. See Trademark Rule 2.122(e); and Plyboo America Inc. v. Smith & Fong Co., 51 USPQ2d 1633, 1634 n.3 (TTAB 1999). Accordingly, the materials sought to be introduced by applicant in its 1<sup>st</sup>, 2<sup>nd</sup>, 20<sup>th</sup>, 27<sup>th</sup> and 28<sup>th</sup> Notice of Reliance have been given no consideration.

In addition, applicant's 8<sup>th</sup> and 9<sup>th</sup> Notices of Reliance upon the file histories of its involved applications are

redundant inasmuch as those applications automatically form part of the record in this proceeding. See Trademark Rule 2.122(b).

We note that the remaining objections raised by each party to its adversary's testimony and evidence are directed toward the probative value thereof. We further note that none of the testimony and/or exhibits sought to be excluded or restricted with regard to the purpose for which it has been submitted is outcome determinative. Given these facts, coupled with the total number of objections (52), we see no compelling reason to discuss the objections in a detailed fashion. Suffice it to say that, with the exception of the notices of reliance specifically excluded above, and the materials that may not be made of record by notice of reliance, as discussed infra, we have considered all of the testimony and exhibits submitted by the parties. In doing so, we have kept in mind the various objections raised by the parties, and we have accorded whatever probative value the subject testimony and exhibits merit.

#### **The Record**

In light of the foregoing, the record in this case consists of the pleadings and the files of the involved applications. In addition, during its assigned testimony period, opposer took the testimony deposition of Stanley Zabar, vice-president and treasurer of opposer, with

accompanying exhibits; and the testimony deposition of Lawrence Zilko, an employee of opposer, with accompanying exhibits. In addition, opposer submitted notices of reliance upon the following: status and title copies of its pleaded registrations; excerpts from printed publications; excerpts from printed articles and publications obtained from the Lexis Nexis search engine; and printed copies of search summaries as well as third-party applications and registrations which list in their identifications goods and services that are the same as those of the parties, obtained from the United States Patent and Trademark Office (USPTO) Trademark Electronic Search System (TESS).<sup>7</sup>

During its assigned testimony period, applicant took the testimony deposition of Robert Terkhorn, a partner and manager of applicant, along with accompanying exhibits; and the testimony deposition of Dr. John J. Burnett, a professor of marketing, along with accompanying exhibits including the results of a marketing research survey regarding public perception of the fame of opposer's marks and the similarity of the parties' marks. In addition, applicant filed notices of reliance upon the following: copies of opposer's pleaded

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<sup>7</sup> Opposer also submitted copies of the results of searches for "Zabar" and certain area codes that were obtained from the Verizon and whitepages.com Internet search engines, as well as copies of applicant's fax order forms. However, such documents cannot be made of record by notice of reliance, and as such are not properly of record. See Trademark Rule 2.122. Accordingly, they have not been considered.

registrations; copies of third-party applications and registrations for various ZABA-formative marks; printed copies of search summaries as well as third-party trademark applications and registrations of various ZA-, ZAB-, ZBAR-, and ZABA-formative marks obtained from the USPTO's TESS database; excerpts from Spanish language pronunciation guides; a printed copy of a magazine article; and applicant's unanswered requests for admission which, as discussed below, have been deemed to be admitted by opposer.<sup>8</sup>

With regard to applicant's admission requests, we note that in an order issued on April 23, 2007, the Board denied opposer's request to withdraw and amend its admissions occasioned by its failure to respond to such requests for admission. As a result, the following matters stand admitted:

1. Admit that Pico de Orizaba is the tallest mountain in Mexico;
2. Admit that Applicant's Mark is a contraction of "Orizaba;"
3. Admit that Applicant is a Mexican-style restaurant;

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<sup>8</sup> Applicant further submitted the results of a search of the Westlaw database and a Wikipedia dictionary definition. However, inasmuch as these documents cannot be made of record by notice of reliance, they have not been considered. See Id.

4. Admit that Zabar is the surname of Opponent's [sic] founders, Louis and Lillian Zabar;
5. Admit that Opposer is not a Mexican-style restaurant;
6. Admit that Opposer has maintained and continues to maintain an Internet website at [www.zabars.com](http://www.zabars.com) in connection with its business;
7. Admit that information presented at [www.zabars.com](http://www.zabars.com) is truthful and accurate;
8. Admit that information presented at [www.zabars.com](http://www.zabars.com) is [sic] truthfully and accurately represents the goods and services typically offered under the Opposer's Marks;
9. Admit that Exhibit 1 is a copy of the home page of Opposer's website at [www.zabars.com](http://www.zabars.com) as it has appeared on January 13, 2006;
10. Admit that the list of items sold in Exhibit 1 includes only bagels and breads, caviar, cheeses, coffee and tea, deli, desserts, dried fruit/nuts and candy, gift baskets and boxes, gift certificates, gourmet cakes by David Glass, housewares, oils and vinegars, preserves, smoked fish...and more, specialty corner, and Zabar's gear;<sup>9</sup>

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<sup>9</sup> The request for admission is as we have set it forth above, including the ellipses. We note that this is the same way the wording appears in Exhibit 1.



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11. Admit that the list of items sold in Exhibit 1 is intended by Opposer to describe items typically sold by Opposer under Opposer's marks;
12. Admit that the text of Exhibit 1 does not include the words "restaurant services;"
13. Admit that Exhibit 1 does not on its face refer to restaurant services;
14. Admit that Opposer is not currently engaged in providing restaurant services;
15. Admit that Opposer has not engaged in providing restaurant services within the last three years under Opposer's marks;
16. Admit that Opposer is not now and has never been engaged in selling Mexican-type foods, including burritos, tacos, and quesadillas;
17. Admit that Opposer is renowned for its lox and smoked salmon;
18. Admit that Opposer is not famous for its green chile, red chile, salsa, burritos, tacos or quesadillas;
19. Admit that with respect to every application for use of "Z" or combination with the letters or words "bar," "bars," or "ba" which application comes to the attention of Opposer, Opposer files an opposition to such application; and

20. Admit that Opposer is unaware of any actual confusion in the market place between Opposer and Applicant.

Opposer and applicant filed main briefs on the case, and opposer filed a reply brief.

### **Findings of Fact**

Opposer is the owner of Zabar's, a specialty store located in New York City that opened in 1934 and has been in continuous operation since that time.<sup>10</sup> Opposer provides a wide selection of foods, delicatessen and catering services, food bar/café services, and retail and mail order services in the field of gourmet foods, cookware and books under its trade name "Zabar's" and its pleaded ZABAR'S marks.<sup>11</sup>

Opposer ships its goods under its ZABAR'S marks throughout the United States as a result of orders received by means of mail, fax and telephone as well as opposer's Internet website.<sup>12</sup> Since 1998, opposer's annual sales have exceeded \$30 million. Since 1999, opposer has annually spent approximately \$500,000 on advertising its goods and services.<sup>13</sup> Opposer presently has approximately 40,000 email customers.<sup>14</sup> Approximately 5,000 customers visit opposer's store each week.<sup>15</sup> Opposer sends each of its

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<sup>10</sup> Zabar Testimony, p. 19.

<sup>11</sup> Id. at p. 78-79.

<sup>12</sup> Id. at p. 41-42.

<sup>13</sup> Id. at 64.

<sup>14</sup> Id. at 14.

<sup>15</sup> Id. at 69.

catalogs to approximately 500,000 people in the United States.<sup>16</sup> Opposer's Internet website receives approximately 2.5 to 3 million hits between the months of January and September, and as many as 10 million hits per month from October to December.<sup>17</sup> Opposer's Internet sales account for 8% of its total sales.<sup>18</sup> Opposer has sold prepared foods for over 25 years. Opposer also sells 20,000 pounds of coffee per week.<sup>19</sup> Opposer advertises in major publications such as the New York Times and Wall Street Journal.<sup>20</sup> Opposer also advertises in movie theaters in Los Angeles, California, and is preparing advertising to appear in Las Vegas, Chicago, Denver, and other major cities.<sup>21</sup> Opposer has been featured in articles in such publications as the Herald Tribune (1961), Cue Magazine (1963), the New York Times (1963, 2004, 2005), and the San Francisco Chronicle (2003).<sup>22</sup> Opposer's store was also referenced in motion pictures including "When Harry Met Sally," "You've Got Mail," "Something's Gotta Give," "Superman," "Manhattan," "Annie Hall," and "Prince of Tides," and the television show "Seinfeld."<sup>23</sup> Further, opposer's goods and services have

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<sup>16</sup> Id. at 47.

<sup>17</sup> Zilko Testimony, p. 9.

<sup>18</sup> Id. at 11.

<sup>19</sup> Zabar Testimony, p. 40, 43.

<sup>20</sup> Id. at 60-61.

<sup>21</sup> Id. at 61-63.

<sup>22</sup> Id. at 65-69, Notice of Reliance Nos. 2-5, 7-8, 10, 15-21, 23-26.

<sup>23</sup> Id. at 75-79.

been featured in such trade publications as CBS MarketWatch and Nation's Restaurant News, as well as tourist and review publications such as Zagat Survey 2006, New York City Marketplace, and Zagat Survey 2006, New York City Restaurants.<sup>24</sup> In addition, opposer has received unsolicited reviews of its goods and services in such publications as Bon Appetit, Wine Spectator and Food and Wine as well as newspapers such as the Washington Post, USA Today, and the Chicago Tribune and magazines such as Newsweek, Forbes, and People Magazine.<sup>25</sup>

Applicant is the owner of Zaba's Grill, a Mexican restaurant that opened in Las Vegas, Nevada in 2001 and has since added two more locations in the same area.<sup>26</sup> Applicant derived the name "Zaba's" from "Pico de Orizaba," the tallest mountain in Mexico.<sup>27</sup> Zaba's is a "fast-casual" type of restaurant that does not offer table service and which applicant describes as akin to Boston Market, Chipotle Mexican Grill, etc.<sup>28</sup> Zaba's Grill only serves fresh Mexican food that is prepared before customers' eyes and is intended for immediate consumption.<sup>29</sup> Zaba's Grill does not use preservatives, package food for later consumption, offer

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<sup>24</sup> Notice of Reliance Nos. 4, 13 and 23.

<sup>25</sup> Notice of Reliance Nos. 2-5, 7-8, 10, 12-21, 23-26, 32.

<sup>26</sup> Terkhorn Testimony, p. 6-7.

<sup>27</sup> Id. at 9, Admission Nos. 1-2, Notice of Reliance No. 27.

<sup>28</sup> Id. at 8-9, Notice of Reliance No. 32.

<sup>29</sup> Id., Exhibit 4.

catering services, or sell food by means of mail order or the Internet.<sup>30</sup> Approximately 60% of applicant's customers purchase and eat their food at the restaurant while the remainder orders their food to go or pre-orders via fax. Applicant does not offer drive through service or delivery.<sup>31</sup> Applicant offers five basic menu choices that may be customized in a variety of ways. The most expensive item on applicant's menu is \$6.75.<sup>32</sup>

**Opposer's Standing and Priority of Use**

Because opposer has properly made its pleaded registrations of record, we find that opposer has established its standing to oppose registration of applicant's marks. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks therein and goods and services covered thereby. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). We further note that applicant does not contest that opposer has made prior use of the marks in its pleaded registrations.

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<sup>30</sup> Id. at 21, 43.

<sup>31</sup> Id. at 11, 21, 87-90.

<sup>32</sup> Id., Exhibit 4.

### **Likelihood of Confusion**

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

#### Fame of Opposer's Mark ZABAR'S<sup>33</sup>

We begin our likelihood of confusion analysis with the fifth du Pont factor, which requires us to consider evidence of the fame of opposer's mark and to give great weight to such evidence if it exists. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the DuPont factors," *Recot*, 214 F.3d

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<sup>33</sup> We have referred to opposer's mark, whether in typed format or stylized form, as ZABAR'S. We note that opposer does not specifically contend or offer evidence that its mark NEW YORK IS ZABAR'S·ZABAR'S IS NEW YORK is famous.

at 1327, 54 USPQ2d at 1456, and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

*Bose Corp. v. QSC Audio Products Inc.*, supra, 63 USPQ2d at 1305.

Upon careful review of the record in this case, we are not persuaded that opposer's mark ZABAR'S is famous. As noted above, opposer has introduced testimony and evidence regarding its sales and advertising, as well as recognition of its ZABAR'S mark in various media. Applicant, for its part, introduced the above-referenced survey and related testimony in support of its contention that opposer's mark is not famous. Opposer strongly contests the validity of applicant's survey based upon asserted flaws in its design and implementation. However, even if we do not consider applicant's survey and concentrate solely on opposer's evidence of fame, we find that such evidence falls short of demonstrating that its mark is famous.

The evidence of record shows that opposer is something of an institution in the City of New York. Opposer has been in business since 1934 and currently receives 5,000 customers per week, suggesting that it has enjoyed a

significant degree of success. Further, opposer's ZABAR'S mark has appeared in movies and the television show, Seinfeld, that are set in New York. However, despite opposer's notoriety in New York, it is not clear from the record how many people outside of the New York area are familiar with the mark ZABAR'S. Although opposer has provided evidence that it distributes 500,000 catalogs, it is not clear to whom these catalogs are sent, e.g., how many of these customers are located in or near New York City. Further, it is not clear what the hits on opposer's website signify, that is, whether many of them represent multiple hits by the same people, or represent casual hits as individuals surf the Internet looking for a search term such as "lox" or some other product available in opposer's store. Similarly, it is unclear from the record the extent to which opposer's facsimile and email orders are confined to the New York area or represent orders placed nationwide. In other words, we simply cannot determine from the evidence whether such sales reach people throughout the United States, or whether the sales are primarily in the New York area and the Los Angeles area, which are the two areas where opposer's advertising is concentrated. We note in addition that opposer's \$500,000 annual advertising figure is very low, compared to annual advertising figures for other marks we have found to be famous. See, for example, Motion



Picture Association of America, Inc. v. Respect Sportswear Inc., 83 USPQ2d 1555 (TTAB 2007) (opposer's member annually spent 4 billion dollars on advertisements and promotion). We have no doubt that opposer has attained a degree of renown as a New York City establishment and among gourmet food enthusiasts. However, such evidence of regional or niche fame falls short of demonstrating that awareness of opposer's products and services among those segments of the population translates into widespread recognition of the mark.

Accordingly, we find on this record that the evidence falls short of establishing that opposer's mark ZABAR'S is famous for purposes of our likelihood of confusion determination.

Nevertheless, we find that the evidence is sufficient to show that opposer's mark ZABAR'S has achieved at least a degree of recognition and strength in the market and that the mark therefore is entitled to a broader scope of protection than might be accorded a less distinctive mark. In coming to this determination, we have considered all of the evidence relevant thereto, including applicant's evidence, more fully discussed below, of third-party registrations of various "Z" formative marks.

The Marks

In this case, we will concentrate our discussion of the issue of likelihood of confusion on that registration of opposer's which is closest to the marks and services for which applicant is seeking registration, namely, opposer's registration for ZABAR'S in standard character form, for "food catering services, retail store services and mail order services for gourmet foods, gourmet cookware utensils, and gourmet books" in International Class 42.<sup>34</sup>

We turn to the first du Pont factor, i.e., whether applicant's marks and opposer's ZABAR'S mark, registered in standard character form, are similar or dissimilar when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot*, supra. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result.

In this case, we find that applicant's marks,

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<sup>34</sup> Registration No. 0947377, supra.

ZABA'S and



are highly similar to opposer's ZABAR'S mark in appearance. The only difference between opposer's ZABAR'S mark and applicant's ZABA'S mark is the presence of the letter "R" in opposer's mark. However, because of where the "R" is placed, consumers who are familiar with opposer's ZABAR'S mark are not likely to notice that it is absent in applicant's ZABA'S mark, and therefore the absence of the letter "R" from applicant's mark does little to distinguish it from that of opposer. Further, the stylization of applicant's ZABA'S and design mark does not serve to distinguish it from opposer's ZABAR'S mark: opposer's mark is registered in standard character form and thus could be displayed in lettering similar, or even identical, to applicant's ZABA'S and design mark. See, e.g., *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); and *Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744, 1751 (TTAB 1987). The presence of the flame design in applicant's ZABA'S and design mark is not a significant distinguishing element either; because it is by the literal portion, ZABA'S, that consumers will refer to the trademark, it is this portion that is likely to be

remembered rather than the less conspicuous flame design. See *In re Appetito Provisions Co.*, 3 USPQ2d 1552 (TTAB 1987) (if a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services.) Accordingly, we find that applicant's marks are highly similar in appearance to opposer's ZABAR'S mark.

The fact that the marks have nearly identical literal elements also results in their being nearly identical in sound. We note that both parties devote substantial arguments, as well as evidence, to the asserted pronunciations of their marks. However, it is well settled that there is no correct pronunciation of a trademark. See *In re Belgrade Shoe*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969); and *Interlego AG v. Abrams/Gentile Entertainment Inc.*, 63 USPQ2d 1862 (TTAB 2002). As a result, the parties' arguments regarding, for example, the proper pronunciation of their respective marks, and the effect of regional dialects upon such pronunciation, are unavailing. See *In re Microsoft Corp.*, 68 USPQ2d 1195 (TTAB 2003) (it is not possible to control how consumers will vocalize marks). In this case, there is no basis for us to assume that the letters common to ZABAR'S and ZABA'S will be pronounced one way for one mark and a different way for the other. Nor does the presence of the letter "R" as the penultimate

letter of opposer's mark result in a significant difference in its pronunciation from that of applicant's marks, as the placement of this letter does not lend to it being emphasized, or perhaps even vocalized.

As for connotation, we note applicant's argument that "Zabar" is a surname and that ZABA'S is derived from the name of the tallest mountain in Mexico. However, aside from opposer's admission that "Zabar" is the surname of its founders, applicant has submitted little, if any, admissible evidence that consumers would perceive the surname significance of opposer's ZABAR'S mark. Furthermore, it is unclear whether consumers would perceive that ZABA'S is derived from "Pico de Orizaba" such that the asserted differences in the marks' connotations would be apparent. It is just as likely that consumers will view both ZABAR'S and ZABA'S as coined words or will view both as surnames.

Nor are we persuaded by applicant's argument that "the Board should...consider the marks as consumers encounter them in the marketplace, first at Zaba's Grill restaurants and then at Zabar's" (brief, p. 17). Applicant argues that its customers will encounter its marks in connection with "some or all of the Zaba Grill design mark on the store front or menu" and that under such circumstances, "the phrase 'Mexican Grill' accompanies the design mark which nullifies any likelihood of confusion" (Id.). Applicant further

argues that consumers encountering opposer's ZABAR'S mark in its store or by means of its catering services will note that the mark denotes goods and services that are very different from applicant's services.

First, to the extent applicant is arguing that we must consider its applied-for marks in the context of additional matter that is not part of those marks, it is established that for purposes of evaluating the similarities or dissimilarities between the parties' marks, we must look to the marks as they appear in applicant's involved applications and opposer's pleaded registration. Second, To the extent that applicant is arguing that its marks are used in connection with a Mexican restaurant while opposer's is used in connection with a New York gourmet market and catering service, and that they will have different connotations resulting from customers' experiences of those marks, applicant seeks to impermissibly narrow the scope of the parties' services. As discussed below, applicant's restaurant services are not limited to Mexican restaurants; nor are opposer's services limited to a "New York style" gourmet food store and catering. As a result, we cannot accept applicant's argument that consumers will view its mark as having the connotation of a Mexican mountain.

Likewise, there is nothing in the record to support a finding that the marks, consisting of nearly identical

literal elements, convey different commercial impressions. Nor does the addition of the flame design, which is a rather non-distinctive element for restaurant services as it merely indicates heat is used in food preparation, suffice to create a commercial impression that is significantly different from that of opposer's mark. We find, therefore, that the marks convey similar commercial impressions.

In view of the nearly identical nature of applicant's ZABA'S and ZABA'S and design marks and opposer's ZABAR'S mark in appearance, and the similar nature of the marks in sound, connotation and overall commercial impression, this du Pont factor favors opposer.<sup>35</sup>

#### The Services

With respect to the services, it is well-established that the services of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing thereof are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the

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<sup>35</sup> Inasmuch as we have found that applicant's mark is nearly identical to opposer's mark, ZABAR'S, in standard character form, it is not necessary for us to consider the similarities between applicant's mark and the marks in opposer's other pleaded registrations or for which it claims common law usage.

marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the parties' services, but rather whether there is a likelihood of confusion as to the source thereof. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

We base our determination of the similarity or dissimilarity between the parties' respective services, as we must, upon the services recited in the involved applications and opposer's above-noted registration for its ZABAR'S mark. See *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.") In that regard, we observe that, as identified, opposer's services under its ZABAR'S mark all concern food and food preparation; namely, food catering, as well as retail store and mail order services in the fields of gourmet foods.<sup>36</sup> Applicant's services, as identified in

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<sup>36</sup> We note that opposer's registration also includes, as part of its services, the sale of gourmet cookware utensils and gourmet books. It is not necessary, in order to find a likelihood of confusion, that confusion be shown with respect to each item in an opposer's registration. See *Tuxedo Monopoly, Inc. v. General*



its subject applications, also concern food and food preparation; namely, restaurant services. Because neither opposer's nor applicant's recitation of services articulates any limitations as to the type, ethnicity, or cuisine of the food provided under their marks, we must presume that applicant's restaurants as well as opposer's catering and retail and mail order gourmet food services encompass any and all foods typically identified thereby. See *Id.* See also *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") Thus, we give no effect to opposer's admissions that applicant is a Mexican-style restaurant (No. 3); that opposer does not sell Mexican foods (No. 16); or any admission or other evidence that would place limitations on the parties' services as

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*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).

identified in their respective registration and applications.

On the record in this case, we find that opposer's "food catering services, retail store services and mail order services for gourmet foods" identified in its registration are related to applicant's restaurant services. First, we note that catering is commonly understood to entail the same activities as those of a restaurant, namely, the provision of prepared food for consumption by others. In addition, applicant's expert witness, Dr. John J. Burnett, acknowledged in his testimony that it is not uncommon for restaurants to also offer catering services:

Q. Oh, okay. Are you familiar with any restaurants that offer catering services?

A. Yes.

Q. Do you recall the names of those restaurants?

A. There are several in Denver that offer catering services; the Wellshire Inn offers catering services; there are a number of restaurants in the Denver downtown area that offer catering services. So, yes, it's quite common.<sup>37</sup>

Thus, the testimony of applicant's own expert witness further establishes a relationship between restaurants and catering services. We further note that applicant

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<sup>37</sup> Burnett Testimony, p. 84-85.

acknowledges opposer "has a small café on location at its retail store" (brief, p. 10) which opposer describes as "take-out" or a "food bar" (Id.). While opposer admits that such a café is not a restaurant, we find nonetheless that the purpose of opposer's café is to provide take away food for consumption by its customers. Thus, opposer's own operation of a retail gourmet food store with a "take-out" café on the premises establishes a relationship between such food store and restaurant services.<sup>38</sup>

In addition, opposer has submitted by notice of reliance a number of use-based third-party registrations which show that various entities have adopted and registered a single mark for restaurant services on the one hand and catering and food store services on the other, that is, for substantially similar services to those identified in applicant's applications and opposer's registration. Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent

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<sup>38</sup> Because we have limited our discussion of opposer's marks to the ZABAR'S mark in its pleaded Registration No. 0947377, we have not considered opposer's claim of likelihood of confusion based on its common law rights in the mark ZABAR'S CAFÉ for café services. Rather, our reference to opposer's café services, discussed above, relates solely to the question of whether opposer's services as identified in its registration are similar to applicant's identified services.

that they serve to suggest that the listed services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

The following examples are illustrative:

Registration No. 3076586 for restaurants, restaurant services, catering, carry-out restaurant services, take out restaurant services;

Registration No. 3079692 for services for providing food and drink, namely, restaurant, catering, bar and take-out food services;

Registration No. 3100258 for restaurant and catering services, namely, providing food and drinks to others;

Registration No. 2959167 for catering, food preparation, restaurant services, take-out restaurant services;

Registration No. 2859600 for retail grocery store and retail delicatessen services, restaurant services and catering services;

Registration No. 3100709 for retail store services featuring foods and gifts relating to food, on-line retail store featuring food and gifts relating to food, restaurant and carryout food service; and

Registration No. 2967126 for retail store and mail order catalog services and on-line retail store services, all featuring food products and services, restaurant and catering services.

Thus, the record in this case supports a finding that opposer's and applicant's services are related. In view thereof, this du Pont factor also favors opposer.

#### Channels of Trade

Because there are no recited restrictions as to the channels of trade or classes of purchasers in the services

identified in either opposer's pleaded registration or the involved applications, we must assume that the services are available in all the normal channels of trade to all the usual purchasers for such goods and services. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, supra. See also *Paula Payne Products v. Johnson Publishing Co.*, supra. As such, the parties' services are presumed to be marketed to the general public through all normal trade channels therefor. Furthermore, the services of both parties, as identified, are the type of services that are offered to the general public and, therefore, the classes of consumers are the same. Thus, we are not persuaded by applicant's arguments regarding asserted differences in the preparation, presentation, price, and distribution methods of the food products available by means of the parties' services because such differences are neither reflected in the recitations thereof, nor are the parties' services of such a specialized nature as to suggest distinct classes of consumers.

As a result of the foregoing, this du Pont factor also favors opposer.

Conditions of Sale

The next du Pont factor discussed by the parties is that of the conditions of sale. Applicant asserts that the food items available at its restaurants are inexpensive,

while opposer offers expensive products at its retail store that would be purchased by careful and sophisticated users. To the extent that applicant is suggesting that the costs of the items the parties sell would differentiate the services, we have already explained that we must consider the services as they are identified in the respective registration and applications. To the extent that applicant is acknowledging that the low cost of its food items means that consumers will not exercise a great deal of care in selecting its restaurant services, that would favor a finding of likelihood of confusion, because such consumers are less likely to notice that applicant's mark does not contain the letter "R" present in opposer's mark. In addition, the evidence in this case shows that opposer sells goods that have a broad price range, including low cost items. Thus, consumers may go into opposer's store on impulse in order to purchase modestly priced items such as a bagel or coffee.

As a result, we find this du Pont factor to favor opposer.

#### Registration of Similar Marks

In its brief, applicant refers to a number of third-party ZA-formative marks registered in connection with various goods and services.<sup>39</sup> We note, however, that most

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<sup>39</sup> Applicant has also listed additional third-party registrations in a summary from the USPTO's TESS search engine. This summary, however, does not make the listed registrations of record. To

of these third-party registrations are for marks that are more dissimilar to opposer's pleaded mark than applicant's involved marks. Such marks include the following: ABBA-ZABA; ZAYDA'S; ZAGARA'S and design; ZABELLA; ZANARO'S; and ZARELA. We further note that Registration No. 3074961 for the more similar mark ZABA recites various customized search services that are far removed from the services at issue herein. As a result, we cannot say that these registrations demonstrate that ZABAR'S is a weak mark that is entitled to a limited scope of protection. Because of the differences in the third-party marks and goods/services, we cannot accept applicant's argument that, because the Patent and Trademark Office determined that these marks can coexist, that there is no likelihood of confusion between applicant's marks and opposer's mark.<sup>40</sup>

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make third-party registrations of record, a party must submit a copy of the registration or a printout of such registration from the USPTO's electronic database. In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974) ("[T]he submission of a list of registrations is insufficient to make them of record."). Furthermore, applicant's submission of third-party applications is entitled to no probative value because applications are only evidence that an applicant has filed for registration of a mark. See In re Phillips-Van Heusen Corp., 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

<sup>40</sup> We also point out that third-party registrations are not evidence that the marks shown therein are in use. See Smith Bros. Mfg. Co. v. Stone Mfg. Co., 476 F.2d 1004, 177 USPQ 462 (CCPA 1973). Thus, they have no probative value with respect to the du Pont factor of the number and nature of similar marks that are in use for similar goods and services.

Actual Confusion

The final du Pont factor discussed by the parties is the lack of instances of actual confusion despite over six years of use by the parties of their respective marks. Applicant asserts that the absence of actual confusion suggests no likelihood of confusion. We note however, that it is often difficult to adduce reliable evidence of actual confusion. Furthermore, it is not necessary to show actual confusion in order to establish likelihood of confusion. See Weiss Associates Inc. v. HRL Associates Inc. 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990).

Accordingly, this du Pont factor must be considered to be neutral.

**Conclusion**

We have carefully considered all of the evidence pertaining to priority of use and the relevant du Pont factors, as well as all of the parties' arguments with respect thereto, including any evidence and arguments not specifically discussed in this opinion.

We conclude that opposer has established priority of use and that consumers familiar with opposer's services under its ZABAR'S mark would be likely to believe, upon encountering applicant's ZABA'S and ZABA'S and design marks for its recited services, that the parties' services originate with or are associated with or sponsored by the



same entity. In making our determination, we have balanced the relevant du Pont factors. The factors of the similarity between the marks and the relatedness of the services weigh strongly in opposer's favor.

**Dilution**

Given our determination that there is a likelihood of confusion herein, we decline to reach a determination on the question of dilution in this proceeding.

DECISION: The opposition is sustained, and registration to applicant is refused on the ground of priority and likelihood of confusion.