

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

CNL Tampa International Hotel Partnership, LP
v.
Laurie A. Gomulka Palazzolo

Opposition No. 91163724
to application Serial No. 78332205
filed on November 24, 2003

Julia L. Frey of Lowndes, Drosdick, Doster, Kantor & Reed,
P.A. for CNL Tampa International Hotel Partnership, LP.

Kevin G. Mierzwa of Harness, Dickey & Pierce, P.L.C. for
Laurie A. Gomulka Palazzolo.

Before Holtzman, Walsh, and Bergsman, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Laurie A. Gomulka Palazzolo filed an intent-to-use application for the mark the PELAGIA for "clothing, namely shirts."¹ CNL Tampa International Hotel Partnership, LP opposed the registration of applicant's mark on the ground of priority of use and likelihood of confusion alleging as its grounds for opposition the following:

¹ Application Serial No. 78332205, filed November 24, 2003.

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1. Opposer filed an intent-to-use application for the mark PELAGIA (Serial No. 76554522) for "restaurant services" on October 27, 2003;²
2. Opposer had already begun using the mark by the time the opposition was filed and has since widely publicized the its PELAGIA restaurant services;
3. Opposer intends to use the mark PELAGIA for clothing;
4. Opposer's mark and applicant's mark are identical;
5. Restaurant services and clothing are related products because clothing is within the natural scope of expansion for restaurant services; and,
6. Applicant's mark PELAGIA if used in connection with shirts so resembles opposer's mark PELAGIA for restaurant services as to be likely to cause confusion.

Applicant admitted that the marks were identical but denied the remaining pertinent allegations in the notice of opposition.

The case has been fully briefed.

The Record

By operation of the rules, the record includes the pleadings and the application file of the mark sought to be registered. In addition, opposer filed two notices of reliance: (1) a notice of reliance filed pursuant to Trademark Rule 2.122(e) on a plain copy of opposer's

² Application Serial No. 76554522 matured into Registration No. 2,977,778 on July 26, 2005. Opposer claimed August 11, 2004 as the dates of first use anywhere and first use in commerce. The registration includes the following translation: "The English translation of 'Pelagia' is 'from the sea'."

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Registration No. 2,977,778; and, (2) a notice of reliance filed pursuant to Trademark Rule 2.122(e) on copies of one hundred two (102) third-party registrations registered for both restaurant services and clothing.

A federal registration owned by a plaintiff may be made of record in one of three ways:

1. Plaintiff pleads ownership of the registration and attaches two copies of the registration prepared by the U.S. Patent and Trademark Office showing the current status and title to the registration;³
2. Plaintiff files a notice of reliance on the registration and attaches a copy of the registration prepared by the U.S. Patent and Trademark Office showing the current status and title to the registration;⁴ or,
3. During the plaintiff's testimony period, a witness having knowledge of the current status and title of the registration testifies regarding the current status and title of the registration.⁵

In addition, a federal registration owned by a plaintiff will be deemed of record if the defendant's answer to the complaint contains admissions sufficient to establish current status and title.⁶ Similarly, a registration owned by a plaintiff will be deemed of record even though it has not been properly made of record if the defendant in its brief, or otherwise, treats the registration as being of record.⁷

³ Trademark Rule 2.122(d)(1); 37 CFR 2.122(d)(1).

⁴ Trademark Rule 2.122(d)(2); 37 CFR 2.122(d)(2).

⁵ Trademark Rule 2.122(d)(2); 37 CFR 2.122(d)(2).

⁶ TBMP §704.03(b)(1)(A) (2nd ed. rev. 2004).

⁷ *Id.*

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Opposer did not properly introduce its registration into the record because it did not submit a copy of its registration prepared by the U.S. Patent and Trademark Office showing the current status and title of the registration. However, applicant did not object to opposer's registration and, in her brief, treated the registration as though it were properly made of record. Applicant made the following admissions in her brief:

1. Applicant agrees that the Opposer's registration was filed and registered prior to the use of the mark by Applicant; and,
2. Applicant agrees that Opposer's mark was granted a U.S. registration on July 26, 2005 and assigned Registration No. 2,977,778.⁸

In view thereof, we have treated the registration as being of record. *Local Trademarks Inc. v. The Handy Boys Inc.*, 16 UPSQ2d 1156, 1157 n.5 (TTAB 1990); *Floralife, Inc. v. Floraline International Inc.*, 225 UPSQ 683, 684 n.6 (TTAB 1984). See also, TBMP §704.03(b)(1)(A) (2nd ed. rev. 2004).

With respect to opposer's third-party registrations introduced "to demonstrate the natural expansion of the areas under the restaurant service mark and the practice of licensing marks for both clothing and restaurant services,"⁹ we will only consider the registrations based on use in commerce. Registrations under Sections 44 and 66 of the

⁸ Applicant's Brief, p. 2.

⁹ Opposer's Notice of Reliance, p. 6.

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Lanham Act have very little persuasive value. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 UPSQ2d 1467, 1470 (TTAB 1988).

Standing and Priority

Because opposer's Registration No. 2,977,778 is considered to be of record, opposer has established a real interest in this proceeding and, therefore, its standing to oppose applicant's application. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Because opposer's registration is of record, priority is not an issue in regard to opposer's claim under Section 2(d) as to the mark (PELAGIA) and the services covered by that registration (restaurant services). *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

This brings us to the issue of likelihood of confusion. Our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the factors set for in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re*

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Majestic Distilling Co., Inc., 315 F.3d 1311, 65 UPSQ2d 1201, 1203 (Fed. Cir. 2003).

In this case, the only probative facts in evidence regarding the relatedness of the parties' goods and services are the copies of third-party registrations for both restaurant services and clothing. The third-party registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them. However, the registrations "**may** have some probative value to the extent that they serve to **suggest** that the listed goods and/or services are of a type that may emanate from a single source." *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993) (emphasis added). See also, *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

Because the only facts in evidence are the third-party registrations, we cannot give any consideration to the following arguments made by opposer:

1. Opposer is using the PELAGIA mark in connection with catering, banquets, aprons, chocolate bars, and other collateral materials;¹⁰
2. Consumers are accustomed to seeing the mark PELAGIA used in connection with restaurant services;¹¹
3. Opposer's mark is widely known;¹²

¹⁰ Opposer's Brief, p. 5.

¹¹ *Id.*

¹² *Id.*

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4. Opposer has widely advertised and publicized its mark;¹³
5. Opposer has received unsolicited publicity;¹⁴
6. Opposer has generated significant revenues;¹⁵ and,
7. Opposer plans to expand the use of its mark to include clothing.¹⁶

By the same token, we cannot give any consideration to the following arguments made by applicant:

1. Opposer's use of the PELAGIA trademark on the collateral materials is merely ornamental;¹⁷
2. Applicant has advertised its mark for use in connection with clothing;¹⁸
3. Applicant has sold its PELAGIA shirts;¹⁹
4. Applicant has a website where it offers its PELAGIA shirts for sale;²⁰
5. Opposer's restaurant is a "fine-dining," "upscale" restaurant;²¹
6. "Fine-dining" restaurants do not typically sell clothing;²²
7. Opposer's dishes are priced from \$31-\$50;²³ and,
8. Applicant's PELAGIA shirts sell for \$14.²⁴

¹³ *Id.*

¹⁴ *Id.*

¹⁵ *Id.*

¹⁶ *Id.* at p. 6.

¹⁷ Applicant's Brief, p. 3.

¹⁸ *Id.* at p. 4.

¹⁹ *Id.*

²⁰ *Id.*

²¹ *Id.* at p. 5.

²² *Id.*

²³ *Id.*

²⁴ *Id.*

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Because the marks are identical, the central issue in this case is whether restaurant services and shirts are related. Comparing applicant's shirts with opposer's restaurant services, it is obvious that they are distinctly different. However, in analyzing the similarity or dissimilarity of the goods and services, it is not necessary that the products and services of the applicant and opposer be similar or even competitive to support a finding of likelihood of confusion. Likelihood of confusion may be found if the respective products and services are related in some manner and/or if the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under conditions that could give rise to the mistaken belief that they emanate from the same source. *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); *Seaguard Corporation v. Seaward International, Inc.*, 223 USPQ 48, 51 (TTAB 1984).

In this regard, opposer argues that the third-party registrations prove that its proposed use of PELAGIA in connection with clothing is within the natural scope of expansion of its use of PELAGIA in connection with restaurant services and, therefore, restaurant services and clothing are related items because "a normal outgrowth of restaurant services is the production and sale of

clothing.”²⁵ However, for the reasons set forth below, we will not draw an inference from the third-party registrations that restaurant services and clothing are legally related products such that the use of PELAGIA in connection with shirts so resembles PELAGIA for restaurant services as to be likely to cause confusion.

Under the doctrine of “natural expansion,” the first user of a mark in connection with particular goods or services possesses superior rights in the mark against subsequent users for the same or similar marks for the same or similar goods, as well as for any goods or services which consumers might reasonably expect to emanate from the first user in the normal expansion of its business. *Mason Engineering v. Mateson Chemical*, 225 USPQ 956, 962 (TTAB 1985). In this case, the doctrine of “natural expansion” would apply if the evidence shows that consumers would generally expect that restaurant services and shirts emanate from the same source.

In determining whether an expansion, either actual or potential, is natural, we consider the following factors:

1. Whether the second area of business (that is, the subsequent user’s area of business into which the first user has or potentially may expand) is a distinct departure from the first area of business (of the prior user), thereby requiring a new technology or know-how, or whether it is merely an extension of the technology involved in the first area of business;

²⁵ Opposer’s Brief, p. 6.

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2. The nature and purpose of the goods or services in each area;
3. Whether the channels of trade and classes of customers for the two areas of business are the same, so that the goodwill established by the prior user in its first area of business would carry over into the second area; and,
4. Whether other companies have expanded from one area to the other.

Id.

Because opposer relied only on third-party registrations, the evidence falls far short of the type of evidentiary showing necessary to establish the facts supporting the doctrine of "natural expansion." That is, opposer has failed to prove that purchasers generally expect restaurant services and shirts to emanate from a single source.

In cases where the senior user's trademark rights have been expanded beyond its core business to encompass "collateral materials," the evidence has shown that the senior user's mark is well-known, if not famous, as a result of extensive advertising and promotion and that the senior user has made use of its mark on "collateral materials." *See, Black and Decker Manufacturing v. Big Yank Manufacturing*, 231 USPQ 484 (TTAB 1986); *In re Phillips-Van Heusen Corporation*, 228 USPQ 949, 951 (TTAB 1986); *Bridgestone Tire Co., Ltd. v. Bridgestone Trading Co.*, 221 USPQ 1012 (TTAB 1984); *Hurst Performance, Inc. v. Trosten*

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Hallman Racing, Inc., 207 USPQ 671 (TTAB 1980); *Amica Mutual Insurance Co. v. R. H. Cosmetics Corp.*, 204 USPQ 155 (TTAB 1979). Moreover, we have previously explained that the mere recognition of the greater diversity and expansion of businesses in a modern economy is not, in and of itself, sufficient to support an inference that purchasers are apt to believe that disparate products or services emanate from the same source. *In re American Olean Tile Co.*, 1 UPSQ2d 1823, 1826 (TTAB 1986). In short, opposer failed to offer persuasive evidence that it has prior rights in the mark PELAGIA used in connection with shirts.

Finally, if we accepted opposer's argument that the third-party registrations alone were sufficient evidence to prove that restaurant services and clothing are legally related, we would, in essence, be creating a *per se* rule that the same or similar marks for restaurant services and clothing is likely to cause confusion. Thus, not only would the senior user of a mark for restaurant services have prior rights for that mark for clothing, but the senior user of a mark for clothing would have prior rights for that mark for restaurant services. But that is just the start. Based on opposer's third-party registrations, restaurant services and clothing are also related to housewares, glassware, toys, sporting equipment, ashtrays, cigarette lighters, key chains, license plate holders, cooking pans and utensils,

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jewelry, real estate development services, gun firing ranges, casinos, hotels, exercise classes, loose-leaf binders, aromatherapy and massage services, and chairs. Taken to its absurd extreme, if third-party registrations alone are considered sufficient to prove that goods and services are related, then virtually all consumer products and services would be related. Accordingly, a *per se* rule regarding the relatedness of goods and services is contrary to trademark law which requires that each case be decided on the basis of all of the relevant facts in evidence. *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 152 (CCPA 1978); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629, 630 (TTAB 1977).

In view of the foregoing, we find that the use of the mark PELAGIA if used in connection with "clothing, namely shirts" does not so resemble the mark PELAGIA used in connection with restaurant services as to be likely to cause confusion, to cause mistake, or to deceive.

Decision: The opposition is dismissed.