

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

Mailed: November 30, 2010

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Satek, Inc.

v.

B.C. Pizza, Inc.

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Opposition No. 91171803  
to application Serial No. 78408745  
filed on April 27, 2004

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Scott W. Satek, pro se for Satek, Inc.

Timothy J. Jordan of Garan Lucow Miller, P.C. for B.C.  
Pizza, Inc.

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Before Seeherman, Kuhlke and Mermelstein, Administrative  
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, B.C. Pizza, Inc., seeks registration of the  
mark B.C. PIZZA in standard characters with PIZZA disclaimed  
for services identified in the application as "dine in and

carry out services featuring pizza and other Italian related cuisine and drinks" in International Class 43.<sup>1</sup>

Opposer, Setak, Inc., has opposed registration of applicant's mark on the ground that, as used in connection with applicant's services, the mark so resembles opposer's previously used and registered mark B&C PIZZA for restaurant services<sup>2</sup> as to be likely to cause confusion under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

Applicant has filed an answer denying the salient allegations of the notice of opposition. In addition, applicant filed a counterclaim against opposer's pleaded registration.

The evidence of record consists of the pleadings herein and the files of the opposed application and the registration sought to be cancelled. In addition, opposer submitted, under a notice of reliance, a copy of opposer's pleaded registration,<sup>3</sup> an excerpt of an order from the

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<sup>1</sup> Serial No. 78408745, filed April 27, 2004, based on a claimed date of first use in commerce of 1998 under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a).

<sup>2</sup> Registration No. 3031683, issued on December 20, 2005, based on an application filed June 28, 2004, for the mark B&C PIZZA in standard characters, claiming January 1, 1979 as the first use in commerce and disclaiming the word PIZZA.

<sup>3</sup> We note that opposer submitted a copy of the registration from the time it issued, which does not show the current status and title of the registration. However, the filing of the counterclaims made opposer's pleaded registration of record as the subject of the counterclaims. We further note that applicant does not dispute the status or title of opposer's pleaded registration and has treated it as being of record.

Michigan Circuit Court granting opposer's motion for partial summary disposition in a civil proceeding between these parties, opposer's Michigan state trademark registration for the mark B&C Pizza, and opposer's Michigan state certificate of assumed name.

Applicant did not take any testimony or file a notice of reliance. The material attached to applicant's brief is untimely and has been given no consideration.<sup>4</sup> We further note that the unilaterally proffered unsigned "concurrent use agreement" attached to applicant's brief and applicant's arguments concerning possible concurrent use in its brief are not proper subject matter for an opposition proceeding. On two separate occasions the Board advised the parties on this issue and provided guidance as to the procedure for dismissing the opposition in favor of a concurrent use proceeding. In view thereof, opposer's motion, presented in its reply brief, to strike the documents attached to applicant's brief, is granted.

In its reply brief, opposer also moves to strike applicant's brief as untimely. The brief was received in the Office on June 1, 2010. In response, applicant argues that it mailed the brief, by first class mail, on the due

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<sup>4</sup> The fact that one of the documents had been previously submitted in support of a motion for summary judgment does not make it of record for purposes of trial. The parties were advised of this in the Board's order denying the second motion for summary judgment.

date, May 26, 2010, and, as such, it is timely under Trademark Rule 2.197(a). However, a party can rely on the date it mailed a submission only if the submission is accompanied by a certificate of mailing. Applicant did not include a certificate of mailing on the USPTO with its filing. See Trademark Rule 2.197(a)(1)(ii) ("Correspondence will be considered as being timely filed if ... The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have a reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.") However, because of the minimal delay in filing the brief, and because the brief is for the benefit of the Board to be able to more fully understand the parties' relative positions, we have exercised our discretion to consider the brief.

**APPLICANT'S COUNTERCLAIMS**

The Board's May 6, 2008 order, denying applicant's motion for summary judgment, noted that applicant's counterclaim is based on the claim of fraud. However, in a subsequent Board order, dated October 31, 2008, the Board, after denying opposer's motion for summary judgment due, in part, to remaining genuine issues of material fact concerning applicant's counterclaims, noted *sua sponte* that applicant's pleading was insufficient to set forth claims of

fraud based on two different scenarios and allowed applicant time in which to perfect its pleading of fraud in the counterclaims. Applicant did not submit an amended pleading. In addition, applicant did not set forth argument regarding its counterclaims in its brief. Thus, we consider the counterclaims to be waived.

**STANDING, PRIORITY AND LIKELIHOOD OF CONFUSION**

Because opposer's pleaded registration is of record, opposer has established its standing to oppose registration of applicant's mark and its priority is not in issue. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) 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 and 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). Two key considerations are the similarities between the marks and the similarities between the services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Opposer, as plaintiff in the opposition proceeding, bears the burden of proving, by a preponderance of the evidence, its asserted ground of likelihood of confusion. See *Cerveceria Centroamericana*,

S.A. v. Cervecería India Inc., 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989); Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).<sup>5</sup>

Applicant argues that opposer "has failed to present any competent and admissible evidence supporting its contention that there exists confusion and/or likelihood of confusion. ... Opposer has simply failed to meet its burden. One cannot simply make a conclusory statement and/or otherwise allege confusion (or the likelihood thereof) and meet its burden and prevent a registration from going forward." Br. pp. 4, 6.

While the record is thin, there is evidence of record. Because opposer's registration is of record opposer may rely on the presumptions provided by Section 7(b) of the Trademark Act. A trademark owner's certificate of registration is "prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate." 15 U.S.C. §1057(b); Cervecería, 13 USPQ2d

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<sup>5</sup> Applicant is mistaken as to the appropriate standard. This is not a motion for summary judgment but rather a final disposition. Summary judgment may only be granted if there is no genuine issue of material fact and the movant is entitled to prevail as a matter of law. By contrast, upon final disposition after trial, the Board may make any necessary fact finding, whether or not the matter is in dispute.

1307. Thus, we consider the relevant du Pont factors in light of the evidence of record.

We turn first to a consideration of the services, channels of trade and classes of purchasers. We must make our determinations under these factors based on the services as they are recited in the registration and application. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). In this case, the services are legally identical because applicant's "dine in and carry out services featuring pizza and other Italian related cuisine and drinks" are encompassed by opposer's "restaurant services."

Considering the channels of trade and classes of purchasers, because the services are identical and there are no limitations as to channels of trade or classes of purchasers in either the application or opposer's registration, we must presume that applicant's and opposer's respective restaurant services will be offered in the same channels of trade and will be used by the same classes of purchasers. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

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In view of the above, the du Pont factors of the similarity of the services, the channels of trade and classes of purchasers favor a finding of likelihood of confusion.

We now consider the similarity or dissimilarity of the marks when compared in their entireties in terms of appearance, sound, connotation and commercial impression, keeping in mind that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

The marks B.C. PIZZA and B&C PIZZA share obvious similarities. The only differences are the periods in applicant's mark and the ampersand in opposer's mark. Taking this record within the parameters of the case law outlined above and given the legal identity of the services, we find that the similarities in these marks outweigh the dissimilarities.

Finally, we note that these parties are not strangers and were involved in a prior action in state court that resulted in a consent decree outlining where in Michigan applicant may use its mark. See May 6, 2008 Board order. During its trial period, opposer made of record an excerpt



from an order of the court, granting a motion for partial summary judgment, wherein the court made a finding of fact that opposer had encountered an instance of actual confusion between its mark and applicant's mark. The excerpt reads in pertinent part:

Finally, this Court fully agrees with Satek's contention that "the use of the mark 'B.C.' in connection with [Jankowski's]<sup>6</sup> sale, offering for sale, and advertising of its pizza products is not only likely to cause confusion or mistake or deceive as to the source or origins of such goods, but has caused actual confusion..."

Applicant argues that the Board has already ruled that collateral estoppel does not apply in this case. However, that earlier ruling was based on applicant's reliance on the consent decree entered into in that case and not the court's grant of summary judgment. That being said, opposer only provided one page of the ruling. This is simply not sufficient for the Board to rely on in making its own determination as to whether to apply the doctrine of issue preclusion. In any event, proof of actual confusion is not necessary to support a determination of likelihood of confusion.

We conclude that the evidence of record as it pertains to the relevant du Pont factors supports a finding of a likelihood of confusion as between applicant's B.C. PIZZA

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<sup>6</sup> Jankowski appears to be related to applicant. The case is captioned "B.C. Pizza, Inc. (Plaintiff) v. Satek, Inc. (Defendant)." May 6, 2008 Board order.

mark and opposer's registered B&C PIZZA mark, such that registration of applicant's mark is barred under Trademark Act Section 2(d). While the record is thin, it is sufficient in this case to satisfy opposer's burden, in view of the presumptions accorded to opposer's registration, the identity of the services and the near identity of the marks. As noted above, applicant has not submitted any evidence or taken any testimony to rebut opposer's showing. Moreover, to the extent we have any doubt we must resolve it in favor of the registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

**Decision:** The opposition is sustained.