

THIS OPINION IS NOT A
PRECEDENT OF THE
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

BUO

Mailed: March 21, 2016

Opposition No. 91214649

Noodle Time, Inc.

v.

Benny Hodge

Before Quinn, Lykos, and Gorowitz,
Administrative Trademark Judges.

By the Board:

Now before the Board is Noodle Time, Inc.'s ("Opposer") motion for summary judgment, filed September 2, 2015, on its pleaded likelihood of confusion and dilution claims under Sections 2(d) and 43(c) of the Trademark Act, 15 U.S.C. §§ 1052(d) and 1125(c). By its motion, Opposer alleges that its "claims warrant summary judgment as there are no genuine issues of material fact and there is a likelihood of confusion and dilution as a matter of law." 28 TTABVUE 5.¹ The motion is fully briefed.

¹ Citations to the record will be to TTABVUE, the docket history system for the Trademark Trial and Appeal Board. Because the Board primarily uses TTABVUE in reviewing evidence, the Board prefers that citations to material or testimony in the record that has not been designated confidential include the TTABVUE docket entry number and the TTABVUE page number. For material or testimony that has been designated confidential and which cannot be viewed on TTABVUE, the TTABVUE docket entry number where such material or testimony is located should be included in any citation. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

Background

Benny Hodge (“Applicant”) seeks to register the mark BENNY HUNNA, in standard character format, for “[e]ntertainment services in the nature of live musical performances,” in International Class 32.²

On January 27, 2014, Opposer filed its notice of opposition pleading ownership of eight registrations for the marks: 1) BENIHANA, in standard characters,³ and the following design marks:



² Application Serial No. 85920599 (“the ’599 application”), filed May 1, 2013, based on Applicant’s *bona fide* intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b). The application contains a statement that: “The name ‘BENNY HUNNA’ shown in the mark identifies the pseudonym of Benny Hodge a living individual whose consent is of record.”

³ The following are the standard character registrations:

- (1) Registration No. 1230609, for “restaurant services,” in International Class 42, issued March 8, 1983;
- (2) Registration No. 1371624, for “sake,” in International Class 33, issued November 19, 1985;
- (3) Registration No. 1412570, for “wines, namely, plum wine; and spirits, namely, sake,” in International Class 33, issued October 7, 1986;
- (4) Registration No. 3784161, for “drinking mugs,” in International Class 21, issued May 4, 2010; and
- (5) Registration No. 3928737, for “franchise services, namely, offering business management assistance in the establishment and operation of restaurant and bar services,” in International Class 35, issued March 8, 2011.

⁴ Registration No. 2029115, for “edible oils and fats,” in International Class 29, issued January 7, 1997. The registration contains a statement that the non-Latin characters in the mark transliterate to “BENI HANA,” and a statement that the English translation of “BENIHANA” is “red flower.”

⁵ Registration No. 2119770, for “restaurant services,” in International Class 42, issued December 9, 1997. The registration includes a disclaimer of the term “GRILL,” and a statement that the English translation of “BENIHANA” is “red flower.”



1 TTABVUE 7-8, ¶ 8. As grounds for its opposition, Opposer alleges likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and dilution under Section 43(c), 15 U.S.C. § 1125(c).

Applicant, in his answer filed March 8, 2014, denied the salient allegations of the notice of opposition, except that Applicant admitted that there is no issue as to priority, inasmuch as “[t]he date of Applicant’s Subject Application is subsequent to the issuance date of Opposer’s Registrations.” 1 TTABVUE 11, ¶ 20; 4 TTABVUE 4, ¶¶ 20 and 24.⁷

Motion for Summary Judgment

Opposer asserts that through decades of use and marketing and unsolicited press, its BENIHANA marks have become famous, and that the mark’s fame coupled with similar trade channels through which “the goods and services at issue are sold and marketed,” and an “admission” made by Applicant regarding similarity in the pronunciation of the marks, there is likelihood of confusion. 28 TTABVUE 8, 10, 17 and 19. Opposer further alleges that in addition to the involved marks being similar,

⁶ Registration No. 2058184, for “restaurant services,” in International Class 42, issued April 29, 1997. The registration includes a disclaimer of the term “GRILL.”

⁷ Applicant also attached exhibits to its answer. With two exceptions that are not applicable here, exhibits attached to pleadings are not evidence on behalf of the party to whose pleading the exhibits are attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony. Trademark Rule 2.122. Therefore, the exhibits that were attached to the answer have not been given any consideration and are not part of the record at this juncture.

the level of fame acquired by the BENIHANA marks has risen beyond mere fame to being “culturally iconic,” and that those marks “entered a state of cultural phenomenon and have enjoyed fame long before the filing date of Applicant’s Subject Application.” *Id.* at 8 and 24. Opposer further alleges that the record demonstrates that Benihana’s use of the BENIHANA® Marks is virtually exclusive,” and “Applicant intended to create an association with Opposer’s famous BENIHANA® Marks” after “the filing of the Subject Application,” thus establishing dilution by blurring. *Id.* at 26-27 (citing 28 Hodge Depo., 52:14-20, 85:24-88:10, Ex. 3 (28 TTABVUE 32-56)). Finally, Opposer asserts that Applicant’s use of a similar mark in connection with music and music videos featuring “vulgar language and adult content” dilutes Opposer’s BENIHANA marks by tarnishment. *Id.* at 8, and 27-28.

Applicant argues that his mark “differs from Opposer’s Mark in sight[,] sound and meaning,” particularly inasmuch as “Opposer’s Mark, BENIHANA, is one word of Japanese origin meaning red flower.” 30 TTABVUE 3. Applicant also asserts that “BENNY HUNNA and BENIHANA are NOT pronounced the same,” because:

BENNY HUNNA is pronounced in English. If BENIHANA is pronounced in English then this word would fall under the ‘vowel consonant vowel’ rule. The ‘vowel consonant vowel’ rule states that the second vowel will make the first vowel sound like it’s [sic] name. For example, B-E-N-I-H-A-N-A, the I would make the E sound and the A would make the A sound.

Id.

Finally, Applicant contends that Opposer’s tarnishment argument is specious, arguing that “Opposer’s remarks of a family oriented restaurant are tarnished by an

open association with world record setting profanity, boarder line [sic] pornography as to the sexual content of the movies they openly endorse or associate with, and drug use in movies that seem to glorify addiction.” *Id.* at 5.

Opposer, in reply, contests that Applicant “did not conduct any discovery,” and “fails to demonstrate the existence of a genuine issue of material fact on any of Benihana’s claims and fails to identify record evidence to support any of his arguments.” 32 TTABVUE 2. Opposer asserts that “Applicant either concedes or fails to dispute virtually every relevant fact entitling Benihana to summary judgment.” *Id.* at 3.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). In deciding motions for summary judgment, the Board must follow the well-established principles that, in considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant’s favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes are present. *See Lloyd’s Food Prods. Inc. v. Eli’s Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy’s Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The burden is on the party moving for summary judgment to demonstrate the absence of any genuine dispute of material fact, and that it is entitled to summary

judgment as a matter of law. Fed. R. Civ. P. 56(c). If the evidence produced in support of the summary judgment motion does not meet the moving party's burden, "summary judgment must be denied even if no opposing evidentiary matter is presented." *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 160-161 (1970) (*quoting* Fed. R. Civ. P. 56 advisory committee notes to the 1963 amendments).

In support of its motion, Opposer submitted the declaration of Opposer's Vice President of Marketing, Elizabeth Jean Means, which authenticated the following exhibits:

- Documents regarding the history of BENIHANA restaurants;
- The registration certificates of Opposer's eight pleaded registrations and Registration No. 940142 for the mark BENIHANA OF TOKYO, issued August 1, 1972;⁸ and a

⁸ Although the declaration references Opposer's ownership of "11 United States trademark registrations," only eight registrations were pleaded in the notice of opposition, and only nine registration certificates were attached as exhibits to Opposer's motion for summary judgment. 24 TTABVUE 5 and 33-41. Moreover, the declaration references "Exhibit 1" attached to the notice of opposition. *Id.* at 5. However, while the record contains a coversheet entitled "EXHIBIT 1" attached to the notice of opposition, no exhibits actually appear in the record. *See* 1 TTABVUE 15.

In any event, these registration certificates, showing the registrations as of the date of issue of the certificates, are not sufficient to evidence the *current* status and title of the registrations. *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (photocopy of registration without status and title information insufficient). The issue date of a registration certificate filed with a complaint or motion for summary judgment must be reasonably contemporaneous with the filing date of the complaint or motion in order to evidence *current* status and title. *See Hard Rock Café Int'l (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1511 (TTAB 2000) (status and title copies prepared three years prior to opposition not reasonably contemporaneous).

In order for Opposer to rely on its pleaded registrations, Opposer must establish current status and title, which can be done by submitting a current printout of information from the electronic database records of the Office such as (a) printouts from TSDR (Trademark Status and Document Retrieval), or (b) printouts from TESS (Trademark Electronic Search System), along with a copy of any records from the Assignment database showing an assignment, if any, to the current owner of the registration. *See* Trademark Rule 2.122(d); *Research In*

summary of foreign registrations and domain name registrations issued to Opposer;

- Copies of decisions from civil actions between Opposer and third parties involving the BENIHANA marks and domain names; and a chart summarizing Uniform Domain Name Dispute Resolution Policy proceedings involving Opposer;
- Email correspondence between Applicant and Opposer;
- Advertising material for Opposer's services featuring the BENIHANA marks, including press releases; copies of Opposer's social media pages; pictures of "BENIHANA-branded" products; and summaries of Opposer's expenditures on advertising and marketing;
- Excerpts from third-party publications discussing Opposer's restaurants, including the history of the company and its founder;
- Copies of online reviews of Opposer's restaurants posted to the Yelp.com website; pictures of celebrities, athletes, and a former U.S. President dining at Opposer's restaurants or holding carry-away bags featuring the BENIHANA marks; and copies of Internet articles that reference celebrities dining at Opposer's restaurants;
- Printouts from webpages that chronicle references to Opposer's marks in movies and television shows;
- Printouts from various websites showing uses of the term BENIHANA in the lyrics of various songs;
- Copies of Internet articles showing Opposer's restaurant listed as a "top restaurant" in the country; copies of Internet articles listing Opposer's restaurant on various "Best of..." lists;
- Copies of articles from publications including Fortune Magazine and The Washington Post, as well as other third-party publications discussing Opposer's BENIHANA restaurants;

Motion Ltd. v. NBOR Corp., 92 USPQ2d 1926, 1928 (TTAB 2009). See also TBMP § 704.03(b)(1)(A) (2015) and authorities cited therein.

The motion also included the following exhibits which were not authenticated by declaration:⁹

- A copy of the transcript of the deposition of Applicant, Benny Hodge;
- A copy of the application file of the '599 application;¹⁰
- Printouts from Applicant's Facebook page, which includes a post featuring a picture of the storefront of one of Opposer's restaurants;¹¹
- Printouts from the USPTO's TESS database showing third-party registrations for marks offering both restaurant and entertainment services in International Classes 41 and 43; printouts from the websites of six establishments that offer food and entertainment; and TESS search result page showing that 2743 records were retrieved in a search of the Register for entertainment services in International Class 41 and restaurant services in Class 43.

A. Standing and Priority

Opposer's allegation of ownership of eight registrations is supported in this motion for summary judgment by the attached "soft" copies of its registration certificates.

⁹ Although the exhibits were not filed in connection with a declaration or affidavit, these types of evidence may be considered on summary judgment. *See* Fed. R. Civ. P. 56(c); Trademark Rules 2.122(e) and 2.127(e)(2); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1369-70 (TTAB 1998). *See also* Trademark Rule 2.120(j)(8); TBMP §§ 528.05(a)(1)-(e).

¹⁰ It was unnecessary for Opposer to submit a copy of the application file as it is of record by operation of Trademark Rule 2.122(b)(1).

¹¹ All of the submitted Internet evidence displays the relevant URL addresses and dates of access, as required by the Board in *Safer Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010).

However, as previously noted, these soft copies do not properly introduce these registrations.

Nonetheless, Applicant has, by way of his answer to the petition to cancel, admitted Opposer's priority of use of its BENIHANA marks. 4 TTABVue 4, ¶¶ 20 and 24.¹² This admission functions not only to establish Opposer's priority, but also that Opposer holds rights to a mark that is allegedly similar to Applicant's applied-for mark. Therefore, Opposer may rely on this admission to establish that it has a real interest in the outcome of this proceeding and is not "a mere intermeddler," *i.e.* Opposer has standing to bring its claims in this proceeding. *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007). *See also, Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (standing established by showing of common law rights).

B. Section 2(d) Likelihood of Confusion

In a likelihood of confusion analysis, two key factors are the degree of similarity of the parties' marks and the degree to which their respective goods or services are related. *See In re Viterra Inc.*, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). However, the U.S. Court of Customs and Patent Appeals, in *du Pont*, discussed thirteen factors relevant to a determination of likelihood of confusion. These factors include the number and nature of similar marks in use on similar goods or services and the

¹² Proper introduction of the current status and title of Opposer's pleaded registrations would serve to remove standing, as well as priority as issues in this proceeding with respect to those registered marks and the goods and services therein. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

nature and extent of any actual confusion. *Id.* at 567. Nonetheless, not all of the factors are relevant and only those relevant factors for which there is evidence in the record must be considered. *Id.* at 567-68; *see also In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.”); *Cunningham*, 55 USPQ2d at 1845.

Opposer argues in support of its motion for summary judgment that: (i) “[t]he BENIHANA® Mark is famous, inherently strong, and commercially strong, and thus, deserves wide latitude of legal protection,” 28 TTABVUE 17; and (ii) Applicant, in correspondence sent to Opposer prior to the institution of this proceeding, has admitted to similarity in the pronunciation of the marks by the following statement:

My name is Benny Hodge. I am the service mark owner [of] the name Benny Hunna. Benny Hunna is an entertainer/musician/director. By the names Benihana and Benny Hunna being so similar in pronunciation it will be a matter of time before we come together and be[come] a house hold name “everywhere.”

24 TTABVUE 86; 28 TTABVUE 40.

Although Opposer is correct in its argument that there is no *correct* pronunciation of a mark, *see Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013), in making a likelihood of confusion determination the Board compares the marks in their entireties for similarities, *i.e.* not just the sound of the marks, but also the overall appearance, connotation, and commercial impression of the marks. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014). Therefore, despite this evidence, we find that

there remains a genuine dispute of material fact as to the connotation and commercial impression of the marks.

Opposer further asserts that the evidence it has made of record establishes the relatedness of the services offered by the parties, through its introduction of USPTO records showing “many live applications and registrations for marks in both classes 41 (entertainment services) and 043 (restaurant services),” and the absence of any restrictions on the channels of trade in the involved application. 28 TTABVUE 19.

Opposer’s asserted argument for entry of summary judgment regarding the relatedness of the parties’ services is also unavailing. The ten third-party registrations cited by Opposer and accompanying marketplace evidence in the form of printouts from the websites of the owners of those marks purportedly showing that these establishments offer both entertainment and restaurant services fails to meet Opposer’s burden to show that no genuine disputes of material fact remain as to the relatedness of the parties’ respective services. Applicant’s applied-for services are not simply any form of entertainment, but entertainment “in the nature of live musical performances.” None of Opposer’s evidence shows use of a single mark for both the provision of live musical performances such as those offered by a performing artist and also restaurant services.¹³ Additionally, Opposer argues that inasmuch as there

¹³ For example, Registration No. 4780924 lists, *inter alia*, “entertainment services, namely, providing play activity center areas for children and families,” in International Class 41, and “café-restaurants [sic] services,” in International Class 43; and Registration No. 4720176 lists, *inter alia*, “arranging and conducting golf tournaments and special events for social entertainment purposes,” along with its restaurant services. As to the marketplace evidence, a series of printouts taken from the website for Off Key Karaoke Lounge & Suites, shows the provision of karaoke lounge and karaoke machine rental services for karaoke parties along with restaurant services.

is no limitation in the recitation of services in the involved application, “the same consumers purchasing BENIHANA® services should be presumed to be likely to purchase music or to attend live musical performances.” 28 TTABVUE 19. This argument is a *non sequitur* and of course is equally unavailing.

Opposer discusses the remainder of the *DuPont* factors, including absence of actual confusion, marketplace interface between Opposer and Applicant, the extent to which Applicant has right to exclude the use of others, and Applicant’s intent, concluding that “a balancing of the likelihood of confusion factors weighs heavily in favor of Benihana.” *Id.* at 22. However, only those factors that are relevant to this proceeding have been considered.

Contrary to Opposer’s assertion, the standard on a motion for summary judgment is not a “balancing of the likelihood of confusion factors,” but a showing of an absence of any genuine disputes of material fact. In light of the standards for summary judgment, as set forth above, we find that based on the evidence presented,¹⁴ Opposer has failed to demonstrate the absence of genuine disputes of material fact. In particular, we find that notwithstanding any similarities in sound to which Applicant may have admitted, genuine disputes of material fact exist at least as to the connotations of Opposer’s mark and Applicant’s mark, the level and effect of any fame

¹⁴ The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *Am. Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

that Opposer's marks may have attained, and the relatedness of the claimed goods and services.¹⁵

In light of the foregoing, Opposer's motion for summary judgment is **DENIED** with respect to its likelihood of confusion claim.

C. Dilution

A claim of dilution under Section 43(c) of the Trademark Act requires that: (1) Opposer's distinctive mark would be diluted by use of Applicant's similar mark; (2) Opposer's mark is famous; and (3) Opposer's mark became famous prior to the earliest date of use (or constructive use) that can be claimed by Applicant. *See* 15 U.S.C. § 1125(c); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1173 (TTAB 2001).

However, just as we have found with respect to Opposer's likelihood of confusion claim, genuine disputes of material fact remain as to the degree of similarity of the marks, *see Nike Inc. v. Maher*, 100 USPQ2d 1018, 1022 (TTAB 2011), and the extent of the fame Opposer's marks have attained.¹⁶ Accordingly, Opposer's motion for summary judgment is **DENIED** with respect to its dilution claim.

Schedule

The proceeding is **RESUMED**. The remaining disclosure and trial dates are reset as follows:

Plaintiff's 30-day Trial Period Ends	4/22/2016
Defendant's Pretrial Disclosures	5/7/2016

¹⁵ The fact that we have identified only certain genuine disputes as to material facts should not be construed as a finding that these are necessarily the only disputes which remain for trial.

¹⁶ Again, with respect to Opposer's dilution claim, these may not be the only disputes which remain for trial.

Defendant's 30-day Trial Period Ends	6/21/2016
Plaintiff's Rebuttal Disclosures	7/6/2016
Plaintiff's 15-day Rebuttal Period Ends	8/5/2016

In each instance, a copy of the transcript of any testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of taking of that testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.