

This Opinion is not a
Precedent of the TTAB

Mailed: May 25, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

———
Trademark Trial and Appeal Board
———

Original Maryland Fried Chicken, LLC

v.

MTM Enterprises Group, LLC

———
Opposition No. 91217560
———

Kevin W. Wimberly and Amber N. Davis of Beusse Wolter Sanks & Maire, PLLC
and Suzanne D. Meehle of Meehle & Jay P.A.
for Original Maryland Fried Chicken, LLC.

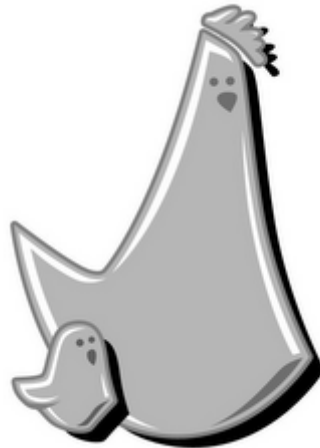
Matthew G. McKinney of Allen, Dyer, Doppelt & Gilchrist
for MTM Enterprises Group, LLC.

———
Before Mermelstein, Bergsman and Lykos,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

MTM Enterprises Group, LLC (“Applicant”) seeks registration on the Principal Register of a mark comprising a design of two chickens, shown below, for “restaurant franchising,” in Class 35.¹

¹ Application Serial No. 77752805 was filed on June 5, 2009, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1052(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as May 1, 2009.



According to the application “[t]he mark consists of a little chicken and a big chicken.”

Color is not claimed as a feature of the mark.

Original Maryland Fried Chicken, LLC (“Opposer”) filed a Notice of Opposition against the registration of Applicant’s chicken mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles Opposer’s previously used common law mark ORIGINAL MARYLAND FRIED CHICKEN and design, shown below, for restaurant services rendered since 2006² and “consulting services to new restaurant owners” rendered since 2007,³ as to be likely to cause confusion.



² Notice of Opposition ¶ 1 (1 TTABVUE 4).

³ Notice of Opposition ¶ 3 (1 TTABVUE 4).

Also, Opposer alleged claim and issue preclusion based on a prior Board opposition proceeding.

Applicant, in its Answer, denied the salient allegations in the Notice of Opposition and asserted the affirmative defenses of collateral estoppel, claim preclusion and issue preclusion, abandonment, and that Opposer is not the owner of its mark.

I. Preliminary Issue

Opposer filed a motion to amend its Notice of Opposition to conform to the evidence in accordance with Fed. R. Civ. P. 15(b)(2).⁴ Fed. R. Civ. P. 15(b)(2) reads as follows:

(b) Amendments During and After Trial.

(2) For Issues Tried by Consent. When an issue not raised by the pleadings is tried by the parties' express or implied consent, it must be treated in all respects as if raised in the pleadings. A party may move – at any time, even after judgment – to amend the pleadings to conform to the evidence and to raise an unpleaded issue. But failure to amend does not affect the result of the trial of that issue.

Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. *Morgan Creek Prod. Inc. v. Foria Int'l Inc.*, 91 USPQ2d 1134, 1137 (TTAB 2009).

A summary of the relevant prosecution history is helpful and is listed below:

⁴ 29 TTABVUE.

- Pursuant to the Board's June 6, 2015 Order, Discovery was scheduled to close November 16, 2015; Opposer's pretrial disclosures were scheduled for December 31, 2015; and Opposer's testimony period was scheduled to open January 13, 2016;⁵

- On January 7, 2016, Applicant filed a motion for summary judgment;⁶

- In an order dated May 2, 2016, Applicant's motion for summary judgment was denied and Opposer's testimony period was rescheduled to open May 25, 2016 and close June 24, 2016;⁷ and

- Opposer filed its testimony and evidence on June 22, 2016⁸ and its motion to amend its Notice of Opposition on June 23, 2016.⁹

Opposer seeks to amend its Notice of Opposition to allege that the application is void *ab initio* based on the non-use of Applicant's mark at the time the application was filed, as well as the ground of abandonment based on Applicant's failure to use the mark since the filing date of the application. Opposer contends that when it reviewed the discovery deposition transcripts, the additional grounds for opposition became clear.¹⁰ The discovery depositions at issue are the September 16, 2015 discovery deposition of Anthony Constantine,¹¹ the September 18, 2015 discovery

⁵ 13 TTABVUE 5.

⁶ 18 TTABVUE.

⁷ 22 TTABVUE.

⁸ 28 TTABVUE.

⁹ 29 TTABVUE.

¹⁰ 29 TTABVUE 3 at ¶ 7.

¹¹ 28 TTABVUE 191.

deposition of Matthew McKinney,¹² and the October 22, 2015 discovery deposition of Michael Constantine.¹³

On July 5, 2016, Applicant filed an objection to Opposer's notice of reliance on those portions of the Michael Constantine, Anthony Constantine, and Matthew McKinney discovery depositions purporting to prove that Applicant had not used its mark at the time it filed its application and that it had abandoned the mark.¹⁴

On July 7, 2016, Applicant filed its opposition to Opposer's motion to amend its pleading.¹⁵ Applicant argues that it has objected to the evidence purporting to prove Opposer's newly asserted claims and that it "was not apprised that evidence was going to be offered in support of non-use and abandonment until June 22, 2016, when the Opposer filed its Notice of Reliance."¹⁶

During the Anthony Constantine discovery deposition, Opposer asked a series of questions regarding Applicant's franchising services. After allowing Opposer some leeway in its questioning, Applicant objected to Opposer's line of questioning regarding Applicant's use of the mark on the ground it is not relevant to the issues in this proceeding.¹⁷ Opposer countered that it was trying to establish Applicant's services.¹⁸

¹² 28 TTABVUE 238.

¹³ 28 TTABVUE 126.

¹⁴ 30 TTABVUE.

¹⁵ 31 TTABVUE.

¹⁶ 31 TTABVUE 3.

¹⁷ Anthony Constantine Discovery Dep., p. 20 (28 TTABVUE 210).

¹⁸ *Id.*

Q. So, prospective franchisees, do you have a marketing plan for franchises?

A. We have a - -

Mr. McKinney: I object. I mean, is that - - it doesn't seem like this is material to the issues here.

Ms. Meehle: We're trying to establish the goods and services of the company. And franchising is a package of services, so we're trying to just establish what the package, that bundle of services, is.

Mr. McKinney: I think - -

Ms. Meehle: What is the franchise program?

Mr. McKinney: He already testified that, we offer franchises to people that want to open a restaurant. That's what he's trying to sell, the franchises.

Ms. Meehle: Yes. And does that include marketing services?

Mr. McKinney: Well, I mean, what difference does that make? I don't see how it's material to the trademark issue.

Ms. Meehle: It certainly is. It establishes whether there's a - - what the package of services is that you are calling franchising.

* * *

Ms. Meehle: I'm not asking - - I'm not asking for the details. I'm asking if you provide these specific segments of a franchise services. That is all I'm asking.

Mr. McKinney: Right. And I think it's immaterial. They offer to sell franchises. They haven't sold one.

Q. Okay. You haven't sold any. And you're - - are you saying that you don't offer any specific services to franchises?

Mr. McKinney: I'm saying it's immaterial to the issues here.¹⁹

In the Matthew McKinney discovery deposition, Applicant objected to Opposer's line of questioning regarding Applicant's franchise disclosure document and franchising services on the ground that they are "immaterial." Opposer disagreed stating that it "goes to your services."²⁰

During the Michael Constantine discovery deposition, Applicant objected to Opposer's line of questioning regarding Applicant's use of the mark on the ground that Opposer had not laid the proper foundation for the line of questioning.²¹

Moreover, in response to Opposer's Request for Admission No. 14 ("Admit that [Applicant] has not actually sold a single Maryland Fried Chicken franchise to any third party.") and Interrogatory Nos. 9-11 (a series of questions regarding the franchises sold by Applicant), Applicant objected to Opposer's requests on the grounds that they are irrelevant and do not relate to any fact at issue in the opposition.²²

We find that Applicant objected to the testimony Opposer sought to introduce to support its new claims. Applicant allowed Opposer some leeway in its questions regarding Applicant's use of its mark in connection with franchising services and then objected on the ground that the line of questioning was not relevant to the claims in

¹⁹ Anthony Constantine Discovery Dep., pp. 20-21 (28 TTABVUE 210-211).

²⁰ Matthew McKinney Discovery Dep., p. 16 (28 TTABVUE 253).

²¹ Michael Constantine Discovery Dep., pp. 20-22 (28 TTABVUE 145-147).

²² 28 TTABVUE 554, 558-565, and 575.

the opposition. As soon as practical after Opposer filed its notice of reliance on the discovery depositions purporting to prove Opposer's newly asserted claims, Applicant filed an objection. Accordingly, Opposer's newly asserted grounds that the application at issue was void *ab initio* because it had not been used at the time the application was filed and abandonment were not tried by implied consent.

Opposer's motion to amend its Notice of Opposition is denied.²³

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file.²⁴ The record also includes the testimony and evidence listed below.

A. Opposer's testimony and evidence.

Opposer introduced a notice of reliance on the testimony and evidence listed below:

1. A copy of application Serial No. 77402411 for the mark MARYLAND FRIED CHICKEN COMPLETE DINNERS TO GO and design printed from the USPTO electronic database;²⁵

²³ The better practice would have been for Opposer to have filed a motion to amend the notice of opposition prior to the December 31, 2015 due date for its pretrial disclosures and no later than shortly after the Board issued its May 2, 2016 order denying Applicant's motion for summary judgment.

²⁴ It was not necessary for Opposer to introduce a copy of the application at issue or its prosecution history. Trademark Rule 2.122(b)(1).

²⁵ 28 TTABVUE 10.

2. A copy of application Serial No. 77497042 for the mark comprising the design of two chickens printed from the USPTO electronic database;²⁶
3. A copy of the Board's decision in Opposition No. 91185766 (*Original Maryland Fried Chicken LLC v. Theresa Constantine as Personal Representative of the Estate of Richard Constantine*);²⁷
4. A printout from the Florida Department of State Division of Corporations that MTM Enterprises Group, LLC has been dissolved effective September 28, 2012;²⁸
5. UCC Financing statement for Maryland Fried Chicken, a Florida Partnership, signed by Michael Constantine, Anthony Constantine and Richard Constantine;²⁹
6. Discovery deposition of Michael Constantine, a member of Applicant, with attached exhibits;³⁰
7. Discovery deposition of Anthony Constantine, a member of Applicant, with attached exhibits;³¹
8. Discovery deposition of Matthew McKinney, a member of Applicant, with attached exhibits;³²

²⁶ 28 TTABVUE 26.

²⁷ 28 TTABVUE 70.

²⁸ 28 TTABVUE 121.

²⁹ 28 TTABVUE 124.

³⁰ 28 TTABVUE 126.

³¹ 28 TTABVUE 191.

³² 28 TTABVUE 238.

9. October 19, 2015, discovery deposition of Robert Constantine, Opposer's owner, with attached exhibits;³³
 10. September 16, 2015, discovery deposition of Robert Constantine with attached exhibits;³⁴
 11. Testimony deposition of Robert Constantine with attached exhibits;³⁵
 12. Deposition of Anthony Constantine from Opposition No. 91185766;³⁶
 13. Excerpts from Applicant's website;³⁷
 14. Applicant's responses to Opposer's request for admissions;³⁸ and
 15. Applicant's responses to Opposer's interrogatories.³⁹
- B. Applicant's testimony and evidence.

³³ 28 TTABVUE 285. Trademark Rule 2.120(k)(1), 37 C.F.R. § 2.120(k)(1), provides that "[t]he discovery deposition of a party or anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party." Robert Constantine is the owner of Opposer and is not an adverse party. However, because Applicant noted the discovery depositions of Robert Constantine in its description of the record without objection, we deem both the October 19, 2015 and the September 16, 2015 discovery depositions of Robert Constantine to have been stipulated into evidence. *See Conde Nast Publications Inc. v. Vogue Travel, Inc.*, 205 USPQ 579, 580 n.5 (TTAB 1979) (improper subject matter deemed stipulated into record where adverse party did not object and specifically referred to the matter its brief).

³⁴ 28 TTABVUE 318.

³⁵ 28 TTABVUE 347.

³⁶ 28 TTABVUE 431. The parties stipulated to the admissibility of a deposition from another proceeding. *See* TBMP § 704.13 (January 2017) ("Testimony from another proceeding may also be made of record in a Board proceeding by stipulation of the parties approved by the Board.").

³⁷ 28 TTABVUE 544.

³⁸ 28 TTABVUE 557.

³⁹ 28 TTABVUE 573.

Applicant introduced the testimonial deposition of Robert Constantine from Opposition No. 91185766.⁴⁰

III. Standing

Standing is a threshold issue that must be proven in every *inter partes* case. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *see also Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (“The facts regarding standing ... must be affirmatively proved. Accordingly, [plaintiff] is not entitled to standing solely because of the allegations in its [pleading].”). Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, has enunciated a liberal threshold for determining standing, namely that a plaintiff must demonstrate that it possesses a “real interest” in a proceeding beyond that of a mere intermeddler, and “a reasonable basis for his belief of damage.” *See Empresa Cubana del Tabaco*, 111 USPQ2d at 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 50 USPQ2d at 1026.

Robert Constantine testified that he is the owner of Original Maryland Fried Chicken, a restaurant that serves “mostly fried chicken.”⁴¹ Original Maryland Fried

⁴⁰ 38 TTABVUE. Neither party filed a motion to introduce the testimony of Robert Constantine taken in another proceeding, nor is there any indication that the parties stipulated to the admissibility of the testimony of Robert Constantine from the prior opposition pursuant to Trademark Rule 2.122(f), 37 C.F.R. § 2.122(f); *see also* TBMP § 704.13. However, Opposer noted this deposition in its description of the record without objection. Accordingly, we consider the deposition to have been stipulated into the record.

⁴¹ Robert Constantine Discovery Dep., pp. 4-5 (28 TTABVUE 288-289) (October 19, 2015).

Chicken also renders consulting services in field of restaurants, including setting up an entire restaurant, choosing a location, selecting a menu, and training staff.⁴² Below is a photograph of Opposer's mark used in connection with its restaurant and consulting services.⁴³



Mr. Constantine also testified that Applicant's mark "is almost like mine"⁴⁴ and that Applicant is "using my marks."⁴⁵ Specifically, Mr. Constantine was concerned that the chicken design Applicant seeks to register is similar to the mark that he uses.

- Q. So, I mean, would you say that this old logo is identical or substantially the same as [Applicant's] logo?
- A. It's very close to the same. But, better yet, though, it means the same thing.
- Q. So, you say it's - - it may be similar – similarities?
- A. It's - - when somebody is looking at yours and looking at mine, it's like - - it means the same thing. It's so close. Even without the feet, they're thinking the same thing.⁴⁶

⁴² Robert Constantine Discovery Dep., pp 5-7 (28 TTABVUE 289-291) (October 19, 2015).

⁴³ Robert Constantine Discovery Dep., p. 8 and Exhibit B (28 TTABVUE 292 and 308) (October 19, 2015).

⁴⁴ Robert Constantine Discovery Dep., p. 13 (28 TTABVUE 297) (October 19, 2015).

⁴⁵ Robert Constantine Discovery Dep., p. 14 (28 TTABVUE 298) (October 19, 2015).

⁴⁶ Robert Constantine Discovery Dep., p. 11 (28 TTABVUE 329) (September 16, 2015).

When testifying about Applicant's mark as displayed on Applicant's website (marylandfriedfranchise.com), shown below, and submitted as its specimen of use in its application, Mr. Constantine testified that the mark that Applicant is trying to register "is almost like mine."⁴⁷



Applicant argues that because the Board previously found that Opposer's mark is in the public domain, Opposer does not have standing.⁴⁸ The specific finding of fact in the prior opposition is set forth below:

These parties [C.F.M. Distributing Company, Inc., Original Maryland Fried Chicken, LLC, and Theresa Constantine, as Personal Representative of the Estate of Richard Constantine] have lost their trademark rights against the world, and thus against each other. ... we view the several opposers' actions herein to be less an attempt to claim rights in these marks for themselves, but instead merely wanting to maintain the *status quo* by keeping

⁴⁷ Robert Constantine Testimony Dep., p. 13 and Exhibit G (28 TTABVUE 393 and 428). Even though the mark sought to be registered is displayed in connection with other elements, the manner in which Applicant's mark is used may nevertheless provide evidence as to whether Applicant's mark is similar to Opposer's mark. *See American Rice, Inc. v. H.I.T. Corp.*, 231 USPQ 793, 796 (TTAB 1986) ("we may take into account whether the trade dress of packages or labels in the application file as specimens, or otherwise in evidence, may demonstrate that the trademark projects a confusingly similar commercial impression."); *Northwestern Golf Co. v. Acushnet Co.*, 226 USPQ 240, 244 (TTAB 1985) ("Evidence of the context in which a particular mark is used on labels, packaging, etc., or in advertising is probative of the significance which the mark is likely to project to purchasers.").

⁴⁸ Applicant's Brief, pp. 20-24 (40 TTABVUE 21-25).

applicant from being able in the future to assert a right to which it is entitled, under the facts of the case.⁴⁹

However, in the prior consolidated oppositions, the Board found that the applicant, Theresa Constantine, as Personal Representative of the Estate of Richard Constantine, “was not the owner of these marks at the time the applications were filed, and consequently, both of these involved applications are deemed to be void *ab initio*” and sustained the oppositions.⁵⁰ The Board made no finding of fact precluding Opposer’s right to use its mark in its trading area.⁵¹

Based on the foregoing, we find that Opposer has a real interest in the outcome of this proceeding based on its claim of common law ownership of the mark ORIGINAL MARYLAND FRIED CHICKEN and design and a reasonable basis to believe that it would be damaged by the registration of Applicant’s chicken design for restaurant franchising because it would be likely to cause confusion with Opposer’s mark. Accordingly, Opposer has standing to pursue any of its other pleaded grounds. *See Jewelers Vigilance Comm. Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987) (“Once standing is established, the [plaintiff] is entitled to rely on any of the grounds set forth in ... the Lanham Act which negate [defendants’] right to its subject registration.”).⁵²

⁴⁹ 28 TTABVUE 113.

⁵⁰ 28 TTABVUE 113.

⁵¹ For this reason, Applicant’s affirmative defense that the opposition should be dismissed because Opposer has abandoned its mark is denied.

⁵² Even assuming that Opposer’s mark ORIGINAL MARYLAND FRIED CHICKEN and design is in the public domain, Opposer has established its standing by proving that it is engaged in the same or related services as those listed in the application; that is, Opposer is in a position to use its purported mark in a descriptive manner. *See Frito-Lay N. Am., Inc. v.*

IV. Claim and Issue Preclusion

Under the doctrine of claim preclusion, “a judgment on the merits in a prior suit bars a second suit involving the same parties or their privies based on the same cause of action.” *Jet Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000) (quoting *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 326 n.5 (1979)).

For claim preclusion to apply, there must be:

- (1) identity of parties (or their privies);
- (2) an earlier final judgment on the merits of a claim; and
- (3) the second claim is based on the same set of transactional facts as the first.

See Parklane Hosiery, 439 U.S. at 326 n.5.

Issue preclusion bars the re-litigation of the same issue in a second action. *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2051 (2015).

The application of issue preclusion requires:

- (1) identity of an issue in the current and a prior proceeding;
- (2) actual litigation of that issue in the prior proceeding;
- (3) that determination of the issue was necessary in entering judgment in the prior proceeding; and

Princeton Vanguard, LLC, 109 USPQ2d 1949, 1951 (TTAB 2014), *vacated and remanded on other grounds*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015); *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1481 (TTAB 2017); *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1350 (TTAB 2013).

(4) that the party with the burden of proof on that issue in the second proceeding had a full and fair opportunity to litigate the issue in the prior proceeding.

See *Montana v. United States*, 440 U.S. 147, 153-54 (1979).

In this proceeding, Applicant is seeking to register the mark shown below for “restaurant franchising.”

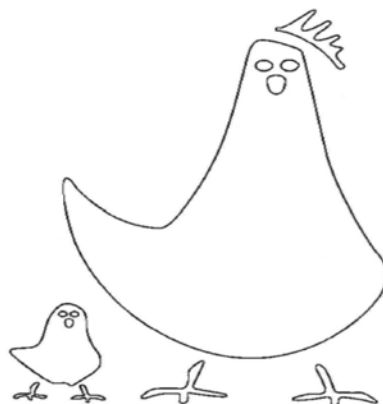


In the prior consolidated oppositions (Opposition Nos. 91185766, 91187377 and 91187378), Richard Constantine sought to register the marks shown below both for “restaurant services, including sit-down service of food and take-out restaurant services,” in Class 43.

53



54



⁵³ 28 TTABVUE 18-24 and 71.

⁵⁴ 28 TTABVUE 26-32 and 71.

Setting aside the element of privity, because Applicant is seeking to register its mark for “restaurant franchising” and the applications in the prior consolidated oppositions were for “restaurant services, including sit-down service of food and take-out restaurant services,” this opposition is not based on the same set of transactional facts as the first, nor were any of the issues in this proceeding litigated in the first proceeding. Therefore, neither claim preclusion nor issue preclusion apply.

Opposer’s claims of claim preclusion and issue preclusion are dismissed.⁵⁵

V. Priority

Turning now to Opposer’s Section 2(d) claim, the filing date of the application at issue is June 5, 2009. However, in response to Opposer’s interrogatory No. 13, Applicant stated that “the date of first use of the services is at least as early as May 1, 2009.”⁵⁶ “Applicant is entitled to rely on the filing date of its application, or whatever date of first use is established by the evidence of record.” *UMG Recordings Inc. v. O’Rourke*, 92 USPQ2d 1042, 1046 (TTAB 2009). Accordingly, we find that Applicant’s priority date is May 1, 2009.

Robert Constantine, Opposer’s owner, testified that Opposer began using its mark on its restaurant signs in 2006⁵⁷ and in connection with its consulting services since

⁵⁵ For these same reasons, Applicant’s affirmative defense of collateral estoppel, claim preclusion and issue preclusion is denied.

⁵⁶ 28 TTABVUE 575.

⁵⁷ Robert Constantine Discovery Dep., pp. 8 and 11 (28 TTABVUE 292 and 295) (October 19, 2015); *see also* Robert Constantine Testimony Dep., p. 15 (28 TTABVUE 362) (“Q. And so how long have you been using Original Maryland Fried Chicken? A. Back in ’06; ’05; ’06.”).

2008.⁵⁸ “Oral testimony, if sufficiently probative, is normally satisfactory to establish priority of use in a trademark proceeding.” See *Daniel J. Quirk, Inc. v. Village Car Co.*, 120 USPQ2d 1146, 1151 (TTAB 2016) (quoting *Powermatics, Inc. v. Globe Roofing Prods. Co.*, 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965)); *Bass Pro Trademarks, LLC v. Sportsman’s Warehouse, Inc.*, 89 USPQ2d 1844, 1856 (TTAB 2008) (the testimony of a single witness with personal knowledge of the facts may be sufficient to prove first use if it is clear, convincing, consistent, uncontradicted, and sufficiently circumstantial to convince the Board of its probative value). Mr. Constantine’s testimony is clear and convincing and because it has not been contradicted there is no reason it should not be accorded its full probative value in evaluating Opposer’s first use.

In view of the foregoing, Opposer has established the priority of use of its mark in connection with restaurant services and consulting services in the field of restaurants vis-à-vis the filing date of the application at issue.

VI. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”) (cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 113 USPQ2d at 2049); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is

⁵⁸ Robert Constantine Discovery Dep., p. 11 (28 TTABVUE 295) (October 19, 2015).

relevant and for which there is evidence of record. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See In re Chatam Int'l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *appeal docketed*, No. 16-1507 (Fed. Cir. Jan. 21, 2016).

A. The similarity or dissimilarity of the marks.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. Because the common elements of the marks are chicken designs, the similarity or dissimilarity of the marks is based primarily on the visual similarity. *In re Vienna Sausage Mfg. Co.*, 16 USPQ 2044, 2047 (TTAB 1990). As such, the analysis is necessarily subjective. *See Franklin Mint Corp. v. Master Mfg. Co.*, 209 USPQ 350, 354 (TTAB 1980), *aff'd*, 667 F.2d 1005, 212 USPQ 233 (CCPA 1981).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quoting *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007); see also *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

The marks are displayed below:

Opposer’s Mark



Applicant’s Mark



Even though Opposer’s mark includes the words “Original Maryland Fried Chicken,” those words are at least highly suggestive of Opposer’s services. Moreover, the chicken designs in its mark are not so inconspicuous or indistinct that they may be overlooked.⁵⁹ Both marks feature two chickens: a large chicken and a smaller

⁵⁹ Applicant uses its mark in conjunction with the words “Maryland Fried Chicken” as shown below. Nonetheless, we must and do consider only the mark Applicant has applied to register.



chicken located at the lower left-hand side of the larger chicken as if it were a hen and her chick. In both marks, the larger chicken is on the right and the smaller chicken is on the left. The larger chickens both feature a comb tilted to the right and a tail that comes to a point. The face of the larger chickens and the chicks comprise three dots although the beak of Applicant's larger chicken is somewhat more pronounced. Finally, because Applicant has not claimed color as a feature of its mark, Applicant is entitled to display its mark with any color scheme, including the identical colors red and yellow as they appear in Opposer's mark as Applicant has, in fact, done.

If the marks were viewed side-by-side for comparison (as we have done above), consumers might perceive the small, but specific differences we note. However, when the marks are seen at different times, what will be remembered is two highly stylized cartoon chickens which are highly similar. And as noted, the wording in Opposer's mark adds little or nothing to the impression made by Opposer's design. Accordingly, we find that the marks are similar.

B. The similarity or dissimilarity and nature of the services.

Applicant is seeking to register its mark for "restaurant franchising." Applicant advertises that the franchising services include reviewing the business plan, marketing, training, securing a location, and construction.⁶⁰

28 TTABVUE 244 (excerpt from Applicant's website).

⁶⁰ 28 TTABVUE 547 (excerpt from Applicant's website).

Opposer uses its mark in connection with restaurant services⁶¹ and “consulting services for new restaurant owners.”

Q. So the consulting business, what kind of services do you provide?

A. Well, we will completely set up the whole business; and it will be like a turnkey operation that will walk right in, and everything will be set up for them.

Q. So that includes choosing the location?

A. Yes.

Q. Does that include - - does that include advising them as to what to serve?

A. Yes.

Q. Does that - - do you tell them they have to serve anything in particular?

A. We would like to keep them with our guidelines.

Q. And do you provide them with an operations manual of any sort?

A. We're probably going to set it up like that, yes.

Q. So this is a planned business, but you are currently consulting?

A. Yes.

Q. So the consulting that you have done in the past, the stores that you have helped already, can you tell me what you have done for them, what services you provided?

A. Well, we found our location, we completely built it out, looking for equipment, products, and things like that.

⁶¹ Robert Constantine Discovery Dep., p. 5 (28 TTABVUE 289).

- Q. Do you provide training services?
- A. Yes. We train them at our main office.
- Q. Do you train the owners?
- A. Yes.
- Q. Do you train the employees?
- A. Yes.
- Q. When you provide your consulting services to these restaurants, do you do that under any particular brand?
- A. Original Maryland Fried Chicken.
- Q. Do you use the same logo that you use in your restaurant?
- A. Yes.⁶²

Because Applicant's restaurant franchising services and Opposer's restaurant consulting services for new owners both include training, securing a location, and construction, we find that those services are in part identical.

C. Established, likely-to-continue channels of trade.

Because the services described in the application and Opposer's consulting services in the field of restaurants are in part identical, we must presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (legally identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there

⁶² Robert Constantine Discovery Dep., pp. 5-7 (28 TTABVUE 289-291).

are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). This *du Pont* factor therefore also weighs in favor of a likelihood of confusion.

D. Conclusion

Because the marks are similar, the services are in part identical and we presume that the services which are identical move in the same channels of trade to the same consumers, we find that Applicant's mark, shown below,



for "restaurant franchising" so resembles Opposer's mark ORIGINAL MARYLAND FRIED CHICKEN and design, shown below,



for consulting services in the field of restaurants as to be likely to cause confusion.

Decision: The opposition is dismissed on the grounds of claim and issue preclusion.

The opposition is sustained on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).