

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
March 29, 2012

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Campo's Deli at Market, Inc.

Serial No. 77768687

J. Conor Corcoran for Campo's Deli at Market, Inc.

Evelyn Bradley, Trademark Examining Attorney, Law Office
105 (Thomas Howell, Managing Attorney).

Before Quinn, Shaw and Greenbaum, Administrative Trademark
Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

On June 25, 2009, Campo's Deli at Market, Inc. filed an application to register PHILADELPHIA'S CHEESESTEAK (in standard characters, CHEESESTEAK disclaimed) on the Principal Register for "sandwiches; sandwiches, namely, cheesesteaks" (in International Class 30). Applicant claims 2009 as its date of first use anywhere and in commerce.¹

¹ In its Request for Reconsideration, applicant filed an amendment to change the date of first use and first use in

The examining attorney refused registration on three grounds: (1) under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because applicant's mark, when applied to applicant's goods, so resembles three previously



registered marks, , PHILADELPHIA CHEESESTEAK CO., and THE ORIGINAL PHILADELPHIA CHEESESTEAK CO. (the latter two in standard characters), for "prepared foods, namely, meat" (in International Class 29), and owned by the same entity, as to be likely to cause confusion;² (2) under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2), because the mark is primarily geographically descriptive of applicant's goods; and (3) the specimens of record do not show use of the mark for applicant's goods under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127.

When the refusals were made final, applicant concurrently filed a request for reconsideration, which the

commerce to January 1, 2009, but the examining attorney did not act on the amendment. In the event applicant ultimately prevails in any appeal, the application will be forwarded to the examining attorney for action on the amendment.

² Respectively, Registration No. 2053943 (PHILADELPHIA CHEESESTEAK CO. disclaimed), registered April 22, 1997, renewed; and Registration Nos. 2809682 and 2809683 (CO. disclaimed), registered February 3, 2004 (in both instances, under the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f)), Section 8 & 15 affidavits accepted and acknowledged.

examining attorney denied, and an appeal of the final refusals. Applicant and the examining attorney filed briefs, and an oral hearing was held.

For the reasons discussed below, we affirm the refusals under Sections 2(d) and 2(e)(2) of the Trademark Act, and reverse the refusal under Sections 1 and 45 of the Trademark Act.

Before turning to the merits of the refusals, we note that applicant, in its appeal brief, listed the serial numbers and literal elements of four applications, now registrations, that were originally listed, among others, in response to the Section 2(e)(2) refusal in the initial Office action. Applicant never submitted copies of those registrations. This is not the proper way to make such applications and registrations of record.³ See *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998). See also *In re Promo Ink*, 78 USPQ2d 1301 (TTAB 2006) (submitting list of registrations is insufficient to make them of record). However, because the examining attorney, during prosecution, did not advise applicant of this procedural

³ It is well-established that in order to make third-party registrations properly of record, "applicant should submit copies of the registrations themselves, or the electronic equivalent thereof" from the USPTO's electronic databases, now known as TARR or TESS. *In re Broadway Chicken Inc.*, [38 USPQ2d 1559, 1560](#) n.6 (TTAB 1996) (citing *In re Smith and Mehaffey*, [31 USPQ2d 1531](#) (TTAB 1994)). Such submissions should be made prior to appeal or, if after appeal, pursuant to a remand of the matter to the examining attorney for further examination. Trademark Rule 2.142(d).

error at a point where applicant could have corrected the deficiency, the examining attorney's objection, raised for the first time in her appeal brief, is considered to be waived. *In re Dist. of Columbia*, 101 USPQ2d 1588, 1592 n.5 (TTAB 2012). Accordingly, we will consider the same list of registrations set out in applicant's brief "for whatever limited probative value such evidence may have." *In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1513, n.3 (TTAB 2011).

Likelihood of Confusion

The first issue in this appeal is likelihood of confusion, which requires us to consider the evidence in relation to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor concerns the similarities and

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dissimilarities of applicant's and registrant's marks. Under this factor, we look to see whether the marks, in their entireties, are similar in appearance, sound, connotation, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691-92 (Fed. Cir. 2005).

Applicant's mark is PHILADELPHIA'S CHEESESTEAK and registrant's marks are PHILADELPHIA CHEESESTEAK CO. and design, PHILADELPHIA CHEESESTEAK CO. (in standard characters), and THE ORIGINAL PHILADELPHIA CHEESESTEAK CO. (in standard characters). The marks are very similar in sound, appearance and meaning because they contain the same words: "PHILADELPHIA" and "CHEESESTEAK". The inclusion or omission in the marks of an apostrophe "s" is an insignificant difference that is used to denote possession, and does not alter the similarity of the commercial impression of applicant's mark to each of registrant's marks. *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) ("The absence of the possessive form in applicant's mark BINION has little, if any, significance for consumers in distinguishing it from the cited mark.") (internal citations omitted).

Applicant argues that the marks are "entirely different", however, applicant does not argue that registrant's inclusion of the laudatory term "THE ORIGINAL" or the design of a cheesesteak in two of the cited marks

differentiates those marks from applicant's in any meaningful way, and, indeed, they would not. App. Br. p. 4.

Instead, applicant contends that the presence of "CO." in the cited marks is the distinguishing feature. Specifically, applicant contends that "CO." identifies a particular company that is a wholesale provider of raw, sliced meat to cheesesteak retailers like applicant, while applicant's mark identifies a product, specifically, a cheesesteak sandwich. App. Br. pp. 4-5. However, applicant provided no evidence to support this contention. Moreover, "CO." is simply an entity designation with no source identifying capacity. See *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019 (TTAB 2009). Accordingly, this attempt to distinguish the marks in terms of meaning is not persuasive.

We conclude that applicant's and registrant's marks contain virtually identical terms, namely, "PHILADELPHIA'S CHEESESTEAK" and "PHILADELPHIA CHEESESTEAK," the marks sound and look similar, and their meanings and commercial impressions are also very similar. Therefore, despite some minor differences, the marks, in their entireties, are very similar, and we resolve this factor against applicant.

We now consider the relatedness of applicant's and registrant's goods, bearing in mind the goods as they are identified in the registrations and application. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). In this regard, we find the record created by the examining attorney

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establishes that registrant's "prepared foods, namely, meat" are closely related to applicant's "sandwiches; sandwiches, namely, cheesesteaks," and that both products may emanate from a single source. For example, the examining attorney submitted several use-based, third-party registrations which, in pertinent part, cover both types of goods: Registration No. 3064770 (fully-cooked, pre-portioned meat products, and meat sandwiches); Registration No. 3552603 (meats and sandwiches); Registration No. 3706470 (canned cooked meat, hot dogs and hot dog sandwiches); Registration No. 2774072 (meat, frozen and prepared entrees consisting primarily of meat, fish, poultry or vegetables, and sandwiches); and Registration No. 3259168 (meat, namely, ribs and steaks, and pita bread sandwiches). This evidence "serve[s] to suggest that such goods or services are of a type which may emanate from a single source." See *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n. 6 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988). See also *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

The examining attorney also submitted internet evidence showing third-party websites touting their products, which include prepared meat and sandwiches, to demonstrate that these goods originate from a common source. For example, the June 1, 2011 final Office action

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attached printouts for SCHWAN'S (steak and sandwiches)⁴ and LOWFAT LIFESTYLE (prepared meat and sandwiches),⁵ and the March 15, 2011 denial of applicant's Request for Reconsideration attached printouts for WENGER MEATS AND ICE (deli meat and sandwiches),⁶ DIPASCALE'S (lunch meats and sandwiches)⁷ and WASSLER'S MEAT MARKET (deli meat and sandwiches).⁸

Moreover, as the examining attorney aptly notes, sandwiches may contain prepared meat (Br. p. 8, unnumbered), and as applicant admits, applicant purchases from registrant the meat applicant uses in its own sandwiches. App. Br. p. 4.

Based on the record, we find that the goods are related, and resolve the *du Pont* factor regarding the similarity of the goods against applicant.

Applicant's arguments regarding the parties' actual trade channels are not relevant to our determination for registration. We must make our determination based on the goods as they are identified in the application and registrations, and not based on evidence of their actual use. *Octocom Systems Inc. v. Houston Computer Services*

⁴<http://www.schwans.com/products/categoryDetail.aspx?c1=10428&c2=9428&kwid=searchgg01084235-pcrid-5522709017&dmg=3320>

⁵ <http://www.lowfatlifestyle.com/sandwiches/sandwichindex.htm>

⁶ <http://www.wengermeats.com/index.php/butcher-shop/>

⁷ <http://meadowbrookfoods.com/deli.htm>

⁸ <http://www.wasslermeatmarket.com/>

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Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1987).
("[T]he 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 sales of the goods are directed.").
See also Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

Further, because there is no limitation regarding the trade channels for the parties' goods, it is presumed that the goods move in all the normal channels of trade and are available to all potential customers, including retail and/or wholesale establishments.

We conclude that these goods are closely related, and the trade channels and purchasers of these products would overlap. As to the common purchasers, we have no evidence that the consumers of these goods would necessarily be sophisticated, so we consider this factor to be neutral.

Finally, while the cited marks are registered on the Supplemental Register or under the provisions of Section 2(f) of the Trademark Act, even "weak" or merely descriptive marks are entitled to protection against a subsequent user's registration of a similar mark for closely related goods, and this protection extends to marks registered on the Supplemental Register. *See, e.g., In re Clorox Co.*, 578

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F.2d 337 (C.C.P.A. 1978); *In re Hunke & Jocheim*, 185 USPQ 188 (TTAB 1975).

In summary, when we consider the marks in their entirety, we conclude that they are more similar than they are different. See *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004). The goods are also closely related, and are presumed to move in similar trade channels to similar classes of purchasers. The factor related to sophistication of purchasers is deemed neutral. Under these circumstances, we conclude that confusion is likely. We add that to the extent that we have any doubts, we have resolved them, as we must, in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988) and *In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes*, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973).

The Section 2(d) refusal is affirmed.

Geographic Descriptiveness

We turn now to the refusal based on geographic descriptiveness. The test for determining whether a mark is primarily geographically descriptive is whether (1) the mark (or a portion thereof) is the name of a place known generally to the public, and (2) the public would make a goods/place association, that is, believe that the goods identified in the application originate in that place. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*,

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824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305 (TTAB 2006); and *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001). If the goods do in fact originate from the place named in the mark, the requisite goods/place association can be presumed. See *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982).

We find, first, that the word "PHILADELPHIA'S" in applicant's mark is the possessive form of the name of a place known generally to the American public, i.e., the city of Philadelphia, Pennsylvania. Philadelphia is defined as "the largest city of Pennsylvania, in the southeast part of the state on the Delaware River."⁹ The primary significance of Philadelphia to the American purchasing public thus is a known geographic area. Further, there is nothing in the record to suggest that Philadelphia is either obscure or remote. Cf. *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 3 USPQ2d at 1451.

Next, we find that the term "CHEESESTEAK" in applicant's mark is at least highly descriptive (if not generic) of applicant's "sandwiches; sandwiches, namely, cheesesteaks." Applicant does not contest this point, and, in fact, has disclaimed "CHEESESTEAK" apart from the mark as shown.

We next turn to the question of whether applicant's mark, PHILADELPHIA'S CHEESESTEAK, is primarily

geographically descriptive. "Under the first prong of the test - whether the mark's primary significance is a generally known geographic location - a composite mark such as applicant's proposed mark must be evaluated as a whole... It is not erroneous, however, for the examiner to consider the significance of each element within the composite mark in the course of evaluating the mark as a whole." *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) [internal citations omitted]. In this connection, it is well settled that "the presence of generic or highly descriptive terms in a mark which also contains a primarily geographically descriptive term does not serve to detract from the primary significance of the mark as a whole." *In re JT Tobacconists*, 59 USPQ2d at 1082. See also *In re Bacardi & Co. Ltd.*, 49 USPQ2d 1301 (TTAB 1997).

For the reasons set forth above, we find that the word "PHILADLEPHIA'S" in applicant's mark is a reference to a well-known geographic place, and that the term "CHEESESTEAK" is at least highly descriptive of applicant's goods. We further find that the presence of the highly descriptive term "CHEESESTEAK" in applicant's mark does not detract from the primary geographical significance of the mark as a whole. See *In re Save Venice New York Inc.*, 59 USPQ2d 1778 (Fed. Cir. 2001); and *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999).

⁹ <http://education.yahoo.com/reference/dictionary/entry/Philadelphia>

In sum, we find under the first prong of the Section 2(e)(2) test that the primary significance of applicant's mark is that of a well-known geographic place, i.e., the city of Philadelphia, Pennsylvania.

We next turn to the second prong of the test, i.e., whether purchasers would make a goods/place association between applicant's goods and the place named in the mark. Applicant acknowledges that it is located in Philadelphia. Additionally, in response to the first and final Office actions, and in its brief, applicant states that the specimens of record are photographs of its booth at the Philadelphia Phillies' baseball stadium and of its store on Market Street in Philadelphia. App. Br. p. 9.

Applicant nonetheless asserts that its mark is not primarily geographically descriptive. Instead, applicant likens its mark to "Boston baked beans," "Swiss cheese," and "Italian spaghetti," arguing that its use of PHILADELPHIA'S designates a kind or type of sandwich that is available nationwide, and that no cheesesteak purchaser would believe that the cheesesteak came from anywhere other than where it was purchased. App. Br. pp. 7-8.

However, applicant's use of the possessive noun "PHILADELPHIA'S" in the composite mark PHILADELPHIA'S CHEESESTEAK underscores the geographic significance of the mark, namely, that applicant's cheesesteak is of, or from, Philadelphia.

Applicant further argues that the apostrophe "s" in "PHILADELPHIA'S" signifies quality. However, applicant presents no evidence in support of this statement, which is simply conjecture. Even if applicant were to establish that "PHILADELPHIA'S" connotes quality in certain circumstances, this implication would be secondary to the primary significance of "PHILADELPHIA'S" as a geographic indicator. See *In re Monograms America, Inc.*, 51 USPQ2d 1317 (TTAB 1999) and cases cited therein.

As noted above, applicant's flagship store and applicant's second location at the Philadelphia Phillies baseball stadium are both located in Philadelphia. As a result, we find that applicant's goods originate in Philadelphia, Pennsylvania, and we may presume that purchasers would make a goods/place association between applicant's goods and Philadelphia, a geographic location that is neither obscure nor remote. *In re Chalk's International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991); and *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988). Further, applicant has not presented sufficient evidence to rebut this presumption of a goods/place association.

Finally, applicant's listing of third-party registrations is not evidence that the subject marks are in use or that the relevant purchasing public is familiar with them. See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); and *In*

re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983). Moreover, we must determine each case on its own merits, and nothing in this record indicates the reasons, or with what statutory limitations, those third-party registrations were allowed. See, e.g., *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (TTAB 1991). Accordingly, the third-party registrations have limited probative value.

We have considered all of the arguments and evidence made of record by applicant and the examining attorney, including any arguments and evidence not specifically discussed herein. We find that applicant's mark, PHILADELPHIA'S CHEESESTEAK, identifies a well-known geographic location, and that purchasers would make a goods/place association between applicant's goods (cheesesteaks) and the place named in the mark (Philadelphia). Because both elements of the Section 2(e)(2) refusal have been established, we find that the examining attorney has established, *prima facie*, that applicant's mark is primarily geographically descriptive of applicant's goods. Applicant's arguments and evidence to the contrary are not persuasive.

The Section 2(e)(2) refusal is affirmed.

Specimens

Finally, we turn to the refusal to register under Sections 1 and 45 of the Trademark Act on the ground that

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applicant's specimens do not support use of the mark for the identified goods.

Section 45 of the Trademark Act, 15 U.S.C. § 1127 permits registration of a mark when the specimens evidence use on goods in commerce and "when it is placed in any manner . . . on the displays associated therewith . . . and the goods are sold or transported in commerce."

As specimens of use, applicant submitted, among other things, several photographs demonstrating use of PHILADELPHIA'S CHEESESTEAK in displays and advertising in connection with the sale of applicant's cheesesteaks at specific points of sale. In particular, the record includes a photograph of applicant's satellite location at the Philadelphia Phillies' baseball stadium, Citizens Bank Park, where applicant's trademark is clearly visible on applicant's sign, and the menu lists "cheese steaks" as one of applicant's "specialties" on the menu on the wall behind the counter:



The examining attorney rejected all of the specimens, arguing that they comprise advertising material or pictures of a restaurant, which are inappropriate specimens for applicant's goods. Br. pp. 20-24 (unnumbered). We disagree, and find instead that the specimen above is

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acceptable because it is a point-of-sale display associated with the goods, "designed to catch the attention of purchasers and prospective purchasers as an inducement to consummate a sale and which prominently display[s] the mark in question and associate[s] it or relate[s] it to the goods in such a way that an association of the two is inevitable. . . ." *In re Bright of America, Inc.*, 205 USPQ 63, 71 (TTAB 1979). See also *In re Marriott Corp.*, 459 F.2d 525, 173 USPQ 799, 800 (CCPA 1972) (menu held an acceptable "display" because the mark appeared on the menu in close proximity to an illustration and/or description of the particular sandwich identified by the mark).

The refusal under Sections 1 and 45 is reversed.

Decision: The refusals under Sections 2(d) and 2(e)(2) of the Trademark Act, 15 U.S.C. §§ 1052(d) and (e)(2) are affirmed, and the refusal under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127 is reversed.¹⁰

¹⁰ As discussed in footnote 1, in the event applicant ultimately prevails in any appeal, the application will be forwarded to the examining attorney for action on the amendment.