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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Southwestern Management, Inc.

Serial No. 78271067

Robert E. Purcell for Southwestern Management, Inc.

Elissa Garber Kon, Trademark Examining Attorney, Law Office
116 (Meryl Hershkowitz, Managing Attorney).

Before Hanak, Walters and Bottorff, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Southwestern Management, Inc. (applicant) seeks to register DELMONICO'S for "restaurant services." The application was filed on July 7, 2003 with a claimed first use date of May 15, 1998.

Citing Section 2(d) of the Trademark Act, the Examining Attorney refused registration on the basis that applicant's mark, as applied to restaurant services, is likely to cause confusion with two registered marks owned

by different entities. The first is for DELMONICO registered for "macaroni, elbow macaroni, macaroni shells, spaghetti, elbow spaghetti and egg noodles." Registration No. 541,258. The second is for DELMONICO registered for "alimentary pastes." Registration No. 877,486.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

Our primary reviewing Court has made it abundantly clear on numerous occasions that "to establish likelihood of confusion a party must show something more than that similar or even identical marks are used for food products and for restaurant services." Jacobs v. International Multifoods Corp., 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982)(emphasis added). See also Lloyd's Food Products Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027, 2030 (Fed. Cir. 1993)("So the board's determination ... disregards the requirement that 'a party must show something more than that similar or even identical marks are used for food products and for restaurant services.'") and In re Coors Brewing Co., 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)("Jacobs provides that 'to establish likelihood of confusion a party must show something more than that

similar or even identical marks are used for food products and for restaurant services.'")(original emphasis).

To the best of this Board's knowledge our primary reviewing Court has identified only two ways in which the "something more" requirement can be met. The first is if the registered mark is not only identical to the applied for mark, but in addition the registered mark is "well known and famous." Jacobs, 212 USPQ at 642. In this case, the Examining Attorney has never contended that either of the cited (registered) marks are famous.

The second way that the "something more" requirement can be met is if the registered mark is not only identical to applicant's mark, but in addition, the registered mark is "particularly unique." In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1469 (TTAB 1988), aff'd as not citable precedent 88-1444 (Fed. Cir. November 14, 1988). In the Mucky Duck case applicant did not in any manner argue that there were any third party marks even remotely similar to the highly unique cited mark MUCKY DUCK.

In stark contrast, applicant here argues that DELMONICO or DELMONICO'S are common names used by numerous parties for a wide array of food items. In this regard, applicant points out that the two cited registrations are owned by different entities, thereby showing that DELMONICO

or DELMONICO'S are hardly "particularly unique" terms as was MUCKY DUCK. In addition, during the course of the examination process, applicant properly made of record over 25 Internet references where the term DELMONICO is used in connection with a wide array of different food items or food recipes.

In sum, despite the fact that applicant's mark is essentially identical to the two cited marks, we find that the Examining Attorney has simply failed to meet the strict "something more" requirement in order to establish that applicant's use of its mark for restaurant services and the use of the two cited marks for various food items is likely to cause confusion. In so doing, we note that our primary reviewing Court has on at least three occasions essentially set forth a higher standard for finding a likelihood of confusion when the services of "one of the parties" are restaurant services, given "the very large number of restaurants in this country." Coors, 68 USPQ2d at 1064.

Decision: The refusal to register is reversed.