

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark application Serial No. 78/271,067


For the mark DELMONICO'S

TTAB

Filing Date: July 7, 2003

Applicant: Southwestern Management, Inc.

Commissioner for Trademarks
Attn: TTAB
2900 Crystal Drive
Arlington, VA 22202-3513


08-16-2004

U.S. Patent & TMO/TTM Mail Rpt Dt. #22

APPLICANT'S APPEAL BRIEF

Applicant hereby appeals the decision of the Trademark Examining Attorney finally refusing registration, as set forth in the Office Action dated March 4, 2004.

The Examining Attorney has refused registration on the basis of an alleged likelihood of confusion with the marks in U.S. Trademark Registration Nos. 0877486 and 0541258 and on the basis that the mark is allegedly primarily a surname. Applicant will address each of these bases for rejection separately below.

The Likelihood of Confusion Rejection

The mark which is the subject of the instant application is "DELMONICO'S" for "restaurant services".

U.S. Trademark Registration No. 541,258 is for the mark "DELMONICO" in a stylized format for the goods "macaroni, elbow macaroni, macaroni shells, spaghetti and elbow spaghetti, and egg noodles". The registration is owned by New World Pasta Company, 85 Shannon Road, Harrisburg, Pennsylvania 17112.

U.S. Trademark Registration No. 877,486 is for the mark "DELMONICO" in a stylized format with a design element for the goods "alimentary pastes". The registration is owned by Hershey Foods Corporation, 100 Mansion Road East, Hershey, Pennsylvania 17033.

The two registered marks cited by the Examining Attorney apparently have been owned

by different corporations.¹ Consequently, the scope of protection for each of these registered marks is extremely narrow. The Examining Attorney has stated that the goods recited in each of the registrations are closely related to restaurant services and has cited three website excerpts showing that restaurants allegedly often sell their own lines of food, including pastas and sauces. The Examining Attorney has also attached five sample federal trademark registrations showing the same marks being registered for restaurants and related food items. Applicant acknowledges, no doubt, that sometimes a restaurant sells its own line of food products, including pastas and sauces, and that sometimes a company registers the same mark for both restaurant services and for food items. Nevertheless, the evidence uncovered and recited by the Examining Attorney does not lead to the conclusion that there is a likelihood of confusion between the two registered marks cited by the Examining Attorney (even presuming *arguendo* that they have always been owned by the same company) and the mark which is the subject of the instant application. Indeed, the Court of Appeals for the Federal Circuit has recently issued a ruling directly contrary to any such likelihood of confusion conclusion:

It is not unusual for restaurants to be identified with particular food or beverage items that are produced by the same entity that provides the restaurant services or are sold by the same entity under a private label. Thus, for example, some restaurants sell their own private label ice cream, while others sell their own private label coffee. But that does not mean that any time a brand of ice cream or coffee has a trademark that is similar to the registered trademark of some restaurant, consumers are likely to assume that the coffee or ice cream is associated with that restaurant. The *Jacobs* case stands for the contrary proposition, and in light of the very large number of restaurants in this country and the great variety in the names associated with those restaurants, the potential consequences of adopting such a principle would be to limit dramatically the numbers of marks that could be used by producers of foods and beverages.

In re Coors Brewing Company, 343 F.3d 1340, 68 U.S.P.Q. 2d 1059 (Fed.Cir. 2003) (emphasis and underscoring in original). Applicant submits that there is no likelihood of confusion between Applicant's mark for which registration is sought and either of the two registered marks cited by the Examining Attorney, even presuming *arguendo* that the two registered marks have always been owned by the same legal entity.

¹The Examining Attorney has more recently provided a copy of a different database showing that each registration was originally owned by Hershey Chocolate & Confectionary Corp. and assigned to New World Pasta Company. Note that the more recently provided database copy does not reference any "Hershey Foods Corporation".

The Surname Refusal

The Examining Attorney bears the burden of showing that the mark is considered to be primarily merely a surname by the relevant public. As evidence that the relevant public considers the term "DELMONICO" to be a surname, the Examining Attorney has cited a Lexis/Nexus search print-out showing that there are 530 persons identified in the database that have the surname "Delmonico". Applicant again acknowledges that the term "Delmonico" is sometimes used as a surname, albeit a fairly rarely occurring surname. However, the simple existence of the term as a surname in telephone directories or other databases does not establish even a prima facie showing that a term functions "primarily merely" as a surname. See, e.g., In re Sava Research Corp., 32 U.S.P.Q. 2d 1380 (T.T.A.B. 1994) (Examining Attorney's citation of 100 persons named "Sava" held to show rarity in view of over 90 million persons listed in the database, and the mark "SAVA" held to be not primarily merely a surname and held to be registerable.).²

The Examining Attorney's search apparently did not extend to determining how many persons have the given name "Delmonico". Applicant has submitted of record a print-out from a website respecting a soap opera character named "Delmonico Delgato". Obviously, the degree to which the relevant public might understand the term "Delmonico" to be a given name, rather than a surname, is an important factor apparently not investigated by the Examining Attorney.

Applicant submits that the bulk of the relevant public would believe the term "DELMONICO" might be a given name (rather than a surname), might be an old Italian mythological god or goddess, might be a French wine-making region along the Mediterranean Sea (near the principality of Monaco), might be the name of a Spanish city, might be the name of an ancient road in Athens, Greece, etc. In addition, Applicant has submitted of record several Internet references to "DELMONICO" in connection with a variety of prepared food recipes, alcoholic beverage names, and even cigars.

Applicant also notes that the term "DELMONICO" has been federally registered for "t-shirts, caps and jackets" without any requirement for acquired distinctiveness under §2(f). See U.S. Trademark Registration No. 2,459,761. Likewise, Applicant notes that at least two

²Would a Lexis/Nexus database search showing the term "Coke" used in 3,000 instances as a noun constitute a prima facie showing that the term "Coke" is generic for a carbonated beverage, rather than a trademark?

applications for registration of "DELMONICO" have been approved for publication without any proof of required distinctiveness for the goods "watches and costume jewelry", "home accessories, namely, cushions", "leather and imitation leather products, namely, purses", "framed pictures", "lamp shades", "candles", and "eye wear, namely, sunglasses". See U.S. Trademark Application Serial Nos. 76/377,109 and 76/976,306.

Applicant further notes that an intent-to-use application was filed on November 13, 1995 for the term "DELMONICO'S" for "restaurant services", Serial No. 75/017,670 and that a notice of allowance was issued without any requirement for acquired distinctiveness and without any rejection based upon the two registered marks cited by the Examining Attorney in the instant application. No statement of use was filed in the application, and the application became abandoned.

In conclusion, Applicant submits that the relevant public would not consider the term "DELMONICO" to be "primarily merely a surname".

Conclusion

For the foregoing reasons, Applicant requests that the Examining Attorney's refusal to register the instant mark be reversed entirely.

Respectfully submitted,

WALL MARJAMA & BILINSKI LLP

By:  _____

Robert E. Purcell
Attorney for Applicant
Wall Marjama & Bilinski LLP
101 South Salina Street, Suite 400
Syracuse, NY 13202
Telephone: (315) 425-9000
Facsimile: (315) 425-9114

REP/cmn

Customer No.: 20874

PATENT TRADEMARK OFFICE

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the 16th day of August, 2004 an original of the foregoing **APPLICANT'S APPEAL BRIEF** was forwarded via Express Mail No. EV 333495333 US, postage prepaid, and addressed as follows:

Commissioner for Trademarks
Attn: TTAB
2900 Crystal Drive
Arlington, VA 22202-3513