

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/271067

APPLICANT: Southwestern Management, Inc.



CORRESPONDENT ADDRESS: Robert E. Purcell, Wall Marjama & Bilinski LLP, 4th Floor, 101 S. Salina Street, Syracuse, NY 13202

RETURN ADDRESS: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514

Mailed 10/15/04

MARK: DELMONICO'S

CORRESPONDENT'S REFERENCE/DOCKET NO: 1216 T 001

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

- 1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

TRADEMARK EXAMINING ATTORNEY'S APPEAL BRIEF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: SOUTHWESTERN MANAGEMENT, INC.
Trademark: DELMONICO'S
Serial No: 78/271,067
Attorney: Robert E. Purcell
Address: Wall Marjama & Bilinski LLP, 4th Floor 101 S. Salina Street, Syracuse, NY 13202
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

ISSUE

The applicant has appealed the final refusal under Section 2(e)(4) of the Trademark Act, 15 U.S.C. Section 2(e)(4), on the basis that the proposed mark is primarily merely a surname, and under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d) on the basis of a likelihood of confusion with the goods/services associated with the marks in Registration Nos. 0877486 and 0541258. The Section 2(e)(4) refusal is hereby withdrawn. The only remaining issue is the Section 2(d) refusal.

FACTS

The applicant sought to register DELMONICO'S in connection with "restaurant services." On January 16, 2004, the examining attorney refused registration under Section 2(d) of the Trademark Act because of a likelihood of confusion with the marks in Registration Numbers 0877486 and 0541258, for the following respective marks: DELMONICO, with the "D" in stylized form, for alimentary pastes; and DELMONICO with the "D" in upper case letters and the rest of the word in lower case, for macaroni, elbow macaroni, and macaroni shells, spaghetti, elbow spaghetti and egg noodles. The examining attorney also refused registration under Section 2(e)(4) of the Trademark Act, 15 U.S.C. Section 1052(e)(4) because mark appeared to be primarily merely a surname which, as stated above, is no longer an issue in this case.

On February 4, 2004, the applicant submitted arguments against both the Section 2(d) refusal and the Section 2(e)(4) refusal. As to the Section 2(d) refusal, the applicant argued that since the two cited marks were owned by different entities, the mark deserved a "very narrow" scope of protection, and that its services should be permitted to coexist with the goods of the registrants.

On March 3, 2004, the examining attorney issued a final refusal as to both statutory refusals. On August 16, 2004, the applicant initiated this appeal.

ARGUMENT

I. The Marks Are Virtually Identical

The dominant portions of the marks at issue are identical in spelling, pronunciation and

meaning. The registered marks are DELMONICO with an upper case “D” (Reg. No. 0541258) and DELMONICO in upper case with a stylized initial letter “D” (Reg. No. 0877486). When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser’s memory and to be used in calling for the goods or services. Therefore, the word portion is controlling in determining likelihood of confusion. *In re Dakin’s Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii).

II. The Dominant, Common Element in the Marks is Relatively Strong

The cited marks appear to be owned by the same entity. At one time or another, the ownership history of these marks shows that the marks were owned by different, but apparently related, entities. Based on this fact alone, the applicant argues “the scope of protection for each of these registered marks is extremely narrow.” Brief at 2.

The ownership history, alone, of the two registrations alone does not render the scope of protection for the marks “extremely narrow.” Indeed, there is no evidence in the record that DELMONICO, either in the singular, plural or possessive forms, is or has been registered to any other entities or that it is used by others as a trademark or service mark for restaurants or food items. There is no other evidence that would render this mark weak.

In *In re Coors Brewing Company*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003) (discussed at greater length below), the court found that restaurants and beer are not closely related, based on the visual differences between the two design marks containing the words BLUE MOOM and the evidence. In *Coors*, despite the applicant’s submission of substantial evidence of third party commercial usage of the terms BLUE MOON, the court held that the registered mark was not weak, stating: “[w]e sustain the Board’s factual finding that the ‘568 mark is not a weak mark.” *Coors, supra*, 343 F.3d at 1345. The instant case does not involve marks with substantial design elements as in *Coors*. Further, in this case, there is no evidence of third party industry usage of this term. Absent any of the afore-mentioned evidence, and based on the applicant’s precedent, the registered marks deserve a

relatively broad scope of protection.

If the marks of the respective parties are identical, the relationship between the goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *Ancor, Inc. v. Ancor Industries, Inc.*, 210 USPQ 70 (TTAB 1981); TMEP §1207.01(a).

III. The Goods and Services of the Parties Are Closely Related

It is well settled by courts that food products and food-related services are considered closely related goods and services under Section 2(d). *In re H. J. Seiler Co.*, 289 F.2d 674, 129 USPQ 347 (C.C.P.A. 1961) (likelihood of confusion between SEILER'S catering services and SEILER'S smoked and cured meats); *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001) (likelihood of confusion between OPUS ONE for restaurant services and the identical mark for wine); *In re Comexa Ltda.*, 60 USPQ2d 1118 (TTAB 2001) (likelihood of confusion between AMAZON for restaurant services and AMAZON and design for chili sauce and pepper sauce); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) (AZTECA MEXICAN RESTAURANT for restaurant services held likely to be confused with AZTECA for Mexican food products); *In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990) (GOLDEN GRIDDLE PANCAKE HOUSE for restaurant services held likely to be confused with GOLDEN GRIDDLE for table syrup); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988) (likelihood of confusion between MUCKY DUCK with duck design used on mustard and MUCKY DUCK with duck design used on restaurant services); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987) (likelihood of confusion between APPETITO and design used on Italian sausage and A APPETITO'S with sandwich design used on restaurant services); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827 (TTAB 1984) (likelihood of confusion between BEEFMASTER used on restaurant services and BEEF MASTER used on frankfurters and bologna); *Roush Bakery Prods. Co., Inc. v. Ridlen*, 190 USPQ 445 (TTAB 1976) (likelihood of confusion between HILLBILLY and design used on bread and HILLBILLY RESTAURANT used on restaurant services); *In re Pick-N-Pay Supermarkets, Inc.*, 185 USPQ 172 (TTAB 1974) (likelihood of

confusion between PICK-N-PAY used on grocery items and supermarket services and PIK-N-PAY used on cafeteria services).

Despite the existence of extensive case law on this point, the applicant relies solely on *In re Coors Brewing Company, supra*, for the proposition that because the *Coors* court held that restaurants and beer are not *necessarily* closely related, restaurants and pasta are not closely related. *Coors* is factually distinguishable from this instant case.

In *Coors*, the marks both contained the words BLUE MOON but also had very distinct and different design elements that rendered them visually distinct from one another. In the instant case, the applicant's mark is DELMONICO'S, in typed form, while the registered marks are "Delmonico" and DELMONICO, with a slightly stylized initial letter "D." The court in *Coors* noted:

Because there are significant differences in the design of the two marks, the finding of similarity is a less important factor in establishing a likelihood of confusion than it would be if the two marks had been identical in design or nearly indistinguishable to a casual observer.

Coors, supra, at 343 F.3d at 1344 (citations omitted).

Visually, the distinctions among the marks in this case are not nearly as significant as in the *Coors* case. Moreover, the applicant seeks to register DELMONICO'S in typed form, which allows the applicant to use the mark in any form it chooses, including with a stylized initial letter "D."

In addition to the visual distinctions between the marks, there was substantial evidence in *Coors* that others in the food and restaurant industry used the word portion of the marks ("BLUE MOON") as a trademark or service mark for their food-related items/services. Moreover, *Coors* provided evidence that there are more than one thousand breweries in the United States, and over eight hundred thousand restaurants, and that even if all such brewing establishments featured restaurants, it would still only be a small percentage of all restaurants overall. *Coors*, 343 F.3d at 1346. In that case, the record contained evidence of the small percentage of industry overlap concerning the goods/services at issue.

In this case, the record is devoid of any such evidence. Indeed, the only evidence in the

record shows the close relationship between restaurants and the food items. The examining attorney has made of record sample registrations from the Office's database of registered marks showing the same marks registered for both restaurants, specifically, for pastas, related sauces and meals containing pasta. The examining attorney has also provided website excerpts that show that restaurants often sell their own lines of foods, including pastas and sauces. This documentation, combined with the numerous cases where courts have found a close relationship between restaurants and food items, provides substantial evidence of the close relationship between the applicant's services and the registrant's goods.

This case is more like *In re Azteca Restaurant Enterprises, Inc.*, *supra*, *In re Mucky Duck Mustard Co., Inc.*, *supra*, and *In re Golden Griddle Pancake House Limited*, *supra*, than the *Coors* case because of the lack of evidence of weakness of the marks; the nature and type of evidence; and the nature of the foods at issue. In *Mucky Duck*, mustard was found to be related to restaurants under Section 2(d) because it is commonly used by restaurants and restaurants often sell their own house specialty sauces, such as salad dressings. In *Azteca*, restaurants and taco shells, tortillas, and salsa were deemed related under Section 2(d), as these are the types of foods typically served in Mexican restaurants. In *Golden Griddle*, syrup and pancake restaurants were related under Section 2(d) because syrup is typically sold in such restaurants. In this case, in addition to the evidence of relatedness, one must consider that pasta dishes and pasta sauces are frequently served in restaurants. These are the types of foods that one would expect to emanate from the same source as restaurants operating under substantially the same name.

Given the substantial visual similarities among the marks, and their relative strength, the evidence of record and the lack of evidence to the contrary, the Section 2(d) refusal must be sustained.

CONCLUSION

The examining attorney respectfully requests that the board affirm the Section 2(d) refusal to register DELMONICO'S in light of the existing, valid registrations for DELMONICO in slightly stylized form the related goods.

Respectfully submitted,

/egkon/
Elissa Garber Kon
Trademark Examining Attorney
Law Office 116
(703) 306-7917

Meryl Hershkowitz
Managing Attorney
Law Office 116
(703) 306-7901