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

Proceeding	85131831
Applicant	Mariola Burgers, LLC
Applied for Mark	THE RAIL
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of: )  
MARIOLA BURGERS, LLC ) Law Office 114  
Serial No. 85131831 ) Trademark Examining Attorney:  
Filed: September 17, 2010 ) Eugenia K. Martin  
Mark: THE RAIL (with design) )

**REPLY BRIEF OF APPLICANT**

**I. THE EXAMINER IMPROPERLY DISCOUNTS EVIDENCE OF THE NUMBER AND NATURE OF SIMILAR MARKS IN USE WITH REGARD TO SIMILAR SERVICES.**

**A. The Examiner Must Consider the Number and Nature of Similar Marks**

The Examiner acknowledges that any determination of likelihood of confusion must consider the factors set forth in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). The sixth *DuPont* factor is: “The number and nature of similar marks in use on similar goods.” *Id.* at 1361. Evidence of use by third parties of similar marks on similar goods or services is probative of the likelihood of confusion, because extensive use of similar marks under such conditions force consumers to distinguish between different marks on the basis of minute distinctions and shows that a mark is relatively weak and entitled to only a narrow scope of protection. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1352 (Fed. Cir. 2011). This issue was discussed at length in the Brief of Applicant, which made it clear that evidence of extensive third-party usage of the word “rail” in relation to bar and restaurant services was introduced in order to demonstrate that RAILS STEAKHOUSE is entitled to only a narrow scope of protection.

Despite the fact that this should have been clear, the Examiner sets up a straw man argument, contending that the existence of similar marks on the register is not a basis for registering Applicant’s mark. The Applicant has never argued that it is entitled to register its

THE RAIL (with design) mark solely on the basis that similar marks have been registered in the past. Rather, the Applicant's argument is that the large number of previous registrations of similar marks demonstrates that each is entitled to only a narrow scope of protection in relation to the word "rail," and that the Applicant's mark is sufficiently dissimilar from these other marks to avoid any likelihood of confusion given the many different bars and restaurants that incorporate "rail" into their names. This is only one of many examples where the Applicant makes an argument as to one of the *DuPont* factors, only to have the Examiner refuse to acknowledge that the factor even exists and then cite irrelevant case law which may use some of the same words but in a different context, e.g., professing that fame has no bearing on a likelihood of confusion analysis (and apparently implying that fame is only relevant to dilution actions) even though fame is one of the *DuPont* factors.

**B. 12 Registrations and 14 Common Law Trademarks are not a "Small Number"**

The Examiner contends that a "small number of third-party registrations for similar marks with similar services" does not demonstrate that a mark has become weak or diluted. In this matter, however, the Applicant has referenced so many third-party registrations and common-law trademark usages of "rail" (used in relation to bar and restaurant services) that the Examiner cannot keep track of them all. While the Examiner states that 24 such examples were referenced, the total number is actually 26. The examples submitted fall into three categories.

First, when the Registrant successfully argued that it should be allowed to register RAILS STEAKHOUSE despite the prior registration of LOS RIELES (with design) in relation to restaurant services, it identified ten prior registrations supporting its position that "rail" was a weak indicator of source due to extensive use of that term in the industry. (Interestingly, the Examiner takes issue with the Registrant's previously stated position that one of these

registrations, RAILROAD PASS, constitutes evidence of usage of the term “rail” in the restaurant and bar industry, thereby supporting the Registrant’s conclusions that the field is crowded and that “rail” has little ability to identify the source of services in the minds of consumers.) The ten previous registrations identified by the Registrant were:

1. RAILROAD PASS (Response to Final Office Action at Exhibit A);
2. RAIL CITY (Response to Final Office Action at Exhibit B);
3. RAILHEAD SMOKEHOUSE BBQ (Response to Final Office Action at Exhibit C);
4. FRITZ’S RAILROAD RESTAURANT (Motion to Suspend Appeal and Remand at Exhibit 1);
5. RAILBEST (Motion to Suspend Appeal and Remand at Exhibit 1);
6. RUSTIC RAIL GRILL AND BREWHOUSE (Motion to Suspend Appeal and Remand at Exhibit 1);
7. BROTHER’S RAILROAD INN (Motion to Suspend Appeal and Remand at Exhibit 1);
8. RAIL CITY ALE HOUSE (Response to Final Office Action at Exhibit E);
9. TERRIBLE’S RAIL CITY CASINO (Motion to Suspend Appeal and Remand at Exhibit 1); and
10. RAILROAD BENTO (Motion to Suspend Appeal and Remand at Exhibit 1).

Second, when the Applicant (unsuccessfully) made this same argument, it cited a number the registrations listed above as well as two others. One of the two was the registration which initially led to the refusal to register the Registrant’s mark. The second was an application which had been allowed to register despite the fact that it should have raised the same issues as the Applicant’s attempts to register THE RAIL (with design). It appears that these may be the two registrations overlooked by the Examiner. The two additional registrations identified by the Applicant were:

11. LOS RIELES (Response to Final Office Action at Exhibit D); and
12. OLD RAIL BREWING COMPANY (Response to Final Office Action at Exhibit F).

Third, the Applicant identified fourteen common-law trademark usages of the word “rail” in relation to bar and restaurant services, all of which predated the Registrant’s use of that term—in some cases by almost a century. The fourteen common-law usages were:

13. Rails (in Maine- Request for Reconsideration at Exhibit 16);
14. Rails (in Arkansas- Request for Reconsideration at Exhibits 17);
15. Rails Restaurant and Bar (Request for Reconsideration at Exhibits 18);
16. Rails Craft Brew & Eatery (Request for Reconsideration at Exhibits 19);
17. Rail House Restaurant & Brew Pub (Request for Reconsideration at Exhibits 6);
18. River Rail Bar & Grill (Request for Reconsideration at Exhibits 7);
19. The Brass Rail Bar and Grill (Request for Reconsideration at Exhibits 8);
20. The Brass Rail (Request for Reconsideration at Exhibits 9);
21. Brass Rail Sports Bar & Grill (Request for Reconsideration at Exhibits 10);
22. Brass Rail (in New Jersey- Request for Reconsideration at Exhibits 11);
23. Brass Rail Restaurant and Bar (Request for Reconsideration at Exhibits 12);
24. Brass Rail (in New York- Request for Reconsideration at Exhibits 13);
25. Brass Rail Steakhouse (Request for Reconsideration at Exhibits 14); and
26. Brass Rail Bar & Grill (Request for Reconsideration at Exhibits 15).

The Applicant does not view 26 examples of third parties using the term “rail” or “rails” as a “small number.” See *Citigroup*, 637 F.3d at 1350 (recognizing evidence of “over twenty” third-party usages of a mark as evidence of third-party use in the field). The goal is to show that the mark is diluted and weak. This should not be a controversial issue, given that the Registrant successfully made the same argument—based upon 16 fewer examples of third-party usage. The Applicant could have listed more, but limited examples of third-party common law usages to those which clearly stated a date of use prior to that alleged by the Registrant in their online advertising. At some point including 50, 75 or 100 attachments stops adding anything to the argument, especially where the Federal Circuit has recognized that 20 is sufficient.

**C. The Examiner has Failed to Address the *Juice Generation* Case.**

The Examiner continues to cite decades old cases for the proposition that third-party registrations are of little evidentiary value when determining the strength or weakness of an existing registration, while ignoring more recent case law from the Federal Circuit. In *Juice*

*Generation*, decided less than a year ago, the Federal Circuit held that third-party registrations are “powerful evidence” that a word or phrase that appears in numerous other registrations is merely descriptive or suggestive and such a word is therefore relatively weak and due a comparatively narrow range of protection. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1337-39 (Fed. Cir. 2015). In that case, the Applicant presented 26 examples of registered and unregistered marks that included some combination of the words “peace” and “love.” *Id.* at 1337 n.1. In considering these examples, the Federal Circuit recognized that the applicant had “introduced evidence of a fair number of third-party uses.” *Id.* at 1339. Later, the Court described these 26 examples as “**extensive** evidence of third-party use *and registrations* [thereby indicating that the phrase peace and love] ... carries a suggestive or descriptive connotation in the food service industry, and is weak for that reason.” *Id.* (bold and underline added).

Despite the extensive evidence provided in *Juice Generation*, the Board had decided that there was not sufficient evidence to determine that “customers have become conditioned to recognize that other entities use PEACE AND LOVE marks for similar services,” which would cut against a likelihood of confusion. *Id.* at 1337. The Board also gave little weight to the fact that the Registrant, during the prosecution of its own marks, “might” have demonstrated a belief that the words “peace” and “love” lack distinctiveness. *Id.* The Federal Circuit disagreed on both counts, holding that discounting the third-party uses did not adequately account for the force of the evidence and that prosecution history estoppel precluded giving the registrant broad protection for a registration it was only able to obtain by arguing that the terms involved were weak and incapable of indicating a single source. *Id.* at 1339-40.

As the evidence presented by the Applicant demonstrates, many bars include a rail that runs along the length of the bar and is used as a foot rest, and bars have long incorporated

references to this rail into their names. (*See* Request for Reconsideration at Exhibit 22.) In fact, at least one of those bars has use the name The Brass Rail Bar and Grill for almost a century. (*See* Request for Reconsideration at Exhibits 8.) Given the **extensive** evidence of third party usage of the word “rail” in restaurant and bar names, this supports the conclusion that “rail” is descriptive of a feature of the bar, the term lacks distinctiveness, and any prior registrations for “rail” in relation to bar and restaurant services should be afforded a narrow scope of protection. It certainly cannot be the case that everyone other than the Registrant is barred from using the word “rail” in their name, when at least twelve other registrants are doing just that and two others established common law rights to the name RAILS in relation to restaurant and bar services before the Registrant filed its application for RAILS STEAKHOUSE.

Further, the cases cited by the Examiner are distinguishable because none of those cases appear to have involved a prosecution history estoppel element. Namely, there is nothing to suggest in those cases that the registrants were only able to obtain their own registrations by arguing that previous registrations should be afforded only a narrow scope of protection because the word or phrase common to both marks was relatively weak and therefore had little ability to help consumers distinguish between competing businesses. Thus, this case is much more similar to *Juice Generation*, which dealt with issues that are identical to this case.

The Applicant first raised the similarity of this case to *Juice Generation* in its Motion to Suspend Appeal and Remand, when it asked the Examining Attorney to further examine the refusal in light of the Federal Circuit’s holding in that case. The Applicant also discusses the *Juice Generation* case at length in the Brief of Applicant, asking the Board to apply the reasoning of that case to the facts of this one. Despite this, the Examiner does even mention the *Juice Generation* case in the Examiner’s Brief, apparently unable to conceive of an argument

that would both follow the guidance offered by the Federal Circuit in *Juice Generation* while also supporting the refusal to allow the application to proceed to registration.

**D. The Examiner has Failed to Address the Inconsistency of Allowing OLD RAIL BREWING COMPANY to Register.**

The USPTO recently launched a “Consistency Initiative” created to facilitate uniform treatment of applications under the Trademark Act. Despite this, while the Registrant’s application was still pending (and blocking the registration of Applicant’s mark), the USPTO allowed the registration of OLD RAIL BREWING COMPANY in relation to bar and restaurant services on September 17, 2013. (*See* Response to Final Office Action at Exhibit F.) The application for that registration alleged a first use in commerce of July 14, 2013 (three years after the intent to use applications filed by Registrant and Applicant). (*See id.* and Request for Reconsideration at Exhibit 20.) Thus, this registrant merely added the words “old” and “brewing company”—even though it disclaimed any exclusive right to use the generic phrase “brewing company.” (*See* Response to Office Action at Exhibit F.)

The USPTO’s decision to allow this mark to register suggests that it recognized that “rail” is entitled to only a narrow scope of protection, given that the mark OLD RAIL BREWING COMPANY added only a common term at the front and a generic description of the services offered at the end. This application was allowed to proceed to registration without even a reference to potential confusion with the numerous other registrations and pending applications which included the word “rail” in relation to restaurant and bar services. This treatment of the OLD RAIL BREWING COMPANY application is inconsistent with suspending (and later denying) the application for THE RAIL (with design) due to a prior filed application for RAILS STEAKHOUSE. The Examiner was made aware of this inconsistency, but still decided to maintain the refusal as to the Applicant’s mark. (*See* Response to Office Action.)



**II. THE MARKS ARE SUFFICIENTLY DISSIMILAR TO AVOID ANY LIKELIHOOD OF CONFUSION AND THE EXAMINER GIVES ONLY LIP SERVICE TO CONSIDERING THE ENTIRETY OF APPLICANT’S MARK.**

The Examiner acknowledges that marks must be considered in their entirety and that it is the overall commercial impression that must be compared in order to determine a likelihood of confusion. Despite this, the Examiner continues to insist that “The Rail” is the dominant part of Applicant’s mark because the word portion is more likely to be impressed upon a purchaser’s memory “and to be used when requesting the services.” “However, the spoken or vocalizable element of a design mark, taken without the design, need not of itself serve to distinguish the goods.” *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) (reversing likelihood of confusion determination that was based upon what consumers would ask for when calling for the products); *see also Citigroup*, 637 F.3d at 1350 (holding that the aural similarity of CITIBANK and CITY BANK was overcome by the written differentiation, i.e., one word versus two and the different spellings); 4 McCarthy on Trademarks and Unfair Competition § 23:47 (4th ed. 2010) (calling the “literacy presumption” that words have more impact than designs a “dubious generalization”). In truth, it is apparent that the rationale that consumers will use “The Rail” or “Rails Steakhouse” when asking for the services is the only basis for determining that the marks are confusingly similar—thus, the Examiner’s continual reference to the two very visually dissimilar marks as being “virtually identical.”

Consider the Applicant’s mark:



The Examiner contends that the thing that leaves the greatest commercial impression is the word RAIL. *But see Kangol, Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 163 (Fed. Cir. 1992) (“kangaroo design ... is likely to be perceived as the dominant feature”). If a giant upside down cow is not the dominant portion of this mark, it is hard to see how the design element (as opposed to the words) could ever be the thing most impressed upon the consumer’s mind. Even large companies that jealousy guard their trademarks have acknowledged that the addition of a design is often sufficient to distinguish one mark from another. *See Citigroup*, 637 F.3d at 1350 (noting that Citibank does not pursue infringement actions against others using CITY BANK if they include a distinguishing logo). Rather, it appears that the examiner has determined that RAIL dominates the mark because that is the easiest way to compare the marks. In fact, the Examiner seems to contend that is the only way to compare the marks, since the Registrant registered a standard character mark.

The Examiner contends that the only option is to compare the standard character portions of the mark, since the Registrant may display its mark in any lettering style. However, simply because one mark is a standard character mark and the other a design mark does not mean that the word element must be presumed to dominate the design mark. *See In re Viterra Inc.*, 671 F.3d 1358, 1365 (Fed. Cir. 2012) (comparing standard character marks to design marks should

not cause an alteration in the basic likelihood of confusion analysis). Further, under the facts of this case, the Examiner's approach is patently improper. The Registrant was only able to obtain its registration in the first place by arguing that "rail" is weak and has little ability to distinguish amongst the many bars and restaurants which incorporate the term "rail" into their name. (*See* Motion to Suspend Appeal and Remand at Exhibit 1.) Given this argument, it is only what a registrant adds to the word "rail" that creates a distinct commercial impression in the minds of consumers.

The Registrant was able to add an "s" (which the Examiner contends is insignificant and incapable of distinguishing one mark from another) and the generic term "steakhouse" (which the Examiner contends should be given little weight) and obtain a registration. It is in this context that the Applicant argued that adding the word "the" should be considered significant; it is no less distinguishing than "steakhouse" in the context of this action. Further, the Examiner is simply wrong that adding an "s" to rail does not change the meaning in any way. It takes two rails to form a single set of railroad tracks, and the "rails" is commonly used to refer to train related travel. (*See* Response to Final Office Action at Exhibit G.) The Examiner, however, contends that a butcher rail is "essentially" the same thing as the rails of a railroad, despite the fact that butcher rails would multiple rails, whereas railroad rails implies a single set. Further, only in Sweeney Todd would the notion of taking a ride on a butcher rail not seem out of place. The Registrant's standard character registration was allowed even though marks such as RAIL CITY were already registered in relation to what the Examiner contends are identical services. If adding a generic term such as "steakhouse" is deemed capable of distinguishing one mark from another given the crowded field and the weak ability of "rail" to indicate the source of bar and

restaurant services, but adding a unique logo does not, when will a design ever be deemed the dominant portion of the mark or capable of distinguishing one mark from another?

In fact, the Examiner's approach gives the broadest protection to what is the thinnest of marks. The Registrant was allowed to register a word that the Registrant itself described as a weak indicator of source, because so many others already used that word in their marks for restaurant and bar services. The only thing the Registrant had to do was combine the word with a generic term. Now, according to the Examiner, the Registrant is entitled to incredibly broad and strong protection for the weak mark, precisely because the "distinguishing" term added was generic and should be discounted in determining whether future applications create a likelihood of confusion. It is simply antithetical to underlying theory of trademarks that such a weak mark should be afforded such broad protection, precisely because the mark is descriptive or borderline generic.

The misguided nature of the Examiner's argument can be seen in her suggestion (raised for the first time on appeal<sup>1</sup>) that the upside down cow logo actually supports a likelihood of confusion analysis. The Examiner contends that since steaks come from cows, consumers are likely to associate the upside cow logo with the RAILS STEAKHOUSE, because both invoke thoughts of beef. This is truly an astonishing argument. Apparently, by combining the generic term "steakhouse" with the descriptive term "rail," anything that causes consumers to think of

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<sup>1</sup> Per the TBMP § 1207.01, the TTAB will ordinarily not consider additional evidence filed with the Board by the examiner after the appeal is filed. Despite this, the Examiner has included 28 attachments with the Examining Attorney's Appeal Brief to support the new basis for refusing registration, i.e., that the upside down cow logo is also likely to cause confusion given the presence of the generic term "steakhouse" in the Registrant's mark. As the Examiner's own newly submitted evidence demonstrates, however, the word "steak" is not limited to cuts of beef and can include slices of other meats and fish.

cows in relation to restaurant services will now create a likelihood of confusion with RAILS STEAKHOUSE.

Here the registered mark combines what the Registrant itself identified as a weak mark with limited capacity to differentiate between various sources of bar and restaurants services with a generic term. Given the weakness of “rail” as a source indicator, the dominant portion of Applicant’s mark is clearly the upside down cow logo. That logo is not likely to engender confusion merely because some steaks come from cows. While “rails” might be the dominant portion of the Registrant’s mark, that should bear little weight given that the Registrant itself attacked the ability of “rail” or “rails” to distinguish among the many bars and restaurants using one of those words in their names.

**III. FAME IS A DuPONT FACTOR AND WEIGHS AGAINST ANY LIKELIHOOD OF CONFUSION.**

The Examiner discounts the lack of fame of the prior mark, stating that the test under the Trademark Act is likelihood of confusion. However, the fifth *DuPont* factor is: “The fame of the prior mark (sales, advertising, length of use).” *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d at 1361. At the time the Applicant adopted its mark, the Registrant had only an intent to use application, with no sales, advertising or use. Thus, this factor clearly weighs against any likelihood of confusion. The Examiner cannot simply ignore *DuPont* factors which do not support the Examiner’s position—or in this case suggest the factor does not even exist!

**IV. THE EXAMINER DOES NOT HAVE TO PROVE CONFUSION BUT MUST ACKNOWLEDGE THAT THE LACK OF CONFUSION WEIGHS AGAINST ANY LIKELIHOOD OF CONFUSION.**

The Examiner’s argument that actual confusion need not be proven to establish likelihood of confusion misses the point. The seventh *DuPont* factor is: “The nature and extent of any actual confusion.” *Id.* Again, the Examiner cannot argue the *DuPont* factors which do not

support her conclusion are irrelevant. Even if the factor is ultimately accorded little weight, it still weighs against a likelihood of confusion. *See Seacret Spa Int'l v. Lee*, No. 2016 U.S. Dist. LEXIS 29611, at \*19 (E.D. Va. Mar. 8, 2016).

Further, the Applicant would note the incongruity of the Examiner's arguments relating to lack of actual confusion and similarity of trade channels. The Examiner argues that, because there are no restrictions on the application or the registration "the identified services are presumed to travel in the same channels of trade to the same class of purchasers." The Examiner later contends that she has "no evidence pertaining to the nature and extent of the use by the applicant and registrant." So the Examiner presumes that such evidence exists in order to invoke similar trade channels as a factor suggesting a likelihood of confusion, only to disavow the presumption when later arguing that the lack of evidence on the same topic prevents the Applicant from relying on the lack of actual confusion as a factor weighing in its favor. An examiner should not be allowed to whipsaw an applicant by invoking a presumption that is (according to the examiner herself) inconsistent with the examiner's basis for finding a different *DuPont* factor does not apply.

## **V. CONCLUSION**

According to the Examiner, the Applicant's mark was properly refused registration because the dominant portion of THE RAIL (with design) mark is likely to be confused with the dominant portion of the RAILS STEAKHOUSE mark. However, there are at least twelve other registrations that include this "dominant" term "rail(s)," and fourteen common-law trademarks. In fact, it was not until the Registrant convinced the USPTO that "rails" was a weak indicator of source that it was allowed to register its mark despite the prior registration of LOS RIELES. (The Registrant must have felt that "rails" was an especially weak indicator of source, given that it

certified that no one had a superior right to use that mark in relation to the services listed, despite the fact that two other bars and restaurants were already using the mark RAILS and the Registrant did nothing more than add the generic term “steakhouse.”) Under the circumstances, the conclusion that the dominant portion of Applicant’s mark is the word “rail” rather than the upside down cow logo is clearly incorrect, and there is no likelihood of confusion given the numerous third-party users of the words “rail” and “rails” in relation to such services. The Applicant’s mark should therefore be allowed to proceed to registration.

Respectfully submitted,

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