

This Opinion is not a
Precedent of the TTAB

Mailed: September 6, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Mariola Burgers, LLC
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Serial No. 85131831
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Andrew P. Lycans of Critchfield Critchfield & Johnston Ltd.,
for Mariola Burgers, LLC

Eugenia K. Martin, Trademark Examining Attorney, Law Office 114,
K. Margaret Le, Managing Attorney.

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Before Seeherman, Shaw and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Mariola Burgers, LLC (“Applicant”) seeks registration on the Principal Register of the following design plus words mark for restaurant and bar services in International Class 43:



The Trademark Examining Attorney has refused registration of Applicant's mark¹ under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that the applied-for mark so resembles the registered mark RAILS STEAKHOUSE (in standard characters, with the exclusive right to use "STEAKHOUSE" disclaimed) for "bar and cocktail lounge services, restaurant" in International Class 43² as to be likely to cause confusion, to cause mistake, or to deceive.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was suspended and remanded to the Examining Attorney at Applicant's request. After the Examining Attorney once again denied the request for reconsideration, the appeal resumed. We reverse the refusal to register.

I. Applicable Law

Our determination of likelihood of confusion under Section 2(d) of the Trademark Act is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*"), cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, __U.S. __, 135 S.Ct. 1293, 113 USPQ2d 2045, 2049 (2015). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

In the course of applying these *du Pont* factors, we bear in mind the fundamental

¹ Application Serial No. 85131831 was filed on September 17, 2010, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

² Registration No. 4588997, issued on the Principal Register on August 19, 2014.

purposes of Section 2(d), which are to prevent consumer confusion as to commercial sources and relationships, and to protect registrants from damage caused by registration of confusingly similar marks. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198, 224 USPQ 327, 331 (1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64, 34 USPQ2d 1161, 1163 (1995); *du Pont*, 177 USPQ at 566. To this end, we have considered each *du Pont* factor that is relevant and for which there is evidence of record, and have treated any other factors as neutral. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. and H.J. Heinz Co. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

II. Analysis

A. Comparison of the Marks.

Under the first *du Pont* factor, we determine the similarity or dissimilarity of Applicant's and Registrant's marks as compared in their entireties, taking into account their appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

The Examining Attorney takes the position that the term RAIL—singular in Applicant's composite mark, plural in Registrant's standard character mark—is a dominant element rendering the two marks confusingly similar in the eyes of the

purchasing public. As the Federal Circuit has observed, though, words are not always the dominant portion of composite word-and-design marks:

In the case of a composite mark containing both words and a design, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed. It is well settled that if a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods. Despite those statements, we also have cautioned that there is no general rule that the letter portion of the mark will form the dominant portion of the mark. Marks, therefore, must be considered on a case-by-case basis.

In re Viterra Inc., 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (internal citations and punctuation omitted). *Accord Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015). *See generally* 4 J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:47 (4th ed. 2016).

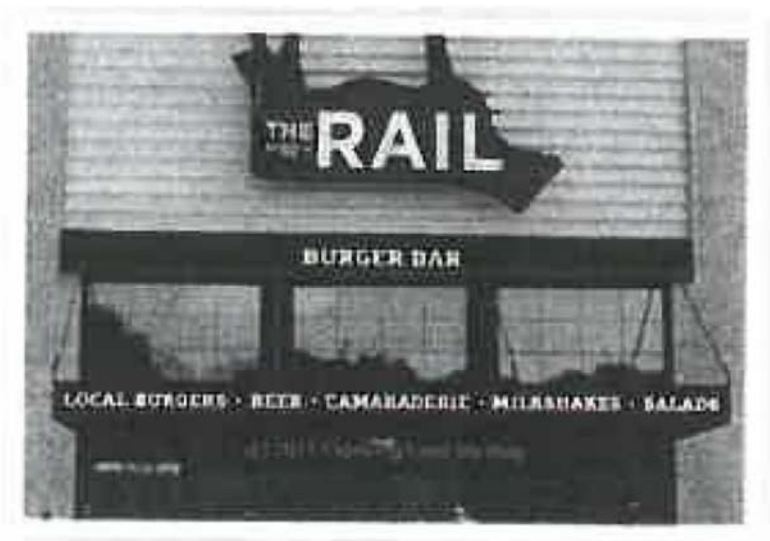
In this case, we find that the appearance of Applicant’s mark, its design element, is its most distinctive, dominant portion:



Judging from the record, which contains no evidence of similar designs for eating establishments, the upside-down cow is indeed a unique design—one that, prominently displayed in advertising, in newspapers or magazines, or on the Internet, “catches the eye and engages the viewer” before drawing attention to its wording. *See Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1016 (TTAB 2007) (BODYMAN design predominates over literal element of mark); *In re Comput. Commc’ns, Inc.*, 484 F.2d 1392, 171 USPQ 51, 52 (CCPA 1973) (holding that the Board

did not err in focusing on the design portion because the Board found the large design portion to be the mark's "most visually prominent feature"), *cited in Jack Wolfskin*, 116 USPQ2d at 1135; *Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1940 (TTAB 2013).

Even if they hear of Applicant's restaurant by word of mouth, customers nowadays are most likely to view the mark as it would ordinarily be displayed in its entirety, whether in advertising, on its website, when they inquire about its cuisine or seek to make reservations, on other Internet sites, or on signage outside Applicant's restaurant:



3

In that context, "the visual impression of the mark is likely to be more important." *In re Covalinski*, 113 USPQ2d 1166, 1168 (TTAB 2014). In *Kellogg Co. v. Pack'em Enters. Inc.*, 14 USPQ2d 1545 (TTAB 1990), the Board found that the applicant's composite word-and-design mark,

³ Response to Office Action of April 24, 2015 at 19.

Frootee
Ice



differed substantially from opposer Kellogg's FROOT LOOPS word mark. *Id.* at 1550. The Federal Circuit affirmed, holding "The Board justifiably held that the substantial and undisputed differences in 'appearance, sound, connotation and commercial impression' between the marks in this case warranted the grant of summary judgment that there was 'no likelihood that [the marks]' contemporaneous use by different parties will result in confusion.'" *Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1144 (Fed. Cir. 1991).

Here, Applicant has chosen an arbitrary word mark, THE RAIL, encompassed by an animal design--bovine, not elephantine. And here, as there, the only similarity between the marks is one word: RAIL in Applicant's mark and RAILS in Registrant's RAILS STEAKHOUSE mark. Focusing on that one small similarity, however, to the exclusion of all else, would be a dissection of the marks. "[M]arks must be viewed 'in their entirety,' and it is improper to dissect a mark when engaging in this analysis, including when a mark contains both words and a design." *Jack Wolfskin*, 116 USPQ2d at 1134 (quoting *In re Viterra*, 101 USPQ2d at 1908). The visual impression of Applicant's mark is likely to be more important than the literal portion it shares with Registrant's mark.

Taken in their entirety, the marks look and sound different. The word STEAKHOUSE at the end of Registrant's mark must be sounded out and considered,

even though it is a disclaimed generic term. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1676 (Fed. Cir. 2015).⁴

Applicant's use of the singular word RAIL is susceptible of a multiplicity of connotations, including:

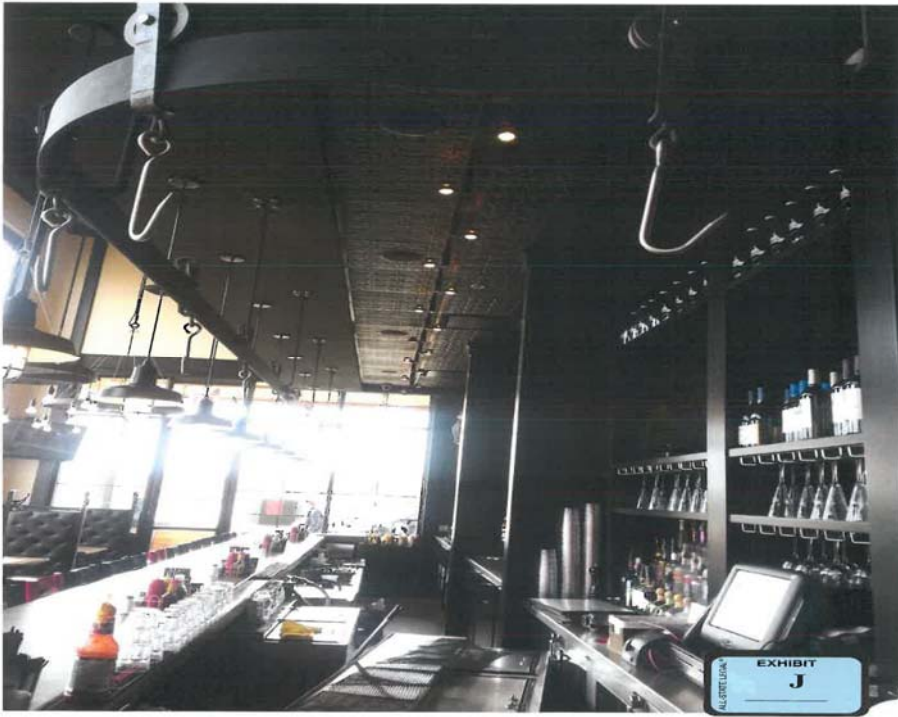
1. A bar of wood or metal fixed horizontally for any of various purposes, as for a support, barrier, fence, or railing.
2. A fence; railing.
3. One of two fences marking the inside and outside boundaries of a racetrack.
4. One of a pair of steel bars that provide the running surfaces for the wheels of locomotives and railroad cars.
5. The railroad as a means of transportation: to travel by rail.
6. Rails, stocks or bonds of railroad companies.
7. Nautical • A horizontal member capping a bulwark.
8. Carpentry, Furniture • Any of various horizontal members framing panels or the like, as in a system of paneling, paneled doors, window sash, or chest of drawers. Compare stile.
9. *Slang* • A line of cocaine crystals or powder for inhaling through the nose.⁵

Applicant maintains that it uses RAIL in the sense of “meat rails, which are ceiling mounted trolley systems used to hang sides of beef. ... In this case, the upside down cow evokes the rail on which sides of beef are hung after butchering,

⁴ The word “THE” at the beginning of Applicant's mark is a definite article, with no trademark significance. *In Re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (citing *inter alia The Conde Nast Pubs. Inc. v. The Redbook Pub. Co.*, 217 USPQ 356, 357 (TTAB 1983)).

⁵ Dictionary.com; Response to Office Action of Jan. 26, 2011, p. 21. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).” *Bond v. Taylor*, 119 USPQ2d 1049, 1056n. 14 (TTAB 2016).

providing context for Applicant's use of THE RAIL."⁶ Applicant has adduced photographs of meat processing rails, with meat hooks, on which it has based the décor of its restaurant and bar:⁷



This reference to butchering operations is not a connotation that leaps readily to mind from the drawing in the application (one usually envisions sides of beef hanging from meat hooks), but it is nonetheless consistent with the upside-down cow design.

The Examining Attorney urges that Applicant's upside-down cow design is a visual reference to a steakhouse: "steak (the primary specialty of a steakhouse restaurant) comes from cows. The presence of the cow design informs the consumer

⁶ Response to Office Action of April 24, 2015, p. 2; Affidavit of Applicant's principal, Michael Mariola, par. 4. Response to Office Action of April 24, 2015, p. 47.

⁷ Response to Office Action of April 24, 2015, pp. 36-41.

that they offer beef, possibly steak, just as the word ‘steakhouse’ informs the consumer that the restaurant offers beef. These descriptive or suggestive elements both create similar impressions in the mind of the consumer.”⁸ However, the word and the design are at opposite ends of the distinctiveness spectrum. One, STEAKHOUSE, is a generic word used by countless chopouses; the other is highly distinctive, showing a cow in an upside-down position:



While the upside-down cow design might be taken as an irreverent depiction of a dead cow—the stuff of which steaks and other beef dishes are made—it is nonetheless consistent with Applicant’s butcher rail theme and distinguishable from Registrant’s word mark (unlike a right-side-up cow, which would be more on all fours with the Examining Attorney’s theory).

Applicant points out that Registrant’s use of the term RAILS evokes a railroad connotation—an association Registrant encourages, witness its form invoice heading:



Rails Steakhouse
10 Whitehall Road
Towaco NJ 07082

⁸ Examining Attorney’s brief, 15 TTABVUE 9, attaching definitions of “steak house,” “steak,” and “beef.” www.Merriam-Webster.com, 15 TTABVUE 15, 22, 24, 31.

⁹ Registrant’s specimen of use, Applicant’s Response to Office Action of April 24, 2015, p. 74.

as well as its webpage depicting its restaurant entrance:¹⁰



Registrant submitted another specimen of use with a different parallel rails stylization:



11

While the reference is subtler in this depiction, it is apparent that Registrant's use of the plural word RAILS is intended to, and does, evoke the nostalgia and enthusiasm commonly associated with railroads—a theme that is popular among

¹⁰ Applicant's Response to Office Action of April 24, 2015, p. 42.

¹¹ Registrant's specimen of use, Applicant's Response to Office Action of April 24, 2015, p. 73.

bars and restaurants, as will be seen when we address third-party uses. We are mindful that the registered mark is in standard characters, which may be depicted in various font styles, sizes, or colors other than the versions Applicant has adduced above. *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011). *See also* Trademark Manual of Examining Procedure (“TMEP”) § 807.03(a) (April 2016). Registrant’s use of its mark is not limited by this extrinsic evidence of its actual use. Nevertheless, the evidence of record shows that the term RAIL admits of multiple meanings, meanings that the purchasing public may interpret quite differently based on other dissimilarities in the marks, such as a highly distinctive design.

When the marks are considered in their entirety, and not dissected, *see In re Viterra*, 101 USPQ2d at 1908, “the overall commercial impression of Applicant’s mark is dominated by its design features....” *In re Covalinski*, 113 USPQ2d at 1169. As in *Kellogg v. Pack’em*, there are, on the whole, substantial differences in the marks’ appearance, sound, connotation and commercial impression. 21 USPQ2d at 1144-45.

Hence, the first *du Pont* factor, similarity or dissimilarity of the marks, weighs against a likelihood of confusion.

B. The Number and Nature of Similar Marks for Similar Services.

The conclusion that consumers are likely to differentiate the marks due to their dissimilarities is strengthened by the prevalence of RAIL-formative marks registered and used in connection with restaurant and bar services. The Federal Circuit has stated that “evidence of third-party use of similar marks on similar goods ‘can show that customers have been educated to distinguish between different marks on the

basis of minute distinctions.” *Jack Wolfskin*, 116 USPQ2d at 1136, quoting *Juice Generation*, 115 USPQ2d at 1674. “A mark that is hemmed in on all sides by similar marks on similar goods or services cannot be very ‘distinctive.’ It is merely one of a crowd of similar marks. In such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other.” 2 J.T. McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 11:85 (4th ed. 2016).

This principle was illustrated in *Anthony's Pizza & Pasta Int'l Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271 (TTAB 2009) *aff'd per curiam* 415 F. App'x 222 (Fed. Cir. 2010). In that case, the testimony, third-party registrations and telephone listings showed that the name “Anthony’s” had been extensively registered and used as a trademark for restaurant services, particularly Italian restaurants and pizzerias. *Id.* at 1278. Consequently, the plaintiff, which owned the senior mark ANTHONY’S PIZZA & PASTA for restaurant services, was “not entitled to such a broad scope of protection that it is a bar to the registration of every mark comprising, in whole or in part, the name ‘Anthony’s.’” *Id.* Rather, the plaintiff’s rights were hemmed in, and could only bar the registration of marks that bore a “striking” enough resemblance to its mark to cause confusion. *Id. cited in in Juice Generation*, 115 USPQ2d at 1675.

Here, Applicant has submitted evidence of third-party registrations and uses in commerce of RAIL-formative marks in connection with restaurants and bars. Most tend to evoke one of two aforementioned definitions of “rail”: either a railroad or a

“brass rail” (used as a footrest at bars). The third-party registrations are set forth in the table below:¹²

Mark	Registration	Services
RAILROAD PASS	Reg. No. 1979701, issued June 11, 1996	Including restaurant and bar services
RAIL CITY	Reg. No. 2124254, issued June 11, 1996	Including restaurant and bar services
RAILHEAD SMOKEHOUSE BBQ & Design	Reg. No. 2555206, issued April 2, 2002.	Including restaurant and bar services
LOS RIELES (translates into “THE RAILS”)	Reg. No. 3654274, issued July 14, 2009, cancelled Feb. 19, 2016.	Restaurant services
RAIL CITY ALE HOUSE & Design	Reg. No. 3678981, issued Sept. 8, 2009	Cocktail lounges, restaurant and bar services
OLD RAIL BREWING COMPANY	Reg. No. 4403700, issued Sept. 17, 2013	Beer, ale and lager; bar services, restaurant services

Based on the third-party registrations, Applicant concludes that “The field is a crowded one, with such registrations both preceding and following the Applicant’s application and the Registrant’s application.”¹³ Applicant continues, “The USPTO has long recognized that, given the crowded field, even small differences are sufficient to distinguish among the various restaurateurs and bar owners who include rail in their name, i.e., Rail City, Los Rieles, and Old Rail Brewing Company.”¹⁴

The Examining Attorney concedes that “These registrations appear to be for services similar to those identified in applicant’s application,”¹⁵ but argues that they are not evidence of what happens in the marketplace or that customers are familiar

¹² Request for Reconsideration, July 16, 2015, pp. 1, 10-18; Response to Office Action of April 24, 2015, pp. 15-29.

¹³ Applicant’s brief, p. 9, 12 TTABVUE 10; Response to Office Action of April 24, 2015, p. 2.

¹⁴ Applicant’s brief, p. 8, 12 TTABVUE 9; Request for Reconsideration, July 16, 2015, p. 2.

¹⁵ Examining Attorney’s brief, 15 TTABVUE 10.

with them.¹⁶ Applicant responds with third-party uses in commerce, listed as follows:¹⁷

Mark	Use in Commerce
Rail House Restaurant & Brew Pub	In Marinette, Wisconsin since 1997; menu includes steak.
The River Rail Bar & Grill	In Shiocton, Wisconsin since 1983.
Brass Rail Bar and Grill	In Matawan, New Jersey for over 94 years.
The Brass Rail	In Allentown, Pennsylvania since 1931.
Brass Rail Sports Bar & Grill	In Kansas City, Missouri since 2004.
Brass Rail	Hoboken, New Jersey
Brass Rail Restaurant and Bar	Phillipsburg, New Jersey
Brass Rail	Locust Valley, New York
Brass Rail Steakhouse	O'Fallon, Missouri
Brass Rail Bar & Grill	Plymouth, Indiana
Rails	Maine
Rails Restaurant and Bar	LaGrange, Kentucky
Rails Craft Brew & Eatery	Seymour, Indiana

Applicant confirmed that all of the above eating and drinking establishments were going concerns, open for business.¹⁸ The Examining Attorney argues that the third-party registrations and “common law trademarks” cited by Applicant generally

¹⁶ *Id.* citing *inter alia* *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973); *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1167 n.5 (TTAB 2013).

¹⁷ Request for Reconsideration, July 16, 2015, pp. 2, 19-33.

¹⁸ Malcolm Affidavit, Exhibit 21, Request for Reconsideration, July 16, 2015, pp. 35-36.

include matter that distinguishes them from Applicant's and Registrant's marks.¹⁹ But that is precisely the point; the RAIL formative is so commonly registered and used as to be distinguished based on slight differences in marks.

Indeed, during Registrant's prosecution of the application that matured into the cited Registration, another then-subsisting registration, Reg. No. 3654274 for LOS RIELES (which translates into THE RAILS), was cited against it in a final Office Action. In a request for reconsideration, Registrant raised the same argument that Applicant does now: "As illustrated below, the word RAILS is diluted with regard to restaurant services. At present, there are at least 10 live marks on the Principal Register owned by third parties containing RAIL or variations of the word for restaurant services."²⁰ The refusal was withdrawn, and Registrant's application was permitted to proceed to registration. Prior statements in *ex parte* proceedings are not binding or preclusive of the issue, nor do they relieve the Board, as decision maker, of its obligation to reach a conclusion based on the entire record, but they do illuminate the shade and tone of the total picture. *Juice Generation*, 115 USPQ2d at 1675; *Stone Lion*, 110 USPQ2d at 1161; *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978); 6 J.T. McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 32:111 (4th ed. 2016).

Here, the total picture shows that the term RAIL is so commonly registered and used for restaurant and bar services that the relevant purchasing public can be expected to distinguish among RAIL-formative marks based on minor differences.

¹⁹ Examining Attorney's brief, 15 TTABVUE 11.

²⁰ 7 TTABVUE 17, Registrant's April 8, 2011 response to Office Action, attached to Applicant's motion to suspend and remand.

Registrant distinguished its mark with the generic suffix STEAKHOUSE. The scope of Registrant's protection is "hemmed in" by the crowd surrounding it, and can only bar registration of marks that, taken in their entirety, bear a "striking" resemblance to it. *Anthony's Pizza & Pasta*, 95 USPQ2d at 1278.²¹ Applicant's highly distinctive upside-down cow design does not bear a striking resemblance to Registrant's mark; rather, as we have found above, it is substantially dissimilar, and far more distinctive than STEAKHOUSE. This serves to distinguish it from Registrant's mark.

For these reasons, the sixth *du Pont* factor weighs against a likelihood of confusion.

C. Comparison of the Services and Channels of Trade

The Applicant's identified services are "restaurant and bar services."

Registrant's identified services are "bar and cocktail lounge services; restaurant." Because both the application and registration include bar and restaurant services, Applicant's identified services are identical to Registrant's. Applicant endeavors to characterize itself as a "burger joint," in contradistinction to Registrant, which is a steakhouse,²² but that distinction is not manifested in the identification of services. We make our determinations under the second *du Pont* factor based on the goods or services as they are identified in the registration and application, not based on extrinsic evidence. See *Stone Lion*, 110 USPQ2d at 1162; *Octocom Sys. Inc. v. Houston*

²¹ Marks "must be considered on a case-by-case basis." *Viterra*, 101 USPQ2d at 1908. In *Anthony's Pizza & Pasta*, the marks' shared dominant component, ANTHONY'S, carried a single connotation as a first name, and the literal portions of the parties' marks, ANTHONY'S PIZZA & PASTA versus ANTHONY'S COAL-FIRED PIZZA, overlapped considerably, so the Board found a likelihood of confusion. Here, the single shared term RAIL carries multiple connotations, and the parties' marks are distinguished by Applicant's dominant design.

²² Applicant's brief, p. 16, 12 TTABVue 17.

Comp. Servs., Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787-88 (Fed. Cir. 1990); *Bond v. Taylor*, 119 USPQ2d at 1052. Nor do we read limitations into the identifications. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983). Consequently, we find that Applicant's and Registrant's services are legally identical. And since the services are deemed identical, it is presumed that they travel in the same channels of trade to the same classes of customers. *In re Viterra*, 101 USPQ2d at 1908. These factors weigh in favor of finding a likelihood of confusion.

D. Other *du Pont* Factors.

Under the fifth, seventh and eighth *du Pont* factors, Applicant argues that the registered mark is not famous, that there was no bad faith on Applicant's part in adopting it, and that the marks have been in concurrent use for over a year, with no actual confusion among restaurant and bar patrons.²³ *du Pont*, 177 USPQ 567.

In an *ex parte* appeal, however, the Board does not expect the Examining Attorney to submit evidence of the registered mark's fame, and absent such evidence, this factor is treated as neutral. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1086 (TTAB 2016). The Examining Attorney has not argued that Applicant adopted its mark in bad faith. Applicant's assertion that there has been no actual confusion during the marks' concurrent use is anomalous to begin with, considering that its application is based on intent-to-use under Section 1(b) of the Lanham Act. 15 U.S.C. § 1051(b). But even if this assertion of use is credited, the self-serving statement of Applicant's principal that he is unaware of instances of actual confusion is of little or

²³ Applicant's brief, pp. 17-18, 12 TTABVUE 18-19; Affidavit of Applicant's principal, Michael Mariola ¶¶ 5-6, Response to Office Action of April 24, 2015 at 47-48.

no probative value in an *ex parte* context, where the Registrant has not been afforded an opportunity to testify. *In re Majestic Distilling Co.*, 65 USPQ2d at 1205; *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026–27 (TTAB 1984). Moreover, given the difficulty in obtaining evidence of actual confusion, and the brevity of the asserted concurrent use, this evidence does not assist us in determining whether confusion is likely. Consequently, we deem these *du Pont* factors neutral.

III. Conclusion

We have considered all of the arguments and evidence of record, and all relevant *du Pont* factors. The parties' services, channels of trade, and classes of customers are the same. We are mindful that where, as here, the services are legally identical, the degree of similarity between the marks necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Nevertheless, the number and nature of similar marks for the same or similar services narrows the scope of protection to which Registrant's mark is entitled, and the dissimilarities in the subject marks, in terms of appearance, sound, connotation, and commercial impression, outweigh their similarity. All other *du Pont* factors are treated as neutral. On balance, we find that the applied-for mark



for restaurant and bar services is not likely to cause confusion with the registered mark, RAILS STEAKHOUSE.

Decision: The refusal to register Applicant's mark is reversed.

Seeherman, Administrative Trademark Judge, dissenting:

I respectfully dissent from the majority view that Applicant's mark THE RAIL and design for restaurant and bar services is not likely to cause confusion with the mark RAILS STEAKHOUSE in standard characters, registered for "bar and cocktail lounge services, restaurant." As the majority has recognized, Applicant's restaurant and bar services are legally identical to the restaurant and bar services identified in the cited registration. As a result, the channels of trade and classes of customers are deemed to be the same. When marks would appear on virtually identical goods or services, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate*, 23 USPQ2d at 1700. Thus, the *du Pont* factor of the similarity of the services weighs heavily in favor of a finding of likelihood of confusion. I believe the majority has not given enough weight to the effect of this factor.

Moreover, the consumers of the identified restaurant and bar services are members of the general public, who may make the decision to visit a restaurant or bar on impulse, and certainly without exercising a great deal of care. That *du Pont* factor also supports a finding of likelihood of confusion.

The majority bases its finding of no likelihood of confusion primarily on what it perceives as differences in the marks and weakness of the cited registration. I disagree with both of these conclusions. Although the design element in Applicant's

mark, with its upside down cow, is distinctive, given the nature of the services, I do not believe that the difference in appearance is sufficient to distinguish Applicant's mark from the Registrant's. That is because restaurant and bar services are frequently recommended by word of mouth, when the appearance of the mark would have no impact. The Board made this point in *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987), a case frequently cited for the proposition that, if a mark comprises both a word and a design, the word is normally accorded greater weight. The Board stated that this principle "is especially important in cases involving restaurant services in view of the propensity of persons to try restaurants based on word-of-mouth recommendations." *Id.* at 1554. Even in *Anthony's Pizza & Pasta Int'l v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1279 (TTAB 2009), a case cited by the majority in connection with the strength to be accorded Registrant's mark, the Board found that ANTHONY'S was the dominant element in the mark shown below, noting that "it is clearly as 'ANTHONY'S' that consumers will refer to defendant's mark in using it to identify the source of the services."



Although customers who decide to patronize the restaurant based on word-of-mouth recommendations will see the cow design when they actually arrive at Applicant's restaurant, this does not serve to avoid confusion, since such

recommendations would not include mention of the cow design in the logo. The customers' intention would be to visit RAILS STEAKHOUSE, and the cow design in THE RAIL and design mark would not alert them to the fact that the latter restaurant is not connected to the restaurant they were looking for.

Similarity in appearance, sound, meaning *or* commercial impression may be a sufficient basis on which to find marks to be similar in terms of the first *du Pont* factor. In *Centraz Indus. Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006), which involved the marks ICE SHINE and ISHINE (stylized), both for floor finishing preparations, the Board found that “the similarity in sound is so substantial that it outweighs any differences in appearance and meaning,” noting specifically that “the goods may be recommended by word of mouth.” In this case, the slight differences in pronunciation between THE RAIL and RAILS STEAKHOUSE, due to the presence or absence of THE and STEAKHOUSE, and the singular or plural form of RAIL, do not distinguish the marks in terms of pronunciation. The definite article THE at the beginning of Applicant's mark and the generic term STEAKHOUSE in Registrant's mark have no source-indicating significance; in fact, consumers hearing the mark RAILS STEAKHOUSE might understand “steakhouse” as merely referring to the type of restaurant, and assume that the mark is RAILS. Further, most consumers would not even notice whether the term RAIL[S] is pronounced in the plural or singular form.

The fact that restaurants are frequently recommended by word of mouth distinguishes the present situation from that in *Parfums de Coeur Ltd. v. Lazarus*, which the majority cites to show that a design may predominate over the word portion

of a mark. The Board found in *Parfums* that the similarity in the sound of the marks was not a dispositive factor because of the differences in the goods and services-- fragrance products vs. a television series-- such that even if recommendations for the television program were by word of mouth, they would be for a television program and not a fragrance product. In the present case, of course, the services are identical.

Even when the design element in Applicant's mark is taken into consideration in terms of the appearance of the marks, I am not as dismissive as the majority of the Examining Attorney's view that the upside-down cow creates a similar impression in the minds of consumers to that conveyed by the word STEAKHOUSE. Although STEAKHOUSE is a generic term for a restaurant, and the upside-down cow only suggests how the products served in the restaurant were obtained, the meanings conveyed by both the word STEAKHOUSE and the cow design are connected and therefore similar. As a result, although consumers will certainly take note of the cow design upon encountering the actual mark, consumers who are familiar with Registrant's RAILS STEAKHOUSE mark are likely to assume that Applicant's THE RAIL and cow design mark is a variation of Registrant's mark. *See Anthony's Pizza & Pasta*, 95 USPQ2d at 1283.

The majority has suggested that the meanings of the words THE RAIL and RAILS in the respective marks are different, based on one of the specimens that was submitted in connection with the cited registration, and based on photographs of the interior of Applicant's restaurant, which the majority describes as having "meat processing rails." I do not believe it is appropriate to distinguish the meanings of what

are virtually identical words for identical services based on such extrinsic evidence.²⁴ As a preliminary matter, it is not clear to me that consumers would even recognize the décor of Applicant's restaurant as featuring meat rails, and conclude from this that the restaurant name THE RAIL refers to such meat rails. As the majority has said, "Applicant has chosen an arbitrary word mark, THE RAIL...." I see no reason why, if the majority views the term as arbitrary, potential customers seeing the mark on signage, or hearing of it through word of mouth, would understand it to mean an item found within the restaurant. Even with the accompanying design of the upside-down cow, I highly doubt that consumers would understand THE RAIL to be a meat rail; based on the explanation of meat rails provided by Applicant and the photographs of the restaurant interior, it is sides of beef that are hung on meat hooks that are suspended from rails, rather than entire cows that are hung upside down on rails.

In any event, the question is not whether, once a consumer enters the restaurant, he or she would divine a meaning for THE RAIL based on the interior décor. The question is whether a consumer, familiar with Registrant's mark RAILS STEAKHOUSE for a restaurant, is likely to believe, upon encountering Applicant's mark (*not* after entering the restaurant), that Applicant's restaurant is associated with Registrant's restaurant. *Cf. In re ALP of South Beach Inc.*, 79 USPQ2d 1009,

²⁴ Identical marks can have different meanings based on the different goods or services with which they are used *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras and CROSSOVER for ladies' sportswear project different meanings); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear versus BOTTOMS UP for men's suits, coats and trousers); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear versus PLAYERS for shoes).

1014 (TTAB 2006) (CAFETERIA deceptive for restaurants, excluding cafeteria-style restaurants; customers will have been misled by the name in the first place—causing them to decide to patronize the restaurant.”).

I disagree with the majority’s point that the marks would convey different meanings because the word RAIL/RAILS can have different meanings, or that, because of the upside down cow design in Applicant’s mark, the words THE RAIL would have a different meaning from RAILS in RAILS STEAKHOUSE. Just as it would be incorrect to look at the interior décor of Applicant’s restaurant to divine a meaning for THE RAIL, it would be incorrect to look to the specimen invoice found in the file of the cited registration, or the webpage from Registrant’s website, and conclude that the overall commercial impression of Registrant’s mark suggests railroads. The cited registration is for the mark in standard characters and, as the majority recognizes, it is not limited to any particular type font or style. Therefore, the protection to be accorded this mark should not be limited by any extrinsic evidence that would restrict it to a particular meaning as a result of any current or past depiction.²⁵

I also disagree with the majority on its assessment of the third-party registration and third-party use evidence. Although the majority opinion sets forth six third-party registrations, one of them (LOS RIELES) has been cancelled, and two are owned by the same entity (RAIL CITY and RAIL CITY ALE HOUSE and design). Further, in four of these registrations the term RAIL makes reference to a railroad or a place

²⁵ In fact, the second specimen in the registration file, depicted in the majority opinion, does not, in my view, convey any indicia of a railroad theme.

located on a railroad, i.e., RAILROAD PASS, RAIL CITY, RAIL CITY ALE HOUSE and RAILHEAD SMOKEHOUSE BBQ. There is only one registration, for OLD RAIL BREWING COMPANY, that has an ambiguous meaning for RAIL, in the same way that the meaning of RAIL is unclear in Applicant's THE RAIL and design mark and Registrant's RAILS STEAKHOUSE mark. This one registration is not sufficient, in my view, to show that RAILS in Registrant's RAILS STEAKHOUSE mark has a significance for restaurant and bar services.

As for the evidence of third-party use, of the thirteen listed marks, eight are for the term BRASS RAIL which, as the majority has noted, has a significance for bar services, as it denotes the rail on which a patron sitting on a bar stool can rest his or her feet. The five remaining third-party uses listed in the chart in the majority opinion, i.e., Rails Craft Brew & Eatery, Rail House Restaurant & Brew Pub, The River Rail Bar & Grill, Rails, Rails Restaurant and Bar, are simply not a sufficient number for me to conclude that consumers have been so exposed to such uses that they will distinguish Applicant's mark from Registrant's mark based on the words THE and STEAKHOUSE and the cow design, particularly when, as I have stated, restaurants are frequently referred to and recommended by word of mouth, when the cow design would not be seen or mentioned.

Recent decisions by the Federal Circuit Court of Appeals, our primary reviewing court, have made it clear that evidence of third-party use bears on the strength or weakness of the cited mark. *See Juice Generation*, 115 USPQ2d at 1674; *Jack*

Wolfskin, 116 USPQ2d at 1135-36.²⁶ However, I do not consider the limited number of third-party uses shown here, or even the third-party registrations, to constitute the “voluminous evidence” of use and registration that the Court referred to in *Jack Wolfskin*, 116 USPQ2d at 1136. Nor do they reach the level of the 26 third-party uses/registrations identified in *Juice Generation*, 115 USPQ2d at 1673, n. 1, all of which began with the phrase at issue, PEACE LOVE”; in the present case, the term RAILS merely appears *somewhere* in the mark.²⁷

Accordingly, when all the *du Pont* factors are considered, I would find that the limited evidence of third-party use and registrations does not outweigh the identity of the services and channels of trade, the lack of care with which the services may be chosen, and the fact that restaurant recommendations are frequently given by word-of-mouth, such that the upside-down cow design does not serve to distinguish the marks.

²⁶ These cases were oppositions, rather than ex parte appeals, and therefore discussed the factor of strength in terms of the opposer’s mark. However, the principle applies to cited registrations in the ex parte context.

²⁷ It should be noted that, in the *Anthony’s Pizza* case, although the evidence of extensive adoption, registration and use of the name “Anthony’s” resulted in a finding that the plaintiff’s mark was weak and entitled to only a narrow scope of protection, this factor was outweighed by the similarity of the marks and the identity of the services, channels of trade and classes of consumers.