

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Palermo Villa, Inc.

Serial No. 86836045

Daniel E. Kattman and Heidi R. Thole of Reihnardt Boerner Van Deuren, s.c.
for Palermo Villa, Inc.

Carol Spils, Trademark Examining Attorney, Law Office 104,
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Before Cataldo, Lynch, and Coggins,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

Palermo Villa, Inc. (“Applicant”) seeks registration on the Principal Register of

the mark  with PIE PIZZA CO. disclaimed, for frozen pizza not sold

or distributed through restaurants in International Class 30.¹ The Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with two registered marks of the same owner:²

URBAN PI and design  and URBAN PI CREATIVE

PIZZA and design  creative pizza both for “[r]estaurant, restaurant

carryout, and catering services; take out restaurant services for consumption of food off the premises” in International Class 43. After the final Office Action, Applicant appealed and requested reconsideration. The Examining Attorney denied the request, and this appeal proceeded. This Board subsequently granted Applicant’s request for a remand to submit newly available evidence.³ The Examining Attorney considered the new evidence, but maintained the refusal, and supplemented the

¹ Application Serial No. 86836045 was filed December 1, 2015, based on a declared intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Registration Nos. 4538919 and 4538920 both issued May 27, 2014. Their mark descriptions contain the following identical wording: “The mark consists of a rectangular design with the stylized wording ‘URBAN Pi’ therein. ‘Pi’ is surrounded by a circle, and a flame represents the dot in the ‘i’. The design of a pizza peel appears behind all of the wording in the rectangle in the mark with its head being directly behind the circle containing ‘Pi.’” And the description in Registration No. 4538920 also contains the concluding sentence, “The stylized wording ‘creative pizza’ appears below the rectangle.”

³ 13 TTABVUE.

record with evidence to rebut Applicant's new evidence.⁴ This appeal again resumed and is fully briefed. We affirm the refusal to register for the reasons set out below.

II. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*du Pont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods and services. *See In re Chatam Int'l Inc.*, 380 F.2d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks.”). We discuss below these and other relevant factors. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006) (only *du Pont* factors that are “relevant and of record” need be considered).

A. The Goods and Services

As to the goods and services, we must determine whether their degree of relatedness rises to such a level that consumers would mistakenly believe the

⁴ 14, 15, and 16 TTABVUE.

respective goods and services emanate from the same source. In making this analysis of the second *du Pont* factor, we look to the identifications in the application and cited registrations. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Applicant identifies “frozen pizza not sold or distributed through restaurants,” while the cited registrations recite “[r]estaurant, restaurant carryout, and catering services; take out restaurant services for consumption of food off the premises.”

Applicant argues that the Examining Attorney has not shown the requisite “something more” needed to establish the relatedness of food items and restaurant services. “[T]o 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.” *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) (citation omitted); see also *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1087 (Fed. Cir. 2014) (explaining the need to show “something more’ than the mere fact that the goods and services are ‘used together’” in situations where the relatedness of the goods and services is obscure or not generally recognized).

The record includes evidence that goods and services of this type emanate from the same source under the same mark. In particular, the evidence suggests that pizzerias offer frozen versions of their pizzas that are sold through retail stores. For example:

The California Pizza Kitchen website invites visitors to “visit your favorite location ... to experience our hand-tossed artisan pizzas...” and promotes its frozen pizzas with a link to “Find Grocery Store” where the goods are available;⁵

The website for Roberta’s in Brooklyn offers location and menu information for its pizza restaurants, and the record includes an online article entitled “Taste Test: We Try the \$12 Roberta’s Frozen Pizza from Whole Foods Gowanus,” stating, “The plastic-wrapped margherita is the Brooklyn restaurant’s first foray into frozen foods” and noting that the pizzas are sold at the local Whole Foods grocery store;⁶

The Connie’s Pizza website advertises pizza restaurant services and notes that its “restaurant-style deep dish pizza is now available as a frozen pizza in your local grocer’s freezer case”;⁷

The Instacart.com website promotes the “Full of Life Flatbread” frozen pizza with a link for delivery as well as information to “Find Stores” and “see prices in your local store” for the frozen pizza, and the Full of Life Flatbread website shows a photograph of the restaurant interior, indicating “We will be open for lunch every Saturday and Sunday”;⁸

⁵ TSDR March 29, 2016 Office Action at 43-45 (cpk.com & cpkfrozen.com).

⁶ *Id.* at 48-49 (robertaspizza.com & firstwefeast.com).

⁷ *Id.* at 41-42 (conniespizza.com). We note that during this appeal, after requesting a remand to submit newly existing evidence, Applicant submitted documentation dated February 14, 2017 that it acquired trademark rights to the CONNIE’S mark for frozen pizza, while the trademark rights in restaurant services will remain with the original owner. 12 TTABVUE. Nonetheless, at the time the Examining Attorney submitted (and consumers were exposed to) the CONNIE’S-related evidence, the respective rights rested with the same original owner.

⁸ TSDR February 20, 2017 Office Action at 46-49 (instacart.com & fulloflifefoods.com).

The American Flatbread website features information about American Flatbread restaurants and about American Flatbread frozen pizza, which can be found “in your freezer section”;⁹

The website of Gino’s East of Chicago features information about its “landmark downtown Chicago eatery” as well as its “deep-dish pizza now available in your grocers freezer,” corroborated by the Target website indicating that Gino’s East of Chicago frozen pizza is available in some of its stores;¹⁰

The Sbarro website offers information about its pizzerias, while the Walmart website shows Sbarro frozen pizza in stock at various Walmart stores;¹¹

The Amy’s mark appears on frozen pizza sold through Walmart and also is used in connection with a fast food restaurant;¹²

The website of Home Run Inn pizzeria indicates that there are multiple restaurant locations under the mark, while the Walmart website shows that Home Run Inn frozen pizza is sold at Walmart stores;¹³

The mark Table 87 appears in connection with restaurant services and on frozen pizzas that the website indicates are sold “in the supermarket”;¹⁴

⁹ *Id.* at 52-55 (americanflatbread.com).

¹⁰ *Id.* at 56-65 (ginoseastpizza.net); 16 TTABVUE 26 (target.com).

¹¹ TSDR March 29, 2016 Office Action at 52-53 (sbarro.com & walmart.com).

¹² 16 TTABVUE 8-22 (walmart.com, amys.com, amysdrivethru.com) (May 22, 2017 Denial of Reconsideration).

¹³ 17 TTABVUE 7 (homeruninnpizza.com); 16 TTABVUE 31 (walmart.com).

¹⁴ 14 TTABVUE 2-7 (table87.com).

The Target website indicates that Uno frozen pizza is sold at some of its stores, while the Uno website shows the same mark used in connection with pizzeria restaurant services.¹⁵

This marketplace evidence demonstrates that consumers encounter frozen pizza sold or distributed through non-restaurant channels under the same mark as restaurant services. The evidence suggests that pizza restaurants, in particular, venture specifically into the frozen pizza industry, marketing frozen pizza under their restaurant marks, even when that pizza is sold through grocery or other retail stores. Showing “something more” than just that these goods and services are offered under the same mark, numerous examples from the record also reflect mark owners touting the connection between their restaurants and their frozen pizza, making restaurant customers aware that, for example, they can “ENJOY OUR PIZZA AT HOME!”¹⁶ The Home Run Inn website provides the background that its “Home Run Inn frozen pizzas are made exactly like they are at all of our pizzeria locations We began freezing the pizzas ahead of time and distributing them to neighborhood grocers—and it was a hit! [They] are now available in more than thirty five states nationwide.”¹⁷ The Connie’s Pizza website similarly explains, “For over 50 years, Connie’s Pizza has been famous for pizza. Our restaurant-style deep dish pizza is now available in your local grocer’s freezer case.”¹⁸ We note that in this case Registrant’s unrestricted

¹⁵ *Id.* at 8-15 (target.com & unos.com).

¹⁶ *Id.* at 6 (table87.com).

¹⁷ 15 TTABVUE 7 (homeruninnpizza.com).

¹⁸ TSDR March 29, 2016 Office Action at 42 (conniespizza.com).

identification of “[r]estaurant . . . services” encompasses pizza restaurants. Indeed, the wording and designs in Registrant’s mark, and other evidence in the record, show that Registrant operates a pizzeria.¹⁹

The Examining Attorney also submitted additional evidence, in the form of a sizable number of use-based third-party registrations that identify frozen pizzas and restaurant services under the same mark.²⁰ These registrations suggest that the relevant goods and services may emanate from the same source. *See Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013) (“The use-based, third-party registrations . . . also have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark.”); *see also In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

Applicant’s proffered statistical-type arguments about the rarity of one entity providing restaurant services and frozen pizza are flawed and have little probative

¹⁹ *Id.* at 8-12; TSDR July 8, 2016 Office Action at 2 (urbanpi.com).

²⁰ TSDR March 29, 2016 Office Action at 13-38; TSDR November 10, 2016 Office Action at 2-50; TSDR February 20, 2017 Office Action at 2-41, 74-. We have not considered registrations that do not contain the relevant goods/service, indicate that the registrations have been cancelled, or that the relevant goods/services have been deleted, such as Reg. Nos. 1780465, 2956376, 3202619, 3313236, 3423391, 3425412, 3473869, 3520355, 3951553, 3982409, 4207013, 4212582, 4487234, 4487235, 4517470, 4752636, 4763888, 4917041, 5081487. We also have taken into consideration the additional evidence submitted by Applicant on remand of its acquisition of three of the third-party registrations, which according to Applicant demonstrates “that even fewer entities sell both frozen pizza at retail and restaurant services under the same or similar trademark” and “that entities that sell frozen pizza at retail and entities that offer restaurant services under a similar trademark may co-exist in the marketplace without causing consumer confusion.” 12 TTABVUE 4 (Applicant’s Request for Remand).

value. We reject Applicant's contentions based on the alleged number of operating restaurants in the U.S.²¹ Applicant's claim about the number of restaurants is not based on evidence in the record in this case, but instead rests on a factual finding from the 2003 *Coors Brewing* case, 68 USPQ2d at 1063. The *Coors Brewing* finding relied on actual evidence submitted by the applicant in that case. By contrast, here, where Applicant introduced no evidence on this point, we decline to find that the state of the restaurant marketplace well over a decade later remains the same. *See, e.g., Faultless Starch Co. v. Sales Producers Associates, Inc.*, 530 F.2d 1400, 189 USPQ 141, 142-43 (CCPA 1976) (holding that ultimate conclusion regarding likelihood of confusion is necessarily drawn from all probative facts in evidence in each individual case, such conclusion, as distinguished from general rules of law or interpretation, cannot be controlled by earlier conclusions reached in another case); *Nat'l Dairy Products Corp. v. Parman-Kendall Corp.*, 122 USPQ 332, 333 (TTAB 1959) ("facts found by a court and the conclusions drawn therefrom in a case involving another party are not binding on this applicant or controlling on this tribunal").

We also find fault with Applicant's arguments stemming from TESS search results it introduced. Regarding the number of registrations identifying "frozen pizza" and restaurant services, or "frozen pizza" but not restaurant services, Applicant's search query and results reflect that it has overlooked that a broader identification such as "pizza" would encompass frozen pizza.²² *See In re Hughes Furniture Indus.*,

²¹ 18 TTABVUE 21 (Applicant's Brief).

²² 4 TTABVUE 55-57 (January 9, 2017 Request for Reconsideration).

Inc., 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”). Thus, Applicant’s numbers of third-party registrations with or without the goods/services at issue cannot be considered accurate. Furthermore, the question is not whether some, or even many, entities have registrations for both frozen pizza and restaurant services. Rather, the question is whether consumers are exposed to entities that engage in both activities, and the evidence submitted by the Examining Attorney is sufficient to show that this is not an aberration done by only one or two companies. As the Board said in connection with a similar argument based on third-party registrations, *i.e.*, that there were many third-party registrations for the goods of the applicant that did not include the goods identified in the cited registration, and vice versa:

There is no requirement for goods to be found related that all or even a majority of the sources of one product must also be sources of the other product. Therefore, evidence showing only that the source of one product may not be the source of another product does not aid applicant in its attempt to rebut the evidence of the examining attorney.

In re G.B.I. Tile and Stone Inc., 92 USPQ2d 1366, 1370 (TTAB 2009) (also noting that registrants may have registered the omitted goods/services in a separate registration or may have begun use on those goods/services at a later date).

Overall, we find that the record amply supports the relatedness of restaurant services and frozen pizza. The evidence of industry practice with pizzerias like Registrant’s branching out into the sale of frozen pizza through retail channels contributes to the requisite “something more.” *Compare Coors Brewing Co.*, 68

USPQ2d at 1064 (court found “something more” lacking to find beer and general restaurant services related but noted that the “case would be different” if comparing a brewpub and beer); *see also In re Opus One Inc.*, 60 USPQ2d 1812, 1815-16 (TTAB 2001) (finding the requisite “something more” showing the relatedness of wine and restaurant services based on industry practice of private labeling as well as other considerations); *In re Azteca Rest. Enterprises Inc.*, 50 USPQ2d 1209, 1211 (TTAB 1999) (evidence indicated that “Mexican food items are often principal items of entrees served by . . . Mexican restaurants,” so “the average consumer, therefore, would be likely to view Mexican food items and Mexican restaurant services as emanating from or sponsored by the same source if such goods and services are sold under the same or substantially similar marks”).

Considering the non-precedential cases cited by Applicant for whatever probative value they may have, we find them quite distinguishable. *See In re Constr. Research & Tech. GmbH*, 122 USPQ2d 1583, 1585 n.6 (TTAB 2017) (“Board decisions which are not designated as precedent are not binding on the Board, but may be cited and considered for whatever persuasive value they may hold”) (citations omitted). In comparing the records to this one, Applicant’s broad characterizations of the evidence in those cases omits significant findings, for example that in *In re DLMW-BBQ, LLC*, the “two website printouts” Applicant refers to were deemed “ambiguous” as to whether the goods were sold separately. The evidence in this case is not ambiguous.

Also under this *du Pont* factor, Applicant argues that the coexistence of other similar or identical marks²³ for frozen pizza and restaurant services shows that such goods and services should be considered unrelated. Applicant provides five examples of such alleged coexistence situations among registered marks, such as CALIFORNIA CHUTNEY TANDOORI KITCHEN for restaurant services and CALIFORNIA PIZZA

KITCHEN for frozen pizza, and  for frozen pizza and  (stylized with design) for restaurant services.²⁴ Applicant cites to no authority for its position that this evidence supports the coexistence of its mark with those in the registrations cited against it. “It has been said many times that each case must be decided on its own facts.” *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010) (internal citation omitted). Our record does not include the records in those cases. Applicant’s proffered coexistence situations have little probative value in our determination whether Applicant’s mark is confusingly similar to Registrant’s marks. “[T]he PTO’s allowance of such prior registrations does not bind the Board.” *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Based on the record as a whole, we find the frozen pizza not sold or distributed through restaurants in the application and the restaurant services in the cited registrations related. The evidence as to pizzerias and frozen pizza shows that “the

²³ We note that the chart in Applicant’s Brief presents only the literal elements of the marks without showing the actual marks, some of which contain either stylization or design elements that may further distinguish them.

²⁴ 4 TTABVUE 19-54 (January 9, 2017 Request for Reconsideration).

circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012).

B. Trade Channels and Classes of Consumers

This *du Pont* factor must be assessed according to the identifications of the respective goods and services in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs.*, 101 USPQ2d at 1722; *Octocom*, 16 USPQ2d at 1787. We must assume that the identified goods and services move through all normal and usual channels of trade and methods of distribution for such goods and services. *In re i.am.symbolic llc*, 866 USPQ2d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983).

While the channels of trade for frozen pizza that is not sold or distributed through restaurants differ from the channels of trade for restaurant services, the marketplace evidence set out above reflects that such goods and services are promoted together, often through the same websites, and the goods and services reach the same classes of consumers. Indeed, the evidence of record indicates that pizza restaurants sell frozen pizzas at other retail locations, such as grocery and big box stores, separate from the restaurant locations.

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

Applicant asserts under the sixth *du Pont* factor that the shared term URBAN in the marks “is weak and diluted for the parties’ respective goods and services.”²⁵ In support thereof, Applicant points in its brief to twelve use-based third-party registrations of marks that contain the word URBAN along with other matter for, *inter alia*, restaurant, bar, or brewpub services. The marks are: URBAN PIZZA, URBAN PUTT, URBAN FONDUE, URBAN SPICE, URBAN GROWLER (in standard characters and with a design), URBAN TACO, URBAN SEOUL, URBAN OLIVE, URBAN FIRE and design, and URBAN BUTCHER (in standard characters and with a design).²⁶ In addition, Applicant also relies on other third-party registrations for food products other than frozen pizza, arguing that because they coexist with the cited registrations, Applicant’s mark also should be allowed to register.²⁷

The Federal Circuit has held that evidence of the extensive registration and use of a term by others in the same industry can be powerful evidence of the term’s weakness. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). Use evidence may reflect commercial weakness, while third-party registration

²⁵ 18 TTABVUE at 9 (Applicant’s Brief).

²⁶ *Id.* at 13-14.

²⁷ *Id.* at 14-15; *see also* TSDR June 10, 2016 Response to Office Action at 29-79 (also includes registrations for bar and restaurant services).

evidence that does not equate to proof of third-party use may bear on conceptual weakness if a term is commonly registered for similar goods or services. *See Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976) (even if “there is no evidence of actual use” of third-party registrations, such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”).

As an initial matter, Applicant did not provide any third-party evidence of *actual use* of the same or similar marks. Turning to the third-party registration evidence, as to the proffered third-party registrations for food items other than frozen pizza, such as honey, cheese spreads, baking spices, and soybeans, Applicant submitted no evidence of their relatedness to the goods and services at issue here. Under the *du Pont* factor of relatedness of the goods and services, when the Examining Attorney relied on third-party registrations that cover both restaurant services and other types of food items, Applicant criticized those registrations that “do not include Applicant’s Goods,” arguing, “These registrations are insufficient to show that Applicant’s Goods and the Cited Registration Services are likely to emanate from a single source.”²⁸ As we disregarded registrations for other food items in that context, *see* fn. 20, *supra*, we similarly find them unpersuasive here to show weakness in relation to restaurant services and frozen pizza. *Cf. i.am.symbolic*, 123 USPQ2d at 1751 (disregarding third-party registrations for goods where the proffering party “has neither introduced evidence, nor provided adequate explanation to support a determination that the

²⁸ 18 TTABVUE 20 (Applicant’s Brief).

existence of I AM marks for goods in other classes, ... support a finding that registrants' marks are weak with respect to the goods identified in their registrations”).

The remaining third-party registrations for marks that contain URBAN along with other matter for restaurant and brewpub services reflect some degree of conceptual weakness of URBAN in this context. However, we do not consider the record analogous to that in *Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030 (TTAB 2016), an *inter partes* case cited by Applicant where this *du Pont* factor carried great weight. In that case, in addition to the eight third-party registrations, the record included more than 85 actual uses of ROSE-formative marks for similar services, as well as expert testimony and other evidence regarding the common nature of ROSE-formative marks in the industry. *Id.* at 1034-35. Here, we have no such actual use evidence of record. Also, in this case, none of the third-party registrations contain URBAN PIE or URBAN PI. Thus, while the evidence may suggest that consumers can distinguish among marks that contain URBAN along with other matter, the record does not support such a finding as to marks containing the term URBAN PI(E) as a whole.

D. Similarity of the Marks

Next, we turn to the *du Pont* factor comparing the applied-for and cited marks, which we consider “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du*

Pont, 177 USPQ at 567). The test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods and services offered under the respective marks is likely to result. *Coach Servs.*, 101 USPQ2d at 1721; *see also Edom Labs., Inc. v. Glenn Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

Comparing  to the registered marks 

and  creative pizza , we find the marks to be very similar. The marks all contain the identical first word, URBAN. The second word in Applicant's mark, PIE, differs by one letter and is phonetically identical to the second word in the cited marks, PI. In all three marks, as explained below, these words dominate over any other wording and design elements.

In Applicant's mark, URBAN PIE appears in much larger font than PIZZA CO, while the stylization and design elements are quite minimal. Also, PIZZA is generic for the goods and "CO." is an abbreviation for "company,"²⁹ an entity designation. Applicant complied with the Examining Attorney's requirement for a disclaimer of PIE PIZZA CO. as describing Applicant's goods and entity type,³⁰ also an implicit acknowledgment, with which we agree, that URBAN PIE PIZZA CO. is not a unitary

²⁹ TSDR March 29, 2016 Office Action at 62 (acronymfinder.com).

³⁰ TSDR June 10, 2016 Response to Office Action at 1; March 29, 2016 Office Action at 1.

term with a distinct meaning derived from the combination of words. *See Trademark Manual of Examining Procedure* § 1213.05 (Oct. 2017) (“If the matter that comprises the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic, or otherwise, is required.”). Thus, with Applicant’s mark, consumers would be more likely to perceive as the stronger source-indicating feature of the mark a more distinctive term like URBAN, rather than the descriptive or generic wording, or common entity designation. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming TTAB’s finding that the dominant portion of the mark THE DELTA CAFE was DELTA, not the disclaimed generic term CAFE); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (finding that the dominant portion of the mark BINION’S ROADHOUSE was BINION’S, not the disclaimed descriptive wording ROADHOUSE). That URBAN is the first word in the mark also contributes to its dominance. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (noting that the first word of a mark is “most likely to be impressed upon the mind of a purchaser and remembered”).

In the first cited mark above, URBAN PI is the only wording, and the pizza peel and circle, which gives the impression of a pizza pan or a pizza on the peel, serve as background designs for the more significant wording. The small flame design that dots the “T” merely reinforces the pizza theme of the designs, connoting the heat of the oven used to bake the pizza. We see no reason to depart here from the typical rule that when a mark comprises both wording and a design, greater weight is given to

the wording. See *In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010). In the second cited mark above, in addition to the wording and design elements just discussed, the additional wording CREATIVE PIZZA appears in smaller font, and describes the type of food available at the restaurant.

We find that in all three marks, URBAN would be understood as modifying PIE or PI, and the phrase URBAN PIE/URBAN PI dominates. See *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985) (“in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety”); see also *Stone Lion Capital* 110 USPQ2d at 1161. For the reasons explained above, regardless of any conceptual weakness of URBAN based on its suggestiveness for restaurant services, it still stands out in the marks. As to the meaning of URBAN PIE, we find that it gives the impression of pizza that is from or characteristic of the city. “Urban” is defined as “of, relating to, [or] characteristic of... a city.”³¹ The record includes numerous references to “pizza pie,” such as an entry in *The Free Dictionary*,³² a business named “the Pizza Pie Guys,”³³ a business named

³¹ We take judicial notice of the *Merriam-Webster* dictionary entry for “urban,” accessed December 19, 2017 at merriam-webster.com. See *Univ. of Norte Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

³² TSDR March 29, 2016 Office Action at 54 (thefreedictionary.com).

³³ *Id.* at 56 (thepizzapieguys.com).

“Sky’s ... Traditional NY Style PIZZA PIE,”³⁴ a business called “Joey’s Pizza Pie,”³⁵ a business named “Wiseguy Pizza Pie,”³⁶ another named “Sweet Basil’s Pizza Pie Food to Go,”³⁷ and a “pizza school” offering a “DIY Pizza Pie” app to help users “master making the perfect pie.”³⁸ Applicant’s submitted dictionary entry for “pie” also includes “pizza” as one of the definitions.³⁹ Thus, in the context of pizza-related goods and services, “pie” would be understood as “pizza pie.”

Applicant expresses doubt, however, that PI in the cited marks carries the same connotation as PIE. According to Applicant’s assessment of the cited marks, because PI is a Greek letter and numerical value, it constitutes “a play on words that creates a distinct meaning and commercial impression,” and is “easily distinguishable from Applicant’s use of ‘PIE.’”⁴⁰ We find that PI looks very similar to PIE, and sounds identical, given that the one-letter variation between the words is a silent E at the end of PIE. Also, PI in the registered marks appears on a pizza-related design, literally on a circular design of a pizza or pizza pan sitting atop a pizza peel. And with one of the registered marks, the word PIZZA also appears in the mark. Thus, whether consumers view PI merely as a misspelling of PIE, or whether they recognize a reference to the Greek letter or math term, the context in which it appears in the

³⁴ *Id.* at 57 (skyspizzapie.com).

³⁵ *Id.* at 58 (joeyspizzapie.com).

³⁶ *Id.* at 59 (wiseguypizzapie.com).

³⁷ *Id.* at 60 (sbpizzapie.com).

³⁸ *Id.* at 61 (pizzaschool.com).

³⁹ TSDR June 10, 2016 Response to Office Action at 17 (dictionary.com).

⁴⁰ 18 TTABVUE 17 (Applicant’s Brief).

marks and its use for pizza restaurants unmistakably gives it the primary connotation of “pizza pie.” Thus, we disagree with Applicant’s contention that this significantly changes the commercial impression of the marks so as to preclude confusion.

Overall, we find that because of the very similar dominant wording shared by the marks, and because the other wording and design elements have much less significance visually and in the commercial impression of the marks, Applicant’s mark and the cited marks have a similar look, sound, meaning, and commercial impression.

E. Conclusion

The overall similarity of the marks for related goods and services that move in channels of trade reaching the same classes of customers renders confusion likely. Applicant’s evidence of the conceptual weakness of URBAN is insufficient to overcome these similarities.

Decision: The refusal to register Applicant’s mark is affirmed.