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

Proceeding	87055289
Applicant	Brats Berlin, Inc.
Applied for Mark	CREPES BONAPARTE
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Serial No. 87/055,289  
Mark: CREPES BONAPARTE  
Applicant: Brats Berlin, Inc.  
Examining Attorney: Samuel R. Paquin  
Law Office 101

**APPLICANT'S *EX PARTE* APPEAL BRIEF**

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COMES NOW Applicant, Brats Berlin, Inc., by Counsel, and hereby respectfully appeals the Examining Attorney's refusal to register Applicant's standard character CREPES BONAPARTE mark in Application Serial No. 87/055,289 ("the Application") pursuant to Trademark Act § 2(d), 15 U.S.C. § 1052(d). The Examining Attorney refused registration of Applicant's mark on the grounds that Applicant's CREPES BONAPARTE mark, applied for use in connection with "food truck services; mobile catering services" is confusingly similar to U.S. Reg. No. 4,670,082, , registered in connection with "restaurant services." The Examining Attorney's refusal was inappropriate because the marks use terms and naming conventions that are familiar to consumers to convey different commercial impressions.

### **PROSECUTION HISTORY**

Applicant filed this use-based Application on June 3, 2016, seeking registration on the Principal Register for the mark CREPES BONAPARTE in standard characters in connection with "food truck services; mobile catering services" in Class 43.

On September 13, 2016, the Examining Attorney issued a Non-Final Office Action refusing registration pursuant to Trademark Act Section 2(d) on the ground that Applicant's mark is confusingly similar to Reg. No. 4,670,082, CAFÉ BONAPARTE. The Examining Attorney also required Applicant enter a disclaimer of the term CREPES.

Applicant filed a response (the "Office Action Response") on October 11, 2016, in which Applicant offered arguments and evidence against the refusal and complied with the Examining Attorney's disclaimer requirement.

On November 1, 2016, the Examining Attorney issued a Final Office Action regarding the refusal under Trademark Act Section 2(d).

Applicant filed a Notice of Appeal with the Board on March 7, 2017. See Docket Doc. 1. Applicant concurrently filed a request for reconsideration. The appeal was acknowledged and instituted the same day, and immediately remanded to the Examining Attorney for reconsideration based on the additional arguments and evidence in Applicant's request for reconsideration. See Docket Docs. 2 & 3.

Applicant's request for reconsideration was denied on March 15, 2017. See Docket Doc. 5. The Board then resumed proceedings on March 22, 2017. See Docket Doc. 6.

## **SUMMARY OF EVIDENCE**

### *A. Evidence Offered by Examining Attorney*

#### **1. Office Action of September 13, 2016**

- Reg. No. 4,670,082
- CREPES BONAPARTE, <http://www.crepesbonaparte.com>
- "Crepe," OXFORD DICTIONARIES, <http://www.oxforddictionaries.com>
- PEACHED TORTILLA, <http://www.thepeachedtortilla.com>
- SLIDIN' DIRTY, <http://slidindirty.com>
- BORDER GRILL, <http://bordergrill.com>
- KOMODO, <http://komodofood.com>
- CURRY UP NOW, <http://www.curryupnow.com>
- SEIS KITCHEN AND CATERING, <http://seiskitchen.com>

- CHI'LANTRO CATERING, <http://chilantrobbq.com>

## **2. Final Office Action of November 1, 2016**

- COMIDA, <http://www.eatcomida.com>
- J. RENDER'S SOUTHERN TABLE & BAR, <http://www.jrendersbbq.com>
- GUAPO'S, <http://www.guapos.com>
- MARCELLO'S, <http://www.marcellos.com>
- PENNYPACKER'S, <http://pennypackersfinefoods.com>
- ANDIAMO, <http://andiamoitalia.com>
- ASADA, <http://www.asadarestaurant.com>
- BARRIO TACOS, <http://barrio-tacos.com>
- LIME, <http://www.thelimetruck.com>
- STACKS & YOLKS, <http://www.stacksandyolkslv.com>

## **3. Reconsideration Refusal Letter of March 15, 2017**

- Printouts of Reg. Nos. 4432340, 4685912, 4774262, 4881487, 4904619, 5106074, 5016156, 5030243, 5103439, 5040855, 5102258, 5054738, 5054739, and 5144918

### *B. Evidence Offered by Applicant*

#### **1. Office Action Response of October 11, 2016**

- Exhibit A: CAFÉ BONAPARTE HERMOSA BEACH, <http://www.cafebonapartehb.com/> (last visited Oct. 11, 2016).
- Exhibit B: KAFE LEOPOLD, <http://www.kafeleopolds.com/> (last visited Oct. 3, 2016).

- Exhibit C: Heide Dieste, “Leopold I,” ENCYCLOPEDIA BRITANNICA, <https://www.britannica.com/biography/Leopold-I-Holy-Roman-emperor> (last visited Oct. 3, 2016).
- Exhibit D: CAFÉ MOZART, <http://www.cafemozartdc.com/> (last visited Oct. 3, 2016).
- Exhibit E: CAFÉ MOZART, <http://cafemozart.net/> (last visited Oct. 11, 2016).
- Exhibit F: “List of foods named after people,” WIKIPEDIA, [https://en.wikipedia.org/wiki/List\\_of\\_foods\\_named\\_after\\_people](https://en.wikipedia.org/wiki/List_of_foods_named_after_people) (last visited Oct. 4, 2016).
- Exhibit G: Selection from US Census Bureau Frequent Surnames Data, available at [http://www.census.gov/topics/population/genealogy/data/2000\\_surnames.html](http://www.census.gov/topics/population/genealogy/data/2000_surnames.html) (last visited Oct. 11, 2016).
- Exhibit H: BONAPARTE’S RETREAT, <http://showcase.netins.net/web/bonaparte/Retreat/> (last visited Oct. 4, 2016).
- Exhibit I: BONAPARTE BREADS, <http://www.bonapartebread.com/> (last visited Oct. 4, 2016).
- Exhibit J: Chris Bibey, “Food Trucks, Street Vendors Move Up in Business [Update],” PAYROLL BLOG, <https://www.surepayroll.com/resources/blog/food-trucks-street-vendors-move-up-in-business> (last visited Oct. 6, 2016).
- Exhibit K: TESS Printout (Oct. 6, 2016).


## **2. Request for Reconsideration (RFR) of March 7, 2017**

- Exhibit A: Printouts of Reg. Nos. 4413779, 4993446, 4795086, 4375228, 4194818, 4711731, 4613185, 4286172, 3725094, 5015968, 3258450, 4541373, 2779433, 4328067, 3272467, 4474314, 4864018, 4954960, 3543380, 3921572, 5107889, 5136528, 3924046, 4241520, 3087204, 2111429, 1238903, 2790579, 2740963, 2892141, 4035146, 4352447, 3971607, 2621586, 2920381, 3898846, 3015553, 4611166, 4043547, 4583909, 4291722, 4455205, 4296766, 4854782, 4585143, 3258492, 3603082, 4647922, 0870229, 5052354, 3054192, 4859514, 3484195, 2904652, 4387627, 3522086, 4866678, 3522278, 3904917, 5138679, 4936207, 4754841, 2132516, 5021144, 4205472, 3258646, 5019512, 4152890, 3727821, 3325750, 3180155, 2892598, 3575807, 3413943, 4379099, 3266540, and 3092719



## ARGUMENT

The Examining Attorney has refused registration of Applicant's CREPES BONAPARTE mark for "food truck services; mobile catering services" in Class 43, pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the basis of a likelihood of confusion with Reg. No. 4,670,082, B CAFÉ BONAPARTE & design, registered for "restaurant services" in Class 43.

Serial No. 87/055,289	Reg. No. 4,670,082
CREPES BONAPARTE	
<i>Class 43: Food truck services; mobile catering services</i>	<i>Class 43: Restaurant services</i>

Applicant respectfully disagrees with the Examining Attorney's refusal. While both Applicant's mark and the cited mark use the familiar and well-known name BONAPARTE, the marks each use the name as part of recognizable naming conventions that result in very different commercial impressions. Furthermore, restaurants routinely coexist in the real world and on the Register with similar, but not identical, names. Given the differences in the marks, the familiar names and naming conventions, and the differences in the services, consumers are not likely to be confused when encountering these marks. Accordingly, the statutory refusal should be reversed and Applicant's mark should proceed to publication.

## I. The Name BONAPARTE is Not a Strong Indicator of Source

Applicant's mark and the cited mark share the name BONAPARTE. But BONAPARTE is not a strong indicator of source: it is a common and famous name, and there are numerous third parties that use the name in connection with restaurant services. The Examining Attorney gave no weight to Applicant's evidence of third party users and dismissed Applicant's argument concerning BONAPARTE's name significance as "not relevant." Final Office Action of Nov. 1, 2016. The strength and meaning of a mark are highly relevant to the scope of protection afforded to a mark and the consumer impression the mark conveys. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

Applicant does not mean to argue that either its mark or the cited mark have primarily surname significance. Marks that have primarily surname significance do not function as indicators of source (absent a showing of acquired distinctiveness), 15 U.S.C. § 1052(e)(4), but names that identify a historical place or person are considered to fall outside the scope of Section 2(e)(4). TMEP § 1211.01(a)(iv); *In re Pyro-Spectaculars, Inc.*, 63 USPQ2d 2022, 2024 (TTAB 2002). Rather, Applicant argues that surnames, regardless of what they refer to, are weak indicators of source and that the cited mark is entitled to only a limited scope of trademark protection because it consists primarily of a surname. See, e.g., *Luigi Lavazza S.p.A. v. Favazza's, Inc.*, Opposition No. 91210050 (TTAB Feb. 16, 2016) [not precedential] ("...surnames per se, because

of their proliferation of use, are generally considered to fall within the designation of “weak” marks...).


Even with its historical significance, consumers would recognize the name BONAPARTE as a surname. The name BONAPARTE’s historical significance comes from Napoleon Bonaparte, the famed French emperor and general (known, incidentally, primarily by his *given* name rather than his surname), and his descendants, some of whom were also historically significant such as Louis-Napoleon Bonaparte (Emperor Napoleon III). BONAPARTE is also a surname belonging to more than 2,000 Americans. See Office Action of Oct. 11, 2016, Exhibit G. Consumers would recognize the term BONAPARTE as a surname rather than a distinct source-identifier, even if they would not give the mark primarily surname significance.

The source identifying capacity of BONAPARTE is further diminished by usage of the name for related services owned and operated by third parties. Applicant submitted evidence of three additional businesses using the name BONAPARTE in connection with restaurants and bakeries, including a second restaurant with the identical name CAFÉ BONAPARTE, as well as the restaurant BONAPARTE’S RETREAT and the bakery BONAPARTE BREADS. See Office Action of Oct. 11, 2016, Exhibits A, H, and I. The Examining Attorney did not address this evidence or Applicant’s argument in the Final Office Action.

While Applicant acknowledges that this third party use is relatively limited, alongside the surname significance of the mark and in the context of the crowded field of food service marks, the usage indicates that the name BONAPARTE has only a limited source identifying significance, and that therefore consumers are able to

“distinguish between different marks on the basis of minute distinctions.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Palm Bay Imports*, 73 USPQ2d at 1691; *Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, Opposition No. 91217095 (TTAB Dec. 27, 2016) [precedential]. The Examining Attorney erred by failing to consider Applicant’s evidence and giving no weight to the relative weakness of the name BONAPARTE and the cited CAFÉ BONAPARTE mark. *See Benjamin J. Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020 (TTAB 2009) (recognizing that weak terms may be entitled to a narrower scope of protection than stronger terms).

## II. The Marks Use Familiar Naming Conventions to Convey Different Consumer Impressions

Applicant’s CREPES BONAPARTE mark and the cited  mark use the shared name BONAPARTE in different manners and contexts, resulting in different sounds, appearances, meanings, and overall impressions. When considered in their entireties, the marks have very different meanings and convey different impressions, and are thus not likely to be confused.

In refusing registration of Applicant’s mark, the Examining Attorney focused narrowly on the fact that the marks share the term BONAPARTE and did not respond to Applicant’s arguments about the different commercial impressions the marks convey.

Even marks containing similar elements are not likely to be confused if the commercial impressions conveyed by the marks are different. See *In re Hearst Corporation*, 982 F.2d 493 (Fed. Cir. 1992) (finding no likelihood of confusion between VARGA GIRL and VARGAS for identical goods); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 1108, 174 USPQ 392, 393 (CCPA 1972) (finding no likelihood of confusion between the applied-for mark “ALL CLEAR!” and the prior mark ALL, both for household cleaning products); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 1401, 172 USPQ 176 (CCPA 1970) (finding no likelihood of confusion between the applied-for mark PEAK PERIOD for deodorant and the prior mark PEAK for dentifrice).

By focusing on the shared term BONAPARTE, the Examining Attorney has ignored the significance of the additional terms and elements of each mark. Although both CAFÉ and CREPES are disclaimed, even material that is descriptive, disclaimed, or non-dominant cannot be excluded in the analysis. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); see *In re Denver Beer Company, LLC*, Serial No. 86/515,920 (November 23, 2016) [not precedential] (finding PRINCESS YUM YUM RASPBERRY ALE not confusingly similar to YUM YUM, both for beer). Here, the disclaimed material in Applicant's mark is not merely an addition to the shared name BONAPARTE. Instead, the disclaimed material substitutes different terms with a different meanings and that complete whole phrases. Thus, the disclaimed material still has a strong impact on the meaning and connotation of each mark and distinguishes the commercial impressions conveyed by each mark.

Both Applicant's CREPES BONAPARTE mark and the cited



mark

rely on widely recognized naming conventions within the food and hospitality industry. The cited mark relies on a widely used [TERM FOR RESTAURANT] + [NAME] convention. For example, Applicant submitted evidence of restaurants with names such as KAFE LEOPOLD, numerous CAFÉ MOZARTs, and a second CAFÉ BONAPARTE, demonstrating not only this naming convention, but the coexistence of these restaurants in the market. See Office Action of Oct. 11, 2016, Exhibits A, B, D, and E. Applicant's mark, on the other hand, uses a naming convention common in naming a specific food item, the [FOOD ITEM] + [NAME] convention commonly used in naming particular styles of food preparation. Applicant submitted a list of such dishes, including examples such as "eggs benedict," said to be named after either banker Lemuel Benedict or Commodore E.C. Benedict; "fettucine alfredo," named for chef Alfredo Di Lelio; "bananas foster," named after Richard Foster; "pizza margherita," named for Queen Margherita of Savoy; "peach melba," named for singer Dame Nellie Melba; "beef wellington," named for Arthur Wellesley, 1st Duke of Wellington; and "chicken (or turkey) tetrazzini," named for Italian opera star Luisa Tetrazzini.<sup>1</sup> See Office Action of Oct. 11, 2016, Exhibit F.

Because of these familiar naming conventions, consumers are likely to perceive each mark in their entirety as a unitary whole, rather than focusing on one particular

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<sup>1</sup> That same list, in fact, contains several food items named after Napoleon Bonaparte, including one using the name BONAPARTE, "Bonaparte's ribs," although the item uses a different naming structure and is not well known. The name MOZART, for which Applicant submitted evidence of restaurants named CAFÉ MOZART, also appears on the list with two food items: "Galantine of pullet à la Mozart" and "Mozartkugels."

term or another. Consumers encountering Applicant's mark and the cited mark are likely to react differently to each mark and the commercial impressions that the marks convey. This is compounded by the weakness of the name BONAPARTE as a source identifier. Consumers are likely to recognize the source-identifying significance of the *entire* marks without assuming that the term BONAPARTE alone identifies a particular source.

Because the marks convey very different commercial impressions, it is not likely that consumers would confuse the marks, and there is no likelihood of confusion.

### **III. Restaurant Names Routinely Coexist on the Register With Only Minor Differences**

The restaurant industry is fast moving and crowded, with a myriad of businesses and trademarks. Restaurants commonly coexist with very similar or even identical names, and consumers are conditioned to distinguish between restaurants and other food service businesses based on subtle differences in the names and other factors. Here, the regular coexistence of similar marks in the same field underscores the differences in the commercial impressions conveyed by each mark.

Applicant submitted evidence of third party usage and registrations of numerous restaurants and other food service businesses sharing similar or identical common elements.<sup>2</sup> The evidence of third party use in the market is indicative of both the crowded nature of the restaurant industry and the way that consumers interact with restaurants and food service businesses. The third party trademark registrations are

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<sup>2</sup> Applicant notes that searching for coexisting businesses with similar names, both in the real world using a search engine and on the Register using TESS, is fraught with challenges. Applicant is confident that there are many, many more restaurants that coexist with similar names than reflected in the record.

further indicative of the crowded nature of the field, and also of the USPTO's routine acceptance of trademarks containing similar or identical elements.

Applicant's evidence indicates that there are several restaurants around the country that use the term BONAPARTE in their name, including at least one other CAFÉ BONAPARTE not owned by Registrant, as well as a restaurant named BONAPARTE'S RETREAT and a bakery named BONAPARTE BREADS. See Office Action Response of Oct. 11, 2016, Exhibits A, H, and I. The evidence also shows two restaurants coexisting with the identical name CAFÉ MOZART, Exhibits D and E, and a third using the name MOZART CAFE. See Request for Reconsideration, Exhibit A. The coexistence of these restaurants reflects the limited source-identifying capacity of famous names such as Bonaparte or Mozart for restaurants, as discussed above. The coexistence also reflects the crowded field of restaurants and food businesses, such that even restaurants with *identical* names coexist in the marketplace. Even putting aside the existence of businesses with identical names, the evidence reflects that at least three other food service businesses use the name BONAPARTE in combination with other (often descriptive or generic) terms—CAFÉ BONAPARTE, BONAPARTE BREADS, and BONAPARTE'S RETREAT. BONAPARTE BREADS is located within the Washington metropolitan area, approximately 20 miles from Registrant, and sells goods at DC area farmer's markets.

Applicant also submitted many third party trademark registrations showing the coexistence of marks that contain identical terms in combination with descriptive or generic wording. Sufficient evidence of third-party use and registrations of similar marks and is "powerful on its face." *Juice Generation, Inc.*, 794 F.3d 1334. Such evidence can






“show that customers . . . have been educated to distinguish between different . . . marks on the basis of minute distinctions.” *Id.* (quoting 2 McCarthy on Trademarks and Unfair Competition § 11:88 (4th ed. 2015) (internal quotations omitted)). The evidence shows “the sense in which the mark is use in ordinary parlance”—that is, showing that the marks have a “normally understood and well-recognized descriptive or suggestive meaning.” *Id.* See also *Jack Wolfskin*, 797 F.3d 1363. In these cases, more weight must be accorded to the differences between the goods and services and any unshared elements of the marks, such as unshared terms, meanings, and connotations. See *Continental Grain Co. v. Central Soya Co.*, 69 F.3d 555 (Fed. Cir. 1995) (holding that “where the mark is a composite of a weak common part and a modifying phrase . . . the common portion of the composite mark is to be given less weight on the rationale that the public will look to other portions of the mark and will not be confused unless the other portions are similar”).

Applicant’s evidence shows more than 25 groups of marks registered by different owners in connection with restaurant, café, bar, or other food service businesses. Many of these groupings are based around names. The registrations are only a sample of such coexisting trademarks, and are indicative of the crowded field of restaurants (and restaurants that use names as dominant elements). This evidence “reflects a determination by the USPTO that various [marks] can be used and registered side-by-side without causing confusion, provided there are minimal differences between the marks and the goods or services.” *In re FiftyThree, Inc.*, Serial No. 86180291 (TTAB Apr. 12, 2017) [not precedential] (finding no likelihood of confusion based in part on

three third-party usages and nine third-party, used-based registrations marks containing the common term PAPER for digital goods).

Coexisting Marks for Food Service in Class 43			
	4413779	<b>Mozart Pasteten</b>	4296766
<b>IRIS CAFE</b>	4993446	<b>RESTAURANT IRIS</b>	4854782
JOHNNY'S BAR & GRILL	4795086	<b>JOHNNY'S</b>	4585143
Johnny's Sliders	4375228		3258492
<b>JOHNNY'S YOGURT</b>	4194818	JOHNNY'S LUNCH	3603082
Johnny's Italian Steakhouse	4711731		
<b>MICHAEL'S PIZZERIA</b>	4613185		4647922
	4286172		0870229
<b>MICHAEL'S GENUINE FOOD &amp; DRINK</b>	3725094	<b>MICHAEL'S DAIRY</b>	5052354
	5015968		

MAUI MIKE'S	3258450	ORIGINAL MIKE'S	3054192
	4541373	MIKE'S SEAFOOD	4859514
JERRY'S RESTAURANT	2779433		3484195
JERRY'S SNOW CONES	4328067		2904652
	3272467		
FRANKIE'S PIZZA	4474314		4387627
FRANKEY'S	4864018	FRANKIE'S SCALOPPINE	3522086
ANTIQUE TACO	4954960	ANTIQUE CAFE	4866678
MESA FRESH	3543380	MESA VERDE	3522278
Black Mesa	3921572	MESA LLENA	3904917
Mesa Grande Taqueria	5107889		5138679

RED MESA GRILL	5136528		
<b>PARIS CREPE CAFÉ</b> <b>PARIS CREPES</b>	3924046 4241520	<b>CREPES DE PARIS</b>	4936207
	3087204		
	2111429		4754841
<b>EL FENIX</b>	1238903	<b>THE PHOENIX</b>	2132516
	2790579		
<b>SAL'S</b>	2740963	<b>SAL'S MEXICAN RESTAURANT</b>	5021144
<b>MAYA</b>	2892141		4205472
<b>ROSA'S CAFE</b>	4035146		3258646
	4352447		5019512

<b>SANDY'S BEACH GRILL</b>	3971607	<b>PALM BEACH GRILL</b>	4152890
<b>NORTH BEACH RESTAURANT</b>	2621586	<b>NORTH BEACH PIZZA</b>	3727821
<b>HILL COUNTRY BAKERY</b>	2920381	<b>HILL COUNTRY</b>	3325750
<b>BERRYHILL</b>	3898846		3180155
<b>TROPICAL GRILL &amp; JUICES</b>	3015553	<b>TROPICAL SMOOTHIE CAFÉ</b>	2892598
<b>GARDEN BAR</b>	4611166	<b>GARDEN CATERING</b>	3575807
<b>THE TOMATO BISTRO</b>	4043547	<b>TOMATO CAFE</b>	3413943
<b>RUSTIC TAVERN</b>	4583909	<b>RUSTIC INN</b>	4379099
<b>CAFE RUSTICA</b>	4291722	<b>PIZZA RUSTICA</b>	3266540
<b>CACTUS RESTAURANTS</b>	4455205	<b>CACTUS GRILL</b>	3092719

The marks above all share identical elements with other distinguishing wording; in many cases, the distinguishing element is a merely descriptive or generic term. In some cases, the distinguishing element is a food item. In some cases, the marks are distinguished by minimal design elements. The evidence here reflects the same determination to be made in this matter: that Applicant's mark is distinguishable from

the cited mark by the unshared word and design elements of the marks and therefore not likely to cause confusion.

The unique nature of the restaurant industry and the crowded field of name trademarks, as well as the USPTO's frequent determination that restaurant names can coexist on the register with minimal differences, all weigh against a refusal to register Applicant's mark on the basis of a likelihood of confusion. This is particularly true in light of the limited source-identifying capacity of the term BONAPARTE and the substantial differences in commercial impressions conveyed by each mark. Accordingly, the Examining Attorney's refusal to register Applicant's CREPES BONAPARTE mark was inappropriate and should be reversed.

#### **IV. The Services Offered in Connection with Each Mark are Not Identical**

While Applicant acknowledges that both Applicant and registrant use their marks in connection with food service, the services offered in connection with each mark are not identical, and the marks can come closer in similarity without consumer confusion. Applicant submitted evidence that, out of more than 50,000 registrations on the Principal Register for restaurants, only 36 registrations identified both "restaurant" and "food truck" services—less than one tenth of one percent—several of which are redundant as to owner. See Office Action Response of Oct. 11, 2016, Exhibit K. The relationship between food trucks and restaurants is not so obvious that consumers would believe that food truck services and restaurant services originate from the same source without something more. See *In re St. Helena Hosp.*, 774 F.3d 747, 753 (Fed. Cir. 2014). The differences in these services is emphasized here by the marks themselves: the cited mark uses the term CAFÉ, which conveys the impression of an

actual place where consumers sit down to order food, while Applicant's services are mobile by nature and not offered in any particular place.

### **CONCLUSION**

Because the marks use such familiar names and naming conventions, consumers are likely to consider the marks in their unitary entirety, and will readily distinguish between Applicant's mark and the cited mark. When considering the marks as a whole, the consumer impressions conveyed are very different and there is no likelihood of confusion. Furthermore, the USPTO routinely determines that restaurant names can coexist on the register with minimal differences, and the particularly in the crowded field of name based restaurant marks. Accordingly, the statutory refusal is inappropriate and should be withdrawn.

WHEREFORE, Applicant respectfully requests that the Board REVERSE the statutory refusal pursuant to Trademark Act Section 2(d) and allow the Application to proceed to publication.

Dated this 9th day of May, 2017.

Respectfully submitted,



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