

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 Pizza Inn, Inc.

Serial No. 87173595

Rebecca Liebowitz of Venable LLP,
for Pizza Inn, Inc.

Steven W. Ferrell Jr., Trademark Examining Attorney, Law Office 121,
Kevin Mittler, Managing Attorney.

Before Bergsman, Hightower and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Pizza Inn, Inc. (“Applicant”) seeks registration on the Principal Register of the mark AMERICA’S HOMETOWN PIZZA PLACE (in standard characters, with “PIZZA PLACE” disclaimed) for “restaurant services; carry-out restaurant services,” in International Class 43.¹

¹ Application Serial No. 87173595 was filed on September 16, 2016, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. On June 16, 2017, during the course of prosecution, Applicant submitted an amendment alleging use of the mark anywhere and in commerce at least as early as November 26, 2016.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act on the ground that the mark, as used in connection with its recited services, so resembles the marks in three registrations, all issued to the same entity on the Principal Register, including the mark HOMETOWN PIZZA (in standard characters, with "PIZZA" disclaimed) for "restaurant services," in International Class 43, as to be likely to cause confusion or mistake, or to deceive.² 15 U.S.C. §§ 1052(d).

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

I. Likelihood of Confusion

We base our determination of likelihood of confusion under Section 2(d) 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) ("DuPont"), cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. __, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

Page references to the application record are to the .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board's TTABVUE docket system.

² Registration No. 3921688, issued on the Principal Register on February 22, 2011, Section 8 and 15 declarations accepted and acknowledged. The other two cited registrations are Registration No. 3921689 for HOMETOWN PIZZA & Design ("PIZZA" disclaimed) for "restaurant services" in International Class 43, issued on the Principal Register on February 22, 2011, Section 8 and 15 declarations accepted and acknowledged; and Registration No. 5072188 for HOMETOWN PIZZA stylized ("PIZZA" disclaimed) for "restaurant services" in International Class 43, issued on the Principal Register on November 1, 2016.

We have considered each relevant *DuPont* factor for which there is evidence or argument, and have treated the 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. 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.”). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (factors “may play more or less weighty roles in any particular determination”).

Two key considerations are the similarities between the marks and the similarities between the services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). We determine this appeal based on Applicant’s mark and identified services and the HOMETOWN PIZZA mark that is the subject of cited Registration No. 3921688. If likelihood of confusion is found as to the mark and services identified in that registration, it will be unnecessary to consider the other cited registrations. *See Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Relatedness of Services, Channels of Trade, and Classes of Customers

Under the second and third *DuPont* factors, we address “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or

registration...” and “[t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567. The respective services need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1207.01(a)(i) (Oct. 2017).

We make our determination under these factors based on the services as they are identified in the Application and cited Registration. See *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); see also *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). In this case, the broadly identified services in the cited registration, “restaurant services,” encompass Applicant’s more specifically identified “restaurant services; carry-out restaurant services.” Because the description of services in both the cited registration and the application include “restaurant service,” the services are identical in part and otherwise legally identical. See *In re Integrated Embedded*, 120 USPQ2d 1504, 1514 (TTAB 2016); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007) (petitioner’s

“restaurant services” encompass respondent’s “restaurant services featuring bagels as a main entrée”).

Because the restaurant services identified in the application and the cited registration are identical in part and otherwise legally identical, we must presume that the channels of trade (sit-down and carry-out restaurants) and classes of purchasers for these services (ordinary consumers) are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *Jansen Enterprises v. Rind*, 85 USPQ2d at 1108.

Applicant does not contest the similarity or relatedness of Applicant’s and Registrant’s services, channels of trade, and classes of customers. We find that the second and third *DuPont* factors weigh heavily in favor of finding a likelihood of confusion.

B. The Effect of Third-Party Registrations on the Degree of Strength or Weakness of the Registered Mark

The sixth *DuPont* factor requires us to consider the number and nature of similar marks in use on similar services. *DuPont*, 177 USPQ at 567; *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1033 (TTAB 2016). Applicant contends that the Registered Mark HOMETOWN PIZZA comprises such weak, commonly used elements that consumers will look to the other features in Applicant’s mark, AMERICA’S and PLACE, to differentiate the marks in appearance, sound, meaning and commercial impression. Specifically, Applicant maintains that

“HOMETOWN” is dilute and ‘PIZZA’ is generic.”³ To demonstrate the weakness of HOMETOWN, Applicant focuses on eight active, use-based third-party registrations and four applications for marks consisting of or containing that word, as used in connection with restaurant services. The registrations are as follows:

Mark/Name/AN/RN	Status/Disclaimer	Full Goods/Services	Owner/Designations
<u>HOMETOWN (Stylized)</u> HomeTown RN: 3339237 SN: 78442232	Registered 8 & 15 December 10, 2013	(Int'l Class: 43) restaurant services	Buffets, Inc. (MINNESOTA CORP.) 1020 Discovery Road, Suite 100 Eagan, Minnesota 55121 United States of America
<u>HOMETOWN BUFFET and Design</u>	Registered 8 & 15 May 10, 2013 Disclaimer: "BUFFET"	(Int'l Class: 43) restaurant services	Buffets, Inc. (MINNESOTA CORP.) 405 Lancaster Avenue Greer, South Carolina

HomeTown B U F F E T RN: 3311656 SN: 78442222			29650 United States of America
<u>HOMETOWN BEAN & CO.</u> RN: 5115694 SN: 86794621	Registered January 3, 2017 Disclaimer: "BEAN & CO."	(Int'l Class: 43) restaurant and catering services	Compass Group Usa, Inc. (DELAWARE CORP.) 2400 Yorkmont Road Charlotte, North Carolina 28217 United States of America
<u>THE ORIGINAL HOMETOWN TASTE</u> RN: 5036074 SN: 86889791	Registered September 6, 2016	(Int'l Class: 43) restaurant services; restaurant services featuring pizza, calzones, salads and sub sandwiches; restaurant services, including sit- down service of food and take-out restaurant services	Michael's Pizza, Inc. (TENNESSEE CORP.) 329 Seven Mile Ferry Road Cunningham, Tennessee 37052 United States of America

³ Id. p. 14, 4 TTABVUE 17.

<u>HONEY'S HOMETOWN HOTDOGS</u> RN: 4487890 SN: 86000172	Registered February 25, 2014 Disclaimer: "HOTDOGS"	(Int'l Class: 43) restaurant services	The Dorminy Group Inc. (ALABAMA CORP.) 3443 Murphy Mill Rd Dothan, Alabama 36303 United States of America
<u>THE OFFICIAL FOOD OF HOMETOWN SPORTS</u> RN: 4230002 SN: 85574035	Registered October 23, 2012	(Int'l Class: 43) bar services; restaurant and catering services	Glory Days, Inc. (VIRGINIA CORP.) 9426 Stewartown Road Gaithersburg, Maryland 20879 United States of America
<u>MAX & ERMA'S THE HOMETOWN</u>	Registered June 3, 2014	(Int'l Class: 43) restaurant services	M&E Brands, LLC (MONTANA LIMITED)

<u>FAVORITE</u> RN: 4542602 SN: 86062489			LIABILITY COMPANY 911 Wisconsin Avenue Suite 203 Whitefish, Montana 59937 United States of America
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Third parties' registration and use of similar marks can bear on the strength or weakness of a registrant's mark in two ways: commercially and conceptually.⁵

First, if a mark, or an element of a mark, is used extensively in commerce by a number of third parties, that could undermine its commercial strength, as the consuming public may have become familiar with a multiplicity of the same or similar marks, and can distinguish them based on minor differences. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). “Evidence of third-party use of similar marks on similar goods [or services] is relevant to show

⁴ Applicant's brief pp. 3-5, 4 TTABVUE 6-8; Trademark Electronic Search System (TESS) printouts in Sept. 27, 2017 Response to Office Action TSDR pp. 9-21. As for the third-party applications, “[a]n application is not evidence of anything except that the application was filed on a certain date....” *Wet Seal, Inc. v. FD Mgmt.*, 82 USPQ2d 1629, 1634 n. 11 (TTAB 2007). The applications are not evidence of use of the marks. *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007); *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1468 n.6 (TTAB 2003).

⁵ See Applicant's brief p. 3, 4 TTABVUE 6.

that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005), quoted in *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015), cert. denied, 136 S. Ct. 982 (2016). “The weaker [a registrant’s] mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Juice Generation*, 115 USPQ2d at 1674.

Second, if there is evidence that a mark, or an element of a mark, is commonly adopted by many different registrants, that may indicate that the common element has some significance that undermines its conceptual strength as an indicator of a single source. *Jack Wolfskin*, 116 USPQ2d at 1136 (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ ... that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak’”) (quoting *Juice Generation*, 115 USPQ2d at 1674 (quoting 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:90 (4th ed. 2015))).

In this case, with respect to commercial strength, Applicant admittedly has not submitted evidence of third-party usage apart from the third-party registrations and applications.⁶ Applicant argues that use-based third-party registrations should be

⁶ Id. pp. 4-5, 4 TTABVUE 7-8.

afforded probative value, as the registrations presumptively represent use in commerce under 15 U.S.C. § 1057(b).⁷ What is missing, though, is evidence beyond that of the extent of use or recognition in the marketplace: “existence of [third-party] registrations is not evidence of what happens in the market place or that customers are familiar with them....” *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) quoted in *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018). That differentiates this case from *inter partes* cases such as *Jack Wolfskin* and *Juice Generation*, in which evidence of commercial use was submitted. See *Jack Wolfskin*, 116 USPQ2d at 1136 (noting that third-party registrations were accompanied by evidence of the marks in use in Internet commerce: “Jack Wolfskin presented extensive evidence of third-party registrations depicting paw prints and evidence of these marks being used in internet commerce for clothing”); *Juice Generation*, 115 USPQ2d at 1674 (acknowledging testimony of applicant’s founder concerning third-party use of similar marks).

In an *ex parte* appeal such as this, the owner of the cited Registration is not a party, and the Examining Attorney is under no obligation to demonstrate the exposure or recognition of the cited mark in the marketplace. *In re Integrated Embedded*, 120 USPQ2d at 1512. For that reason, “[I]n an ex parte analysis of the *du Pont* factors for determining likelihood of confusion ..., the ‘fame of the mark’ [fifth] factor is normally treated as neutral when no evidence as to fame has been provided.” TMEP § 1207.01(d)(ix) (Oct. 2017). By the same token, where, as here, an applicant

⁷ Id. p. 6, 4 TTABVUE 9.

cites third-party registrations with no evidence of the extent of their market usage, there is insufficient evidence to diminish the presumptive strength of the cited registered mark under the sixth *DuPont* factor. Hence, its commercial strength must still be treated as neutral.

In terms of conceptual strength, even where the record lacks proof of actual third-party *use*, third-party registration evidence may show that a term carries a descriptive or highly suggestive connotation in the relevant industry and therefore may be considered conceptually weak. *Jack Wolfskin*, 116 USPQ2d at 1136; see *Institut National Des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992). “However, third-party registrations are relevant evidence of the inherent or conceptual strength of a mark or term because they are probative of how terms are used in connection with the goods or services identified in the registrations.” *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745-46 (TTAB 2016).

Applicant contends that the coexistence of the first registration cited in the above table, No. 3339237 for **HomeTown**, with other marks including the term HOMETOWN “is textbook crowded field,” demonstrating that the term is weak.⁸ Applicant insists that:

Reg. No. 3339237 was incorporated in its entirety in every other HOMETOWN formative restaurant registration, including the cited marks. By the Examiner’s logic, each of the above third-party registrations aside from Reg. No. 3339237 and the cited registrations should have been

⁸ Id. p. 8, 4 TTABVUE 11.

refused. The fact that they were not refused demonstrates that Examiner's argument is erroneous.⁹

* * *

Under the Examiner's reasoning, the third-party registrations and applications cited by Applicant should not have been allowed to co-exist. Yet, they have all been allowed to coexist. The coexistence of these marks is an indication that prior USPTO practice has been to allow multiple restaurant marks containing HOMETOWN when "HOMETOWN" is accompanied by additional unique wording.¹⁰

For these reasons, Applicant contends that the Examining Attorney's position is erroneous and inconsistent with prior USPTO practice.

As we have already noted, there is no rule that likelihood of confusion automatically applies where one mark encompasses another. The true issue here is whether Applicant's third-party evidence demonstrates that the cited registered mark, HOMETOWN PIZZA, is so weak conceptually that it may be distinguished by the additional wording AMERICA'S and PLACE. We find that it does not.

Of the eight third-party registrations Applicant cites, the first two, Registration

No. 3339237 for **HomeTown**, and No. 3311656 for **HomeTown**
BUFFET, have been cancelled. "An expired or cancelled registration is evidence of nothing but the fact that it once issued." *Anheuser-Busch, LLC v. Innovopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1819 n.4 (TTAB 2016) (citing *Sonnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987)). As for the remaining six third-party registrations, "[t]he

⁹ Id.

¹⁰ Id. p. 11, 4 TTABVUE 14.

third-party evidence here is far less in quantity and quality than that in *Juice Generation*, which included at least 26 uses or registrations of the same phrase for restaurant services, *Juice Generation*, 115 USPQ2d at 1673 n.1, or in *Jack Wolfskin* where there were at least fourteen, 116 USPQ2d at 1136 n.2.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1636 (TTAB 2018). And as for consistency in examination, “[w]hile we recognize that ‘consistency is highly desirable,’ … consistency in examination is not itself a substantive rule of trademark law, and a desire for consistency with the decisions of prior examining attorneys must yield to proper determinations under the Trademark Act and rules. … The Board must assess each mark on its own facts and record.” *In re Am. Furniture Warehouse CO*, 126 USPQ2d 1400, 1407 (TTAB 2018) (citing *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541, 1544 (Fed. Cir. 2007); *In re Cordua Rests.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016); and *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)).

On the whole, we note, none of the registered third-party marks uses both HOMETOWN and PIZZA; only two of the applications contain both terms; and none use the two terms together in the phrase HOMETOWN PIZZA, as the cited registration does. Even though PIZZA is disclaimed as generic for food served at Registrant’s restaurants, it still contributes to the overall commercial impression created by the cited mark. See *In re Inn at St. John’s*, 126 USPQ2d at 1748 (citing *Juice Generation*, 115 USPQ2d at 1676 (Board paid insufficient heed to the word JUICE in mark for juice bar services)). Although it is fair to consider the relative

strength of a mark’s component parts, we must ultimately consider marks in their entireties. As the Federal Circuit succinctly put it:

Finally, the Board may “state that, for rational reasons, more or less weight has been given to a particular feature of the mark.” *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1357 [56 USPQ2d 1351] (Fed. Cir. 2000). Even so, the touchstone of this factor is consideration of the marks in total. *Id.*; see also *Juice Generation, Inc. v. GS Enters. LLC*, ...[115 USPQ2d 1671] ... (explaining that this factor “merely requires heeding the common-sense fact that the message of a whole phrase may well not be adequately captured by a dissection and recombination”).

Jack Wolfskin, 116 USPQ2d at 1134.

Here, although HOMETOWN is used in some third-party registered marks, Applicant’s evidence does not demonstrate that the registered mark as a whole is weak and entitled only to a narrow scope of protection. Rather, we accord the HOMETOWN PIZZA mark the normal scope of protection to which suggestive marks are entitled. 15 U.S.C. § 1057(b); see *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (stating that likelihood of confusion fame varies along a spectrum from very strong to very weak). We add that even if we had found the scope of the cited registered mark to be somewhat narrowed based on Applicant’s evidence, it would not change the result, as even weak marks are entitled to protection against registration of similar marks for identical goods or services. *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401 182 USPQ 108, 109 (CCPA 1974); see also *In re i.am.symbolic*, 127 USPQ2d at 1636 n. 13.

Consequently, the sixth *DuPont* factor is neutral.

C. Similarity of the Marks

Under the first *DuPont* factor, we consider the similarity or dissimilarity of Applicant's and Registrant's marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567; *Stone Lion v. Lion Capital*, 110 USPQ2d at 1160; *Palm Bay Imps.*, 73 USPQ2d at 1692.

Applicant's mark, AMERICA'S HOMETOWN PIZZA PLACE, encompasses Registrant's word mark, HOMETOWN PIZZA, in its entirety, flanking it with the words AMERICA'S and PLACE. While there is no rule that likelihood of confusion automatically applies where one mark encompasses another, in this case, as in many others, the fact that the entire cited mark is incorporated in Applicant's mark increases the similarity between the two. Likelihood of confusion often has been found where the entirety of one mark is incorporated within another. See *In re Denisi*, 225 USPQ 624, 626 (TTAB 1985) (PERRY'S PIZZA for restaurant services specializing in pizza and PERRY'S for restaurant and bar services); see also *Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (applicant's mark BENGAL LANCER for club soda, quinine water and ginger ale likely to cause confusion with BENGAL for gin); *In re Integrated Embedded*, 120 USPQ2d at 1513 (applicant's mark BARR GROUP wholly encompasses the registered mark BARR); *Johnson Publ'g Co. v. Int'l Dev. Ltd.*, 221 USPQ 155, 156 (TTAB 1982) (applicant's mark EBONY DRUM for hairdressing and conditioner is likely to cause confusion with EBONY for cosmetics); *In re Mighty Leaf*

Tea, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant’s mark ML is similar to registrant’s mark ML MARK LEES); *In re U.S. Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (finding applicant’s CAREER IMAGE marks similar to registered mark CREST CAREER IMAGES). Thus, the marks are similar in appearance and sound to the extent that Applicant’s mark fully encompasses Registrant’s mark.

Applicant contends, however, that “there is no bright-line rule that two marks are confusingly similar if one mark incorporates the entirety of the other mark.”¹¹ Applicant argues that “the addition of the wording ‘AMERICA’S’ and ‘PLACE’ in Applicant’s Mark creates impactful differences in sight, sound, meaning and commercial impression.”¹² Visually, “the applied-for mark is longer in appearance and includes the words ‘AMERICA’S’ and ‘PLACE,’” it argues. Phonetically, “the applied for mark is longer and includes consonant and vowel sounds that are absent from the registered mark.”¹³

As we have noted, the marks are similar in appearance and sound to the extent that Applicant’s mark fully encompasses the registered mark. We acknowledge that the leading and last terms in Applicant’s mark create some differences, both visually and aurally, from the registered mark. Those points of difference, however, do not suffice to distinguish these overlapping marks, which have marked similarities in connotation and overall commercial impression. See, e.g., *In re Mighty Leaf Tea*, 94

¹¹ Applicant’s brief p. 12, 4 TTABVUE 15.

¹² Id. p. 14, 4 TTABVUE 17.

¹³ Id.

USPQ2d at 1260 (applicant's mark ML is similar to registrant's mark ML MARK LEES); *In re Denisi*, 225 USPQ at 626 (PERRY'S PIZZA for restaurant services specializing in pizza and PERRY'S for restaurant and bar services). As the Supreme Court once observed, "The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety...." *Estate of P.D. Beckwith, Inc. v. Com'r of Patents*, 252 U.S. 538, 545-46 (1920) quoted in *Juice Generation*, 115 USPQ2d at 1676.

Addressing connotation and commercial impression, Applicant argues that "[t]he marks also have very different meanings. [T]he registered marks ultimately refer to a pizza, while the applied-for mark refers to a place."¹⁴ The Examining Attorney counters that "The marks are highly similar in that registrant's marks are entirely incorporated within Applicant's mark, and Applicant has merely added a common geographic term and a highly descriptive or generic term for the designation as its restaurant as a location."¹⁵ The Examining Attorney continues:

The wording HOMETOWN PIZZA as used on a restaurant conveys that the pizza served in the restaurants has a local flavor. Changing this to AMERICA'S HOMETOWN PIZZA PLACE has a nearly identical meaning, especially given the fact that all marks must be used in United States commerce. "America's", then, is redundant in describing the nature of the pizza served as being "American" in nature. And the remainder of the wording simply indicates that the pizza served still has a local flavor. The wording "place" has little significance in reference to a pizza restaurant—it simply indicates that it is a physical location, which is conveyed by the

¹⁴ Id.

¹⁵ Examining Attorney's brief, 6 TTABVUE 6.

wording HOMETOWN PIZZA as the name of a restaurant.¹⁶

Applicant responds that “commerce encompasses US companies that ship from the United States to foreign countries.”¹⁷ But that misses the point. The term “AMERICA’S” can be literal, denoting that Applicant’s services originate in this country. *See, e.g., In re Am. Furniture Warehouse CO*, 126 USPQ2d at 1404 (“We find that consumers would believe that Applicant’s services [under the mark AMERICA’S FURNITURE WAREHOUSE and design] originate in America.”). Or “AMERICA’S” can be part of a laudatory slogan, indicating nationwide popularity. *See, e.g., In re Wileswood, Inc.*, 201 USPQ 400, 404 (TTAB 1978) (AMERICA’S BEST POPCORN! and AMERICA’S FAVORITE POPCORN! held merely descriptive of unpopped popcorn); *Kotzin v. Levi Strauss & Co.*, 111 USPQ 161, 163 (Comm’r Pats. 1956) (AMERICA’S FINEST JEANS and AMERICA’S FINEST for overalls held not confusingly similar and incapable by inference); *see generally* TMEP §§ 1209.03(n), 1210.02(b)(iv) (Oct. 2017) (“Typically these marks primarily extol the quality or popularity of the goods or services and secondarily denote geographic origin.”).

Applicant endorses the second, laudatory interpretation: “The commercial impression of AMERICA’S HOMETOWN PIZZA PLACE is of a place that has nationwide appeal.”¹⁸ But that merely reinforces and emphasizes the core impression conveyed in Registrant’s mark, HOMETOWN PIZZA. As the possessive in

¹⁶ Examining Attorney’s brief, 6 TTABVUE 8.

¹⁷ Applicant’s reply brief p. 5, 7 TTABVUE 8.

¹⁸ Applicant’s brief p. 16, 4 TTABVUE 19.

“AMERICA’S” indicates, the thing that is popular is HOMETOWN PIZZA. And if a customer wants to obtain this nationally popular HOMETOWN PIZZA, Applicant’s restaurants are the PLACE to do so. Far from distinguishing the marks, we find that that Applicant’s use of AMERICA’S and PLACE dovetails with and complements the connotation and impression conveyed in Registrant’s wholly encompassed mark, HOMETOWN PIZZA. As the Examining Attorney puts it, Applicant’s mark could be Registrant’s slogan.¹⁹ The consuming public, which is prone to shortening marks, could easily regard one mark as a shortened version of the other. *See In re Mighty Leaf Tea*, 94 USPQ2d at 1260 (“ML is likely to be perceived as a shortened version of ML MARK LEES when used on the same or closely related skin care products.”). That is quite sufficient to establish the marks’ similarity, especially given Applicant’s and Registrant’s legally identical services. “When marks would appear on virtually identical ... services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines.” *See Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *see also In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016).

Taken in their entireties, then, the marks are very similar in sight, sound, connotation and commercial impression. We find that the first *DuPont* factor weighs in favor of finding a likelihood of confusion.

II. Conclusion

We have considered of all of the evidence of record and all of the arguments,

¹⁹ Examining Attorney’s brief, 6 TTABVUE 8.

including evidence and arguments not specifically discussed in this opinion, as it pertains to the relevant *DuPont* likelihood of confusion factors. We find that Applicant's and Registrant's marks, taken in their entireties, are similar; that the third-party evidence does not appreciably diminish the strength of the cited registered mark; and that Applicant's and Registrant's identified services are identical in part and otherwise legally identical, and would travel through the same channels of trade to the same classes of customers. For the above reasons, we conclude that Applicant's subject mark, as used in connection with the services identified in the Application, so resembles the cited registered mark as to be likely to cause confusion or mistake, or to deceive under Section 2(d) of the Trademark Act.

Decision: The refusal to register Applicant's mark AMERICA'S HOMETOWN PIZZA PLACE is affirmed.