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Subject: U.S. Trademark Application Serial No. 88880667 - WEDGIE - 18504 - Examiner Brief
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Attachments

United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 88880667

Mark: WEDGIE

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Reference/Docket No. 18504

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EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the trademark examining attorney's Final refusal to register the mark WEDGIE (Serial No. 88880667) for, "Sandwiches" in International Class 30 on the grounds that 1) the proposed mark is a generic term for the goods under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051, 1052, 1127; 2) in the alternative, the mark is merely descriptive under Trademark Act Section 2(e)(1); 3) the evidence submitted is insufficient to support a claim of acquired distinctiveness under Trademark Act Section 2(f); 4) the applied-for mark is likely to cause confusion, mistake of

deception under Trademark Act Section 2(d), 15 U.S.C. §1052(d), with the registered mark for THE WEDGIE in U.S. Registration No. 5707574; 5) the mark, as used on the specimen, does not function as a trademark to indicate the source of applicant's goods under Trademark Act Sections 1, 2, and 45; 6) the mark on the specimen does not match the mark on the drawing under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127.

STATEMENT OF FACTS AND PROCEEDINGS

On April 21, 2020, applicant filed Serial No. 88880667 to register the mark WEDGIE in standard characters for, "Sandwiches" in International Class 30. In the Office Action dated July 17, 2020, the examining attorney refused registration under Trademark Act §2(e)(1) as Merely Descriptive and advised of the potential generic refusal, refused registration under Trademark Act §2(d) due to a Likelihood of Confusion with the mark in U.S. Registration No. 5707574, and refused registration based on the specimen. On January 15, 2021, applicant filed a Response, claiming Acquired Distinctiveness under Trademark Act §2(f), submitting arguments and evidence against the refusals and entering substitute specimens. On February 5, 2021, the examining attorney refused registration of the mark as Generic, maintained the §2(e)(1) refusal as Merely Descriptive in the alternative, refused the evidence for the claim of acquired distinctiveness under §2(f) as insufficient, maintained the §2(d) refusal, maintained the specimen refusal for failure to function and refused the specimens as non-matching. On August 5, 2021, applicant filed a Response, submitting arguments and evidence against the refusals and providing duplicated substitute specimens. On September 1, 2021, the issues were maintained and made final. On March 1, 2022, applicant filed a Request for Reconsideration, which was subsequently denied on April 4, 2022. On March 1, 2022, applicant filed a Notice of Appeal, and on June 3, 2022, applicant filed its Appeal Brief. The file was forwarded to the examining attorney for statement on June 7, 2022.

ISSUES

The issues on appeal are: 1) Whether the proposed mark WEDGIE is generic under Trademark Act Sections 1, 2, and 45, for the identified goods of "Sandwiches"; 2) In the alternative, if not generic, whether the proposed mark is merely descriptive under Trademark Act Section 2(e)(1); 3) Whether the proposed mark has acquired distinctiveness under Trademark Act Section 2(f); 4) Whether the applied-for mark WEDGIE, when used with the identified goods of "Sandwiches", so resembles the mark THE

WEDGIE in U.S. Registration No. 5707574 used with the same goods of “Sandwiches”, as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d); 5) Whether the applied-for mark WEDGIE functions as a trademark to indicate the source of applicant’s goods under Trademark Act Sections 1, 2, and 45; 6) Whether the specimen demonstrates use of the applied-for mark WEDGIE on the specimen.

ARGUMENTS

A. WEDGIE, THE PROPOSED MARK, IS A GENERIC TERM FOR SANDWICHES.

Generic terms do not meet the statutory definition of a trademark because they are incapable of indicating a particular source of goods and thus, cannot be registered. *USPTO v. Booking.com B.V.*, 140 S. Ct. at 2303, 2020 USPQ2d 10729, at *3-4; *In re Cordua Rests., Inc.*, 823 F.3d at 599, 118 USPQ2d at 1634 (quoting *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987)); TMEP §1209.01(c).

The proposed mark WEDGIE is a generic term for sandwiches under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051, 1052, 1127.

A term is generic if its primary significance to the relevant public is the class or category of goods with which it is used. *See USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2304, 2020 USPQ2d 10729, at *5 (2020); *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 965, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (quoting *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986)); TMEP §1209.01(c)(i). Registering generic terms “would grant the owner of [a] mark a monopoly, since a competitor could not describe his goods as what they are.” *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d at 1569, 4 USPQ2d at 1142.

Determining whether a term is generic requires a two-step inquiry: (1) What is the genus of goods at issue? (2) Does the relevant public understand the term primarily to refer to that genus of goods? *In re Cordua Rests., Inc.*, 823 F.3d 594, 599, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016) (citing *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d at 990, 228 USPQ at 530); TMEP §1209.01(c)(i). Regarding the first part of the inquiry, the genus of the goods may be defined by an applicant’s identification of goods. *See In re Cordua Rests., Inc.*, 823 F.3d at 602, 118 USPQ2d at 1636 (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)); *see*

also *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1361, 1363, 92 USPQ2d 1682, 1682, 1684 (Fed. Cir. 2009). In this case, the application identifies the goods as “Sandwiches”, which adequately defines the genus at issue.

Regarding the second part of the inquiry, the relevant public is the purchasing public for the identified goods. *Loglan Inst. Inc. v. Logical Language Grp., Inc.*, 962 F.2d 1038, 1041, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992) (quoting *Magic Wand Inc. v. RDB Inc.*, 940 F.2d at 640, 19 USPQ2d at 1553). In this case, the relevant public comprises ordinary consumers who purchase applicant’s goods, because there are no limitations to the channels of trade or classes of consumers. The evidence in the Office action dated July 17, 2020, Office action dated February 5, 2021 and Final Office action dated September 1, 2021 comprises at least twenty-five instances demonstrating that a wedgie is a sandwich.^[1] Specifically, a wedgie is a sandwich made with pizza. This evidence includes the menus of twelve restaurants that offer a wedgie.^[2] In addition, **Barry Popik**’s website contains an entry defining “Wedgie (sandwich)” and also lists additional restaurants that sell a wedgie as a sandwich.^[3] For example, **Pizza Parma** describes a wedgie as a sandwich made of pizza and features wedgies on its menu.^[4] **Carnivores**’ menu features “Hoagies, Wedgies & Carni Sandwiches”.^[5] **Bellagio** makes “Bellagio Wedgie Sandwiches”, explaining that “Wedgies are a sandwich prepared on a 9" crust instead of a bun.”^[6] Under the category for “WEDGIES” on **Pizza Joe’s** menu is the description “A 10" Round pizza shell baked and folded into a delicious sandwich.”^[7] **Italian Village Pizza**’s menu has a section for “Wedgies” with the explanation, “A 14" pizza crust sandwich”.^[8] The menus establish that a wedgie is the name of a type of food, listed in the same manner as pizza, hoagies, calzones, wings, pastas and salads. Accordingly, the evidence shows that providers of these goods use the term “wedgie” to refer to a sandwich made with pizza dough. Competitor use has been found probative on the issue of genericness. *USPTO v. Booking.com B.V.*, 140 S. Ct. at 2307 n.6, 2020 USPQ2d 10729, at *7 n.6; *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 1570, 35 USPQ2d 1554, 1558 (Fed. Cir. 1995) (citing *Remington Prods., Inc. v. N. Am. Philips Corp.*, 892 F.2d 1576, 1578, 13 USPQ2d 1444, 1446 (Fed. Cir. 1990)); *In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at *9 (TTAB 2019) (citing *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d at 1370, 127 USPQ2d at 1048).

The evidence also includes eight recipes for a wedgie, being a sandwich using pizza dough.^[9] For

example, **The Kitchen Whisper** provides a recipe for a wedgie and states, “Essentially a wedgie is a half-moon shaped pizza dough that is filled with all the ingredients that would go into/on top of a hoagie [...]. The dough was your 'bread' for this pizza sandwich.”^[10] **De Socio in the Kitchen** shares a recipe for a “Turkey and Pepperoni Wedgie”, explaining “This is a sandwich I grew up eating. [...] A wedgie is basically a pizza crust cut in half and filled with your favorite deli meat and toppings.”^[11] As such, the evidence demonstrates that a wedgie is a sandwich that any consumer can make. Thus, the relevant public would understand this designation primarily to refer to that genus of goods, because a wedgie is a type of sandwich. Consequently, the proposed mark WEDGIE is a generic term for sandwiches.

Furthermore, applicant itself uses the term, wedgie, as a generic indication for a sandwich. An applicant’s own website and marketing material is probative and can be “the most damaging evidence” in showing how the relevant public perceives a term. *In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1957-58 (TTAB 2018) (citing *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 966, 114 USPQ2d 1827, 1831 (Fed. Cir. 2015); *In re Gould Paper Corp.*, 834 F.2d 1017, 1019, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987)). For example, applicant’s specimen provided in the Application dated April 21, 2020, consists of an online menu page from applicant, with the categories of “Specials Pizza Strombolis Salads Breads & Sides Hoagies Wedgies Wings” listed at the top of the menu. In addition, the Final Office action dated September 1, 2021 contains another version of applicant’s online menu, showing that "Wedgies" is a category of food, provided in the same manner as "Pizzas", in the same font, color, and sizing and contained within identical, beige rectangles, naming the respective category of food.^[12] Moreover, applicant’s menu lists the categories for “Pizzas Gourmet Stromboli Hoagies Wedgies Salads Sides Desserts” under the "MENU" tab.^[13] In the Response dated August 5, 2021, applicant concedes, “The most basic description of the Applicant’s Wedgie is sandwich. Sandwich is the ‘genus’ of the goods of which ‘Wedgie’ is a species.”^[14] Applicant further states, “‘Wedgie’ is but one name [...] for a sandwich that is made using pizza crust as the bread.”^[15] Accordingly, applicant appears to concede that wedgie is a generic term for a sandwich. Therefore, the proposed mark WEDGIE is a generic term for sandwiches.

Applicant’s Arguments that the Proposed Mark is Not Generic are Not Persuasive

First, applicant argues that the examining attorney has not met the heightened burden to prove

genericness based on clear and convincing evidence. Contrary to this argument, *Examination Guide 1-22 Clarification of Examination Evidentiary Standard for Marks Refused as Generic* was published in May 2022 stating, “This examination guide clarifies that an examining attorney does not bear a greater burden in supporting a position that an applied-for mark is generic beyond the evidentiary showing required by the relevant legal test.” *Examination Guide 1-22* also clarifies that the evidence required must support a “reasonable predicate” or “reasonable basis”, as opposed to “clear evidence” or “clear and convincing evidence”. *Examination Guide 1-22* further states, “To resolve the confusion, the USPTO will no longer use the terminology 'clear evidence' in the TMEP to refer to the examining attorney’s burden to support genericness refusals.” In particular, the Trademark Manual of Examining Procedure (TMEP) states, “The examining attorney must establish a prima facie case that a term is generic by providing a *reasonable predicate* (or basis) that the relevant purchasing public would primarily use or understand the matter sought to be registered to refer to the genus of goods or services in question.” TMEP §1209.01(c)(i) (emphasis added). Accordingly, a heightened burden is not placed on the examining attorney and the evidence need not rise to a higher level of clear and convincing evidence. In the present record, as discussed above, the evidence satisfies the relevant legal test to support a reasonable predicate that for sandwiches, the relevant public understands the term “wedgie” primarily to refer to that genus of goods.

Second, applicant asserts that the evidence demonstrates the trademark significance of applicant’s mark WEDGIE. Contrary to applicant’s assertions, the evidence shows that a wedgie is a type of sandwich, of which applicant’s restaurant, Fox’s, is but one seller. In particular, the evidence shows that applicant and other restaurants provide wedgies as a category of food on their menus, described as a sandwich. Competitor use is probative on the issue of genericness. *USPTO v. Booking.com B.V.*, 140 S. Ct. at 2307 n.6, 2020 USPQ2d 10729, at *7 n.6.

Additionally, the excerpts of evidence that applicant has pasted in its Brief to support its argument for demonstrating its trademark use, show “wedgie” as a generic term for a sandwich. Contrary to applicant’s statements, **Barry Popik**’s website defines “wedgie” as a sandwich and lists restaurants that sell a wedgie sandwich, stating “Other restaurants (mostly in Pennsylvania) also have 'wedgies' on the menu.”^[16] As discussed above, **De Socio in the Kitchen** provides a background explanation of a wedgie in conjunction with its recipe for a wedgie sandwich. Although **De Socio in the Kitchen**

names applicant as one seller of a wedgie, **De Socio in the Kitchen** uses the word “wedgie” as a generic term for a sandwich. Next, the screenshot from **Twitter** says, “Wedgie Wed! Buy any wedgie sandwich, get 1 free!” This statement is equivalent to the saying “Taco Tuesday! Buy any taco, get 1 free!” The excerpts do not establish trademark use, because no indication of source has been provided. Further, the mere inclusion of applicant’s restaurant along with a wedgie sandwich does not show trademark use of the proposed mark WEDGIE. The evidence proves that wedgie is a generic name, used by many for a sandwich.

Applicant continues by stating, “Applicant submitted evidence that demonstrates that the relevant public perceives Applicant’s Mark WEDGIE to be a source-indicator of Applicant’s sandwich.” As noted above, although the evidence names applicant’s restaurant, the proposed mark WEDGIE is not used as the source of the goods, because the evidence uses “wedgie” as a generic term for a sandwich. For example, **Battle Creek Enquirer** opens its article with, “Few foods are more fun to order than the veggie wedgies. Seriously. That’s a great name for a sandwich.”^[17] The article also lists “PRICES: Pizza, \$5 to \$24; Stromboli, \$6 to \$13.49; hoagies, \$3.69 to \$7; salads, \$3 to \$5.49; wedgies, \$6.29 to \$6.79.”^[18] **Turtles Travel**'s online post is titled, "Pittsburgh Wedgie" and explains the background of this Pittsburgh tradition, further stating, “Incarnations of the wedgie can be found at dozens of local pizza shops [...]”^[19] **Prattville Life** details its experience on eating a wedgie and provides a definition of the wedgie, saying “The definition I was given is that a wedgie is a sandwich on pizza crust instead of bread. [...] After I had been seated, the waitress promptly took my order: a steak wedgie.” As such, the evidence contains non-source-identifying and generic uses of the word “wedgie” to represent a sandwich.

To further support its argument, applicant states that the evidence shows that applicant is the creator of the wedgie sandwich. As a whole, it is unclear who may have invented wedgie as a sandwich. For instance, **Pizza Parma** states, “Many claim to have invented the wedgie, so we don't know for sure who actually came up with it.”^[20] Regardless of the origins of the wedgie sandwich, the evidence in the record establishes that “wedgie” is a generic term for a sandwich. Moreover, the fact that an applicant may be the first user of a generic designation is not dispositive on the issue of genericness where, as here, the evidence shows that the word is generic for the goods. *See In re Empire Tech. Dev.*

LLC, 123 USPQ2d 1544, 1549 (TTAB 2017) (quoting *In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1083 (TTAB 2010)); TMEP §1209.03(c). Furthermore, “Trademark rights are not static.” *In re Thunderbird Prods. Corp.*, 406 F.2d 1389, 1391, 160 USPQ 730, 732 (C.C.P.A. 1969). A term that might not have been considered merely descriptive or generic originally or in the past may now be considered so due to the frequency of its use over time. *See In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, at *9 (TTAB 2019) (citing *In re Thunderbird Prods. Corp.*, 406 F.2d at 1391, 160 USPQ at 732). Eligibility for registration must be determined on the basis of the facts and evidence in the record at the time registration is sought, which includes during examination and any related appeal. *In re Chippendales USA Inc.*, 622 F.3d 1346, 1354, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1344, 213 USPQ 9, 18 (C.C.P.A. 1982); *In re Thunderbird Prods. Corp.*, 406 F.2d at 1391, 160 USPQ at 732.

Third, applicant opines that the small amount of evidence submitted is insufficient to meet the examining attorney’s heightened burden of clear and convincing evidence. As detailed above, the examining attorney is not held to a higher burden of proving generic use by clear and convincing evidence. A term is generic if its primary significance to the relevant public is the category of goods with which it is used. *See USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2304, 2020 USPQ2d 10729, at *5 (2020); TMEP §1209.01(c)(i). As such, the applicable test is whether the relevant public would *understand* the mark to be generic for the category or genus of the goods at issue. *In re Cordua Rests., Inc.*, 823 F.3d 594, 603, 118 USPQ2d 1632, 1637 (Fed. Cir. 2016). To satisfy this test, the examining attorney must establish a *prima facie* case that a term is generic by providing a *reasonable predicate* that the relevant purchasing public would primarily understand the matter sought to be registered to refer to the genus of goods in question. TMEP §1209.01(c)(i). Here, the examining attorney’s record contains at least twenty-five instances in which “wedgie” is utilized as a generic term for sandwich. This evidence contains menus listing wedgies as a category of food, articles describing a wedgie sandwich, and recipes for a wedgie sandwich. In addition, as discussed above, applicant has provided additional examples of such. Thus, the record establishes a *prima facie* case that the term “wedgie” is generic, as evidenced by a reasonable predicate that relevant purchasers would understand “wedgie” to refer to the genus of the sandwich goods at issue.

Fourth, applicant provides examples from third-parties for different terms in order to argue that

competitors have other terms available to them to describe these sandwiches. However, it is well settled that each application must be decided on its own facts; the USPTO is not bound by prior decisions involving different records. *See In re Boulevard Ent., Inc.*, 334 F.3d 1336, 1343, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) (citing *In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); TMEP §1209.03(a). The question of whether a mark is generic or merely descriptive is determined based on the evidence of record at the time each registration is sought. *In re Consumer Prot. Firm PLLC*, 2021 USPQ2d 238, at *22 (citing *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1064, 1067 (TTAB 2011)); TMEP §1209.03(a). The showing of uses of other names for the same or similar goods is not relevant to the present case, because those third-party terms are not at issue here.

Moreover, these examples indicate that competitors are creating their own words, separate from wedgie, in order to function as their source-indicators or trademarks for this sandwich. As such, to distinguish themselves, it is normal that competitors market their goods by their trademarks. In the present case, the term at issue is “wedgie” and the goods at issue are sandwiches. The evidence contains at least fifteen examples of restaurants that offer a wedgie being a sandwich.^[21] As such, applicant’s competitors use the term “wedgie” as the name for their sandwiches. Competitor use is probative on the issue of genericness. *USPTO v. Booking.com B.V.*, 140 S. Ct. at 2307 n.6, 2020 USPQ2d 10729, at *7 n.6. “To allow trademark protection for generic terms, i.e., names which describe the genus of goods being sold, even when these have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.” *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987).

Lastly, applicant argues that any doubt should be resolved on applicant’s behalf. *E.g.*, *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571 4 USPQ2d 1141, 1144 (Fed. Cir. 1987); *In re Grand Forest Holdings, Inc.*, 78 USPQ2d 1152, 1156 (TTAB 2006). However, in the present case, the evidence of record leaves no doubt that the proposed mark is a generic name for a sandwich.

B. THE PROPOSED MARK IS MERELY DESCRIPTIVE FOR APPLICANT’S GOODS.

In the alternative to the above, if the applied-for mark is determined not to be generic, then the

proposed mark is merely descriptive of applicant's goods under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). Particularly, the applied-for mark, WEDGIE, merely describes a feature, quality, characteristic, purpose, and use of applicant's sandwich goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.* In the Response dated January 15, 2021, applicant claimed acquired distinctiveness under Trademark Act Section 2(f). Applicant's claim of acquired distinctiveness is a concession that the mark sought to be registered is merely descriptive of applicant's goods. *In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, at *9 (TTAB 2019) (citing *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 1358, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009); *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1577, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *In re Am. Furniture Warehouse Co.*, 126 USPQ2d 1400, 1403 (TTAB 2018)).

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. TMEP §1209.01(b). The evidence, portions of which are highlighted above, shows that the proposed mark is highly descriptive of sandwiches and there is great industry need for competitors to use the wording. Specifically, a wedgie is a category and type of sandwiches.

Applicant's Arguments that the Proposed Mark is Not Merely Descriptive are Not Persuasive

Applicant submits general arguments against the evidence. As discussed in detail above, the evidence establishes that a wedgie is a type of sandwich. Applicant states that its proposed mark, WEDGIE, is coined by applicant. Contrary to this argument, as addressed above, the origins of wedgie as a sandwich are unclear and whether an applicant may be the first user of a merely descriptive designation does not necessarily render a word or term incongruous or distinctive; as in this case, the evidence shows that wedgie is merely descriptive of sandwiches. *See In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1514 (TTAB 2016); *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); TMEP §1209.03(c).

Applicant's proposed mark is not similar to Papa John's "Papadias". As noted above, each application must be decided on its own facts. *See In re Boulevard Ent., Inc.*, 334 F.3d 1336, 1343, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) (citing *In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566); TMEP §1209.03(a). The question of whether a mark is merely descriptive is determined based on the evidence of record at the time each registration is sought. *In re Consumer Prot. Firm PLLC*,

2021 USPQ2d 238, at *22 (citing *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1064, 1067 (TTAB 2011)); TMEP §1209.03(a). Moreover, the evidence does not demonstrate that Papa John's is using its mark for "Papadias" in a non-source-identifying manner. As detailed above, applicant uses the term "wedgie" as a generic word for a sandwich.

Applicant claims that its proposed mark is arbitrary based on the other meanings of the word "wedgie". Descriptiveness is considered in relation to the relevant goods. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). "That a term may have other meanings in different contexts is not controlling." *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *5 (TTAB 2019) (citing *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1598 (TTAB 2018)); TMEP §1209.03(e). "It is well settled that so long as any one of the meanings of a term is descriptive, the term may be considered to be merely descriptive." *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018) (quoting *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984)). Here, the goods at issue are sandwiches. In connection with the sandwich goods at issue, the evidence establishes that a wedgie is a type of sandwich.

Lastly, applicant asserts that any doubt regarding the mark's descriptiveness should be resolved on applicant's behalf. *E.g.*, *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571 4 USPQ2d 1141, 1144 (Fed. Cir. 1987); *In re Grand Forest Holdings, Inc.*, 78 USPQ2d 1152, 1156 (TTAB 2006). However, in the present case, the evidence of record leaves no doubt that the mark is merely descriptive.

C. THE EVIDENCE IS INSUFFICIENT TO SUPPORT A CLAIM OF ACQUIRED DISTINCTIVENESS.

The proposed mark, WEDGIE is a generic term for sandwiches, because a wedgie is a sandwich. As such, a claim of acquired distinctiveness under Trademark Act Section 2(f) is insufficient because "generic terms cannot be rescued by proof of distinctiveness or secondary meaning no matter how voluminous the proffered evidence may be." *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1370, 127 USPQ2d 1041, 1048 (Fed. Cir. 2018) (quoting *In re Northland Aluminum Prods.*, 777 F.2d 1556, 1558, 227 USPQ2d 961, 962 (Fed. Cir. 1985)); *see* TMEP §1212.02(i).

If the proposed mark is determined to be merely descriptive and not generic, the Section 2(f) evidence submitted by applicant is insufficient to show acquired distinctiveness, because the evidence

does not demonstrate that the relevant consumers view the word “wedgie” as a mark for the goods at issue. *See* 37 C.F.R. §2.41. To show that a mark has acquired distinctiveness, applicant bears the burden of proving that a mark has acquired distinctiveness under Trademark Act Section 2(f) by demonstrating that the relevant public understands the primary significance of the mark as identifying the source of a product rather than the product itself. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1335, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015) (citing *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005)); TMEP §1212.01. An applicant’s evidentiary burden of showing acquired distinctiveness increases with the level of descriptiveness of the mark sought to be registered; a more descriptive term requires more evidence. *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d at 1365, 127 USPQ2d at 1045. Here, applicant has not met its burden.

As evidence to support its claim of acquired distinctiveness, applicant submitted: Seven advertisements in Exhibit D in the Response dated August 5, 2021, Pages 45-51 in TSDR (This Exhibit D is the same as Exhibit B in the Response dated January 15, 2021.); Ten articles in Exhibit E in the Response dated August 5, 2021, Pages 53-75 in TSDR (The five pages of Exhibit C in the Response dated January 15, 2021 are the same beginning five pages of this Exhibit E in the Response dated August 5, 2021.); Statement of substantially exclusive and continuous use since 1981. This evidence is insufficient to demonstrate that the public associates the proposed mark with a single source in light of the amount of evidence in the record demonstrating the generic and descriptive uses of the term “wedgie” for sandwiches and because the word is so highly used in the market and thus, so highly descriptive. The evidence provided by applicant does not show that the relevant public understands the primary significance of the mark as identifying the source of a product, rather than the product itself.

Although the evidence mentions applicant’s restaurant, Fox’s, applicant’s evidence demonstrates that a wedgie is a type of sandwich and a generic name for this menu item. Specifically, applicant’s advertisements show that a wedgie is a type of food. For example, the second advertisement in the August 5, 2021 Response (notated by applicant as “D-2”), Page 46 in TSDR, lists a wedgie as a menu item stating, “Now You Can Enjoy A Delicious Bowl Of Soup At Ms. D’s-Regularly \$1.25 For Only 75[cents] With The Purchase Of Any Sandwich, Wedgie or Hoagie”. Next, on Page 48 in TSDR of the August 5, 2021 Response, applicant’s advertisement markets the following categories of food: “Fox’s Homemade Stromboli’s”, “Fox’s Pizza”, “Fox’s Side Orders”, “Fox’s Wedgies”, and “Fox’s

Hoagies”. Each of these items are listed in the same manner with the same font, stylization, and sizing on applicant’s menu. This advertisement also offers discounts for: "LARGE OR MEDIUM PIZZA", "WHOLE HOAGIE", "LARGE OR MEDIUM STROMBOLI", and "WHOLE WEDGIE". The next advertisement in the August 5, 2021 Response (applicant’s "D-5"), Page 49 in TSDR lists: Menu Items, Stromboli - Wedgie, Hoagie - Salads, Wings - Desserts, Sides - Pizza. As such, applicant’s evidence demonstrates that applicant utilizes the term “wedgie” as a type of food. Applicant’s advertisements fail to demonstrate that the relevant public would understand the primary significance of the mark as identifying the source of a product, rather than the product itself, because applicant uses the word to represent the goods themselves.

Second, applicant submits ten articles in Exhibit E in the Response dated August 5, 2021, Pages 53-75 in TSDR. These articles also support the finding that a wedgie is a sandwich, as opposed to identifying the source the goods. Although the articles associate a wedgie with applicant’s restaurant, the articles discuss a wedgie as a type of food or sandwich. The **Myrtle Beach Online, Kicks!** article in the Response dated August 5, 2021, Page 57 in TSDR (notated by applicant as "E-5") states, “If wedgies aren't your thing, stick with the hoagies. Customers can buy a whole wedgie [...] for \$6.99 or pay \$7.99 for a 13-inch hoagie.” The **Reddit** post in the Response dated August 5, 2021, Page 58 in TSDR asks, “Do you know any restaurant that serves Wedgies or Foldovers in Chicago?” The **Reddit** post further explains, “A ‘Wedgie Sandwich’ or ‘Foldover’ is popular in Philadelphia and other east coast locations.” The evidence from **Just a Pinch**, in the Response dated August 5, 2021, Pages 53, 61-64 in TSDR, consists of a recipe to for “How to Make Best Wedgie Sandwich”. Additionally, the generic uses of the word “wedgie” as a sandwich in the articles from **Battle Creek Enquirer**, **Turtle Travel**, **De Socio in the Kitchen** and **Prattville Life** are quoted and detailed above. As a whole, the articles do not show that applicant is identified as the source of the goods, separate from using the word to represent the generic name of the goods themselves. The evidence submitted establishes that there are many providers of wedgie sandwiches. Moreover, a person can make their own wedgie sandwich by following the available recipes. Accordingly, applicant’s evidence is insufficient to demonstrate that the relevant public would understand the primary significance of the mark as identifying the source of a product, rather than the product itself.

Third, applicant asserted its claim of acquired distinctiveness based on length of use. *See* 15 U.S.C. §1052(f). In particular, applicant states that it was the first user of the word and has been in substantially exclusive and continuous use since 1981. Contrary to applicant's statements, the record shows that applicant's use has **not** been exclusive and continuous since 1981. Specifically, the evidence confirms that applicant's use is not exclusive, because many other sellers offer a wedgie as a menu category and as a sandwich. Further, the evidence establishes that a wedgie is a type of sandwich. As such, the allegation based on length of use is insufficient to show acquired distinctiveness because the applied-for mark is at least highly descriptive of applicant's goods. *See In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1336-37, 116 USPQ2d 1262, 1265 (Fed. Cir. 2015); *In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, at *11-12 (TTAB 2019); TMEP §1212.05(a). Consequently, applicant has not provided evidence sufficient to support a claim of acquired distinctiveness under Trademark Act Section 2(f).

Applicant's Assertions that the Proposed Mark has Acquired Distinctiveness are Not Persuasive

Applicant's claim of length of use and its evidence are insufficient to demonstrate that the relevant public associates the proposed mark with a single source for sandwiches. Applicant asserts that it has made no concessions. However, applicant's Response dated January 15, 2021 contains a Section 2(f) Claim of Acquired Distinctiveness based on Five or More Years' Use. Contrary to applicant's assertions, applicant's claim of acquired distinctiveness is a concession that the mark sought to be registered is merely descriptive of applicant's goods. *In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, at *9 (TTAB 2019).

Applicant maintains that its creation of the wedgie sandwich, use since 1981, unsolicited media coverage and the evidence of restaurants replicating the sandwich is sufficient to support its claim of acquired distinctiveness. Applicant bears the burden of proving that a mark has acquired distinctiveness under Trademark Act Section 2(f). *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1335, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015); TMEP §1212.01. "To show that a mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself." *In re Steelbuilding.com*, 415 F.3d at 1297, 75 USPQ2d at 1422. The ultimate test in determining acquisition of distinctiveness under Section 2(f) is not applicant's efforts, but applicant's success in educating the

public to associate the claimed mark with a single source. *In re LC Trademarks, Inc.*, 121 USPQ2d 1197, 1208 (TTAB 2016) (quoting *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1480 (TTAB 2016)); TMEP §1212.06(b).

Applicant has not met its burden. The evidence provided by applicant demonstrates that the term “wedgie” is the name of the goods themselves. As detailed above, applicant’s use has not been exclusive since 1981. Further, applicant’s assertion that others have copied it supports that applicant is aware that its competitors provide the same goods under the same generic name. The evidence illustrates that applicant has had no success in educating the public to associate the proposed mark with a single source, because a wedgie is a sandwich, of which applicant’s restaurant, Fox’s, is but one seller of the many providers. The evidence fails to establish that the relevant public understands the primary significance of the proposed mark as identifying the source of a product, rather than the product itself. Therefore, the proposed mark has not acquired distinctiveness for the goods.

D. APPLICANT’S MARK AND REGISTRANT’S MARKS ARE CONFUSINGLY SIMILAR AND APPLICANT’S GOODS AND REGISTRANT’S GOODS ARE RELATED SUCH THAT CONSUMERS ARE LIKELY TO BE CONFUSED, MISTAKEN, OR DECEIVED AS TO THE SOURCE.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis, and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567. In this case, the following factors are the most relevant: similarity of the marks, and relatedness of the goods. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin’s Miniatures Inc.*, 59 USPQ2d 1593, 1595-96

(TTAB 1999); TMEP §§1207.01 *et seq.*

1. APPLICANT'S MARK AND REGISTRANT'S MARKS ARE CONFUSINGLY SIMILAR

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

In this case, the applied-for mark is WEDGIE in standard characters and registrant's mark is THE WEDGIE in standard characters in U.S. Registration No. 5707574. For the reasons stated below, applicant's mark is highly similar in meaning, connotation and commercial impression to registrant's mark. The marks at issue are virtually identical. Specifically, the minimal difference in the marks is that the registered mark contains the wording “THE”. When comparing similar marks, the Trademark Trial and Appeal Board has found that inclusion of the term “the” at the beginning of one of the marks will generally not affect or otherwise diminish the overall similarity between the marks. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (finding WAVE and THE WAVE “virtually identical” marks; “[t]he addition of the word ‘The’ at the beginning of the registered mark does not have any trademark significance.”); *In re Narwood Prods. Inc.*, 223 USPQ 1034, 1034 (TTAB 1984) (finding THE MUSIC MAKERS and MUSIC-MAKERS “virtually identical” marks; the inclusion of the definite article “the” is “insignificant in determining likelihood of confusion”).

Moreover, the wording “WEDGIE” in the marks marks is identical in appearance, sound, and meaning, “and have the potential to be used . . . in exactly the same manner.” *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). Additionally, because this wording is identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant's and registrant's respective goods. *Id.* Thus, the marks are virtually identical and therefore, the marks are confusingly similar.

Applicant's Arguments Regarding the Similarity of the Marks are Not Persuasive

Applicant argues that the marks convey different connotations and commercial impressions because the parties offer different types of sandwiches. In particular, applicant asserts that its mark is for a sandwich made with pizza crust and cut into a wedge shape. Applicant also opines that registrant's sandwiches are similar to a wedge salad on a biscuit with chicken. Applicant's argument is not persuasive for the following reasons.

Determining likelihood of confusion is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)). The use of broad wording in an identification to describe goods, presumably encompasses all goods of the type described. *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Here, the identification of goods in the application and in the registration is for "Sandwiches". Based on this broad wording, registrant owns its registration for all types of sandwiches. Accordingly, applicant may not restrict registrant's goods in an attempt to argue that the marks convey different meanings. For example, in *In re St. Helena Hospital*, 113 USPQ2d 1082 (Fed. Cir. 2014), the Court determined that TAKE 10! and TAKE TEN conveyed similar connotations, where one party's mark referred to ten minutes and the other meant ten days, because "the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods'." *In re St. Helena Hospital*, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *see Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990).

Furthermore, the goods in the application and registration are identical. Where the goods of an applicant and registrant are identical, the degree of similarity between the marks required to support a finding that confusion is likely declines. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); TMEP §1207.01(b).

In the present case, the applied-for mark is WEDGIE and registrant's mark is THE WEDGIE. These

marks are virtually identical. Therefore, applicant's mark is highly similar in meaning, connotation and commercial impression to registrant's mark.

2. THE GOODS IDENTIFIED IN THE APPLIED-FOR MARK AND IN REGISTRANT'S MARK ARE RELATED

Applicant's goods are "Sandwiches" in International Class 30. The goods in U.S. Registration No. 5707574 are also "Sandwiches" in International Class 30. When analyzing an applicant's and registrant's goods for similarity and relatedness, that determination is based on the description of the goods in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). In this case, the goods in the application and registration are identical. As such, it is presumed that the channels of trade and classes of purchasers are the same for these goods. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)). Thus, applicant's and registrant's goods are related.

Applicant's Arguments Regarding the Relatedness of the Goods are Not Persuasive

With respect to the goods at issue, applicant argues that the parties offer different types of sandwiches. Specifically, applicant asserts that its mark is for use with a sandwich made with pizza crust and cut into a wedge shape. Applicant also states that registrant's sandwiches are similar to a wedge salad on a biscuit with chicken. Applicant's argument is not persuasive for the following reasons.

The identification of goods in the application is "Sandwiches". The identification in U.S. Registration No. 5707574 is also "Sandwiches". As noted above, determining likelihood of confusion is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)). The use of broad wording in an identification to describe goods, presumably encompasses all goods of the type described, including narrower types of these goods. *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*,

115 USPQ2d 1007, 1025 (TTAB 2015). As each of the identifications of goods in the application and in the registration is for “Sandwiches”, the broad identification encompasses all types of sandwiches. Consequently, contrary to applicant’s arguments, the goods are the same and thus, related.

3. ADDITIONAL DU PONT FACTORS DO NOT AFFECT THE FINDING OF A LIKELIHOOD OF CONFUSION

Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). However, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976); TMEP §1207.01. In the present application, the additional *du Pont* factors are not relevant, because the marks are virtually identical, and the compared goods are the same, as detailed above. Because the two key considerations in a likelihood of confusion analysis have been met, the additional *du Pont* factors are not relevant, nor of great weight.

Applicant’s Assertion that the Marks Coexist Without Confusion is Unpersuasive

Applicant asserts that the companies have coexisted for at least twelve years without confusion and that there is no evidence of confusion. “[A] showing of actual confusion is not necessary to establish a likelihood of confusion.” *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); TMEP §1207.01(d)(ii). “[T]he relevant test is *likelihood* of confusion, not *actual* confusion.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 1309, 128 USPQ2d 1047, 1053 (Fed. Cir. 2018) (emphasis in original). Further, applicant has supplied no evidence to support its conclusory statements. “Uncorroborated statements of no known instances of actual confusion . . . are

of little evidentiary value,” especially in ex parte examination. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1317, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003).

In the present case the two key considerations in a likelihood of confusion analysis have been satisfied. Specifically, the compared marks are confusingly similar, and the respective goods are related, giving rise to a likelihood of confusion. Consequently, the additional *du Pont* factor of evidence of actual confusion is not relevant, nor of great weight. Finally, the overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

E. SPECIMEN DOES NOT DEMONSTRATE THAT THE PROPOSED MARK FUNCTIONS AS AN INDICATOR OF SOURCE.

The applied-for mark, as used on the substitute specimens, does not function as a trademark to indicate the source of applicant’s goods and to identify and distinguish it from others under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127. The original specimen in the application was refused for multiple reasons, including being unacceptable as a webpage specimen because it lacks the required URL. *See* 37 C.F.R. §2.56(c); Mandatory Electronic Filing & Specimen Requirements, Examination Guide 1-20, at V.B. (Rev. Feb. 2020). Accordingly, the specimen refusals pertain to the five substitute specimens submitted in applicant’s Response dated January 15, 2021, Pages 55-56 in TSDR and duplicated in applicant’s Response dated August 5, 2021, Pages 88-89 in TSDR.

Whether a designation functions as a mark depends on the commercial impression it makes on the relevant public; that is, whether purchasers would be likely to regard it as a source-indicator for the goods. *See In re Keep A Breast Found.*, 123 USPQ2d 1869, 1879 (TTAB 2017) (quoting *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010)); TMEP §1202. This refusal applies to the substitute specimens showing applicant’s menus in the January 15, 2021 Response on Pages 55-56 in TSDR. These specimens demonstrate that applicant uses

the term “wedgie” as the name for food. First, the specimen in the January 15, 2021 Response on Page 55 in TSDR is applicant’s online menu. Additional screen captures of this online menu are provided in the September 1, 2021 Final Office action, Pages 2-3 in TSDR, showing that "Wedgies" is a category of food on applicant’s menu, provided in the same manner as "Pizzas", in the same font, color, and sizing and contained within identical, beige rectangles. In addition, at the top of applicant’s online menu, under the "MENU" tab, the categories for “Pizzas Gourmet Stromboli Hoagies Wedgies Salads Sides Desserts” are listed. Second, the specimen in the January 15, 2021 Response on Page 56 in TSDR is a screen capture of another menu of applicant. This menu lists “Menu Categories”, followed underneath by the categories for: Pizza, Strombolis, Salads/Wraps, Breads & Sides, Hoagies, Wedgies, Wings, Desserts, and Beverages. "Wedgies" as used on this specimen, appears in the same font, sizing and color as the additional categories or types of foods. Thus, applicant’s menus utilize the proposed mark as the name of a food. The specimens do not demonstrate use of the applied-for mark WEDGIE as an indicator of source for the specified goods. Therefore, the applied-for mark, as used on these substitute specimens, does not function as a trademark to indicate the source of applicant’s goods under Trademark Act Sections 1, 2, and 45.

Applicant’s Arguments that the Specimens are Acceptable are Not Persuasive

Applicant argues that the specimens are acceptable as displays associated with the goods. This specimen refusal does not pertain to the manner of the specimen, but to whether the proposed mark, as used on the specimen, functions as a trademark to indicate the source of applicant’s goods. Although the proposed mark appears on the specimens, it does not function as a trademark to indicate the source of applicant’s goods, as detailed above. Applicant’s menus use the proposed mark as the name of a food available on the menu, as opposed to a source-indicator for the goods.

F. SPECIMEN DOES NOT SHOW THE PROPOSED MARK.

This refusal pertains to the three photographs of the red box or packaging, submitted as substitute specimens in applicant’s Response dated January 15, 2021, Pages 52-54 in TSDR and duplicated in the Response dated August 5, 2021, Pages 85-87 in TSDR. These specimens do not show the mark in the drawing in use in commerce in International Class 30 as required by Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), 1301.04(g)(i). The mark appearing on the specimen and in the drawing must match; that is, the mark in the drawing

“must be a substantially exact representation of the mark” on the specimen. *See* 37 C.F.R. §2.51(a)-(b); TMEP §807.12(a).

Here, the specimens at issue display the mark as FOX’S FAMOUS WEDGIE on the packaging. However, the drawing displays the mark as the sole wording WEDGIE. The mark on the specimen does not match the mark in the drawing because it adds wordings to the sole wording in the applied-for mark that change the meaning and commercial impression of the sole wording in the applied-for mark drawing. Specifically, the “substantially exact” standard is based on the commercial impression or meaning of the applied-for mark as submitted in the drawing in the application. *See* 37 C.F.R. §2.72(a)(2), (b)(2); TMEP §807.14. A material alteration to the applied-for mark as submitted in the drawing in the application would be impermissible and thus, not substantially exact. *See* TMEP §807.14. The mark on the specimens adds applicant’s name “FOX’S” and the laudatory word “FAMOUS” before the wording in the drawing. These additional words alter the meaning of the sole wording in the drawing from “wedgie” to that of a “famous wedgie belonging to Fox”. Thus, the mark on the specified specimens does not match the mark in the drawing because it adds words that change the meaning and commercial impression of the applied-for mark. Applicant has thus failed to provide the required evidence of use of the mark in commerce. *See* TMEP §807.12(a).

Applicant’s Assertions that the Mark on the Specimens Matches the Mark Drawing are Not Persuasive

Applicant argues that the words “Fox’s Famous”, added to the mark drawing, are laudatory words that do not change the meaning or commercial of the applied-for mark WEDGIE. Contrary to applicant’s arguments, the additional words change the meaning of the sole wording in the applied-for mark, as discussed above. Moreover, generally, the addition of any element that would require a further search will constitute a material alteration. *In re Pierce Foods Corp.*, 230 USPQ 307, 308-09 (TTAB 1986). Further, proposed amendments to marks were found to be material alterations in the following decisions: *In re Hacot-Colombier*, 105 F.3d 616, 41 USPQ2d 1523 (Fed. Cir. 1997) (finding proposed addition of house mark to be a material alteration of the mark on the drawing filed with original application); *In re Nationwide Indus., Inc.*, 6 USPQ2d 1882 (TTAB 1988) (finding addition of house mark “SNAP” to product mark “RUST BUSTER” to be a material alteration); *In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986) (finding addition of house mark “PIERCE” to “CHIK’N BAKE”

to be a material alteration). The additional words on these specimens are similar to these proposed amendments found to be material alterations. Thus, the three photographs of the red packaging, submitted as substitute specimens, do not demonstrate use of the applied-for mark WEDGIE.

CONCLUSION

Applicant's mark, WEDGIE, represents a generic term for the goods of "Sandwiches". Alternatively, the mark is merely descriptive of a feature, quality, characteristic, and use of applicant's sandwich goods. The evidence submitted by applicant is insufficient to support a claim of acquired distinctiveness under Trademark Act §2(f). Applicant's mark, WEDGIE, on its face, is confusingly similar to registrant's mark in U.S. Registration No. 5707574, in that both marks share the term "WEDGIE", conveying the same meaning, connotation and commercial impression. The marks are also used in conjunction with the same goods. Thus, it is highly likely that applicant's mark and registrant's mark will cause consumer confusion. The present record does not contain an acceptable specimen demonstrating use of the applied-for mark as a source in commerce for the goods. The mark, as used on the substitute specimens, does not function as a trademark to indicate the source of applicant's goods. The mark, as used on the additional substitute specimens, does not demonstrate use of the mark on the drawing in the application.

Respectfully submitted,

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Law Office 123

End Notes

1. See Evidence attached to July 17, 2020 Office Action, Pages 4-23 in TSDR, February 5, 2021 Office Action, Pages 2-58 in TSDR and September 1, 2021 Final Office Action, Pages 9-31 in TSDR.
2. See Evidence attached to July 17, 2020 Office Action, Pages 13-17, 19-23 in TSDR, February 5, 2021 Office Action, Pages 34-58 in TSDR and September 1, 2021 Final Office Action, Pages 2-3, 9-10, 17-20 in TSDR.
3. See Evidence attached to September 1, 2021 Final Office Action, Pages 27-30 in TSDR.
4. See Evidence attached to July 17, 2020 Office Action, Pages 4-9 in TSDR and September 1, 2021 Final Office Action, Pages 9-10 in TSDR.
5. See Evidence attached to July 17, 2020 Office Action, Pages 13-15 in TSDR.
6. See Evidence attached to July 17, 2020 Office Action, Pages 19-20 in TSDR.
7. See Evidence attached to February 5, 2021 Office Action, Pages 37-38 in TSDR.
8. See Evidence attached to February 5, 2021 Office Action, Pages 43-47 in TSDR.
9. See Evidence attached to July 17, 2020 Office Action, Pages 10-11 in TSDR, February 5, 2021 Office Action, Pages 2-13, 18-24, 27-28 in TSDR and September 1, 2021 Final Office Action, Pages 24-26, 31 in TSDR.
10. See Evidence attached to February 5, 2021 Office Action, Pages 2-13 in TSDR.
11. See Evidence attached to February 5, 2021 Office Action, Pages 18-21 in TSDR.
12. See Evidence attached to September 1, 2021 Final Office Action, Pages 2-3 in TSDR.
13. *Id.*
14. See Applicant's Response dated August 5, 2021, Page 3 in TSDR.
15. See Applicant's Response dated August 5, 2021, Page 4 in TSDR.
16. See Evidence attached to September 1, 2021 Final Office Action, Pages 27-30 in TSDR.
17. See Applicant's Response dated January 15, 2021, Page 27 in TSDR.
18. *Id.*
19. See Applicant's Response dated August 5, 2021, Page 59 in TSDR.
20. See Evidence attached to July 17, 2020 Office Action, Page 5 in TSDR.
21. See Evidence attached to July 17, 2020 Office Action, Pages 13-17, 19-23 in TSDR, February 5, 2021 Office Action, Pages 34-58 in TSDR and September 1, 2021 Final Office Action, Pages 9-10, 17-20, 27-30 in TSDR.

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Examining attorney's appeal brief has issued
on July 28, 2022 for
U.S. Trademark Application Serial No. 88880667

A USPTO examining attorney has issued an appeal brief. Follow the steps below.

- (1) **[Read the appeal brief](#)**. This email is NOT the appeal brief.
- (2) **Submit reply brief within 20 days of July 28, 2022**, if you wish to do so. If submitted, a reply brief must be submitted using the [Electronic System for Trademark Trials and Appeals \(ESTTA\)](#) and received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the reply period.
- (3) **Direct questions** about the appeal proceeding to the Trademark Trial and Appeal Board at 571-272-8500 or TTABInfo@uspto.gov.