

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: February 22, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Lohn Enterprises, Incorporated*  
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Serial No. 88914168  
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Joseph J. Weissman of Johnson, Pope, Bokor, Ruppel & Burns, LLP,  
for Lohn Enterprises, Incorporated.

Yatsye I. Lee, Trademark Examining Attorney, Law Office 107,  
J. Leslie Bishop, Managing Attorney.

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Before Kuczma, Coggins, and Dunn,  
Administrative Trademark Judges.

Opinion by Coggins, Administrative Trademark Judge:

Lohn Enterprises, Incorporated (“Applicant”) seeks registration on the Principal  
Register of the mark shown below:




for “restaurant services” in International Class 43.<sup>1</sup>

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied to the services identified in the application, so resembles the marks in the following three registrations, each for “restaurant services,” owned by two different registrants:

- Registration No. 4504623 for the standard character mark MELS DRIVE-IN (with DRIVE-IN disclaimed), owned by the first registrant;<sup>2</sup> and
- Registration No. 4857483 for the standard character mark THE ORIGINAL MELS (with THE ORIGINAL disclaimed), and



- Registration No. 4857484 for the composite mark  (also with THE ORIGINAL disclaimed), owned by the second registrant;<sup>3</sup>

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<sup>1</sup> Application Serial No. 88914168 was filed on May 13, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and first use in commerce since at least as early as September 10, 1986. According to the application:

- (1) The name shown in the mark identifies Mel Lohn, a living individual, whose consent to register is made of record;
- (2) No claim is made to the exclusive right to use HOT DOGS, HOT DOG, or FEATURING REAL CHICAGO STYLE HOT DOGS apart from the mark as shown;
- (3) Color is not claimed as a feature of the mark; and
- (4) The mark consists of the large stylized wording “MEL’S” above a shaded oblong shape resembling a hot dog. The stylized wording “HOT DOGS” is superimposed over the oblong. In smaller stylized font below “HOT DOGS” within the oblong is the stylized wording “FEATURING REAL CHICAGO STYLE HOT DOGS”. Superimposed over the “S” in “MEL’S” is a caricature of a man with light hair and a dark mustache wearing a bow tie, seated on the bottom of the letter “S” with his arms resting on his knee, his legs crossed, and a hot dog coming out of both of his ears with a small sign placed on the left side of the hot dog that reads “HOT DOG”.

<sup>2</sup> Registration No. 4504623 issued April 1, 2014; Sections 8 & 15 combined declaration accepted and acknowledge.

<sup>3</sup> Registration Nos. 4857483 and 4857484 issued November 24, 2015.

on the Principal Register as to be likely to cause confusion, to cause mistake, or to deceive.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed and fully briefed. We affirm the refusal to register.

### I. Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all 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 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. See, e.g., *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

In any likelihood of confusion analysis, varying weights may be assigned to each *DuPont* factor depending on the evidence presented, see *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011), and *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993), but 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); *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at \*3 (TTAB 2020). The

Examining Attorney focuses on these two key factors as well as the channels of trade, while Applicant emphasizes equity under the thirteenth factor based, *inter alia*, on ownership of a prior registration for a “virtually identical” mark with which the cited registrations appear to have coexisted. 8 TTABVUE 10.<sup>4</sup>

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

The second *DuPont* factor “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,’” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir 2018) (quoting *DuPont*, 177 USPQ at 567), while the third *DuPont* factor considers “the similarity or dissimilarity of established, likely-to-continue trade channels.” *Id.* at 1052 (quoting *DuPont*, 177 USPQ at 567). *See also Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014). We begin with these *DuPont* factors.

There is no dispute that the services identified in the application and each cited registration are identical: “restaurant services.” Because the services are identical, we must presume that the channels of trade and classes of purchasers for these services are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). In addition, “[b]ecause the services at issue are ‘restaurant . . . services,’ the average customer is an ordinary consumer.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1747 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019).

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<sup>4</sup> Citations to the briefs in the appeal record refer to the TTABVUE docket system. Citations to the prosecution record refer to the .pdf version of the TSDR system. *See In re Integra Biosciences Corp.*, 2022 USPQ2d 93, \*7 (TTAB 2022).

The second and third *DuPont* factors weigh in favor of a likelihood of confusion.

B. Number and Nature of Similar Marks in Use for Similar Services

Applicant argues, based on various registrations, that “[b]ecause ‘MELS’ marks are commonly used in conjunction with food, slight but meaningful differences between such marks are sufficient to avoid any likelihood of confusion despite the similarity in marks and services.” 8 TTABVUE 15. In support of this argument, Applicant points to the three cited registrations, owned by two separate registrants, plus a fourth, live registration owned by a third party for the typed mark MEL-O-CREAM SECRET FORMULA DONUTS.<sup>5</sup> In addition, Applicant lists six “now cancelled” registrations, including its own “now cancelled” prior registration which we discuss in more detail below under the thirteenth *DuPont* factor. *See* 8 TTABVUE 16 (Applicant’s chart of MELS-formative registrations including six “now cancelled”).

The cancelled registrations are only evidence that the registrations issued, and are not evidence of use of the registered marks at any time. *See, e.g., Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1956 n.9 (TTAB 2014) (cancelled and expired registrations are not probative), *vacated and remanded on other grounds*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015); *Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“[A] canceled registration does not provide constructive notice of anything.”); *In re Info.*

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<sup>5</sup> Registration No. 2885138 for the typed mark MEL-O-CREAM SECRET FORMULA DONUTS identifies “restaurant services.” October 23, 2020 Response to Office Action, Exhibit L at TSDR 156-57. A typed mark is the legal equivalent of a standard character mark. *See In re Viterro*, 101 USPQ2d at 1909 n.2.

*Builders, Inc.*, 2020 USPQ2d 10444, at \*6 n.19 (TTAB 2020) (“A cancelled registration is only evidence that the registration issued and it does not carry any of the legal presumptions under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b.)”); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1264 (TTAB 2011) (“[D]ead’ or cancelled registrations have no probative previous value at all.”). Moreover, “[t]he existence of a cancelled registration—particularly one cancelled for failure to provide a declaration of continued use—does not tend to show that the cited mark is weak due to third-party use.” *In re Inn at St. John’s*, 126 USPQ2d at 1745.

The single live third-party registration is irrelevant on this point because it is “not evidence of third-party use of the registered mark[] in the marketplace, for purposes of the sixth [*DuPont*] factor.” *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009) (citing *Olde Tyme Foods Inc. v. Roundy’s Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992)); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009). *See also AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) (“The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.”). In addition, the MEL-portion of that MEL-O-CREAM SECRET FORMULA DONUTS mark conveys a commercial impression quite different than the MELS-portions of the cited marks and Applicant’s mark.<sup>6</sup>

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<sup>6</sup> As the Examining Attorney observes, “[t]o the extent that [A]pplicant is arguing the existence of a crowded field of ‘MEL’ trademarks, it is fairly clear that MEL-O-CREAM

In this case there is no evidence of third-party usage of any MELS-formative mark. As indicated just above, the “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.*, 177 USPQ at 269. Nonetheless, in our analysis of the degree of weakness, if any, in the shared MELS term, “we must ‘adequately account for the apparent force of [third-party use and registration] evidence,’ regardless of whether ‘specifics’ pertaining to the extent and impact of such use have been proven.” *In re Inn at St. John’s*, 126 USPQ2d at 1746 (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-5 (Fed. Cir. 2015)). “[E]xtensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation*, 115 USPQ2d at 1674). However, unlike cases in which extensive evidence of third-party registration and use of similar marks was found to be “powerful on its face” because “a considerable number of third parties[?] use [of] similar marks was shown,” *Juice Generation*, 115 USPQ2d at 1674, Applicant here has presented no evidence of third-party use, and at most, one third-party registration of diminished probative value (due to the different commercial impression created by the mark). When that is considered along with the marks of the two cited registrants, it is a far

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SECRET FORMULA DONUTS conveys a commercial impression of a donut flavor, which is altogether different from the commercial impression created by [A]pplicant’s mark and the three cited marks, wherein ‘MEL’S’ and ‘MELS’ connote a person’s name.” 10 TTABVUE 12.

cry from the large quantum of evidence of third-party use and third-party registration held to be significant in both *Jack Wolfskin*, 116 USPQ2d at 1136, and *Juice Generation*, 115 USPQ2d at 1674. In short, the record does not support narrowing the scope of protection for the term MELS in connection with restaurant services. Accordingly, the number and nature of similar marks in use for similar services is a neutral factor.

### C. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we consider “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. v. Veuve Cliquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Inn at St. John’s*, 126 USPQ2d at 1746 (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

When comparing Applicant’s mark to each of the Registrants’ marks, the proper test regarding similarity “is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks and citation omitted)). The proper focus is on the recollection of the average customer, who retains




a general rather than specific impression of trademark marks. *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at \*4 (TTAB 2020). Consumers may not necessarily encounter the marks in close proximity and must rely upon their recollections thereof over time. *In re Mucky Duck Mustard*, 6 USPQ2d 1467, 1468 (TTAB 1988). As mentioned above, “[b]ecause the services at issue are ‘restaurant . . . services,’ the average customer is an ordinary consumer.” *Inn at St. John’s*, 126 USPQ2d at 1747.

“[S]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)). Because the involved restaurant services are identical, “the degree of similarity between the marks necessary to support a determination that confusion is likely declines.” *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citing *Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); and *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)).

The marks must be considered in their entirety, *St. Julian Wine Co.*, 2020 USPQ2d 10595, at \*4-5, but “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.” *Detroit*

*Athletic Co.*, 128 USPQ2d at 1050 (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)).



Applicant's mark is . The first registrant's mark is MELS DRIVE-IN, in standard characters with DRIVE-IN disclaimed. The second registrant's marks are both THE ORIGINAL MELS, one in standard characters and one in the stylized

form with design as , each with THE ORIGINAL disclaimed.

Applicant argues that its inclusion of the wording HOT DOGS and FEATURING REAL CHICAGO STYLE HOT DOGS “in conjunction with [the] distinctive design [in its mark] is sufficient to differentiate [its] mark from the cited marks.” 8 TTABVUE 17. The Examining Attorney, on the other hand, argues that “Applicant’s mark and the registered marks are similar in overall commercial impression because they share the names ‘MEL’S’ and ‘MELS’” which “are phonetic equivalents,” “nearly identical,” and “the dominant elements” of the respective marks because the MELS “word portion” is “accorded greater weight” than the designs or any of the “the additional word[ing]” in each mark which is “all descriptive” and has “been disclaimed.” 10 TTABVUE 5-6.

In the case of a composite word-and-design mark such as Applicant’s mark in this appeal, “the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the [services].” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d

1181, 1184 (TTAB 2018) (citing *Viterra*, 101 USPQ2d at 1908). “The verbal portion of a word and design mark ‘likely will appear alone when used in text and will be spoken when requested by consumers.’” *Id.* (quoting *Viterra*, 101 USPQ2d at 1911). This “principle is especially important in cases involving restaurant services in view of the propensity of persons to try restaurants based on word-of-mouth recommendations.” *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987). “[R]estaurants are often recommended by word of mouth and referred to orally, [so] it is the word portion of applicant’s mark which is more likely to be impressed on the consumer’s memory.” *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (quoting *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983)).


The largest literal portion of Applicant’s mark is MEL’S, which is presented in the largest letters and is placed at the top of the mark. This MEL’S element dominates the mark not only due to its size and position, but also because the mark includes the caricature of a man which, along with the apostrophe in MEL’S, creates and reinforces the commercial impression of the mark as naming an individual.

Applicant has disclaimed all other wording in the mark in recognition of its descriptiveness, and disclaimed matter that is descriptive of or generic for a party’s services is typically less significant or less dominant when comparing marks. *See Detroit Athletic Co.*, 128 USPQ2d at 1050 (citing *Dixie Rests.*, 41 USPQ2d at 1533-34 (Fed. Cir. 1997)). Moreover, given “the penchant of consumers to shorten marks,” *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1961 (TTAB 2016) (citing *In re Abcor*

*Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring) (“the users of language have a universal habit of shortening full names--from haste or laziness or just economy of words”), and the descriptive nature of HOT DOGS and FEATURING REAL CHICAGO STYLE HOT DOGS, it is unlikely that consumers will rely on these word for purposes of distinguishing the marks. *See Aquitaine Wine USA*, 126 USPQ2d at 1188 (“consumers often have a propensity to shorten marks” when ordering goods or services orally); *Detroit Athletic Co.*, 128 USPQ2d at 1049 (“[N]on-source identifying nature of the words and the disclaimers thereof constitute rational reasons for giving those terms less weight in the analysis.”).

As Applicant states in the description of its mark, the shaded oblong carrier design at the bottom of Applicant’s mark resembles a hot dog. This simple design element is suggestive of hot dogs, and indeed it serves as a carrier for the term HOT DOGS which wording is descriptive of the services and has been disclaimed. Similarly, the oblong element is a carrier for the small wording FEATURING REAL CHICAGO STYLE HOT DOGS at the bottom of the mark, which is relatively quite small and also disclaimed. When viewed as a whole, the connotation of Applicant’s mark is of MEL’S restaurant which serves hotdogs.

We find the term MELS in each cited mark to be the dominant element. As with Applicant’s mark, all the other wording of the cited marks has been disclaimed because it is descriptive, and is therefore entitled to less weight when comparing the marks in their entireties. This is particularly evident in the second registrant’s special form mark which displays MELS in a large, stylized format and as the largest

literal element of that mark. The commercial impression of MELS DRIVE-IN, the first registrant's mark, is of MELS restaurant which offers drive-up service or the nostalgia of a former drive-in restaurant.<sup>7</sup> The commercial impression of THE ORIGINAL MELS and , the second registrant's marks, is similarly of MELS restaurant, but being the first or the original MELS.

Applicant makes no argument, and there is no evidence of record, to suggest that consumers would perceive MEL'S or MELS to engender a different meaning or commercial impression in the context of the identical "restaurant services" in the application and cited registrations. We further note that there are no restrictions to the identifications of services, and each restaurant may serve hot dogs. *See, e.g., In re Country Oven, Inc.*, 2019 USPQ2d 443903, at \*4 (TTAB 2019) (quoting *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) ("Where the identification of services is broad, the Board 'presume[s] that the services encompass all services of the type identified.'")). Indeed, the record demonstrates that the first registrant "serv[es] up traditional American comfort food . . . [including] hot dogs, fries, . . . and the like," November 27, 2020 Office Action at TSDR 15 (baycityguide.com), and the second registrant's menu includes two hot dogs (i.e., a "Meldog" described as a "100% all-beef hot dog," and a "chili-cheese dog" described as

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<sup>7</sup> Applicant made of record a definition of "drive-in" from merriam-webster.com showing one meaning as "a restaurant at which people are served in their cars" and indicating that the first known use of "drive-in" was in 1937. *See* October 23, 2020 Response to Office Action at TSDR 30.

“Mels hot dog with chopped onions and melted cheese.”). *Id.* at TSDR 27 (originalmels.com).

The dominant MEL’S literal element of Applicant’s mark will be pronounced the same as the dominant MELS literal element of each cited mark. The apostrophe in Applicant’s mark does not alter the appearance or sound of MELS in any meaningful manner. *See Pinocchio’s Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1228 (TTAB 1989) (“the marks [PINOCCHIOS and PINOCCHIO’S] are virtually identical, the only difference being the insignificant inclusion of an apostrophe”).

As to appearance and stylization, two of the cited marks are standard character marks which means they may be displayed in any font style, color, and size, including the identical stylization of Applicant’s mark, because the rights reside in the wording and not in any particular display or rendition. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (“[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a difference cannot legally be asserted by that party.”). Thus, we must consider the registrants’ standard character marks “regardless of font style, size, or color” *Citigroup v. Capital City Bank*, 98 USPQ2d at 1259, including iterations displaying the mark in the same or similar font, size, or possible color as the term MEL’S appears in Applicant’s composite mark. *Aquitaine Wine USA*, 126 USPQ2d at 1186-87.

We acknowledge the different stylization of MELS in the second registrant’s special form mark, but as discussed above MELS is the dominant element of that

mark, just as MEL'S is the dominant element of Applicant's mark. In addition, that registrant's mark contains a shaded, oblong carrier for relatively smaller wording, as does Applicant's mark – another point of similarity.

It is clear that Applicant's mark includes elements not present in either of the other registrants' marks. We recognize the differences between Applicant's mark and the respective registrants' marks. Nonetheless, viewing each mark as a whole, the points of distinction do not significantly diminish the strong similarities in connotation and overall commercial impression engendered by the marks for identical services. We find that Applicant's composite mark is more similar than dissimilar to each of the registrants' marks in terms of sound, connotation, and commercial impression. As a result, we find ordinary consumers may reasonably assume, due to presence of the dominant term MEL'S in Applicant's mark which is highly similar to the dominant term MELS in each of the registrants' marks, Applicant's restaurant services offered under its mark emanate from the same source as the identical services in the cited registrations. Thus, consumers encountering Applicant's mark could mistakenly believe that it is a variation on the registered marks used to identify restaurants, but nonetheless emanating from a common source. *See Bay State Brewing Co.*, 117 USPQ2d at 1961. For these reasons, we find that Applicant's mark is similar to each of the cited marks. The first *DuPont* factor thus also weighs in favor of finding a likelihood of confusion.

D. Other Established Facts Probative of the Effect of Use

The thirteenth *DuPont* factor relates to “[a]ny other established fact probative of the effect of use.” *DuPont*, 177 USPQ at 567. It is a “catchall” factor, *Country Oven*, 2019 USPQ2d 443903, at \*15, which “accommodates the need for flexibility in assessing each unique set of facts . . . .” *Id.* (quoting *In re Strategic Partners Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012)). “This includes a variety of circumstances, such as the coexistence of an applicant’s prior-registered mark with the cited registration. Where an applicant owns a prior registration and the mark is ‘substantially the same’ as in the applied-for application, this can weigh against finding that there is a likelihood of confusion.” *Id.* (citing *Inn at St. John’s*, 126 USPQ2d at 1748 (internal citation omitted)). Applicant relies heavily on the thirteenth factor, arguing that its current situation “is even more compelling than that in . . . *Strategic Partners*.” 8 TTABVUE 12. Applicant’s arguments are fact intensive, and, while we have considered all of the subtleties presented by the record, we summarize the main points below.

1. Applicant’s Prior Registration

Applicant was the owner of prior Registration No. 1680680 for the mark



for “restaurant services” which registered on March 24, 1992, and

which was renewed once for a term of ten years (i.e., until March 24, 2012). *See* October 23, 2020 Response to Office Action at TSDR 19-20 (TSDR printout of the former registration). *See also* 15 U.S.C. §§ 1058 and 1059. Applicant contends that



“due to an oversight, Applicant failed to file the necessary papers to maintain its [p]rior [registration], which the PTO cancelled on January 29, 2016.” 8 TTABVUE 9.

Applicant argues that its prior registration “coexisted with the First Cited Mark (the MELS DRIVE-IN word mark) . . . from April 1, 2014, through January 29, 2016,” and also “coexisted . . . with the Second Cited Mark (THE ORIGINAL MELS) and Third Cited Mark (MELS THE ORIGINAL [sic] with design) from November 24, 2015[,] through January 29, 2016, when the Prior Registration went abandoned.” 8 TTABVUE 11. Central to this aspect of Applicant’s argument is the apparent January 2016 cancellation date of its prior registration which followed the April 2014 and November 2015 registration dates of the cited registrations.<sup>8</sup> Although the Office did not take the ministerial act of updating its computerized records to list Applicant’s prior registration as “cancelled” until January 29, 2016, the prior registration expired by operation of law on March 24, 2012, because Applicant neither renewed it nor filed an affidavit of use beyond the first ten-year renewal term. *See Land O’ Lakes, Inc. v. Hugunin*, 88 USPQ2d 1957, 1959 (TTAB 2008) (“[T]he date of expiration of [a] registration is not dependent on the date the Office took the ministerial function of entering the cancellation into the USPTO database.”). In view thereof, the cited registrations never technically coexisted with Applicant’s prior registration; but, even if it could be said that there was coexistence on the register, it was for relatively short periods.

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<sup>8</sup> As noted above, Registration No. 4504623 issued April 1, 2014, and Registration Nos. 4857483 and 4857484 issued November 24, 2015.

In *Strategic Partners*, the appellant owned a registered mark that had coexisted with the cited mark for over five years. Because the appellant's prior registration was over five years old, it was not subject to challenge by the owner of the cited registration based on a claim of likelihood of confusion. 102 USPQ2d at 1399. In finding no likelihood of confusion in *Strategic Partners*, the Board provided the following explanation:

[T]he present case involves the unique situation presented by the coexistence of applicant's existing registration with the cited registration for over five years, when applicant's applied-for mark is substantially similar to its existing registered mark, both for identical goods. When we consider these facts under the thirteenth *du Pont* factor, we find in this case that this factor outweighs the others and leads us to conclude that confusion is unlikely.

102 USPQ2d at 1400.

The current appeal is substantively different from *Strategic Partners* because the overlap of conflicting registrations was nonexistent (or far less than five years), and Applicant's prior registration is no longer in existence. In view thereof, the "unique situation" presented in *Strategic Partners* is not present in this appeal.

## 2. The First Cited Registration

Applicant argues that during examination of the application underlying the first cited registration (i.e., Registration No. 4504623 for MELS DRIVE-IN), the first registrant itself employed an argument under *Strategic Partners* to successfully overcome a § 2(d) refusal based on Applicant's prior registration and a separate third-party registration. In that instance, the first registrant argued that it was the owner of an existing registration for a stylized version of its mark, and that the two cited

registrations (one being Applicant's prior registration) both issued after and had coexisted for over five years with the first registrant's stylized mark registration. See October 23, 2020 Response to Office Action at TSDR 34 (first registrant's argument) and TSDR 158-60 (first registrant's stylized registration, now cancelled).

Based on the first registrant's arguments – which were made in 2013, under different circumstances – that its then-live stylized mark registration had coexisted with Applicant's prior registration for over five years, Applicant contends “[w]hat is good for the goose should certainly be good for the gander.” 8 TTABVUE 13. But, as explained above, Applicant is not entitled to rely on *Strategic Partners* because the unique situation presented in that case is not present in this appeal. To the extent that Applicant is essentially asserting that the first registrant's position in its application for registration serves as file wrapper estoppel, see *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 958 (TTAB 1986) (file wrapper estoppel is the principle that a party “is bound by statements it made during the prosecution of its application”), that doctrine is not applicable in trademark cases, nor is the first registrant's earlier position an admission against interest. See *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 153-54 (CCPA 1978) (finding that a likelihood of confusion argument made in support of an application for registration is a legal conclusion, and therefore, cannot constitute an admission because only facts may be admitted); *Calypso Tech. Inc. v. Calypso Cap. Mgmt. LP*, 100 USPQ2d 1213, 1233 (TTAB 2011) (recognizing that a party's position in a prior proceeding “is not an admission, but may be considered only as illuminative of shade

and tone in the total picture”); *Anthony’s Pizza & Pasta Int’l Inc. v. Anthony’s Pizza Holding Co.*, 95 USPQ 1271, 1281 (TTAB 2009), *aff’d*, 415 F. App’x 222 (Fed. Cir. 2010) (“The doctrine of ‘file wrapper estoppel’ does not apply in trademark cases” nor does a party’s position in a prior proceeding “rise to the level of an admission against interest.”). *Cf. Taffy’s of Cleveland, Inc. v. Taffy’s, Inc.*, 189 USPQ 154, 156 (TTAB 1975) (fact that petitioner argued before examining attorney that its mark and that of respondent were not confusingly similar does not preclude petitioner from asserting likelihood of confusion as ground for cancellation).

### 3. The Second and Third Cited Registrations

Applicant argues that the disposition here should be consistent with the examination of the applications underlying the second and third registrations (i.e., Registration Nos. 4857483 and 4857484 for THE ORIGINAL MELS standard character and special form marks, respectively), in which the second registrant attempted to overcome a § 2(d) refusal (based on the same third-party registration that had been cited against the first registrant) by arguing that “MEL’S is used by many in conjunction with food” and was therefore “weak.” 8 TTABVUE 7 (citing the second registrant’s argument which was attached to the October 23, 2020 Response to Office Action at TSDR 69). Applicant also argues that when the first registrant’s registration was cited as bar under § 2(d) against the second registrant’s applications, the second registrant submitted a consent agreement signed by both the first and second registrants to demonstrate the registrants’ belief that they could operate in geographically close markets without a likelihood of confusion. 8 TTABVUE 8.

Again, Applicant overstates the effect of arguments made during examination of underlying applications. The second registrant's arguments and actions were made in 2014 under different circumstances, with two circumstances of particular note. First, the examining attorney found the weakness argument "unpersuasive" and maintained the refusal based on the third-party registration, October 23, 2020 Response to Office Action at TSDR 111 and 121, but then the third-party registration expired during the pendency of the applications and was no longer a barrier to registration. *Id.* at TSDR 134, 138; 146, 150. Second, the first and second registrants had executed a consent and coexistence agreement in 1989 which was still in effect and submitted in favor of registration. *Id.* at TSDR 141-43, 153-55.

Consent agreements are given "substantial weight" by examining attorneys. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1207.01(d)(viii) (July 2021). *See also In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071, 1072 (Fed. Cir. 1993) (consent agreements should carry great weight in the likelihood of confusion analysis); *DuPont*, 177 USPQ at 568 ("[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't"). In the present appeal, Applicant did not submit a consent agreement.

#### 4. Applicant's Prior Application

Applicant contends that it filed application Serial No. 88637519 pro se on October 1, 2020, for the same mark as the current application but mistakenly identified "hot

dog sandwiches” as the goods instead of restaurant services,<sup>9</sup> and argues that the examining attorney therefor did not cite any of the three now-cited registrations against that earlier application. 8 TTABVUE 9. *See* May 24, 2021 Request for Reconsideration at TSDR 8-9 (TSDR print out of application), 10-14 (Office action). Applicant states that it “had no choice but to let [that application] abandon” because it could not provide an appropriate specimen since it “had not used the . . . mark for ‘[h]ot dog sandwiches,’ as opposed to ‘[r]estaurant services.’” 8 TTABVUE 9.

There is a difference between “hot dog sandwiches” and unrestricted “restaurant services.” Applicant may consider this a subtle difference, but we are compelled to note that “[e]ach case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonic’s Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

#### 5. Summary on this Factor

Applicant’s prior registration expired by operation of law on March 24, 2012, the Office updated its computerized records to list Applicant’s prior registration as “cancelled” on January 29, 2016, and the current application was not filed until May 13, 2020. While we are sympathetic to Applicant’s argument that “[u]nfortunately, due to an oversight, Applicant failed to file the necessary papers to maintain its” prior registration, 8 TTABVUE 9, we must nonetheless consider the cited registrations which issued in the time following the expiration of the prior registration.

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<sup>9</sup> Applicant mistakenly and repeatedly refers to application Serial No. 88637519 by the serial number for the current application. *See* 8 TTABVUE 9-10. We understand this to be a repeated typographical error and so consider the arguments as they are intended.

The thirteenth *DuPont* “factor is highly fact specific and it is under very specific circumstances that this factor may matter.” *Country Oven*, 2019 USPQ2d 443903, at \*18. While the circumstances Applicant has presented and argued are relevant considerations, the thirteenth *DuPont* factor is neutral in our analysis of the likelihood of confusion.

#### E. Conclusion

The restaurant services are identical, and the channels of trade and classes of purchasers are presumed to be the same. The purchasers are ordinary consumers. The record does not support narrowing the scope of protection for the term MELS or MEL’S in connection with restaurant services. While the marks contain obvious differences, Applicant’s mark is more similar than dissimilar to each of the registrants’ marks in terms of sound, connotation, and commercial impression. The thirteenth *DuPont* factor does not outweigh the other factors. On balance, we find that confusion is likely.

#### II. Decision

The refusal to register Applicant’s mark



is affirmed.