

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

BUO

Mailed: June 10, 2014

Opposition No. 91208911

Fox Rest. Concepts LLC

v.

Sunshine C & C, Inc.

Before Quinn, Ritchie and Adlin, Administrative Trademark Judges.

By the Board:

Sunshine C & C, Inc. (“applicant”) seeks registration of the mark ZEN BURGER, in standard character format and with BURGER disclaimed, for “veggie burger patties,” in International Class 29, and “restaurant and hotel services,” in International Class 43.¹ Fox Restaurant Concepts LLC (“opposer”) alleges prior use and registration of the marks:

The logo for Zinburger features the word 'Zinburger' in a stylized, red, serif font. The letter 'Z' is significantly larger and more prominent than the other letters. Below the main text, the words 'Wine & Burger Bar' are written in a smaller, black, sans-serif font. A vertical line is positioned to the left of the word 'Zinburger'.²
Wine & Burger Bar

¹ Application Serial No. 85677047, filed July 13, 2012, alleging applicant’s intent to use the mark in commerce under Trademark Act Section 1(b).

² Registration No. 3578742, issued February 24, 2009, from an application filed December 19, 2007. The registration includes a disclaimer of the term “WINE & BURGER BAR.”



and ZINBURGER, in standard character format,⁴ (“ZINBURGER marks”) for “hamburger sandwiches,” in International Class 30, “wine bar services and cafe services featuring sit down service of gourmet burgers made with meat,” and “full service restaurant services featuring sit down service of wine and gourmet burgers made with meat,” in International Class 43; and opposes registration on the ground that use of applicant’s mark would be likely to cause confusion with opposer’s marks under Trademark Act § 2(d), 15 U.S.C. 1052(d). Notice of Opposition, ¶¶ 3, 23, 26 and 32. Applicant denies the salient allegations in the notice of opposition. Opposer filed a motion for summary judgment on its likelihood of confusion claim on January 4, 2014, which applicant contests.

Opposer’s motion appears to have been precipitated by applicant’s failure to respond to opposer’s three sets of requests for admission. Opposer alleges that applicant’s failure to respond to requests for admission concerning, *inter alia*, (i) the similarity of the marks (RFA No. 54), (ii) instances of actual confusion (RFA No. 56), and (iii) relatedness of the goods and services (RFA

³ Registration No. 3582319, issued March 3, 2009, from an application filed December 19, 2007. The registration includes a disclaimer of the term “WINE & BURGER BAR.”

⁴ Registration Nos. 3620050, issued May 12, 2009, from an application filed August 9, 2007; and 4098996, issued February 14, 2012, from an application filed July 5, 2011.

Nos. 33-39), creates binding admissions that establish opposer's likelihood of confusion claim. Opposer also asserts that in any event, the parties' marks are "[a]udibly and visually ... virtually identical," and that "there is no genuine issue of material fact that the goods and services offered or to be offered under the parties marks are identical." Opposer's Brief, pp.7 and 9.

Applicant argues in response that the mark "Zinburger with its logos pairing animals and a sophisticated glass evoke immediate reference to enjoyment of Zinfandel (or other) wine with an assortment of choices of accompanying burger," while the mark "Zen Burger with its logo of an appealing burger, bun and vegetables speaks to a clientele appreciating an Asian approach focusing on vegetarian food."⁵ Applicant's Response, p.3.

Motion for Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). In deciding motions for summary judgment, the Board must follow the well-established principles that, in considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes are present. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766,

⁵ Inasmuch as the design elements mentioned by applicant in its response brief are not present in the drawing of the mark as it appears in the application, they will not be considered in this proceeding.

25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The burden is on the party moving for summary judgment to demonstrate the absence of any genuine dispute of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). The burden of the nonmovant to respond arises only if the summary judgment motion is properly supported. *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 160-161 (1970). If the evidence produced in support of the summary judgment motion does not meet this burden, “summary judgment must be denied even if no opposing evidentiary matter is presented.” *Id.* (quoting Fed. R. Civ. P. 56 advisory committee notes to the 1963 amendments).

Standing and Priority

Opposer has alleged ownership of U.S. Registration Nos. 3578742, 3582319, 3620050, and 4098996. Notice of Opposition, ¶ 3. Opposer attached “soft” copies of its registration certificates as exhibits to its motion for summary judgment, however, as discussed further below, these soft copies do not properly introduce these registrations. However, if these registrations are properly introduced at trial, they will establish opposer’s standing, i.e. a personal interest in this proceeding, and remove priority as an issue. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed.

Cir. 2000); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Section 2(d) Likelihood of Confusion

In order to establish a reasonable belief of damage where likelihood of confusion has been alleged, opposer must assert proprietary rights and current ownership of a mark that is the same or similar to the applied for mark. *See Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002).

1. Priority

Because opposer has pleaded ownership of its registrations, and in the absence of a counterclaim for cancellation, opposer need not plead (or prove) its priority of use of its pleaded marks as used on the goods and services recited in its registrations. However, as previously stated, at trial opposer must properly make of record acceptable status and title copies of the pleaded registrations. *See Trademark Rule 2.122(d)(1)*;

2. Likelihood of Confusion

Opposer's evidence consists of the soft copies of the registration certificates for its pleaded registrations, screenshots of webpages from its website, including a menu of items served at its cafés and restaurants, copies of consumer reviews from a review website, an Internet article discussing hamburgers, a real estate listing from the Tucson area that mentions opposer's restaurant, Internet posts from the Tucson area referring to ZEN

BURGER, purportedly showing actual confusion among consumers, accompanied by the declaration of David M. Andersen, opposer's counsel, which includes exhibits comprising opposer's Second Set of Interrogatories and Requests for Admission, email communication between counsel for the parties and between opposer's counsel and applicant following the withdrawal of applicant's counsel, and opposer's Third Set of Requests for Admission.

Opposer's motion for summary judgment primarily is based on applicant's failure to respond to opposer's requests for admission, under Fed. R. Civ. P. 36. It is settled that a requested admission is deemed admitted unless a written answer or objection is provided to the requesting party within thirty days after service of the request, or within such time as the parties agree in writing. In order to avoid admissions resulting from a failure to timely respond, a responding party may pursue two separate avenues for relief: a party may either (1) move to reopen its time to respond to the admission requests because its failure to timely respond was the result of excusable neglect under Fed. R. Civ. P. 6(b)(2), or (2) move to withdraw and amend its admissions pursuant to Fed. R. Civ. P. 36(b).

Applicant has not formally availed itself of either of these avenues for relief. Indeed, applicant offers no explanation whatsoever for its failure to respond to opposer's requests for admission, instead arguing the merits of the case. However, in light of the Board's preference to decide cases on the

merits, the Board construes applicant's denials regarding the similarity of the connotation and appearance of the marks as an implicit motion to withdraw its admissions under Fed. R. Civ. P. 36(b). Under that rule the Board may permit withdrawal or amendment of admissions where presentation of the merits of the action would be promoted and the party who obtained the admissions fails to satisfy the Board that withdrawal or amendment would prejudice that party in maintaining its action or defense on the merits. *See* Fed. R. Civ. P. 36(b); *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1308 (TTAB 2007); *Hobie Designs, Inc. v. Fred Hayman Beverly Hills, Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990). The type of prejudice envisioned by this rule is the loss of witnesses or evidence, not merely that opposer would now have to prove its case, which opposer was presumably prepared to do prior to this impasse. *See Giersch*, 85 USPQ2d at 1309. Opposer has shown no such prejudice. A review of the cited requests for admission reveals that should the Board allow the admissions to stand as admitted by applicant's failure to timely respond, the merits of the case would be subverted. Although applicant would be deemed to have admitted such conclusory factual issues as the similarity of its applied-for mark with opposer's pleaded marks and the relatedness of the goods and services provided in connection with those marks, the admissions would also cover the ultimate legal conclusion of a likelihood of confusion. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160

(Fed. Cir. 2014) (“Likelihood of confusion is a question of law with underlying factual findings made pursuant to the *DuPont* factors”). Applicant’s response to the motion for summary judgment makes clear that some of these issues are disputed. Therefore, presentation of the merits of the case would not be served by allowing these admissions to stand. *See Johnston Pump/General Valve Inc. v. Chromalloy Am. Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989).

Further, opposer did not advance any allegation of prejudice in maintaining its action on the merits that would arise if the Board withdrew the admissions, nor does the record reveal any such prejudice. *See Giersch*, 85 USPQ2d at 1308-1309; *Hobie Designs*, 14 USPQ2d at 2065 (amendment permitted where the requested admissions were conclusory and would not advance the presentation of the merits of action).

Accordingly, applicant’s motion to withdraw its admissions is **GRANTED**. However, applicant is ordered to serve complete responses to all three sets of requests for admission within **THIRTY DAYS** of the mailing date of this order. Should applicant fail to respond to the requests within the allowed time, the Board may reconsider the motion for summary judgment in light of the deemed admissions, or a motion for sanctions based upon applicant’s failure to comply with an order of the Board. *See* Trademark Rule 2.120(g); Fed. R. Civ. P. 37(b).

Based on the standards for summary judgment, as set forth above, and the withdrawal of applicant’s admissions we find that opposer has failed to

demonstrate the absence of genuine disputes of material fact. In particular, we find that a genuine dispute of material fact exists at least as to the similarity of connotation between opposer's marks and applicant's mark.

Additionally, priority remains an issue in this proceeding. Opposer attached "soft" copies of the certificates of its pleaded registrations as exhibits to its motion for summary judgment. However, these certificates, showing the registrations as of the date of issue of the certificates, are not sufficient to evidence the *current* status of and title to the registrations. *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (photocopy of registration without status and title information insufficient). The issue date of a registration certificate filed with a complaint must be reasonably contemporaneous with the filing date of the complaint in order to evidence status and title. *See Hard Rock Café Int'l (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1511 (TTAB 2000) (status and title copies prepared three years prior to opposition not reasonably contemporaneous).

In order for opposer to rely on its pleaded registrations, opposer must establish current status and title, which can be done by amending its notice of opposition and attaching thereto current printouts of information from the electronic database records of the Office such as (a) printouts from TSDR (Trademark Status and Document Retrieval), or (b) printouts from TESS (Trademark Electronic Search System), along with a copy of any records from the Assignment database showing an assignment, if any, to the current

owner of the registration. *See* Trademark Rule 2.122(d); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009). *See also* TBMP § 704.03(b)(1)(A) (3d ed. rev.2 2013) and authorities cited therein. Alternatively, opposer may establish the status and title of its pleaded registrations through testimony.

In view thereof, opposer has failed to meet its initial burden and the motion for summary judgment on its Section 2(d) claim is **DENIED**.⁶

Pro Se Information

Applicant is again strongly encouraged to seek experienced trademark counsel for representation in this proceeding. **Nonetheless, strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, and adherence to the dates set forth in the Board's orders, is expected of all parties before the Board, whether or not they are represented by counsel.**

Applicant is expected to fully comply with the deadlines set by this order; as

⁶ The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *Am. Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

Furthermore, the fact that we have identified only certain genuine disputes as to material facts should not be construed as a finding that these are necessarily the only disputes which remain for trial.

indicated below, failure to do so could result in the entry of judgment against applicant.⁷

Accelerated Case Resolution

We note that the relevant facts of this proceeding are uncomplicated and that the parties are well-acquainted with them. Accordingly, the parties may wish to stipulate to resolution of this proceeding by means of the Board's accelerated case resolution ("ACR") procedure. They may do so through summary judgment-type briefs accompanied by evidence, perhaps incorporating the record for this motion, with or without supplementation. *See e.g., Freeman v. Nat'l Ass'n of Realtors*, 64 USPQ2d 1700 (TTAB 2002) (parties agreed that evidence and arguments submitted with petitioner's motion for summary judgment and respondent's response could be treated as the final record and briefs). *See also* TBMP § 528.05(a)(2) and authorities cited therein. In the event the parties agree to ACR, they will need to stipulate that the Board may resolve any genuine disputes of material fact the Board may find to exist. *See* TBMP § 702.04 for more information.

The parties are therefore encouraged to jointly contact the assigned Board interlocutory attorney responsible for this proceeding by telephone to discuss the possibility of ACR, any necessary stipulations and an agreed upon schedule for proceeding under ACR.

⁷ If counsel is retained by applicant an appearance should promptly be filed with the Board, indicating the new correspondence information for applicant's retained counsel.

If the parties determine not to proceed via ACR the proceeding will continue on the schedule as set below.

Schedule

Proceedings are resumed, and disclosure and trial dates are reset as follows:

Plaintiff's Pretrial Disclosures	6/15/2014
Plaintiff's 30-day Trial Period Ends	7/30/2014
Defendant's Pretrial Disclosures	8/14/2014
Defendant's 30-day Trial Period Ends	9/28/2014
Plaintiff's Rebuttal Disclosures	10/13/2014
Plaintiff's 15-day Rebuttal Period Ends	11/12/2014

In each instance, a copy of the transcript of any testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of taking of that testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.