

This Opinion is not a
Precedent of the TTAB

Mailed: September 26, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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CB Specialists, Inc.

v.

Central Avenue Deli, LLC d/b/a Lucky Dill Deli

—
Opposition No. 91212366
to Application Serial No. 85716289
—

Zachary D. Messa of Johnson, Pope, Bokor, Ruppel & Burns LLP,
for Opposer, CB Specialists, Inc.

Brittany J. Maxey and William R. Brees of Maxey Law Offices, PLLC,
for Applicant, Central Avenue Deli, LLC d/b/a Lucky Dill Deli.

—
Before Bergsman, Kuczma and Heasley,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

In defense of this Opposition filed under Section 2(d) of the Trademark Act, Central Avenue Deli, LLC d/b/a Lucky Dill Deli (“Applicant”) asserts that CB Specialists, Inc. (“Opposer”) abandoned its pleaded marks through naked licensing. This assertion flows from the fact that the son of Opposer’s principal established and subsequently sold three restaurants offering essentially the same services as

Opposer, under variants of Opposer's marks, without any formal licensing arrangements with Opposer or with those who purchased the businesses. Related to its abandonment defense, Applicant, an ultimate purchaser of one of the son's businesses, maintains that the operation of four restaurants by different entities within 30 miles of one another means that Opposer's marks lost their capacity to function as trademarks; and that the mark as used in the son's business later purchased by Applicant, and appurtenant goodwill, were conveyed to Applicant's predecessor and eventually were conveyed to Applicant. As set forth below, we find that Opposer's marks have not been abandoned and have not lost their source-identifying function, and that registration of Applicant's mark would result in a likelihood of confusion.

I. Pleadings

Opposer opposes registration on the Principal Register of Applicant's mark shown below:



for: Food kiosk services in International Class 35; and,
Delicatessen and restaurant services; take-out restaurant services; catering services in International Class 43.¹

¹ Application Serial No. 85716289 was filed on August 29, 2012, based upon Applicant's claim of first use anywhere and first use in commerce for the services in International Class 35 since at least as early as December 31, 2009; and claim of first use anywhere and first use in commerce for the services in International Class 43 at least as early as August 23, 2009. As

As grounds for opposition, Opposer alleges prior use of LUCKY DILL and THE LUCKY DILL for restaurant services, as well as ownership of pending Application Serial No. 85937930 for THE LUCKY DILL (in standard characters) for “Restaurant services, including sit-down services of food and take-out restaurant services,” in International Class 43.²



Opposer opposes registration of Applicant’s mark  on its asserted priority and the ground of likelihood of confusion under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), alleging that Applicant’s mark, when used in connection with Applicant’s identified services, so resembles Opposer’s earlier-used marks, as to be likely to cause confusion, mistake or deception in violation of § 2(d) of the Trademark Act.

Aside from admitting that Opposer filed its pleaded trademark Application Serial No. 85937930, Applicant denies the allegations in the Notice of Opposition. Applicant

set forth in more detail below, Applicant has moved to amend the asserted dates of use. The mark is described in the application as consisting of the words “LUCKY DILL” in a fanciful font, wherein said words “LUCKY DILL” further appear in shadow boxes. Below said words “LUCKY DILL” appear the words “DINING. CATERING. NEW YORK STYLE.” in another fanciful font, said words “DINING. CATERING. NEW YORK STYLE.” appearing in front of a stylized silhouette of the New York City skyline. Applicant has disclaimed the exclusive right to use “DINING. CATERING. NEW YORK STYLE.”

² Application No. 85937930 was filed by Opposer on May 21, 2013, based upon Opposer’s claim of first use anywhere and first use in commerce in International Class 43 at least as early as March 1, 2000. Notice of Opposition, Exhibit 2; Answer to Notice of Opposition, paragraph No. 2.

also pleaded several affirmative defenses, proceeding to trial solely on its abandonment defense.³

II. Preliminary Matters

Before addressing the merits, we address Applicant's Motion to Amend the Dates of First Use of the Mark. Applicant seeks to amend the dates of first use and first use in commerce in its application to the later dates of December 21, 2010, for the services in International Class 35, and to June 23, 2010, for the services in International Class 43. Both of these dates are prior to the August 29, 2012 filing date of Applicant's application. These amended dates are acceptable as they are supported by the testimony of Applicant's owner.⁴ They are different from the dates set forth in its application, which Applicant has admitted are not the correct dates of first use, but are prior to the filing date of Applicant's application. Therefore, Applicant's Motion is granted.

³ While Applicant alleged other affirmative defenses including waiver, acquiescence, estoppel and unclean hands, because Applicant did not pursue any of its other affirmative defenses, either through presentation of evidence at trial or in its brief, those defenses are waived. *Research in Motion Ltd. v. Defining Presence Mktg. Grp. Inc.*, 102 USPQ2d 1187, 1189-90 (TTAB 2012); *Swiss Watch Int'l Inc. v. Fed'n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1734 n.4 (TTAB 2012).

⁴ The corrected dates of use are supported by the testimony of Kenneth O'Bannon at Kenneth O'Bannon Discovery Dep. p. 82:2-14; 84:8-88:18, Exhibits 12-14 (23 TTABVUE 83, 85-89, 317, 347-356, 357).

The citations to "TTABVUE" throughout the decision are to the Board's public online database that contains the proceeding file, available on the USPTO website, www.uspto.gov. The first number represents the prosecution history number listed in the electronic case file and the second represents the page number(s).

III. The Record

By rule, the record includes Applicant's involved application file. Trademark Rule 2.122(b), 37 C.F.R. 2.122(b). The pleadings are also automatically of record.

The evidence submitted into the record by Opposer consists of the testimony depositions of Opposer's witnesses, Kimberly Mitow and Jason Mitow, and the exhibits thereto, and the discovery deposition testimony of Applicant's witness, Kenneth O'Bannon,⁵ and the exhibits thereto.

Additionally, Applicant has submitted copies of publications and government records via a Notice of Reliance.

In this decision, we will endeavor to discuss confidential testimony and evidence submitted by the parties only in general terms

IV. Standing

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. To establish standing in an opposition, an opposer must show both a real interest in the proceeding as well as a reasonable belief of damage. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

⁵ The parties have stipulated that the discovery deposition of Mr. Kenneth O'Bannon taken on November 14, 2014, as a 30(b)(6) witness for Applicant and the exhibits thereto be admitted as testimony. The parties retained the right to substantively object to Mr. O'Bannon's deposition. See Stipulation to Admit 30(B)(6) Discovery Deposition of Central Avenue Deli, LLC as Testimony Evidence (15 TTABVUE).

At the time of filing the Notice of Opposition, Opposer has established that it had been using the marks THE LUCKY DILL and LUCKY DILL DELI for restaurant services for many years, and that Opposer and Applicant are competitors in the restaurant marketplace in the greater St. Petersburg/Tampa Bay, Florida area. Opposer is therefore not a mere intermeddler. Moreover, Opposer's application to register the mark THE LUCKY DILL has been suspended based on Applicant's prior-filed application. Accordingly, Opposer has a real interest in this proceeding and a reasonable basis for its belief that it will be damaged by registration of Applicant's LUCKY DILL DINING. CATERING. NEW YORK STYLE. and Design mark. *Ritchie v. Simpson*, 50 USPQ2d at 1025; *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 USPQ at 189; *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2008 (TTAB 2015). Accordingly, Opposer has established its standing to bring this opposition proceeding.

V. Background

A. Opposer's Use of the Name "Lucky Dill"

Over the years, Opposer and its predecessors in interest, including members of the Mitow family, have owned, operated and sold various restaurants named, in whole or in part, "Lucky Dill," consisting of a restaurant, bar, bakery and catering services. The first "Lucky Dill" restaurant owned by the Mitow family opened in 1991. After about a year of operation, Kimberly Mitow assumed responsibility for the operation of the restaurant, which was founded by her former husband, Alexander

Mitow. She has managed all aspects of the restaurant ever since.⁶ The first Lucky Dill restaurant opened at 35236 U.S. 19 North, Palm Harbor, Florida (“First Location”), had 1,000 square feet and seated about 75 customers.⁷ This restaurant was a New York style deli serving sandwiches, including corned beef, pastrami, turkey and roast beef.⁸

“Lucky Dill” was displayed on signage and on the menu of the First Location as shown below:



From Menu-1991



First Location Storefront⁹

Opposer advertised its restaurant in newspapers, flyers, coupon books and radio ads in Tampa, Florida and throughout Pinellas, Pasco, Hernando, and Hillsborough counties in Florida. Its advertising stressed New York deli style food and prominently bore the restaurant’s name “Lucky Dill” or “Lucky Dill Deli”¹⁰ accompanied by a silhouette of the New York City skyline, as shown below in the upper right corner:

⁶ Kimberly Mitow Testimony Dep. pp. 5:23-25, 6:4-6, 11:21-12:15 (18 TTABVUE 6-7, 12-13); Jason Mitow Testimony Dep. p. 4:19-25 (22 TTABVUE 5).

⁷ Kimberly Mitow Testimony Dep. p. 6:7-15 (18 TTABVUE 7); Jason Mitow Testimony Dep. p. 5:3-17 (22 TTABVUE 6).

⁸ Kimberly Mitow Testimony Dep. p. 7:1-6 (18 TTABVUE 8).

⁹ Menu: Kimberly Mitow Testimony Dep. pp. 31:17-32:3, Ex. 1 Bates No. 27 (18 TTABVUE 32-33, 145); First Location Storefront: Kimberly Mitow Testimony Dep. Exhibit 1 Bates No. 19 (18 TTABVUE 139).

¹⁰ Kimberly Mitow Testimony Dep. p. 24: 7-23 (18 TTABVUE 25).



Advertisement for First Location¹¹

Over the years, Kimberly Mitow's son, Jason Mitow, helped with the restaurant, performing a variety of tasks including washing dishes, cleaning, bussing, helping servers, hosting, operating the cash register and cooking.¹²

Outgrowing its First Location, Opposer moved to a second location in 2000 that had over 4,000 square feet and was located at 2800 U.S. Alternate 19, Palm Harbor, Florida ("Second Location")¹³:

¹¹ Kimberly Mitow Testimony Dep. Ex. 1 Bates No. 19 (18 TTABVUE 139).

¹² Kimberly Mitow Testimony Dep. pp. 6:4-15, 7:1-6, 16:20-18:20 (18 TTABVUE 7, 8, 17-19); Jason Mitow Testimony Dep. pp. 5:23-6:7 (22 TTABVUE 6-7).

¹³ Kimberly Mitow Testimony Dep. pp. 7:7-9, 8:11-14 (18 TTABVUE 8, 9); Picture of Second Location found at Kimberly Mitow Testimony Dep. Ex. 1 Bates No. 26 (18 TTABVUE 144).



Located on the north east corner of Alternate 19 and Alderman Rd.

After the move, Opposer significantly increased its advertising for the restaurant in newspapers, radio, television, flyers, coupon books and internet advertising throughout Pasco, Hernando, Hillsborough, and Pinellas counties to build its business.¹⁴ Customers followed it to the Second Location, and Opposer attracted out-

¹⁴ Kimberly Mitow Testimony Dep. p. 9:2-15 (18 TTABVUE 10-11). From 2008 through 2010, Opposer broadcast television advertisements up to seven days a week in Hillsborough, Pasco and Pinellas counties, on channels including TNT, HLN, Bay News 9, USA, CNN, ESPN, FOX Sports, Hallmark, Travel Channel, CNBC, Sci Fi Channel, and AMC and during feature shows such as *Anthony Bourdain: No Reservations*. Kimberly Mitow Testimony Dep. pp. 35:3-20; 52:16-54:9; 55:8-58:18; Exhibit 6 Bates Nos. 1162-1165, 1142-1146, 1153-56, 1133-36, 1121-26; Exhibit 7 Bates Nos. 939-941, 945-949, 953-954, 958-959, 963-966, 971-972, 976-980, 984-985, 926-927, 931-932. (18 TTABVUE 36, 53-55, 56-59, 199-202, 207-211, 214-217, 220-223, 229-234, 237-239, 243-247, 251-252, 256-257, 261-264, 269-270, 274-278, 282-283, 287-288, 292-293) (CONFIDENTIAL 21 TTABVUE 199-202, 207-211, 214-217, 220-223, 229-234, 237-239, 243-247, 256-257, 261-264, 269-270, 274-278, 287-288).

From January 1, 2008 through December 31, 2010, Opposer spent several tens of thousands of dollars on television advertising, all prominently bearing Opposer's Mark. Kimberly Mitow Testimony Dep. 37:3-52:11, 54:4-7, 84:18-87:3, Exhibits 35-36 (18 TTABVUE 38-53, 55, 85-88; 19 TTABVUE 211-232) (CONFIDENTIAL 21 TTABVUE 38-53, 85-88, 1102-1123); Brief of Plaintiff p. 7 (CONFIDENTIAL 20 TTABVUE 8).

Opposer's Restaurant also advertised on television with ABC Action News, broadcast on multiple dates, enjoying 50,000 impressions during each broadcast. (*Id.* 58:23-59:25; Exhibit 11 Bates Nos. 743, 455, 852) (18 TTABVUE 59-60, 633, 635, 638) (CONFIDENTIAL 21 TTABVUE 632, 634, 637). In addition to television advertising, Opposer advertised its restaurant in the St. Petersburg Times and Tampa Bay Times newspapers with distribution through Pinellas, Pasco, Hernando, and Hillsborough counties, spending well-over \$100,000. *Id.* 38:19-39:6; 60:6-64:18; 65:2-20; Exhibits 12-13, 16, 35-36 (18 TTABVUE 39-40, 61-65, 66, 641-739, 816-825; 19 TTABVUE 211-232) (CONFIDENTIAL 21 TTABVUE 640-738, 819-820, 822). It also expanded its menu to accommodate different tastes while retaining its signature items such as corned beef and pastrami. *Id.* 8:15-9:1 (18 TTABVUE 9-10).

of-state customers as well. Opposer also expanded its menu, offering additional items to broaden the restaurant's appeal, and its business doubled.¹⁵

The following advertisement for its Second Location appeared in the April 6, 2000 edition of the St. Petersburg Times:¹⁶



Near the end of 1999, around the time when Opposer was preparing to move its restaurant from the First Location to the Second Location, Kimberly and Jason Mitow formed another Florida corporation named Lucky Dill Burger Grill, Inc.¹⁷ At Kimberly's request, Jason opened the Lucky Dill Burger Grill restaurant at 35236 U.S. Highway 19, Palm Harbor, Florida, (*i.e.*, the site of the First Location of Opposer's restaurant), for the purpose of assuming Kimberly's unfinished lease at that location.¹⁸ After operating for approximately one year, the Lucky Dill Burger

¹⁵ Kimberly Mitow Testimony Dep. pp. 7:19-8:10, 8:15-9:1, 9:16-10:5 (18 TTABVUE 8-11).

¹⁶ Advertisement of Second Location, Kimberly Mitow Testimony Dep. Ex. 1 Bates No. 24 (18 TTABVUE 142).

¹⁷ Jason and Kimberly Mitow were originally listed as the Incorporators and Directors of Lucky Dill Burger Grill, Inc. Applicant's Notice of Reliance, Ex. 40 (14 TTABVUE 134-138) (Articles of Incorporation for Lucky Dill Burger Grill, Inc., filed with Florida's Secretary of State on December 21, 1999); Kimberly Mitow Testimony Dep. p. 99:7-11 (18 TTABVUE 100).

¹⁸ Lucky Dill Burger Grill obtained a Permanent Food Service License from the State of Florida for use at the Lucky Dill Burger Grill restaurant located at 35236 U.S. Highway 19,

Grill, Inc. sold the Lucky Dill Burger Grill restaurant as an ongoing business.¹⁹ The Lucky Dill Burger Grill restaurant has since closed.²⁰

Sometime in 2001, Jason Mitow via Lucky Dill Downtown, Inc. in which Jason Mitow was a Director and Incorporator,²¹ opened a second restaurant, at 400 North Tampa Street in Tampa, Florida using the names “Lucky Dill Deli Downtown” and “Lucky Dill Deli.”²² In 2003, after about a year to a year and a half from its opening, the Lucky Dill Deli in Tampa was sold as an ongoing business.²³ The restaurant subsequently closed.²⁴

In 2004, Jason Mitow opened a third restaurant, the “Lucky Dill Deli” restaurant in St. Petersburg, Florida.²⁵ The restaurant was owned and operated by the same owner of the Lucky Dill Deli in Tampa, *i.e.*, Lucky Dill Downtown, Inc., with Jason Mitow listed as a Director.²⁶ Lucky Dill Downtown, Inc. only operated the Lucky Dill

Palm Harbor, Florida, which is the same address as Opposer’s First Location. Applicant’s Notice of Reliance, Ex. 37 (14 TTABVUE 127-128).

¹⁹ Jason Mitow Testimony Dep. pp. 12:16-21; 31:8-33:22 (22 TTABVUE 13, 32-34).

²⁰ Jason Mitow Testimony Dep. pp. 14:25-15:3, 33:9-18 (22 TTABVUE 15-16, 34).

²¹ Applicant’s Notice of Reliance Exhibits 47 and 49 (Articles of Incorporation for Lucky Dill Downtown, Inc. filed with Florida Secretary of State) (14 TTABVUE 153-154, 158-162).

²² Jason Mitow Testimony Dep. pp. 15:6-20, 16:7-10 (22 TTABVUE 16-17).

²³ Jason Mitow Testimony Dep. pp. 18:25-19:8, 46:18-21 (22 TTABVUE 19-20, 47).

²⁴ Jason Mitow Testimony Dep. pp. 20:17-21:1 (22 TTABVUE 21-22).

²⁵ Jason Mitow Testimony Dep. pp. 21:14-22:1, 28:2-6 (22 TTABVUE 22-23, 29).

²⁶ Applicant’s Notice of Reliance Exhibits 46 and 49 (Articles of Incorporation for Lucky Dill Downtown, Inc. filed with Florida Secretary of State) (14 TTABVUE 151-152, 158-162); Exhibit 50 (Reinstatement of Lucky Dill Downtown, Inc. filed with Florida Secretary of State) (14 TTABVUE 151-152, 158-162, 163-165).

Deli in St. Petersburg for about a month before it was sold as an ongoing business changing ownership a few times until it was purchased by Applicant.²⁷

Over the years, Opposer outgrew its Second Location at 2800 U.S. Alternate 19, Palm Harbor and in November 2011, moved its restaurant to an 8,000 square foot location at 33180 U.S. 19 North, Palm Harbor (“Third Location”).²⁸

Again, its customers followed Opposer to its Third Location (located in the same town as the First and Second Locations), Opposer invested in advertising, and its “business [has] more than doubled.”²⁹ Opposer continues to feature its mark in advertising via television, newspapers and other outlets, for which it spent hundreds of thousands of dollars between January 1, 2011 and December 31, 2013.³⁰ Opposer’s

²⁷ Applicant’s Notice of Reliance Exhibit 46 (14 TTABVUE 151-152); Jason Mitow Testimony Dep. pp. 27:18-28:-6, 46:22-25, Exhibit 2 (22 TTABVUE 28-29, 47, 68-89); Kenneth O’Bannon Discovery Dep. pp. 46:15-47:19 (23 TTABVUE 47-48).

²⁸ Kimberly Mitow Testimony Dep. p. 10:6-12 (18 TTABVUE 11).

²⁹ Kimberly Mitow Testimony Dep. pp. 10:13-16, 11:5-15 (18 TTABVUE 11-12).

³⁰ Kimberly Mitow Testimony Dep. Exhibit 34-35 (19 TTABVUE 201-222) (CONFIDENTIAL 21 TTABVUE 1092-1113). Opposer also maintains a website that bears THE LUCKY DILL and Design mark in the upper left hand corner of various webpages. *Id.* at p. 22:3-12, Exhibit 2 pp. 28, 4-7 (18 TTABVUE 23, 168, 171-174). The “About Us” section of the website describes the history of the restaurant. *Id.* at p. 33:15-25, Exhibit 2 pp. 28-29 (18 TTABVUE 34, 168-169). Since 2011, Opposer has utilized Facebook showing Opposer’s THE LUCKY DILL mark accompanied by the silhouette of the New York City skyline, to advertise its services. *Id.* at 34:6-13, Exhibit 3 pp. 10, 11, 15 (18 TTABVUE 35, 177, 178, 182). Opposer has engaged in other forms of advertising and promotion featuring its mark in addition to the newspaper, television and internet advertising. Opposer advertised in Creative Loafing, the Waiting Game, the Senior Voice, Neighborhood News, Valpak coupon book, BCC coupon book, Clipper (Lighthouse Clipper) Magazine, National CineMedia (advertising on movie screen) Kimberly Mitow Testimony Dep. p. 80:2-11, Exhibit 29 (18 TTABVUE 81; 19 TTABVUE 156-168) (CONFIDENTIAL 21 TTABVUE 1047-1059), Living Social (internet-based advertising), Money Mailer (coupon books), Baywood Village Magazine, billboards and the Crystal Beach Community Scoop, and the Phillies, Blue Jays and Threshers Baseball team programs, and the inside of book covers for Palm Harbor University High School. Kimberly Mitow Testimony Dep. 65:22-84:12, Exhibits 18-19, 21-34 (19 TTABVUE 2-11, 21-222); (CONFIDENTIAL 21 TTABVUE 893-902, 912-1106). Because the Backyard Coupon Magazine (BCM) paid money



mark (the “Pickle Logo”) is used in all of Opposer’s advertisements and on its vehicles.³¹ Opposer advertises throughout Pasco, Hernando, Hillsborough and Pinellas counties, with such advertisements featuring the Pickle Logo. Examples of

the exposure of Opposer’s Pickle Logo  mark include:



Logo used on Third Location website³²



Menu Cover from Third Location³³

to Opposer for advertising placed in Opposer’s menus, it is not included in Opposer’s advertising for its THE LUCKY DILL restaurant. Exhibit 20 (19 TTABVUE 12-20); (CONFIDENTIAL 21 TTABVUE 903-911).

³¹ Kimberly Mitow Testimony Dep. p. 101:1-20 (18 TTABVUE 102).

³² Kimberly Mitow Testimony Dep. Ex. 2 p. 000004 (18 TTABVUE 171).

³³ *Id.*



Third Location exterior³⁴

Since its opening, Opposer’s “Lucky Dill” restaurant has spanned three locations, has been advertised as a New York style deli,³⁵ and has doubled its business at each successive location with increased advertising and revenue from Opposer’s restaurants totaling several millions of dollars.³⁶

B. Applicant Central Avenue Deli, LLC

Applicant operates the “Lucky Dill” restaurant located at 277 Central Avenue, St. Petersburg, Florida, which it purchased as an ongoing business in December 2008. The restaurant was originally opened by Jason Mitow in 2004 and has had multiple owners before it was purchased by Applicant. Mr. Kenneth O’Bannon is now the owner, managing member and acting general manager of Applicant.³⁷

³⁴ *Id.* p. 000029 (18 TTABVUE 169).

³⁵ Kimberly Mitow Testimony Dep. Exhibits 1 and 37, Palm Harbor Panther March 1998 “Fridays & Saturdays - N.Y. DELI NITE;” April 6, 2000 St. Petersburg Times ad “FRI., SAT. & SUN. 3-9 PM NY DELI NITES;” ad filed with trademark application “The Best Deli This Side of Manhattan,” “Bar NYC Cocktails, Drafts, Wine” (18 TTABVUE 155, 142; 19 TTABVUE 250). *See also*, Brief of Applicant p. 7 (24 TTABVUE 8).

³⁶ Kimberly Mitow Testimony Dep. pp. 39-51, 84-86, Ex. 35-36 (CONFIDENTIAL 21 TTABVUE 40-52, 85-87, 1102-1113).

³⁷ Jason Mitow sold the restaurant to Richard Budzinski. Jason Mitow Testimony Dep. p. 24:19-22 (22 TTABVUE 25); Mr. O’Bannon testified that there were “multiple owners in between there and when [he] bought it....” Mr. O’Bannon purchased the restaurant from Paul

On August 29, 2012, Applicant filed its application which is the subject of this proceeding for the word and design mark shown at the outset of this decision.³⁸ As set forth above in Section II., the correct dates of first use in commerce of the involved mark were June 23, 2010 for the restaurant and catering services in International Class 43, and December 21, 2010 for the food kiosk services in International Class 35.³⁹ Thus, while Applicant's defense focuses in part on an argument that the purchasers of the three restaurants started by Jason Mitow also continued to use Lucky Dill formative marks, for our analysis of priority in this case, Applicant relies on its current mark and these 2010 dates of use.

While in the process of researching the purchase of the restaurant at 277 Central Avenue in St. Petersburg, Mr. O'Bannon learned that there were three businesses with a version of the name "Lucky Dill" in the Tampa Bay area. Mr. O'Bannon visited the three establishments, one located in downtown Tampa, one in the Palm Harbor area, and the one at Central Avenue in St. Petersburg, which he eventually purchased.⁴⁰ After visiting the three restaurants, he observed, without providing any details, that the logos were different, the menus were different, and the services were different.⁴¹

Berg, President of Lucky Dill Deli Central, Inc., in December 2008, Kenneth O'Bannon Discovery Dep. pp. 9:2-4, 9:15-23, 46:21-47:2, Exhibit 5-7 (23 TTABVUE 10, 47-48, 151-160).

³⁸ Kenneth O'Bannon Discovery Dep. p. 20:5-12, Ex. 3 (23 TTABVUE 21, 133-148). Application Serial No. 85716289. Applicant disclaimed "Dining. Catering. New York Style."

³⁹ Kenneth O'Bannon Discovery Dep. p. 82:2-14 (23 TTABVUE 83).

⁴⁰ Kenneth O'Bannon Discovery Dep. p. 42:12-43:5, 45:18-21 (23 TTABVUE 43-44, 46).

⁴¹ Kenneth O'Bannon Discovery Dep. p. 43:10-15 (23 TTABVUE 44).

Thus, before it acquired its restaurant and filed its Application, Applicant was aware of Opposer's restaurant in Palm Harbor, Florida. Additionally, when formulating the menu for its restaurant, Applicant reviewed Opposer's 2009 menu, which featured Opposer's mark. Applicant also saw Opposer's website and advertising.⁴²

Applicant's first date of operation of its "Lucky Dill" restaurant was January 2, 2009.⁴³ Its restaurant presently has a "New York style menu that's very broad in selection from deli-style sandwiches and burgers, wraps, salads, specialties, desserts." It also provides catering services with a more extensive customized catering menu.⁴⁴ Applicant began developing its brand in an attempt to ensure that it differentiated its restaurant from the other two "Lucky Dill" restaurants in the Tampa Bay area.⁴⁵ It started using the word and design mark that is the subject of this proceeding on its website on June 23, 2010 for delicatessen, restaurant, take-out restaurant and catering services; and on December 21, 2010 for food kiosk services.⁴⁶

Applicant advertises in newspapers and other print media, on the internet and in other media using its applied-for mark, but has not done any television advertising.⁴⁷ Applicant's mark has appeared on the large screen Jumbotron at Tropicana Field in

⁴² Kenneth O'Bannon Discovery Dep. p. 12:12-13:-20, 15:1-23, 46:1-7, 100:7-101:7 (23 TTABVUE 13-14, 16, 47, 101-102).

⁴³ Kenneth O'Bannon Discovery Dep. p. 9:20-23 (23 TTABVUE 10).

⁴⁴ Kenneth O'Bannon Discovery Dep. p. 6:5-7:3 (23 TTABVUE 7-8).

⁴⁵ Kenneth O'Bannon Discovery Dep. p. 15:6-17 (23 TTABVUE 16).

⁴⁶ Kenneth O'Bannon Discovery Dep. p. 82:2-14 (23 TTABVUE 83).

⁴⁷ Kenneth O'Bannon Discovery Dep. pp. 75:6-19-80:6 (23 TTABVUE 76-81).

St. Petersburg “as a trailing listing of multiple sponsors and vendors.”⁴⁸ Applicant has used its mark in direct marketing, including electronic and paper mailings to individuals and companies both within and outside of Florida.⁴⁹ Also, Applicant is an approved vendor listed with the City of St. Petersburg, and official caterer for the teams participating in the East-West Shrine games and for the St. Petersburg Bowl.⁵⁰ Additionally, Applicant has used its mark in advertising with the St. Petersburg Chamber of Commerce, on a billboard, in the Pinellas Scene newspaper circulated in Pinellas County, in a single radio broadcast during the St. Petersburg Grand Prix, and on its 2013 and 2014 menus. Applicant also sponsors, advertises or caters various other sporting events such as Wounded Warrior International Baseball and Softball, Rowdies soccer, the Rock-and-Roll Marathon (when it was held in St. Petersburg), and golf tournaments.⁵¹

On occasion, Applicant’s customers seek to redeem Opposer’s coupons, only to learn that Applicant’s restaurant is not affiliated with Opposer’s restaurant.⁵² Opposer has also run into customers thinking that Applicant’s restaurant is affiliated with, or the same as, Opposer’s restaurant.⁵³

⁴⁸ Kenneth O’Bannon Discovery Dep. pp. 23:3-11, 26:6-10 (23 TTABVUE 24, 27).

⁴⁹ Kenneth O’Bannon Discovery Dep. pp. 18:5-19:22, 21:1-17, 77:5-80:20 (23 TTABVUE 19-20, 22, 78-81).

⁵⁰ Kenneth O’Bannon Discovery Dep. pp. 21:18-22:23 (23 TTABVUE 22-23).

⁵¹ Kenneth O’Bannon Discovery Dep. pp. 28:17-35:12 (23 TTABVUE 29-36).

⁵² Kenneth O’Bannon Discovery Dep. pp. 13:25-14:7 (23 TTABVUE 14-15).

⁵³ For example, one incident involved Applicant’s catering client calling Opposer’s restaurant “yelling” because the catering order was not delivered, only to discover that it was an order placed with Applicant’s restaurant. Kimberly Mitow Testimony Dep. p. 97:2-10 (18 TTABVUE 98).

VI. Applicant's Defenses

Turning to the merits of this case, we first consider Applicant's "abandonment" defense which challenges Opposer's rights in its claimed trademarks.⁵⁴ Should Applicant prevail on its defense, Opposer's claim of likelihood of confusion would be defeated.

Applicant contends that Opposer abandoned its rights in the "Lucky Dill" name by allowing Jason Mitow and then the subsequent purchasers of the three "Lucky Dill" eating establishments he started, ultimately including Applicant, to continue to use the names without exercising reasonable control over the nature and quality of the services on which the mark was used.⁵⁵ Applicant argues that because Opposer failed to control the quality of the services provided at the three "Lucky Dill" restaurants opened by Jason Mitow, and later sold to others who continued to use the "Lucky Dill" marks, the term "Lucky Dill" became free for anyone to use.⁵⁶ Opposer strongly disagrees and maintains that it had sufficient quality control over Jason's use of Opposer's marks, which is borne out by the absence of any decline in the quality of goods and services offered at his restaurants, thus avoiding involuntary abandonment of its rights in its marks as a result of naked licensing. Although

⁵⁴ While Applicant alleged certain other affirmative defenses including waiver, acquiescence, estoppel and unclean hands, because Applicant did not pursue these affirmative defenses either through presentation of evidence at trial or in its brief, those defenses are waived. *Research in Motion Ltd. v. Defining Presence Mktg. Grp. Inc.*, 102 USPQ2d 1187, 1189-90 (TTAB 2012); *Swiss Watch Int'l Inc. v. Fed'n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1734 n.4 (TTAB 2012).

⁵⁵ Applicant's Brief p. 23 (24 TTABVUE 24).

⁵⁶ Brief of Applicant p. 24 (24 TTABVUE 25).

Opposer, to the extent it either controlled Jason Mitow's uses, or was able to rely on his uses, failed to control the use of LUCKY DILL marks or trade names once those restaurants were sold to third parties, the failure did not cause Opposer's LUCKY DILL marks to lose all trademark significance.

A. Whether Opposer Abandoned Its Trademark By Jason Mitow's Use of Lucky Dill for the Restaurants He Developed

We first look at whether Opposer in fact exercised sufficient control over the use of the name "Lucky Dill" by Jason and his companies. Opposer has used the LUCKY DILL mark as the name of its restaurant since 1991.⁵⁷ When deciding to move its Lucky Dill restaurant to a larger space in 1999, Kimberly Mitow asked Jason to take over Opposer's lease at its original location. In 2000, Jason (and a partner), doing business as Lucky Dill Burger Grill, Inc., re-designed and opened up a new restaurant under the name Lucky Dill Burger Grill at Opposer's original location.⁵⁸ The Lucky Dill Burger Grill was promoted in the local press together with Opposer's Lucky Dill Deli.⁵⁹ Although Kimberly Mitow was not directly involved in the day to day operation of the Lucky Dill Burger Grill restaurant⁶⁰ she saw how Jason was using "Lucky Dill"

⁵⁷ Kimberly Mitow Testimony Dep. p. 6:4-6 (18 TTABVUE 7).

⁵⁸ Kimberly Mitow Testimony Dep. pp. 7:19-24, 8:3-14 (18 TTABVUE 8, 9); Jason Mitow Testimony Dep. pp. 9:2-16, 10:2-7 (22 TTABVUE 9, 11).

⁵⁹ Kimberly Mitow Testimony Dep. Ex. 1 (18 TTABVUE 142, 144) articles in April 6, 2000 The Times, St. Petersburg newspaper; June 2000 Palm Harbor Panther North newspaper.

⁶⁰ Kimberly Mitow Testimony Dep. pp. 88:23-92:14, 98:2-7; Jason Mitow Testimony Dep. pp. 8:3-9:18, 21:24-22:11 (22 TTABVUE 9-10, 22-23).

and saw the quality of the products offered when she visited the Lucky Dill Burger Grill restaurant at least a handful of times.⁶¹

In 2001, Jason Mitow opened up his second restaurant, the Lucky Dill Deli Downtown (also called Lucky Dill Deli) in Tampa, Florida. Prior to its opening, Kimberly Mitow told Jason it would be a great idea for him to open the restaurant because she “was so sure he could expand on the Lucky Dill and really -- really make a name for it.”⁶² According to Jason, the owner of the building in Tampa, Florida, where the Lucky Dill Deli was opened, wanted a “Lucky Dill” restaurant in that location “because of our high quality. They liked our operation from Palm Harbor. We won a lot of awards.”⁶³

Jason Mitow opened his third Lucky Dill Deli restaurant in St. Petersburg, Florida in 2004,⁶⁴ operating it for about a month before selling it together with the “name and goodwill” of the Lucky Dill Deli for that location.⁶⁵ Kimberly Mitow was aware that Jason used the name Lucky Dill Deli for this restaurant in St. Petersburg

⁶¹ Jason Mitow Testimony Dep. p. 11:1-9, 12:9-15 (22 TTABVUE 12, 13).

⁶² Kimberly Mitow Testimony Dep. p. 93:5-15 (18 TTABVUE 94).

⁶³ Jason Mitow Testimony Dep. p. 35:1-3 (22 TTABVUE 36).

⁶⁴ Jason Mitow Testimony Dep. pp. 21:14-22:1; 23:7-17; 28:2-6; 37:6-11 (22 TTABVUE 22-23, 24, 29, 38).

⁶⁵ Jason and Lucky Dill Downtown, Inc. sold the name and goodwill for that location for \$25,000. Jason Mitow Testimony Dep. pp. 26:13-15, 38:19-40:23, Exhibit 2 Bates 41 and 55 (22 TTABVUE 27, 39-41, 74, 88); Applicant’s Notice of Reliance Exhibit 46 (14 TTABVUE 151-152).

and thought it was a good idea for Jason to use “Lucky Dill” in the name of this restaurant.⁶⁶

Although Opposer had no written agreements with Jason Mitow, Jason opened up the three “Lucky Dill” restaurants with the implicit consent of Opposer. Kimberly was very familiar with Jason’s experience and knowledge of the restaurant business. Jason Mitow started working for Opposer when he was in high school. Around the time of Opposer’s move to its Second Location in 2000, Jason’s involvement with Opposer’s restaurant increased.⁶⁷ He designed that location, including the kitchen and bakery.⁶⁸ He also oversaw quality control; negotiated purchasing deals with suppliers for products and supplies to be used at the Second Location;⁶⁹ and designed some of the restaurant’s ads.⁷⁰ The Third Location, which is Opposer’s current location, was completely gutted and Jason Mitow designed that location from “scratch.”⁷¹ Over the years, Jason learned all facets of the business including cooking, cleaning, product quality, creating menus and specials and promotions, maintenance,

⁶⁶ Jason Mitow Testimony Dep. p. 22:23-25 (22 TTABVUE 23); Kimberly Mitow Testimony Dep. p. 95:1-10 (18 TTABVUE 96).

⁶⁷ Kimberly Mitow Testimony Dep. pp. 16:10-14, 18:10-20 (18 TTABVUE 17, 19).

⁶⁸ Kimberly Mitow Testimony Dep. p. 19:2-11 (18 TTABVUE 20).

⁶⁹ Kimberly Mitow Testimony Dep. pp. 20:3-21:17 (18 TTABVUE 21-22).

⁷⁰ Kimberly Mitow Testimony Dep. p. 23:4-15 (18 TTABVUE 24). During this time, Jason performed these activities on Opposer’s behalf although he was not an employee of Opposer’s restaurant; he did not become an employee of Opposer’s restaurant or receive a salary from the restaurant until 2014. Kimberly Mitow Testimony Dep. pp. 19:18-24, 24:9-14 (18 TTABVUE 20, 25).

⁷¹ Kimberly Mitow Testimony Dep. pp. 10:17-11:4, 23:16-24:8 (18 TTABVUE 11-12, 24-25).

marketing and advertising, quality control, suppliers, sub-contracting and restaurant design. The “only thing [he] didn’t really do to an art is baking.”⁷²

Kimberly Mitow visited the restaurants Jason started on his own and they met with her approval.⁷³ She ate at the Lucky Dill Burger Grill multiple times, and was a taste tester.⁷⁴ Kimberly Mitow knew Jason was using the name Lucky Dill Deli in Tampa, and was present during the opening days of that restaurant.⁷⁵ She also testified that the food at the Tampa restaurant “was up to our standard,” and was happy that Lucky Dill was being used by Jason in the name of this restaurant.⁷⁶ Additionally, she visited Jason’s restaurant in St. Petersburg a couple of times and thought it was a “[r]eally cool store.”⁷⁷

Although there was no formal agreement between Opposer and Jason Mitow covering the use of the LUCKY DILL marks, a license can be implied. *See, e.g., Woodstock’s Enters. Inc. (California) v. Woodstock’s Enters. Inc. (Oregon)*, 43 USPQ2d 1440, 1447 (TTAB 1997) *aff’d mem.*, 152 F.3d 942 (Fed. Cir. 1998); *McCoy v. Mitsubishi Cutlery Inc.*, 67 F.3d 917, 36 USPQ2d 1289, 1291 (Fed. Cir. 1995); *University Book Store v. Univ. of Wisconsin Bd. of Regents*, 33 USPQ2d 1385, 1396

⁷² Jason Mitow Testimony Dep. pp. 6:1-7:23 (22 TTABVUE 7-8); Kimberly Mitow Testimony Dep. pp. 16:20-24:8 (18 TTABVUE 17-25).

⁷³ Kimberly Mitow Testimony Dep. pp. 89:5-91:22, 93:5-95:25, 97:21-98:10, 100:2-21; 102:11-13, 103:9-20, 104:8-105:1 (18 TTABVUE 90-92, 94-96, 98-99, 101, 103, 104, 105-106). See also, Applicant’s Brief p. 21 (24 TTABVUE 22).

⁷⁴ Jason Mitow Testimony Dep. 12:9-15 (22 TTABVUE 13).

⁷⁵ Jason Mitow Testimony Dep. pp. 16:16-18, 17:4-18:24 (22 TTABVUE 17, 18-19).

⁷⁶ Kimberly Mitow Testimony Dep. p. 94:9-14; 94:20-21 (18 TTABVUE 95).

⁷⁷ Kimberly Mitow Testimony Dep. p. 96: (18 TTABVUE 97).

(TTAB 1994). We find that to be the case here. Rather than constituting uncontrolled use by Jason resulting in Opposer's marks losing all source-indicating significance, the reality of the situation is akin to an informal implied license from Opposer to Jason to use the marks in connection with the restaurants he opened. As Applicant acknowledges, Opposer relied on Jason to control the quality of goods and services of each Lucky Dill restaurant he opened.⁷⁸

Kimberly's knowledge and approval of the three restaurants opened by Jason constituted an implied license to use the trademarks from Opposer. Jason's father and mother trained Jason in how to run a restaurant from the time he started working at Opposer's restaurant during high school.⁷⁹ Kimberly developed standards that Jason followed and she relied on him to control the quality of the goods and services of Opposer's restaurant and each Lucky Dill restaurant he opened.⁸⁰ Thus, Opposer had both knowledge of, and was responsible for, the quality of the goods and services being provided in the restaurants opened by Kimberly's son Jason. Although there was no formal written agreement between Opposer and Jason regarding his use of the term "Lucky Dill"⁸¹ in the name of those restaurants, Kimberly knew he was

⁷⁸ Applicant's Brief p. 28 (24 TTABVUE 29).

⁷⁹ Kimberly Mitow Testimony Dep. pp. 16:24-17:21 (18 TTABVUE 17-18).

⁸⁰ Kimberly Mitow Testimony Dep. pp. 20:3-21:17, 107:12-108:1, 108:8-12 (18 TTABVUE 21-22, 108-109, 109); Jason Mitow Testimony Dep. p. 31:11-18 (22 TTABVUE 32).

⁸¹ Jason Mitow Testimony Dep. pp. 9:5-18; 16:11-17:9 (22 TTABVUE 10, 17-18).

using the marks, she was familiar with and visited the restaurants, she taste-tested menu items and she gave her approval.⁸²

There is no evidence of any decline in the level of quality of the services or food served at the restaurants opened by Jason, nor evidence noting any other material differences between Opposer's restaurant and Jason's restaurants, indicating that an understanding regarding the standard of quality existed between Kimberly and Jason. While there was no formal system of quality control over the restaurants opened by Jason, an inference of abandonment is not drawn if satisfactory quality has been maintained such that no deception of purchasers has occurred. Under these circumstances, we find that Opposer has exercised sufficient control over the nature and quality of the services rendered under the LUCKY DILL marks used by Jason. *Cf. Taco Cabana International, Inc. v. Two Pesos Inc.*, 952 F.2d 1113, 19 USPQ2d 1253, 1259 (5th Cir. 1991), *aff'd* 505 U.S. 763, 23 USPQ2d 1081 (1993) ("Where the license parties have engaged in a close working relationship, and may justifiably rely on each parties' intimacy with standards and procedures to ensure consistent quality, and no actual decline in quality standards is demonstrated, we would depart from the purposes of the law to find an abandonment simply for want of all the inspection and control formalities."). Therefore, even without a formal system of quality control over the restaurant services provided by Jason's restaurants, Opposer's LUCKY DILL marks were not abandoned by his use of the Lucky Dill name. *See Stockpot*,

⁸² Kimberly Mitow Testimony Dep. pp. 91:1-22, 93:5-94:25, 95:1-16, 98:2-10, 102:11-13, 103:1-104:17 (18 TTABVUE 92, 94-96, 99, 103, 104-105); Jason Mitow Testimony Dep. p. 12:9-15; 17:10-23; 18:11-13 (22 TTABVUE 13, 18, 19).

Inc. v. Stock Pot Rest., Inc., 220 USPQ 52, 59 (TTAB 1983) (“[T]he inference of abandonment is not drawn because satisfactory quality was maintained and, hence, no deception of purchasers occurred.”), *aff’d* 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1888-89 (TTAB 2006) (mere fact of misuse, just like the mere absence of formal control, is not sufficient to raise an inference that the control was not adequate or that all significance as a mark is lost); *Guiding Eyes for the Blind, Inc. v. Guide Dog Found. for the Blind, Inc.*, 384 F.2d 1016, 155 USPQ 462, 464 (CCPA 1967) (the record as a whole does not show that appellee’s “course of conduct” had caused the mark “to lose its significance as an indication of origin”).

B. Whether the Sale of Lucky Dill Restaurants Established by Jason Mitow Constituted Abandonment Due to Uncontrolled Use of Lucky Dill

While Jason’s use of the Lucky Dill name for the three restaurants he opened was pursuant to an implied license, his sale of those restaurants brings us to the next question, *i.e.*, whether Opposer engaged in naked licensing with the subsequent owners of the “Lucky Dill” restaurants resulting in the abandonment of Opposer’s rights in its service mark LUCKY DILL. Applicant contends that its predecessor-in-interest, Opposer, and two unrelated third parties, all operated restaurants located within 30 miles driving distance from each other, were each using the term “Lucky

Dill” in connection with their restaurant services⁸³ and were responsible for the quality of goods and services provided at the restaurants each purchased.⁸⁴

After running the Lucky Dill Burger Grill restaurant in Palm Harbor from about 2000-2001, Jason sold the restaurant, allowing the new owner to continue using the name.⁸⁵ Over the years, there were two subsequent owners of the Lucky Dill Burger Grill, each of whom continued to use the name “Lucky Dill” in connection with the restaurant.⁸⁶

Based on the assumption that Kimberly Mitow was an officer of the Lucky Dill Burger Grill, Inc. (“LDBGI”), Applicant argues “the facts indicate that LDBGI would have had the ability to constructively transfer the trademark rights and goodwill in the term ‘Lucky Dill’ to the new owner of the Lucky Dill Burger Grill as part of the sale of the ongoing business.”⁸⁷ In order for this to occur however, at minimum, we would have to find that Kimberly Mitow was an officer of LDBGI when the business was sold to the first purchaser. While Kimberly was identified as a corporate director of LDBGI at the time of its founding,⁸⁸ there is a subsequent corporate document

⁸³ Applicant’s Brief pp. 26-27 (24 TTABVUE 27-28). Applicant’s request that the Board take judicial notice of the driving distance between the restaurant locations providing Exhibits A-D which are copies of pages from the *maps.google.com* website, is granted.

⁸⁴ Applicant’s Brief p. 28 (24 TTABVUE 29).

⁸⁵ Jason Mitow Testimony Dep. pp. 12:16-21; 12:25-13:7; 13:11-17; 31:8-33:18 (22 TTABVUE 13-14, 32-34).

⁸⁶ Jason Mitow Testimony Dep. p. 14:11-24 (22 TTABVUE 15).

⁸⁷ Applicant’s Brief pp. 25-26 (24 TTABVUE 26-27).

⁸⁸ See Exhibit 40, Articles of Incorporation of Lucky Dill Burger Grill, Inc. filed December 21, 1999, showing Kimberly Mitow as a director. (14 TTABVUE 136-137),

identifying Jason Mitow as the sole officer and director of LDBGI.⁸⁹ Moreover, Jason Mitow's testimony is consistent that Kimberly Mitow did not maintain ownership in any of the three restaurants.⁹⁰ Thus, there is no showing that Kimberly Mitow was an owner, officer or director of LDBGI at the time of the sale of the Lucky Dill Burger Grill. Accordingly, there is no sufficient basis to find that she could have constructively transferred any trademark rights to LDBGI when the restaurant was sold by Jason.

Applicant also contends that because the Lucky Dill Burger Grill restaurant was sold by Jason as a going concern, the trademark and goodwill of the business symbolized by it were presumed to pass with the sale of the business.⁹¹ Normally, the common law rights in a mark will be presumed to have passed, absent contrary evidence, with the sale and transfer of the business with which the mark has been identified. *See Harry Fischer Corp. v. Kenneth Knits, Inc.*, 207 USPQ 1019, 1022 (TTAB 1980); *Airport Canteen Services, Inc. v. Farmer's Daughter, Inc.*, 184 USPQ 622, 627 (TTAB 1974); *Sun Valley Co. Inc. v. Sun Valley Mfg. Co.*, 167 USPQ 304, 309 (TTAB 1970). Inasmuch as Opposer's Lucky Dill restaurant was in business before, during and after the time that the Lucky Dill Burger Grill was in business, we do not find that unrestricted rights to the Lucky Dill Burger Grill were necessarily transferred with the sale of that business by Jason. Additionally, the Lucky Dill Burger Grill

⁸⁹ See Exhibit 30, Corporation Reinstatement document for lucky Dill Burger Grill, Inc. filed June 18, 2001, showing Jason Mitow as sole officer and director. (14 TTABVUE 106-108).

⁹⁰ Jason Mitow Testimony Dep. p. 21:24-22:11 (22 TTABVUE 22-23).

⁹¹ Applicant's Brief p. 24 (24 TTABVUE 25).

restaurant that was sold to a third-party in 2001 eventually closed sometime between 2004 and 2007⁹² such that Applicant was unaware of the existence of the Lucky Dill Burger Grill restaurant.⁹³

In 2003, after about a year to a year and a half of doing business in Tampa, Jason Mitow sold the Lucky Dill Deli in Tampa as an ongoing business,⁹⁴ giving the buyers permission to continue to use the name.⁹⁵ Because Kimberly and Jason Mitow were not communicating at that time, Kimberly learned about the sale of the Lucky Dill Deli in Tampa sometime after the sale occurred.⁹⁶ On behalf of Applicant, Mr. O'Bannon later visited the Lucky Dill Deli restaurant in Tampa in the first or second quarter of 2008. However, the restaurant subsequently closed in September 2008, prior to his purchase of the restaurant in St. Petersburg.⁹⁷ Thus, for five years after the sale by Jason Mitow, from 2003-2008, the Lucky Dill Deli in Tampa was doing business as "Lucky Dill Deli."

⁹² Jason Mitow Testimony Dep. pp. 14:25-15:3, 33:9-18 (22 TTABVUE 15-16, 34). *See* Exhibit 8 (14 TTABVUE 54-55), which is a Fictitious Name report issued by the Florida Department of State Division of Corporations indicating that the fictitious name Lucky Dill Burger Grill was filed on September 20, 2002 and expired on December 31, 2007.

⁹³ Kenneth O'Bannon Discovery Dep. p. 42:1-43:5 (23 TTABVUE 43-44).

⁹⁴ Jason Mitow Testimony Dep. pp. 18:25-19:8, 46:18-21 (22 TTABVUE 19-20, 47).

⁹⁵ Jason Mitow Testimony Dep. p. 19:16-19 (22 TTABVUE 20).

⁹⁶ Kimberly Mitow Testimony Dep. p. 103:1-8 (18 TTABVUE 104).

⁹⁷ "Downtown Tampa's Lucky Dill Deli Evicted by Landlord," September 12, 2008 The Tampa Tribune; "Lucky Dill in downtown Tampa evicted for not paying rent," September 11, 2008 Tampa Bay Times; Applicant's Exhibits 2, 4 (14 TTABVUE 18-20, 33-34); Jason Mitow Testimony Dep. pp. 20:17-21:1; 35:25-36:3 (22 TTABVUE 21-22, 36-37); Kenneth O'Bannon Deposition Dep. p. 42:1-23 (23 TTABVUE 43).

Similarly, Kimberly Mitow did not find out about the sale of the Lucky Dill Deli restaurant in St. Petersburg until after it was sold.⁹⁸ In 2004, Jason sold the restaurant including the “Lucky Dill Deli” name and goodwill limited to that “location or [it] may relocate within [a] three (3) miles radius of same.”⁹⁹ After the sale in 2004, the restaurant continued using the Lucky Dill Deli name and subsequently changed owners at least a couple of times.¹⁰⁰ Applicant eventually acquired the restaurant and “The Lucky Dill Deli” trade name for that location only in December 2008.¹⁰¹ It then obtained a license from the State of Florida and initially opened up for business on

⁹⁸ Kimberly Mitow Testimony Dep. p. 96:1-14 (18 TTABVUE 97).

⁹⁹ Jason Mitow Testimony Dep. pp. 26:13-15, 38:19-39:14, Exhibit 2 Bates No. 41 (22 TTABVUE 27, 39-40, 74).

¹⁰⁰ Jason Mitow (President of Lucky Dill Downtown, Inc.) sold the Lucky Dill Deli restaurant in St. Petersburg to Richard Budzinski in May 2004. Jason Mitow Testimony Dep. p. 24:19-24 and Exhibit 2 (22 TTABVUE 25, 68-69, 72-75, 159-160). Kenneth O’Bannon purchased the restaurant from Paul Berg (who was the President of Lucky Dill Deli Central, Inc.) in December 2008. Kenneth O’Bannon Discovery Dep. p. 9:15-19 and Exhibits 5-7 (23 TTABVUE 10, 151-160).

Notice of Reliance Ex. 46 (14 TTABVUE 151-152); Jason Mitow Testimony Dep. pp. 28:2-6, 46:22-25, Exhibit 2 (22 TTABVUE 29, 47, 68-89). The sales agreement for the Lucky Dill Deli restaurant in St. Petersburg included a clause that said “[b]uyer agrees to use Lucky Dill products through a bulk buying plan where possible.” Jason Mitow explained that the bulk buying program was set up on the premise that they (*i.e.*, the buyer and Opposer) could receive a better price if multiple restaurants purchased products through the program. Jason Mitow Testimony Dep. p. 29:1-22 (22 TTABVUE 30).

¹⁰¹ Paragraph 27 of the Standard Asset Purchase Contract and Receipt dated December 17, 2009, provided: “Seller hereby grants Buyer, effective with the Closing of this sale, any and all rights held by Seller in the trade name, ‘The Lucky Dill Deli’ for this location St. Pete, and any variations thereof.” Kenneth O’Bannon Discovery Dep. p. 9:15-23; Exhibit 5 (23 TTABVUE 10, 154). While Jason Mitow originally transferred the trade name for use at that location or within a three mile radius of same, Applicant purchased rights in the trade name “The Lucky Dill Deli” for the location in St. Pete.

January 2, 2009¹⁰² under the name “Lucky Dill Deli.” Applicant subsequently re-designed and adopted a new word and design mark  and filed an application to register that mark which is the subject of this proceeding.¹⁰³

Opposer did not give Jason permission to sell the LUCKY DILL name,¹⁰⁴ yet Opposer never sought to have the subsequent owners of those Lucky Dill restaurants change the names of the restaurants.¹⁰⁵ While Kimberly never inspected or visited any of the Lucky Dill restaurants Jason opened after he sold them,¹⁰⁶ Jason did. He visited all three restaurants to check on them, answer questions, provide training and assistance to the different owners of the restaurants, eat at the restaurants, communicate with employees, help with the logo, and see that they “were keeping up the standards.”¹⁰⁷ Moreover, many of the employees he trained remained with the new owners of the restaurants.¹⁰⁸ Indeed, Jason met with Kenneth O’Bannon prior to Applicant’s purchase of its restaurant; another time after that, Mr. O’Bannon saw Jason and Kimberly drive up in a car and stop at Applicant’s restaurant.¹⁰⁹

¹⁰² Kenneth O’Bannon Discovery Dep. p. 9:15-23 (23 TTABVUE 10); Exhibits 5 and 28 (14 TTABVUE 100-101). Kenneth O’Bannon Discovery Dep. p. 9:15-23; Exhibit 5 (23 TTABVUE 10, 154).

¹⁰³ See 23 TTABVUE 143.

¹⁰⁴ Kimberly Mitow Testimony Dep. pp. 92:15-17; 96:12-14 (18 TTABVUE 93, 97); Jason Mitow Testimony Dep. pp. 13:18-14:1 (22 TTABVUE 14-15).

¹⁰⁵ Kimberly Mitow Testimony Dep. pp. 107:12-108:12 (18 TTABVUE 108-109).

¹⁰⁶ Kimberly Mitow Testimony Dep. pp. 98:11-13; 104:3-7 (18 TTABVUE 99, 105).

¹⁰⁷ Jason Mitow Testimony Dep. pp. 13:11-14; 14:2-21; 19:24-20:16; 25:2-26:5 (22 TTABVUE 14, 15, 20-21, 26-27).

¹⁰⁸ Jason Mitow Testimony Dep. p. 25:18-26:7 (22 TTABVUE 26-27).

¹⁰⁹ Kenneth O’Bannon Discovery Dep. pp. 48:5-49:4 (23 TTABVUE 49-50).

Jason eventually sold the three restaurants he started. Although Jason sold and transferred limited rights in the Lucky Dill name to the restaurants, he continued to monitor their use of the Lucky Dill names. The restaurants continued in business using the “Lucky Dill” names: Lucky Dill Burger Grill in Palm Harbor from 2001-2007¹¹⁰, Lucky Dill Deli in Tampa from 2003-2008, Lucky Dill Deli in St. Petersburg from 2004 to the present. Notably, the first two restaurants have been closed at least since 2008.

Applicant’s purchase on December 30, 2008 of the restaurant in St. Petersburg included the trade name “‘The Lucky Dill Deli’ for this location St. Pete....”¹¹¹ Significantly, what Applicant purchased was only the rights to the trade name “The Lucky Dill Deli” at that one location.

Applicant’s reliance on the Board’s unpublished decision in *C.F.M. Distrib. Co., Inc. v. Costantine*, Opposition No. 91185766 (TTAB March 20, 2013), *aff’d mem.*, *Costantine v. C.F.M. Distrib. Co., Inc.*, 553 Fed. Appx. 1005 (Fed. Cir. 2014), offers no support for its position on consumer perception of services provided under the mark Lucky Dill.¹¹² That non-precedential case involved decades of widespread

¹¹⁰ See Exhibit 8 (14 TTABVUE 54-55), which is a Fictitious Name report indicating that the fictitious name Lucky Dill Burger Grill was filed on September 20, 2002 and expired on December 31, 2007. Additionally, Jason Mitow testified that “it’s been a while” since the Lucky Dill Burger Grill closed, guessing that it closed in 2004. Jason Mitow Testimony Dep. p. 15 (22 TTABVUE 16).

¹¹¹ Kenneth O’Bannon Discovery Dep. Exhibits 5 and 7 (23 TTABVUE 154, 160).

¹¹² See Applicant’s Brief pp. 27-29 (24 TTABVUE 28-30). That decision is not precedential. Although parties may cite to non-precedential decisions, the Board does not encourage the practice. *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1875 n.5 (TTAB 2011). Moreover, because such decisions are not binding on the Board and because they have no precedential effect, the Board generally will not discuss them in other decisions. *In re Luxuria*

uncontrolled licensing resulting in an excess of thirty franchises in a tangled web of numerous corporations and individuals all claiming ownership in the same logo. In this case, for over the twenty-five years it has been in business, Opposer has provided its restaurant services and invested in advertising and promotions, under its LUCKY DILL name. During that time, Kimberly Mitow's son Jason, as an implied licensee, set up and opened three restaurants under the Lucky Dill name. Although Jason sold limited rights to the "Lucky Dill" name for use only by those three restaurants to buyers who continued to use the Lucky Dill name, two of those restaurants went out of business and stopped using the Lucky Dill name by September 2008.¹¹³ Thus, at the time Applicant purchased the Lucky Dill restaurant in St. Petersburg on December 30, 2008, that St. Petersburg restaurant was the only other restaurant, besides Opposer's, having "Lucky Dill" in its name.



Additionally, Applicant's mark involved in this Opposition, , is a different mark than the "The Lucky Dill Deli" trade name (for that one location) it received in connection with its purchase of the restaurant in December 2008. Applicant admits that its earliest date of first use for the opposed mark is June 23, 2010 for delicatessen, restaurant, take-out and catering services.¹¹⁴ Opposer has been using LUCKY DILL since 1991 for nearly identical services.

s.r.o., 100 USPQ2d 1146, 1151 n.7 (TTAB 2011). Moreover, *Costantine* involved very different facts.

¹¹³ See footnotes 97 and 110; Jason Mitow Testimony Dep. pp. 14:25-15:3, 33:9-18 (22 TTABVUE 15-16, 34).

¹¹⁴ Kenneth O'Bannon Discovery Dep. p. 82:2-14 (23 TTABVUE 83).

That LUCKY DILL identifies Opposer as one of the sources of restaurant services negates any inference of abandonment. So long as at least some members of the purchasing public identify Opposer with the LUCKY DILL marks at issue, it cannot be said that its course of conduct has caused the marks to lose their significance as a mark. *See Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 214 USPQ 327, 335 (CCPA 1982) (noting distinction between conduct of a trademark owner which results in a loss of right to enjoin a particular use because of an affirmative defense available to that user and conduct which results in the loss of all rights of protection as a mark against use by anyone; only when all rights of protection are extinguished is there abandonment); *Engineered Mechanical Services, Inc. v. Applied Mechanical Tech., Inc.*, 584 F. Supp. 1149, 223 USPQ 324, 332 (M.D. La. 1984) (defendants failed to prove that because of the lack of efforts by plaintiffs in “policing” use of the mark, that the mark has become so diluted by widespread use by others that it has lost its distinctiveness); *University Book Store v. Univ. of Wisconsin Bd. of Regents*, 33 USPQ2d at 1402 (clothing and other items bearing the marks at issue sold by retailers, except for a few occasional and transitory incidents, have reflected applicant’s standard that such merchandise be in good taste, applicant, in effect, has maintained adequate control over the nature and quality of the goods and services sold under the mark). Opposer has been continuously using the name LUCKY DILL in connection with its restaurant on its menus and signage and in extensive advertising beginning in 1991.

As the Board explained in *Woodstock's Enterprises Inc. (California) v. Woodstock's Enterprises Inc. (Oregon)*, 43 USPQ2d at 1446:

We begin our analysis with the premise that maintenance of exclusivity of rights in a mark is not required in order to avoid a finding of abandonment ... Instead, so long as at least some purchasers identify respondent with the registered mark, it cannot be said that respondent's course of conduct has caused the registered mark to lose its significance as a mark ... As in *Crown*, it is necessary to remember the following:

[There is a] distinction between conduct of a trademark owner which results in a loss of right to enjoin a particular use because of an affirmative defense available to that user and conduct which results in a loss of all rights of protection as a mark against use by anyone. Only when all rights of protection are extinguished is there abandonment.

[*Wallpaper Manufacturers, Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 214 USPQ 327, 335 (CCPA 1982)] ...

... Moreover, as emphasized by the court in *Crown*, "a mark becomes abandoned only when the mark loses its significance as indication of origin, not the sole identification of source." ... In other words, regardless of whether petitioner has the right to use the WOODSTOCK'S mark, the fact that the registered WOODSTOCK'S PIZZA PARLOR and design mark identifies respondent as one of two sources of the restaurant services negates any inference of abandonment.

Therefore, regardless of whether Applicant may have a right to use the Lucky Dill name at its location, the fact that LUCKY DILL continues to identify Opposer as one of the sources of the restaurant services, negates any inference of abandonment. For twenty-five years, Opposer has never discontinued its use of the LUCKY DILL marks and has grown its business, which confirms its lack of intent to abandon. *See Conagra, Inc. v. Singleton*, 743 F.2d 1508, 224 USPQ 552, 557-58 (11th Cir. 1984) (finding of

acquiescence in defendant's use of the name was not sufficient to foreclose [plaintiff's] rights to terminate that use); *see also Univ. of North Carolina v. Helpingstine*, 714 F.Supp. 167, 11 USPQ2d 1506, 1510 (M.D. N.C. 1989) (neither UNC's failure to prosecute alleged infringers nor its allowance of uncontrolled use of its marks prior to 1982 establishes that it abandoned its marks. Accordingly, it has valid trademarks in its name, initials, seal, and Tarheel foot). Thus, a mark becomes abandoned only when the mark loses all significance as an indication of origin in the mark holder, not merely because it may no longer be viewed as indicating only the mark holder as a single source. *Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp.*, 214 USPQ at 336.

In view of the absence of evidence showing the lack of significance of the LUCKY DILL marks as identifiers of Opposer's restaurant, the LUCKY DILL marks have not been abandoned.

VII. Opposer's Claims in This Proceeding

Inasmuch as Applicant has not prevailed on its abandonment defense, we turn to Opposer's claim of priority of use and the likelihood of confusion between its use of the marks THE LUCKY DILL and LUCKY DILL and Applicant's mark



. Applicant contests both priority and likelihood of confusion.¹¹⁵

A. Priority

In order for Opposer to prevail on its § 2(d) claim, it must first prove that it has a proprietary interest in its LUCKY DILL marks, and that its interest was obtained

¹¹⁵ Answer to Notice of Opposition (4 TTABVUE).

prior to either the filing date of Applicant's application for registration or Applicant's proven date of first use. These proprietary rights may arise from prior common law usage as a mark, or any other use sufficient to establish proprietary rights. *Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co., Inc. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993).

Opposer has used, and continues to use, the mark LUCKY DILL since the opening of its first restaurant in 1991.¹¹⁶ Opposer has also submitted copies of various newspaper advertisements and articles corroborating its use of the names THE LUCKY DILL and/or LUCKY DILL for its restaurant since at least as early as 1998-2000. Thus, Opposer has shown use of its marks since well prior to the August 29, 2012 filing date of Applicant's application and Applicant's claimed first use date of June 23, 2010. Accordingly, Opposer has established priority.

B. Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act is based on an analysis of all of the relevant probative evidence in the record related to a likelihood of confusion. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co.*

¹¹⁶ Kimberly Mitow Testimony Dep. p. 6 and Ex. 1 (18 TTABVUE 7, 137, 141-144) and Jason Mitow Testimony Dep. p. 4 (22 TTABVUE 5).

KGAA v. New Millennium Sports, S.L.U., 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015).

In this case, the word portions of the marks of the parties, though not identical, are very similar, particularly in appearance, sound and meaning. Opposer's marks are LUCKY DILL, THE LUCKY DILL and , while Applicant's mark is



. The term "Lucky Dill" is emphasized in both parties' stylized marks and is the dominant term both in appearance and sound.¹¹⁷ This is particularly so given that the remaining language in Applicant's mark, *i.e.*, Dining. Catering. New York Style., is descriptive, has been disclaimed and is equally applicable to Opposer's use of its marks. Thus, there is little doubt that the marks have similar commercial impressions.

The services provided in connection with each mark are identical in part, and otherwise very similar. Opposer provides restaurant, catering and take-out services which are largely identical to Applicant's delicatessen, restaurant, take-out restaurant and catering services. Also, Applicant's food kiosk services are related to take-out restaurant services.

¹¹⁷ Additionally, underneath the term LUCKY DILL in Applicant's mark is the wording "Dining. Catering. New York Style" along with the silhouette of the Statue of Liberty. It is undisputed that Opposer has "advertised as a New York deli," *see* Brief of Applicant p. 7 (24 TTABVUE 8), and the Lucky Dill Deli in Tampa also used a distinctive "Statue of Liberty" logo and a New York theme, Kimberly Mitow Testimony Dep. pp. 94:5-8; 102:18-21 (18 TTABVUE 95, 103); Applicant's Brief p. 29 (24 TTABVUE 30). Thus, there is little doubt that the marks present similar commercial impressions.

Because there are no limitations as to channels of trade or classes of purchasers in Applicant's identification of services, it is presumed that Applicant's services are available through all channels of trade normal for those services, and that they are available to all classes of purchasers for those services, including the channels of trade and classes of consumers for Opposer's similar restaurant, catering, and carry out services. *See Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

VIII. Conclusion

Based on the foregoing, Opposer's LUCKY DILL marks have not lost significance as source identifiers for its services endowing Opposer with prior rights in those marks. Whether Applicant has a right to use its mark is beyond the scope of this proceeding. Our function is to determine whether there is a right to secure a registration.



Applicant's mark  and Opposer's LUCKY DILL marks are similar given their prominent use of the term "Lucky Dill." Additionally, the parties' services are identical in part and otherwise closely related, and therefore are presumed to travel in the same trade channels, to the same classes of purchasers. Accordingly, we find that Applicant's mark is likely to cause confusion with Opposer's LUCKY DILL marks.

Decision: The opposition to registration of the mark  shown in Serial No. 85716289 is sustained.