

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Doctor's Associates Inc.

v.

Janco, LLC

Opposition No. 91217243

Walter B. Welsh of Whitmyer IP Group LLC for Doctor's Associates Inc.

D. Bruce Gardiner of The Gardiner Law Firm for Janco, LLC.

Before Cataldo, Ritchie and Wolfson, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Janco, LLC ("Applicant") seeks to register the mark FLATIZZA (in standard characters) for "pizza" in International Class 30. Doctor's Associates Inc. ("Opposer") opposes registration of the mark, pleading prior use of the mark FLATIZZA for flat sandwiches, ownership of two pending applications for the marks FLATIZZA¹ and FLATIZZAS,² and that Applicant did not make use of its mark in interstate commerce prior to the filing date of its application, thereby rendering its application *void ab initio* under Section 1(a) of the Trademark Act, 15 U.S.C. §

¹ Serial No. 86250900, filed April 14, 2014, alleging first use dates of February 15, 2013.

² Serial No. 86251566, filed April 14, 2014, alleging first use dates of February 15, 2013.

1051(a).³ By its answer, Applicant denies the salient allegations in the opposition and asserts that it has made use of its mark in interstate commerce, thereby according it priority of use and entitlement to registration of the mark FLATIZZA.

The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file. In addition, the parties agreed to resolve the instant proceeding by way of Accelerated Case Resolution ("ACR"), and stipulated by written agreement that witness testimony would be submitted by declaration, reserving their right to object "to reliance on any of the above, for example, on the grounds of relevancy, hearsay, materiality, weight, and competency."⁴ All evidence would be submitted "through one or more declarations and notices of reliance submitted during each party's respective testimony periods."⁵ The parties further agreed that documents exchanged during discovery are authentic and that the Board may make determinations of genuine issues of material fact.

Opposer's Evidence

Opposer filed four Notices of Reliance.

³ Opposer offered two bases for this claim. First, that Applicant did not use its mark in interstate commerce, and second, that Applicant's only use of its mark constitutes a mutilation or material alteration of what it seeks to register.

⁴ 9 TTABVUE 3.

⁵ *Id.*

Pursuant to Opposer's first Notice of Reliance,⁶ Opposer made of record the March 25, 2015 discovery Deposition of Jon Anderson, Applicant's President, with Exhibits.

Pursuant to the second Notice of Reliance,⁷ Opposer made of record copies of Applicant's menus, sales reports, Opposer's First Set of Document Requests to Applicant and Applicant's responses, Opposer's First Set of Interrogatories to Applicant and Applicant's responses, and Opposer's Requests for Admission to Applicant and Applicant's answers.

Opposer's third Notice of Reliance⁸ made of record the declaration of Jessica Johnson, a trademark attorney employed by Franchise World Headquarters, LLC, which she describes as "a service organization for [Opposer] and companies associated with SUBWAY restaurants."⁹ Attached to her declaration are several confidential Exhibits regarding sales and advertising of Opposer's FLATIZZA sandwiches.

Opposer's fourth Notice of Reliance¹⁰ contains copies of Office records for Applicant's FLATIZZA application (Serial No. 86202552) as well as Opposer's two pending applications for FLATIZZA and FLATIZZAS (Nos. 86250900 and 86251566).

Applicant's Evidence

⁶ At 11 TTABVUE.

⁷ At 13 TTABVUE.

⁸ At 14 and 15 TTABVUE. 15 TTABVUE contains confidential copies of Exhibits filed with Opposer's third Notice of Reliance.

⁹ 14 TTABVUE 6.

¹⁰ At 16 TTABVUE.

Applicant filed the August 13, 2015 Declaration of Jon Anderson, with Exhibits, under Notice of Reliance at 17 TTABVUE.

Standing

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). To establish its standing, Opposer must prove that it has a “real interest” in the proceeding (that is, a “direct and personal stake” in its outcome) and a “reasonable basis” for its belief of damage. *Ritchie* 50 USPQ2d at 1026. Here, Opposer has shown that it uses the mark FLATIZZA nationwide on food items that are essentially identical to those on which Applicant uses its mark FLATIZZA. This is sufficient to show that Opposer has a reasonable belief that it will be damaged by registration of Applicant’s mark. Moreover, Applicant does not contest Opposer’s standing in this case.

Analysis

The parties do not dispute that the marks are confusingly similar and the goods related. The sole issue in this case involves their dispute over priority. In this regard, the record evidence shows that Applicant’s founder and president, Jon Anderson, conceived of the concept of a fast service, Italian style restaurant in 2003 that would be named Readi Spaghetti.¹¹ To promote the restaurant, together with a design team, Mr. Anderson developed several terms for specific menu items. One of the terms they thought of was the term FLATIZZA for a flat pizza. Prior to opening

¹¹ Declaration of Jon Anderson, 17 TTABVUE 5.

the first Readi Spaghetti restaurant, Applicant created a business plan and mock-up menus.¹² A website was established approximately two weeks before the opening of the first restaurant, which opened in Bothell, Washington on September 27, 2012.¹³ Applicant filed its application for the FLATIZZA mark on February 24, 2014 and opened a second restaurant in Kirkland, Washington in June 2014.¹⁴ Because Applicant operated only one restaurant at a single location prior to the filing date of its FLATIZZA application, Opposer claims that Applicant's use was purely intrastate and thus was insufficient to support the use-based application.

Under Trademark Act Section 1(a), only the “owner of a trademark *used in commerce* may request registration of its trademark.” Trademark Act Section 1(a), 15 U.S.C. § 1051(a) (2015) (emphasis added). This provision is made applicable to service marks under Section 3 of the Act, 15 U.S.C. § 1053. “Commerce” is defined by Section 45 as “all commerce which may lawfully be regulated by Congress” and “use in commerce” in association with services occurs when a mark “is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services,” 15 U.S.C. § 1127. It thus follows that before a service mark owner may apply to register its mark with the USPTO on the basis of actual use in commerce under Section 1(a), the mark must have been

¹² 17 TTABVUE 6; Exhibits 9 and 10.

¹³ 17 TTABVUE 6.

¹⁴ *Id.*

displayed in the sale or advertising of the services and the services must have been rendered in a type of commerce over which Congress has regulatory authority, such as interstate commerce or commerce between the United States and a foreign country. In other words, for an application filed under Section 1(a), use in commerce must have been made before the filing date of the application or the application is void. Trademark Act Section 1(a), 15 U.S.C. § 1051(a); *Larry Harmon Pictures Corp. v. Williams Rest. Corp.*, 929 F.2d 662, 18 USPQ2d 1292, 1293 (Fed. Cir. 1991) (“In general, therefore, service marks must be ‘used in commerce’ before they may be registered.”).

In *Harmon*, the court found that a single location restaurant used its mark in connection with services rendered to customers traveling across state boundaries. Acknowledging Congress’s broad powers to regulate interstate commerce under Article 1, section 8 of the United States Constitution (the “commerce clause”), the court held that these services had a direct effect on interstate commerce and were sufficient to show that the applicant’s mark was used in commerce within the meaning of Sections 3 and 45 of the Lanham Act. The evidence in that case established that the applicant was located about an hour’s drive from Memphis, Tennessee, a metropolitan statistical area made up of portions of three different states, Tennessee, Mississippi and Arkansas. The restaurant attracted patrons from Memphis and was featured in publications originating in New York, Washington, D.C., Dallas, Texas and Palm Beach, Florida. The applicant’s witness estimated that 15% of its business each year came from out-of-state customers and submitted

affidavits and letters from persons out of state who had patronized the applicant's restaurant at various times prior to the application filing date. *Larry Harmon*, 18 USPQ2d at 1293 n.1.

While a certain threshold level of interstate activity is not required before registration of the mark used by a single-location restaurant may be granted, some use in commerce must be shown. In this case, Applicant has not shown that its services were rendered to any out-of-state customers. Its restaurant was not shown to have been listed in any travel or restaurant guide. No advertising has been submitted. The record does not support a finding that any viewers (from out-of-state or otherwise) accessed Applicant's website, and the business plan and menu mock-ups were for internal use only. Nor has Applicant shown that its services affected interstate commerce. Although there are situations in which intrastate sales may be found to have such an effect on interstate commerce that the activities constitute acceptable use in commerce for purposes of trademark registration, there must be a showing that the activities have such an effect. *See In re Gastown*, 326 F.2d 780, 140 USPQ 216, 218 (CCPA 1964) (federal registration granted for the service mark of a chain of automobile and truck service stations located only in Ohio; held that the location of some of these stations on interstate highways, the frequent patronage by out-of-state vehicles and persons engaged in interstate commerce, the road service provided to disabled vehicles from out-of-state, and the extension of credit and out-of-state billing were sufficient to show that the services rendered had a "direct effect" on commerce); *compare Silenus Wines*, 557 F.2d 806, 194 USPQ 261,

264 (CCPA 1977) (sale in Massachusetts intimately involved with shipment of wine from France to seller in Massachusetts; activity held sufficient to affect interstate commerce because shipments were necessary for the accomplishment of the sales) *with In re The Bagel Factory, Inc.*, 183 USPQ 553, 554 (TTAB 1974) (sales entirely within Michigan cannot support federal registration even when a customer transported the product to Ohio after sale).

Applicant argues in its brief that its Bothell restaurant is located about .7 miles from I-405 and 3 miles from Interstate-5, which “is the major North/South corridor of the West Coast.”¹⁵ Applicant further argues that it “advertises on the Web, on Facebook and Twitter, and is frequently rated on Yelp with reviews [from] local and out-of-state patrons, such as Arizona, New York, Colorado, Singapore, Florida, and Oregon.”¹⁶ These arguments are unavailing. First, assertions made in a party’s brief are not recognized as evidence. *In re Simulations Publications, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975); *In re Vesoyuzny Ordena Trudovogo Krasnogo Znameni*, 219 USPQ 69, 70 (TTAB 1983); *Spin Physics, Inc. v. Matsushita Electric Co.*, 168 USPQ 605, 607 (TTAB 1970) (the arguments and opinion of counsel are insufficient to overcome the facts). Secondly, there is no record evidence supporting Applicant’s argument that any of its patrons has written a review of its restaurant at any time, let alone before Applicant filed its application. And while the copy of its webpage submitted with Opposer’s second Notice of Reliance invites readers to “Become a fan on Facebook,” “Follow us on Twitter” and “Check Us out

¹⁵ Applicant’s Brief, 23 TTABVUE 12.

¹⁶ *Id.*

on Yelp,”¹⁷ the record does not show that anyone ever took advantage of these entreaties and we do not take judicial notice of the contents of those websites or that in fact, any viewers ever accessed them.¹⁸ *In re Planalytics Inc.*, 70 USPQ2d 1453, 1457 (TTAB 2004) (the mere listing of a link to a website does not make the material that might be found on that website of record).

In considering Applicant’s arguments, we have taken judicial notice of the location of Bothell in the state of Washington as being approximately 20 miles northeast of Seattle, but unlike in *Larry Harmon*, there is nothing in the record to indicate the size or scope of the Seattle metropolitan area at the time the application was filed, or the travel time between Bothell and Seattle, or whether Seattle’s location puts it at a nexus of more than one state. Further, while I-5 traverses Seattle, it is speculation to assume that out-of-state travelers would travel 3 miles off the Interstate highway to patronize Applicant’s restaurant, especially given that the route from I-5 to Bothell would require either driving the distance in a reverse direction or taking side roads. As for the I-405 highway, it is not an interstate highway. We are not convinced that the location of Applicant’s restaurant is such as to compel a presumption that Applicant’s services have had an effect on interstate commerce.

¹⁷ 13 TTABVUE 8.

¹⁸ Applicant’s website evidence consists of a copy of a single web page at which the menu for FLATIZZA pizza is displayed. The page bears a 2012 copyright notice, which supports Applicant’s declarant’s assertion that the website was active prior to the opening of the Bothell restaurant. However, the contents of the page do not support Applicant’s assertions that viewers came from outside the state of Washington, or that it was ever rated on Yelp. The links merely invite readers to link to Facebook, Twitter, or Yelp but do not demonstrate that any readers did so, or where they originated from (in-state or out-of-state).

In order to meet the use requirement of the Lanham Act, it is not required that the services be rendered in more than one state. *Larry Harmon*, 18 USPQ2d at 1295. However, if they are not, then it is required that the services impact interstate commerce. Applicant has failed to show that its use of the mark FLATIZZA prior to the filing date of its service mark application was either rendered in more than one state or had an impact on interstate commerce. Accordingly, Applicant has not satisfied the Trademark Act Section 1(a) use-in-commerce requirement.

Because we find that Applicant did not make use of its mark prior to the filing date of the application we need not reach the issue of whether Applicant made proper use of the FLATIZZA mark, given that its specimens displayed the mark as PIZZA – FLATIZZA! However, for the sake of completeness, we consider the evidence and arguments regarding this issue. We find that Applicant’s use of PIZZA – FLATIZZA! is not a mutilation or material alteration of the applied-for mark FLATIZZA. See *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257, 260 (CCPA 1950) (allowing registration for SERVEL where specimens of use displayed the mark as SERVEL INKLINGS); *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989) (registration refusal reversed; applied-for mark TINEL-LOCK had a separate commercial impression from the other matter in the specimens that showed TRO6AI-TINEL-LOCK-RING); *In re Sansui Electric Co., Ltd.*, 194 USPQ 202 (TTAB 1977) (Board allowed registration of QSE and QSD; specimens showed use

as QSE-4 and QSD-4). Applicant's use of the mark in the form PIZZA – FLATIZZA! constitutes proper use of the mark FLATIZZA.

Nonetheless, because we find that Applicant used the mark FLATIZZA only in connection with a single location restaurant prior to the filing date of its Section 1(a) application, and that such use was not in interstate commerce and had no impact on interstate commerce, the application is *void ab initio*.

Concurrent Use

Seeking a concurrent use registration, Opposer has amended its FLATIZZA application Serial No. 86250900 to a geographically restricted application and named Applicant as the sole excepted user and owner of the application that is the subject of this opposition proceeding. Opposer's witness, Ms. Johnson, testified that "[b]eginning on February 1, 2014, [Opposer] began using the FLATIZZA mark in direct association [with] open-faced flatbread sandwiches in more than twenty-seven thousand SUBWAY Restaurants in each of the fifty states of the United States ('National Launch')." ¹⁹ Opposer contends that it is entitled to a concurrent use registration for the entire United States with the exception of Snohomish and King counties in Washington State, the area in which Opposer alleges Applicant has actually used its mark. By showing that it used the mark FLATIZZA on a nationwide basis prior to the filing date of Applicant's application, Opposer meets the jurisdictional requirement for a concurrent use proceeding. Trademark Act Section 2(d).

¹⁹ 14 TTABVUE 9.

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Decision: The opposition is sustained and Applicant's application for the mark FLATIZZA is refused registration under Section 1(a) of the Trademark Act.

A concurrent use proceeding will be instituted with respect to Serial No. 86250900 in due course.