

This Opinion is not a
Precedent of the TTAB

Hearing: November 13, 2018

Mailed: November 15, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Peter Piper, Inc.
v.
OTG Experience, LLC
—

Opposition No. 91230289
—

Ray K. Harris and Stacie K. Smith of Fennemore Craig, P.C.,
for Peter Piper, Inc.

Jordan A. LaVine of Flaster Greenberg PC,
for OTG Experience, LLC.

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Before Bergsman, Adlin and Hightower,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

OTG Experience, LLC (Applicant) filed applications to register PETER PIPER
(standard characters) for:

Mobile automated machine that accepts orders for,
dispenses and packages for delivery various food and retail
items; Vending machines, mobile vending machines, and
automatic vending machines, in Class 7;

Motor vehicles, namely, automobiles that accepts orders
for, dispenses and packages for delivery various food and
retail items, in Class 12; and

Order fulfillment services; retail store services featuring machines for order fulfillment; rental and leasing of machines for order fulfillment in the nature of vending machines, in Class 35;

and PETER PIPER SMARTRUCK (standard characters) for:

Mobile automated machine that accepts orders for, dispenses and packages for delivery various food and retail items; Vending machines, mobile vending machines, and automatic vending machines, in Class 7; and

Order fulfillment services; Wholesale and retail store services featuring mobile vending machines for order fulfillment; leasing and rental of mobile vending machines; Mobile vending in the field of convenience store items, in Class 35.¹

Peter Piper, Inc. (Opposer) filed an opposition under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's marks so resemble Opposer's registered PETER PIPER PIZZA marks as to be likely to cause confusion.² Opposer's most relevant pleaded registrations are:

- Registration Nos. 4101250 and 4432382 for the mark PETER PIPER PIZZA (standard characters) for "pizza," in Class 30;³ and "restaurant services," in Class 43.⁴

Opposer disclaimed the exclusive right to use the word "Pizza" in both registrations.

¹ Application Serial Nos. 8659399 and 86594003, respectively, each filed April 10, 2015, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's bona fide intent to use the marks in commerce.

² Opposer also alleged that Applicant's mark will dilute Opposer's marks. Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). Inasmuch as Opposer did not pursue this claim in its brief, it is waived. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff'd*, 565 Fed. Appx. 900 (Fed. Cir. 2014).

³ Registered February 21, 2012; Sections 8 and 15 declaration accepted and acknowledged.

⁴ Registered November 12, 2013.

Applicant, in its Answer, denied the salient allegations in the Notice of Opposition.

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the application files at issue.⁵ The parties introduced the following testimony and evidence:

A. Opposer's testimony and evidence.

1. Notice of reliance on the following items:

- a. Copies of Opposer's pleaded registrations printed from a USPTO electronic database showing the current status of and title to the registrations;⁶
- b. Applicant's admissions in response to Opposer's requests for admission Nos. 1-3;⁷
- c. Applicant's written responses to Opposer's interrogatory Nos. 1-5;⁸
- d. Applicant's written responses to Opposer's request for the production of documents Nos. 2-7;⁹

⁵ Because Applicant's application files and the pleadings are of record by operation of the Trademark Rules of Practice, there was no need for Opposer to introduce them through a notice of reliance. 10 TTABVUE 8-35 and 86-97.

⁶ 10 TTABVUE 37-79.

⁷ 10 TTABVUE 99-101.

⁸ 9 TTABVUE 103-11 (improperly designated confidential). There is nothing in the interrogatory answers that constitute trade secret or commercially sensitive information. Pursuant to Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g), "[t]he Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party." Accordingly, we are not bound by the confidential designation of the interrogatory responses.

⁹ 10 TTABVUE 104-08. We consider Applicant's responses only to the extent that they state that there are no responsive documents. *See City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion*

- e. Excerpts from Applicant's website;¹⁰ and
 - f. A copy of Trademark Registration No. 3583951 for the mark AN OTG EXPERIENCE (standard characters) for "restaurant and bar services," in Class 43, and the accompanying assignment recordation;¹¹
2. A notice of reliance on the following:
- a. A copy of Patent No. 9114748;¹²
 - b. An excerpt from Applicant's website;¹³
 - c. "Commercial Service Airports (Rank Order), based on Calendar Years 2016 Enplanements" accessed from faa.gov;¹⁴ and
 - d. Applicant's written response to Opposer's request for production of documents No. 2;¹⁵ and
3. Testimony deposition of William Toole, Opposer's Chief Operating Officer.¹⁶
- B. Applicant's testimony and evidence.

OPGI Inc., 106 USPQ2d 1668, 1674 n.10 (TTAB 2013) (responses to document production requests are admissible solely for purposes of showing that a party has stated that there are no responsive documents); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 n.7 (TTAB 2012) (written responses to document requests indicating that no documents exist may be submitted by notice of reliance).

¹⁰ 10 TTABVUE 110-13.

¹¹ 10 TTABVUE 115-23.

¹² 11 TTABVUE 6-24.

¹³ 11 TTABVUE 26.

¹⁴ 11 TTABVUE 28.

¹⁵ 11 TTABVUE 30-34. See n.9 *supra*.

¹⁶ 12 TTABVUE. Opposer failed to include a word index required by Trademark Rule 2.123(g)(3), 37 C.F.R. § 2.123(g)(1), thus making the review of the deposition transcript more difficult than necessary.

Applicant introduced the testimony deposition of Justin Blatstein, Applicant's Director of Aura.¹⁷

II. Standing

Standing is a threshold issue in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). To establish standing in an opposition or cancellation proceeding, a plaintiff must prove that it has a "real interest," i.e., a "reasonable" basis for its belief of damage. *See Empresa Cubana*, 111 USPQ2d at 1062; *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 (TTAB 1982).

Opposer has established its standing by properly introducing into evidence its pleaded registrations. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015). Applicant, in its brief, does not contest Opposer's standing.

¹⁷ 20 TTABVUE. Trademark Rule 2.123(g)(1), 37 CFR § 2.123(g)(1), "[t]he deposition transcript must be submitted in full-sized format (one page per sheet), not condensed (multiple pages per sheet)."

The portions of the Blatstein deposition designated confidential are posted at 30 TTABVUE. Blatstein Dep. Exhibits 17 and 18, designated confidential, are posted at 19 TTABVUE 87-116.

III. Priority

Because Opposer's pleaded registrations are of record, priority is not at issue with respect to the goods and services identified therein. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)). In any event, Applicant has conceded that Opposer has priority.¹⁸

IV. Likelihood of confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*") cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant or for which there is evidence of record. See *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) ("While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant."). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *In re Chatam Int'l Inc.*, 380 F.3d 1340,

¹⁸ Applicant's response to Opposer's request for admission No. 2. (10 TTABVUE 100).

71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. Fame

Opposer has pleaded and argued that its PETER PIPER PIZZA marks are famous. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp.*

v. QSC Audio Prods. Inc., 63 USPQ2d at 1305-06, 1309. Raw numbers alone may be misleading, however. Thus, some context in which to place raw statistics may be necessary, for example, market share or sales or advertising figures for comparable types of goods. *Id.* at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

Opposer, in its brief, contends that its PETER PIPER PIZZA marks are famous for the following reasons:¹⁹

- The PETER PIPER PIZZA marks have been in use for over forty years;²⁰
- The revenue generated under the PETER PIPER PIZZA marks is approximately \$300 million per year across its 145 locations;²¹ and
- Opposer spends approximately \$20 million annually advertising and promoting the PETER PIPER PIZZA marks.²²

However, this evidence does not establish that PETER PIPER PIZZA is famous. Long use, without evidence of the extent of consumer exposure to or recognition of

¹⁹ Opposer's Brief, pp. 16-17 (13 TTABVUE 18-19).

²⁰ Toole Testimony Dep., p. 6 (12 TTABVUE 9).

²¹ Toole Testimony Dep., p. 6 (12 TTABVUE 9).

²² Toole Testimony Dep., p. 12 (12 TTABVUE 15).

the mark over the years, is not sufficient by itself to prove fame. *Wet Seal Inc. v. FD Mgt. Inc.*, 82 USPQ2d 1629, 1635 (TTAB 2007); compare *Nina Ricci, S.A.R.L. v. ETF Enters., Inc.*, 203 USPQ 947, 951 (TTAB 1979) (“Not only has opposer enjoyed long use of its ‘RICCI’ marks, but the record shows the fame, prestige and reputation which the name ‘NINA RICCI’ has brought to opposer as evidenced by the numerous newspaper articles and reports of opposer’s activities in the ladies’ apparel fields, previously referred to.”).

While Opposer has 145 locations, that number includes 43 locations in Mexico.²³ Because foreign use of a mark does not ordinarily influence purchaser perceptions in this country, and the evidence does not demonstrate that it does in this case, Applicant’s foreign use is irrelevant. See *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991) (information concerning applicant’s foreign activities is not relevant to the issues in an opposition proceeding); *Johnson & Johnson v. Salve S.A.*, 183 USPQ 375, 376 (TTAB 1974) (since foreign trademark use creates no rights in the United States, any information or evidence pertaining to foreign use is thus immaterial to a party’s right to register its mark in the United States); *Oland’s Breweries [1971] Ltd. v. Miller Brewing Co.*, 189 USPQ481, 489 n.7 (TTAB 1975) (use or promotion of a mark confined to a foreign country, including Canada, is immaterial to ownership and registration in U.S.), *aff’d*, *Miller Brewing Co. v. Oland’s Breweries*, 548F.2d 349, 192 USPQ 266 (CCPA 1976).

²³ Toole Testimony Dep., p. 6 (12 TTABVUE 9).

Thus, we do not know what percentage of Opposer's \$300 million in revenue or \$20 million in advertising and marketing represent activities in the United States.

Nevertheless, as noted above, 102 of the 145 restaurants or 70% are located in the United States. Presumably, much of Applicant's revenue is generated in the United States and much of its advertising and marketing budget is spent in the United States.²⁴ Opposer's revenues and advertising expenditures in the United States undoubtedly are significant.

On the other hand, Opposer did not provide any context for us to assess the meaning of Opposer's revenues and advertising expenditures. For example,

- There is no testimony or evidence as to Opposer's market share in the restaurant business, in the pizza restaurant business, or in regard to pizza;
- There is no testimony or evidence as to how Opposer's advertising and marketing expenditures compare to Opposer's competitors; and
- There is no testimony or evidence as to how many consumers have encountered or are familiar with Opposer's marks.²⁵

In the likelihood of confusion analysis, "fame 'varies along a spectrum from very strong to very weak.'" *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857

²⁴ Mr. Toole testified that each franchisee is required to spend 7% of its revenues on marketing and advertising. Toole Dep., p. 12 (12 TTABVUE 15).

²⁵ Mr. Toole testified that Opposer's "legacy markets where we have been for the longest - - Texas, Arizona, Las Vegas, Albuquerque, New Mexico, throughout Mexico - - as you mentioned, those are the markets that we have been in the longest." Toole Testimony Dep., pp. 44-45 (12 TTABVUE 47-48). Opposer intends to open restaurants in central and south Florida and in Dallas, Texas. *Id.* at 6-7 (12 TTABVUE 9-10). Based on the record before us, Opposer has a presence in five states.

F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)). Opposer's testimony and evidence shows that Opposer's PETER PIPER PIZZA is a successful and growing brand, not that the PETER PIPER PIZZA trademark is famous. The evidence establishes that PETER PIPER PIZZA is a commercially strong mark entitled to a broad scope of protection or exclusivity of use in connection with pizza and restaurant services, but it does not have the extensive public recognition and renown of a famous mark.

B. The number and nature of similar marks in use on similar goods and in connection with similar services.

Applicant introduced excerpts from third-party websites using PETER PIPER as a trademark:²⁶

- Peter Piper's Pickle Palace (peterpiperspicklepalace.com), with three locations in Kutztown, Gilbertsville, and Leesport, Pennsylvania, advertising pickles and olives;²⁷
- Peter Piper Pepper soy sauce (jaredpacific.com) advertising soy sauce;²⁸ and

²⁶ The Peter Piper Memorial Conference sponsored by The Caloosa Veterinary Medical Society "offering programs for veterinarians, technicians, practice management, and reception," is not relevant because those activities have nothing to do with the goods and services identified in the pleaded registrations or involved applications. Blatstein Dep., Exhibit 14 (20 TTABVUE 69). See *SBS Products Inc. v. Sterling Plastic & Rubber Products Inc.*, 8 USPQ2d 1147, 1149 n.6 (TTAB 1988) ("[E]ven if evidence of such third-party use were submitted, it would be of no aid to respondent herein where the third-party usage was for goods unrelated to either petitioner's skin care products or respondent's stuffing box sealant.").

²⁷ Blatstein Dep. Exhibit 10 (20 TTABVUE 50-53).

²⁸ Blatstein Dep., Exhibit 11 (20 TTABVUE 54).

- Peter Piper Porter, a porter brewed by Salamander Brewing (untapped.com).²⁹

Applicant also introduced a “Peter Piper Pickled Prawns” Martha Stewart recipe (marthastewart.com).³⁰

While Applicant has not presented evidence concerning the extent or impact of these uses, it nevertheless presented evidence of these marks [incorporating the name “Peter Piper”] being used in Internet commerce for food and beverages or their sale and preparation. “Evidence of third-party use of similar marks on similar goods [or services] is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (citation omitted). Internet printouts, such as those offered by Applicant, “on their face, show that the public may have been exposed to those internet websites and therefore may be aware of the advertisements contained therein.” *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011). While the Federal Circuit has held that “extensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established,” see *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)), the record

²⁹ Blatstein Dep., Exhibit 13 (20 TTABVUE 63-68).

³⁰ Blatstein Dep., Exhibit 12 (20 TTABVUE 55-61).

of third-party use in this case reflects a much more modest accumulation of evidence than that found convincing in *Jack Wolfskin* and *Juice Generation* wherein “a considerable number of third parties’ use [of] similar marks was shown.” *Id.* Ultimately, we do not believe the much more limited evidence of weakness here is nearly as persuasive as in either *Juice Generation* or *Jack Wolfskin*.

In assessing the strength of Opposer’s mark, we must also analyze its conceptual strength or inherent strength. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006). We find that the mark PETER PIPER PIZZA (“Pizza” disclaimed) used in connection with pizza and restaurant services is an arbitrary term and, therefore, inherently distinctive.³¹ There is nothing that prohibits Opposer from adopting the name of a public domain nursery rhyme character and using it as a trademark for goods or services unrelated to the subject of the nursery rhyme. *Cf. In re United Trademark Holdings, Inc.*, 122 USPQ2d 1796, 1798-99 (TTAB 2017) (LITTLE MERMAID is merely descriptive of a doll featuring

³¹ Applicant concedes that Opposer’s mark PETER PIPER PIZZA is not descriptive when used in connection with pizza and restaurant services. Applicant’s Brief, p. 2 (16 TTABVUE 5). Also, at the oral hearing, Applicant argued that PETER PIPER PIZZA is suggestive. Even if we accepted Applicant’s argument, PETER PIPER PIZZA would be inherently distinctive.

the appearance of a young or small mermaid conveying the commercial impression of the fictional public domain character); *In re Carlson Dolls Co.*, 31 USPQ2d 1319, 1320 (TTAB 1994) (MARTHA WASHINGTON for “historical dolls” is merely descriptive because the mark identifies an historical figure). The cases Applicant cite in its brief do not hold otherwise.³² See, e.g., *Am. Montessori Soc’y, Inc. v. Ass’n Montessori Internationale*, 155 USPQ 591, 593 (TTAB 1967) (“if the term ‘MONTESSORI’ is generic and/or descriptive as applied to the ‘MONTESSORI’ teaching methods, it is equally so as used in connection with toys, games, teaching aids, and other material employed in connection with said methods”); *Atmore & Son, Inc. v. United Biscuit Co. of Am.*, 123 UPSQ 241, 242 (TTAB 1959) (“purchasers would not be likely to assume, merely because of the similarity of the marks [consisting of or comprising JACK HORNER], that a mincemeat pie filling and sandwich cookies emanate from the same source.”).

C. Similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs.*, 101 USPQ2d at 1721; see also *Midwestern Pet Foods, Inc. v. Societe des Produits*

³² Applicant’s Brief, pp. 12-13 (16 TTABVUE 15-16).

Nestle S.A., 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

The marks are similar because they share the name PETER PIPER. Opposer's addition of the descriptive word "Pizza" has little, if any, bearing in our analysis because it is a generic term when used in connection with pizza and restaurant services. It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'") (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression"). While our analysis of the similarity or dissimilarity of the marks must be predicated on the marks in their entireties, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Nat'l Data Corp.*, 224 USPQ at 751; *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

In addition, the importance of the name PETER PIPER in Opposer's marks PETER PIPER PIZZA and Applicant's mark PETER PIPER SMARTRUCK is further established because PETER PIPER is the first part of the marks. *See Palm Bay Imports Inc.*, 73 USPQ2d at 1692 ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (dominance of BARR in the mark BARR GROUP is reinforced by its location as the first word in the mark); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"). Thus, consumers encountering PETER PIPER SMARTRUCK who are familiar with Opposer's PETER PIPER PIZZA may mistakenly believe that PETER PIPER SMARTRUCK is a food truck, or similar vehicle, with Internet capability and, thus, a variation of or new method of distributing the PETER PIPER PIZZA pizza and restaurant services with which they are familiar.³³

³³ "Smart" is defined, inter alia, as "operating by automation" or "using a built-in microprocessor for automatic operation, for processing of data, or for achieving greater versatility." Merriam-Webster.com. The Board may take judicial notice of dictionary definitions, including online dictionaries. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

While there is no ironclad rule that marks must be found to be similar where one incorporates the entirety of another, it often increases the similarity between the two, and does so here. *See, e.g., In re Mighty Leaf Tea*, 601 USPQ2d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant's mark ML is similar to opposer's mark ML MARK LEES both for personal care and skin products); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (THE LILLY as a mark for women's dresses is likely to be confused with LILLI ANN for women's apparel including dresses); *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1660 (TTAB 2014) (applicant's mark PRECISION is similar to opposer's mark PRECISION DISTRIBUTION CONTROL); *In re U.S. Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (CAREER IMAGE for women's clothing stores and women's clothing likely to cause confusion with CREST CAREER IMAGES for uniforms including items of women's clothing). In *U.S. Shoe*, the Board observed that "Applicant's mark would appear to prospective purchasers to be a shortened form of registrant's mark." 229 USPQ at 709.

Likewise, consumers may perceive PETER PIPER to be a shortened form of Opposer's mark PETER PIPER PIZZA. Mr. Toole testified that Opposer's customers refer to Opposer as PETER PIPER.³⁴ *See Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) ("Although the record does not indicate that applicant's business is commonly referred to as "Giant", it does indicate that people have called it by that name, omitting the word "Hamburgers".

³⁴ Toole Dep., p. 10 (12 TTABVUE 13).

Thus, in a conversation between two consumers in opposer's area about a place of business called "Giant", there likely would be confusion about which "Giant" they were talking about."); *Big M Inc. v. U.S. Shoe Co.*, 228 USPQ 614, 616 (TTAB 1985) ("[W]e cannot ignore the propensity of consumers to often shorten trademarks and, in the present case, this would be accomplished by dropping the 'T.H.' in referring to registrant's stores [T.H. MANDY].").

We find that Applicant's marks PETER PIPER and PETER PIPER SMARTRUCK are similar to Opposer's mark PETER PIPER PIZZA in appearance, sound, connotation, and commercial impression.

D. The similarity or dissimilarity and nature of the goods and services.

Applicant is a service provider for airports.

We create unique experiences inside of airports and we do that a couple of different ways. We build, own and operate our own restaurants, retail grab-and-go markets and locations, consumer locations within the airport.³⁵

Applicant's PETER PIPER and PETER PIPER SMARTRUCK services are intended to be

... a back-end solution for order fulfillment. It would receive orders and fulfill - - pick, pack and sort – different orders for different kinds of goods, whether it's magazines, food, beverage – food, prepackaged food, beverage, headphones, different gifts, neck pillows, anything. It's an order fulfillment back-end solution.³⁶

³⁵ Blatstein Dep., pp. 6-7 (20 TTABVUE 6).

³⁶ Blatstein Dep., p. 17 (30 TTABVUE 18) (improperly designated confidential). Applicant filed applications to register PETER PIPER and PETER PIPER SMARTRUCK which puts consumers and competitors on notice as to the goods and services for which registration is sought. Thus, it is hard to fathom how testimony expounding on the description of goods and services can be designated as confidential when that testimony does not contain any trade

* * *

What Peter Piper is is [sic] it's a vending apparatus that picks, packs and sorts items.³⁷

* * *

Because [Applicant's PETER PIPER] is not a restaurant. It's not a restaurant or food and beverage location. It's a mobile – It's a technology. It's a mobile vending apparatus and would only be branded with the brand that it is going to be - - the product that it's going to be served with.³⁸

Applicant “intends to use its marks solely in connection with its unique food delivery services at United States transportation venues, whereby customers can remotely order various food items that will be delivered to them for consumption on transportation carriers.”³⁹ There is nothing in Applicant's description of goods or services precluding pizza from being a product available using Applicant's services.⁴⁰

Nevertheless, in assessing the similarity or dissimilarity of the goods and services, we must consider the goods as they are described in the application and registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys, Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant's mark must be decided on the basis

secret or commercially sensitive information. Pursuant to Trademark Rule Trademark Rule 2.116(g), we are not bound by Applicant's improper designation of the Blatstein testimony as being confidential. See n.8 *supra*.

³⁷ Blatstein Dep., p. 36 (20 TTABVUE 13).

³⁸ Blatstein Dep., p. 41 (20 TTABVUE 14).

³⁹ Applicant's responses to Opposer's interrogatory Nos. 1-5 (9 TTABVUE 104-09) (improperly designated confidential).

⁴⁰ *Id.*

of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”).

Also, we may not read limitations into the description of goods or services. *In re i.am.symbolic, LLC*, 123 USPQ2d at 1748; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) (“There is no specific limitation and nothing in the inherent nature of Squirtco’s mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration.”); *Thor Tech*, 90 USPQ2d 1634, 1638 (TTAB 2009) (“We have no authority to read any restrictions or limitations into the registrant’s description of goods.”). Accordingly, it is irrelevant that Opposer does not currently provide any products or services in airports because there is nothing in Opposer’s description of services for restaurant services that prevents Opposer from rendering restaurant services in airports.⁴¹ Likewise, we cannot give any probative value to Applicant’s argument that it does not intend to use its marks in connection with offering food-related services or products sold directly end consumers at airports, because there is nothing in Applicant’s description of goods and services that prevents Applicant from offering those goods and services to the ultimate consumers at airports.⁴²

Applicant is seeking to register its marks for:

⁴¹ Applicant’s Brief, p. 5 (16 TTABVUE 8) (citing Toole Dep., p. 36 (12 TTABVUE 39)).

⁴² *Id.* at page 6 (16 TTABVUE 9) (citing Blatstein Dep., pp. 40-41 (20 TTABVUE 14); *see also* Blatstein Dep., p. 18 (30 TTABVUE 19) (end consumer will not see the vending apparatus) and p. 56 (30 TTABVUE 57) (PETER PIPER will not be the main branding to customer facing units)).

Mobile automated machine that accepts orders for, dispenses and packages for delivery various food and retail items; Vending machines, mobile vending machines, and automatic vending machines;

Motor vehicles, namely, automobiles that accepts orders for, dispenses and packages for delivery various food and retail items;

Order fulfillment services; retail store services featuring machines for order fulfillment; rental and leasing of machines for order fulfillment in the nature of vending machines;⁴³ and

Order fulfillment services; wholesale and retail store services featuring mobile vending machines for order fulfillment; leasing and rental of mobile vending machines; Mobile vending in the field of convenience store items.⁴⁴

⁴³ A “vending machine” is defined “a coin-operated machine for selling small articles, beverages, etc.” Dictionary.com based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2018).

During the 1940s and '50s the vending machine business was concentrated in plants and factories, and by the end of that period, machines were being used to sell a wide variety of freshly prepared as well as prepackaged foods to replace or supplement traditional in-plant food service facilities. ...

The ability of vending machines to sell products at competitive prices around the clock without regard to holidays is now widely recognized. The business has grown beyond plants and factories, and machines are commonly used in schools, colleges and universities, recreation centres, health care facilities, offices, and the like.

Vending machines, *ENCYCLOPAEDIA BRITANNICA*. The Board may take judicial notice of information from encyclopedias. *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (“dictionaries and encyclopedias may be consulted”).

⁴⁴ A “convenience store” is defined as “a retail store that carries a limited selection of basic items, as packaged foods and drugstore items, and is open long hours for the convenience of shoppers.” Dictionary.com based on the Random House Unabridged Dictionary (2018).

Located primarily near residential areas, convenience stores are relatively small outlets that are open long hours and carry a limited line of high-turnover convenience products at high

Applicant's description of goods and services thus includes machines and services that provide food delivery.

The description of goods and services in Opposer's pleaded registrations are pizza and restaurant services. Opposer's arcades attached to restaurants feature vending machines that dispense candy and other non-perishable items, but not other types of food.⁴⁵ Customers "can order through [Opposer's] website or through these Door Dash/Grub Hub platforms and have their Peter Piper meal delivered."⁴⁶ Opposer maintains an online ordering platform, permitting guests to order Opposer's food products using desktops, laptops, and mobile devices.⁴⁷ Moreover, it is common knowledge that many pizza restaurants deliver.

It is only necessary that there be a viable relationship between the goods and services to support finding a likelihood of confusion. *In re Concordia Int'l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983). The issue here, of course, is not whether purchasers would confuse the parties' goods and services, but rather whether there is a likelihood of confusion as to the source of these goods and services. *In re Cook Medical Technologies LLC*, 105 USPQ2d 1377, 1380 (TTAB 2012); *Helene Curtis*

prices. Although many have added food services, consumers use them mainly for "fill-in" purchases, such as bread, milk, or miscellaneous goods.

Marketing and merchandising, *ENCYCLOPAEDIA BRITANNICA*.

⁴⁵ Toole Dep., p. 20 (12 TTABVUE 23).

⁴⁶ Toole Dep., p. 10 (12 TTABVUE 13).

⁴⁷ *Id.* at 9 (12 TTABVUE 12).

Indus. Inc. v. Suave Shoe Corp., 13 USPQ2d 1618, 1624 (TTAB 1989); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Consumers familiar with Opposer's PETER PIPER PIZZA pizza and restaurant services encountering Applicant's PETER PIPER and PETER PIPER SMARTRUCKS marks in connection with vending machines featuring various food products, motor vehicles that take orders and dispense, package and deliver various food items, and order fulfillment services featuring food could because of the similarity of the marks mistakenly believe that the goods and services originate from the same source or are in some way associated with the same producer. *Coach Servs.*, 101 USPQ2d at 1722; *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010). Reading the description of goods and services broadly, as we must, we find that the parties' goods and services are related.

E. Established, likely-to-continue channels of trade and buyers to whom sales are made.

Where, as here, there are no limitations in the pleaded registration's or involved applications' descriptions of goods or services, we must presume that the goods and services are offered in all channels of trade that would be normal for such goods and services and that they would be purchased by all potential customers. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Paula Payne Prods. Co. v. Johnson Publ'g Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77-78 (CCPA 1973).

While restaurant and pizza services may be offered in different channels of trade than vending machines and vending machine services, they are offered in the same channels of trade as automobiles that deliver food and order fulfillment services (including those provided by vending machines) that may include pizza. Moreover, the goods and services described in the applications and registrations are offered to the same ordinary consumers.

We find that the channels of trade and buyers to whom sales are made are similar.

F. Conditions under which sales are made, i.e., “impulse” vs. careful, sophisticated purchasing.

Applicant argues that its customers will not be average consumers shopping at retail stores, but rather airports and airlines seeking to offer products through machines, and that it will take weeks to complete the purchasing process and obtain the necessary approvals for operating the machines.⁴⁸ However, as noted above, there is nothing in Applicant’s description of goods and services that precludes sales to the ultimate, ordinary consumers. We cannot resort to extrinsic evidence to restrict the consumers to whom sales will be made and, thus, improperly characterize the sales process. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 110 USPQ2d at 1163-64 (recognizing that the Board properly considered all potential investors for the recited services, not just applicant’s actual investors); *In re Sailerbrau Franz Sailer*, 23 USPQ2d 1719, 1720 (TTAB 1992) (finding that all purchasers of wine may not be discriminating); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB

⁴⁸ Applicant’s Brief, pp. 15-16 (16 TTABVUE 18-19).

1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration).

G. Balancing the factors.

Because the marks are similar, the goods and services are related and are offered in some of the same channels of trade to the same classes of consumers, we find that Applicant's marks PETER PIPER and PETER PIPER SMARTRUCK for the identified goods and services are likely to cause confusion with the registered mark PETER PIPER PIZZA for pizza and restaurant services.

Decision: The opposition is sustained and registration of Applicant's marks is refused.