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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92044254
Party	Plaintiff Theme Food, Inc.
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Attachments	Petitioner's Reply Brief.pdf (6 pages)(178239 bytes)

**In The United States Patent and Trademark Office
Before the Trademark Trial And Appeal Board**

In the Matter of Registration No. 2,336,220
Date of Issue: March 28, 2000

THEME FOOD INC.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92044254
)	
LIVE BAIT, L.L.C.)	
)	
Respondent.)	
)	

PETITIONER'S REPLY BRIEF

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I. Petitioner Has Established the Elements Necessary For Cancellation

In order to cancel the mark under Section 2(d), the Petitioner must demonstrate both priority of use and likelihood of confusion. Petitioner has satisfied both of the elements necessary for the Board to cancel Reg. No. 2,336,220.

A. Priority

Respondent does not dispute Petitioner's priority of use.

Petitioner has clearly established priority of use. Petitioner Theme Food Inc. has continuously used the mark "LIVE BAIT" in connection with its restaurant services prior to the Registrant's first date of use; Petitioner began its use in September 1987 while Respondent's predecessor-in-interest began its use in 1993 (Humphries Dep. 47:9-18 May 7, 2007). Petitioner has provided evidence of its prior usage including publications which featured Petitioner's mark throughout the U.S. prior to 1993.

Accordingly, Petitioner has demonstrated priority of use and this element is not challenged by Respondent.

B. Likelihood of Confusion

The mark in the '220 Registration is identical to Petitioner's mark. Nevertheless, Respondent argues that there is no likelihood of confusion because Respondent uses its mark in conjunction with a fish skeleton logo and two slogans. However, Respondent's mark in the '220 Registration is the word mark LIVE BAIT; no additional logos or slogans are present or registered. The mark in the '220 Registration has an identical overall appearance, sound, connotation, and commercial impression as compared with Petitioner's mark; this heavily favors a finding of a likelihood of confusion.

The recitation of services in Respondent's '220 Registration is simply "restaurant services". These services are identical to Petitioner's restaurant services. Respondent argues that

its services are different than Petitioner's services because the theme of Respondent's restaurant is a beach and/or waterfront theme whereas Petitioner's restaurant has a "southern style roadhouse type menu" that evokes images of a truck stop somewhere in Carolina. This argument is legally irrelevant because in a TTAB proceeding, the question of likelihood of confusion must be determined based on an analysis of the goods and/or services recited in the registration, not what any proffered evidence shows the goods to be. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.3d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Since the recitation of services in the '220 Registration lists the Respondent's services as general "restaurant services", the theme of the restaurant is irrelevant. Furthermore, while there may be subtle thematic differences between the parties' restaurants, there are many more similarities than differences between the fundamental theme of the restaurants. Both restaurants feature a casual atmosphere, simple casual menu, hats/shirts for sale, and "primitive" lettering of LIVE BAIT. Registrant's restaurant services are generally duplicative of those of Petitioner. Indeed the parties' services are virtually identical. This is highly probative of a likelihood of confusion, especially when considering the identical wording and appearance of the marks.

Since Respondent's services are identical to Petitioner's services and the parties' marks are identical, both marks are likely to be encountered by the same persons under circumstances that would give rise to the mistaken belief that the parties' respective services originate from or are sponsored by the same source. Petitioner has clearly established a likelihood of confusion.

The continued existence of the '220 Registration is likely to cause harm and damage to Petitioner in that it falsely represents to the public that Respondent has rights in and to the LIVE BAIT mark inconsistent with those of Petitioner as a prior user, and that there is a false presumption of rights to the '220 Registration which are inconsistent with Petitioner's superior rights. Further, the '220 Registration falsely suggests to the public that, by virtue of the registration, there is an association between Petitioner and Respondent with respect to the LIVE BAIT mark or that Respondent's restaurant services are in some manner associated with

Petitioner. The '220 Registration also wrongfully prevents Petitioner from registering its previously used mark.

II. Respondent's Request for a Geographic Limitation on Respondent's Registration Must be Denied

Respondent argues at length in its brief that if the Board finds that there is a likelihood of confusion between the parties' identical marks which are used in connection with identical services, Respondent as an alleged innocent adopter should be entitled to maintain its registration with a geographic limitation on the registration for New York City.¹ See Registrant's Main Brief dated February 27, 200, pp. 6- 43. However, under Section 18 of the Trademark Act, a geographic limitation to a registration cannot be made in a cancellation proceeding. The *Weiner King* case upon which Respondent bases its request for a geographic restriction on its registration involved a concurrent use proceeding and a cancellation proceeding and a civil litigation rather than a cancellation proceeding alone.

In *Selfway, Inc v. Travelers Petroleum, Inc.*, 579 F.2d 75 (CCPA 1978) the court found that under Section 18 of the Lanham Act, the Board could not place geographical limitations on a registration in a cancellation proceeding and the only relief available in a cancellation proceeding is an entire cancellation of a registration. See also *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815 (TTAB 1990) (The Board cannot partially cancel a registration in a cancellation proceeding by placing geographical restrictions thereon because "the Commissioner has elected to exercise his authority to geographically restrict a registration only in the context of a concurrent use proceeding"). Accordingly, Respondent's request for a geographical limitation on the registration must be denied. Instead, since Petitioner has shown a likelihood of confusion the Petitioner's petition should be granted and the Respondent's mark must be cancelled in its entirety.

¹ It is noted that while Respondent claims to have expanded its usage, its restaurant services are offered essentially in one small geographic location, greater Orange Beach, Alabama having a population substantially smaller than that of New York City, a "world capital" tourist destination with a population of approximately eight million people.

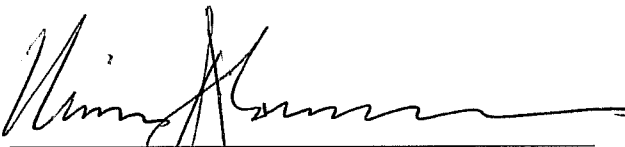
III.

CONCLUSION

The evidence of record establishes that there is a likelihood of confusion because the parties' marks and goods and services are identical. Petitioner has priority of use; accordingly its petition should be granted.

Respondent's request for a geographical limitation to the registration must be denied because the Board does not have authority to place geographical restrictions on a registration in a cancellation proceeding. Accordingly, the '220 Registration should be cancelled in its entirety as a matter of law.

Dated: March 11, 2008



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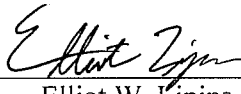
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CERTIFICATE OF SERVICE

It is hereby certified that on March 11, 2008, a true copy of the foregoing
PETITIONER'S REPLY BRIEF, is being served by first-class mail, postage prepaid, to the
attorney for Respondent at the following address:

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