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

Proceeding	92056269
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Registration No. 4,121,825
For the mark Eat Well. Drink Well. Be Happy. issued April 3, 2012

BL Restaurant Operations, LLC,

Petitioner,

v.

Uptown Dining Group I, f/k/a
The Clean Plate Club, Inc.

Registrant.

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Cancellation No. 92056269

PETITIONER'S TRIAL BRIEF

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INTRODUCTION

Petitioner BL Restaurant Operations, LLC ("Petitioner" or "BL Restaurant") owns and is the senior user of the mark EAT·DRINK·BE HAPPY for use in connection with restaurant and bar services offered under the trademark BAR LOUIE. Bar Louie has a nationwide presence with more than 70 locations in more than 25 states. Since 1998, Bar Louie has continuously used its EAT·DRINK·BE HAPPY mark, and the mark has become an invaluable asset, recognized by Bar Louie customers and the general public as symbols of quality goods and services.

On August 19, 2011, Registrant Uptown Dining Group I, f/k/a The Clean Plate Club, Inc. ("Registrant" or "Uptown Dining Group") filed a federal trademark application for the mark EAT WELL. DRINK WELL. BE HAPPY for use with restaurant and bar services. Petitioner seeks to cancel Registrant's mark EAT WELL. DRINK WELL. BE HAPPY because the slogan so closely resembles Petitioner's EAT·DRINK·BE HAPPY mark as to cause a likelihood of confusion as to the source of restaurant and bar services. Registrant's mark is likely to confuse, to cause mistake to, or deceive the consuming public as to the source of Registrant's services. This confusion, mistake and deception are causing and will continue to cause irreparable damage to Petitioner's business and goodwill. Accordingly, Petitioner requests that its Petition for Cancellation be granted.

DESCRIPTION OF THE RECORD

Both Petitioner BL Restaurant and Registrant Uptown Dining Group have offered evidence. The evidence of record consists of the following (in addition to the Petitioner's

Petition for Cancellation with Exhibits, Applicant's (aka Registrant) Answer to Notice of Cancellation, as well as Petitioner's mark under Registration No. 3,322,988):

Discovery

1. Registrant Uptown Dining Group's Responses to Petitioner's First Set of Requests for Production of Documents, No. 4.
2. Registrant Uptown Dining Group's Responses to Petitioner's First Set of Interrogatories, Nos. 2, 3, 4, 5, 6, 7, and 15.
3. Registrant Uptown Dining Group's Responses to Petitioner's First Set of Requests for Admission, Nos. 11, 15, 16, 22, 25, and 26.

Official Records

4. BL Restaurant's pleaded registration on the EAT DRINK BE HAPPY mark.
5. Uptown Dining Group I, f/k/a The Clean Plate Club, Inc.'s, Application Serial No. 85402823, status for Registration No. 4121825, and related file history documents.

Public Records

6. Escape Hatch Dallas, available at <http://escapehatchdallas.com/tag/bar-louie/>; published September 26, 2011, last visited October 7, 2013.
7. Downtown Austin Blog, available at <http://downtownaustinblog.org/2012/04/27/bar-louie-eat-drink-and-be-happy-in-downtown-austin/>, published April 12, 2012, last visited October 7, 2013.
8. Taste of Anaheim 365, available at <http://tasteofanaheim365.com/restaurants-2/1064/bar-louie-at-the-taste-of-anaheim-eat-drink-be-happy>, published April 24 2012, last visited October 7, 2013.
9. Nique's "O" Town Eats, available at <http://niquesotowneats.blogspot.com/2010/07/after-work-happy-hour.html>, published July 16, 2010, last visited October 7, 2013.
10. Writing for the News, available at <http://kristianaboch.blogspot.com/2013/04/bar-louie.html>, published April 15, 2013, last visited October 7, 2013.
11. Rochester Hills Patch, available at <http://rochester.patch.com/groups/business-news/p/bar-louie-moving-into-shields-pizza-spot-in-rochester-hills>, published March 4, 2011, last visited October 7, 2013. .
12. The Bouma Group Realtors, available at <http://blog.bouma.com/eat-drink-be-happy/>, published September 15, 2010, last visited October 7, 2013. .
13. Palm Beach Happening, available at <http://palmbeach.happeningmag.com/top-5-happy-hours-clematis-street>, not dated, last visited October 7, 2013.

14. SavannahRedSupperClub, available at <http://savannahredsupperclub.blogspot.com/2013/04/bar-louie-eat-drink-be-happy-your-alive.html>, published April 2, last visited October 7, 2013.

The foregoing evidence was made of record by Petitioner pursuant to Notices of Reliance, dated October 7, 2013; First Testimony Affidavit of Kerry Paredes (with Exhibit Nos. 18-35), dated October 8, 2013, and Testimony Affidavit of Jennifer Scott, Testimony Affidavit of Anthony DeSalvo, Testimony Affidavits of Mike Knapick, all dated October 8, 2013. Uptown Dining Group also filed a Notice of Reliance, dated January 6, 2014.

Petitioner filed its Motion to Strike, dated January 13, 2014. Registrant filed Registrant's Response to Petitioner's Motion to Strike arguing that the determinations as to the admissibility of Registrant's evidence was premature because the objections were based on substantive issues. To the extent that the Board determines Petitioner's objections to be substantive in nature, Petitioner re-asserts its objections and moves to strike the following documents submitted in Respondent's Notice of Reliance No. 1 on the following bases:

- Registrant offers Exhibits 7-10 and 16-17 as evidence of the meaning of certain terms, but these exhibits, on their face, do not provide the meaning of individual terms or the subject phrase. These websites are not online dictionaries or encyclopedias, do not contain reference materials or linguistic opinions, or otherwise provide meaning of relevant terms. Exhibit 7 is the website of a media group publisher, Exhibits 8 and 9 are magazine titles. Names of unrelated products or services do not provide meaning. In fact, they may be completely arbitrary. Exhibit 10 is a dietary proportion diagram coined the "Eatwell Plate." Exhibit 16 is a website for a restaurant, and Exhibit 17 is a screenshot of an online store that is selling a wall hanging. None of these websites, on their face, provide a meaning of the individual terms or subject phrase.
- The bibliographic information on Exhibits 11 and 12 and the descriptions offered by Registrant do not correspond. Also, these exhibits appear to be incomplete. Further, Exhibits 11 and 12 articles which, which potentially may be probative of the truth of the matter asserted, do not contain any definition or explanation of the individual terms or subject phrase.
- The general description of Exhibit 13 assumes facts not in evidence, i.e., that Petitioner's mark is derived from a specific source.
- Registrant uses "frequency" in its descriptions of Exhibits 14-17 without providing evidence of the frequency in which these websites are viewed.

STATEMENT OF THE ISSUES

The issues before the Board are whether (a) Petitioner is the senior user of EAT·DRINK·BE HAPPY ("Petitioner's Mark") and (b) whether Registrant's use of EAT WELL·DRINK WELL·BE HAPPY ("Registrant's Mark") creates a likelihood of confusion with Petitioner's mark EAT·DRINK·BE HAPPY.

RECITATION OF FACTS

The first Bar Louie opened in Chicago in 1990, marketing itself as a neighborhood restaurant and bar.¹ Locations soon opened in several markets nationwide, including Pittsburgh, St. Louis, Cincinnati and Tampa.² In 1998, the second Bar Louie was opened in Chicago. Since 1998, the EAT·DRINK·BE HAPPY mark has continuously been used in connection with Bar Louie's restaurant and bar services.³

On January 25, 2007, BAR LOUIE TRADEMARK, INC. filed a federal trademark application that matured into Registration No. 3,322,988 (the '988 Registration") for the mark EAT·DRINK·BE HAPPY in Class 43 for restaurant and bar services on October 30, 2007.⁴ Petitioner is the assignee of the '988 Registration, as evidenced by the Trademark Assignment duly filed and recorded with the USPTO at Reel/Frame 4227/0865.⁵ The '988 Registration states

¹ See First Testimony Affidavit of Kerry Paredes ("Paredes Affidavit") at ¶2.

² *Id.*

³ *Id.*; Testimony Affidavit of Jennifer Scott ("Scott Affidavit"), at ¶7; Testimony Affidavit of Anthony DeSalvo ("DeSalvo Affidavit") at ¶6, Testimony Affidavits of Mike Knapick ("Knapick Affidavit") at ¶6.

⁴ See Reg. No. 3,322,988 Application for Serial No. 77091343, status for Registration No. 3,322,988 and related file documents, attached to Petitioner's First Notice of Reliance ("NOR") as Exhibit 7; *see also*, Paredes Affidavit at ¶3 and Exhibit 18 thereto.

⁵ *See id.*

that "the mark consists of the words of the mark separated by a dot" and provides the following rendering: **EAT • DRINK • BE HAPPY**.⁶

On August 19, 2011, Registrant filed a federal trademark application that matured into Registration No. 4,121,825 (the '825 Registration") for the standard character mark EAT WELL. DRINK WELL. BE HAPPY. in Class 43 for restaurant and bar service on April 3, 2012.⁷ Registrant admitted that it did not use EAT WELL. DRINK WELL. BE HAPPY. in commerce and in connection with restaurant and bar services prior to August 1, 2007.⁸ Registrant admitted that "has no right, license, or authority to use Petitioner's Mark or any confusingly similar variation of Petitioner's Mark."⁹

Petitioner filed its Petition for Cancellation based on its priority of use of the '988 Registration and the likelihood of confusion created by Registrant's Mark, EAT WELL. DRINK WELL. BE HAPPY with Petitioner's EAT•DRINK•BE HAPPY mark.¹⁰

Registrant is using EAT WELL. DRINK WELL. BE HAPPY. to identify restaurant and bar services associated with the following entities The Mark Dine & Tap, Uptown Kitchen, and the corporate entity The Clean Plate Club in South Bend, Indiana, and Granger, Indiana.¹¹ Registrant intends to open another restaurant in Mishawaka, Indiana.¹²

Currently, the EAT•DRINK•BE HAPPY mark is used in more than 70 Bar Louie locations in more than 25 states and is aggressively expanding its Bar Louie brand to operate 100

⁶ See *id.*

⁷ See Application Serial No. 85402823, status for Registration No. 4121825, and related file history documents, attached to NOR as Exhibit 8.

⁸ Registrant Uptown Dining Group's Responses to Petitioner's First Set of Requests for Admission, No. 11, attached to NOR as Exhibit 6.

⁹ See *id.* Nos. 15 and 16, attached to NOR as Exhibit 6.

¹⁰ See Petition for Cancellation.

¹¹ See Applicant's Answer to Notice of Cancellation at ¶4; see also Registrant Uptown Dining Group's Responses to Petitioner's First Set of Interrogatories, No. 3, attached to NOR at Exhibit 4.

¹² *Id.*

locations throughout the United States.¹³ Presently, Bar Louie has three locations in Indiana: one in Mishawaka, Evansville and Merrillville.¹⁴

Bar Louie's neighborhood restaurant and bar concept has a universal appeal. In 2010, BL Restaurant commissioned a report of the Bar Louie Brand Audit & Architecture by the Bellwether Food Group, Inc. (the "Bellwether Report") to further profile its customer base and to measure the level of customer satisfaction.¹⁵

BL Restaurant extensively advertises and markets the Bar Louie brand nationally, spending over \$1.3 million in 2010, over \$2.1 million in 2011 and almost \$4 million in 2012.¹⁶ BL Restaurant utilizes the following marketing channels for its EAT·DRINK·BE HAPPY mark: menus, tripod cardboard table-top displays, the Bar Louie America website <http://www.barlouieamerica.com/default.aspx>, Facebook pages, signs displayed on the exterior of its locations, radio advertisements, e-mail blasts, flyers, Twitter pages, Yelp internet pages, and electronic billboards.¹⁷

In Bar Louie's Mishawaka, Indiana location, the EAT·DRINK·BE HAPPY mark is displayed on the outside awnings and patio mural.¹⁸ The Mishawaka location also uses the EAT·DRINK·BE HAPPY mark on its menus, Facebook page and flyers.¹⁹

In Bar Louie's Evansville, Indiana location, the EAT·DRINK·BE HAPPY mark is displayed on the outside sign and mural.²⁰ The Evansville location also uses the EAT·DRINK·BE HAPPY mark on its menus, Facebook page and flyers.²¹

¹³ See Paredes Affidavit at ¶ 5 and Bar Louis Store List, attached thereto as Exhibit 19.

¹⁴ *Id.*

¹⁵ See Paredes Affidavit at ¶ 6. and Bellwether Report, attached thereto as Exhibit 20.

¹⁶ See Paredes Affidavit at ¶ ¶ 6-7 and Marketing Expenses 2010, Marketing Expenses 2011, and Marketing Expenses 2012 attached thereto respectively as Exhibits 21, 22 and 23 and Summary of Marketing Expenses attached thereto as Exhibit 24.

¹⁷ See Paredes Affidavit at ¶ 8 and menus, screenshots, flyers, radio advertisements, gift cards and loyalty cards attached thereto respectively as Exhibits 25-29.

¹⁸ See Paredes Affidavit at ¶ 9 and copies of Mishawaka's awnings and patio attached thereto as Exhibit 30.

¹⁹ See *id.* and copies of Mishawaka menus, Facebook page and flyers attached thereto as Exhibit 31.

Bar Louie's Merrillville, Indiana location opened in November 2012.²² The Merrillville location uses the EAT·DRINK·BE HAPPY mark on its shirts, Facebook page and flyers.²³

Additionally, Bar Louie locations across the United States are known in their neighborhoods for fundraising efforts such as Share Our Strength's Dine Out for No Kid Hungry and Eat Drink Think Pink breast cancer research fundraisers.²⁴

Bar Louie is recognized as a leader in the restaurant and bar industry. Recently, it received the following awards: the 2013 Breakout Brands in Nation's Restaurant News; the 2013 Top 10 Newcomers—Nation's Restaurant News; the 2010 & 2011 Cheers Magazine's Beverage Excellence Awards, the "Concept of Tomorrow" by Restaurant Hospitality Magazine, and the 2010 VIBE Vista Award for the Chain Restaurant and Multi-unit Operator segment.²⁵

BL Restaurant's trademarks have become an invaluable asset, recognized by Bar Louie's customers and the general public as symbols of quality goods and services.²⁶ Petitioner seeks to protect Petitioner's Mark from the confusion, mistake and deception caused by Registrant's Mark.

LEGAL ARGUMENT

A. Petitioner's EAT·DRINK·BE HAPPY is the senior mark.

²⁰ See Paredes Affidavit at ¶ 10 and copies of Evansville's sign and mural attached thereto as Exhibit 32.

²¹ See *id.* and copies of Facebook page and flyers attached thereto as Exhibit 33.

²² See Paredes Affidavit at ¶ 11.

²³ See *id.* and copies of copies of Mishawaka's shirts, Facebook page and flyers attached thereto as Exhibit 34.

²⁴ See Paredes Affidavit at ¶ 12.

²⁵ See *id.* at ¶ 13.

²⁶ See *id.* at ¶ 14.

BL Restaurant filed its federal trademark application on January 25, 2007, claims 1998 as the date of its first use of its trademark in commerce, and can show that it continues to use the mark.²⁷

- Registrant admitted that it did not use EAT WELL. DRINK WELL. BE HAPPY. in commerce and in connection with restaurant and bar services prior to August 1, 2007.²⁸
- Registrant did not file its until August 19, 2011²⁹;
- Registrant admitted that it does not have any documents or writings disclosing BL Restaurant's consent or permission (by expressed or implied agreement, waiver, acquiescence, or otherwise) to file an application to register Registrant's Mark with the USPTO.³⁰
- Registrant admitted that that it has no right, license, or authority to use Petitioner's Mark or any confusingly similar variation of Petitioner's Mark.³¹

Accordingly, Petitioner has priority over Registrant's mark.

B. Registrant's mark for EAT WELL. DRINK WELL. BE HAPPY. is likely to cause confusion with Petitioner's mark for EAT·DRINK·BE HAPPY.

Cancellation is proper because Petitioner has priority of use and consumers are likely to be confused as to the origin of Registrant's services.³²

The Board's determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the "*du Pont*" factors as set forth in *In re Hyper Hyper de Nemours & Co.*³³ Petitioner submits an examination of the following relevant *du Pont* factors that reveals a likelihood of confusion exists between Petitioner's and Registrant's marks:

²⁷ See *supra* notes 3 and 4.

²⁸ See *supra* note 8.

²⁹ See *supra* note 7.

³⁰ See *supra* note 9.

³¹ See *id.*

³² *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 U.S.P.Q.2d 1842, 1844 (Fed. Cir. 2000).

³³ 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973); see also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 U.S.P.Q.2d 1201 (Fed. Cir. 2003).

- (1) Appearance, sound, connotation, and commercial impression: The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression;
- (2) The Goods: The similarity or dissimilarity and nature of the goods described in an application or registration or in connection with which a prior mark is in use;
- (3) Trade Channels: The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) Sales: The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing;
- (5) Fame: The fame of the prior mark;
- (6) Similar Marks: The number and nature of similar marks in use on similar goods;
- (7) Actual Confusion: The nature and extent of any actual confusion;
- (8) Concurrent Use: The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion;
- (9) Variety of Goods: The variety of goods on which a mark is or is not used;
- (10) Market Interface: The market interface between the applicant and the owner of a prior mark;
- (11) Right to Exclude: The extent to which applicant has a right to exclude others from use of its mark on its goods;
- (12) Potential Confusion: The extent of potential confusion; and
- (13) Any Other Fact: Any other established fact probative of the effect of use.

In the likelihood of confusion analysis, the two key considerations are the similarities between the marks and the similarities between the goods and/or services, i.e., factors 2 and 3.³⁴

1. The Similarities in Sound, Appearance and Connotation.

When performing a Trademark Act Section 2(d) analysis, the Board compares the marks in their entirety.³⁵ Although the two marks are compared in their entirety, one feature of a mark may be recognized as more significant in creating a commercial impression and greater weight is given to that dominant feature in determining whether the marks are confusingly similar.³⁶ The literal portions of the word marks are the dominant portions that create the

³⁴ *In re Modern Woodmen of America*, 2012 WL 3224709, at *1 (T.T.A.B. 2012) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 U.S.P.Q. 24, 29 (CCPA 1976)); see also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 U.S.P.Q.2d 1531 (Fed. Cir. 1997).

³⁵ See T.M.E.P. at §1207.01(b).

³⁶ See *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); *In re J.M. Originals Inc.*, 6 U.S.P.Q.2d 1393, 1394 (T.T.A.B. 1987); T.M.E.P. §1207.01(b)(viii), (c)(ii).

greatest commercial impression.³⁷ Here, both marks include the terms "Eat," "Drink" and "Be Happy." Where similar terms or phrases or similar parts of terms or phrases appear in the junior and senior user's mark, the marks are likely to be confusingly similar in appearance.³⁸

Registrant may contend that its addition of the word "well" to Petitioner's Mark creates dissimilarity. However, adding a new word to a cited mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d).³⁹ The inclusion of "well" does not significantly change the sound, appearance or meaning of Registrant's mark.

Registrant may contend that one dissimilarity between the two marks is that Petitioner's Mark is in stylized form and Registrant's Mark is in standard form. However, the use of a stylized font as compared to a standard font does not create a distinct commercial impression.⁴⁰ Additionally, because Registrant's Mark is registered in standard form, Registrant's Mark is not limited to the mark depicted in any one form.⁴¹ If Registrant's registration is not cancelled, it would be free to create additional confusion by using its mark exactly as Petitioner uses its mark,

³⁷ *Inter-State Oil Co., Inc. v. Questor Corp.*, 209 U.S.P.Q. 583, 586 (T.T.A.B. 1980).

³⁸ See, e.g., *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 U.S.P.Q. 689 (T.T.A.B. 1986), aff'd sub nom; *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 U.S.P.Q.2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH while they are not identical, "are strikingly similar in appearance, sound and in the commercial impression engendered").

³⁹ See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 U.S.P.Q.2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 U.S.P.Q. 105 (CCPA 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 U.S.P.Q. 406 (CCPA 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 U.S.P.Q.2d 1266 (T.T.A.B. 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 U.S.P.Q.2d 2002 (T.T.A.B. 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 U.S.P.Q. 65 (T.T.A.B. 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 U.S.P.Q. 707 (T.T.A.B. 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 U.S.P.Q. 630 (T.T.A.B. 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE).

⁴⁰ *In re Phillips-Van Heusen Corp.*, 228 U.S.P.Q. 949 (T.T.A.B. 1986) (21 CLUB for use with clothing is likely to cause confusion with The "21" CLUB (stylized) for restaurant services and towels).

⁴¹ 1207.01(c)(iii).

in the stylized form.⁴² Thus, this dissimilarity weighs in favor of finding a likelihood of confusion and cancelling Registrant's Mark.

Registrant may contend that Petitioner's Mark uses interpuncts whereas Registrant's Mark uses periods creates distinguishing differences. However, punctuation, such as quotation marks, hyphens, periods, commas, and exclamation marks generally does not significantly alter the commercial impression of the mark.⁴³ Moreover, when Petitioner's EAT·DRINK·BE HAPPY mark was registered, the examiner determined that the slogan constituted a unitary mark and therefore did not require its independent elements to be disclaimed as descriptive.⁴⁴ A mark or portion of a mark is considered "unitary" when it creates a commercial impression separate and apart from any unregistrable component. That is, the elements are so merged together that they cannot be divided to be regarded as separable elements.⁴⁵

While the examiner's decision is not binding on the Board, the use of interpuncts between the elements weighs in favor of finding that Petitioner's Mark is a unitary mark that creates a distinct commercial impression.⁴⁶ For these reasons, the marks are similar in sound, appearance and connotation.

2. The Similarities in Services Offered.

⁴² *Id.* (citing Trademark Rule 2.51(d) and *Industrial Valley Bank and Trust Co. v. Bankers Trust of South Carolina*, N.A., 201 U.S.P.Q. 888 (T.T.A.B. 1979))

⁴³ *In re Benedent Corp.*, 2012 WL 3875736 (T.T.A.B. 2012) (finding that the hyphen in applicant's 3D-CLEAN does not significantly alter the commercial impression of the mark enough to overcome a refusal based on the likelihood of confusion with 3D WHITE); *In re Litehouse, Inc.*, 82 U.S.P.Q.2d 1471 (T.T.A.B. 2007); *See also In re Promo Ink*, 78 U.S.P.Q. 2d 1301, 1305 (T.T.A.B. 2006).

⁴⁴ T.M.E.P. § 1213.05(b).

⁴⁵ *Id.* at § 1213.05.

⁴⁶ *See id.* at § 1213.05(a)(ii); *see also* Paredes Affidavit and marketing exemplars attached thereto as Exhibits 25-33.

When marks are used in connection with legally identical goods, as the subject facts reveal, “the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines.”⁴⁷

Petitioner and the Registrant use their marks as source identifiers for restaurant and bar services.⁴⁸ Even if the services were not identical, the parties need not be direct competitors to support a finding of a likelihood of confusion.⁴⁹ Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because the services are otherwise related in some manner, they would be encountered by the same consumers under circumstances such that offering the services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source.⁵⁰

Thus, because Petitioner's services are identical to Registrant's services, or at least encountered by the same customers (see discussion below), this factor weighs heavily in finding a likelihood of confusion.

3. The Similarities in Trade Channels.

The channels of trade are exactly the same. Petitioner and Registrant are competitors who sell the same services and who target the same customers. Registrant stated that it currently markets to "customers who reside in the 'Michiana' region of northeastern Indiana and southwestern Michigan, particularly South Bend, Granger, and adjacent towns."⁵¹ Registrant

⁴⁷ *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 U.S.P.Q.2d 1698, 1700 (Fed. Cir. 1992).

⁴⁸ See *supra* notes 4 and 7.

⁴⁹ See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 U.S.P.Q. 476, 480 (C.C.P.A. 1975); T.M.E.P. §1207.01(a)(i).

⁵⁰ *In re Iolo Techs., LLC*, 95 U.S.P.Q.2d 1498, 1499 (T.T.A.B. 2010); see *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 U.S.P.Q. 1289, 1290 (Fed. Cir. 1984); T.M.E.P. §1207.01(a)(i).

⁵¹ See Applicant's Answer to Notice of Cancellation at ¶4; see also Registrant Uptown Dining Group's Responses to Petitioner's First Set of Interrogatories, No. 4, attached to NOR at Exhibit 4.

currently has one location in Granger, Indiana and one in South Bend, Indiana.⁵² Registrant's current expansion plans includes opening a restaurant in Mishawaka, Indiana.⁵³ In comparison, presently, Petitioner has three locations in Indiana: one in Mishawaka, Evansville and Merrillville.⁵⁴ If Registrant pursues its plans to open a location in Mishawaka, the parties will have geographically identical markets.

Even if Registrant abandons its plans to expand, there are only about 3.4 miles that separate Bar Louie, Mishawaka from Registrant's South Bend location, thereby creating geographically overlapping markets.⁵⁵ Furthermore, Registrant admits that its advertising and marketing efforts target customers or potential customers who seek bar or restaurant services in St. Joseph County, Indiana, and Petitioner targets customers in St. Joseph County, Indiana and its adjacent towns.⁵⁶

Registrant also stated that its services are marketed particularly to families, business clientele, and members of the Notre Dame University community (particularly faculty, staff and alumni) and appeals to customers between 35 to 60 years-old with above-average incomes.⁵⁷ Additionally, Registrant uses its mark at its South Bend location in connection with its restaurant called "The Mark Dine and Tap," which markets directly to customers seeking alcoholic beverages.⁵⁸

⁵² See Registrant Uptown Dining Group's Responses to Petitioner's First Set of Interrogatories, No. 3, attached to NOR at Exhibit 4.

⁵³ *Id.*

⁵⁴ See Paredes Affidavit at ¶ 5 and Bar Louis Store List, attached thereto as Exhibit 19.

⁵⁵ See Registrant Uptown Dining Group's Responses to Petitioner's First Set of Requests for Admission, Nos. 22 and 25, attached to NOR as Exhibit 6.

⁵⁶ *Id.*

⁵⁷ See Applicant's Answer to Notice of Cancellation at ¶4; see also Registrant Uptown Dining Group's Responses to Petitioner's First Set of Interrogatories, No. 4, attached to NOR at Exhibit 4.

⁵⁸ Registrant Uptown Dining Group's Responses to Petitioner's First Set of Requests for Production of Documents, No. 4, attached to NOR at Exhibit 4.

Petitioner's Bellwether Report describes Bar Louie as first a "neighborhood bar" with alcohol sales making up over 55% of total revenues, and second a great restaurant with a high proportion of "regular" customers with brand loyalty.⁵⁹ Most of Petitioner's customers come to Bar Louie for a meal.⁶⁰ Petitioner's Indiana locations are in suburban areas that attract customers between the ages of 35 to 60 years old with mid-level incomes.⁶¹ Additionally, similar to Registrant's targeted customer, Bar Louie, Mishawaka targets Notre Dame faculty, staff and alumni.⁶²

Registrant is using the slogans EAT WELL. DRINK WELL. BE HAPPY. and EAT WELL. BE HAPPY on the following: menus, magazines, newspapers, church bulletins, signs located inside its restaurants; the awning on the restaurant exterior; coupons and other print advertisements; radio and television advertisements; and the internet at <http://uptowndininggroup.com/>, <http://theuptownkitchen.com/menu>, and <http://themarkdineandtap.com>.⁶³ Both restaurants use their marks in connection in the following advertising media: menus, signs located inside and on the exterior of their restaurants, print advertisements, the radio and web pages. Accordingly, this factor weighs in favor of finding a likelihood of confusion.

Registrant has not conducted any market studies, surveys, focus groups, or other studies which relate to the use or advice against use of Registrant's Mark.⁶⁴ Thus, the channels of trade for Petitioner and Registrant are not just similar, they are exactly the same; they are competitors. This factor weighs heavily in favor of likelihood of confusion.

⁵⁹ Paredes Affidavit and copy of Bellwether Report at BLRO 00113, 00116, 00124, attached thereto as Exhibit 20.

⁶⁰ *Id.* at BLRO 00141.

⁶¹ *d.* at BLRO 00145.

⁶² Knapick Affidavit at ¶7.

⁶³ See Applicant's Answer to Notice of Cancellation at ¶4; see also Registrant Uptown Dining Group's Responses to Petitioner's First Set of Interrogatories, No. 6, attached to NOR at Exhibit 4.

⁶⁴ See Registrant Uptown Dining Group's Responses to Petitioner's First Set of Interrogatories, No. 2, attached to NOR at Exhibit 4.

4. The Fame of Petitioner's Mark.

Petitioner is recognized as a leader in the restaurant and bar industry.⁶⁵ Recently, it received the following awards: the 2013 Breakout Brands in Nation's Restaurant News; the 2013 Top 10 Newcomers—Nation's Restaurant News; the 2010 & 2011 Cheers Magazine's Beverage Excellence Awards, the "Concept of Tomorrow" by Restaurant Hospitality Magazine, and the 2010 VIBE Vista Award for the Chain Restaurant and Multi-unit Operator segment.⁶⁶

Additionally, Petitioner extensively advertises and markets the Bar Louie brand nationally, spending over \$1.3 million in 2010, over \$2.1 million in 2011 and almost \$4 million in 2012.⁶⁷ Petitioner utilizes the following marketing channels: menus, tripod cardboard table-top displays, the Bar Louie America website, Facebook pages, signs displayed on the exterior of its locations, radio advertisements, e-mail blasts, flyers, Bar Louie Twitter page, Yelp internet pages, and electronic billboards.⁶⁸ These expenses illustrate Petitioner's extensive marketing efforts. its strategy of using branding to develop good will, and the fame of Petitioner's Mark. Moreover, Petitioner's Mark is published on at least nine third-party blogs.⁶⁹ Accordingly, this factor weighs in favor of likelihood of confusion.

5. The Number and Nature of Similar Marks in Use on Similar Goods.

Petitioner timely objected to the evidence proffered by Registrant in connection with this *du Pont* factor in Petitioner's Motion to Strike. Additionally, other marks either do not contain the same literal elements or they are used in connection with goods and services *other than* restaurant and bar services.

⁶⁵ Paredes Affidavit at ¶13.

⁶⁶ *Id.*

⁶⁷ *Id.* at ¶7

⁶⁸ *Id.* at ¶8.

⁶⁹ *See* NOR Exhibit Nos. 9-16.

6. Evidence of Actual Confusion

Proof of actual confusion is not necessary to establish likelihood of confusion.⁷⁰ Neither party has identified any instances of actual confusion. It is well settled that the relevant test is likelihood of confusion, not actual confusion. Additionally, the Board has consistently recognized that evidence of actual confusion is notoriously difficult to obtain.⁷¹ If there is any doubt as to whether there is a likelihood of confusion, that doubt will be resolved in favor of the prior registrant, BL Restaurant.⁷²

CONCLUSION

EAT WELL. DRINK WELL. BE HAPPY used in connection with restaurant and bar services so resemble Petitioner's EAT·DRINK·BE HAPPY mark as to cause a likelihood of confusion as to the source of restaurant and bar services. Accordingly, Petitioner requests that the Board cancel Registrant's Mark.

⁷⁰ *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571 (Fed. Cir. 1983).

⁷¹ *Block Drug v. Ben-Met, Inc.*, 17 U.S.P.Q.2d (BNA) 1315, 1318 (T.T.A.B. 1989).

⁷² See *In re Shell Oil Co.*, 992 F.2d 1204, 1209, 26 U.S.P.Q.2d 1687, 1691 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 U.S.P.Q.2d 1025, 1026 (Fed. Cir. 1988); *In re G.B.I. Tile & Stone, Inc.*, 92 U.S.P.Q.2d 1366, 1372 (T.T.A.B. 2009).

Date: April 21, 2014

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CERTIFICATE OF SERVICE

I hereby certify that on the 21st day of April, 2014, a true and correct copy of the foregoing document was served on the following attorneys by sending such copy via electronic mail:

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