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

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| Proceeding | 92056269 |
| Party | Plaintiff BL Restaurant Operations, LLC |
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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

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|--------------------------------|---|---------------------------|
| BL Restaurant Operations, LLC, | § | |
| | § | |
| Petitioner, | § | Cancellation No. 92056269 |
| | § | |
| v. | § | |
| | § | |
| Uptown Dining Group I, f/k/a | § | |
| The Clean Plate Club, Inc. | § | |
| | § | |
| Registrant. | § | |

PETITIONER'S REPLY BRIEF

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PETITIONER'S REPLY

Petitioner BL Restaurant Operations, LLC ("Petitioner") owns and operates more than 70 Bar Louie locations, offering restaurants and bars services in more than 25 states. Since 1998, Petitioner has continuously used the Bar Louie brand, annually spending millions dollars to promote its slogan EAT·DRINK·BE HAPPY through electronic, radio and print media.

Petitioner obtained a federal registration of its EAT·DRINK·BE HAPPY mark in 2007. Registrant did not use its EAT WELL. DRINK WELL. BE HAPPY. mark prior to Petitioner's use or application. Registrant does not dispute Petitioner's priority. There also is no dispute that both parties use their respective marks in connection with restaurant and bar services. The only major issue to be determined, therefore, is whether Registrant's EAT WELL. DRINK WELL. BE HAPPY mark so resembles Petitioner's EAT DRINK BE HAPPY mark as to be likely to cause confusion, mistake or deception.

Petitioner's EAT·DRINK·BE HAPPY mark is strong and deserves broad protection. Petitioner has continuously used the EAT·DRINK·BE HAPPY mark for more than 15 years in Bar Louie establishments throughout the United States. Petitioner extensively advertises and markets its brand nationally, spending over \$1.3 million in 2010, over \$2.1 million in 2011 and almost \$4 million in 2012.¹ Petitioner 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

¹ 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.

internet pages, and electronic billboards.² Petitioner operates 70 locations in more than 25 states and is aggressively expanding throughout the United States.³ Bar Louie has received industry specific awards, including 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.⁴ The longevity of Petitioner's usage and the nationwide scope of its usage combine to connect EAT·DRINK·BE HAPPY to Bar Louie in the minds of the consuming public. The use of EAT·DRINK·BE HAPPY in connection with restaurant and bar services is not only inherently distinctive, but it also has secondary meaning in the market.

Both Petitioner and Registrant registered their marks in connection with “restaurant and bar services” without any limitations. Registrant cannot restrict the scope of its goods/services listed in the registration by extrinsic evidence or argument that its mark is being used in a manner distinctive from Petitioner's use.⁵ Thus, the cited services encompass all types of restaurants and bars, and that the restaurant and bar services are rendered to all classes of purchasers.⁶

Even so, Registrant advertises it serves “great burgers & tasty comfort foods,”⁷ “American food,”⁸ a “full bar⁹ with classic cocktails”¹⁰ and “a great selection of imported,

² See Paredes Affidavit at ¶ 8 and menus, screenshots, flyers, radio advertisements, gift cards and loyalty cards attached thereto respectively as Exhibits 25-29.

³ See Paredes Affidavit at ¶ 5 and Bar Louis Store List, attached thereto as Exhibit 19.

⁴ Id.

⁵ In re Bercut-Vandervoort & Co., 229 USPQ 763, 764 (T.T.A.B. 1986).

⁶ Jansen Enterprises Inc. v. Rind, 85 USPQ2d 1104 (T.T.A.B. 2007) (citing In re Smith and Mahaffey, 31 USPQ2d 1531 (T.T.A.B. 1994); and In re Elbaum, 211 USPQ 639 (T.T.A.B. 1981).

⁷ See Affidavit of Kerry Paredes, Exhibits 25-26.

⁸ See Petitioner's NOR, Exhibit 2 (BLRO 00093 and BLRO 00096).

⁹ See Affidavit of Kerry Paredes, Exhibits 25-26.

¹⁰ See id. (R0038CPC_St. PiusXdirectAd 10-11 final).

domestic and microbrew beers”¹¹ in an atmosphere catering to families, business clientele and the Notre Dame University community.¹² Similarly, Petitioner serves American comfort food in an atmosphere catering to suburban areas, people between 35 to 60 and Notre Dame faculty, staff and alumni.¹³ The services registered in connection with the parties’ marks are legally and actually identical.

Registrant's mark EAT WELL. DRINK WELL. BE HAPPY incorporates Petitioner's entire mark, EAT·DRINK·BE HAPPY and simply adds "well" after “eat” and “drink.” 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.¹⁴ Simply adding “well” 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).¹⁵

Registrant cites third-party usage of marks, Exhibits 7-13 and 17 to show the meaning of the phrase “Eat Well” or “Eat, drink and be merry.”¹⁶ However, third-party usage of the phrases “Eat Well” or “Eat, drink and be merry” is not relevant because these are **not** the slogans used by

¹¹ See *id.* (R004611-6 Uptown).

¹² 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.

¹³ Knapick Affidavit at ¶7; Paredes Affidavit at Exhibits 25 and 26.

¹⁴ 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.”).

¹⁵ 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).

¹⁶ Respondent’s Notice of Reliance No. 1.

Petitioner and Registrant, i.e., EAT·DRINK·BE HAPPY and EAT WELL. DRINK WELL. BE HAPPY. Additionally, these third-party usages are **not** for the same services offered by Petitioner and Registrant and therefore are **not** probative of descriptive usage of the parties' marks. Moreover, the cited websites are **not** online dictionaries or encyclopedias, they do **not** contain reference materials or linguistic opinions or otherwise provide meaning for the terms. Furthermore, there is no way to know what effect, if any, these purported uses of "Eat well" and "Eat Drink Be Merry" marks may have had in the minds of consumers.¹⁷ Also, Exhibits 14-17 are not probative of their stated purpose of proving "the frequency with which consumers will encounter" because there is no evidence of the frequency in which customers visit these websites. Therefore, Exhibits 7-13 and 14-17 are not relevant to the relevant issues and should be stricken.

Both parties used their marks with legally identical services and both marks are actually used with restaurants that feature bars and which serve gastropub¹⁸ lunch and dinner items and alcoholic beverages. Their consumers are the same and their trade channels are the same. Both parties promote their marks on their menus, signs, print advertisements, websites and social media. Both parties operate in overlapping markets in suburban Indiana and target customers between the age of 35-60 years old. The parties are direct competitors and are offering services under confusingly similar marks which could cause the consuming public to be misled, mistaken or deceived as to the actual source of the services. Petitioner has invested extensive time and money in promoting its mark and building goodwill. Accordingly, Petitioner requests that the Board grant Petitioner the relief requested so that Petitioner can protect its mark.

¹⁷ Carl Karcher Enterprises Inc. v. Star Restaurants Corp., 35 USPQ2d 1125, 1131 (T.T.A.B. 1995).

¹⁸ Petitioner's NOR Exhibit 2.

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.

Date: June 3, 2014

By: /s/Caroline Pace

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CERTIFICATE OF SERVICE

I hereby certify that on the 3rd day of June, 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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