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THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*BL Restaurant Operations, LLC*

*v.*

*The Clean Plate Club, Inc.*<sup>1</sup>

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Cancellation No. 92056269

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Michael M. Logan and Caroline C. Pace of Kane Russell Coleman & Logan PC for BL Restaurant Operations, LLC

Chris McElwain and Dalia Saper of Saper Law Offices, LLC for Uptown Dining Group I, Inc. f/k/a/ The Clean Plate Club, Inc.

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Before Quinn, Zervas and Hightower, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On April 3, 2012, Registration No. 4121825 (“the ‘825 registration”) for the mark EAT WELL. DRINK WELL. BE HAPPY. (in standard character

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<sup>1</sup> The parties refer to the defendant in this proceeding as Uptown Dining Group I, Inc., f/k/a The Clean Plate Club, Inc. Neither party has moved to join Uptown Dining Group I, Inc. or substitute Uptown Dining Group I, Inc. for The Clean Plate Club, Inc. See TBMP §§ 512.01 and 512.02 (2014).

form) issued on the Principal Register for “restaurant and bar services” in International Class 43, based on an application filed on August 19, 2011. The ‘825 registration states dates of first use anywhere and first use in commerce on August 1, 2007.

BL Restaurant Operations, LLC (“Petitioner”) filed a petition to cancel the ‘825 registration. In the petition to cancel, Petitioner pleaded ownership of Registration No. 3322988 (the ‘988 registration”) for the mark<sup>2</sup>

## **EAT • DRINK • BE HAPPY**

for “restaurant and bar services” in International Class 43, based on an application filed on January 25, 2007.<sup>3</sup> The ‘988 registration identifies first use anywhere and first use in commerce in 1998. Petitioner has alleged that Respondent’s mark so closely resembles the mark of Petitioner's pleaded registration as to be likely to cause confusion, mistake or deception in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

Respondent has answered the petition to cancel by denying the salient allegations thereof.

### The Record

The record consists of (i) the pleadings; (ii) the file of the involved registration; (iii) Petitioner’s Notice of Reliance (filed October 7, 2013), including a printout taken from the U.S. Patent and Trademark Office’s

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<sup>2</sup> The “Mark Drawing Type” identified in the U.S. Patent and Trademark Office’s electronic record is “An Illustration Drawing ....”

<sup>3</sup> The ‘988 registration issued on October 30, 2007. Section 8 declaration accepted.

Trademark Status and Document Retrieval (“TSDR”) database of the ‘988 registration; (iv) Respondent’s Notice of Reliance (filed January 6, 2014);<sup>4</sup> (v) testimony affidavit of Kerry Paredes, Petitioner’s Director of Legal Services (with exhibits, filed October 8, 2013); (vi) testimony affidavit of Jennifer Scott, Petitioner’s Senior Director of Human Resources (filed October 8, 2013); (vii) testimony affidavit of Anthony DeSalvo, a partner in the “Bar Louie” restaurant located in Evansville, Indiana (filed October 8, 2013); (viii) testimony affidavit of Mike Knapick, a partner in the “Bar Louie” restaurant located in Mishawaka, Indiana (filed October 8, 2013); (ix) testimony affidavit of Jonathan Lutz, president, founder and owner of Respondent (filed December 6, 2013); and (x) testimony affidavit of Charles Loupe, server at Uptown Kitchen in Granger, Indiana (filed December 6, 2013). By a stipulation filed on October 8, 2013, the parties agreed to file testimony by affidavit.

The parties have fully briefed the case. We sustain the petition for cancellation.

### *Background*

Petitioner opened its first restaurant/bar named “Bar Louie” in Chicago in 1990 and a second restaurant/bar also named “Bar Louie” in Chicago in 1998.<sup>5</sup> Petitioner has used its EAT·DRINK·BE HAPPY mark

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<sup>4</sup> On January 14, 2014, Petitioner filed a motion to strike Exhibits 7-17 of Respondent’s Notice of Reliance. The Board denied Petitioner’s motion on May 29, 2014.

<sup>5</sup> Paredes Aff. at ¶2, 10 TTABVUE at 2.

continuously in connection with Bar Louie's restaurant and bar services since 1998.<sup>6</sup> Petitioner's "Bar Louie" now has more than 70 locations in 25 states.<sup>7</sup>

In August, 2007, Respondent's owner Jonathan Lutz opened his first restaurant, "Uptown Kitchen," in Granger, Indiana.<sup>8</sup> According to Mr. Lutz, "eat well,' and 'drink well' were chosen to reflect the Restaurant's emphasis on healthy, handmade meals"; the restaurants "target customers who are interested in hand-crafted, healthy, delicious meals made from scratch from high-quality, fresh ingredients"; and "the phrase 'be happy' was chosen to imply that the effect of healthy eating and healthy drinking (i.e., eating well and dinking well) is a happier life."<sup>9</sup> Respondent opened a second restaurant in August, 2010 named "The Mark Dine & Tap" and Respondent used "Eat well. Drink well. Be happy." in this second restaurant.<sup>10</sup>

A year after Uptown Kitchen opened, Bar Louie began licensing franchises in Indiana, and opened restaurants in Mishiwaka, Indiana in July, 2008, Evansville, Indiana in July, 2009 and Merrillville, Indiana in November, 2012.<sup>11</sup>

### *Priority*

In a cancellation proceeding in which both parties own registrations, a petitioner must prove priority of use. *See Brewski Beer Co. v. Brewski Bros.*,

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<sup>6</sup> *Id.*; Scott Aff. ¶7, 12 TTABVUE at 6; DeSalvo Aff. ¶6, 12 TTABVUE at 9; and Knapick Aff. ¶6, 12 TABVUE at 12.

<sup>7</sup> Paredes Aff. ¶¶ 5-6, 10 TTABVUE at 3-4.

<sup>8</sup> Lutz Aff. ¶¶ 2-3, 16 TTABVUE at 2.

<sup>9</sup> *Id.* ¶¶ 5-8, 16 TTABVUE at 2-3.

<sup>10</sup> *Id.*

*Inc.*, 47 USPQ2d 1281 (TTAB 1998). Because Petitioner's pleaded registration is of record, Petitioner may rely on the filing date of the underlying application as a constructive use date for purposes of priority. Trademark Act § 7(c). See *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965). Petitioner filed its application for its EAT·DRINK·BE HAPPY mark on January 25, 2007. Mr. Lutz, Respondent's founder, testified that Respondent's has used the slogan EAT WELL. DRINK WELL. BE HAPPY. since the opening of Respondent's Uptown Kitchen restaurant in August 2007.<sup>12</sup> Inasmuch as Petitioner's underlying application for the pleaded '988 registration was filed prior to the August 19, 2011 filing date of Respondent's application, and Respondent maintains its first use of its mark was subsequent to the filing date of Petitioner's application, Petitioner has priority in connection with the EAT·DRINK·BE HAPPY mark. Indeed, Respondent has not contested Petitioner's priority in its brief and has admitted in its responses to Petitioner's requests for admissions 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.<sup>13</sup>

Thus, Petitioner has established its priority.

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<sup>11</sup> Paredes Aff. Exh. 19; 10 TTABVUE at 18-20.

<sup>12</sup> Lutz Aff. ¶ 4; 16 TTABVUE at 2.

<sup>13</sup> Respondent's Response to Petitioner's Request for Admission No. 11, Ex. 6 to Petitioner's Notice of Reliance.

*Likelihood of Confusion*

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that “[t]he 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.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). *Services, Trade Channels and Purchasers*

First, we consider the parties' services, trade channels and purchasers, which Petitioner maintains are identical based on the recitations of services set forth in the registrations. Respondent has not contested Petitioner's arguments or addressed these factors in its brief. It states, “[t]his case comes down to the first *du Pont* factor.”<sup>14</sup>

The issue of likelihood of confusion must be determined on the basis of Respondent's services as they are set forth in the involved registration, rather than on “real-world conditions,” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014), or “what the record may reveal as to the particular nature of [the services], the particular channels of trade or the class of purchasers to which sales of

the [services] are directed.” *Octocom Sys., Inc. v. Houston Comp. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (internal citations omitted). The identifications in the involved registration and Petitioner's pleaded registration are identical: “restaurant and bar services.” Because the services are identical, and the parties' registrations contain no limitations on the channels of trade and classes of purchasers, we must presume that the channels of trade and classes of purchasers are the same. See *Stone Lion Capital Partners*, 110 USPQ2d at 1161; *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011). Thus, the *du Pont* factors regarding the similarity or dissimilarity of the services, the established, likely to continue trade channels, and purchasers favor a finding of likelihood of confusion.

#### The Marks

We turn next to the *du Pont* factor regarding the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of

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<sup>14</sup> Respondent's brief at 4.

their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Jack B. Binion*, 93 USPQ2d 1531 (TTAB 2009); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Insofar as the services are identical, the degree of similarity between the marks that is necessary to support a finding of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

In addition, our analysis cannot be predicated on dissection of the involved marks. *See Stone Lion Capital Partners*, 110 USPQ2d at 1161; *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Rather, we are obliged to consider the marks in their entireties. *Id.* *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 23, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion”). Nonetheless, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion Capital Partners*,

110 USPQ2d at 1161, quoting in part *In re National Data Corp.*, 224 USPQ at 751.

Both marks include the wording EAT, DRINK and BE HAPPY, in the same order, with punctuation before the terms “drink” and “be.” There hence are immediate similarities in appearance and sound, including the manner in which the mark is pronounced through pauses between each of the terms separated by punctuation in the marks. The distinctions in appearance and sound that Respondent points out<sup>15</sup> are far too subtle to sufficiently distinguish the marks. As it has been often stated, there is no correct pronunciation of a mark, *see In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012), and it is just as likely that consumers would pronounce the marks with the same inflections.

Respondent’s better arguments are directed to the meaning of the marks. Respondent’s points are succinctly summarized as follows:

The commercial impressions of the two slogans are, in fact, completely opposite. Registrant’s tagline urges its lunchtime guests to “eat well,” to watch what they put into their bodies in order to live a more satisfying life. Petitioner’s tagline, in contrast, encourages its late-night revelers to live it up like there’s no tomorrow.<sup>16</sup>

Respondent explains:

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<sup>15</sup> For example, at p. 5 of its brief, Respondent states:

[T]heir differing punctuation changes not only how the marks look but also how they are likely to be pronounced, with Registrant’s Mark being read with the inflection given to three short imperative sentences—Eat well. Drink well. Be happy—and Petitioner’s Mark being read as one might read a list—eat, drink, be happy.

<sup>16</sup> Respondent’s brief at 9.

“Eat well” refers to Registrant’s emphasis on healthy cuisine. The phrase was chosen to reflect the nutritional qualities of Uptown Kitchen’s fare, and Registrant’s customers understand the phrase as such. Lutz Aff. ¶ 6, 13-14. The phrase “eat well” is generally used to mean “eat healthy.” For example, the magazine EATINGWELL, which purports to have a North American audience of 1.8+ million readers, is plainly aimed at promoting healthy eating. Reg. NOR, Exh. 7-8. The NGO EatWellGlobal is focused on improving global nutrition. Reg. NOR, Exh. 9. The U.K. equivalent of the USDA’s Food Pyramid is known as the “Eatwell Plate.” Reg. NOR, Exh. 10. The children’s section of one’s local library is likely to contain multiple books titled Eat Well, which unfailingly promote healthy eating. Reg. NOR, Exh. 11 (“In order to be healthy, you must take care of your body. One way to do this is to eat well.”), Exh. 12 (“Do you eat well? We are what we eat, and it follows that our eating habits must therefore affect our health.”).<sup>17</sup>

With regard to the meaning and commercial impression of Petitioner’s mark, Respondent states:

Petitioner’s motto is simply “EAT · DRINK · BE HAPPY,” a slight variation on the commonplace expression “eat, drink, be merry.”

Then I commended mirth, because a man hath no better thing under the sun, than to eat, and to drink, and to be merry: for that shall abide with him of his labour the days of his life, which God giveth him under the sun.

Ecclesiastes 8:15 (KJV). Reg. NOR, Exh. 13. While American restaurant-goers might not be aware of the Biblical origins of the cliché trifecta of hedonism, “eat, drink, be merry,” they will almost certainly be universally familiar with the expression. “Eat, drink, be merry” is a ubiquitous platitude. In THE NEW YORKER alone, it has been the punchline of at least five separate cartoons between 1960 and 2001. Reg. NOR, Exh. 14. In all five cases, readers’ familiarity with the adage is a basic assumption of the joke. *Id.* “Eat, drink, be merry” appears frequently on all kinds of signs, napkins, plates, posters, banners, advertisements, invitations and cards, as a Google

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<sup>17</sup> Respondent’s brief at 7.

Image search for “eat+drink+be+merry” reveals. Reg. NOR, Exh. 15.1 And, while the King-James-vintage “merry” is most often used, the more modern equivalent “happy” is not unknown. See, e.g. Reg. NOR, Exh. 16. “Eat, drink, be merry”/“eat, drink, be happy” is plainly a set phrase that carries a specific, idiomatic connotation beyond its component words.

According to the author of Ecclesiastes, “to eat and to drink; and to be merry” are examples of “mirth,” pleasure being the best human beings can hope for during their short time “under the sun.” Ecclesiastes 8:15 (KJV). The expression today conveys essentially this same hedonist sentiment. See, e.g. Reg. NOR, Exh. 16 (“Eat, Drink and Be Happy. Isn't that what life is all about?”). In other words, “live it up,” “enjoy yourself.”

The problem with Respondent’s argument, however, is that Respondent’s recitation of services is not limited to bar and restaurant services with a focus on healthy food and drink, but includes bar and restaurant services that do not have such a focus, such those provided in “greasy spoon” bars and restaurants. For such services, which are encompassed within the recitation of services, Respondent’s mark does not have the connotation that Respondent ascribes to the its mark. Rather, for such services, which are outside of the context of healthy food restaurants, the mark has the same connotation as Petitioner’s mark, but signifies a superlative (due the inclusion of the term “well.”) Not only should the bar and restaurant guest “eat,” the guest should “eat well.” The essential meaning of Petitioner’s and Respondent’s phrases is substantially the same.

The commercial impression of Petitioner’s phrase does not change due to the inclusion of the term “well” in two locations. The essential message of

the marks is to eat, drink and have fun, whether with or without the term “well.”

In view of the foregoing, the *du Pont* factor regarding the similarity of the marks favors a finding of likelihood of confusion.

*Strength*

Respondent challenges the inherent strength of Petitioner’s mark, stating that the mark

“is inherently weak on two counts: (1) it consists of the generic words “eat” and “drink” followed by the laudatory phrase “be happy”; and (2) it is, as a whole, a commonplace expression meaning “enjoy yourself” or “live it up,” a platitude that is, at best, suggestive of Petitioner’s restaurant and bar services.<sup>18</sup>

The evidence in the record adduced by Respondent itself, however, demonstrates that EAT. DRINK. BE HAPPY. is a unitary phrase.<sup>19</sup> The protection accorded to the phrase is therefore not limited in scope because it has certain components, which if considered independently, have some relationship to the services offered under the mark. Further, there is not sufficient evidence in the record to support Respondent’s contention that the phrase is “a commonplace expression.” Additionally, even if Petitioner’s mark has some association with food and drink, and is less than arbitrary, it is not so weak as to maintain the registration of Respondent’s mark for identical services.

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<sup>18</sup> Respondent’s brief at 10–11.

Fame

Because Petitioner has asserted that its mark is famous, we consider the *du Pont* factor regarding the fame of this mark. This factor plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. *Id.* at p. 1456. A famous mark is one “with extensive public recognition and renown.” *Id.* See also *Palm Bay Imports*, 73 USPQ2d at 1694.

In determining whether a mark is famous, we may consider sales, advertising expenditures, and the length of time the mark has been used. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811 (TTAB 2005). This information, however, must be placed in context (e.g., a comparison of advertising figures with competitive products, market share, reputation of the product, etc.). *Bose*, 63 USPQ2d at 1309.

We have carefully considered Petitioner's evidence and arguments in support of its contention that its mark is famous and find that the evidence does not support Petitioner's contention. Petitioner relies on Ms. Paredes' affidavit and her statements therein concerning advertising and marketing

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<sup>19</sup> Both Petitioner and Respondent take the position that the mark is unitary. See Petitioner's brief at p. 11 and Respondent's brief at p. 12 (“Petitioner's position that

expenses of "the Bar Louie brand nationally," awards and recognitions, marketing channels (e.g., website and Facebook pages), references in blogs to Petitioner, and that Petitioner has more than 70 Bar Louie locations in more than 25 states. The evidence does not establish that Petitioner's mark is famous because there is no context for the advertising and marketing expenses, no indication that the advertising and marketing expenses are limited to the mark in question, no information about the number of website visitors and contacts through social media, and no information about the significance of the awards listed.

*No Actual Confusion*

Respondent points out that Petitioner has conceded that it is not aware of any instances where consumers have actually been confused by Respondent's mark; and notes that the parties have had restaurants in the same general region for five years.<sup>20</sup> The fact that there have been no instances of confusion is not surprising because most of the examples of use of the parties' marks have been in conjunction with their house marks, suggesting that the subject marks are used with other marks, which reduces the likelihood of confusion. However, Respondent is not restricted from using its subject mark independently of its house mark, and may do so in the future. Additionally, it is not necessary to show actual confusion in order to establish likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates*

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its mark is unitary is plausible.").

<sup>20</sup> Respondent's brief at 15.

*Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1843 (Fed. Cir. 1990). The *du Pont* factor regarding actual confusion is neutral.

*Balancing the relevant du Pont factors*

We have found above that the services, trade channels and purchasers are identical and that the marks are similar in sound, meaning, appearance and commercial impression. Further, we have found that Respondent has not established weakness in Petitioner's mark, at least insofar as in comparison to Respondent's mark. Thus, even if Petitioner's mark is not famous, as it contends, upon consideration of the relevant *du Pont* factors, we find that Respondent's mark, when used upon Respondent's identified services, is likely to be confused with Petitioner's mark, used on services identical to Respondent's services.

**DECISION:** The petition to cancel Registration No. 4121825 on the ground of likelihood of confusion is granted. The registration will be cancelled in due course.