

## **UNITED STATES: TTAB Rejects Applicant's Menu of Arguments for Restaurant Mark**

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The Trademark Trial and Appeal Board (“TTAB”) has upheld the refusal to register the mark CARMINE’S on the ground that the mark is likely to cause confusion with two registrations for different forms of CARMINE’S. *In re Carmine’s Broadway Feast Inc.*, Serial No. 78934642 (T.T.A.B. February 25, 2010) [not precedential]. The Board rejected all four of the applicant’s arguments, including the lack of actual confusion in the marketplace.

Carmine’s Broadway Feast, Inc. filed a trademark application for CARMINE’S & Design, for “restaurant and bar services, banquet services, catering services and restaurant take-out services” in Class 43. The examining attorney issued a final refusal, claiming the applicant’s mark was likely to be confused with two marks owned by different parties: CARMINE’S & Design, for “restaurant services,” in Class 42, and CARMINE’S RESTAURANT & Design, for “restaurant services,” in Class 43 (RESTAURANT disclaimed).

Ruling on the applicant’s appeal, the TTAB noted that the services were identical and that CARMINE’S was the dominant portion of each mark. Because the applicant’s mark sounded exactly like the registered marks, it was deemed to be highly similar to them.

The applicant claimed there was no likelihood of confusion because of other factors. First, it argued that, as a given name, CARMINE’S was entitled only to narrow protection. The TTAB acknowledged that marks that are primarily merely surnames require a showing of acquired distinctiveness to be registered. However, the Board noted distinctiveness was not a requirement for given names, which are therefore entitled to broader protection.

Second, the applicant argued the coexistence of the two cited registrations supported its position. The applicant pointed out that the examining attorney who handled the issuance of the second registration had cited the first registration against the application for the second mark but later had withdrawn the citation. The applicant said the TTAB should reverse the current refusal consistent with the other examining attorney’s earlier action. The Board stated that it is not bound by actions examining attorneys have taken on applications not currently before the Board and that it must decide the case based on the record and the evidence before it.

Third, the applicant argued that CARMINE’S was a weak mark in the restaurant field because of other third-party uses, of which applicant provided 14 examples. The TTAB did not find that argument persuasive because the evidence did not suggest customers would view CARMINE’S as descriptive or even suggestive of restaurant services. In fact, the Board found the opposite—that CARMINE’S was the most distinctive part of the CARMINE’S marks.

Finally, the applicant argued there was no likelihood of confusion because the applicant and the owners of the cited registrations have coexisted for a substantial period of time without any actual confusion. Rejecting that argument, the TTAB said its focus must be on the likelihood of confusion, not actual confusion. Because the parties operated in different geographical areas, according to the applicant’s arguments, there was no opportunity for confusion. Moreover, the Board said, arguments based on a lack of actual confusion have little or no probative value in an *ex parte* proceeding.

After considering all the evidence and arguments, the TTAB concluded there was a likelihood of confusion between the applicant's mark and the cited registrations. Accordingly, the Board affirmed the examining attorney's refusal to register the mark.

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