

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Aladdin's Eatery, Inc.

Serial No. 76020517

James C. Wray and Matthew J. Laskoski for Aladdin's Eatery, Inc.

Laura Hammel, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Seeherman, Drost and Zervas, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Aladdin's Eatery, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register ALADDIN'S EATERY, with the word EATERY disclaimed, for "small neighborhood storefront restaurants featuring Middle Eastern food specialties."¹ Registration has been refused

¹ Application Serial No. 76020517, filed April 7, 2000, based on an asserted intention to use the mark in commerce. On June 7, 2002, applicant filed an Amendment to Allege Use, asserting first use and first use in commerce as of April 15, 1994. There have

pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the following registrations,² both of which are owned by the same entity, that, if used in connection with applicant's

been several amendments to the identification of services. The identification set forth above was offered by applicant in its response dated February 25, 2005. In its supplemental appeal brief applicant states that its companion application had been published for opposition, and that "applicant would be pleased to adopt the identification of goods" from that application. p. 1. The Examining Attorney, in her brief, advised that this companion application had been withdrawn from publication, and further stated that, while she had no objection to the further amendment, "it is unclear whether applicant does in fact intend such amendment." Applicant, in its reply brief, did not address this question, and we have therefore assumed that applicant did not wish to amend its identification, but was making the offer only if, by conforming its identification to that in its companion application, it would result in the allowance of the application. Accordingly, we have treated the identification as that offered in the February 25, 2005 response. We would add that, even if the identification were that mentioned in applicant's supplemental brief, namely, "restaurants featuring Middle Eastern cuisine, provided in small, neighborhood or local restaurant establishments having no additional services offered concurrent therewith," it would not change our opinion herein.

² Two other registrations for ALADDIN marks, owned by the same registrant, were also cited during the examination of the application. However, one citation was withdrawn because that registration was cancelled, and another citation, for Registration No. 2628932, was withdrawn because that registration issued from an application that was filed subsequent to the filing date of the subject application. We note that, although applications are normally examined in the order of their filing, such that a later-filed conflicting application will normally be suspended until there has been a final disposition of a prior-pending application, once a registration has issued the filing date of the underlying application should be irrelevant, since Section 2(d) of the Statute prohibits the registration of a mark which is likely to cause confusion with a previously registered mark. However, since the Examining Attorney had clearly considered the issue of whether registration should be refused on the basis of Registration No. 2628932 and had withdrawn that citation, we have no basis for remanding the application to the Examining Attorney for consideration of that issue.

services, it is likely to cause confusion or mistake or to deceive:

ALADDIN for hotel and restaurant services;³ and



for hotel, restaurant, bar, lounge services; beauty salon and health spa services.⁴

The appeal has been fully briefed; an oral hearing was not requested.

We turn first to a procedural point. In her brief, the Examining Attorney objected "to applicant's introduction of new evidence in [its] brief, including the introduction of a trademark search, a Google search, and a Hoover search as evidence." p. 4. These documents were not submitted with applicant's brief, and it is clear that the Examining Attorney's objection is to applicant's references in its brief to results from searches of trademark records, and the Hoover and Google search engines. Applicant did not respond to this objection in its reply brief. We note that during the prosecution of this application applicant had made reference to results

³ Registration No. 1779369, issued June 29, 1993; Section 8 affidavit accepted; Section 15 affidavit acknowledged; renewed.

⁴ Registration No. 2632473, issued October 8, 2002.

shown by a search of USPTO trademark records and searches using the Google and Hoover search engines in its responses filed June 7, 2002⁵ and July 24, 2003, and that, in the September 2, 2003 Office action, the Examining Attorney stated that applicant "has failed to provide any evidence in this regard." p. 2. Applicant never responded to this point, nor did it submit a copy of this evidence. After reviewing the entire file we have found no evidence supporting applicant's references to the results of these various searches. Further, the Board telephoned applicant's counsel to ascertain whether this evidence had been filed. In response, counsel provided copies of documents that he indicated had been submitted to the Examining Attorney during an interview on June 7, 2002.⁶ In comparing the materials, we note that the response itself is in the application file, along with an amendment to

⁵ This response was filed during the time proceedings were suspended pending a final disposition of a potentially conflicting application, an application which eventually issued as cited registration No. 2632473 for ALADDIN and lamp design.

⁶ Applicant's counsel stated that he had prepared this response in advance of the interview, but had crafted it as though the interview had already taken place, and he submitted it at the time of the interview. (This paper bears a filing stamp in the law office itself of June 7, 2002 at 10:54.) The response states that "during the interview, exhibits in support of the following statement, amendments to allege use, and declaration with exhibits were shown to and discussed with the Examining Attorney and were filed." However, in view of the fact that the response was written prior to the interview, we cannot regard this paper as actually showing that all these documents were submitted.

allege use which was filed at the same time, and those exhibits referred to as "Attachment A" consisting of Exhibits 1-9, and the first page of "Attachment B." The remainder of "Attachment B," which was not found in the file, is a binder which consists of an "overview" of applicant's plans, organization, etc., as well as articles for the years 1994 through 2001 in which applicant's restaurant is mentioned or reviewed. Although these binder materials were not found in the file, from the information provided (and particularly the fact that the first page of "Attachment B" was in the file, we are persuaded that this evidence consisting of "Attachment B", and referred to in applicant's response as Exhibits 10-83, was duly submitted, and we have therefore treated it as being of record.

However, applicant's counsel could not locate any exhibits relating to Google and other searches in his records, nor could applicant's co-counsel, who was also present at the interview at which these exhibits were purportedly shown to the Examining Attorney. Because we have no indication that this evidence was ever filed, and indeed, we have statements from the Examining Attorney from 2003 that it was not; because applicant never responded to the Examining Attorney's statement during the examination of the application that this evidence was not of record;

because applicant could not supply copies of this evidence; and because applicant never responded to the Examining Attorney's objection in her brief that the documents were not of record, the asserted exhibits consisting of results from searches of the Hoover and Google search engines, and USPTO records, and the book A Thousand and One Nights are not of record.⁷

We would add that even if this evidence had properly been made of record, it would have been of little probative value. The exhibits from the search engines, according to applicant, were merely a summary of search results. The Board has previously stated, and has reiterated in the TTAB Manual of Procedure, that "a search result summary from a search engine, such as Yahoo! or Google, which shows use of a phrase as key words by the search engine, is of limited probative value. ...Use in a search summary may indicate only that the two words in an overall phrase appear separately in the website literature." TBMP §1208.03. See also *In re Fitch IBCA Inc.*, 64 USPQ2d 1058 (TTAB 2002). As for what has been described "a search of the Patent and Trademark Office records", this single exhibit, No. 102, appears to be a mere listing of "397 marks that contain the

⁷ We need hardly add that it is not possible to consider evidence that the applicant was not able to furnish.

term 'Aladdin.'" Such a listing is not sufficient to make the registrations of record. See *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). Further, even if the registrations were of record, registrations are not evidence that marks are in use, or that the public is familiar with them. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). We also point out that the Examining Attorney has stated that there are no third-party registrations for ALADDIN marks for restaurant services.

Although the book The Thousand and One Nights is not of record, the Examining Attorney submitted the following dictionary definition of "Aladdin": "In the *Arabian Nights*, a boy who acquires a magic lamp and a magic ring with which he can summon two jinn to fulfill any desire."⁸ Both applicant and the Examining Attorney are in agreement that the story of Aladdin is well known. In the Office action mailed July 3, 2003, the Examining Attorney stated that "the term Aladdin calls to mind the boy in the Arabian Nights who acquires a magic lamp to fulfill wishes," while applicant stated, in the response filed July 7, 2002, that "Aladdin is a character from a wonderful fantasy book read, known and loved throughout the United States and

⁸ The American Heritage Dictionary of the English Language, 3d. ed © 1992.

worldwide." We concur that, as a result of the popular knowledge of the story of Aladdin, people in the United States would recognize the name "Aladdin" as being the name of the main character in this story.

We now turn to the refusal at issue in this appeal, namely, whether applicant's use of ALADDIN'S EATERY for "small neighborhood storefront restaurants featuring Middle Eastern food specialties" is likely to cause confusion with ALADDIN for a hotel and restaurant services and ALADDIN and lamp design for hotel, restaurant, bar, lounge services; beauty salon and health spa services.

Our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

We turn first to a consideration of the services. Applicant has characterized the registrant's services as casino services and "incident food services for casino patrons." Supp. brief, p. 6. However, the cited registrations are, in fact, for "hotel and restaurant services" (Reg. No. 1779369) and for "hotel, restaurant, bar, lounge services; beauty salon and health spa services"

(Reg. No. 2632473). Both registrations, thus, include restaurant services. Applicant has argued that the identifications should be interpreted as restaurant services that are integrated with, in the case of Registration No. 1779369, hotel services, and, in the case of Registration No. 2632473, hotel, bar and lounge services, pointing, in particular, to the separate listing of "beauty salon and health spa services" in the latter registration in support of its position.

We are not persuaded by this argument. Identifications of goods and services may go through several changes during the examination process, as applicants seek as broad an identification as possible without running into conflict with an existing registration, and Examining Attorneys require that all goods and services in the identification be definite and acceptable. As part of this process, items may be combined within one grouping or separated by commas or semicolons. However, we do not view the phrase "hotel and restaurant services" as requiring an interpretation of "restaurant services that are combined with hotel services." On the contrary, the ordinary understanding of this phrase is "hotel services and restaurant services"; under normal parlance, one would omit a repeated reference to services.

We would also point out that, in similar circumstances, the court in *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997), treated the registrant's identification of "hotel, motel, and restaurant services" as being for, *inter alia*, "restaurant services," not for restaurant services integrated with hotel services. For similar reasons, we consider Registration No. 2632473 to be for, *inter alia*, "restaurant services," not restaurant services integrated with hotel, lounge and bar services.

Thus, the cited registrations both include restaurant services and, as such, encompass the more limited restaurant services identified in applicant's application. The services are, in part, legally identical. The factor of the similarity of the services favors a finding of likelihood of confusion.

Because the services are legally identical, the channels of trade must also be considered identical. Again, we note applicant's argument that applicant's services are "aimed at local patrons that are looking for exotic and healthy foods" and that the registrant's services "are located only in Las Vegas and are a tourist destination" so that "patrons of Applicant's local neighborhood family establishments are not likely to be the same consumers of the cited references' services except

perhaps on a one-time vacation basis." Supp. brief, p. 8. The difficulty with applicant's position is that it ignores the well-established principle that "likelihood of confusion must be determined based on an analysis of the mark as applied to the...services recited in applicant's application vis-a-vis the...services recited in [a]...registration, rather than what the evidence shows the...services to be. " In re Dixie Restaurants, Inc., supra at 41 USPQ2d 1534, quoting Canadian Imperial Bank v. Wells Fargo Bank, N.A., 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). "The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed." Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Thus, for purposes of our analysis, we cannot treat registrant's restaurant services as limited to a casino in Las Vegas; rather, registrant's identification must be viewed as encompassing neighborhood restaurants serving Middle Eastern food, with such restaurants being located

throughout the United States, including in the areas in which applicant's restaurants are located. The classes of consumers would therefore be the same. The factor of the similarity of trade channels favors a finding of likelihood of confusion.

The next du Pont factor we address is the conditions under which and the buyers to whom sales are made. Again, applicant's arguments limiting registrant's customers to those who are attracted to casino services can be given no consideration. Consumers for restaurant services are the public at large. Moreover, the decision to go to a particular restaurant may be made on impulse and without a great deal of care, especially if the restaurant is inexpensive. In this respect, we note from the materials applicant has submitted that most of its entree platters cost less than \$8.00. This factor favors a finding of likelihood of confusion.

We turn next to a consideration of the marks. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, 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. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Turning to the marks at issue, applicant's mark is ALADDIN'S EATERY. The word EATERY, which has been disclaimed, is a generic term for restaurant services. See dictionary definition made of record by Examining Attorney, March 8, 2005. Accordingly, this word has no source-indicating significance, and ALADDIN'S is clearly the dominant part of applicant's mark. Moreover, we note that in the materials submitted by applicant that applicant's mark is often shortened to just ALADDIN'S. See, e.g., "The Observer", March 31, 1995 ("Aladdin's is becoming one of the most popular restaurants in Cleveland Heights"), "The Morning Journal," June 3, 1994 ("Magic: tasty food also healthy at Aladdin's"); "The Washington Post," December 6, 2001 ("Aladdin's, which specializes in healthful, inexpensive Middle Eastern food"). Even applicant's advertising materials bear the slogan "At Aladdin's, Eat Good, Eat Healthy." Moreover, applicant generally depicts its mark with the "Aladdin's" portion shown prominently and in more distinctive lettering than the word "eatery," which is depicted below "Aladdin's" in all lower case and smaller type.

One of the cited registrations is for ALADDIN per se, shown in standard character form. The second registration

is for ALADDIN with the design of a lamp. ALADDIN is clearly the dominant part of this mark as well. The word ALADDIN appears in larger size than the lamp and, because restaurants are often recommended by word of mouth and referred to orally, it is the word portion of applicant's mark which is more likely to be impressed on the consumer's memory. See *In re Dixie Restaurants, Inc.*, supra. Moreover, the lamp design merely reinforces the connotation of ALADDIN, as the story of Aladdin is inextricably connected to the magic lamp with the genie inside.

When the marks are considered in their entirety, and giving due weight to the dominant portions of applicant's mark and the registrant's word and design mark, they are very similar in appearance, pronunciation, connotation and commercial impression. Although in applicant's mark ALADDIN is in the possessive form, neither this difference (nor the presence of the generic term EATERY, or, in Registration No. 2632473, the lamp design) is sufficient to distinguish the marks. The fact situation here is very similar to that in *In re Dixie Restaurants*, supra, where the Court found that applicant's mark THE DELTA CAFE and design was similar in appearance, sound and meaning to the registrant's mark DELTA, and that neither the design element nor the generic term "cafe" offered sufficient

distinctiveness to create a different commercial impression.

The factor of the similarity of the marks favors a finding of likelihood of confusion.

With respect to the fifth du Pont factor, that of fame, applicant has conceded that the registrant is known for casino services, but asserts that that it is not known for restaurant services, and therefore claims that this factor favors applicant. This conclusion is incorrect. There is no requirement that the Office must show fame of the registered mark in order to prove likelihood of confusion, and therefore the absence of fame does not favor the applicant. Because we have no evidence regarding the fame of the registrant's mark, we have treated this factor as neutral. However, we would point out that, if the registrant's mark were famous for casino services, such a fact would either be neutral or would support a finding of likelihood of confusion, it would never favor the applicant's position.

With respect to the du Pont factor of the number and nature of similar marks in use, as we have previously stated, there is no evidence in the record as to any third-party use. This factor is therefore neutral.

The seventh and eighth du Pont factors relate to the question of actual confusion. There is no evidence of actual confusion, despite the fact that applicant began using its mark in Ohio 1994, and since then has expanded the geographic area of its use to Pennsylvania, as far west as Chicago, and as far south as northern Virginia. The lack of actual confusion may be explained by the specific geographic areas in which applicant and the registrant actually operate, as well as by the specific type of restaurant services each offers. However, because applicant seeks to register its mark without any geographic limitations, and because the cited registration entitles the registrant to use its mark anywhere in the United States, and in connection with any type of restaurant services, including neighborhood restaurants featuring Middle Eastern cuisine, the lack of confusion in the past is not an indication that confusion is not likely to occur in the future. Thus, we regard these du Pont factors as neutral.

The ninth du Pont factor goes to the variety of service for which the cited mark is used. Because the registrant's mark is registered for services that are legally identical to applicant's services, it is not as necessary to support a finding of likelihood of confusion

that the registrant's mark is also used on additional goods or services. However, in view of the fact that the cited registrations include such additional services as bars and lounges and hotels and beauty salons and spas, to the extent that this factor is applicable to our determination, it must be seen to favor a finding of likelihood of confusion.

There is no evidence of a market interface between applicant and the registrant. This du Pont factor is therefore neutral. We also consider the factor of "the extent to which applicant has a right to exclude others from use of its mark on its goods [or services]" to be neutral. Although applicant asserts that it has a right to exclude anyone from using ALADDIN'S EATERY "by virtue of the applicant's wide, continuous and exclusive use of the mark in its entirety," Supp. brief p. 10, in fact cited registration No. 1779369 claims a first use date of 1966, the underlying application was filed in 1992, and it was registered in 1993, all prior to the first use claimed by applicant of its mark. And, as indicated above, applicant started using its mark in connection with restaurant services in Ohio, and while it has expanded to other geographic areas, its use is still in a relatively circumscribed area. In these circumstances, we do not

regard applicant as having shown that its use is wide or exclusive.

The potential for confusion from the use of virtually identical marks in connection with legally identical services that could be offered to the general public across the United States is substantial. Therefore, to the extent that this du Pont factor favors either party, it favors a finding of likelihood of confusion.

Finally, we note that in its brief applicant has discussed and attempted to distinguish the various cases cited by the Examining Attorney. For example, applicant asserts that in *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, supra, the marks COMMCASH and COMMUNCASH were similar and were used with identical services, while "in the present case the goods or services are distinct and the marks are different." Supp. brief p. 13. We point out that the Examining Attorney cited these cases for the legal principles enunciated in them, not because the specific fact situation or specific marks in those cases were similar to those in this appeal. We have done the same in our opinion. There is one case, however, that applicant asserts is similar to the present situation, namely, *California Fruit Growers Exchange v. Sunkist Baking*

Company, 166 F.2d 971, 76 USPQ 85 (7th Cir. 1947), from which applicant cites the following language:

Unless "Sunkist" covers everything edible under the sun, we cannot believe that anyone whose I. Q. is high enough to be regarded by the law would ever be confused or would be likely to be confused in the purchase of a loaf of bread branded as "Sunkist" because someone else sold fruits and vegetables under that name. The purchaser is buying bread, not a name. If the plaintiffs sold bread under the name "Sunkist," that would present a different question; but the plaintiffs do not, and there is no finding that the plaintiffs ever applied the word "Sunkist" to bakery products.

Although applicant believes that this case supports its position, our view is just the opposite. Here the goods are not fruits and bread, but are legally identical restaurant services. Thus, the situation is more akin to the hypothetical situation posited by the court: "if the plaintiffs sold bread under the name 'Sunkist,' that would present a different question." This "different question" is the one that is before us here, namely, whether applicant's use of its mark for its narrowly described restaurant services is likely to cause confusion with the registrant's virtually identical marks for its restaurant services which encompass those identified in applicant's application. After considering all the evidence in light

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of the applicable du Pont factors, our answer to this question is yes. We therefore find that applicant's use of ALADDIN'S EATERY for "small neighborhood storefront restaurants featuring Middle Eastern food specialties" is likely to cause confusion with the cited registered marks ALADDIN and ALADDIN and design for, inter alia, restaurant services.

Decision: The refusal of registration is affirmed.