

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Mailed:  
June 8, 2005

Grendel

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Roth Kase U.S.A. Ltd.

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Serial No. 76479059

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Erik W. Ibele of Neider & Boucher, S.C. for Roth Kase  
U.S.A. Ltd.

Inga Ervin, Trademark Examining Attorney, Law Office 111  
(Craig D. Taylor, Managing Attorney).

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Before Hohein, Grendel and Rogers, Administrative Trademark  
Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register  
of the mark ICEBERG (in standard character form) for goods  
identified in the application as "cheese."<sup>1</sup>

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<sup>1</sup> Serial No. 76479059, filed on December 30, 2002 on the basis of  
intent-to-use under Trademark Act Section 1(b), 15 U.S.C.  
§1051(b).

The Trademark Examining Attorney has issued a final refusal to register applicant's mark on the ground that the mark, as applied to the goods identified in the application, so resembles the mark ICEBERG DRIVE INN, previously registered (in standard character form; DRIVE IN (sic) disclaimed) for "restaurant services," as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant has appealed the final refusal. The appeal is fully briefed, but no oral hearing was requested. We reverse the refusal to register.

In support of her refusal, the Trademark Examining Attorney has submitted printouts of various third-party registrations, offered to show a relationship between applicant's goods and registrant's services. Applicant submitted a copy of registrant's menu with its appeal brief. The Trademark Examining Attorney has objected to the menu as untimely, see Trademark Rule 2.142(d), but she nonetheless has cited to and relied on the evidence herself, in her brief. Because both applicant and the Trademark Examining Attorney have relied on this evidence, we shall consider it as part of the record notwithstanding its untimeliness.

The third-party registrations made of record by the Trademark Examining Attorney are summarized as follows:

Registration No. 2810581, owned by Papa Gino's, Inc., of the mark PAPA'TIZERS for "restaurant services," "cheese and chicken," and "bread sticks";

Registration No. 2766831, owned by A&W Concentrate Company, of the mark A&W and design for "monthly newsletter circulated to restaurant franchisees," "potato chips and french fried potatoes," "soft drinks and syrups, and bases and concentrates for making same," "restaurant services," and "hot dog sandwiches, hamburger sandwiches, cheeseburger sandwiches, barbecued beef sandwiches, chicken sandwiches, and grilled cheese sandwiches";

Registration No. 2688768, owned by Taco Bell Corp., of the mark SPICE UP THE NIGHT for "restaurants," "Mexican food in the nature of beans namely re-fried beans, and cheese," "prepared Mexican dishes, namely, bean paste, tacos, burritos, tostadas, nacho cheese sauce, fajitas; and meal kits primarily containing salsa, nachos, nacho cheese sauce, taco meat and seasoning and also containing beans";

Registration No. 2816454, owned by Taco Bell Corp., of the mark TACO BELL and design for "tacos, tostadas, fajitas, burritos, enchiladas, tortillas, nachos, taco salad, Mexican pizza, prepared fried flour tortilla confections, taco seasoning mix, taco shells, taco dinner kit consisting of taco shells, taco sauce and seasoning mix, tortilla chips, picanta sauce, salsa, all for consumption on or off the premises," and "restaurant services";

Registration No. 2751105, owned by Mr. Goodburger's International, LLC, of the mark MR. GOODBURGER'S for "processed vegetarian meals, namely, vegetarian hamburger meat, chili, soup, french fry alternatives consisting

of chopped baked potato, fruit salad, vegetable salad, soy-based food beverages, soy cheese, soy yogurt, stir-fry vegetables, stir-fry meat substitute, vegetarian meat substitutes," "restaurant services, namely, vegetarian fast-food restaurants," and "processed vegetarian meals, namely, vegetarian hamburger sandwiches, sandwiches, pasta salad, rice salad, salsa, curry";<sup>2</sup>

Registration No. 2788363, owned by BHT Franchise Corporation, of the mark BERRYHILL HOT TAMALES & BAJA TACOS and design for "prepared and packaged foods, fresh and frozen, namely tamales, tacos, sauces and salsa," and "restaurant services"; and

Registration No. 2788362, owned by BHT Franchise Corporation, of the mark BERRYHILL BAJA GRILL for "prepared and packaged foods, fresh and frozen, namely tamales, tacos, sauces and salsa," and "restaurant services."

Registrant's menu, a copy of which is attached to applicant's brief, shows that registrant's "drive in" fare includes, among other grilled items, cheeseburgers, Philly cheesesteak sandwiches, grilled cheese sandwiches, grilled ham and cheese sandwiches, and chili cheese dogs.

In light of the decision of the Federal Circuit Court of Appeals in *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003) (a decision not discussed by either the Trademark Examining Attorney or applicant in

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<sup>2</sup> An additional Registration, of the mark AVANZA, was made of record by the Trademark Examining Attorney, but it appears to be inapposite because it does not include restaurant services.

this case), we find that there is not substantial evidence in the record to establish that purchasers are likely to assume that a source connection exists between "cheese" sold under applicant's ICEBERG mark and "restaurant services" offered under registrant's ICEBERG DRIVE INN mark.

The ICEBERG portion of the cited registered mark appears to be a strong mark for registrant's restaurant services, a fact which weighs in favor of a finding of likelihood of confusion. However, the third-party registration evidence submitted by the Trademark Examining Attorney simply fails to establish the "something more" that is required to find that a likelihood of confusion exists between restaurant services and cheese, even if offered under identical marks. *See Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641 (CCPA 1982). Only three of the third-party registrations cover both restaurant services and cheese, per se. That cheese may be an ingredient in other of the food items covered by the third-party registrations, and an ingredient in several of the items on the cited registrant's own menu, is not enough, under *In re Coors Brewing Co.*, *supra*, to persuade us that a likelihood of confusion exists.

**Decision:** The refusal to register is reversed.