

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
March 27, 2006
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Olieco, Inc.

Serial No. 76552294

Arnold S. Weintraub of The Weintraub Group, P.L.C., for
Olieco, Inc.

Esther Borsuk, Trademark Examining Attorney, Law Office 112
(Janice O'Lear, Managing Attorney).

Before Seeherman, Bucher and Kuhlke, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Olieco, Inc. seeks registration on the Principal
Register of the mark shown below for "restaurant services"
in International Class 43:¹



¹ Application Serial No. 76552294 was filed on October 17, 2003 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this mark based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has found that applicant's mark, when used in connection with the recited services, so resembles the mark **OLIVERS** (*standard character drawing*) registered for services recited as "restaurant and carry-out services,"² as to be likely to cause confusion, to cause mistake or to deceive. The Trademark Examining Attorney has also made final her requirement for a new drawing and for a disclaimer of the terms "Pizza," "Hot & Fresh" and "Authentic Italian Taste!"³

Applicant and the Trademark Examining Attorney have fully briefed the case, but applicant did not request an oral hearing.

LIKELIHOOD OF CONFUSION

As to the Section 2(d) refusal, applicant argues that the Trademark Examining Attorney has improperly focused on the word OLIVER'S while totally ignoring all the other words and design features making up applicant's composite

² Reg. No. 0899398 issued to Oliver's Pubs, Inc. on September 22, 1970, based upon allegations of use in commerce since at least as early as July 1, 1969; second renewal.

³ Applicant argued its position on the issue of likelihood of confusion in its appeal brief and again in its reply brief, but failed to mention these two requirements at all.

mark. Applicant argues that its mark creates an altogether different commercial impression from that of registrant's standard character mark. Applicant points out, for example, that its mark "also has a unique logo associated therewith including an oval and a mustachioed head having a bowler, a monocle and a bowtie." Applicant also appears to take the position that inasmuch as the term OLIVERS (plural) or OLIVER'S (singular possessive) is a surname, the registered mark should be accorded a narrowed scope of protection.

By contrast, the Trademark Examining Attorney contends that applicant's restaurant services and registrant's restaurant services are legally identical, and that inasmuch as the dominant portion of applicant's mark is OLIVER'S - which is almost identical to registrant's mark, OLIVERS, the marks are similar in appearance, sound, connotation and commercial impression. As to the argument about OLIVER'S being a surname, the Trademark Examining Attorney denies that the record shows it to be a surname, but concludes, in any case, that this is largely irrelevant to our determination herein as to likelihood of confusion.

Our determination under Section 2(d) of the Act is based upon an analysis of all of the probative 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).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to the du Pont factor focusing on the relatedness of the services as listed in the cited registration and in the involved application. The Board must base its determination of whether there is a relationship between the services of applicant and registrant on the basis of the services identified in the respective application and registration. Octocom Systems, Inc. v. Houston Computer Services, Inc., 918 F.2d 937, 16 USPQ2d 1783, 1788 (Fed. Cir. 1990). Here, as noted by the Trademark Examining Attorney, both applicant's application and registrant's registration include restaurant services. Hence, for our purposes, the services are legally identical. In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) [Applicant's restaurant services identified as "restaurant services specializing in Southern-style cuisine" are legally identical to registrant's restaurant services identified as "... restaurant services."].

Moreover, turning to the du Pont factors dealing with the similarity or dissimilarity of established, likely-to-continue trade channels, as well as the conditions under which and buyers to whom sales are made, we must presume that applicant's services and registrant's services will move through all of the normal channels of trade to all of the usual consumers of services of the type recited. See Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Hence, in looking to these two related du Pont factors, we conclude that the channels of trade and classes of purchasers will be the same.

Next, we turn to the du Pont factor focusing on the similarity of the marks. "If the services are identical, 'the degree of similarity necessary to support a conclusion of likely confusion declines.'" Dixie Restaurants, 41 USPQ2d at 1534, quoting, Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

There is no doubt but that there are differences between the cited mark and the applied-for mark, but the question is whether the marks are similar when viewed in their entireties. "[T]here is nothing improper in stating that, for rational reasons, more or less weight has been

given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). "The focus must be on the 'general recollection' reasonably produced by appellant's mark and a comparison of appellee's mark therewith." Johann Maria Farina Gegenuber Dem Julichs-Platz v. Chesebrough-Pond, Inc., 470 F.2d 1385, 176 USPQ 199, 200 (CCPA 1972). We also understand that human memory of trademarks is not necessarily perfect. See Clorox Company v. State Chemical Mfg. Co., 197 USPQ 840, 844 (TTAB 1977) ["[T]aking into account, as we must, the fallibility of the human memory over a period of time, we conclude that applicant's mark 'FORMULA 999' so resembles opposer's mark 'FORMULA 409' as to be likely" to cause confusion].

Here, when we compare the marks, we find that their similarities far outweigh their differences. There is no serious dispute but that the only word in registrant's mark and the first word in applicant's mark would be pronounced identically.

Applicant makes much of the fact that its mark contains a design element. Although this is correct, its presence is not enough to distinguish the marks. Because consumers use the word portion of a mark to call for or refer to

restaurant services, the design portion must be accorded lesser significance. See In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987).

We also have considered the fact that applicant's mark contains the additional wording "Pizza," "Hot & Fresh" and "Authentic Italian Taste!" While applicant has not disclaimed these terms as required by the Trademark Examining Attorney, these informational phrases cannot avoid confusion when the terms OLIVERS and OLIVER'S PIZZA are used with legally identical services. Highly descriptive or informational matter is often given less weight when considering the issue of likelihood of confusion. In this case, as applied to applicant's identified restaurant services, the additional wording describes qualities of the restaurant. Consumers are not likely to view these phrases as indicating source; rather, it is the word OLIVER'S that is the dominant source-indicating element of applicant's mark.

When we consider the marks in their entirety, we conclude that there are similarities in the appearance, pronunciation and connotation of the marks due to the common, dominant term OLIVER'S/OLIVERS, and that they convey similar commercial impressions. We further find that OLIVER'S PIZZA and design for restaurant services is likely

to cause confusion with OLIVERS for restaurant and carryout services. Dixie Restaurants, 41 USPQ2d at 1534 [THE DELTA CAFÉ is confusingly similar to DELTA].

A final point we should address on the issue of likelihood of confusion is applicant's argument that the word OLIVERS, or OLIVER'S, is primarily merely a surname. Brief at pp. 2 - 3; reply brief at pp. 1 - 2. Applicant did not properly make of record any evidence in support of the argument. While applicant submitted limited evidence of surname significance with its brief, the Trademark Examining Attorney objected to it as untimely. We agree that this evidence is untimely under Trademark Rule 2.142(d). Accordingly, we have given it no consideration.

Moreover, even if applicant had submitted evidence of the surname significance of OLIVER in order to show that the cited registration is entitled to only a limited scope of protection, that protection would still extend to prevent the registration of a mark as similar as is applicant's mark for identical services.⁴

In conclusion, for all the reasons noted above, the refusal on the basis of likelihood of confusion is affirmed.

⁴ Of course, to the extent that applicant is attempting to attack the cited registration on the basis that it is primarily merely a surname, such an attack is not permitted in an *ex parte* proceeding. Moreover, inasmuch as the cited registration is more than five years old, it would no longer be subject to a cancellation action on this ground in an *inter partes* proceeding.

DISCLAIMER

As noted earlier, the Trademark Examining Attorney required applicant to disclaim the terms "Pizza," "Hot & Fresh" and "Authentic Italian Taste!" The Trademark Examining Attorney asserts that this wording is merely descriptive because it immediately conveys knowledge of the characteristics of the cuisine and the qualities of the restaurant services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987); and *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). We agree that this entire wording is merely descriptive, and that a disclaimer of all of these terms is appropriate.

REQUIREMENT FOR SUBSTITUTE DRAWING

Finally, the Trademark Examining Attorney found unacceptable applicant's drawing because she alleged that applicant had used gray tones to indicate shading in the mark. The third portion of her final refusal to register was based on applicant's failure to comply with the requirement to provide a new drawing. As noted by Examination Guide 1-05, "Examination Procedures for Drawings Containing the Color Gray," issued May 20, 2005, the revised Trademark Manual of Examining Procedure (TMEP 4th ed. rev. 2005) permits Trademark Examining Attorneys to accept

drawings containing the color gray. Section 807.07(e) of the TMEP provides in pertinent part: "The Office now accepts drawings that contain the color gray, or stippling that produces gray tones. Unless an applicant claims the color gray, color will not be considered to be a feature of the mark and the drawing will be processed as a black and white drawing." In view of the change in examination practice since the final refusal issued, the Examining Attorney's refusal must be reversed.

We note that the final paragraph in the May 2005 Examination Guideline contains guidance consistent with this result:

Drawing quality

Drawings with gray tones, gray shading, or gray stippling must meet the USPTO's requirements for drawing quality. See 37 C.F.R. §§2.53(c) and 2.54(e); TMEP §807.05(c). If the image on the Publication Review program, available on the Office's internal computer network, is illegible, or contains matter that is not part of the mark and is not necessary to accurately depict the mark, the examining attorney must require the applicant to submit a new drawing.

It is our observation that the black and white image reproduced on the first page of this decision depicts the mark in a sufficiently high definition for later reproductions that it cannot be deemed to be illegible. TMEP §§807.04(a) and 807.06(e). Accordingly, we reverse this refusal to register.

Decision: The requirement for a new drawing is reversed. The refusal to register the mark under Section 2(d) of the Lanham Act is hereby affirmed. The refusal to register based upon applicant's failure to comply with the Trademark Examining Attorney's requirement for a disclaimer of the words "Pizza," "Hot & Fresh" and "Authentic Italian Taste!" is also affirmed.