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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Crescent City Restaurant, Inc.

Serial No. 77100572

Crescent City Restaurant, Inc., pro se.

Elizabeth N. Kajubi, Trademark Examining Attorney, Law
Office 107 (J. Leslie Bishop, Managing Attorney).

Before Quinn, Rogers and Taylor, Administrative Trademark
Judges.

Opinion by Taylor, Administrative Trademark Judge:

Crescent City Restaurant, Inc. has filed an
application to register on the Principal Register the mark
CRESCENT CITY STEAKS SINCE 1934 and design, shown below,



for services identified as "catering; restaurant and bar services."¹ "CRESCENT CITY STEAKS SINCE 1934" has been disclaimed.

The examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark resembles the mark in U.S. Registration No. 2881157, CRESCENT CITY (in typed form), for "restaurant services."²

When the refusal was made final, applicant appealed and requested reconsideration of the final refusal. On October 19, 2007, the examining attorney denied the request for reconsideration and, on November 15, 2007, this appeal was resumed. Briefs were filed by both applicant and the examining attorney. For the reasons discussed below, we affirm the refusal to register.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative

¹ Serial No. 77100572, filed February 6, 2007, and alleging December 13, 1992 as the date of first use of the mark anywhere and in commerce. The application also contains the following color statements: "The applicant claims color as a feature of the mark, namely, navy and green circles, semi, rectangles with one or more curved sides, green [sic] letters and numbers, red letters, yellow crescent moon." "The mark consists of navy and green circles, semi, rectangles with one or more curved sides, the words crescent city since 1934 in green, the word steaks in red, crescent moon in yellow."

² Registration No. 2881157, issued September 7, 2004.

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 Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to a consideration of the services. It is well settled that the question of likelihood of confusion must be determined based on an analysis of the services recited in applicant's application vis-à-vis the services identified in the cited registration. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). In the present case, the identified services of applicant and those of the cited registrant have a service in common (i.e., restaurant services), and the additional services in applicant's application (i.e., catering and bar services)

are otherwise closely related services in the food and beverage industry.

Applicant, in its July 10, 2007 response, appears to argue that the services are unrelated because registrant's mark is used in connection with a business that does not sell steak. This argument is unpersuasive because registrant's restaurant services as identified in the cited registration are not limited to a particular type or style of food. See e.g., *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (An applicant may not restrict the scope of the goods [or services] covered in the cited registration by argument or extrinsic evidence).

Further, we must presume that these legally identical services will be offered in the same channels of trade and will be purchased by the same classes of purchasers, i.e., ordinary consumers, while the related services will be offered in some of the same channels of trade, and will be bought by some of the same purchasers. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). In view of the above, the *du Pont* factors of the similarity of the services, channels of trade and classes of purchasers favor a finding of likelihood of confusion as to the cited registration.

We now consider applicant's mark, CRESCENT CITY STEAKS SINCE 1934 and design, and the cited mark CRESCENT CITY, keeping in mind that when marks would appear on even some identical services, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In determining the similarity or dissimilarity of marks, we must consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). That is, the purchaser's fallibility of memory over a period of time must be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477

F.2d 586, 177 USPQ 573 (CCPA 1973); and Spoons Restaurant Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1991); aff'd unpub'd (Fed. Cir., June 5, 1992). Applicant maintains that granting it a registration for its mark, which includes "a distinctive logo in combination with the words 'Crescent City Steaks Since 1934', will not impair Crescent City Beignet's right to 'crescent city.'" (Br., at unnumbered p. 2). The examining attorney, by comparison, contends that applicant's mark is highly similar to the cited mark.

We agree that applicant's mark CRESCENT CITY STEAKS SINCE 1934 and design is similar to the cited CRESCENT CITY mark. Although we must compare the marks in their entirety, one feature of a mark may be more significant than another and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) ("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 consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable.").

Further, with a composite mark comprising a design and words, it is the wording that would make a greater impression on purchasers and is the portion that is more likely to be remembered as the source-signifying portion of the applicant's mark. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593 (TTAB 2001) ("words are normally accorded greater weight because they would be used by purchasers to request the goods"). See also, e.g., *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (1987). It is not unusual for restaurants to be discussed by patrons who have eaten in them, or by reviewers, and any such discussions would necessarily utilize the words in applicant's mark, rather than a description of the colors and designs in the mark.

In this case, applicant's mark is dominated by the words CRESCENT CITY; they are the first words in the mark and, along with the word STEAKS, are visually larger than the text "SINCE 1934" and more distinct than the crescent moon design. Although the term STEAKS is in the same size text as CRESCENT CITY, because STEAKS clearly describes the type of food served in applicant's restaurants, as acknowledged by applicant, it is not source signifying and therefore not a dominant element. See *In re National Data Corp.*, 224 USPQ at 751 ("That a particular feature is descriptive or generic with respect to the involved goods

or services is one commonly accepted rationale for giving less weight to a portion of the mark.”). The phrase “Since 1934,” has also been disclaimed, as it merely describes when applicant first offered its restaurant services, and likewise would not be looked upon as a source-identifying element. Moreover, we do not find the design sufficient to distinguish applicant’s mark from the cited mark. While clearly noticeable, the curved rectangular feature merely serves to frame the mark and the crescent moon and bowl design simply reinforces the CRESCENT CITY portion of the mark.

We acknowledge that applicant has also included a disclaimer of the words CRESCENT CITY, but that does not remove those words from the mark or reduce their visual dominance of the composite mark. This dominant portion of applicant’s mark is identical to the cited mark in appearance, sound, connotation and commercial impression. In terms of appearance, because the registered mark is registered in typed or standard characters, we are required to consider that registrant may display the words in any reasonable form of lettering, including the font used by applicant. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-1848 (Fed. Cir. 2000).

Applicant essentially argues that its mark is not capable of causing confusion because the term "crescent city" is in common usage and because it has disclaimed the phrase "CRESCENT CITY STEAKS SINCE 1934." To the extent that applicant is arguing that the disclaimed matter is of no import, applicant is incorrect. Disclaimed matter must be considered with the rest of the mark as a whole in assessing the similarity between the marks. As stated by our primary reviewing court,

it is well settled that the disclaimed material still forms a part of the mark and cannot be ignored in determining likelihood of confusion. Such disclaimers are not helpful in preventing likelihood of confusion in the mind of the consumer, because he is unaware of their existence. Therefore, the disclaimed portions must be considered in determining the likelihood of confusion. (citations omitted)

Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218, USPQ2d 390, 395 (Fed.Cir. 1983); see also In re National Data Corp., 224 USPQ at 751-752; V-M Mayfair Sound Prd., Inc., 480 F.2d 898, 178 USPQ 477, 477-478 (CCPA 1973). As noted above, notwithstanding the disclaimer, the words CRESCENT CITY can still be dominant, visually, and because they would be used to refer to the restaurant when discussed orally.

As regards applicant's assertion of common usage of the term "Crescent City," applicant made of record an

excerpt from the Greater New Orleans Directory listing various businesses whose name includes the term "Crescent City." These listings of companies with the term "Crescent City" in their names do not show actual use in the marketplace of these trade names and company names. These listings are of limited probative value because they do not demonstrate that these businesses actually exist or that the public is aware of them and therefore able to distinguish one CRESCENT CITY business from another. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1622 (TTAB 1989) and *In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983). We add that the use of the term "Crescent City" in connection with the various companies whose businesses are as diverse as an antique gallery, a cab company and a cleaning service, do not show that the registered mark is weak and entitled to a limited scope of protection for restaurant services.

However, even assuming registrant's mark is weak, even weak marks are entitled to protection. See *Matsushita Electric Company v. National Steel Co.*, 442 F.2d 1383, 170 USPQ 98, 99 (CCPA 1971) ("Even though a mark may be 'weak' in the sense of being a common word in common use as a trademark, it is entitled to be protected sufficiently to prevent confusion from source arising"). At issue here are

substantially similar marks for identical (in part) services. Under these circumstances, the mere weakness of the term "CRESCENT CITY" does not obviate a likelihood of confusion, because it is the common portion of the marks (and the whole of the cited mark). Moreover, applicant fails to acknowledge that while CRESCENT CITY may be geographically descriptive for businesses located in New Orleans³, and may even be descriptive for businesses in other locations called CRESCENT CITY, there is no evidence of record that registrant's restaurant is located in such a place. Therefore, we cannot conclude that CRESCENT CITY is weak for registrant's restaurant, even though it may be weak in other contexts.

As noted previously, the dominant, albeit disclaimed, portion of applicant's mark is identical to the cited mark in appearance, sound, connotation and overall commercial impression. While we have not overlooked the design element or applicant's arguments regarding the weakness of the term CRESCENT CITY, we nonetheless conclude that the marks, when considered in their entireties, are substantially similar due to the shared term CRESCENT CITY.

³ As applicant points out, "New Orleans is referred to by many natives of the area as the crescent city, by virtue of the bend in the Mississippi River as it winds through town. (Response, filed July 10, 2007, p. 1).

Thus, the factor of the similarity of the marks favors a finding of likelihood of confusion.

Two final arguments made by applicant must be addressed. First, during prosecution, applicant suggests that it has priority over registrant. Such a claim is an impermissible collateral attack on the cited registration. Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), provides that a certificate of registration on the Principal Register shall be prima facie evidence of the validity of that registration, or the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in connection with the goods and services identified in the certificate. During *ex parte* prosecution, including an *ex parte* appeal, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (e.g., applicant's claim of priority over the cited mark). In *re* Dixie Restaurants, 41 USPQ2d at 1534; and In *re* Peebles Inc., 23 USPQ2d 1795, 1797 n.5 (TTAB 1992). See TMEP § 1207.01(d)(iv) (5th ed. 2007). Accordingly, no consideration has been given applicant's argument in this regard. We do not have before us a claim for cancellation of the cited registration, or even a claim that applicant has concurrent use rights, both

of which would have to be raised in an inter partes proceeding.

Second, applicant states that it had a previous registration for the same mark for the same services that it inadvertently allowed to lapse for failure to file an affidavit of continuous use. Applicant contends that its mark previously was allowed to register even though the Patent and Trademark Office ("PTO") at first suspended the original application based on priority of rights of another to the term "crescent city." (Br., unnumbered p. 1). Applicant then vigorously argues that "[t]he PTO has acted inconsistently and incorrectly by granting our Original Service Mark in 1997 but rejecting our application to renew the mark in 2007," when in both cases it disclaimed the term "CRESCENT CITY STEAKS SINCE 1934." (Br., unnumbered p. 2). While we are not unsympathetic to applicant's situation, we simply are not bound by the decisions of prior examining attorneys. As has often been stated, each case must be considered on its own merits based on evidence of record at the time registration is sought. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); and *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977). See also, *In re Sunmarks Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994) (Applicant who has previously

registered a mark is not guaranteed the right to obtain additional registrations for the mark if an intervening registration creates conflict).

After careful consideration of the briefs and all of the evidence of record, and given the constraints under which we are obligated to assess the current application, i.e., based on the identifications, and on comparison of the marks without regard to circumstances relating to use that might serve, in the real world, to obviate possible confusion, and given the requirement that any doubt be resolved in favor of registrant, we conclude that the refusal of registration must be affirmed.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.