

THIS DECISION IS NOT A
PRECEDENT OF THE TTAB

Mailed: July 22, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE¹

Trademark Trial and Appeal Board

In re Center Cut Hospitality, Inc.

Serial No. 78267308

Drew T. Palmer of Crowe & Dunlevy, PC, for Center Cut Hospitality.

Samuel E. Sharper, Trademark Examining Attorney, Law Office 108, Andrew Lawrence, Managing Attorney.

Before Quinn, Walters, and Mermelstein, Administrative Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

Center Cut Hospitality, Inc. seeks registration of the mark SWINGIN' AT SULLY'S (typed mark) for "restaurant and bar services" in International Class 43. Registration has been finally refused pursuant to Trademark Act § 2(d), 15 U.S.C. § 1052(d), on the ground that applicant's mark so

¹ Filed June 26, 2003, based on first use of the mark and first use in commerce of June 15, 2003. Filed in the name of Lone Star Steakhouse & Saloon, Inc., this application was assigned to the current applicant by transfer dated June 19, 2007, and recorded in the assignments records of the USPTO at Reel 3590, Frame 0306.

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resembles the mark in Registration No. 2988867² (shown below), for "restaurant and bar services," as to be likely if used on or in connection with the identified goods, be likely to cause confusion, to cause mistake, or to deceive.



After careful consideration of the record,³ we affirm.

I. Applicable Law

Our determination under Trademark Act § 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

² Issued August 30, 2005, based on first use and first use in commerce of June 12, 1984, and a claim of acquired distinctiveness pursuant to Trademark Act § 2(f).

³ Applicant and the examining attorney filed briefs on appeal. Although applicant sought and was granted an extension of time to file a reply brief (to March 26, 2008), no reply brief was filed.

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999), and cases cited therein.

II. Discussion

We review the relevant *du Pont* factors as they apply to this case.

A. The Similarity Or Dissimilarity And Nature Of The Goods or Services

Applicant's services and those of the cited registrant are identical: "restaurant and bar services." This factor strongly supports a finding of likelihood of confusion.

B. The Similarity Or Dissimilarity Of Established, Likely-to-Continue Trade Channels and Potential Purchasers

The fact that the services are identical also means that we must assume that purchasers and channels of trade are also identical. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any

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restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

This factor likewise supports a finding of a likelihood of confusion.

C. The Similarity Or Dissimilarity of the Marks in Their Entireties as to Appearance, Sound, Connotation and Commercial Impression.

We must compare the marks for similarities and dissimilarities in appearance, sound, meaning, and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. But where the goods or services recited by the applicant are closely related or identical to those in the cited registration, "the degree of similarity necessary to support a conclusion of likely confusion declines."

Century 21 Real Estate Corp. v. Century Life of Am., 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); see also *In re Smith and Mehaffey*, 31 USPQ2d at 1532; *In re La Peregrina Ltd.*, 86 USPQ2d 1645 (TTAB 2008).

As the Court of Appeals for the Federal Circuit observed,

in articulating reasons for reaching a conclusion on the issue 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 consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.

In re Nat'l Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant's mark is SWINGIN' AT SULLY'S (typed), while the mark in the cited prior registration is SULLY'S, with a penguin design. Applicant agrees that the marks share a common element: "SULLY'S." Nonetheless, pointing to the additional material in both marks ("SWINGIN' AT --" in applicant's mark and the penguin design in the prior registrant's), applicant argues that "the matter not common to the marks is especially distinctive." App. Br. at 8 (citations omitted). "As a result, where there is additional distinctive material not shared between the two marks, there is no likelihood of confusion between the marks." *Id.* at 9.

Applicant's formulation of the test is incorrect. The question is not whether there is a "likelihood of confusion between the marks." The question in determining whether a

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likelihood of confusion exists is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (CCPA 1972).

We find that the term SULLY'S is the dominant portion of both marks. Applicant's mark includes additional wording. In that regard, applicant notes that "the SWINGIN' AT SULLY'S mark brings to mind a different era, one of big bands, swing dancing, and connotes a party atmosphere, where singles can meet and mingle." App. Br. at 9. Because of this connotation, we find that the words "SWINGIN' AT --" in applicant's mark are somewhat suggestive of a bar and restaurant featuring band music and dancing. Although we consider the entire mark as a whole, we find that this suggestive wording is less dominant in the overall impression of opposer's mark, and that guests of the restaurant are likely to focus primarily on the word "SULLY'S" than "SWINGIN' AT --" in the mark.

As for the mark in the cited registration, we recognize, of course, that the penguin design makes a significant visual impression. Nonetheless, we note that in combined word and design marks, the word portion frequently dominates inasmuch it is the words by which

consumers will call for the goods and services. *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553 (TTAB 1987). In discussing a restaurant operating under the registrant's mark, or in calling for reservations, we think it highly unlikely that customers would speak of - or even think of - the penguin design. Such an establishment would almost surely be referred to simply as "Sully's."

The marks thus share both similarities and differences. While they are somewhat different in appearance and connotation, we find them more similar than dissimilar in sound and significantly similar in overall commercial impression.

This factor supports a finding of likelihood of confusion.

D. Family of Marks

In response to the examining attorney's refusal of registration, applicant argued that the mark in the subject application is part of a "family" of marks, listing the following registrations⁴ as prior members of its family:

⁴ A list of registrations is generally not sufficient evidence of such registrations nor is it sufficient to make them of record. Nonetheless, because the examining attorney failed to object to this submission, we will consider the list for whatever probative value it may have. However, the registrations themselves, which were never submitted, are not of record, nor is the listing of goods and services associated with each of the listed registrations. The latter information was first submitted with

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SWINGIN' AT SULLIVANS	Reg. No. 2853848
SULLIVAN'S STEAKHOUSE	Reg. No. 2062637
SULLIVAN'S STEAKHOUSE	Reg. No. 2529991
RINGSIDE AT SULLIVAN'S	Reg. No. 2249440
RINGSIDE AT SULLIVAN'S	Reg. No. 2256909

Resp. to Office Action March 12, 2007.

Applicant argues that "[w]hen a given mark is part of a family of marks that are 'closely similar in sound, appearance and connotation,' consumers are likely to believe that the origin of the goods and services of that mark is the same as that of the rest of the marks in the family." App. Br. at 6 (citations omitted). On the contrary, we disagree that the "family of marks" doctrine has any applicability in this *ex parte* proceeding.

In general usage,

[t]he owner of the family of marks contends that, because the defendant's mark contains the asserted family characteristic, purchasers familiar with plaintiff's family of marks are likely to believe that defendant's mark is but another member of the family.

Jeffrey A. Handelman, 1 GUIDE TO TTAB PRACTICE § 6.13 [B] (2008).

The family of marks doctrine is thus used by a plaintiff in an opposition or cancellation proceeding, who

applicant's brief (and was not accepted or used by the examining attorney) and is thus clearly untimely. Trademark Rue 2.142(d).

argues that it is entitled to recognition of an "asserted family characteristic" to prevent registration of another's mark similar to that family characteristic. By contrast, applicant here is attempting to use the "family of marks" doctrine as a shield against a refusal to register.

Applicant essentially contends that because it has other registrations for what it claims to be similar marks, it is entitled to registration of this application. But as the examining attorney points out, priority is not an issue. This is so because the refusal to register is based on a registration. It is not a defense to such a refusal to argue that the cited registration should not have issued over applicant's other registrations or that applicant actually has priority by virtue of them. Such an argument is no more than a impermissible collateral attack on the validity of the cited registration.⁵ See *In re Calgon Corp.*, 168 USPQ 278, 279-280 (CCPA 1971). See also *Baroid Drilling Fluids Inc. v. Sun Drilling Prod.*, 24 USPQ2d 1048 (TTAB 1992). Accordingly, we give applicant's "family of marks" argument no further consideration.

⁵ Further, even the family of marks doctrine could help applicant in this situation, applicant has not proven that it owns such a family, or that SULLY'S is a family member. A party claiming to own a family of marks must show that "the marks that are asserted to make up the family have been used and advertised in such a manner that consumers have come to recognize that the

III. Conclusion

In weighing the relevant *du Pont* factors, we find that the goods are identical, and that they share legally identical channels of trade and customers. Although the marks at issue bear obvious differences, the dominant part of both marks is both distinctive and identical. We conclude that such marks, when used in connection with the identified services, are likely to cause confusion, to cause mistake, or to deceive, within the meaning of Trademark Act § 2(d).

Decision: The refusal to register under Trademark Act § 2(d) is accordingly affirmed.

characteristic is indicative of a common origin of the goods." 1
GUIDE TO TTAB PRACTICE § 6.13[B].