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AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sacco¹

Serial No. 78688885

Kathleen A. Pasulka of Procopio Cory Hargreaves & Savitch
LLP for Joe Sacco.

John E. Michos, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Rogers, Drost, and Cataldo, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 9, 2005, applicant Joe Sacco applied to
register the mark KICK'N WINGS (standard character mark) on
the Principal Register for "restaurant services" in Class
43. Application Serial No. 78688885 is based on
applicant's allegation of a bona fide intent to use the

¹ The application identifies the applicant as "Sacco, Joe/Joe
Sacco." In response to the examining attorney's inquiry
concerning ownership, applicant responded: "The USPTO
instruction requested that the individual's name be typed
backwards slash forwards. There is only one Applicant, Joe
Sacco." Response dated September 6, 2006 at 1.

Ser No. 78688885

mark in commerce. Applicant has disclaimed the word "Wings."

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of the following two registrations.

Registration No. 2381484
KICK'N WINGS (typed or standard character form)
For: "poultry" in Class 29
Disclaimer: Wings
Registration date: August 29, 2000
Affidavits: §§ 8 and 15

Registration No. 1752747



For: "poultry; namely, prepared chicken"² in Class 29
Registration date: February 16, 1993
Renewed

The current owner of both registrations is identified as Perdue Holdings, Inc.

After the examining attorney made the refusal final, this appeal followed.

Inasmuch as the issue in this case involves a determination of whether there is a likelihood of

² The term "wings" has been deleted from the registration's identification of goods.

confusion, we consider the facts of record in view of the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 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).

We begin by comparing the marks at issue here. Applicant's mark is KICK'N WINGS. Registrant's marks also contain the identical words KICK'N WINGS although in one (the '747 registration), registrant adds a design that does not appear to include the apostrophe before the letter "N." Thus, one registration is identical to applicant's mark and the other registration contains the identical words. In these situations, "even when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source." *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d

Ser No. 78688885

1687, 1689 (Fed. Cir. 1993). See also *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981) (When the marks are identical, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar").

Applicant argues that "KICKIN is not uncommon for food products as well as restaurant services." Brief at 3. In its brief and in its response dated September 6, 2006 at 1, applicant also listed some marks and argues that:

A search of the Internet proves this point as well as the registered marks on the Principal Register. For example: TENDERS! WHERE THE CHICKEN IS KICKIN! For restaurant services, KICKIN' CORNBREAD for cornbread, ASS KICKIN' for sauces and bread, KICKIN CORNBREAD, for cornbread, KICKIN KARIBBEAN for chicken wing sauce, KICKING HORSE COFFEE for coffee, KICKIN' CAJUN for meat snacks, and KICKIN' IT with FLAVOR for tortilla chips.

According to applicant, "[a]ll of these marks are owned by parties other than those of the cited Registrations." Brief at 3.

The examining attorney has objected to these registrations because applicant "has not properly made any third party registrations of record." Brief at unnumbered p. 6. While we normally require copies of registrations to be submitted before we will consider them on appeal, there are exceptions.

Copies of third-party registrations that are submitted with an applicant's brief may be considered in certain circumstances, even if the examining attorney objects to the registrations or does not discuss them in the examining attorney's brief. If the applicant, during the prosecution of the application, provided a listing of third-party registrations, without also submitting actual copies of the registrations, and the examining attorney did not object or otherwise advise applicant that a listing is insufficient to make such registrations of record at a point when the applicant could cure the insufficiency, the examining attorney will be deemed to have waived any objection as to improper form.

TBMP § 1207.03 (2d ed. rev. 2004).

Here, the examining attorney did not advise applicant that he needed to submit copies of these registrations that applicant referred to in his response to the first Office action. Therefore, we will consider the information that applicant has made of record. TBMP § 1208.02 (2d ed. rev. 2004) ("The Board will not consider more than the information provided by applicant. Thus, if applicant has provided only a list of registration numbers and marks, the list will have very limited probative value").

Applicant also submitted two pages of GOOGLE search results. These truncated search results are entitled to little weight. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) ("Because the GOOGLE search report provides very little context of the use of ASPIRINA on the webpages linked to the search

report, it is of little value in assessing the consumer public perception of the ASPIRINA mark"). Some of these search engine results are difficult to understand or not relevant. See, e.g., www.darkstarlings.com ("o wait don't forget that lovable psychotic squirrel foamy!! Kicken wings!..."); www.wwhh.net (Wheels Wings-N-Hobbies Forums ... kicken new computer"); and www.urbandictionary.com (no identified reference to Kicken wings). However, there is a reference to "Kicken Chicken Pizza" (www.chiefsonline.com); "Our famous oven baked wings: Choose from · Kicken · Hot · Medium · Mild..." (pigseye.keenesaw.com); and "Kicken Wings recipe" (www.epicurious.com). While these uses generally show the term as "Kicken," and this evidence is entitled to only very limited weight, it does undercut the examining attorney's argument (Brief at 6) that "Registrant's marks include a novel contraction of the word 'kicking.'" Nonetheless, the limited evidence that applicant has made of record does not establish as fact applicant's contention that because "of the many uses of the word KICK'N, in various forms, ... the public will be able to differentiate between the source of Applicant's services and the goods sold by" registrant. Brief at 3.

We conclude that the wording in the marks is identical in sound, appearance, meaning, and commercial impression.

Ser No. 78688885

The addition of the design in the '747 registration does not overcome the fact that words are identical and they would dominate the mark because it is likely to be the way purchasers refer to the cited registrant's prepared chicken.

Next, we consider whether applicant's restaurant services are related to registrant's poultry and prepared chicken. We must consider the goods and services as they are identified in the application's and registration's identifications of goods and services. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("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 [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed"). The "prepared chicken" in cited Registration No. 1752747 can include chicken that is available for carry out at restaurants, grocery stores, and similar establishments.

Inasmuch as the goods and services here involve restaurant services and food items, we must also consider that there is no per se rule that confusion is likely simply because "similar or even identical marks are used for food products and for restaurant services." *Jacobs v. International Multifoods Corporation*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982). See also *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1064 (Fed. Cir. 2003) ("But the registered mark in this case is simply for restaurant services in general, and the Board's conclusion that restaurant services and beer are related is based on the fact that a tiny percentage of all restaurants also serve as a source of beer, which is a very weak evidentiary basis for a finding of relatedness"). The Federal Circuit further explained, however, that the outcome would have been different "if the registrant's mark had been for a brewpub or for restaurant services and beer. In that case, the goods and services associated with the two marks would clearly be related." *Id.*

The examining attorney has submitted numerous use-based registrations to show that the same entity has registered a common mark for restaurant services and chicken food products.

Ser No. 78688885

No. 1461151 - "restaurant services" and "barbecued chicken wings"

No. 3127996 - "eat in and take out restaurant services" and "chicken wings served with a variety of sauces and prepared in a variety of ways"

No. 2898622 - "delicatessen, restaurant and catering services" and "meat and poultry"

No. 2965476 - "restaurant services" and "fried chicken and shish ka bobs"

No. 3068668 - "restaurant and catering services" and "meat and poultry"

No. 1896345 - "restaurant and catering services" and "prepared frozen or packaged entrees or meals consisting primarily of meat, fish, poultry, and/or vegetables"

In addition, other registrations show that the same mark has been registered for restaurant services and also for prepared chicken for consumption on and off the premises of the restaurants. See, e.g., Registration Nos. 1896345, 2736423, 2866170, 2934591, 3042453, and 3110692.

These registrations suggest, in general, that poultry and restaurants services are related; and more specifically, that restaurant services and takeout and prepared chicken items are also related. See *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001) ("The registrations show that entities have registered their marks for both television and radio broadcasting services. Although these registrations are

Ser No. 78688885

not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the services listed therein, including television and radio broadcasting, are of a kind which may emanate from a single source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988)".

Furthermore, not only does applicant's identification of restaurant services include restaurants that sell chicken, but also applicant has disclaimed the word "Wings" and argued (response dated September 6, 2006 at 2) that KICK'N is "the dominant portion of both marks, with the rest being descriptive." Our case law has recognized that the "something more" requirement of *Jacobs* includes situations where the specific food items of one entity are likely to be sold in the other's restaurant. See *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209, 1211 (TTAB 1999) ("The average consumer, therefore, would be likely to view Mexican food items and Mexican restaurant services as emanating from or sponsored by the same source if such goods and services are sold under the same or substantially similar marks"); *In re Opus One Inc.*, 60

Ser No. 78688885

USPQ2d 1812, 1815 (TTAB 2001) ("The fact that applicant's restaurant serves the type of goods (indeed the actual goods) identified in the cited registration is certainly probative evidence which supports a finding under the second *du Pont* factor that applicant's services and [registrant's] goods are related"). Therefore, we find that applicant's restaurant services and registrant's poultry and prepared chicken are related. Furthermore, patrons of restaurants serving chicken to eat in or take out are likely to overlap with purchasers of prepared chicken and poultry in grocery stores.

Because the wording in the marks is identical and restaurant services, which would include restaurants that serve chicken, are related to poultry and prepared chicken, we conclude that that consumers are likely to believe that there is an association between applicant's KICK'N WINGS restaurant services and registrant's KICK'N WINGS poultry and KICK'N WINGS and design prepared chicken.

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.