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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Tenda Chick Inc.

v.

The Salty Dog, Inc.

Opposition No. 91162402 to application Serial No. 76454157
filed on October 1, 2002

James E. Shlesinger of Shlesinger, Arkwright & Garvey LLP
for Tenda Chick Inc.

John L. DuPre of Hamilton, Brook, Smith & Reynolds, P.C. for
The Salty Dog, Inc.

Before Hairston, Grendel and Zervas, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Applicant, The Salty Dog, Inc., seeks registration on
the Principal Register of the mark FRESH FISH ... NO BONES
ABOUT IT (in standard character form) for the following
services, as amended: "retail store services featuring
cooked seafood" in International Class 35. Applicant has

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asserted a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b).

Opposer Tenda Chick Inc. filed a timely notice of opposition to registration of applicant's mark. In opposer's notice of opposition, opposer pleaded that it is the owner of Registration No. 1772044 for the mark NO BONES ABOUT IT (in typed form) for "restaurant services";¹ and that it has used the mark GREAT CHICKEN ... NO BONES ABOUT IT prior to the filing date of the application in connection with its restaurant, take out and catering services. Further, opposer pleaded that applicant's mark so resembles opposer's marks 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 answered the amended notice of opposition by denying the salient allegations thereof.

The Record

The record consists of the pleadings; the file of the involved application; the trial deposition of Donald P. Moore, president of opposer, and exhibits thereto; and a status and title copy of Registration No. 1772044 made of record pursuant to a notice of reliance filed on August 30, 2005.

¹ Registration No. 1772044 (renewed) issued on the Principal Register on May 18, 1993, and claims first use anywhere on May 31, 1990 and first use in commerce in 1990.

Applicant has not introduced any evidence and has not filed a brief in response to opposer's main brief.

Factual Findings

Opposer is a restaurant and catering establishment, which processes food products including chicken and fish, french fries, coleslaw and potato salad, and sells such products through dine-in, take-out and catering retail outlets. Since 1990, opposer has been continuously selling all of the foregoing food items and services under the mark NO BONES ABOUT IT and has been using GREAT CHICKEN ... NO BONES ABOUT IT on its letterhead. Opposer advertises its food items and services under the mark NO BONES ABOUT IT in print media (newspapers, magazines and in high school football programs), on television and on the radio.

Priority

The question of priority is not an issue in this case because opposer owns an existing registration upon which it can rely under Section 2(d). *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Additionally, opposer has established through the testimony of Mr. Moore that it has continuously used NO BONES ABOUT IT in connection with restaurant services since 1990; and that it has been using GREAT CHICKEN ... NO BONES ABOUT IT on its letterhead since the early 1990s, prior to the filing date of applicant's intent-to-use application.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the 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). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we 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 [services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Turning first to the *du Pont* factor regarding the similarity or dissimilarity of the marks, we consider whether applicant mark and opposer's marks are similar in sound, appearance, meaning, and commercial impression in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 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 impression that confusion as to the source of the services 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 *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

We consider applicant's mark FRESH FISH ... NO BONES ABOUT IT and opposer's registered mark NO BONES ABOUT IT and unregistered mark GREAT CHICKEN ... NO BONES ABOUT IT, for which opposer has established priority.² The wording NO BONES ABOUT IT in each mark conjures up the popular expression "make no bones about it" - "make no bones" is defined in *Merriam-Webster's Online Dictionary*³ (at merriam-webster.com) as "to be straightforward, unhesitating, or sure <makes no bones about the seriousness of the matter>." Because each mark contains or makes use of NO BONES ABOUT IT, purchasers will likely readily recall this portion of the marks, or recall the entire mark due to this portion of the mark. Further, applicant's mark and registrant's unregistered mark each contain an initial portion consisting

² We do not consider the mark discussed in opposer's brief but not pleaded by opposer, i.e., GREAT FISH ... NO BONES ABOUT IT. A plaintiff may not rely on an unpleaded claim. See TBMP § 314 (2d ed. rev. 2004). Also, because applicant has not participated in the trial in this case, the pleadings cannot be deemed amended as asserting this mark pursuant to Fed. R. Civ. P. 15(b).

³ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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of two words followed by an ellipsis and the identical phrase NO BONES ABOUT IT. This construction makes applicant's mark and registrant's unregistered mark similar in appearance. In view thereof, and of the commonality of NO BONES ABOUT IT, we find that the marks are highly similar in sound, meaning, appearance and commercial impression, and that any differences due to the different initial wording of applicant's mark are outweighed by the similarities in the marks. The first *du Pont* factor is therefore resolved in opposer's favor.

We now consider the similarity and dissimilarity of the services. Opposer's registration is for "restaurant services" and opposer has used its common law marks in connection with dine-in, take-out, and catering outlets. Applicant's services are legally identical to opposer's take-out services and otherwise highly similar to the services provided by opposer in its dine-in and catering outlets, as well as the restaurant services identified in the registration - prepared food for consumption by the general public. We thus resolve the *du Pont* factor regarding the similarity or dissimilarity of the services in opposer's favor.

As for the *du Pont* factor regarding the similarity or difference in the trade channels, we note that the

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identifications of services in both the registration and the application do not include any limitations regarding trade channels. In such circumstances, we must presume that the identified services move in all channels of trade that would be normal for such services. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Opposer's witness, Mr. Moore, has testified that opposer advertises its services in media such as ordinary newspapers and magazines, as well as television and radio advertisements. Because applicant's identification of services is not restricted, applicant's trade channels are identical to opposer's trade channels and include newspapers, magazines, television and radio. This *du Pont* factor thus is resolved in opposer's favor.

In addition, we note that both opposer's and applicant's services are of the type that may be inexpensive and purchased on impulse. Further, there is no evidence of any third party uses of the same or similar marks which would reduce the scope of protection to be accorded to opposer's marks. In fact, the record reflects that opposer has successfully stopped the unauthorized use of NO BONES ABOUT IT by Chili's, Applebee's and Subway.

Upon consideration of all of the relevant *du Pont* factors in this case, we find that confusion as to source is likely if applicant's mark FRESH FISH ... NO BONES ABOUT IT for "retail store services featuring cooked seafood" is used

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concurrently with opposer's registered mark NO BONES ABOUT IT for "restaurant services" and/or opposer's unregistered mark GREAT CHICKEN ... NO BONES ABOUT IT in connection with the retail sale of food through dine-in, take-out and catering retail outlets.

DECISION: The opposition on the ground of likelihood of confusion is sustained and registration to applicant is refused.