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This Opinion is Not a
Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Hot Stuff Foods, LLC
v.
Obsidian Group Inc.

Opposition No. 91169298
to application Serial No. 76624188
filed on December 10, 2004

Gregory C. Golla of Merchant & Gould P.C. for Hot Stuff
Foods, LLC

Serge Anissimoff of Anissimoff & Associates for Obsidian
Group, Inc.

Before Quinn, Rogers and Wellington, Administrative
Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Obsidian Group, Inc. [applicant], a corporation of
Canada, has applied under the intent-to-use provisions of
the Trademark Act to register WE'RE HOT STUFFED! for
"restaurant services." The stylized mark is shown below.

We're hot stuffed!

Applicant claimed a priority filing date of June 10, 2004 when it filed its application. See Trademark Act Section 44(d), 15 U.S.C. § 1126(d).¹ When an applicant files its application under Trademark Act Section 1(b), 15 U.S.C. § 1051(b) [the intent-to-use provision], and also claims a priority filing date, the Office presumes that the applicant will eventually base issuance of the United States registration on use of the mark in commerce as well as on any foreign registration that may issue based on the home country application yielding applicant its priority filing date. See Trademark Manual of Examining Procedure (TMEP) Sections 1003.03 and 1103 (fifth ed. September 2007). However, such an applicant may elect to proceed based solely on the intent-to-use filing basis while retaining its claim to a priority filing date and will not, then, have to wait for issuance of its foreign registration to perfect that basis for registration in the United States. See TMEP Section 1003.04. That is what applicant has done in the case at hand. Applicant has not, however, amended its

¹ Applicant based its claim to a priority filing date in the United States on a Canadian application, serial no. 1,220,286.

application to assert use of the mark in commerce. For priority purposes, the earliest date on which applicant can rely is its June 10, 2004 priority filing date.

Hot Stuff Foods, LLC [opposer] has opposed issuance of a registration to applicant based on its prior use and registration of numerous marks including the terms HOT STUFF.² In addition, opposer asserts that it has "used the HOT STUFF mark as a family mark for a variety of restaurant, franchising and food products and services." Notice of Opposition, ¶2. Opposer asserts various arguments in its pleading as to why applicant's use and registration of the WE'RE HOT STUFFED! mark will result in confusion, mistake or deception in the trade and among consumers. Opposer also asserts that its "HOT STUFF marks are famous, particularly within the restaurant and food kiosk markets" and invokes, in its pleading, Sections 2(a), 2(d), 2(f) and 43(c) of the Trademark Act.

Applicant has admitted only those allegations relating to the filing of applicant's application, of opposer's extension of the opposition period, and the timeliness of opposer's notice of opposition. All other allegations of

² In its brief on the case, at p. 9, opposer further explains it "is the owner of 5 federal registrations for the mark HOT STUFF, and 26 additional registered or pending marks for permutations thereof."

opposer have been either expressly or effectively denied by applicant. See Fed. R. Civ. P. 8(b).

Although its pleading makes reference to various provisions of the Trademark Act, in its brief opposer only references its claim under Section 2(d) of the Act and does not argue that the record supports any claim under Sections 2(a) or 2(f) and 43(c).³ Accordingly, opposer has waived any pleaded claims other than that asserted under Section 2(d).

As for the brief filed by applicant, opposer has moved to strike it, asserting that it is untimely and that applicant's late filing of the brief resulted in prejudice to opposer, insofar as the late filing shortened the time opposer had to prepare and file its reply brief on the case. Applicant has contested the motion to strike, although it did not file and serve its brief in response to the motion until 37 days after filing and service of the motion. A response to a motion served by first class mail is due in twenty days. See Trademark Rule 2.127(a) (response time fifteen days) and Trademark Rule 2.119(c) (add five days to response time when motion is served by first class mail). Applicant did not include any explanation for the late brief in response to the motion to strike or otherwise ask that

³ We take the references to Sections 2(f) and 43(c) as an attempted pleading of a dilution claim.

its tardiness be excused. Having failed to establish excusable neglect for the late-filed response to the motion, applicant's response has not been considered. Nonetheless, we have not treated the motion to strike as conceded and have instead considered it on its merits.

Applicant's brief was overdue by two days, as acknowledged in opposer's motion to strike. Applicant's brief runs a total of 17 pages but only includes 12 pages of text. In addition, since applicant did not take testimony, there are no citations to evidence in the brief except for citations to evidence put into the record by opposer. Applicant's short delay could not have been particularly prejudicial to opposer's effort to prepare a reply to such a brief. If the two-day delay had genuinely undercut opposer's ability to prepare a reply brief, it could have sought an extension. Opposer's filing of the brief on time casts doubt on opposer's claim of prejudice. Moreover, when a case has been tried and must be decided on the merits, it benefits the Board's attempt to reach a meritorious decision to have briefs from both parties; even when, as in this case, applicant's brief is plagued by assertions of fact that have no basis in the record. Opposer's motion to strike applicant's brief on the case is denied. We therefore turn to consideration of the merits of opposer's claim of likelihood of confusion under Section 2(d).

The record for this case was created solely by opposer, which filed a notice of reliance and took testimony depositions of two witnesses: Steve Watkins, opposer's Chief Financial Officer, Secretary-Treasurer and a director, who started as an employee of opposer in August 1987; and Tim Schendel, who has been with the company for over 18 years, is the current Director of Contract Administration, and whose responsibilities include "working with counsel on our trademark registrations and renewals."⁴ Applicant took discovery, did not attend the depositions taken by opposer, and added nothing to the trial record created by opposer.

Though opposer has pleaded registration of numerous HOT STUFF formative marks, the notice of reliance it filed introduces only plain paper copies of the registrations and related reprints from USPTO electronic database records.⁵ Opposer has not put in the record copies prepared by the USPTO showing the current status and title to the registrations. In addition, neither of opposer's witnesses testified as to, or was asked to testify as to, the current status of any particular pleaded registration. Instead,

⁴ Schendel dep. p. 8.

⁵ A plaintiff pleading in a Board proceeding its ownership of a registration may submit with its pleading copies of USPTO electronic database records to concurrently prove its ownership and validity of the pleaded registration. See Trademark Rule 2.122(d)(1). However, that is an option that was introduced into the rule only as of August 31, 2007, for cases commenced on or after that date. See 72 Fed. Reg. 42242 (August 1, 2007).

each witness spoke only generally about the approximate number of registrations owned by opposer for HOT STUFF formative marks or the HOT STUFF brand. See Trademark Trial and Appeal Board Manual of Procedure (TBMP) Section 704.03(b) (2d ed. Rev. March 2004) (discussion of ways in which a plaintiff can prove pleaded registrations).

Had opposer proved its ownership of registrations for its pleaded HOT STUFF formative marks, it would have both proved its standing and removed priority as an issue requiring proof in this case. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000) ("These registrations and the products sold under the mark they register suffice to establish Laser Golf's direct commercial interest and its standing to petition for cancellation of Cunningham's LASERSWING mark."), and *Herbko International, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) (holding that a plaintiff's superior proprietary rights may be established through proof of prior registration.). See also, *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Because opposer did not submit proof of ownership and of the status of its individual pleaded registrations, and applicant did not in its answer admit opposer's ownership of such registrations, opposer has not satisfied

its responsibility for proving its standing and removing priority as an issue in this case.

Notwithstanding opposer's failure to avail itself of the options for proving its pleaded registrations, the testimony of its witnesses is clearly sufficient to establish opposer's standing in this case and its priority of use.⁶ Proof of standing in the absence of proof of ownership of a registration can result from proving any one of a number of types of use sufficient to establish prior proprietary rights. See *Herbko, supra*, and *National Cable Television Ass'n, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1429 n.5 (Fed. Cir. 1991) ("Our decision that Editors has prior rights in ACE as a trade name subsumes any argument over standing.") (internal citation omitted). By the testimony of its witnesses, opposer has established that it uses HOT STUFF and related marks for licensed or franchised restaurants and food kiosks located in other businesses, primarily convenience stores or gas station stores. See, e.g., Schendel dep. pp. 11-16. Opposer's presence in the marketplace is substantial throughout the United States, except for the New England and Northeastern states, and abroad, including 25 sites in

⁶ Applicant, in its brief, has not argued in any way that opposer does not have standing or that its evidence does not establish its standing. Likewise, applicant has not argued in any way that opposer does not have priority or that its evidence does not establish priority.

Canada. Watkins dep. p. 13, Schendel dep. p. 16. In addition, there is no question that opposer has been engaged in business, using the HOT STUFF marks, since long before the priority filing date of applicant. Watkins dep. p. 5, Schendel dep. p. 12.

We turn, then, to the question of likelihood of confusion. Our determination under Section 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 Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); see also, *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, key considerations are the similarities of the marks and the fact that the parties' respective services are the same (i.e., restaurant services) or are related (i.e., opposer's food kiosks and applicant's restaurant services). *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

In comparing the marks of the parties, we have compared the mark in applicant's application to the following marks used by opposer: HOT STUFF FOODS and design, HOT STUFF

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PIZZA, HOT STUFF FOOD ON THE GO and design, HOT STUFF PIZZERIA and design. The design element in those marks employing a design is an inverted triangle design clearly intended to serve as the outline of a slice of pizza. We focus on these marks because, in the absence of proof of the pleaded registrations, these are the marks shown by the Schendel testimony and exhibits to be in use for restaurants and food kiosks. See Schendel dep. pp. 38-39 and 42-43, and exhs. 16, 17 and 21-30.

To determine whether the marks are similar for purposes of assessing the likelihood of confusion, we must consider the appearance, sound, connotation and commercial impression of each mark. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In a particular case, any one of these means of comparison may be critical in finding marks to be similar. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988); see also, *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988). In fact, "the PTO may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark." *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983). In addition, it is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of

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confusion, while the marks are compared in their entireties, including descriptive or disclaimed portions thereof, "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 National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In each of opposer's marks, HOT STUFF is clearly the dominant element, as the triangular design in some of those marks will be seen either as a common geometric shape or as a descriptive image of a slice of pizza, and the other words in opposer's marks, FOODS, PIZZA, FOOD ON THE GO, and PIZZERIA, all are descriptive and add little, if any, source identifying significance to the marks. Applicant contends in its brief, at numbered p. 5, that the "prefix 'WE'RE'" in its mark cannot be ignored and that "the prefix is commonly accepted as the defining feature of any mark." While we agree that the case law directs that the contraction cannot be ignored, and that the first word in a mark is often of significant importance in comparing that mark with another, in this case we do not find the contraction WE'RE to be as significant as the terms "HOT STUFFED!". Visually, the word HOT is larger and clearly emphasized, and the word STUFFED

is followed by an exclamation point, which draws attention to the phrase HOT STUFFED. The contraction WE'RE serves only to set up the exclaimed words "HOT STUFFED!". In addition, while the pronunciation of marks by consumers cannot be controlled and there is no "correct" way to pronounce a mark, the larger size of the term HOT and the exclamation point will, if anything, lead more consumers to emphasize those two words in speaking applicant's mark. See *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (Federal Circuit found no error in the Board's determination that the word DELTA was the dominant element in THE DELTA CAFÉ and design - "an ordinary geometric shape" - and observed that restaurants are often recommended by word of mouth).

As for the connotation of the involved marks, applicant contends, at numbered p. 4 of its brief, that STUFF is a noun that will be taken as referring to an item of food, while STUFFED is an adjective that will be taken as referring to "a culinary process or preparation." We are not persuaded that the average restaurant consumer will draw this distinction. Moreover, when the respective marks are spoken, the difference may not be articulated clearly enough to even allow for the distinction to be possible.

We find the dominant portions of the respective marks very similar and the marks, when considered in their

entireties, to yield very similar overall commercial impressions. Given the similarity of the marks, use on the same or related services will result in a likelihood of confusion among consumers.

As already noted, opposer's marks are used for restaurants and food kiosks. Restaurants are a much smaller part of its business than its food kiosk operations. Schendel dep. p. 15. The latter are essentially stations or sections of convenience stores or institutional food service operations that allocate space, including in many cases, seating, for a wide variety of food items distributed by opposer to its licensees and franchisees. See Schendel dep. pp. 13-16 (describing a typical site) and 38 (differentiating institutional accounts from convenience store licensees or franchisees) and exh. 17 (menu). On the other hand "the majority of [opposer's] convenience store sites do have some form of seating, booths or tables" and "customers will indeed treat it as if it were a restaurant." Schendel dep. pp. 15-16. Applicant did not attend either of the testimony depositions taken by opposer and therefore did not object to or probe any of the testimony of opposer's witnesses. We therefore have accepted all such testimony without reservation.

On the testimony of opposer's witnesses, we find the opposer's food kiosk operations to be competitive with fast

food type restaurants, which we must consider to be within the scope of applicant's identification. *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 set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). Further, since there are no restrictions as to the anticipated classes of consumers for applicant's restaurant services, we must presume that they will include all possible classes of restaurant consumers, including those who frequent the sites of opposer's licensees or franchisees. Accordingly, we find the involved services related for likelihood of confusion purposes, and the classes of consumers to overlap.

There is a protective order in place that precludes us from mentioning the precise extent of opposer's sales and advertising, but suffice it to say that the annual sales are significant. While applicant contends in its brief, at numbered p. 10, that opposer's mark is not "strong or distinctive" and "is generic and descriptive," we reject

this contention and find that at a minimum opposer's marks have significant acquired distinctiveness.

Applicant also contends in its brief, at numbered p. 5, that consumers can differentiate between marks including the term "hot." However, there is no evidence of record regarding any such marks for restaurant or food kiosk services, and there is certainly nothing to establish that consumers can distinguish between marks containing the words HOT STUFF or HOT STUFFED for the same or similar services.

In sum, the marks are very similar, there is no evidence establishing that opposer's marks are weak or for any reason entitled to a narrow scope of protection, the involved services are in part the same and otherwise related, and the services must be presumed to be marketed to the same classes of end consumers. On the unchallenged record created by opposer we find that confusion among consumers is likely.

Decision: The opposition is sustained.