

**THIS OPINION IS
NOT A PRECEDENT
OF THE TTAB**

*Decision Mailed:
July 23, 2008
GDH/gdh*

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Theme Food, Inc.
v.
Live Bait, L.L.C.

Cancellation No. 92044254

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Gross & Bondell LLP for Theme Food, Inc.

India E. Vincent, Howard P. Walthall, Jr. and Andrea L. Weed of
Burr & Forman LLP for Live Bait, L.L.C.

Before Hohein, Cataldo and Wellington, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Theme Food, Inc. ("petitioner") has petitioned to
cancel the registration owned by Live Bait, L.L.C. ("respondent")
of the mark "LIVE BAIT" for "restaurant services" in
International Class 42.¹

Petitioner, in seeking cancellation, alleges among
other things that "[f]rom at least as early as August 1988 and

¹ Reg. No. 2,336,220, issued on March 28, 2000 from an application
filed on June 25, 1999 on the basis of an alleged bona fide use of the
mark in commerce, which sets forth a date of first use anywhere and in
commerce of the mark of February 1, 1993; affidavit §8 accepted.

continuously through the present, Petitioner has owned and operated a restaurant under Petitioner's ... mark LIVE BAIT"; that such mark "was registered for restaurant services in International Class 042 in the USPTO by two of its owners on June 20, 1989 by way of US Registration No. 1,544,956, which registration provided legal notice to the ... [respondent] and all others in the period June 20, 1989 to June 20, 1995 of the Petitioner's LIVE BAIT service mark"; that such registration "was cancelled by the USPTO on December 26, 1995, notwithstanding that the Petitioner was using the mark and failed, through oversight, to file a timely Declaration of Use"; that, "[i]n fact Petitioner's LIVE BAIT restaurant was in full operation at the time of cancellation of Registration No. 1,544,956 and has continued in full operation through the present time"; that petitioner "has filed a new application Serial No. 78/568,256 in the USPTO to secure registration in International Class 042 for its LIVE BAIT mark"; that "[u]pon information and belief, ... [respondent] was actually aware of the existence of and operation of the Petitioner's LIVE BAIT restaurant in 1993 when ... [respondent] commenced usage of the mark LIVE BAIT"; and that the existence of respondent's "Registration No. 2,336,220 for restaurant services in [International] Class 042 on the Principal Register impedes the Petitioner's ability to secure registration of its LIVE BAIT mark for restaurant services and interferes with its ability to expand its restaurant services into Alabama and other regions of the U.S."; and that such registration "gives a presumption of its ownership of the mark LIVE BAIT for restaurant

services in derogation of petitioner's superior rights" in its mark.

Respondent, in its answer, admits that "Registration [No.] 1,544,936 was cancelled by the USPTO on December 26, 1995" and that petitioner has filed a new application, Serial No. 78/568,256, in the USPTO to secure registration in International Class 42 for its LIVE BAIT mark, but has otherwise denied the salient allegations of the petition to cancel.

The record consists of the pleadings; the file of the involved registration; the testimony and exhibits thereto, submitted by petitioner as its case-in-chief, of one of its three present shareholders, Charles Milite;² and the testimony and exhibits thereto, filed by respondent as its case-in-chief, of a "member manager" of respondent, Terry W. Humphryes.³ Both parties filed a main brief and petitioner submitted a reply brief. As such briefs make clear, both parties have tried and argued this case as one which solely involves the ground of priority of use and likelihood of confusion. We accordingly have so treated this case.

Preliminarily, it is noted that there is no issue as to petitioner's standing to bring this proceeding. As previously indicated, respondent has admitted in its answer to the petition to cancel that that petitioner has filed a new application, Serial No. 78/568,256, in the USPTO to secure registration in

² Mr. Milite was also an original shareholder in petitioner when it was formed in March 1986. (Milite dep. at 5 and 27.)

³ Mr. Humphryes is "considered a member and a manager" of respondent, which is "a manager-operated L.L.C." (Humphryes dep. at 5.)

International Class 42 for petitioner's LIVE BAIT mark. Such application, as confirmed by the testimony of Mr. Milite, has been rejected on the basis of respondent's involved registration. (Milite dep. at 25.) Petitioner, therefore, has adequately proven its standing to be heard on its claim of priority of use and likelihood of confusion. See, e.g., Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) [to have standing in a cancellation proceeding, "it would be sufficient that appellee prove that it filed an application and that a rejection was made because of appellant's registration"].

Moreover, there is no issue that petitioner, rather than respondent, has priority of use. Respondent, in its brief, concedes that "in this case, it is undisputed that Petitioner has been utilizing its ['LIVE BAIT'] mark since at least as early as September 1987, approximately five years before ... [respondent's] predecessor's use of the ['LIVE BAIT'] mark began." Specifically, Mr. Milite testified that petitioner, which was formed around March 1986 "for the purpose of operating a restaurant in New York City," opened its "Live Bait Restaurant in September 1987 and has been running [such restaurant] consecutively ever since." (Id. at 5.) Mr. Humphryes, on the other hand, testified that respondent presently operates two "Live Bait Restaurant[s] in Orange Beach, Alabama," with a third such business under construction and about to open. (Humphryes dep. at 5.) The first of such restaurants, he further testified, opened in "1993," with the second facility opening around "2002."

(Id. at 6.) While he also testified that, in 1993, the first of such restaurants was owned by a Bill Taylor rather than respondent, Mr. Humphryes noted that respondent bought the restaurant in "June of 1998" as "an asset purchase," including the acquisition of "the buildings and land, all of the equipment, trade name, [and] good will." (Id. at 46.) Thus, it is plain that petitioner has established that it has priority of use of its "LIVE BAIT" mark, as respondent admits.

In consequence thereof, the only issue to be determined in this proceeding is whether there is a likelihood of confusion from contemporaneous use by the parties of their respective "LIVE BAIT" marks in connection with restaurant services. Respondent argues, among other things, that because the parties use their marks in different logos (with respondent's "LIVE BAIT" mark accompanied by a "fish skeleton" design (id. at 23), while petitioner's mark frequently appears in a "child's scribble" (Milite dep. at 10) as "LiVE bAiT")⁴ and render their restaurant

⁴ Although respondent also contends that the parties use their marks in connection with distinct slogans and geographical references, it is settled that, insofar as the registrability of respondent's mark is concerned, the issue of likelihood of confusion in this proceeding must be determined solely on the basis of the manner in which respondent's mark is set forth in its involved registration, which is the words "LIVE BAIT" and nothing more. The reason for such is because Section 2(d) of the Trademark Act precludes registration of "a mark which so resembles a mark registered in the Patent and Trademark Office ... as to be likely ... to cause confusion" Therefore, the facts that (i) respondent has often used its "LIVE BAIT" mark in conjunction with the slogans "Catch me, clean me, grill me, eat me" and "Dead Food Live Music," while petitioner has used its "LIVE BAIT" mark in connection with the slogan "If you want home cookin' stay home," and (ii) respondent's has used its mark with the geographical designation "Orange Beach, Alabama," while petitioner has used its mark with the geographical term "New York," are simply irrelevant and immaterial to the issue of likelihood of confusion. See, e.g., Sealy, Inc. v. Simmons Co., 265 F.2d 934, 121 USPQ 456, 459 (CCPA 1959); Burton-Dixie Corp. v. Restonic Corp., 234 F.2d 668, 110 USPQ 272, 273-

services under different themes (with respondent's premises modeled on a "beach" environment (Humphryes dep. at 7), while petitioner's services feature "a [S]outhern style roadside roadhouse" motif modeled on "a truck stop somewhere in Carolina" (Milite dep. at 7-8) so as to appeal to different clienteles), confusion is not likely. Alternatively, respondent asserts that "even if there were a likelihood of confusion," it "is entitled to maintain" its involved registration, "subject only to a geographic restriction excluding New York City" as "the area where Petitioner was actively doing business at the time of ... [issuance of respondent's] registration."

Turning, therefore, to the issue of whether there is a likelihood of confusion from contemporaneous use by the parties of their respective "LIVE BAIT" marks in connection with restaurant services, our determination thereof is based on an analysis of all of the facts in evidence which are pertinent to the factors bearing on such issue as set forth 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). However, as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods and/or services at issue and the

74 (CCPA 1956); *Hat Corp. of America v. John B. Stetson Co.*, 223 F.2d 485, 106 USPQ 200, 203 (CCPA 1955); and *ITT Canteen Corp. v. Haven Homes Inc.*, 174 USPQ 539, 540 (TTAB 1972).

similarity or dissimilarity of the respective marks in their entireties.⁵ Such considerations, along with the factor of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion, are the principal *du Pont* factors which need to be addressed.

Focusing first on the *du Pont* factor which pertains to the similarity or dissimilarity of the services at issue, petitioner correctly notes in its reply brief that it is well settled that the issue of likelihood of confusion must be evaluated on the basis of the identification of services as set forth in the involved registration, regardless of what the record may reveal as to the particular nature of those services, their actual channels of trade, and/or the classes of purchasers to which the services are in fact directed and sold. See, e.g., *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). Here, as broadly identified in its involved registration, respondent's "restaurant services" are not limited or restricted to just a beach theme like that actually utilized by respondent but, instead, also plainly encompass a Southern style roadside roadhouse motif modeled on a Carolina truck stop like that used by petitioner in connection with its restaurant services. In short, respondent's "restaurant services" must be deemed to include restaurant

⁵ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the

services which are legally identical to those rendered by petitioner. Such identity in the respective services of the parties is thus a factor which strongly favors a finding of a likelihood of confusion.

As to the marks at issue, petitioner is also correct that respondent's "LIVE BAIT" mark, in the standard character or typed format in which it is registered, is legally identical to petitioner's "LIVE BAIT" mark in appearance. See, e.g., Phillips Petroleum Co. v. C. J. Webb, Inc. 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) [a mark registered in standard character or typed form is not limited to being depicted in any particular manner of display]. Respondent's mark thus includes such manner of display as the "child's scribble" format ("LiVE bAiT") utilized by petitioner. Moreover, it is clear that the parties' marks are also identical in sound and meaning and that, when used in connection with restaurant services, such marks engender the same overall commercial impression. Respondent, we observe, notably acknowledges in its brief that "the identical word portions of the marks tend to indicate a likelihood of confusion, particularly with respect to restaurants which are often recommended by word of mouth," citing *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). The identity of the respective marks is thus a factor which strongly favors a finding of a likelihood of confusion.

Respondent, nonetheless, insists that confusion is not likely based the *du Pont* factor of the lack of any incidents of

essential characteristics of the goods [and/or services] and

actual confusion between the parties' use of their respective "LIVE BAIT" marks. Specifically, based solely on the following testimony by Mr. Humphryes, respondent maintains that "[d]uring more than *fourteen* years of concurrent use of these marks, the parties are not aware of any instances of actual confusion caused by their respective uses of the 'Live Bait' marks in issue" (italics in original; underlining added):

Q. Are you aware of any customers of the Live Bait restaurants in Orange Beach who have mentioned a New York restaurant that had the same name?

A. No, sir.

(Humphryes dep. at 15.) However, contrary to respondent's contention that it has used its mark "in nationwide commerce," there is no showing on this record that the parties' use of their respective marks has ever significantly extended into the area of use of the other party. In order for an asserted lack of any incidents of actual confusion to be a meaningful factor, the record must demonstrate that there has been appreciable and continuous use by respondent of its mark in the same market(s) as those served by petitioner under its mark. See, e.g., Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). Specifically, there must be evidence showing that there has been an opportunity for instances of actual confusion to occur and here the record is devoid of any such proof. See, e.g., Cunningham v. Laser Golf Corp., supra at 55 USPQ2d 1847 (Fed. Cir. 2000). Thus, the fact that respondent is unaware of any

differences in the marks." 192 USPQ at 29.

instances of actual confusion is not a meaningful factor in the determination of whether confusion is likely to occur.

We accordingly conclude, in light of the above, that contemporaneous use by respondent of its "LIVE BAIT" mark in connection with "restaurant services" is likely to cause confusion with the prior use by petitioner of its "LIVE BAIT" mark for its restaurant services. However, citing and chiefly relying on *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820 (CCPA 1980), respondent alternatively contends that it "is entitled to maintain its registration subject to a geographic restriction for Petitioner's actual use," which respondent asserts is the area comprising "New York City." Respondent insists that, "with [such] a geographic restriction in place there is no chance of a likelihood of confusion."

Respondent's alternative contention is not well taken inasmuch as possible concurrent rights are determined by the Board only in a concurrent use proceeding rather than a cancellation proceeding. See Sections 2(d), 17 and 18 of the Trademark Act; Trademark Rules 2.99(h) and 2.133(c); and TBMP §1101.02 (2d ed. rev. 2004). As petitioner correctly points out in its reply brief (footnote omitted):⁶

⁶ While, subsequent to the *Selfway* case cited by petitioner, Section 18 of the Trademark Act was amended to give the Board authority to partially restrict a registration in a cancellation proceeding by limiting the identification of goods and/or services so as to avoid a likelihood of confusion on the register, see *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1268-70 (TTAB 1994), it remains the case that any geographic limitation thereto, as petitioner accurately points out, will be considered and determined by the Board only in the context of a concurrent use proceeding. *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815, 1816 (TTAB 1990).

Respondent argues at length in its brief that if the Board finds that there is a likelihood of confusion between the parties' identical marks which are used in connection with identical services, respondent as an alleged innocent adopter should be entitled to maintain its registration with a geographic limitation on the registration for New York City. . . . However, under Section 18 of the Trademark Act, a geographic limitation to a registration cannot be made in a cancellation proceeding. The *Weiner King* case upon which Respondent bases its request for a geographic restriction on its registration involved a concurrent use proceeding and a cancellation proceeding and a civil litigation rather than a cancellation proceeding alone.

In *Selfway, Inc. v. Travelers Petroleum, Inc.*, 579 F.2d 75[, 198 USPQ 271] (CCPA 1978)[,] the court found that under Section 18 of the Lanham Act, the Board could not place geographical limitations on a registration in a cancellation proceeding and the only relief available in a cancellation proceeding is an entire cancellation of a registration. See also *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815 (TTAB 1990) (The Board cannot partially cancel a registration in a cancellation proceeding by placing geographical restrictions thereon because "the Commissioner has elected to exercise his authority to geographically restrict a registration only in the context of a concurrent use proceeding"). According, Respondent's request for a geographical limitation on the registration must be denied. Instead, since Petitioner has shown a likelihood of confusion the Petitioner's petition should be granted and the Respondent's [registration of its] mark must be cancelled in its entirety.

Determination of whether respondent is entitled to a concurrent use registration for its "LIVE BAIT" mark for restaurant services is thus improper in this proceeding and the issue will not be considered further. Respondent's involved registration, instead, must be cancelled in its entirety due to a likelihood of

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confusion of such mark with petitioner's prior and continuing use of the mark "LIVE BAIT" in connection with restaurant services.

Decision: The petition to cancel is granted and Reg. No. 2,336,220 will be cancelled in due course.