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PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Opryland USA Inc.**

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Serial No. 74/**442,309**

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**L. Lawton Rogers, III** of Rogers & Killeen for applicant.

Angela M. Micheli, Trademark Examining Attorney, Law Office  
**108 (David E. Shallant, Managing Attorney)**

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Before Simms, Hanak and Hairston, Administrative Trademark  
Judges.

Opinion by **Hanak**, Administrative Trademark Judge:

Opryland USA Inc. of Nashville, Tennessee seeks to register MUSIC CITY EVENTS in typed capital letters for "catering; contract food and beverage services." The intent-to-use application was filed on September 30, 1993.

The Examining Attorney refused registration pursuant to Section 2(d) of the Lanham Trademark Act on the basis that applicant's mark, as applied to applicant's services, is likely to cause confusion with the previously registered marks MUSIC CITY ROADHOUSE in typed form and MUSIC CITY

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ROADHOUSE and design (shown below). Registration Nos. 1,870,843 and 1,855,385. Both registrations are owned by the same entity and the services of both registrations are "restaurant services." In each registration, registrant disclaimed the exclusive right to use the word "roadhouse" apart from the mark in its entirety.



When the refusal was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

In any likelihood of confusion analysis, two key considerations are the similarities of the goods or services and the similarities of the marks. 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 [or services] and differences in the marks.").

In considering the marks, we will base our likelihood of confusion analysis upon a comparison of applicant's word mark MUSIC CITY EVENTS and registrant's word mark MUSIC CITY ROADHOUSE. Registrant's other mark contains a very prominent design feature (i.e. a large guitar) and thus if it is determined that there is no confusion between the two word marks, there would be no confusion between applicant's word mark and registrant's word and design mark.

Obviously, both word marks share the words MUSIC CITY. During the examination process, applicant made of record evidence demonstrating that Nashville, Tennessee is known as MUSIC CITY. In her appeal brief, the Examining Attorney has now conceded that "MUSIC CITY is a nickname for the city of Nashville" and that Nashville "is known for its country music." (Examining Attorney's brief p. 3). Thus, the only element common to both word marks is the well known nickname of a major American city. The other portion of applicant's word mark (EVENTS) is totally dissimilar from the other portion of registrant's word mark (ROADHOUSE) in terms of visual appearance, pronunciation and meaning. The Examining Attorney argues that in comparing the two word marks, less weight should be given to the ROADHOUSE portion of registrant's word mark because it "is disclaimed as it is

descriptive of registrant's restaurant services."

(Examining Attorney's brief p. 3).

The record is silent as to why registrant disclaimed the term ROADHOUSE. However, whether disclaimed or not, the term ROADHOUSE is rarely used in connection with restaurant services. The word "roadhouse" is defined either as "an inn furnishing meals and lodging to travelers" or as "an inn or tavern usually located outside city limits and setup for serving liquor and usually meals, for dancing, and often for gambling." Webster's Third New International Dictionary Unabridged (1976). During the examination process, the Examining Attorney made of record photocopies of fifteen selected pages from the Yellow Pages for Philadelphia, Atlanta, Miami, Beverly Hills and Northern Virginia. The heading for these fifteen selected pages is in each case "Restaurants." These fifteen pages contain the names of approximately 750 restaurants. Not one of the restaurant names incorporates the word "roadhouse" in any way whatsoever. Moreover, not one of the Yellow Pages advertisements uses the word "roadhouse" in a descriptive manner (i.e. BILL'S PLACE ... a great roadhouse). Thus, as shown by the Examining Attorney's own evidence, the term ROADHOUSE is rarely used in the name of a restaurant or indeed to describe a restaurant. Given the highly unusual nature of the term ROADHOUSE as applied to restaurant

services, we find that the presence of this term in registrant's word mark would clearly be noticed by consumers. Moreover, the highly unusual term ROADHOUSE serves to readily distinguish registrant's word mark MUSIC CITY ROADHOUSE from applicant's mark MUSIC CITY EVENTS. Stated somewhat differently, we are not comparing the hypothetical word mark MUSIC CITY RESTAURANT for restaurant services with MUSIC CITY EVENTS for catering services.<sup>1</sup>

Considering next applicant's services and registrant's services, the Examining Attorney argues that "the services are related in that they both involve the provision of food to paying customers." (Examining Attorney's brief p. 5). Applicant, of course, has never disputed this point. By the same token, the Examining Attorney has never disputed

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<sup>1</sup> With regard to the highly unusual nature of the term ROADHOUSE for restaurant services, we note that the dissent has elected to consider evidence not in the record, namely, purported third-party registrations of marks containing the term ROADHOUSE. The action of the dissent is in clear violation of this Board's practice of not taking judicial notice of third-party registrations. See Trademark Trial and Appeal Board Manual of Procedure, Section 712.01 at page 700-45 (1<sup>st</sup> ed. 1995) and Cities Service Co. v. WMF of America, Inc., 199 USPQ 493, 495 n. 4 (TTAB 1978). If the dissent insists upon going outside the evidentiary record, it should at least provide to the readers of this opinion an approximate total number of registrations for restaurant services, night club services and "related goods" from which it selected the purported 25 registrations containing the term ROADHOUSE. Without this baseline, it is impossible to judge the rarity of the term ROADHOUSE.

As for the dissent's comment that the fifteen selected Yellow Pages show no use of the expression "Fish Restaurant," this is very misleading. Many of the restaurants listed incorporate the word "fish" in their names. As noted, none of the listed restaurants incorporate the word "roadhouse" in their names, and none of the restaurants use the word "roadhouse" in a descriptive manner.

applicant's contention that "the services provided by restaurants and caterers are significantly different" in that "restaurant services are public place food services provided to unrelated customers ... whereas catering services are private (not public) food services provided to related (not unrelated) customers, i.e., sophisticated customers who pre-plan a menu and the order and timing of food service to their private invitees." (Applicant's brief pgs. 3 and 5). While there is no separate dictionary listing for the term "catering," there is a dictionary listing for the term "caterer" which supports applicant's assertion that the selection of a caterer is not made on a casual basis but rather is made with considerable care. The term "caterer" is defined as "one whose business is to arrange for and supervise all the details as to food and service for any social affair (as at club or private house)." Webster's Third New International Dictionary Unabridged (1976) (emphasis added). Thus, the dictionary definition of the word "caterer" supports the contention that catering does not encompass the mere delivery of prepared, ready-to-eat food. Stated somewhat differently, a restaurant that merely delivers, for example, pizza or Chinese food to a home or office is not providing catering services. In selecting a caterer - that is someone who is responsible "to arrange for and supervise all the details as to food and service" - we

believe that consumers would exercise great care and would, by necessity, have to have a rather detailed discussion(s) with the caterer and reach a formal understanding as to precisely what services would be and would not be provided by the caterer. At a minimum, an oral contract (if not a written contract) would be entered into between the caterer and its customer. In this regard, we note that applicant's entire identification of services reads as follows:

"catering; contract food and beverage services."

Given the fact that the marks are by no means identical; the fact that the services are not identical; and the fact that catering services are purchased only with care and after significant discussion with the prospective caterer, we find that the contemporaneous use of MUSIC CITY EVENTS for catering services and MUSIC CITY ROADHOUSE for restaurant services is not likely to result in confusion.

In reaching our determination, we have taken into account the Examining Attorney's argument "that restaurants provide catering services." (Examining Attorney's brief p. 5). A review of the fifteen Yellow Pages having the heading "Restaurants" made of record by the Examining Attorney reveals that fewer than five percent of the restaurants also offer catering services. Moreover, in reviewing these fifteen Yellow Pages, as well as the twelve Yellow Pages having the heading "Caterers" also made of record by the

Examining Attorney, we note that for that small percentage of restaurants which also offer catering services, they do so under the same service mark or trade name. In other words, there is nothing in the record to indicate that when a restaurant also offers catering services, it does so under a somewhat different service mark or trade name. Based upon the Examining Attorney's own evidence, we have every reason to believe that if registrant were to offer catering services, it would do so under the service mark MUSIC CITY ROADHOUSE. A patron familiar with MUSIC CITY ROADHOUSE restaurant would, if she later had an occasion to employ a caterer, have no reason to believe that registrant, if it offered catering services, would do so under a somewhat different service mark such as MUSIC CITY CATERING.

To cut to the quick, a consumer familiar with and favorably impressed by MUSIC CITY ROADHOUSE as a restaurant would not assume, in looking for a caterer, that MUSIC CITY EVENTS was in some way associated with the former. The absence of the highly unusual and distinctive term ROADHOUSE (for restaurant or catering services) in the service mark MUSIC CITY EVENTS would cause most consumers either to assume there was no association or, at a minimum, to inquire further as to whether there was association. It must be remembered that mere inquiry as to possible association or affiliation does not by itself demonstrate a likelihood of

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confusion. 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 23:16 at page 23-39 (4<sup>th</sup> ed. 1996).

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Decision: The refusal to register is reversed.

E. W. Hanak

P. T. Hairston  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board

Simms, Administrative Trademark Judge, dissenting:

Because I believe that applicant's mark MUSIC CITY EVENTS for catering and contract food and beverage services so resembles the registered marks for restaurant services that confusion is likely, I would affirm the refusal.

With respect to the marks, the Examining Attorney has admitted that "Music City" is the nickname for the city of Nashville, Tennessee. The Examining Attorney argues that because the term "ROADHOUSE" is descriptive and disclaimed, the dominant part of the registered mark MUSIC CITY ROADHOUSE is the term "MUSIC CITY". It is not clear that the majority disputes this contention. With respect to applicant's mark, "MUSIC CITY EVENTS," I agree with the Examining Attorney, that, as applied to catering services, the term "EVENTS" suggests a social occasion or activity which may be catered.<sup>2</sup> I agree, therefore, with the Examining Attorney's position, brief, 3:

The marks are similar in appearance as they all contain the wording MUSIC CITY that is the dominant feature of the two marks. The EVENTS portion in applicant's mark is weaker, as it suggests a social occasion or activity. The ROADHOUSE portion in registrant's marks is disclaimed as it is descriptive of registrant's restaurant services. While the examining attorney cannot ignore a disclaimed portion of a mark and must view marks in their entirety,

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<sup>2</sup> It is noted that the Examining Attorney had earlier required a disclaimer of the term "EVENTS." The Examining Attorney later withdrew that requirement.

one feature of a mark may be more significant in creating a commercial impression. Disclaimed matter is typically less significant or less dominant. Thus, the MUSIC CITY portion is the dominant feature in both registrant's and applicant's marks.

While we may accept the fact that "MUSIC CITY" is known by a substantial number of people as the nickname for Nashville,<sup>3</sup> and while applicant has submitted evidence that a number of businesses in the Nashville Yellow Pages have this term in their business names -- Music City Drain Cleaning, Music City Plumbing, Music City Sewer & Drain, Music City Dodge, Music City Truck & Equipment, etc. -- the Examining Attorney argues that this record does not show "widespread use", which I take to mean nationwide use or at least use outside of the Nashville area, of this term with respect to food and beverage providers. Applicant admits that there are no other registrations including the words "MUSIC CITY" for restaurant or food services.

Nevertheless, applicant contends that the term "MUSIC CITY" is primarily geographically descriptive (or

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<sup>3</sup> There is simply no evidence or admission that MUSIC CITY is a "well known nickname". I think this statement is certainly debatable. In fact, in comparison to such other city nicknames as "The Big Apple" or "The Windy City," the expression "MUSIC CITY" would undoubtedly be recognized by fewer people as the nickname of Nashville than would recognize those other nicknames of New York City and Chicago. Indeed, I would not be surprised if a significant number of people did not associate "MUSIC CITY" with Nashville. Of course, to the extent that the words "MUSIC CITY" in the registered marks are not recognized by potential customers as the nickname of Nashville, the marks would appear to

misdescriptive) and is thus a subordinate part of each mark. According to applicant, the remainder of the respective marks -- the words "ROADHOUSE" and "EVENTS" -- are dominant.<sup>4</sup> I cannot agree. When considered in the context of the average member of the general public, either in a geographic area which is near or which is remote from Nashville, Tennessee, it seems to me that the dominant part of the registered marks would be the words "MUSIC CITY." In this regard, I note that the registrant's business address is in Falls Church, Virginia. A consumer encountering the mark MUSIC CITY ROADHOUSE in connection with restaurant services in the Northern Virginia area, for example, who then encounters MUSIC CITY EVENTS catering is likely, in my opinion, to believe that the latter service is sponsored by or otherwise emanates from the same source as the restaurant service.

I also find fault with the majority's conclusion that the term "ROADHOUSE" is a "highly unusual term" as applied to restaurant services. The majority's statement concerning the "rarity" of this term lacks persuasive support in this record. By way of example, the fact that none of the hundreds of restaurants in the copies of the Yellow Pages of record appears to use the expression "Fish Restaurant" in

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those individuals as less geographically suggestive of, and therefore more arbitrarily associated with, restaurant services.

their names does not make this expression "highly unusual" or serve to readily distinguish restaurants with these words in their names from those that do not contain these words. With regard to the word "roadhouse," a quick check of the register reveals over 25 registrations for restaurant and night club services (as well as related goods) wherein this term has been disclaimed--BOOTS TEXAS ROADHOUSE, BROWN DERBY ROADHOUSE, BUCKEYE ROADHOUSE, BUCKHEAD ROADHOUSE, CAROLINA ROADHOUSE, CHESTER'S ROAD HOUSE, EARTHQUAKE ETHEL'S ROADHOUSE, LOGAN'S ROADHOUSE, O'TOOLE'S ROADHOUSE, WRANGLER'S ROADHOUSE, etc.

With respect to the services, the Examining Attorney argues, Office Action issued March 30, 1995:

Applicant's services are catering and contract food and beverage services. The registrant's services are operating restaurants. The services are related because they are both involve [sic] the provision of food. The person who ate at registrant's restaurant could believe on seeing applicant's mark on catering services that the registrant provides catering services as well. Also it appears common in the food industry for restaurants to provide catering. The examining attorney submitted in the Office Action No. 2 registrations which showed restaurant and catering services sold under the same mark. As a consequence a confusion as to the identity of the source of the services could occur.

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<sup>4</sup> Elsewhere, applicant concedes that "roadhouse" is a descriptive term for a nightclub or tavern.

I agree. Of course, for confusion to be found, the respective services need not be identical or directly competitive so long as they are related in such a manner that they could be encountered by the same purchaser under circumstances that could give rise to the mistaken belief that the services come from the same source. In this regard, this record includes numerous third-party registrations (not mentioned by the majority) which show that the same entity has registered the same mark for both restaurant services and catering services. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). The Examining Attorney has also made of record copies of pages from several Yellow Pages directories showing that restaurants provide catering services and so advertise in their listings. It is also clear that the same class of customers -- the general public -- who dine in restaurants are also potential customers for catering services. Applicant also admits that the services "overlap somewhat" (brief, 2) and that some restaurants also provide catering services and so advertise in their Yellow Pages advertisement (reply brief, 5; Response, 2, filed April 29, 1996).

Undoubtedly, many catering companies do not operate restaurants and many restaurants do not offer catering services. However, I believe it to be true that in almost

any community in this country a significant number of restaurants offer catering services. In the Washington, D.C. area, for example, that is the case. The point is not that most people, if they even thought about it, would say that most restaurants do not offer catering services, as the majority seems to imply, but that the general public is certainly aware that many restaurants do offer catering services and that, if the average purchaser encounters the same or similar mark in connection with a restaurant and then in connection with a catering service, that person would be likely to assume that the respective services come from the same source.

I also cannot agree that the dictionary definition of "caterer" provides support for the proposition that catering services are selected with "great care." There is simply no evidence that catering services would be selected with any higher degree of care than restaurant services. For example, there is no evidence that a couple planning a small catered event on a Saturday night at their home would exercise any more care in selecting this service than if they were taking a group of friends out to a restaurant.<sup>5</sup>

The majority also seems to make a point about the difference between mere delivery of food and the catering

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<sup>5</sup> Indeed, it may well be that the catered event would be less expensive than the equivalent meal for the same number of people in a restaurant.

thereof. First, the difference between the two is certainly not explained in this record. What the record does contain, however, is listings of numerous restaurants of all types (Chinese, Italian, Mexican, Thai, Indian, etc.) offering "catering," as well as such other restaurants as barbecue, deli, luncheonette, sandwich (Subway), pizza (Armand's Chicago Pizzeria) and fast food restaurants (Boston Market, Kentucky Fried Chicken) offering both "catering" in addition to their restaurant services. Any difference there may be in the level of service between mere food delivery and catering services, does not, in my opinion, dispel any likelihood of confusion, especially when such similar marks as MUSIC CITY ROADHOUSE and MUSIC CITY EVENTS are used on restaurant and catering services.<sup>6</sup> We should also keep in mind that catering services may include the full gamut of events from the most elaborate of weddings to a simple backyard picnic or birthday party. While undoubtedly more care will be used in the selection of a caterer for an elaborate wedding or other event, less care may be presumed in the selection of catering services for less elaborate and less expensive events, such as a child's birthday party.

I would also point out that we are not here presented with a situation where the respective marks convey clearly

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<sup>6</sup> If the majority is suggesting that one might be confused, by the similarities of the marks, if a restaurant were offering mere

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different commercial impressions. If the marks involved herein were, for example, MUSIC CITY BUCKAROO for restaurant services and applicant's mark were, say, MUSIC CITY GALAXY for catering services, then we would be presented with a situation where the respective marks would clearly have significantly different commercial impressions - one a western motif and the other perhaps an astronomical connotation. Here, not only is the word "ROADHOUSE" disclaimed in the registration, but applicant admits that it is descriptive with respect to a tavern or a nightclub and suggestive with respect to restaurant services. Similarly, the term "EVENTS" is suggestive, as indicated above. Under these circumstances, where the third word in each mark is either descriptive or suggestive of the respective services to which the mark applies and is thus of less distinguishing nature, it is not unreasonable for one to believe that the average person would believe that MUSIC CITY EVENTS is the catering arm of the MUSIC CITY ROADHOUSE.

R. L. Simms  
Administrative Trademark Judge,  
Trademark Trial and Appeal Board

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delivery of its food but not if the establishment were offering catering, I find this hard to believe.