

Hearing:

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Paper No. 25

HRW

THIS DISPOSITION IS NOT

CITABLE AS PRECEDENT OF THE TTAB MAY 25, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re O'Briens Irish Sandwich Bars Limited

Serial No. 75/164,499

David Wolf of Wolf, Greenfield & Sacks, P.C.
for applicant.

Teresa A. Lee, Trademark Examining Attorney, Law Office 111
(Craig Taylor, Managing Attorney).

Before Cissel, Quinn and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

O'Briens Irish Sandwich Bars Limited has filed an
application to register the mark O'BRIENS SANDWICH BARS
LIMITED for "restaurant services featuring sandwiches."¹

A disclaimer has been made of any exclusive right to use
the term SANDWICH BARS apart from the mark as shown.²

¹ Serial No. 75/164,499, filed September 11, 1996, based on an
allegation of a bona fide intent to use the mark in commerce.

² Applicant originally complied with the Examining Attorney's
requirement for a disclaimer of the entire phrase IRISH SANDWICH

Registration has been finally refused under Section 2(d) on the ground of likelihood of confusion with the registered marks O'BRIEN'S³ and O'BRIEN'S PIT BARBECUE,⁴ both owned by the same entity, and both for "restaurant and catering services." The requirement that the entire phrase IRISH SANDWICH BARS be disclaimed has also been continued by the Examining Attorney, in view of applicant's amendment of its earlier filed disclaimer to one disclaiming only SANDWICH BARS. Applicant and the Examining Attorney have filed briefs and both participated in an oral hearing.

We make our determination of likelihood of confusion on the basis of those of the du Pont factors⁵ which are relevant under the present circumstances. Two key considerations in our analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services in connection with which the marks are being used, or are intended to be used.

BARS, but, in its request for reconsideration of the final refusal under Section 2(d), applicant amended the disclaimer to one for SANDWICH BARS only.

³ Registration No. 1,509,635, issued October 18, 1988 under the provisions of Section 2(f). Section 8 and 15 affidavits accepted and acknowledged, respectively.

⁴ Registration No. 1,513,156, issued November 15, 1988 under the provisions of Section 2(f). Section 8 and 15 affidavits accepted and acknowledged, respectively. A disclaimer is made of the term PIT BARBECUE.

⁵ In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

See In re Azteca Restaurant Enterprises, Inc., 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The Examining Attorney maintains that the dominant portion of the marks of both registrant and applicant is the common element O'BRIEN'S or O'BRIENS (the absence of an apostrophe in applicant's mark being considered of no consequence). She argues that the remaining portions of the marks consist of highly descriptive, disclaimed matter which would have little impact on the commercial impressions created by the marks. She points out that the restaurant services of registrant encompass the restaurant services featuring sandwiches of applicant and argues that even the catering services of registrant are closely related to applicant's services, both being particular types of food services. Accordingly, she bases her determination of the likelihood of confusion on the similarity of the marks and the close relationship of the services. While applicant has made several arguments for a different treatment of marks containing surnames, the Examining Attorney has summarily rejected these arguments, stating that the fact that the common element in the marks is a surname is irrelevant to the determination of likelihood of confusion.

Applicant strongly contends that an applicant should not be prohibited from using a surname as part of a mark so long as the applicant, if a subsequent user of the name, makes a simple differentiation by the use of a distinctive suffix. Applicant insists that the right to registration of a mark containing a surname that is the same as in a prior registration is as compelling as the right to use the name, and that concurrent registration should be permitted so long as there is a reasonable basis in the marks for distinguishing the two uses of the surname. Applicant argues that since surnames are not inherently distinctive, they may be distinguished by the addition of different terms, even if these terms are descriptive, citing the Board's decision in *In re Martin's Famous Pastry Shoppe, Inc.*, 221 USPQ 364 (TTAB 1984); *aff'd*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

With respect to its own mark, applicant argues that "O'Brien" is a common surname which many persons may wish to use in connection with restaurants and that registration should not be barred by a prior registration for a mark containing the same surname so long as there are sufficient differences, even if these are suggestive or descriptive terms, to distinguish the marks as a whole. Comparing the marks at issue, applicant argues that the difference

between applicant's O'BRIENS IRISH SANDWICH BARS mark and the registered mark O'BRIEN'S PIT BARBEQUE is readily apparent, in that the suffix portion of each is suggestive of a different type of food establishment. The difference between applicant's mark and O'BRIEN'S is argued to lie in the absence of any qualifying descriptor at all in the registered mark. Applicant further argues that IRISH SANDWICH BARS is a unique suffix; that even if descriptive, this suffix should be enough to distinguish applicant's mark from the registered marks; and that since there is no evidence that IRISH is descriptive of sandwich bars, this term should be considered as a part of the dominant portion of applicant's mark. Applicant also argues that there are differences in the particular type of food services involved, and that the marks serve to point out these differences.⁶

Although we have taken under consideration applicant's arguments with respect to the interests of an applicant in using his surname, particularly when it is a common surname in connection with a restaurant business, our principal reviewing court long ago pointed out that

⁶ We have given no consideration to the evidence which applicant has attached to its brief in support of this point. The Examining Attorney has objected to the evidence as untimely and we have sustained this objection. See Trademark Rule 2.142(d).

...the interest in allowing an entrepreneur to use his own surname as a trademark on his goods must give way to the more compelling public and private interests involved in avoiding a likelihood of confusion or mistake as to source where use of the surname leads to such confusion or mistake.

Ford Motor Co. v. Ford, 462 F.2d 1405, 174 USPQ 456 (CCPA 1972).

Moreover, the issue before us is not applicant's right to use the mark, but rather the right to register the mark under the provisions of the Trademark Act. Inasmuch as the cited registrations have been issued under Section 2(f), any inherent nondistinctiveness stemming from the fact that O'BRIEN'S is a surname has been overcome by a showing of acquired distinctiveness on the part of registrant.

Surnames are not regarded as weak marks once the statutory surname issues have been resolved. In re Martin's Famous Pastry Shoppe, Inc, *supra* at 367. Furthermore, as pointed out by the Board in *In re H & H Products*, 228 USPQ 771, 773 (TTAB 1986), "it is well settled that there are no special rules regarding the registration of marks involving surnames in determining likelihood of confusion issues."

While it is true that marks must be considered in their entireties in determining likelihood of confusion, it is also well established that there is nothing improper in

giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). We agree with the Examining Attorney that the surname O'BRIEN'S is the dominant portion of both of the cited marks; in fact it is one of the marks in toto. The additional words PIT BARBEQUE simply describe the particular food specialty of that restaurant. Similarly, the surname O'BRIENS dominates applicant's mark, with the wording IRISH SANDWICH BAR once again providing information as to the food specialty (SANDWICH BAR) and, in addition, information as to either the geographic location or at least as to the IRISH origin of the restaurant. The portion of the respective marks which would be most likely to be viewed as an indication of source and to be used in referring to the restaurants is the same, the surname O'BRIEN'S or O'BRIENS.⁷

Although we agree that inherently distinctive suffixes might be sufficient to distinguish two marks containing the surname O'Brien, as argued by applicant, the present

⁷ The absence of the apostrophe in applicant's mark is a minimal difference, not likely to even be noticed by customers. Furthermore, the aural and connotative impressions would be identical for both forms of the surname.

suffixes do not so qualify. The circumstances are not similar to those in *In re Martin's Famous Pastry Shoppe, Inc.*, supra, wherein the addition of the wording PASTRY SHOPPE to the mark MARTIN'S was found to operate as a "built-in source distinction" over the mark MARTIN'S alone. Here, for purposes of determining likelihood of confusion, the services are identical. The identification by registrant of its services as "restaurant and catering services" fully encompasses the narrower "restaurant services featuring sandwiches" of applicant. By contrast, MARTIN'S was registered for cheese, whereas MARTIN'S FAMOUS PASTRY SHOPPE was being used with baked goods. Thus, the Board found the additional wording PASTRY SHOPPE, even though descriptive, sufficient to project a different commercial impression for the mark as a whole, since "one would not expect cheese to emanate from a 'pastry shoppe'."

Although applicant argues that the suffixes in the marks serve to point out the distinctions in the particular specialties of the respective restaurants, as we have previously stated, we do not believe the identification of a food specialty would be likely to be viewed by customers as an indication of source. Certainly the absence of a descriptor in the mark O'BRIEN'S alone leaves it equally open to interpretation as a shortened form of either

applicant's mark or registrant's mark. Not even the presence of the word IRISH in applicant's mark can serve as a distinguishing element. O'Brien is a well-known Irish name and the word IRISH is an apt descriptor for any restaurant run by an Irish proprietor.

Accordingly, in view of the similarity of the marks of applicant and registrant and the identical services with which the marks are intended to be used, we find confusion likely.

Looking to the requirement that the entire phrase IRISH SANDWICH BARS be disclaimed, we note that the Examining Attorney has based this requirement on the fact that applicant is located in Ireland and thus the term is geographically descriptive of its restaurant services. Applicant, on the other hand, argues that while there may be "Irish restaurants," one would not expect a "restaurant featuring sandwiches" to have an ethnic identity. Applicant continues to argue that IRISH is part of the unique portion of applicant's mark, i.e., O'BRIENS IRISH.

We agree with the Examining Attorney that the mere fact that applicant is located in Ireland makes IRISH descriptive of restaurant services offered in that geographic location. Furthermore, assuming that applicant intends to expand its operations to the United States, the

Ser No. 75/164,499

term IRISH would still be descriptive of the origin or proprietorship of the sandwich bars run under the mark O'BRIENS IRISH SANDWICH BARS. There is no need for the Examining Attorney to show that the entire phrase IRISH SANDWICH BAR is generic or in common use, in the same manner as "Irish restaurant" or "Irish pub." The fact that IRISH has independent descriptive significance is sufficient to require a disclaimer of this word, in addition to SANDWICH BARS. The requirement for a disclaimer of the entire phrase is proper.

Decision: The refusals to register under Section 2(d) and on the basis that the entire phrase IRISH SANDWICH BARS must be disclaimed are affirmed.

R. F. Cissel

T. J. Quinn

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board

Ser No. 75/164,499