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Paper No. 12  
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re MVD Pizza Corp.

Serial No. 75/714,181

Gordon D. Coplein and Andrew Baum of Darby & Darby, P.C.  
for MVD Pizza Corp.

Suellen C. Hickey, Trademark Examining Attorney, Law  
Office 112 (Janice O'Lear, Managing Attorney).

Before Wendel, Bucher and Drost, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

MVD Pizza Corp. has filed an application to register  
the mark LOUIE'S BROOKLYN PIZZA (typed drawing) for  
"restaurant services"<sup>1</sup> in International Class 42. A  
disclaimer has been made of any exclusive right to use the  
term BROOKLYN PIZZA apart from the mark as shown.

Registration has been refused under Section 2(d) of  
the Trademark Act, 15 U.S.C. §1052(d), on the ground that

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<sup>1</sup> Application Serial No. 75/714,181, filed on June 26, 1999,  
based upon allegations of use in commerce since at least as  
early as January 8, 1999.

applicant's mark, when applied to its services, so resembles the mark LOUIE'S PIZZA & ITALIAN RESTAURANT, and design, which is registered, as illustrated below,



also for "restaurant services"<sup>2</sup> in International Class 42, as to be likely to cause confusion, to cause mistake or to deceive.

After the Trademark Examining Attorney made the refusal final, this appeal followed. Applicant and the Trademark Examining Attorney have each filed appeal briefs. Applicant did not request an oral hearing.

The sole issue in this appeal is whether confusion is likely when applicant uses its mark on the services recited in the application. Based upon the record before us in this appeal, we affirm the refusal to register.

In the course of rendering this decision, we have followed the guidance of In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA

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<sup>2</sup> Registration No. 1,247,373, issued on August 2, 1983 [Section 8 affidavit accepted and Section 15 affidavit acknowledged].

1973). This case sets forth the factors, which if relevant, should be considered in determining likelihood of confusion. In the case at hand, the factors about which we have evidence are the similarity of the marks and the relationship between the services of the applicant and the registrant.

Turning first to a consideration of the respective services, applicant does not dispute that its "restaurant services" are identical to those of the registrant. Accordingly, we agree with the Trademark Examining Attorney that the services, as recited in the application and registration, are legally identical.

Hence, we focus our attention, as applicant and the Trademark Examining Attorney have done, on the similarity between the marks, keeping in mind as well, that when marks are used in connection with identical services, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines."

Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). See also In re Dixie Restaurants, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

The question here is whether the marks create the same commercial impression. The test is not whether the

marks can be distinguished in a side-by-side comparison, but whether they are sufficiently similar in their overall commercial impression so that confusion as to the source of the goods marketed under the respective marks is likely to result.

The Trademark Examining Attorney contends that the terms LOUIE'S BROOKLYN PIZZA and LOUIE'S PIZZA & ITALIAN RESTAURANT, have the same connotation, so that when the marks are used on identical restaurant services, there would be a likelihood of confusion, mistake, or deception. She maintains that the dominant portion of the marks of both registrant and applicant is the common element LOUIE'S. She argues that the remaining portions of the marks consist of highly descriptive, disclaimed matter that would have little impact on the commercial impressions created by the marks.

By contrast, applicant argues that the Trademark Examining Attorney's conclusion of likelihood of confusion is based upon an improper dissection of the marks. Applicant maintains that "LOUIE'S" is a common name which many persons may wish to use in connection with restaurants and that registration should not be barred by a prior registration for a service mark containing such a

weak term<sup>3</sup> so long as there are differences in the balance of the respective marks. In fact, applicant contends that the differences in descriptive terms can serve herein to distinguish the marks as a whole. Comparing the marks at issue, applicant argues that the difference between applicant's LOUIE'S BROOKLYN PIZZA mark and the registered mark LOUIE'S PIZZA & ITALIAN RESTAURANT and design is readily apparent. With respect to its own mark, applicant notes that its mark "is cleverly constructed since the connective term BROOKLYN can be said to qualify either or both of the terms LOUIE'S or PIZZA." (Applicant's appeal brief, p. 8). However, given the strong similarity of the marks, we simply disagree with applicant's argument that the marks are dissimilar in overall commercial impression.

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<sup>3</sup> The Trademark Examining Attorney correctly objected to applicant's Exhibit B, attached to its appeal brief. We note that these nine alleged third-party registrations in International Class 42 where the marks contained the word LOUIE'S, were not properly made of record. In order to make third-party registrations of record, soft copies of the registrations or photocopies of the appropriate U.S. Patent and Trademark Office electronic printouts should be submitted. See Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992). This was not done. Furthermore, the printouts of the search results were merely an exhibit attached to applicant's appeal brief. Copies of the registrations are to be made part of the record prior to the time of the appeal. See, 37 CFR 2.142(d); In re Broadway Chicken, Inc., 38 USPQ2d 1559, 1560-1561 n. 6 (TTAB 1996); and In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994). Accordingly, we have not considered this evidence in reaching our decision.

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); and Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993).

Applicant is correct in pointing out that there are differences between the marks in terms of appearance and sound. We find, however, in determining the overall commercial impressions of the respective marks, that these visual and aural differences are outweighed by the similar connotations of the marks. The marks in their entireties, when applied to identical services, essentially convey the same impression, namely, a restaurant known as LOUIE'S that specializes in PIZZA.

We agree with the Trademark Examining Attorney that the name LOUIE'S is the dominant portion of the cited mark. The additional words PIZZA & ITALIAN RESTAURANT simply describe the particular food specialty of that restaurant. Similarly, the name LOUIE'S dominates applicant's mark. The word PIZZA again providing information as to the food specialty, and the word

BROOKLYN may well provide information as to the locale or history of Louie's restaurant. Or the phrase BROOKLYN PIZZA, which applicant readily disclaimed as merely descriptive matter, may actually suggest a traditional style of New York pizza made for generations in the borough of Brooklyn. Irrespective of the exact origins of the word BROOKLYN in the context of applicant's composite mark, 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 name LOUIE'S.

Applicant also argues the significance of the fact that the word LOUIE'S in registrant's mark is highly stylized:

The compound word mark of the registration is in stylized form with the term LOUIE'S itself is (sic) in a highly distinctive design form, i.e., a script writing with a bold center lining. It also uses the "&" symbol and not the equivalent word "and."

(Applicant's brief, p. 6).

However, we agree with the Trademark Examining Attorney that applicant, with a typed drawing of its mark, is not restricted to any particular stylization when actually making use of the composite mark. In fact, as correctly noted by the Trademark Examining Attorney,

applicant's specimens of record (i.e., menus from its Long Island restaurant located in Huntington Station, NY) already show usage of the name LOUIE'S with cursive lettering similar to that shown in the cited registration.



From applicant's specimens of record



From registrant's drawing

As to the other features of registrant's special form drawing, the remaining features are limited to highly descriptive or generic terminology having an ampersand, and all of this contained on a background device. Even assuming that customers would in fact notice the design elements of registrant's composite mark, it would not be unreasonable for them to assume mistakenly upon encountering applicant's mark that applicant's restaurant services are merely a new outlet for "LOUIE'S PIZZA" restaurant services provided by registrant - this one connected in some way with the locale, cuisine or history of the borough of Brooklyn - and that the same entity therefore provides or sponsors both.

Accordingly, we find that consumers familiar with registrant's LOUIE'S PIZZA & ITALIAN RESTAURANT and design

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mark for restaurant services would be likely to believe, upon encountering applicant's similar LOUIE'S BROOKLYN PIZZA mark for identical restaurant services, that such services emanate from, or are otherwise sponsored by or affiliated with, the same source.

Decision: The refusal to register under Section 2(d) of the Act is affirmed.